

## What Do We Do With a Doctrine Like Merger? A Look at the Imminent Collision of the DMCA and Idea/Expression Dichotomy

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## What Do We Do With a Doctrine Like Merger?

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## INTRODUCTION

Meet Pete. Pete is an average, nondescript sports fan who works hard during the day and enjoys fantasy football.<sup>1</sup> Pete does not have a law degree, and his only knowledge of the law behind fantasy sports comes from a segment he recently heard on ESPN, about Major League Baseball being sued over the right to use player names and statistics for fantasy baseball purposes.<sup>2</sup> In response to this court decision, which seriously limited the ability of major sports leagues to license the statistics of their athletes, the National Football League (NFL) determined that it could make more money off of fantasy football by offering fantasy football participants an official “NFL Championship Package.”<sup>3</sup> Pete learns that this package is available for download or on CD and includes various forms to help participants conduct their fantasy football draft and track their teams throughout the season. Additionally, Pete is interested in the sortable data collection of the athletes’ statistics from the last three seasons that is included with the Championship Package. Strangely, the NFL’s Championship Package is completely devoid of any software; it consists solely of various files that contain the players’ information.

Although Pete wants his fantasy football team to prevail this year, he feels the NFL’s price of \$59.99 (not including tax or shipping and handling) is too steep. Instead of purchasing the content online, Pete resorts to his favorite file-sharing software to download it. But when Pete learns that he cannot view the content without a password, he downloads a program that will figure out the password and open the files without the NFL’s authorization. Shortly after downloading the files, Pete receives a letter from the NFL threatening him with a lawsuit for violating its copyright in the Championship Package. Fearing a protracted legal battle with the NFL, Pete capitulates and pays the NFL the \$1000 it demands to avoid the suit.

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1. Fantasy sports is a multimillion dollar industry in which Pete (“owner”) “drafts” athletes from various professional sports teams. In a given period of time (usually one week) the owners compete against other owners by comparing the statistics of their drafted athletes against those of the other owners. *C.B.C. Distrib. & Mktg., Inc. v. Major League Baseball Advanced Media*, 443 F. Supp. 2d 1077, 1080 (E.D. Mo. 2006).

2. The case Pete heard about is *C.B.C. Distributing & Marketing, Inc.* See generally *id.* (holding that the defendant was unable to prevent fantasy baseball providers from using the players’ names and statistics in its services).

3. Although a brief visit to the NFL’s fantasy football website, <http://www.nfl.com/fantasy> (last visited Sept. 19, 2007), reveals that the NFL does have a market presence in the fantasy sports industry, the NFL’s appearance in this paper is purely hypothetical and all facts are devised by the author solely for the purpose of illustration.

Unfortunately for Pete, there was no way for him to know whether the NFL would actually bring suit, or even if it would succeed. Of course, if Pete had contacted his attorney, he would have learned that the NFL's claims were not nearly as strong as they stated in their letter. In fact, for reasons explained below, the forms and data collections were probably not copyrightable at all. However, depending on where the NFL brought suit, Pete could be liable for claims under the Digital Millennium Copyright Act (DMCA) even though an infringement claim would likely fail.

The Courts of Appeals are split in how they would handle Pete's case. Some would find liability under the DMCA, even though no infringement actually took place. Others would likely hold that various copyright doctrines, like merger and *scènes à faire* (which are related to the idea/expression dichotomy), would eviscerate the NFL's infringement claims, and therefore hold that a lack of protectable subject matter would foreclose the NFL's DMCA claim altogether.

Despite the theoretical nature of this scenario, a successful DMCA claim does not need to be supported by a valid infringement suit.<sup>4</sup> To make matters worse, these claims place most of the burden on putative defendants<sup>5</sup> who may have difficulty defending the action or raising a copyright misuse defense.<sup>6</sup>

This Comment will analyze the impending collision between the DMCA and the idea/expression dichotomy. Part I will provide an overview of the relevant copyright fundamentals (including constitutional and statutory requirements, infringement, the idea/expression dichotomy, and relevant portions of the DMCA). After establishing these basic copyright principles, this Comment will analyze the collision between the DMCA and the idea/expression dichotomy in Part II. Finally, in Part III, this Comment will suggest that the tools necessary to resolve the circuit split and provide stability to this emerging aspect of the law already exist and should be widely implemented.

