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Copyright Protection for Attorney Work Product: Practical and Ethical Considerations

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ARTICLES

COPYRIGHT PROTECTION FOR ATTORNEY WORK PRODUCT: PRACTICAL AND ETHICAL CONSIDERATIONS

*Stanley F. Birch, Jr.**

My humble and minuscule contribution to the Journal's symposium issue in tribute to my friend and early copyright law mentor Professor L. Ray Patterson should not be considered any measure of my respect and affection for him. Our friendship began with his invaluable counsel in the early eighties, when I championed the copyright lineage of those Cabbage Patch Kids® dolls, Original Artworks, Inc. v. Toy Loft, Inc., 684 F.2d 821 (11th Cir. 1982). It continues through our present exchange of thoughts, concerns, articles (his), and published opinions (mine) on our mutual lifetime enchantment—the law of copyright. Professor Patterson has left an indelible impression. Having encountered many legal scholars and practitioners these many years, few, if any, hold a candle to Ray's capacity for original and independent thought—not only in copyright but in professional responsibility as well. Whatever meager contribution I have made to the development of the law of copyright is in large measure due to Ray's early tutelage in the core, first principles of copyright in which I now share his passion—even without his depth of insight. Ray has time and again demonstrated his unique proclivity for thoughtful and provocative application of the Copyright Clause to new emerging conflicts spawned by the technological advances of science. Ray is truly an original, whose intellectual and pedagogical contributions will light the way for generations of scholars—and struggling jurists—in the years ahead. I have the great fortune to call Professor L. Ray Patterson my good friend.

The impetus for this rumination occurred on a flight from Orlando to Atlanta in 1989. As it happened, I was seated next to an old friend-in-the-law who, having begun as a legal aid lawyer when I was clerking on the district court, had by then founded a firm that was a pioneer of condominium law. This speciality firm was in demand all over the world as the leader in composing integrated land use plans and restrictions, notably in the development of residential resort and

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retirement properties. The integration and harmonizations of covenants, restrictions, rights and responsibilities of multiple property regimes under one umbrella development was truly a legal art form—one that required hours of labor, thought and creativity borne of experience.

After an exchange of pleasantries and what-is-the-latest-with-you, he related and lamented a new and troubling development. A long-time developer client asked him to review and comment upon a set of resort documents for a project in a neighboring state in which the developer had been invited to participate. My friend discovered that the hundreds of pages of land restrictions and covenants were those of *his* firm, with only the names changed to protect the purloining practitioners. What was particularly unsettling to him was that the law firm whose name now appeared as the author of the documents was an established and respectable firm. He mused that the client who had paid the firm for their work product was probably unaware of the origins of their “effort.” He wondered aloud as to what, if any, recourse that his firm would have against these unethical plagiarists.

After explaining that it was his good fortune to have shared his tale of woe with me, thereby casting this rabbit into the proverbial briar patch, I suggested that he “sue the bastards” for copyright infringement. While today I would certainly counsel mediation and settlement, my perspective at that time, tempered in no small part by my shared outrage, counseled for more direct and forceful resolution. My tormented, but clear thinking, friend then logically inquired: you mean that attorney work product¹ can be protected by copyright? Thus came about the impetus for my study on this intriguing issue.

Upon return to my library, I at once consulted the venerable treatise on the law of copyright by Professor Nimmer. Imagine my surprised delight when I read the following:

There appear to be no valid grounds why legal forms such as contracts, insurance policies, pleadings and other legal documents should not be protected under the law of copyright. Section 113(b) of the [1976] Act suggests this conclusion by negative implication. . . . by limiting the scope of copyright protection to “useful articles,” connotes that it is inapplicable to a book containing legal forms—such a book does not portray a “useful article” [17 U.S.C.

¹ For the purpose of this Article, “attorney work product,” while it may indeed encompass the definition and concept articulated in *Hickman v. Taylor*, 329 U.S. 495, 67 S. Ct. 385 (1947) (later codified in Fed. R. Civ. P. 26(b)(3)), refers to the creative work generated by a law firm on behalf of a client generally for publication and dissemination in some manner.

§ 101. Because a legal form does not “convey information,” it falls outside the definition of a “useful article.”]

Moreover as far back as the Second Circuit’s 1958 ruling in *Continental Casualty Co. v. Beardsley* [253 F.2d 702 (2d Cir.), cert. denied, 358 U.S. 816 (1958)], despite some ambiguity in the opinion, conforms with this conclusion.²

However, that brief observation by Professor Nimmer together with only a remarkably few case citations,³ appears to be the full extent of the available authority and discussion of this topic. One would think in the current competitive and lawyer-mobile environment that characterizes the practice of law, firms would pay more attention to their own intellectual property.

