

10-2009

# Originality

Alex Stein  
*Brooklyn Law School*

Gideon Parchomovsky

Follow this and additional works at: <https://brooklynworks.brooklaw.edu/faculty>

 Part of the [Other Law Commons](#)

---

## Recommended Citation

95 Va. L. Rev. 1505 (2009)

This Article is brought to you for free and open access by BrooklynWorks. It has been accepted for inclusion in Faculty Scholarship by an authorized administrator of BrooklynWorks.

# ORIGINALITY

*Gideon Parchomovsky\* and Alex Stein\*\**

*IN this Article we introduce a model of copyright law that calibrates authors' rights and liabilities to the level of originality in their works. We advocate this model as a substitute for the extant regime that unjustly and inefficiently grants equal protection to all works satisfying the "modicum of creativity" standard. Under our model, highly original works will receive enhanced protection and their authors will also be sheltered from suits by owners of preexisting works. Conversely, authors of less original works will receive diminished protection and incur greater exposure to copyright liability. We operationalize this proposal by designing separate rules for highly original works, for works exhibiting average originality, and for works that are minimally original or unoriginal. We illustrate our rules' application by showing how they could have altered court decisions in classic copyright cases in a socially beneficial way.*

*"[T]o make the copyright turnstile revolve, the author should have to deposit more than a penny in the box . . . ."*

Benjamin Kaplan<sup>1</sup>

## INTRODUCTION

Originality is the sine qua non of copyrightability. A work must be original to receive copyright protection. Yet, it is a very minimal requirement.<sup>2</sup> To prove originality, an author needs to show that

---

\* Professor, University of Pennsylvania Law School; Bar-Ilan University Faculty of Law, Israel.

\*\* George W. Crawford Visiting Professor of Law, Yale Law School. Professor of Law, Cardozo Law School. We thank Barton Beebe, Abraham Bell, Ben Depoorter, Bob Ellickson, Jim Gibson, Bobbi Kwall, and Peter Siegelman for insightful discussions and comments, and Taly Dvorkis and Lital Helman for superb research assistance.

<sup>1</sup> An Unhurried View of Copyright 46 (1967).

<sup>2</sup> See *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 250 (1903) ("Personality. . . expresses its singularity even in handwriting, and a very modest grade of art has in it something irreducible, which is one man's alone. That something he may copyright . . .") (Holmes, J.).

the expression for which protection is sought originated with her and was not copied from someone else. Once this showing is made, an author only needs to demonstrate that her expression contains a modicum of creativity<sup>3</sup> and that it was fixed in a tangible medium of expression<sup>4</sup> in order to enjoy the full panoply of exclusive rights and benefits under copyright law. Protection is granted indiscriminately to all expressive works, whether highly or only minimally original.<sup>5</sup>

Copyright law fails to take the next step and calibrate the scope of the copyright protection to the degree of the work's originality. Originality under the extant regime is a mere threshold requirement, and, moreover, one that can be easily satisfied.<sup>6</sup> The problem with the existing design is that by rewarding minimally original works and highly original works alike, the law incentivizes authors to produce works containing just enough originality to receive protection—but not more. This result is neither efficient nor just. Whether one subscribes to utilitarian theories of copyright law or to desert-based justifications, it appears that identical treatment of all works, regardless of the level of originality, is a misguided idea. From an efficiency perspective, the current approach incentivizes production of too many works at the low end of the originality spectrum and a suboptimal number of truly original works.<sup>7</sup> From a

---

<sup>3</sup> See *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345 (1991) (“Original, as the term is used in copyright, means only that the work was independently created by the author . . . and that it possesses at least some minimal degree of creativity.”).

<sup>4</sup> See 17 U.S.C. § 102(a) (2006) (making eligible for copyright protection any original work of authorship “fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device”).

<sup>5</sup> We believe that owners of unoriginal works would suffer lesser damage from copyright infringements. The prospect of lesser damage could potentially increase an infringer's chances to defeat the owner's suit by the “fair use” defense. Cf. *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 566 (1985) (observing that “the effect of the use upon the potential market for or value of the copyrighted work” . . . is undoubtedly the single most important element of fair use”). While this factor could mitigate the overbreadth of copyright protection, it does so haphazardly and in a very limited way.

<sup>6</sup> Cf. Douglas Lichtman, *Copyright as a Rule of Evidence*, 52 *Duke L.J.* 683, 704–16 (2003) (rationalizing the minimalist originality requirement as a cost-saving evidentiary device that allows courts to deny protection to works not exhibiting distinctiveness that makes it easy to establish copying).

<sup>7</sup> For discussion, see *infra* Part II.

fairness perspective, the distortion may be even greater as the just reward of authors who made a significant contribution to society is supposed to be much greater than for those who made a relatively insignificant contribution.<sup>8</sup>

In this Article we set out to design a workable copyright system that calibrates authors' protection and liability to the originality level of their works.<sup>9</sup> We do not propose to revamp the current definition of originality. We accept the two constituent elements of that definition—independent creation by the author and creativity—but treat them as continuums, rather than thresholds, and then vary the rules of copyright protection and liability in accordance with the degree of creativity of works. Under our proposed design, authors of highly original works will not only receive greater protection, but will also be sheltered from liability if sued for infringement by owners of preexisting works. Conversely, creators of minimally original works will receive little protection and incur greater exposure to liability if sued by others.

To operationalize our vision of copyright law, we introduce three legal mechanisms that combine substantive standards with evidentiary rules. Although each of our mechanisms is designed differently, they all share the common goal of inducing creation of original expression, either by rewarding authors of highly creative works or by penalizing authors of minimally original or completely unoriginal ones.

Our first mechanism is called “the doctrine of inequivalents” and is designed to afford the maximum degree of protection to exceptionally original works. Authors of works that incorporate uniquely high originality and creativity will not only receive the maximum

---

<sup>8</sup> For discussion of this idea, see *infra* Part II.

<sup>9</sup> For a more restrictive approach that imports the patent law nonobviousness requirement into copyright law, see Joseph Scott Miller, *Hoisting Originality*, 32 *Cardozo L. Rev.* (forthcoming 2009), available at [http://papers.ssrn.com/sol3/papers.cfm?abstract\\_id=1361040](http://papers.ssrn.com/sol3/papers.cfm?abstract_id=1361040). For discussions of this proposal, see Justin Hughes, *Should Copyright's Originality Standard be Sort-of Non-obviousness?* 2 (Apr. 5, 2009) (unpublished manuscript, available at <http://blog.richmond.edu/ipi/article-1/commentators/>); Roberta Rosenthal Kwall, *Hoisting Originality: A Response* 1 (Apr. 2009) (unpublished manuscript, available at <http://blog.richmond.edu/ipi/article-1/commentators/>); see also Roberta Rosenthal Kwall, *Originality in Context*, 44 *Hous. L. Rev.* 871, 874 (2007) (analyzing the relationship between the minimalist originality standard of copyright law and moral rights).

possible copyright protection, but will also be sheltered from liability for infringing the works of others.

Our second mechanism, "the added value doctrine," will govern infringement actions involving works of standard or average originality. It will require courts to compare the *relative* originality of the plaintiff's work with that of the defendant. If a court determines that the original contribution of the defendant is equal to or greater than that of the plaintiff, the plaintiff will be denied injunctive relief and be awarded market value compensation instead. This remedial shift from injunctions to damages<sup>10</sup> is designed to balance the competing demands of works of average originality by ensuring that original works are not suppressed from the market.

Our third and final mechanism, "the sameness rule," will regulate copyright conflicts that involve minimally original or non-original works. The rule will create a rebuttable presumption of copying when an allegedly infringing work containing minimal originality is substantively similar to the plaintiff's work. The presumption will be removed if the defendant successfully shows independent creation or the existence of a prior common source from which both works are borrowed.

As we will demonstrate, implementation of our proposed mechanisms will increase the benefits and reduce the costs associated with copyright protection. By putting a positive and a negative premium on originality, our framework will encourage creators to focus on the original content of their works and thereby enhance their contributions to society. At the same time, our proposal will also scale back the protection currently granted to multiple existing works and by so doing will clear the path for future creativity. Indeed, we will show how our mechanisms could have altered the analysis of classic copyright cases in a way that might have benefited society.

It should be emphasized that in designing our mechanisms, we were mindful of the constraints faced by adjudicators and were

---

<sup>10</sup> The classic taxonomy of Calabresi and Melamed would categorize this shift as a substitution of the property-rule protection for a liability rule. See Guido Calabresi & A. Douglas Melamed, *Property Rules, Liability Rules, and Inalienability: One View of the Cathedral*, 85 Harv. L. Rev. 1089, 1092-93, 1105-07 (1972). For a detailed discussion of the possibility and desirability of such substitutions, see Abraham Bell & Gideon Parchomovsky, *Pliability Rules*, 101 Mich. L. Rev. 1, 59-64 (2002).

therefore careful to craft them in a way that will enable their use in practice. Hence, the adoption of our framework will not require adjudicators to make determinations they do not make already, nor will it require them to opine on the inherent value of art and expression more than they do so now.

Structurally, the Article unfolds in three parts. In Part I, we will discuss the overbreadth problem of the extant copyright regime and its adverse effect on future creativity. We will show that over time the protection accorded to existing authors has become excessive to the point that it threatens to undermine copyright law's very goal of underwriting a rich expressive domain. In Part II, we will make the theoretical case for a copyright system that correlates protection and liability to works' originality. We posit that both efficiency and fairness-based justifications support this vision. We will also identify possible objections to this vision of copyright law and demonstrate that these objections are not compelling. We will then specify the design principles that should guide policymakers in creating an originality-based copyright law. Finally, in Part III, we will introduce our specific mechanisms for reforming copyright law, explain how they can be implemented in practice, and demonstrate their superiority over the existing legal rules and adjudicatory tools.

### I. COPYRIGHT'S OVERBREADTH

In assessing the breadth, or strength, of a property regime, it is important to pay heed to four distinct aspects of the problem. First, one must look at the rules governing acquisition of rights. Second, one must analyze the scope of rights (or dominion) of the owner. Third, one must examine the ease with which the owner may successfully assert her rights against others. Finally, one must consider the remedies the law grants to an owner whose rights have been violated. Looking at copyright law from this perspective reveals that right-holders enjoy very broad protection on each dimension and even more so in the aggregate.

Begin with the rules of acquisition. Copyrights may well be the easiest property rights to acquire. Copyright law sets two main prerequisites for acquisition of rights: the work in which rights are

sought must be original and must be fixed in a tangible medium of expression.<sup>11</sup> Both requirements set a very low threshold for obtaining protection, even in combination. The originality requirement demands that the person seeking copyright protection originated the work. Restated in the negative, originality requires that a person wishing to obtain rights in a work of expression did not copy the work from someone else. In the landmark decision *Feist v. Rural*,<sup>12</sup> the Supreme Court raised the originality bar somewhat by interpreting the requirement to incorporate a demand for “a modicum of creativity.”<sup>13</sup> Therefore, to satisfy the requirement after *Feist*, an author needs to show that she composed her work and that it contains a minimal amount of creativity.

The fixation requirement is even easier to meet. Under the Copyright Act, fixation does not require a specific form: any physical embodiment satisfies the requirement. Furthermore, the law does *not* require a permanent or even long-lasting fixation. Quite the contrary, even temporary or transient fixation that lasts for a very brief period of time will suffice. For example, in *MAI v. Peak*,<sup>14</sup> the Ninth Circuit ruled that a temporary copy of a program, generated by turning a computer on, qualifies as fixation under the Copyright Act, even though the copy vanishes once the computer is turned off.<sup>15</sup>

It should be noted that originality and fixation, the “gatekeepers” of copyright law, fall short of the “gatekeepers” employed by patent law. Patent law requires inventions to be useful, novel, and nonobvious to “a person having ordinary skill in the art.”<sup>16</sup> The usefulness requirement ensures that the claimed invention succeeds in

---

<sup>11</sup> 17 U.S.C. § 102(a) (2006).

<sup>12</sup> See *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340 (1991).

<sup>13</sup> *Id.* at 346.

<sup>14</sup> *MAI Sys. Corp. v. Peak Computer, Inc.*, 991 F.2d 511 (9th Cir. 1993).

<sup>15</sup> *Id.* at 518 (“[B]y showing that Peak loads the software into the RAM and is then able to view the system error log and diagnose the problem with the computer, MAI has adequately shown that the representation created in the RAM is ‘sufficiently permanent or stable to permit it to be perceived, reproduced, or otherwise communicated for a period of more than transitory duration.’”).