### I. A BRIEF OVERVIEW OF COPYRIGHT FUNDAMENTALS

Although this Comment does not depend upon an intricate knowledge of the history and evolution of copyright law throughout

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4. Jacqueline D. Lipton, *The Law of Unintended Consequences: The Digital Millennium Copyright Act and Interoperability*, 62 WASH. & LEE L. REV. 487, 543 (2005).

5. *Id.* at 492.

6. *Id.*

American history, a handy understanding of basic principles will help the reader. Accordingly, before delving into any specific arguments, this Part will discuss constitutional requirements for copyright protection, provide an overview of copyright infringement, and look at the relevant doctrines for excluding copyright protection. Finally, this Part will close with a brief overview of the DMCA.

*A. The Constitutional and Statutory Requirements of Copyright*

The federal government derives its authority to create and regulate copyright from the Constitution. Article I vests Congress with 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>7</sup> From this archaic grant of power, Congress has created the Copyright Act, 17 U.S.C. §§ 101-1332. Since the Copyright Act of 1790, copyright jurisprudence has evolved to recognize two fundamental constitutional requirements before copyright protection will attach to a work: originality and fixation.<sup>8</sup>

The first, and until recently the most controversial, requirement for copyright protection is that of originality. By statute, copyright only protects “original works of authorship.”<sup>9</sup> Although this essential underpinning was greatly simplified in *Feist Publications v. Rural Telephone Service Co.*,<sup>10</sup> originality plays an essential role in understanding the idea/expression dichotomy and the doctrines of merger and *scènes à faire*. Justice O’Connor described originality as the

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7. U.S. CONST. art. I, § 8, cl. 8.

8. See Marci A. Hamilton, *Copyright at the Supreme Court: A Jurisprudence of Deference*, 47 J. COPYRIGHT SOC’Y U.S.A. 317 (2000) (providing an in-depth analysis of the Court’s interpretation of the Copyright Act, beginning with the adoption of the IP Clause, extending through the holding of *Feist Publications, Inc. v. Rural Telephone Service Co.*, 499 U.S. 340 (1991), and ending with a prediction for the Court’s future forays into copyright law). See also Douglas Lichtman, *Copyright as a Rule of Evidence*, 52 DUKE L.J. 683, 689-99 (2003) (advocating that evidentiary concerns also are through minimal copyright requirements).

9. 17 U.S.C. § 102 (2006). See also *Durham Indus., Inc. v. Tomy Corp.*, 630 F.2d 905, 910 n.10 (1980) (describing the inclusion of the statutorily mandated originality requirement).

10. *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 359-60, 363 (1991) (repudiating the “sweat of the brow” doctrine as justifying copyright protection of works lacking a *de minimus* amount of originality). Although some degree of originality has always been required for copyright protection, the *Feist* Court used relatively underutilized portions of previous case law to establish the modern concept of originality. See Lichtman, *supra* note 8, at 689-99.

“*sine qua non*” of copyright<sup>11</sup> and ultimately recognized originality, and thus copyright, as “requir[ing] independent creation plus a modicum of creativity.”<sup>12</sup> In doing so, the Court refused to extend copyright protection to a telephone directory and eliminated the popular “sweat of the brow” doctrine<sup>13</sup> in favor of the originality requirement.<sup>14</sup> Not surprisingly, Justice O’Connor’s “modicum of creativity” language has become an essential aspect of defining whether a work is “original.” In addition to excising the “sweat of the brow” doctrine from American copyright jurisprudence, the Court reaffirmed the longstanding rationale for an originality requirement:

The mere fact that a work is copyrighted does not mean that every element of the work may be protected. Originality remains the *sine qua non* of copyright; accordingly, copyright protection may extend only to those components of a work that are original to the author. Thus, if the compilation author clothes facts with an original collocation of words, he or she may be able to claim a copyright in this written expression. Others may copy the underlying facts from the publication, but not the precise words used to present them.<sup>15</sup>

In this way, originality serves a limited gate keeping function that prevents copyright from granting monopoly protection to authors over facts and ideas that are otherwise necessary to “promote Progress.” In the hypothetical described at the beginning of this Comment, the NFL’s data collection of player statistics is analogous to the phone book in *Feist* in that any useful iteration of the data will render the collection non-original, and thus lacking the “creative spark” required for originality.