There are many firms, large and small, that have established reputations in certain areas of practice. Frequently, the written work product of those firms represents and reflects years of experience and countless hours of drafting and revision. By its very nature, the work product often must be published, thereby rendering it vulnerable to wholesale usurpation by unethical competitors who have not invested the resources necessary to create the work. By placing a notice of claim of copyright routinely on work product, although no longer required for protection but advisable, a potential pirate may well be dissuaded.

Institution by a law firm of a copyright protection program may also thwart the unauthorized reproduction of client files (including legal memorandums and correspondence) that often precedes the defection of attorneys. Unauthorized copying and the use of the contents of client files that are properly “noticed,” would facilitate any infringement action pursued by the firm. Although non-competition agreements are rare in the law firm environment, the firm nevertheless may be able to limit its exposure to a raid on its current clients by controlling its written resources through an aggressive program of copyright protection and management.

At this juncture it should be emphasized that we are not discussing the law itself; it is now clear that no compiler can have a copyright in the law itself.⁴

² MELVILLE B. NIMMER & DAVID NIMMER, 1 NIMMER ON COPYRIGHT § 2.18[E] (2002).

³ See *Khandji v. Keystone Resorts Mgmt., Inc.*, 140 F.R.D. 697 (D. Colo. 1992) (claim of copyright in attorney’s settlement brochure recognized); *City Consumer Servs., Inc. v. Horne*, 100 F.R.D. 740 (D. Utah 1983) (extensive compilation of over 80,000 documents deemed copyrightable but available under the fair use doctrine as information of universal concern citing *Dow Jones & Co. v. Bd. of Trade of the City of Chicago*, 546 F. Supp. 113, 199 (S.D. N.Y. 1982)).

⁴ *Veck v. S. Bldg. Code Congress Int’l, Inc.*, 293 F.3d 791 (5th Cir. 2002) (*en banc*) (an excellent discussion of copyright and the law by Judge Edith Jones, including *Wheaton v. Peters*, 33 U.S. (8 Pet.) 591, 8 L. Ed. 1055 (1834), *Banks v. Manchester*, 128 U.S. 244, 9 S. Ct. 36, 32 L. Ed. 429 (1888), *Davidson v. Wheelack*, 27 F. 61 (D. Minn. 1886), *Harrison Co. v. Code Revision Comm’n*, 244 Ga.

Notwithstanding, some rights have been afforded to compilers and commentators relative to treatments and compilations of cases and statutes.⁵ However, here we will focus on the generation by attorneys of documents on behalf of clients involved in transactions governed by the law.

Given the pervasive use of form books, and now databases, in the profession, many practitioners may question the enforceability of a claimed copyright in a work that is the composite of innumerable contributions of lawyers throughout a work's evolution. To understand and appreciate the interface of copyright law with the typical generation of work product in a law office, an examination of certain copyright concepts is helpful. Many, if not most, legal documents may well fall within the statutory definitions of "derivative works," "compilations," and "collective works."⁶ Section 103(b) clarifies the limitations in the scope of protection afforded by copyright to derivative works and compilations. It provides:

The copyright in a compilation or a derivative work extends only to the materials contributed by the author of such work, as distinguished from the pre-existing material employed in the work, and does not imply any exclusive right in the pre-existing material.⁷

325, 260 S.E.2d 30 (1979), *Georgia v. The Harrison Co.*, 548 F. Supp. 110 (N.D. Ga. 1982), *vacated per stipulation*, 559 F. Supp. 37 (N.D. Ga. 1983). Also cited, as any informed judicial opinion on copyright would do, is L. Ray Patterson & Craig Joyce, *Monopolizing the Law: The Scope of Copyright Protection for Law Reports and Statutory Compilations*, 36 UCLA L. REV. 719 (1989)).

⁵ See *West Publ'g Co. v. Mead Data Cent., Inc.*, 799 F.2d 1219 (8th Cir. 1986); *Callaghan v. Meyers*, 128 U.S. 617 (1888). But see *Matthew Bender & Co. v. West Publ'g Co.*, 41 U.S.P.Q. 1321 (S.D.N.Y. 1996), *aff'd* 158 F.3 693 (2d Cir. 1998) (finding pagination process unprotectable).