<sup>16</sup> 35 U.S.C. § 103(a) (2006); see also Robert P. Merges & Richard R. Nelson, On the Complex Economics of Patent Scope, 90 Colum. L. Rev. 839, 844 (1990) (“To be patentable an invention must meet all the statutory requirements for patentability: novelty, utility and non-obviousness.”).

attaining the goal or function described in the application.<sup>17</sup> The novelty requirement prescribes that an invention must be new in order to qualify for patent protection.<sup>18</sup> Finally, the nonobviousness requirement obliges an inventor to prove that her innovation marks a non-trivial improvement over the prior art.<sup>19</sup> Unlike copyright law, patent law requires inventions to undergo examination to ensure compliance with the statutory prerequisites prior to the grant of protection. Copyright law never incorporated an examination process and, strictly speaking, even registration is not required to secure protection.<sup>20</sup> It should be noted here that copyrights are rights in rem that avail against the rest of the world. Their recognition is not cost free.<sup>21</sup> As rights in rem, copyrights impose a duty on all members of our society to comply with the rights of the holder. This effect is of particular note in a democratic society since copy-

---

<sup>17</sup> See 35 U.S.C. § 101 (2006); see also *In re Fisher*, 421 F.3d 1365, 1371 (Fed. Cir. 2005). Additionally, the invention must be workable, since inoperative or nonsensical inventions will not be considered useful. See *CFMT, Inc. v. Yieldup Int'l Corp.*, 349 F.3d 1333, 1339 (Fed. Cir. 2003).

<sup>18</sup> See 35 U.S.C. § 102 (2006); see also Richard A. Mann et al., *Starting from Scratch: A Lawyer's Guide to Representing a Start-Up Company*, 56 Ark. L. Rev. 773, 785 (2004) ("The novelty requirement means that the invention must be new and not previously patented, described, or otherwise anticipated."); David W. Opderbeck, *Patent Damages Reform and the Shape of Patent Law*, 89 B.U. L. Rev. 127, 168 (2009) (explaining that an invention "is non-obvious only if, given the state of all the relevant prior art at the time of the invention, a person of ordinary skill in the art would consider the invention non-obvious" and that "the patent examiner or the court is required to put itself into the shoes of a person of ordinary skill in the art at the time of the invention in order to make the . . . determination . . . of the claimed invention's 'specific contribution' over the prior art").

<sup>19</sup> See 35 U.S.C. § 103 (2006); *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966) ("Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented."); see also *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 415–26 (2007) (applying *Graham's* criteria and invalidating patent on obviousness grounds).

<sup>20</sup> See 17 U.S.C. § 408(a) (2006). Registration of copyrights still provides owners with practical advantages. See *infra* note 50.

<sup>21</sup> Cf. James Wilson, *Could there be a Right to Own Intellectual Property?*, 28 L. & Phil. 393 (2009) (demonstrating that the moral case for recognizing intellectual property ownership is also far from obvious).



rights constrain others' freedom of expression. Furthermore, since copyright law grants owners *exclusive* rights it raises the specter of monopolistic pricing. As a result, certain users who value works at more than their competitive price, but are unwilling or unable to pay the right-holder's extortionary premium, will not acquire the works. Finally, copyrights also generate enforcement costs. Some of these costs are borne by the copyright holders themselves, but others are shouldered by society. The state puts its law enforcement machinery—courts, agencies, and the police—at the disposal of copyright holders in order to help them vindicate their rights and generate deterrence against putative infringers.

As far as the aspect of dominion is concerned, copyright law grants to authors six exclusive rights in their works. Section 106 of the Copyright Act confers upon authors the right of reproduction, adaptation, distribution, public performance, public display, and digital performance (in the case of sound recordings).<sup>22</sup> These exclusive rights do not exhaust all possible uses of expressive works: for example, one can freely perform a work privately or consume a work by reading or listening to it. Yet, they do put a very wide range of activities under the exclusive control of the copyright owner.<sup>23</sup>

To be sure, the Act also sets certain limitations on the dominion of the owner. But the limitations are either very narrow and specific<sup>24</sup> or very vague and complex.<sup>25</sup> As Professor James Gibson re-

---

<sup>22</sup> 17 U.S.C. § 106 (2006).

<sup>23</sup> *Id.*

<sup>24</sup> Such narrow exceptions include, *inter alia*, the use of copyrighted works in the framework of nonprofit, face-to-face teaching events, nonprofit informative religious services, or public broadcasts for the blind. See 17 U.S.C. §§ 108, 110 (2006).

<sup>25</sup> For example, 17 U.S.C. § 107 defines a general exception for the "fair use" of copyrighted works, which requires courts to employ a balancing test that includes four specific factors. The scope and limits of the fair use standard have been subject to various debates and criticism owing mainly to the doctrine's lack of clarity. See, e.g., Barton Beebe, *An Empirical Study of U.S. Copyright Fair Use Opinions, 1978–2005*, 156 U. Pa. L. Rev. 549, 549–50 (2008) (describing the fair use doctrine as enigmatic and developing an empirical account of its applications by courts); see also Lawrence Lessig, *Free Culture* 187 (2004) ("[F]air use in America simply means the right to hire a lawyer . . ."); Gideon Parchomovsky & Kevin A. Goldman, *Fair Use Harbors*, 93 Va. L. Rev. 1483, 1484–91 (2007) (attesting that applications of the fair use doctrine are unpredictable and proposing establishment of nonexclusive bright-line rules that will define *per se* fair uses); cf. 17 U.S.C. § 115 (2006) (stating the complex mechanisms for compulsory licenses).

cently noted, the architecture of rights and limitations in the Copyright Act—in combination with the ease of suing infringers and the remedies provided by the Act, which we discuss below—generates an unceasing dynamic of expansion of the copyright holders' dominion at the expense of users.<sup>26</sup> Specifically, Gibson demonstrated that the vagueness of the various limitations and defenses generated a high degree of uncertainty among users regarding the scope and content of their privileges, which in turn prompted them to pay copyright owners a license fee rather than risk litigation.<sup>27</sup>

Copyrights are also limited in time.<sup>28</sup> But the current protection term—life of the author plus 70 years—gives copyright owners at least 99.8% of the value they could extract if the protection were to last in perpetuity.<sup>29</sup> Furthermore, as life expectancy increases, so will the term of the protection. Finally, there is always a possibility that Congress will decide to extend the term as it has several times in the past.<sup>30</sup> Hence, the finite duration proviso is no longer a meaningful limitation on the dominion of copyright owners, and in the future it may become virtually irrelevant—if it has not become so already.

Let us turn to the third aspect: the ease with which copyright owners can vindicate their rights against putative infringers. Here, too, copyright law favors plaintiffs. To succeed in an infringement suit, a plaintiff needs to show copying and improper appropriation by the defendant. The terminology, however, is misleading. Importantly, courts do not require plaintiffs to prove *actual* copying. Instead, courts use access and similarity as proxies for copying. Accordingly, in order to prevail in an infringement suit, the plaintiff needs to show that the defendant had access to her work and that there are similarities between the two works. Access in copyright infringement actions is typically proved by circumstantial evidence. If the plaintiff's work achieved commercial success, or was widely

---

<sup>26</sup> See James Gibson, *Risk Aversion and Rights Accretion in Intellectual Property Law*, 116 Yale L.J. 882, 884 (2007).

<sup>27</sup> *Id.* at 887–906.

<sup>28</sup> 17 U.S.C. § 302 (2006).

<sup>29</sup> See *Eldred v. Ashcroft*, 537 U.S. 186, 255–56 (2003) (Breyer, J., dissenting).

<sup>30</sup> Congress extended the duration of copyrights in several instances, principally in 1831, 1909, 1976, and 1998. See *Eldred*, 537 U.S. at 192, 222 (2003) (dismissing constitutional challenges to the Copyright Term Extension Act of 1998).

disseminated, access will be inferred.<sup>31</sup> Furthermore, copyright liability does not depend on the mental state of the defendant. Innocent copying and even subconscious copying suffice to give rise to liability.<sup>32</sup> Copyright law thus effectively establishes a strict liability regime.<sup>33</sup>

The plaintiff also must prove improper appropriation. This requires the plaintiff to show that the defendant borrowed protected elements from her work. This showing is necessary to ensure that the similarity between the two works is not due to the presence of the same *unprotected* elements in both works. On its face, the unlawful appropriation inquiry may appear to be an important check on the power of copyright owners to bring infringement suits against others. The unlawful appropriation requirement, however, does not raise a significant bar for plaintiffs. As one commentator observed, “new creative works almost invariably borrow from old creative works, which raises the possibility of infringement on the part of the borrower.”<sup>34</sup>

As for the fourth and final aspect, remedies, copyright law furnishes an impressive array of remedies to successful plaintiffs, including injunctions and supra-compensatory damages.<sup>35</sup> Courts also have broad discretion to issue preliminary injunctions.<sup>36</sup> While preliminary injunctions are difficult to secure in other contexts, courts tend to grant them as a matter of course in copyright infringement cases without requiring a showing of irreparable harm, so long as the plaintiff can demonstrate a likelihood of success on the merits.<sup>37</sup> The ease with which preliminary injunctions are issued in copyright infringement cases is highly significant since most cases do not go

---

<sup>31</sup> *Three Boys Music Corp. v. Bolton*, 212 F.3d 477, 482–83 (9th Cir. 2000).

<sup>32</sup> *Id.* at 482–85 (affirming imposition of liability for subconscious copying); *Bright Tunes Music Corp. v. Harrisongs Music*, 420 F. Supp. 177, 180–81 (S.D.N.Y. 1976) (holding George Harrison liable for subconsciously infringing the copyright in the plaintiff’s song). For criticism, see Olufunmilayo B. Arewa, *The Freedom to Copy: Copyright, Creation and Context*, 41 U.C. Davis L. Rev. 477, 531–39 (2007).

<sup>33</sup> See, e.g., David Fagundes, *Crystals in the Public Domain*, 50 B.C. L. Rev. 139, 152 (2009) (“Direct copyright infringement remains a strict liability offense, and even a relatively minor unauthorized use can result in major liability if the owner has registered the work and chooses to claim statutory damages.”).

<sup>34</sup> Gibson, *supra* note 26, at 887.

<sup>35</sup> See 17 U.S.C. §§ 502–505 (2006).

<sup>36</sup> *Id.* § 502.

<sup>37</sup> Gibson, *supra* note 26, at 890.

beyond this stage. Faced with a preliminary injunction, most defendants elect not to proceed with the trial and choose to settle the case instead.<sup>38</sup>

In addition, the Copyright Act allows successful plaintiffs to collect both the compensation for the losses they suffered as a result of the infringement,<sup>39</sup> as well as the defendants' profits.<sup>40</sup> In the alternative, the Act entitles plaintiffs to seek statutory damages without proof of harm. The Act prescribes that statutory damages must range from \$750 to \$150,000 per work infringed, while leaving courts the discretion to set the actual amount based on the circumstances of the case.<sup>41</sup> Finally, the Act authorizes courts to order the impounding and destruction of infringing articles.<sup>42</sup>

In light of this analysis, it is not at all surprising that many copyright scholars believe that copyright protection goes overboard.<sup>43</sup> Indeed, there is virtual consensus among theorists that copyright law offers excessive protection to existing authors and does so at the expense of future creators. Professor Yochai Benkler, for example, has decried the "enclosure movement" in copyright law, pointing out that many uses of expressive works that were considered legitimate in the past can no longer be carried out without permission from the right-holder.<sup>44</sup> Referring to the same dynamic, Professor Pamela Samuelson colorfully termed it the "copyright grab."<sup>45</sup> Moreover, Professor Lawrence Lessig cautioned that if the

---

<sup>38</sup> Id. at 944–45. Gibson notes that plaintiffs take advantage of courts' willingness to issue preliminary injunctions in order to "keep[] cases from reaching a substantive ruling that might clarify feedback-fueling gray areas." Id.

<sup>39</sup> 17 U.S.C. § 504(b) (2006).

<sup>40</sup> Id.

<sup>41</sup> Id. § 504(c)(1)–(2). If the infringement is not willful, the maximum amount a plaintiff can collect is \$30,000. Id. § 504(c)(1). The minimum damage award for good-faith infringements is \$200. Id. § 504(c)(2).

<sup>42</sup> Id. § 503.

<sup>43</sup> See, e.g., Neil Weinstock Netanel, *Copyright's Paradox* 54–80 (2008) (discussing "copyright's ungainly expansion"); Jessica Litman, *Billowing White Goo*, 31 Colum. J.L. & Arts 587, 587 (2008) (attesting that rights granted by copyright law underwent extraordinary expansion over the past fifty years); John Tehranian, *Infringement Nation: Copyright Reform and the Law/Norm Gap*, 2007 Utah L. Rev. 537, 543–48 (2007) (attesting that copyright protection and liability for copyright infringement are excessive).

<sup>44</sup> Yochai Benkler, *Free as the Air to Common Use: First Amendment Constraints on Enclosure of the Public Domain*, 74 N.Y.U. L. Rev. 354, 354–60 (1999).

<sup>45</sup> Pamela Samuelson, *The Copyright Grab*, *Wired*, Jan. 1996, at 134.

trend of expansion in copyright law is not arrested, it will put future creativity at risk.<sup>46</sup> Finally, Siva Vaidhyanathan best captured the essence of the problem when he concluded that “[copyright] law has lost sight of its original charge: to encourage creativity, science, and democracy. . . . [it] rewards works already created and limits works yet to be created.”<sup>47</sup>

In the next Part, we develop a proposal to redesign copyright law in a way that fixes this defect. Specifically, we make a case for a copyright regime that correlates authors’ protection and potential liability to the level of originality and creativity in their works. We demonstrate that our proposal has the potential not only to remedy the overbreadth problem that currently plagues copyright law, but also to enhance the originality and creativity of expressive works and thus enrich the domains of art, culture, and technology.