In addition to originality, the Court has also established “fixation” as

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11. *Feist*, 499 U.S. at 345.

12. *Id.* at 346.

13. The “sweat of the brow” doctrine has roots in an agrarian metaphor used to justify the extension of copyright protection to those works that, although lacking in originality, required great effort to create. The metaphor likens the author’s work to that of a farmer who plants seeds, toils in the sun, and ultimately harvests a crop. Under this reasoning, some foreign governments will grant protection to collections of information. Patricia Loughlan, *Pirates, Parasites, Reapers, Sowers, Fruits, Foxes . . . The Metaphors of Intellectual Property*, 28 SYDNEY L. REV. 211, 222 n.36 (2006).

14. *Feist*, 499 U.S. at 364.

15. *Id.* at 348 (internal citations omitted). See also *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 556-57 (1985) (balancing the public’s rights under the First Amendment against an individual copyright holder’s rights afforded by the Copyright Act); Lichtman, *supra* note 8, at 703; Hamilton, *supra* note 8, at 344.

a predicate for copyright protection.<sup>16</sup> Although fixation as a requirement for protection seems rather obvious,<sup>17</sup> its own evolution is as convoluted as that of originality, a fact exacerbated by the lag between technological innovation and legislative adaptation.<sup>18</sup> In creating the Copyright Act of 1976, Congress finally sought to place the law ahead of technology by establishing fixation as “any tangible medium of expression, now known or later developed, . . . either directly or with the aid of a machine or device.”<sup>19</sup> In this sense, fixation clearly applies to written words, but also applies to recorded sounds and even more transitory alternatives, such as a computer’s RAM.<sup>20</sup> Accordingly, there should be no doubt that the NFL’s files are sufficiently fixed for the purposes of copyright.

### *B. Infringement*

The provisions governing infringement under the Copyright Act are found under Chapter Five, §§ 501-512.<sup>21</sup> Infringement occurs when the defendant has “violate[d] any of the exclusive rights of the copyright owner.”<sup>22</sup> Generally speaking, these exclusive rights include unauthorized copying of the work, along with unauthorized distribution and performance.<sup>23</sup> Accordingly, the courts have devised a standard format to prove that a defendant did in fact violate one of the plaintiff’s exclusive rights.

Successful copyright infringement actions generally rely only upon the satisfaction of a two-part test created by the Supreme Court.<sup>24</sup> First, the plaintiff must show the ownership of a valid copyright.<sup>25</sup> Next, the aggrieved owner must show that the defendant’s work has copied original elements of the infringed work.<sup>26</sup> As copyright plaintiffs know, however, the satisfaction of these elements is not always as easy as it

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16. Lichtman, *supra* note 8, at 718 (citing *Goldstein v. California*, 412 U.S. 546, 561 (1973)).

17. A basic interpretation of “Writings” as referenced by the IP Clause very clearly establishes some type of tangibility of the work as a constitutional requirement.

18. Lichtman, *supra* note 8, at 716-23.

19. 17 U.S.C. § 102(a) (2006).

20. Lichtman, *supra* note 8, at 716-17.

21. 17 U.S.C. §§ 501-12 (2006).

22. 17 U.S.C. § 501(a) (2006).

23. 17 U.S.C. § 106 (2006). Section 501 refers to sections 106-21, but section 106 delineates the owner’s exclusive rights.

24. *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 361 (1991).

25. *Id.*

26. *Id.*

may seem. Although the first element can be satisfied by the presentation of a “timely obtained” Certificate of Registration from the U.S. Copyright Office,<sup>27</sup> satisfying the second element is rarely as simple.