⁶ 17 U.S.C. § 101 defines those terms of art as follows:

A "derivative work" is a work based upon one or more preexisting works, such as a translation, musical arrangement, dramatization, fictionalization, motion picture version, sound recording, art reproduction, abridgment, condensation, or any other form in which a work may be recast, transformed, or adapted. A work consisting of editorial revisions, annotations, elaborations, or other modifications which, as a whole, represent an original work of authorship, is a "derivative work."

A "compilation" is a work formed by the collection and assembling of preexisting materials or of data that are selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes an original work of authorship. The term "compilation" includes collective works.

A "collective work" is a work, such as a periodical issue, anthology, or encyclopedia, in which a number of contributions, constituting separate and independent works in themselves, are assembled into a collective whole.

⁷ 17 U.S.C. § 103(b) (2000).

Thus, as a practical matter, should a firm desire to assert a claim of copyright in its work product, it should establish a copyright-evolution file relative to the work documenting what, if any, predicates were utilized in the drafting and creation of the final product. One might not be surprised to find an experienced practitioner able to create, from his or her own intangible experience and thoughts, a legal document from the proverbial “whole cloth.” Nevertheless, it would be prudent to contemporaneously document the sources utilized by the drafter whether they be cerebral or tangible. Thus, whether the product is an original work of authorship of the compilation or derivative work variety⁸ or one crafted only by the wit, skill and experience verbalized in expression,⁹ we should examine the next concern for the law firm; that is, who owns this work product? Copyright authorship and ownership are distinct concepts because copyright rights are separable and transferable.¹⁰ Accordingly, in the context of attorney work product generated in a traditional law firm by “partners” and “associates” at the behest of a client, the relationship of the parties must be analyzed with respect to copyright law to determine ownership.

Central to the issue of ownership is the legal fiction embedded in Section 201(b):

In the case of a work made for hire, the employer or other person for whom the work was prepared is considered the author for purposes of this title, and, unless the parties have expressly agreed otherwise in a written instrument signed by them, owns all of the rights comprised in the copyright.¹¹

Accordingly, while the actual composer of the law firm’s work may be the “associate” toiling away in the catacombs for little more pay than that of a federal circuit judge, the law firm, by operation of law, becomes the “author” entitled to copyright ownership.¹² While this result may seem perfectly rational to the lawyer,

⁸ In the hierarchy of copyright protection compilation copyrights enjoy the least protection. The Court in *Feist Publications, Inc. v. Rural Telephone Service, Co.*, 499 U.S. 340, 349, 111 S. Ct. 1282, 1289, 13 L. Ed. 2d 358 (1991), characterized that protection as “thin”; e.g., general protection against rote, verbatim copying.

⁹ Typically derivative and creative types of copyright enjoy greater protection. See Warren Pub., Inc. v. Microdos Data Corp., 115 F.3d 1509, 1515 n.16 (11th Cir. 1997) (*en banc*).

¹⁰ 17 U.S.C. § 201(d)(2). See also *Morris v. Bus. Concepts, Inc.*, 283 F.3d 502, 503-04 (2d Cir. 2002); *Gardner v. Nike, Inc.*, 279 F.3d 777, 778-79 (9th Cir. 2002).

¹¹ 17 U.S.C. § 201(b).

¹² See *Community For Creative Non-Violence v. Reid*, 490 U.S. 730, 109 S. Ct. 2166 (1989) (discussing “employee” versus “independent contractor” status. Generally, an employee’s work created in the purview of his or her employment constitutes a work-made-for-hire [hereinafter “work for hire”] thereby vesting authorship and ownership in the employer; here, the law firm).

it may well come as a surprise to the client who is paying for the document preparation. But what few clients (even sophisticated corporations with in-house counsel) may understand is that any interest it may have in the document is merely possessory and does not extend to the copyright on the expression embodied in the document.¹³ Query, although the ethical rules may not affirmatively require an attorney or law firm to disclose to the client that the attorney or firm will, absent transfer to the client, retain the copyright in the document,¹⁴ would it not seem proper to do so? In at least one other profession, architecture, in which this issue is more graphically presented, the professional typically affirmatively undertakes to put the client on notice of such a claim of copyright.¹⁵ As intellectual property becomes more and more valuable and, concomitantly, better understood, perhaps savvy clients and attorneys will exercise more deliberate attention to copyright rights as an important element of the professional relationship.