## II. ORIGINALITY-BASED COPYRIGHTS

In this Part, we lay out a normative case for correlating copyright protection and liability with the originality of works of authorship. We submit that originality-based copyright law can curtail the overbreadth problem we discussed in Part I, as well as improve the utility and fairness of the current regime.

Our definition of originality is qualitatively similar to that used by the courts. Originality subsists in independently created expressive elements and embodies a demand for a certain level of creativity. Rather than a threshold requirement, we conceive of originality as a continuum and set out to redesign copyright law in accordance with this vision. We argue that a high level of originality should entitle the author to a higher degree of protection against unauthorized uses, as well as shelter her, to varying degrees, against liability for borrowing from others. Conversely, a low originality level should qualify authors to minimal protection under the Copyright Act and expose them to enhanced liability if they borrowed from preexisting works.<sup>48</sup>

---

<sup>46</sup> Lawrence Lessig, *The Future of Ideas: The Fate of the Commons in a Connected World* (2001).

<sup>47</sup> Siva Vaidhyanathan, *Copyrights and Copywrongs: The Rise of Intellectual Property and How it Threatens Creativity* 4 (2001).

<sup>48</sup> Cf. Gideon Parchomovsky & Alex Stein, *Torts and Innovation*, 107 Mich. L. Rev. 285, 288–90 (2008) (conceptualizing tort liability rules as taxes and subsidies for inno-

We adopt the originality criterion for a number of reasons. The first reason is benefit to society. United States copyright law is grounded in utilitarian philosophy. The Intellectual Property Clause in the Constitution grants Congress the power “[t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.”<sup>49</sup> On this view, copyright protection is a means to an end. Its *raison d’être* is to enrich the domain of expression and thereby improve the well-being of society. Naturally, only original works promote social welfare. Society has no interest in protecting unoriginal works that effect no advancements in art, literature, science, education, or other useful endeavors.

The analysis should not stop here, however. Under the extant regime, originality is a mere threshold requirement, and, moreover, one that minimally original works satisfy as well. The problem with this design is that it fails to differentiate between different levels of originality. By rewarding minimally original works and highly original works alike, the existing law incentivizes authors to produce works containing just enough originality to receive protection, but not more. From a societal viewpoint, however, the degree of originality matters. Presumably, the more original works generate a greater benefit for society. Yet, this fact is not embedded in the current regime. If society wishes to encourage authors to produce highly original works and not settle for the bare minimum necessary to secure protection, it must reflect this preference in the design of the law. That is, it ought to increase the amount of protection and decrease the potential liability of authors whose works incorporate a high degree of originality. Conversely, it ought to decrease the amount of protection and increase the potential liability of authors who produce minimally original works. These measures will prompt authors to focus on the originality factor, and thereby align their private interests with the broader social interest.

An additional justification for our proposal has to do with cost. Copyright protection generates four types of cost. The first type is

---

vators, on the one hand, and for replicators and users of conventional knowledge, on the other hand, and calling for the removal of rules that chill innovation).

<sup>49</sup> U.S. Const. art. I, § 8, cl. 8.

the cost of establishing and maintaining a system of copyright protection. To enable the system to operate, it was necessary to pass elaborate legislation that defines the relevant rights, powers, and privileges of authors. Then, it became necessary to set up a special administrative agency, the Copyright Office, to administer the registration of rights.<sup>50</sup> Like other administrative agencies, the Copyright Office is funded by society. Society also bears the cost of criminal enforcement against copyright violators<sup>51</sup> and of the resolution of private copyright disputes that find their way to the court system.

The second type of cost is monopolistic pricing. At least in some cases, copyright law, through its grant of exclusivity, bestows upon right-holders enough market power to charge monopolistic supra-competitive prices.<sup>52</sup> As a result, some buyers who would have pur-

---

<sup>50</sup> Although registration is no longer mandatory, it offers three distinct benefits to copyright owners. First, it establishes *prima facie* evidence of the validity of the copyright and of the facts stated in the certificate in judicial proceedings. 17 U.S.C. § 410(c) (2006). Second, subject to certain exceptions, it serves as a prerequisite for commencing a copyright infringement suit. *Id.* § 411(a). Third, it serves as a precondition for awarding statutory damages and attorney's fees in judicial proceedings, while only an award of actual damages and profits is available in the absence of registration. *Id.* § 412.

<sup>51</sup> See, e.g., *Id.* §§ 506, 1204(a). Congress recently showed an inclination to expand criminal liability for copyright violations. See Eric Goldman, *Warez Trading and Criminal Copyright Infringement*, 51 J. Copyright Soc'y USA 395, 396 (2004). This development will increase the costs of criminal enforcement. The recent Pro-IP Act, officially called the Prioritizing Resources and Organization for Intellectual Property Act of 2008, exacerbates those costs by stiffening the penalties for all intellectual property violations and by appointing a special "IP Czar" to oversee the enforcement of those penalties. Pub. L. No. 110-403, 122 Stat. 4256 (codified as amended in scattered sections of 15 U.S.C. and 17 U.S.C. (2006)).

<sup>52</sup> See, e.g., S.J. Liebowitz, *Copyright Law, Photocopying, and Price Discrimination*, 8 Res. L. & Econ. 181, 184 (1986) (associating copyright ownership with pricing monopoly); Christopher Sprigman, *Reform(aliz)ing Copyright*, 57 Stan. L. Rev. 485, 524 (2004) (explaining that copyright "creates deadweight losses in markets for expression" because "exclusive rights . . . enable the creator to charge a supracompetitive price" and "[c]onsequently, access to the work will be denied to those who value it in excess of the competitive price, but less than the supracompetitive price that the monopolist is able to command"); see also Michael Abramowicz, *A Theory of Copyright's Derivative Right and Related Doctrines*, 90 Minn. L. Rev. 317, 325-32 (2005) (analyzing anti-competitive effects of copyright's derivative rights and whether the rights' benefits offset those effects); Christopher S. Yoo, *Copyright and Product Differentiation*, 79 N.Y.U. L. Rev. 212, 220-24 (2004) (arguing for a "differentiated products" model for copyrights as a basis for monopolistic competition).

chased copyrighted works at their competitive price must forego the transaction and do without the works.

The third cost is political rent-seeking. This cost is related to, yet analytically distinct from, the problem of monopoly. By providing a legal structure that allows for supra-competitive profits, copyright law creates rents over which various interest groups compete. Rent-seeking is an inherently wasteful activity.<sup>53</sup> It diverts resources to non-productive uses, such as political lobbying, that often yield socially suboptimal legislation or regulation.<sup>54</sup> Indeed, as Professor Jessica Litman has pointed out, interest-group politics play a key role in shaping our copyright law,<sup>55</sup> and many other scholars believe that the Copyright Term Extension Act of 1998 was powered through by Disney.<sup>56</sup>

The fourth and final cost is the adverse impact of copyright on future creativity. The magnitude of this cost is a direct function of the breadth of copyright protection accorded to existing authors. The broader the scope of the protection, the costlier it becomes for aspiring authors to produce their works. In a world with extremely broad protection, aspiring authors will either have to create completely original works or secure permission from prior authors. As

<sup>53</sup> See Robert D. Tollison, *Rent Seeking: A Survey*, 35 *Kyklos* 575, 576 (1982).

<sup>54</sup> Fred McChesney succinctly described it as “money for nothing.” See Fred S. McChesney, *Money for Nothing: Politicians, Rent Extraction, and Political Extortion* 3 (1997).

<sup>55</sup> See Jessica D. Litman, *Copyright, Compromise, and Legislative History*, 72 *Cornell L. Rev.* 857, 903 (1987) (claiming that in considering the 1976 Copyright Act, Congress relied heavily on industry specialists); Jessica Litman, *Revising Copyright Law for the Information Age*, 75 *Or. L. Rev.* 19, 22–23 (1996) (demonstrating copyright laws’ bias in favor of industry players).

<sup>56</sup> Professor Lessig termed the legislation the “Mickey Mouse Protection Act.” See Lawrence Lessig, *Copyright’s First Amendment*, 48 *UCLA L. Rev.* 1057, 1065 (2001); see also Jessica Litman, *Digital Copyright* 23 (2001) (describing Disney’s lobbying effort at protecting Mickey Mouse for an additional twenty years); Lawrence Lessig, *How I Lost the Big One*, *Legal Affairs*, Mar.-Apr. 2004, at 57, 58; Christopher Sprigman, *The Mouse that Ate the Public Domain: Disney, The Copyright Term Extension Act, and Eldred v. Ashcroft*, *FindLaw’s Writ*, Mar. 5, 2002, [http://writ.news.findlaw.com/commentary/20020305\\_sprigman.html](http://writ.news.findlaw.com/commentary/20020305_sprigman.html) (“Rather than allow Mickey and friends to enter the public domain, Disney and *its* friends—a group of Hollywood studios, music labels, and PACs representing content owners—told Congress that they wanted an extension bill passed. Prompted perhaps by the Disney group’s lavish donations of campaign cash—more than \$6.3 million in 1997–98, according to the nonprofit Center for Responsive Politics—Congress passed and President Clinton signed the Sonny Bono Copyright Term Extension Act.”).



is the case with any property regime, the need to secure permission may give rise to the spectre of holdups. But in the copyright context, a greater problem lurks: the vastness of the universe of copyrighted works makes it virtually impossible to identify the relevant rights-holders and negotiate with them. Worse yet, the same reason makes it impracticable for future authors to engage in comprehensive preemption searches, without which they can never be sure that their works are completely original.

Our proposal does not concern the first three costs; it targets the fourth. Given the high information costs that exist in the field of copyright law,<sup>57</sup> the only workable way to afford elbow room for future creators is by narrowing copyright protection based on the originality criterion. Varying protection based on originality will reduce the ability of authors of minimally original works to bring infringement suits against subsequent creators. This should help clear the path for future authors by lowering the cost of producing new works. In property parlance, it may be said that our proposal seeks to minimize the blocking effect of prior expressive assets by reconfiguring their size.<sup>58</sup> Our proposal can also be justified on fairness grounds. Economic justifications focus almost invariably on individuals' *ex ante* incentives for action.<sup>59</sup> Fairness-based justifications, in contrast, predominantly take an *ex post* approach.<sup>60</sup> A fairness-driven theory that is often invoked to justify copyright protection focuses on desert. Under this theory, authors deserve to be rewarded for their labor and the contribution they made to soci-

---

<sup>57</sup> See Clarisa Long, *Information Costs in Patent and Copyright*, 90 Va. L. Rev. 465, 500–18 (2004) (explaining that copyright law imposes high information costs on potential infringers, but also reduces those costs by allowing independent-creation and other defenses to defeat owners' suits).

<sup>58</sup> See generally Abraham Bell & Gideon Parchomovsky, *Reconfiguring Property in Three Dimensions*, 75 U. Chi. L. Rev. 1015, 1051–53 (2008) (justifying regulation and other measures against owner-initiated configurations of assets that impose externalities on others).

<sup>59</sup> See Mark A. Lemley, *Ex Ante Versus Ex Post Justifications for Intellectual Property*, 71 U. Chi. L. Rev. 129, 129–30 (2004); see also *Mazer v. Stein*, 347 U.S. 201, 219 (1954) (“The economic philosophy behind the clause empowering Congress to grant patents and copyrights is the conviction that encouragement of individual effort by personal gain is the best way to advance public welfare . . .”).

<sup>60</sup> See Frank H. Easterbrook, *Foreword: The Court and the Economic System*, 98 Harv. L. Rev. 4, 11 (1984).

ety.<sup>61</sup> From this perspective, too, an author's rewards should correlate with either her effort or her contribution to society. Awarding the same protection to works that are highly original and works that exhibit scant originality (or no originality whatsoever) is unfair. Allowing authors of minimally original works to block the creation of novel works, more original than theirs, is also unjust. This unfairness is far from being an unavoidable consequence of copyright ownership. The existence and scope of copyright protection are both matters of social choice, and society should make this choice wisely. It can and should condition that protection on the size of the benefit that the protected work brings to society.

A workable originality-based system of copyright protection must combine flexibility and commitment. The system's rules must be flexible enough to allow courts to adjust the protection of copyrighted works to their level of originality. Rigid rules would impair the adjudicators' ability to make these case-specific adjustments. Courts' decisions on copyright liability and remedies cannot be completely discretionary, though. The system needs to give authors a credible assurance that its protection of copyright on the ground will actually correspond to the underlying work's originality. Failure to provide this assurance would not allow the system to eliminate the perverse incentives that exist under extant law.

Our system attains the twin goals of flexibility and commitment to originality. It creates a synergy between the substantive standards of copyright protection and the evidentiary rules that implement those standards.<sup>62</sup> The substantive standards we recommend are flexible. They will allow courts to make case-by-case assessments of works' originality. Evidentiary rules that accompany those standards will systematically influence courts' decisions in favor of original creators and against authors whose works exhibit

---

<sup>61</sup> See Justin Hughes, *The Philosophy of Intellectual Property*, 77 *Geo. L.J.* 287, 297–310 (1988) (providing an insightful and comprehensive account of labor-based justifications of intellectual property); see also Cheryl Swack, *Safeguarding Artistic Creation and the Cultural Heritage: A Comparison of *Droit Moral* Between France and the United States*, 22 *Colum. J.L. & Arts* 361, 361–62 (1998) (discussing artists' "moral rights" in their artwork).

<sup>62</sup> This methodology originates from Richard A. Bierschbach & Alex Stein, *Overenforcement*, 93 *Geo. L.J.* 1743, 1746 (2005); see also Alex Stein, *Foundations of Evidence Law* 17–25, 133–53 (2005) (explicating the capacity of evidentiary rules to optimize law-enforcement by allocating the risk of error in adjudicative fact-finding).

scant or no originality. This skewing will credibly signal the system's commitment to originality. Developers of original works will consequently be able to count on and benefit from that commitment.

Before we introduce our specific mechanisms for improving copyright law, we wish to address two possible objections. The first objection is predicated on the concern that our proposal may lead to excessive originality. This objection questions the utility of legal rules designed to induce authors to produce original works. Arguably, those rules may force out excessive originality, which will be wasteful or otherwise detrimental to society.

We do not dispute that originality has an optimal amount. But this amount is difficult to ascertain, and our proposed system does not even begin to address it. We doubt that anyone can ever identify the optimal amount of originality in arts and literature. Adoption of this unrealistically perfectionist, if not utopian, criterion for reforming copyright law would forestall any attempt at improving the law. We take a modest position on the quantum of originality issue. We believe that society should reflect its interest in original works in the design of copyright law. Our goal is to reduce the obvious distortions that prevent copyright law from achieving its stated goals.

The second objection goes to the practicality of our proposal. In an oft-cited paragraph, Justice Holmes cautioned that "[i]t would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits."<sup>63</sup> Echoing Justice Holmes, one may wonder whether judges are qualified to implement our proposal. We believe that this concern is misplaced for a number of reasons. To begin with, we do not require judges to make determinations about the intrinsic value of art, or even what constitutes art. Justice Holmes wrote his famous sentence in response to Justice Harlan's opinion stating that advertisements should be denied copyright protection because they do not constitute art.<sup>64</sup> Our proposal does not touch on that issue. Indeed, we do not address this question at all. We clearly do not seek to bar pro-

---

<sup>63</sup> *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251 (1903).

<sup>64</sup> *Id.* at 253 (Harlan, J., dissenting).

tection to any expressive or art form. Quite the opposite; we accept Justice Holmes' view that the public ought to have the power to decide what art is.

We merely assign courts the task of determining an expressive work's level of originality. Courts are not only capable of performing this task, but they already do so. Every infringement suit requires the court to identify the original elements in the works involved and decide whether the defendant appropriated original expression from the plaintiff's work.<sup>65</sup> Furthermore, whenever a defendant raises a fair use defense, the court must assess the level of transformativeness in her work as part of the analysis. In doing so, judges assess the level of originality and creativity in the allegedly infringing work.<sup>66</sup> In appropriate cases, judges can seek assistance from expert witnesses in making originality determinations, as they do already.<sup>67</sup> This means that courts are quite adept at making originality determinations and that our proposal will not present them with a new challenge.

### III. THE MECHANICS OF ORIGINALITY-BASED COPYRIGHTS

In this Part, we introduce a set of rules designed to calibrate the scope of a work's protection to its level of originality. Our rules have two goals. First, they aim to strengthen the protection granted to authors of highly original works by increasing the level of pro-

---

<sup>65</sup> The subtractive approach (an important method for determining unlawful appropriation in copyright infringement suits) requires courts to remove from their consideration the unoriginal and other unprotected elements of the plaintiff's work in order to determine whether there is sufficient similarity between the defendant's work and the *protectable elements* of the plaintiff's work. See David Nimmer et al., A Structured Approach to Analyzing the Substantial Similarity of Computer Software in Copyright Infringement Cases, 20 Ariz. St. L.J. 625, 635 (1988); see also *Alexander v. Haley*, 460 F. Supp. 40, 46 (S.D.N.Y. 1978) (finding no substantial similarity between the protectable, as opposed to non-protectable, elements of the plaintiff's novel and the defendant's book). The "Abstract-Filtration-Comparison" test for software-related copyright suits also entails assessment of works' originality. See *Computer Assocs. Int'l, Inc. v. Altai, Inc.*, 982 F.2d 693, 706-12 (2d Cir. 1992).

<sup>66</sup> See, e.g., Pierre N. Leval, *Toward a Fair Use Standard*, 103 Harv. L. Rev. 1105, 1111 (1990) (demonstrating that transformativeness is critical to whether a use "fulfill[ed] the objective of copyright law to stimulate creativity" and arguing that creative use might be justified despite a copyright owner's objection).

<sup>67</sup> For one such example, see *Bright Tunes Music Corp. v. Harrisongs Music*, 420 F. Supp. 177, 178 n.3 (S.D.N.Y. 1976); see also *infra* note 68.

tection to which they will be entitled. Second, they reduce—and, in appropriate cases, completely eliminate—those authors' exposure to liability for infringement. Our rules will bring about the opposite result for authors of works exhibiting scant originality by scaling down their works' protection correspondingly with the low originality level. The decrease we propose will not stop at a zero-protection: authors of completely unoriginal works will receive "negative protection" in the form of an increased prospect of copyright liability.

To achieve these effects, we reformulate the substantive standards of copyright law and adjust the evidentiary doctrines that accompany those standards. Specifically, we divide the domain of expressive works into three categories. The first category consists of exceptionally original works. The second is comprised of a wide variety of works that exhibit regular or average originality. The third accommodates works that are almost or completely unoriginal.

Under our proposed system, exceptionally original works will entitle their authors to a sword and a shield. Authors of such works will both receive very broad protection against infringements and be sheltered from copyright liability. Works in the second category will not enjoy the privileged status of works that belong to the first category. The protection and liability of those works' authors will depend on the *relative* originality of each work. In resolving conflicts between those works, courts will compare the level of originality of the plaintiff's work with that of the defendant's work. If the plaintiff's work is more original than the defendant's, the plaintiff will prevail. Upon winning this originality competition, the plaintiff will be able to collect damages but not injunctive relief. Finally, authors of the scantily original or altogether unoriginal works that fall into the third category will receive no protection at all. Those authors will also assume liability for imitating works of others.

To operationalize our scheme, we introduce three legal mechanisms: "the doctrine of inequivalents," "the added-value doctrine," and "the sameness rule." Each of these mechanisms is designed to apply in one of our originality categories. Our first mechanism, the inequivalents doctrine, will apply to the category of exceptionally original works. The second, the added-value doctrine, will govern disputes between works of average originality. Finally, the same-

ness rule will regulate conflicts involving minimally original or unoriginal works. In the remainder of this Part, we explain in detail how courts should apply our proposed mechanisms. We also compare our mechanisms to the rules that copyright law currently employs, and show that these mechanisms outperform extant copyright rules by any chosen criterion of efficiency and fairness.

### *A. The Doctrine of Inequivalents*

The doctrine of inequivalents will exempt the defendant from copyright infringement liability when her work is exceptionally original and creative. The work's exceptional creativity may be self-evident, so that a court can verify it without recourse to expert testimony. Alternatively, the work's exceptional creativity could be established by reliance on the testimonies of experts from the relevant industry. The experts will rely on the same knowledge they presently invoke in copyright trials when they testify about works' similarity and success on the market.<sup>68</sup>

In either case, an alleged infringer who borrowed from a copyrighted work and seeks to rely on the doctrine of inequivalents will have to establish her work's exceptional creativity—or inequivalence—by clear and convincing evidence. This evidentiary requirement will minimize the number of court decisions that erroneously grant works an inequivalence status.<sup>69</sup> As a result, only highly original and creative works will earn the safe harbor of "exceptional creativity." Authors of those truly exceptional works will consequently be immunized against infringement suits by prior authors from whose works they borrowed.

---

<sup>68</sup> See, e.g., *Metro-Goldwyn-Mayer Studios Inc. v. Gorkster, Ltd.*, 545 U.S. 913, 952–54 (2005) (Breyer, J., concurring) (relying on expert testimony to find a market for non-infringing uses of peer-to-peer software and to quantify the volume of infringement); *Three Boys Music Corp. v. Bolton*, 212 F.3d 477, 485 (9th Cir. 2000) (stating that "[t]he extrinsic test [of works' substantial similarity] often requires analytical dissection of a work and expert testimony." (citing *Apple Computer, Inc. v. Microsoft Corp.*, 35 F.3d 1435, 1442 (9th Cir. 1994))); *Repp v. Webber*, 132 F.3d 882, 887 (2d Cir. 1997) (relying on expert testimony in determining "harmonic similarities" between musical works); *Sid & Marty Krofft Television Prods., Inc. v. McDonald's Corp.*, 562 F.2d 1157, 1164 (9th Cir. 1977) (describing the use of expert testimony for the extrinsic test on substantial similarity); see also *Sturdza v. U.A.E.*, 281 F.3d 1287, 1300 (D.C. Cir. 2002) (observing that courts adjudicating copyright cases increasingly rely on experts).

<sup>69</sup> See Stein, *supra* note 62, at 152–53.

Accordingly, if Anna, a film producer, incorporated expressive elements from a short story by Bill in a path-breaking movie she produced, our doctrine of inequivalents will shelter her from liability. The high level of originality and creativity in Anna's work should grant her privileged status under our proposed scheme, even though she used protected elements from a preexisting work.

The inequivalents doctrine may be justified on grounds of both efficiency and fairness. Works demonstrating exceptional creativity significantly enrich society's literary, artistic, and aesthetic experiences.<sup>70</sup> Authors of exceptionally creative works therefore ought to be both encouraged to produce them and rewarded for doing so. Their creative efforts should not be stalled by the threat of copyright liability for non-imitative copying of other works.

This justification may encounter an objection from general property theory. Arguably, an expressive work that exhibits a scintilla of creativity<sup>71</sup> should belong to its author in the same categorical way in which tangible assets belong to their owners. An asset owner should be able to fend off unauthorized users by means of self-help and by recourse to the legal system. She should also be able to set a price for allowing other people to acquire or use her asset. This regime is fair in that it protects the fruits of people's productive labor against encroachments and free-riding.<sup>72</sup> This regime is also efficient in that it gives people a selfish reason for developing and protecting assets that improve society's well-being.<sup>73</sup> Arguably, these well-known justifications of ownership extend to all assets that can be owned, rather than to tangible property alone.

---

<sup>70</sup> See Julie E. Cohen, *Creativity and Culture in Copyright Theory*, 40 U.C. Davis L. Rev. 1151, 1151 (2007) ("Creativity is universally agreed to be a good that copyright law should seek to promote.").

<sup>71</sup> See, e.g., *Luck's Music Library, Inc. v. Ashcroft*, 321 F. Supp. 2d 107, 118 (D.D.C. 2004), *aff'd sub nom. Luck's Music Library, Inc. v. Gonzales*, 407 F.3d 1262 (D.C. Cir. 2005) (describing originality as requiring independent creation and "just a scintilla of creativity").

<sup>72</sup> See Mark A. Lemley, *Property, Intellectual Property, and Free Riding*, 83 Tex. L. Rev. 1031, 1031-33 (2005) (discussing prevention of free-riding in intellectual property).

<sup>73</sup> See, e.g., Robert M. Hurt & Robert M. Schuchman, *The Economic Rationale of Copyright*, 56 Am. Econ. Rev. (Papers & Proc.) 421, 425 (1966) (explicating the prediction that "[t]he general welfare will . . . be enhanced by enacting copyright legislation which encourages the creation and publication of manuscripts that otherwise would not have come into existence").

Expressive works, regardless of how original they are, are among those assets.<sup>74</sup> If so, authors of those works should be able to enjoin others from unauthorized copying; at the very least, those who copy an owned work should pay its author a market-price fee or other equitable amount.<sup>75</sup>

We believe that this objection is overstated. An author who borrows from another's work to create an exceptionally creative work of her own does not appropriate the copied work in the traditional property sense. Far from imitating or reproducing this work, the author creates a novel and highly creative expressive work that integrates predominantly her original ideas. The closest property analogue of the author's action, therefore, is accession of assets,<sup>76</sup> as opposed to misappropriation of another's property. The accession in our context is special in that it does not destroy the copied work, as in the case of accession of tangible inputs. Nor does expressive accession necessarily dilute the income-generating opportunities of the copied work's owner. The owner can still sell his work or allow others to use it for a fee in exactly the same way in which he could do so before the accession. Furthermore, the linkage between the first work and the new creation increases the copied work's visibility and promotes its sales.