Moving then from the potentially thorny issue of attorney-client relations, including conflicts of interest, the law firm desiring to secure its intellectual property must next confront an internal thicket of legal and business concerns. In ascertaining the ownership of attorney work product generated within the confines of the law firm, the relationship of a firm's constituent attorneys to the firm must be examined in light of the work-for-hire statute and its judicial construction. In a traditional law firm environment, the "firm" has the right to control and supervise the manner in which the legal work is performed. The degree of exercise of that supervision may vary depending upon the nature of the project, the skill and experience of the attorney, and the seniority of the attorney

¹³ 17 U.S.C. § 109(a). This concept is known as the "first sale" doctrine or, as Professor Nimmer more accurately describes it, the "first authorized disposition by which title passes" doctrine. 2 Nimmer on Copyright § 8.12[B][1][a]. In the case of a firm's preparation of a form to be used by its client, perhaps a bank or insurance company, the client would need to acquire a written transfer of the firm's § 106(a) rights to "reproduce the work in copies." I venture to guess that few, if any, such clients require its law firm to make such an assignment to it even having paid handsomely for having the document drafted for the express purpose of use by reproduction. Only by such an assignment could the client be certain that thereafter it exclusively *owns* the expression embodied in the document. See Joseph J. Legat Architects PC v. U.S. Dev. Corp., 625 F. Supp. 293, 296-99 (N.D. Ill. 1985). Naturally, the client obtains no greater copyright "title" than that provided by the law firm. This gets back to the scope of the copyright discussed *supra* notes 8 and 9. Accordingly, the client would be prudent to require the law firm to provide it with the copyright-evolution documentation described above. Without that evidence it may be impossible for the client to prevent a competitor from copying its publicly distributed and utilized documents for which it has paid the law firm a fee.

¹⁴ See American Bar Association, Model Rules of Prof'l Conduct R. 1.6, 1.7(b) & 1.8(a).

¹⁵ See Art. 6 of the "Standard Form of Agreement Between Owner and Architect" (1997 ed.) (advising the client that "the Architect shall be deemed the author of these documents and shall retain all . . . rights, including the copyright").

(which may or may not be commensurate with experience, depending upon the area of law involved). Although subject to these variables, which may be important in a particular situation, the firm would usually be the owner and statutory author of the associate/employee's work product.

The lines become faded, however, when considering the work of "partners" (in the traditional nomenclature). With the various incarnations of law firms today, including partnerships, professional corporations, partnerships of professional corporations, and the newer limited liability corporations, absent some sort of written agreement between the "firm" and its constituent "partners," it may be difficult to ascertain ownership in work product created by such a "partner"—unlike the somewhat easier "associate" situation.

The foregoing discussion clearly indicates that the safe and practical course to be undertaken by the law firm in securing ownership rights in its attorneys' work product is to enter into a written agreement whereby the attorney assigns to the law firm (pursuant to sections 201(d) and 294(a) and (b)(1)) all his or her right, title and interest in any copyrighted work of a legal nature produced during the term of his or her association with the firm. Reliance on such an express transfer under the Copyright Act is far sounder than the alternative constructive (*i.e.*, work-for-hire) method.

Finally, another application of the copyright law may also prove helpful to the law firm, or any business, where client information is of value. All of the documents and records, including correspondence,¹⁶ prepared on behalf of clients or for internal firm use are also subject to copyright protection—at least to prohibit wholesale replication by a defecting attorney (usually accomplished on the firm's own photocopiers). Where the copying of such records is unauthorized or for an improper purpose (*i.e.*, the pirating of clients), the firm would be on solid ground seeking the return of the copied documents as well as a bar against any further copying of same. Where there is no non-compete agreement this approach may impede, if not thwart, the exodus of client information that would facilitate a raid on the firm's clients.

While much of these musings are based on application of fundamental copyright principles, as noted above, there has been little litigation to test the scope of copyright protection for attorney work product. However, intriguing opportunities and concerns are presented for consideration by attorneys, law firms and clients—particularly in this era of increased intellectual property value and awareness.

¹⁶ In the case of correspondence, the author of the letter retains ownership of the copyright relative to the expression therein (the firm under work for hire doctrine or by written agreement) while the recipient of the letter acquires ownership of the tangible physical property of the letter itself. See 17 U.S.C. § 202; *Salinger v. Random House, Inc.*, 811 F.2d 90, 94-95 (2d Cir. 1987).

To complete the opening story, my friend's firm contacted the plagiarizing firm's senior partner and demonstrated that the unauthorized use had occurred—easily accomplished since both sets of documents had been filed as public records. In order to avoid the embarrassment (or worse) should the client of the offending firm discover its legerdemain and, one would hope, to do the right thing, that firm compensated the authoring firm for its work product and pledged to associate them in future endeavors. Perhaps Professor Patterson can incorporate this tale of professional misconduct and copyright into both of his courses!