Highly creative works are likely to enhance the value of the pre-existing works from which they borrow. This fact distinguishes our case from cases in which an unauthorized user uses the owner's asset to create a new asset. When tangible assets are used in the process of creating new ones, the original assets are often destroyed or transformed, and, in any event, the owner stands to lose from the unauthorized use. Hence, the law seeks to reinstate the

---

<sup>74</sup> See Hughes, *supra* note 61, at 291. For a recent philosophical defense of this claim, see Jonathan Peterson, *Lockean Property and Literary Works*, 14 *Legal Theory* 257 (2008).

<sup>75</sup> See Gideon Parchomovsky & Peter Siegelman, *Towards an Integrated Theory of Intellectual Property*, 88 *Va. L. Rev.* 1455, 1467 (2002) ("By creating and enforcing exclusive rights in intellectual goods, copyrights . . . not only stifle unauthorized copying, but also enable authors and inventors to charge for the use of their works.").

<sup>76</sup> See Thomas W. Merrill & Henry E. Smith, *Property: Principles and Policies* 165–75 (2007) (stating and explaining the principle of accession in property law); Thomas W. Merrill, *Accession and Original Ownership* (May 2009) (unpublished manuscript, available at [http://papers.ssrn.com/sol3/papers.cfm?abstract\\_id=1400902](http://papers.ssrn.com/sol3/papers.cfm?abstract_id=1400902)) (providing a comprehensive analysis of accession principles and their economic and moral justifications).



aggrieved owner's wealth.<sup>77</sup> This is not the case in the context of intangible goods. When the subsequent work falls into the category of inequivalence, the original author suffers no real harm, and his plea for remediation is unfounded.<sup>78</sup>

It is noteworthy that patent law has long recognized an exception similar to the one we seek to introduce into copyright law.<sup>79</sup> Patent law's doctrine of reverse equivalents limits the protection granted to first-in-time patentees against genuine technological innovators whose inventions accomplish the same result described in a prior patent, but in a wholly different way.<sup>80</sup> As the Supreme Court explained:

[W]here a device is so far changed in principle from a patented article that it performs the same or a similar function in a substantially different way, but nevertheless falls within the literal words of the claim, the doctrine of equivalents may be used [in reverse] to restrict the claim and defeat the patentee's action for infringement.<sup>81</sup>

This doctrine of reverse equivalents in patent law is a conceptual twin of our inequivalence doctrine. Although there are important differences in the design and substance of the two doctrines,<sup>82</sup> both serve to bar liability in certain cases of literal infringement.

---

<sup>77</sup> Merrill & Smith, *supra* note 76, at 171; see also Henry E. Smith, *Intellectual Property as Property: Delineating Entitlements in Information*, 116 *Yale L.J.* 1742, 1766 (2007) ("The law of accession deals with situations in which one person mixes her labor or other inputs with someone else's property. Generally, innocent improvers can purchase the owner's interest in the improved property . . . , but if the owner's property is more valuable than the improvement, the improver can demand payment for the added value but cannot keep the improved property.").

<sup>78</sup> Professor Henry Smith, *supra* note 77, at 1766–73, was first to analogize the acquisition of intellectual property rights to the rules of accession. Under his theory, intellectual property rights remunerate innovators who produce value by mixing their intellectual labor and other inputs with the information situated in the public domain.

<sup>79</sup> See, e.g., Robert L. Harmon, *Patents and the Federal Circuit* 417 (8th ed. 2007).

<sup>80</sup> For discussions of the doctrine of reverse equivalents in modern patent law, see 5B Donald S. Chisum, *Chisum on Patents* § 18.04[4], at 18-827 to -51 (2007); Charles F. Pigott, Jr., *Equivalents in Reverse*, 48 *J. Pat. Off. Soc'y* 291 (1966).

<sup>81</sup> *Graver Tank & Mfg. Co. v. Linde Air Prods. Co.*, 339 U.S. 605, 608–09 (1950).

<sup>82</sup> See Jeanne C. Fromer, *Claiming Intellectual Property*, 76 *U. Chi. L. Rev.* 719, 731–49 (2009) (distinguishing between the peripheral protection of patents and the exemplar-focused protection of copyright).

*Suntrust Bank v. Houghton Mifflin Co.*<sup>83</sup> vividly illustrates how our inequivalents doctrine can be operationalized. This cause célèbre featured Alice Randall, a young African-American novelist, whose book *The Wind Done Gone*<sup>84</sup> retold the story of *Gone with the Wind*<sup>85</sup> from the vantage point of the black characters. Randall's goal was to offer a very different portrayal of the South than that offered in Margaret Mitchell's classic. To achieve this goal, Randall had to draw to some extent on Mitchell's book. And she did.<sup>86</sup> It was undisputed that Randall referred to *Gone with the Wind* in the foreword of her book;<sup>87</sup> she mentioned key characters from Mitchell's book, albeit by different names;<sup>88</sup> and she also borrowed from their central relationships and scenes.<sup>89</sup> It was also alleged that Randall copied some dialogue from *Gone with the Wind*.<sup>90</sup> This allegation was disputed by Randall.

The trustee of Mitchell's estate filed a copyright infringement suit against Randall and her publisher, seeking injunctive relief against both. The district court granted the plaintiff's motion for a preliminary injunction and enjoined Randall and her publisher from distributing, offering, or even displaying the new book.<sup>91</sup> The Eleventh Circuit vacated the judgment of the District Court<sup>92</sup> and remanded for a finding on whether Randall's book should be considered a parody of "Gone with the Wind."<sup>93</sup> Despite Randall's extensive copying from Mitchell's classic that normally amounts to an infringement of copyright, the court acknowledged that a fair use defense was available, and that, given its likelihood of success, the injunction should be vacated.<sup>94</sup>

We agree with the outcome of the case, but not with the court's reasoning. We contend that, as a normative matter, the case should have come under our doctrine of inequivalents. The court's catego-

---

<sup>83</sup> 268 F.3d 1257 (11th Cir. 2001).

<sup>84</sup> Alice Randall, *The Wind Done Gone* (2001).

<sup>85</sup> Margaret Mitchell, *Gone With the Wind* (Macmillan 1936).

<sup>86</sup> *Suntrust Bank*, 268 F.3d at 1259.

<sup>87</sup> *Id.*

<sup>88</sup> *Id.*

<sup>89</sup> *Id.*

<sup>90</sup> *Id.*

<sup>91</sup> *Id.* at 1259.

<sup>92</sup> *Id.* at 1277.

<sup>93</sup> *Id.*

<sup>94</sup> *Id.*

rization of Randall's book as a "parody" was deeply problematic.<sup>95</sup> This book is certainly not a parody in the conventional sense of the term.<sup>96</sup> Randall used Mitchell's romanticized portrayal of the white antebellum South as a background for her antithetical account of the black slaves' experience.<sup>97</sup> Therefore, the court's categorization of *The Wind Done Gone* as a parody may have done injustice to Randall's literary achievement and hurt its sales. Yet, under extant doctrine, the Eleventh Circuit did not have much of a choice.

We posit that our inequivalents doctrine provides a much more promising venue for dealing with such works as *The Wind Done Gone*. Under our framework, Randall's book would not have been infringing at all, and hence there would be no need for a strained fair use analysis to salvage the work. Even though Randall invariably had to borrow certain elements from Mitchell's book, her book is brimming with originality. Indeed, Randall's book possessed such a high level of originality as to immunize it from an infringement suit from Mitchell's estate. Randall's creative effort produced a book qualitatively different from *Gone with the Wind*. Randall did not attempt to imitate the classic. Instead, she attempted—successfully—to break new literary ground. The plaintiff's portrayal of Randall's book as an unauthorized sequel of *Gone with the Wind* therefore seems specious. The two books are inequiva-

---

<sup>95</sup> The court below thoroughly examined Randall's novel and concluded that its overall purpose was not to parody *Gone With the Wind*, but rather "to create a sequel to the older work and provide Ms. Randall's social commentary on the antebellum South. . . . [that] retells the earlier story in a condensed version from a different perspective. . . ." *Suntrust Bank v. Houghton Mifflin Co.*, 136 F.Supp. 2d 1357, 1378 (N.D. Ga. 2001).

<sup>96</sup> See, e.g., Merriam-Webster's Collegiate Dictionary 902 (11th ed. 2003) (defining "parody" as "a literary or musical work in which the style of an author or work is closely imitated for comic effect or in ridicule"); The Oxford Reference Dictionary 611 (Joyce M. Hawkins ed., 1986) (defining "parody" as "a humorous exaggerated imitation of an author, literary work, style, etc." and as "a grotesque imitation, a travesty").

<sup>97</sup> See Siva Vaidhyanathan, *The Anarchist in the Library: How the Clash Between Freedom and Control is Hacking the Real World and Crashing the System* 84 (2004) (explaining that "*The Wind Done Gone* is not a parody of *Gone with the Wind*. It is a revision, a retelling of the classic from a critical stance in a vernacular voice. It's also a supplement, another perspective in the parallax view of race and history that the United States desperately needs" and concluding that "[i]nstead of cheating by stretching the definition of parody . . . the appeals court should have considered the big questions: Does American copyright law protect works . . . in too many ways, and with too many ancillary powers for the general good?").

lents. There is no reasonable way to perceive them differently. Classifying Randall's book as a non-infringing inequivalent would have spared her the embarrassment of being labeled an infringer that escaped liability by proving a defense. Likewise, it would have saved Randall's publisher the need to market her highly creative novel as a parody.

Another case that fits under our inequivalents doctrine involves the "epic" legal battle between Superman and "The Greatest American Hero."<sup>98</sup> The owners of the copyright in Superman, the famous fictional hero of films and books, brought copyright infringement allegations against the developers and broadcasters of a television series featuring Ralph Hinkley as The Greatest American Hero.<sup>99</sup> Both characters had superhuman powers, which they used to defend the world against evil forces.<sup>100</sup> They also closely resembled each other in their appearance, actions, and phrases.<sup>101</sup> Hinkley's personality and mental makeup, however, profoundly differed from Superman's.<sup>102</sup> Superman was a fearless and proud hero, who "performs his superhuman feats with skill, verve, and dash . . . [as] the master of his own destiny."<sup>103</sup> Hinkley, in contrast, acted "like a timid, reluctant hero, who accepts his missions grudgingly[,] prefers to get on with his normal life, . . . is perplexed by the superhuman powers his costume confers and uses them in a bumbling, comical fashion."<sup>104</sup>

Based on these facts, the Second Circuit agreed with the trial court's finding that the two characters are not substantially similar to each other<sup>105</sup> and affirmed the dismissal of the plaintiffs' suit.<sup>106</sup> The court of appeals also mentioned "[t]he 'parody' branch of the 'fair use' doctrine" that serves as "a means of fostering the creativity protected by the copyright law"<sup>107</sup> and "balances the public interest in the free flow of ideas with the copyright holder's interest

---

<sup>98</sup> Warner Bros., Inc. v. Am. Broad. Cos., 720 F.2d 231 (2d Cir. 1983).

<sup>99</sup> Id. at 238.

<sup>100</sup> Id. at 236-37.

<sup>101</sup> Id. at 237.

<sup>102</sup> Id. at 243.

<sup>103</sup> Id.

<sup>104</sup> Id.

<sup>105</sup> Id. at 245.

<sup>106</sup> Id. at 235.

<sup>107</sup> Id. at 242.

in the exclusive use of his work.”<sup>108</sup> This reference, however, was merely parenthetical, since the court ultimately decided to align its decision with the trial judge’s findings and reasoning.<sup>109</sup>

We contend that our inequivalents doctrine justifies the outcome of the case more convincingly than the reasons chosen by the trial and appellate courts. The courts’ similarity analysis is deficient for a simple reason. Hinkley and Superman did not merely have similar superhuman powers, outfit, vocabulary, and achievements. Viewers’ understanding of the two faces of Hinkley crucially depended on their familiarity with Superman. Hinkley was designed as a hero-antihero whose personality sharply contrasted with the unbendingly heroic personality of Superman. To establish this contrast, Hinkley’s creators had to imitate Superman’s features as closely as possible, and they did so successfully. This imitation also does not fit the category of “parody” because *The Greatest American Hero* attempted to achieve more than that and, arguably, succeeded. The authors of this work created a new fictional character that broke new ground in the genre of heroic comics.<sup>110</sup> This character was categorically different from his “only hero” predecessors, and uniformly defeated Superman in one-sided copyright battles.<sup>111</sup> *The Greatest American Hero* was an exceptionally creative work that copyright law should encourage rather than block. This simple fact prompted the courts to find a doctrine that would keep *Hero* alive. Our normative analysis is not constrained by positive law. We therefore propose to give exceptionally creative works—the true inequivalents—an explicit exemption from liability for copying. Creators of these exceptional works benefit society strongly enough to deserve this exemption.

---

<sup>108</sup> Id.

<sup>109</sup> Id. at 243–45.

<sup>110</sup> *The Greatest American Hero* became a cult-TV classic after building a distinct fanbase around the world. See, e.g., Jill Kipnis, Home Video Studios Seek Titles With Niche Allure, *Billboard*, Apr. 2, 2005, at 31, available at <http://www.imdb.com/news/ni0751803/> (noting that “[r]ecent cult releases from Anchor Bay [Entertainment] include ‘The Greatest American Hero—Season One’”).

<sup>111</sup> See *American Broadcasting Cos.*, 720 F.2d. at 235.

### B. The Added-Value Doctrine

The second doctrine we propose may be termed the “added-value doctrine.” We designed it to identify the desirable scope of protection for authors of derivative works whose development involved copying from preexisting material and who do not qualify for the safe harbor of the inequivalence doctrine.<sup>112</sup> As a general matter, authors are entitled to copyright protection only in their original contributions; the protection does not extend to “the pre-existing material employed in the work.”<sup>113</sup> An author’s original contribution receives full copyright protection even when it is very modest.<sup>114</sup> All authors, from highly original to virtually unoriginal, have the power to enjoin others from copying their works and recover compensation for such copying.<sup>115</sup>

Apart from being costly to administer, these rules distort the creators’ incentive to compete with each other for the market segment that values high originality. Under our added-value doctrine, a copyright owner should only be able to *enjoin* works that are less original than her own. Her work’s property-rule protection will not exceed this limit. To secure injunctive relief against a putative infringer, the author will thus need to show that her work contains a higher degree of originality relative to prior works than the infringer’s work relative to hers. Authors of works as original as

---

<sup>112</sup> See 17 U.S.C. § 101 (2006) (defining “derivative work” as “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”); *Micro Star v. FormGen Inc.*, 154 F.3d 1107, 1110 (9th Cir. 1998) (attesting that the definition of “derivative work” in 17 U.S.C. § 101 is “hopelessly overbroad” because all works borrow something from prior art, and noting that only substantial incorporation of preexisting materials will make a work “derivative” (citing *Litchfield v. Spielberg*, 736 F.2d 1352, 1357 (9th Cir. 1984))); *Gates Rubber Co. v. Bando Chem. Indus.*, 9 F.3d 823, 839 (10th Cir. 1993) (explaining that a court decision on whether an incorporation of preexisting material was substantial enough to make the work derivative requires “a qualitative rather than a purely quantitative analysis” (citing *Whelan Assocs., v. Jaslow Dental Lab., Inc.*, 797 F.2d 1222, 1245 (3d Cir. 1986))).

<sup>113</sup> 17 U.S.C. § 103(b) (2006); see also *CMM Cable Rep. Inc. v. Ocean Coast Props., Inc.*, 97 F.3d 1504, 1515 (1st Cir. 1996) (observing that when an infringement allegation comprises a complaint about an “expression that is not proprietary to plaintiff, then an essential ingredient is lacking from plaintiff’s *prima facie* case”).

<sup>114</sup> See supra notes 11–13 and accompanying text.

<sup>115</sup> *Id.*

those they copy from, and—a fortiori—authors whose works are more original than those they copy from, will not be enjoined by copyright law. Instead, the author whose work was copied will receive liability-rule protection and collect compensation measured by the market value of the lifted expression.<sup>116</sup> The goal of our design is to ensure, on the one hand, that authors receive compensation commensurate with the market value of their original contributions, and, on the other hand, that works containing greater originality and creativity than the plaintiff's protected work are not expelled from the market.

Under this design, the defendant will carry the burden of proving her work's equal or higher originality. The plaintiff will then have to prove to the court the market value of the defendant's use of his work. Both burdens will be satisfied by a preponderance of the evidence. Courts will apply these rules by relying on expert testimony and by making their own comparisons between works. This task will be easier to perform than the controversial dissection analysis<sup>117</sup> by which courts presently determine the copyright protection of works that combine both original and unoriginal elements.<sup>118</sup>

The added-value doctrine will promote creativity in two ways. First, it will stimulate competition for originality among all authors. Second, and equally important, the doctrine will afford greater freedom to more creative authors of derivative works and lesser freedom to authors whose derivative works are only modestly original. The combined effect of those incentives and protections is an environment that induces authors to optimize their creative ef-

---

<sup>116</sup> In determining the appropriate compensation amounts, courts can rely on expert witnesses and market data.

<sup>117</sup> See 4 Nimmer on Copyright, § 13.03[A] at 1-34 (2008) (discussing difficulties of the dissection analysis and other methods courts use in determining works' similarity); see also Sarah Brashears-Macatee, Total Concept and Feel or Dissection?: Approaches to the Misappropriation Test of Substantial Similarity, 68 Chi.-Kent L. Rev. 913 (1993) (discussing courts' applications of the dissection analysis).

<sup>118</sup> For authoritative formulation and application of the dissection analysis, see *Apple Computer, Inc. v. Microsoft Corp.*, 35 F.3d 1435, 1442-47 (9th Cir. 1994). For other cases in which courts relied on the dissection method, see *Concrete Mach. Co. v. Classic Lawn Ornaments, Inc.*, 843 F.2d 600, 608-10 (1st Cir. 1988); *Mattel, Inc. v. Azrak-Hamway Int'l, Inc.*, 724 F.2d 357, 360 (2d Cir. 1983); *Eden Toys, Inc. v. Marshall Field & Co.*, 675 F.2d 498, 500 (2d Cir. 1982); *Conan Properties, Inc. v. Mattel, Inc.*, 712 F. Supp. 353, 358-59 (S.D.N.Y. 1989); *Farmers Independent Telephone Co. v. Thorman*, 648 F. Supp. 457, 460-61 (W.D. Wis. 1986).

forts—an incentive that will likely increase the development of original and creative works.

The doctrine's allocation of the burden of proof conforms to the general principles of evidence law.<sup>119</sup> These principles require a plaintiff to establish his cause of action by a preponderance of the evidence, while placing a similar burden on the defendant who relies on an affirmative defense.<sup>120</sup> Our inequivalents doctrine places a heavier burden on the alleged infringer: she can establish her work's exceptional creativity and inequivalence only by clear and convincing evidence.<sup>121</sup> As we explained, this proof burden will separate works that are unequivocally exceptional in their originality from those that are not.<sup>122</sup> Because authors of such exceptional works will get a full exemption from copyright liability, court decisions that erroneously grant this exemption to an author will cause serious harm: annihilation of a well-earned copyright to the benefit of an opportunistic free-rider and the ex ante distortion of the incentive to create original works. The law consequently needs to impose on alleged infringers a stringent proof requirement that will minimize the incidence of those erroneous deprivations. The added-value doctrine need not incorporate such a requirement because it does not give defendants a complete exemption from copyright liability. Under this doctrine, a defendant who copies another's work to create an equally or more original work of her own will not go scot-free. Any such defendant will have to pay the copied work's owner a market-priced fee.

We illustrate our added-value doctrine through the case of *Bateman v. Mnemonics, Inc.*,<sup>123</sup> which involved a technologically complex and fundamentally important dispute. There, the court was asked to address compatibility-driven copying of computer software as an issue of first impression.<sup>124</sup> A company operating parking garages needed computer software for its operations. It retained two engineers, who worked on the software development as independent contractors. The engineers failed to develop a pro-

---

<sup>119</sup> Stein, *supra* note 62, at 219–25.

<sup>120</sup> *Id.*

<sup>121</sup> See *supra* Section III.A.

<sup>122</sup> *Id.*

<sup>123</sup> 79 F.3d 1532 (11th Cir. 1996).

<sup>124</sup> *Id.* at 1536–37.



gram with which the company felt comfortable, and the parties dissolved their engagement.<sup>125</sup> The company subsequently used parts of the engineers' copyrighted software to develop a program with which it could work.<sup>126</sup> The engineers sued the company, claiming that this use infringed their copyright.<sup>127</sup> The company's defense relied on the "compatibility exception"—a proposition that copying from another's software does not violate copyright to the extent it was dictated by interface-compatibility requirements.<sup>128</sup>

This proposition holds that certain components of a computer program—namely, the interface components—set up communication between the hardware, the operating system, and specific-application programs. To secure unimpeded communication throughout the system, these components must be mutually compatible.<sup>129</sup> Ideally, they must also be standard in order to minimize learning costs for computer users.<sup>130</sup> Making compatibility-driven copying actionable in copyright would give interface developers a colossal monopolistic power, while depriving the users—and society at large—of crucial network benefits.<sup>131</sup> Based on this theory, the company argued that its use of the engineers' software was compatibility-driven and did not exceed the dictates of compatibility.<sup>132</sup> Furthermore, it urged the court to filter out portions of the engineers' software that were dictated by the interface with its garage-management program.<sup>133</sup> The company requested the trial judge to instruct the jury about the compatibility exception, but the judge denied that request.<sup>134</sup> Subsequently, the jury decided the case in the engineers' favor, and the company appealed.<sup>135</sup>

The appellate court granted the company's appeal without fitting its decision into a specific doctrinal niche. It held that, although in-

---

<sup>125</sup> Id. at 1538–39.

<sup>126</sup> Id. at 1539–40.

<sup>127</sup> Id. at 1540.

<sup>128</sup> Id. at 1546.

<sup>129</sup> See Timothy S. Teter, Note, *Merger and the Machines: An Analysis of the Pro-Compatibility Trend in Computer Software Copyright Cases*, 45 *Stan. L. Rev.* 1061, 1063–65 (1993).

<sup>130</sup> Id. at 1065.

<sup>131</sup> Id. at 1067.

<sup>132</sup> *Bateman*, 79 F.3d at 1537, 1546.

<sup>133</sup> Id. at 1540.

<sup>134</sup> Id.

<sup>135</sup> Id. at 1536.

interface specifications are copyrightable in principle, compatibility demands “may work to deny copyright protection to certain portions of a computer program.”<sup>136</sup> As far as doctrine is concerned, the court ruled that “[w]hether the protection is unavailable because these factors render the expression unoriginal, nonexpressive per [Section 102(b) of the Copyright Act], or whether these factors compel a finding of fair use, copyright estoppel, or misuse, the result is to deny copyright protection to portions of the computer program.”<sup>137</sup>

This decision obviously fails to deliver a criterion by which to distinguish between interface specifications that are copyrightable and those that are not. Among the academic formulations of the required criterion, two stand out as attractive.<sup>138</sup> Both formulations rely on the idea/expression merger doctrine.<sup>139</sup> The two formulations, however, set different conditions for removing the copyright protection from interface software and for allowing compatibility-driven copying of interface specifications. Under one of those formulations, interface specifications necessary for achieving compatibility should be categorized as unprotected “ideas,” as opposed to protected “expressions.”<sup>140</sup> Under another, more restrictive formulation, an interface element would be classified as an “idea” after actually attaining a *de facto* industry standard status.<sup>141</sup> Each of those proposals acknowledges its dependency on a legal doctrine

---

<sup>136</sup> *Id.* at 1547.

<sup>137</sup> *Id.*

<sup>138</sup> See Teter, *supra* note 129, at 1067–68 (“Two frequently raised innovation arguments militate against allowing copying to achieve compatibility, but both are inconclusive at best. The ‘incentive’ innovation argument maintains that if interface software can be copied to the extent necessary to achieve compatibility, developers will not bother to create new interfaces . . . . The second innovation concern, the ‘QWERTY argument,’ notes that due to the user’s costs of abandoning an old standard, standardization both constrains design and stifles innovation.”); see also Peter S. Menell, Tailoring Legal Protection for Computer Software, 39 *Stan. L. Rev.* 1329, 1340–41 (1987) (balancing costs and benefits in designing legal protection for intellectual work).

<sup>139</sup> See Teter, *supra* note 129, at 1072 (relating compatibility and the merger doctrine).

<sup>140</sup> *Id.*

<sup>141</sup> See Peter S. Menell, An Analysis of the Scope of Copyright Protection for Application Programs, 41 *Stan. L. Rev.* 1045, 1101 (1989).

that is notoriously difficult to apply, but claims to be an optimal solution of a difficult problem.<sup>142</sup>

The added-value doctrine resolves this problem in a simple and intuitive fashion without invoking the fuzzy distinction between "ideas" and "expressions." The doctrine will require the court to determine whether the allegedly infringing computer program is original. If it is, the programmer's copying of interface specifications from another program will be permitted, subject to compensation. The defendant's creative endeavor will not be suppressed by the interface developer, but she would have to pay the plaintiff the market price of the copied interface software. If this software is not generally accessible, the developer would be entitled to compensation that the court would determine with the help of experts. In cases in which the copied part is publicly available code, either because it is a non-protected standard or open-source code, the compensation amount will be zero. This straightforward liability-rule solution would allow developers of computer programs to internalize the benefits they produce without blocking each others' innovative efforts.<sup>143</sup>

Our second illustration of the added-value doctrine is *Acuff-Rose v. Jostens*.<sup>144</sup> This case featured a plaintiff whose work was not original enough to receive full copyright protection that includes injunctive relief, but was sufficiently creative to qualify for the liability-rule protection under our added-value doctrine. The court, however, dismissed the plaintiff's entire suit. As we will now explain, this outcome resulted from the court's interpretation of existing copyright doctrines that divert courts' attention from the straightforward added-value analysis.

---

<sup>142</sup> See *id.* at 1103; Teter, *supra* note 129, at 1066-72.

<sup>143</sup> Note that our proposal does not chill creative inventors of path-breaking interface programs. Any such program can be patented. The *Bateman* court acknowledged it by observing that "[i]t is particularly important to exclude methods of operation and processes from the scope of copyright in computer programs because much of the contents of computer programs is patentable. Were we to permit an author to claim copyright protection for those elements of the work that should be the province of patent law, we would be undermining the competitive principles that are fundamental to the patent system." *Bateman*, 79 F.3d at 1541 n.21; see also Menell, *supra* note 141, at 1103; cf. Miller, *supra* note 9 (proposing to model copyright protection on a standard akin to the non-obviousness requirement of patent law).

<sup>144</sup> 155 F.3d 140 (2d Cir. 1998).

The defendant promoted sales of class rings by using the slogan “U Got 2 Stand 4 Something.”<sup>145</sup> This slogan portrayed the ring as a symbol of its wearer’s social identity and affiliation to his or her school.<sup>146</sup> The slogan was identical to the name of Aaron Tippin’s famous cowboy lyric “You’ve Got to Stand for Something” that repeatedly uses the expression, “You’ve got to stand for something or you’ll fall for anything.”<sup>147</sup> The song’s copyright owner sued the defendant for copyright infringement. The defendant denied wrongdoing, claiming that the phrase “You’ve got to stand for something” is an unprotected cliché that belongs to the public domain.<sup>148</sup> As an alternative, the defendant raised the “fair use” defense.<sup>149</sup>

The defendant’s denial of copying was untrustworthy. The creation and approval of its advertising campaign coincided with the song’s peaking popularity.<sup>150</sup> The campaign’s advertisement almost expressly acknowledged copying from the song by stating that “The *song* says it best: If you don’t stand for something, you’ll fall for anything.”<sup>151</sup> The identity between the defendant’s campaign slogan and Tippin’s famous line therefore could not be accidental. Unsurprisingly, the court determined that the defendant copied the slogan from the song.<sup>152</sup> This determination, however, did not avail the plaintiff because the court accepted the defendant’s second claim and held that the contested phrase is, indeed, a cliché.<sup>153</sup> This holding relied on numerous documented uses of the phrase “If you

---

<sup>145</sup> *Acuff-Rose Music v. Jostens Inc.*, 988 F. Supp. 289, 291 (S.D.N.Y. 1997).

<sup>146</sup> The defendant’s sales brochures, fliers, and posters read:

The song says it best: If you don’t stand for something, you’ll fall for anything. And one of the best ways to show you stand for something is by wearing a Jostens Class Ring. The ring stands for your school. It stands for the people you know. It stands for the greatest class of all time (yours, of course). And it stands for the things you do to make your class the greatest. Most of all, it stands for you. The gold, the stone, the inscriptions, they add up to nothing less than a small piece of your personal history. The ring stands for who you are—and that’s something worth standing for.

*Id.*

<sup>147</sup> *Acuff-Rose*, 155 F.3d at 141.

<sup>148</sup> *Acuff-Rose*, 988 F. Supp. at 290.

<sup>149</sup> *Id.*

<sup>150</sup> *Id.* at 293.

<sup>151</sup> *Id.* at 291 (emphasis added).

<sup>152</sup> *Id.* at 293.

<sup>153</sup> *Id.* at 295.

don't stand for something, you will fall for anything" in sermons, political speeches, and newspaper articles that bore no connection to Tippin's song.<sup>154</sup>

We believe that this decision is flawed. The decision failed to address the significance of the defendant's copying from Tippin's song. The defendant's campaign used the phrase "You've got to stand for something or you'll fall for anything" *as appearing in that song*. The defendant did not use this phrase as a cliché, nor did it refer to similar phrases that appeared in sermons, political speeches, or elsewhere in the public domain. Most crucially, the defendant's advertisement of the ring alluded specifically to *the song's line* "You've got to stand for something or you'll fall for anything."<sup>155</sup> The defendant designated *this line* to be the focus of its prospective buyers' attention. This designation constituted an almost explicit acknowledgment of the song's creativity and prominence. The defendant therefore could not even deny that the song's line exhibited a "scintilla"<sup>156</sup> or "modicum"<sup>157</sup> of creativity—the originality level that the law deems sufficient for establishing copyright protection.<sup>158</sup> Nor could the defendant deny the fact that it traded on the public approbation of Tippin's efforts.<sup>159</sup>

The court's ruling against the plaintiff also relied on the fact that Tippin's lyric represented "a moral lesson in the form of a father's advice to his son to live a principled life,"<sup>160</sup> while the defendant's campaign extolled the virtue of wearing the advertised ring as a symbol of social status and achievement.<sup>161</sup> Based on this fact, the court concluded that "the 'total concept and feel' of the two works differ dramatically."<sup>162</sup> This inference, however, resulted from the

---

<sup>154</sup> *Id.*

<sup>155</sup> *Id.* at 291.

<sup>156</sup> *Luck's Music Library, Inc. v. Ashcroft*, 321 F. Supp. 2d 107, 118 (D.D.C. 2004).

<sup>157</sup> *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345–46 (1991); see also 1 *Nimmer*, *supra* note 117, § 2.01[A] & [B].

<sup>158</sup> 1 *Nimmer*, *supra* note 117, § 2.01[A] & [B].

<sup>159</sup> See *Arnstein v. Porter*, 154 F.2d 464, 473 (2nd Cir. 1946) (Frank, J.) (rationalizing a musician's copyright entitlement as protecting "his interest in the potential financial returns from his compositions which derive from the lay public's approbation of his efforts").

<sup>160</sup> *Acuff-Rose*, 988 F. Supp. at 296.

<sup>161</sup> *Id.*

<sup>162</sup> *Id.* (quoting *Kretschmer v. Warner Bros.*, 1994 WL 259814, at \*9 (S.D.N.Y. June 8, 1994)).

court's failure to consider the works' common theme: approbation of people who "belong to something" by virtue of having ironclad commitments and affiliations.

The defendant undoubtedly expanded the meaning of Tippin's phrase in an original way. This expansion, however, was not exceptionally creative and thus did not turn the defendant's use of the phrase into an inequivalent. Notice that the defendant's campaign did not contribute to the popularity of Tippin's song. On the contrary, it attempted to profit from the song's popularity. Our theory therefore calls for the application of the added-value doctrine. This doctrine would have afforded the song's owner a liability-rule protection, forcing the defendant to compensate the owner for the unauthorized use of the song. As for the compensation amount, courts should be able to determine it by relying on experts and common sense. Courts will not make such determinations easily. This difficulty, however, is not insurmountable and it hardly provides a good reason for turning copyrighted works into a fair game for opportunists.

The added-value doctrine has a socially desirable implication for cases involving plaintiffs whose works' originality is only slight. We exemplify this implication by a battle of T-shirts found in *Matthews v. Freedman*.<sup>163</sup> A souvenir children's T-shirt that the plaintiff designed and marketed featured a slogan, "Someone Went to Boston and got me this shirt because they love me Very much." This slogan was surrounded by small drawings of a fish, a sailboat, a lobster, Faneuil Hall, and scattered hearts. A souvenir children's T-shirt designed and marketed by the defendant told the world "Someone Who Loves Me Went to Boston and Got Me this Shirt." This slogan was surrounded by small drawings of a fish, a sailboat, a lobster, a swan boat, ducklings, and a smiling sun. The two designers confronted each other at the Boston Gift Show and subsequently in court.<sup>164</sup>

Both the trial court and the First Circuit found no infringement of copyright in the defendant's T-shirt.<sup>165</sup> The two T-shirts were strikingly similar to each other. The defendant, in all likelihood,

---

<sup>163</sup> 157 F.3d 25 (1st Cir. 1998).

<sup>164</sup> Id. at 26.

<sup>165</sup> Id. at 27-28.

copied the plaintiff's T-shirt design. Both T-shirts, however, exhibited a trivial compilation of ideas, expressions, and images easily extractable from the public domain.<sup>166</sup> Because of this lack of originality, the courts held that the plaintiff's T-shirt deserves only weak protection against complete literal copying.<sup>167</sup> The defendant's T-shirt was not completely identical to the plaintiff's. The defendant consequently won the suit.<sup>168</sup>

The courts' decision to scale the plaintiff's protection down and unlock the added value of the competitor's product perfectly aligns with our proposal. Our added-value doctrine would yield exactly the same result. Given the plaintiff's almost invisible addition to prior art, any difference between her and the defendant's T-shirt design would allow the defendant to win the originality contest or, alternatively, establish that his design of the T-shirt was as original as hers. As far as compensation is concerned, the plaintiff's eligibility for that remedy will depend on the market value of the expression that the defendant borrowed from her work. The plaintiff would obviously fail to prove that her addition to phrases and images extractable for free from the public domain had any value on the market. Adjudicators applying the added-value doctrine would consequently have to dismiss her suit.<sup>169</sup>

### C. THE SAMENESS RULE

Our third doctrinal proposal, the "sameness rule," is different from the first two doctrines we advanced. It is designed to penalize *copiers and imitators* whose works are plainly *unoriginal*. It also bears emphasis that our sameness rule resembles the copyright infringement analysis adopted by the Seventh Circuit, although we believe that our design improves upon that circuit's approach. The primary purpose of this rule is to deter creators from copying prior works and incentivize them to ensure that their works contain at least some originality. The rule's secondary purpose is to

---

<sup>166</sup> *Id.*

<sup>167</sup> *Id.*

<sup>168</sup> *Id.*

<sup>169</sup> The outcome of that suit would be different if the plaintiff could establish literal copying of her design by the defendant. The court would then enjoin the defendant. The plaintiff, however, would still have difficulties in proving her compensable damage.

strengthen the copyright protection of original creators, whose works—after becoming successful—entice copying and imitation. An author who copies a prior work of another person does not merely fail the test for originality. By and large, he also acknowledges that the copied work is original and valuable.

The sameness rule achieves its desiderata by setting up a strong presumption of copyright infringement in cases featuring striking similarity between the plaintiff's and the defendant's works. To benefit from this rule, the plaintiff will have to establish that her and the defendant's works are identical, or at least strikingly similar to each other, and bear no similarity to a work or object in the public domain. The plaintiff will also have to prove that she created her work before the defendant created hers. Based on these facts, the court will deem the plaintiff's work original and deserving of protection against reproduction and imitation by others. The defendant will then be able to rebut this presumption by adducing clear and convincing evidence that the plaintiff's work itself is ineligible for copyright protection or that she created her own work independently. If the defendant fails to establish one of those defenses, the court would hold her responsible for infringing the plaintiff's copyright. The clear and convincing evidence requirement will thus solidify the protection of authors of original works and deter free-riders.

The inequivalents doctrine and the sameness rule both aim at calibrating a defendant's liability to the degree of originality in her work. Yet, the two doctrines operate at the opposite extremes of the originality spectrum. The inequivalents doctrine operates at the high end of the originality spectrum, where it attempts to grant immunity to defendants whose works contain significant originality. The sameness rule, by contrast, operates at the low end of the originality spectrum, where it increases the potential liability of defendants whose works possess little to no originality.

The sameness rule thus induces originality by incentivizing the production of novel works that substantially differ from those that already exist. Creation of a highly original work will guarantee its author not only the highest degree of protection but also complete immunity against suit. Authors who wish to take advantage of the inequivalents doctrine may need to research preexisting expressive works and distinguish their works from them. The breadth of that



research will depend on its cost and the author's expected benefit from the contemplated work. Creators of works that have high expected value consequently will have a strong incentive to intensify the preemption search. The search, admittedly, can never be perfect in light of the number of expressive works that already exist. Nevertheless, it can help authors in distinguishing their works from preexisting expressions.

As we already mentioned, our sameness rule aims to preserve the independent creation defense recognized by extant copyright law, and it is designed to do so. That said, we need to post a caveat here. In the real world, there is a risk that courts will tend to infer infringement whenever there is striking similarity between two works. Based on an experience-driven presumption against coincidences, courts may decide that such a high level of similarity is never accidental, and if so, they might sometimes trample upon the independent creation defense by erroneously identifying as infringement some cases of independent creation. We are also cognizant of the fact that the clear and convincing evidence requirement that we impose on defendants will exacerbate this risk. This allocation of the risk of error will achieve the following effect: relative to the general rule that imposes the burden of proof on the plaintiff, the incidence of false negatives (decisions erroneously denying the claim of independent creation) will increase, while the incidence of false positives (decisions erroneously granting the claim) will decrease.<sup>170</sup> Hence, the sameness rule enhances the protection of highly original authors at the price of exposing independent creators of works that are similar to preexisting works to an increased risk of copyright liability.<sup>171</sup> From an *ex post* perspective, this tradeoff is far from obvious. Yet, the proper way to examine its effects is to evaluate the *ex ante* incentives for independent creators. Those creators would have to preserve evidence demon-

---

<sup>170</sup> Tradeoff between false positives and false negatives is what evidentiary rules generally do: see Stein, *supra* note 62, at 133–40. Formulation of evidentiary rules therefore should always reflect societal preferences in the allocation of the risk of error that vary from one category of cases to another. *Id.* at 118–33.

<sup>171</sup> It should be emphasized that the increase in risk is very small because even under current doctrines independent creation is very difficult to establish and defendants whose works are identical or strikingly similar to those of the plaintiffs fare very poorly in court. So, in practice, our amendment will worsen the lot of independent creators only marginally.

strating that they created their works independently. Because preserving such self-regarding evidence is easy, creators that are truly independent would virtually always be able to prove their defense. These creators would easily separate their true claims from the false defenses of independent creation.

The Seventh Circuit case of *Ty v. GMA Accessories*<sup>172</sup> illustrates how the sameness rule will penalize unoriginal creators. This case was resolved by Chief Judge Posner's decision that affirmed a preliminary injunction enjoining the defendant from selling a toy similar to a bean-bag pig copyrighted and marketed by the plaintiff.<sup>173</sup> Chief Judge Posner began his analysis of the case by observing that the two pigs are "nearly identical."<sup>174</sup> Identity, of course, does not entail copying that the law proscribes: "if independent creation results in an identical work, the creator of that work is free to sell it."<sup>175</sup> Showing a striking similarity between the two works, however, can establish copying—and it can do so, according to Chief Judge Posner, even in the absence of an independent demonstration that the defendant had access to the plaintiff's work.<sup>176</sup> This showing, however, must be accompanied by evidence proving the protected work's uniqueness. Specifically, the plaintiff must prove that he did not copy an object or a work that exists in the public domain from which the defendant could copy as well. As Chief Judge Posner explained, similarity between works replicating the same thing in the public domain "may be striking without being suspicious."<sup>177</sup>

---

<sup>172</sup> 132 F.3d 1167 (7th Cir. 1997).

<sup>173</sup> Id. at 1169, 1173.

<sup>174</sup> Id. at 1169.

<sup>175</sup> Id. (citing *Grubb v. KMS Patriots, L.P.*, 88 F.3d 1, 3 (1st Cir. 1996)); *Selle v. Gibb*, 741 F.2d 896, 901 (7th Cir. 1984). The court also explained the rule's practical rationale:

[T]he creator of an expressive work—an author or sculptor or composer—cannot canvass the entire universe of copyrighted works to discover whether his poem or song or, as in this case, "soft sculpture" is identical to some work in which copyright subsists, especially since unpublished, unregistered works are copyrightable.

Id.

<sup>176</sup> As the court explains, "[the defendant] must produce evidence of access, all right—but, as we have just said . . . a similarity that is so close as to be highly unlikely to have been an accident of independent creation is evidence of access." Id. at 1170.

<sup>177</sup> Id. The court illustrates this proposition by "two people photographing Niagara Falls from the same place at the same time of the day and year and in identical weath-

Once the plaintiff proves that the defendant's work is similar to his but not to anything else in the public domain, the burden of proof shifts to the defendant.<sup>178</sup> The defendant must prove by a preponderance of the evidence that she created her work independently rather than copied the plaintiff's work.<sup>179</sup> Chief Judge Posner held in this regard that the defendant's evidence of independent creation ought to be more detailed and, consequently, more persuasive than a generic claim that the work was independently created.<sup>180</sup> This evidence must explain away the suspicion arising from the similarity between the defendant's design and the plaintiff's work.<sup>181</sup> The defendant's explanation also needs to specify the choices she made with regard to her design's individual features.<sup>182</sup>

The defendant in *Ty* failed to provide such evidence and consequently was unable to defeat the plaintiff's request for a preliminary injunction.<sup>183</sup> The outcome in this case was due to the *complete* originality of the plaintiff's toy and the *complete* unoriginality of the defendant's product. As Chief Judge Posner explained, the plaintiff's bean-bag pig had a fictional appearance that was original and unique.<sup>184</sup> This appearance starkly differed from that of natural and lifelike toy pigs.<sup>185</sup> The unique appearance of the plaintiff's toy

---

er." *Id.*; see also *First Am. Artificial Flowers, Inc. v. Joseph Markovits, Inc.*, 342 F. Supp. 178, 186 (S.D.N.Y. 1972) ("[A] copyright on a work which bears practically a photographic likeness to the natural article, as here, is likely to prove a relatively weak copyright.").

<sup>178</sup> *Ty*, 132 F.3d at 1171.

<sup>179</sup> *Id.* (holding that "[a]ccess (and copying) may be inferred when two works are so similar to each other and not to anything in the public domain that it is likely that the creator of the second work copied the first, but the inference can be rebutted by disproving access or otherwise showing independent creation").

<sup>180</sup> *Id.* at 1171-72.

<sup>181</sup> *Id.*

<sup>182</sup> In Chief Judge Posner's words:

Silence can be pregnant; the absence of any evidence of how the [defendant's] designer's drawing was translated into the Squealer-resembling production model, combined with the similarity of that model to Squealer (and to nothing in the public domain) . . . overbore the weak evidence of the [designer's] affidavit.

*Id.*

<sup>183</sup> *Id.* at 1173.

<sup>184</sup> *Id.* at 1170.

<sup>185</sup> As Chief Judge Posner put it, "[r]eal pigs are not the only pigs in the public domain. But GMA has not pointed to any fictional pig in the public domain that Preston resembles." *Id.*

pig was a major contributor to its commercial success. The defendant made an opportunistic attempt at sharing this success by developing a similarly looking toy.

Under our sameness rule, the plaintiff in *Ty* would receive the highest degree of copyright protection for her original work. The plaintiff would be entitled to enjoin the unoriginal defendant from replicating her toy (and making profits from that replication). The rule's application would thus make copyright protection coextensive with the originality of the works in question. Chief Judge Posner's decision in *Ty* squarely aligns with the sameness rule and promotes its goals.<sup>186</sup>

Application of the sameness rule will not always produce the same results as extant doctrine. We illustrate this point with another Seventh Circuit opinion, *Selle v. Gibb*.<sup>187</sup> This case featured a complaint by Ronald Selle, a composer, that the Bee Gees' hit tune "How Deep Is Your Love" had infringed the copyright of his song "Let It End."<sup>188</sup> After trial, the jury decided that the alleged infringement took place, but the judge granted Bee Gees' motion for judgment notwithstanding the verdict.<sup>189</sup> Selle appealed.

The court affirmed the trial judge's decision and ended the litigation that threatened the famous creators and performers of pop music with embarrassment and financial losses.<sup>190</sup> The court's dismissal of Selle's appeal was based on the appraisal of the tunes'

---

<sup>186</sup> A more recent decision of the Seventh Circuit, *JCW Invs., Inc. v. Novelty, Inc.*, 482 F.3d 910 (7th Cir. 2007), is equally illustrative. This case featured an infringement suit by one plush doll manufacturer against another that replicated its doll. The plaintiff's doll, although peculiar, was highly original and created a niche market for itself. *Id.* at 912–13. Aware of the success of the plaintiff's product, the defendant sought to compete with it by offering a similarly designed doll that replicated the total look and feel of the plaintiff's doll. *Id.* The plaintiff sued the defendant for copyright infringement and obtained a summary judgment. The defendant appealed. *Id.* The Seventh Circuit affirmed the lower court's decision. It acknowledged that the plaintiff's doll evoked social stereotypes and humor that exist in the public domain, but held that the doll's unique combination of features singles it out as an original expression of these phenomena that deserves copyright protection. *Id.* at 916. Most importantly, the Circuit used the originality of the plaintiff's doll as a proxy for its determination that the defendant copied it. This ruling implicitly acknowledges that a work's originality correlates with the level of copyright protection it will receive.

<sup>187</sup> 741 F.2d 896 (7th Cir. 1984).

<sup>188</sup> *Id.* at 898.

<sup>189</sup> *Id.*

<sup>190</sup> *Id.*

similarity.<sup>191</sup> The court decided that this similarity was not striking enough. This decision overrode the opinion of the only expert who testified about the tunes' similarity. This expert was a renowned professor of music from the Northwestern University, whose testimony unequivocally supported Selle's complaint of copyright infringement.<sup>192</sup> The expert compared the two songs' musical notes and found that "the first eight bars of each song . . . have twenty-four of thirty-four notes in plaintiff's composition and twenty-four of forty notes in defendants' composition which are identical in pitch and symmetrical position" and that "[o]f thirty-five rhythmic impulses in plaintiff's composition and forty in defendants', thirty are identical."<sup>193</sup> The expert also pointed to striking similarities between the notes and rhythmic impulses in the last four bars of the songs.<sup>194</sup> Based on these similarities, the expert opined that the songs could not have been composed independently of one another and that he had never encountered two songs by different composers that are so similar to each other.<sup>195</sup>

Bee Gees did not call expert witnesses. Instead, its singer, songwriter and producer, Barry Gibb, testified that "How Deep Is Your Love" was the group's independent creation.<sup>196</sup> The group's manager and two musicians corroborated this testimony.<sup>197</sup> The work tape of "How Deep Is Your Love" indicated that its singers, the Gibb brothers, hummed and sang the tune to a keyboard player, who subsequently played it on his keyboard.<sup>198</sup> Bee Gees' witnesses authenticated this tape as a contemporaneous record of the song's creation.<sup>199</sup>

Two facts were not in controversy. Selle's song "Let It End" was created and copyrighted before the creation of "How Deep Is Your Love."<sup>200</sup> The public dissemination of "Let It End" was minimal. Selle and his band played the song two or three times in the

---

<sup>191</sup> *Id.* at 901-06.

<sup>192</sup> *Id.* at 899.

<sup>193</sup> *Id.*

<sup>194</sup> *Id.*

<sup>195</sup> *Id.*

<sup>196</sup> *Id.*

<sup>197</sup> *Id.*

<sup>198</sup> *Id.*

<sup>199</sup> *Id.*

<sup>200</sup> *Id.* at 898.

Chicago area. Selle also sent the song to eleven music recording and publishing companies. These companies showed no interest in the song.<sup>201</sup>

The court based its decision to dismiss the appeal on a theory that attributed a miscalculation to Selle's expert. According to that theory, the expert underestimated the probability of the tunes' accidental sameness. This probability is much higher than estimated by the expert because the genre of pop music is simplistic by design. All pop songs are relatively short and build on repeated patterns that are mostly not unique.<sup>202</sup> Two independently composed melodies therefore may contain many accidental similarities. Alternatively, similar melodies may originate from a common source.<sup>203</sup> This genre-specific reality erodes the significance of "striking similarity" evidence. Factfinders cannot deduce from this evidence that the defendant had access to the plaintiff's melody and copied it.<sup>204</sup> The plaintiff consequently needs to adduce independent evidence of access.<sup>205</sup> Selle's failure to adduce such evidence doomed his suit to dismissal without a new trial.<sup>206</sup>

We believe that this ruling was unjustified. We are puzzled by the court's attribution of musical minimalism and homogeneity to the entire pop genre. Any musical genre accommodates compositions that occupy different positions on the originality spectrum. Some compositions score high on that spectrum, and some score low. The Bee Gees' song "How Deep Is Your Love" scored low because its melody was similar to "Let It End." Selle testified that "Let It End" was his original creation and Bee Gees did not dispute it. Nor did the group advance a "prior common source" claim. Instead, it argued that "How Deep Is Your Love" is its independent creation. Because Selle's song preceded that creation, its score on the originality spectrum was superior. Under the sameness rule, therefore, the case would go to trial. The Bee Gees would then have to prove their independent creation claim by clear and convincing evidence. If they fail to do so, Selle would win the case.

---

<sup>201</sup> Id.

<sup>202</sup> Id. at 905.

<sup>203</sup> Id.

<sup>204</sup> Id.

<sup>205</sup> Id. at 904-05.

<sup>206</sup> Id. at 905-06.

## CONCLUSION

Herman Melville famously observed that “it is better to fail in originality than to succeed in imitation.”<sup>207</sup> This saying certainly captures a deep-seated human intuition. Throughout history, societies always had a special interest in original and highly creative works of art and expression. It is not surprising therefore that originality and creativity were selected as the gatekeepers of our copyright system. Yet, the existing copyright system does not use these two criteria properly. By assigning a very minimal role to these criteria, the system deprived society of a considerable expressive wealth that could have been realized under a more efficient and just design.

In this Article, we sought to remedy this design flaw by proposing an originality-based framework for reshaping our copyright law. Our goal was to calibrate protection and liability to the level of originality of works. Instead of using originality and creativity as threshold requirements whose satisfaction makes an owner eligible for uniformly strong copyright protection, we utilized originality and creativity as continuums and varied the scope of rights and liabilities in accordance with a sliding originality scale. In so doing, we remained mindful of practicability constraints and supplemented our substantive legal mechanisms with evidentiary rules that should assist courts in implementing our proposal. We demonstrated that an originality-based copyright system can help overcome some of the main shortcomings of the current regime and lead to the production of more original and creative works. To return to Melville’s quote, many believe that the current copyright system “succeeds in imitation and fails in originality.” We proposed a way to turn things around and put copyright law back on track.

---

<sup>207</sup> Herman Melville, *Hawthorne and His Mosses*, *The Literary World*, Aug. 17 & 24, 1850, available at <http://www.ibiblio.org/eldritch/nh/hahm.html>.