The second element of copyright infringement, termed “actionable copying” by the Fifth Circuit,<sup>28</sup> breaks down into two elements. These include proof of “factual copying” and “substantial similarity.”<sup>29</sup> It is the rare case that a copyright plaintiff has direct evidence of the defendant factually copying the infringed work. When this direct evidence does not exist, courts will infer copying if the plaintiff can show that defendant 1) had access to the infringed work, and 2) “the accused work is substantially similar to the plaintiff’s” protected work.<sup>30</sup> To further complicate matters, the “substantially similar” requirement of actionable copying differs from the “substantially similar” requirement of factual copying, giving rise to a reinvention of terms, as it were, by the Fifth Circuit.<sup>31</sup> According to the Fifth Circuit, the term “substantially similar” only refers to the final comparison between the two works that will establish actionable copying.<sup>32</sup> When a court looks to establish factual copying in the Fifth Circuit, access to the infringed work must be coupled with “probative similarity.”<sup>33</sup> Because of the more precise nature of the Fifth Circuit’s terminology, this Comment will utilize these terms in lieu of the more traditional vocabulary.<sup>34</sup>

In Pete’s situation, the NFL can more than likely demonstrate actual copying by proving 1) that the files are on Pete’s computer, and 2) that Pete did not pay for them. This situation differs from most infringement claims because the court will not have to decide if Pete created a work that infringes on the NFL’s rights. Even though Pete may not have to worry about an actual test for substantial similarity, these various tests

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27. *Gates Rubber Co. v. Bando Chem. Indus., Ltd.*, 9 F.3d 823, 832 n.5 (10th Cir. 1993).

28. *Positive Black Talk, Inc. v. Cash Money Records, Inc.*, 394 F.3d 357, 367 (5th Cir. 2004).

29. *Id.*

30. *Incredible Techs., Inc. v. Virtual Techs., Inc.*, 400 F.3d 1007, 1011 (7th Cir. 2005).

31. *Positive Black Talk*, 394 F.3d at 367.

32. *Id.* at 368 n.7.

33. *Id.*

34. According to the Fifth Circuit, these terms have also been adopted by the First, Second, Third, Tenth, and Eleventh Circuits. *Id.* See, e.g., *Dam Things From Den. v. Russ Berrie & Co., Inc.*, 290 F.3d 548, 562 (3d Cir. 2002); *Transwestern Pub. Co. LP v. Multimedia Mktg. Assocs., Inc.*, 133 F.3d 773, 775 (10th Cir. 1998); *Ringgold v. Black Entm’t Television, Inc.*, 126 F.3d 70, 75 (2d Cir. 1997); *Bateman v. Mnemonics, Inc.*, 79 F.3d 1532, 1541 (11th Cir. 1996); *Lotus Dev. Corp. v. Borland Int’l, Inc.*, 49 F.3d 807, 813 (1st Cir. 1995).



are important because, as will be discussed below, certain infringement tests predispose a court to find liability under the DMCA even when no infringement has taken place.

Myriad tests have evolved among the various Courts of Appeals for determining “substantial similarity” between the protected and infringing works. Because the focal point of this Comment resides at the intersection of copyright infringement and the DMCA, several of the more noteworthy tests are discussed below.

### 1. The *Arnstein* and Ordinary Observer Tests

One of the earlier tests used by the courts was devised by the Second Circuit in *Arnstein v. Porter*.<sup>35</sup> The basis of modern infringement jurisprudence can be clearly seen in this test as the court required proof not only of copying but also of improper appropriation.<sup>36</sup> The copying prong can be proven with either an admission of copying by the defendant or with evidence of access.<sup>37</sup> Only if copying is proven, should the court come to the question of “unlawful appropriation,” which is gauged by “the response of the ordinary lay hearer.”<sup>38</sup> Interestingly, while expert testimony and dissection may be considered in the first portion of the test, they are immaterial in the second portion of the test.<sup>39</sup>

The *Arnstein* test has evolved into the modern ordinary observer test, which is used in many circuits to determine “substantial similarity.”<sup>40</sup> For instance, the First Circuit uses a version of the

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35. 154 F.2d 464 (2d Cir. 1946).

36. *Id.* at 468.

37. *Id.*

38. *Id.*

39. *Id.* See also Jeffrey Cadwell, Comment, *Expert Testimony, Scènes à faire, and Tonal Music: A (Not So) New Test for Infringement*, 46 SANTA CLARA L. REV. 137 (2005) (arguing for the use of expert testimony throughout an infringement trial).

40. See, e.g. *Incredible Techs., Inc. v. Virtual Techs., Inc.*, 400 F.3d 1007, 1011 (7th Cir. 2005) (“The test for substantial similarity may itself be expressed in two parts: whether the defendant copied from the plaintiff’s work and whether the copying, if proven, went so far as to constitute an improper appropriation.”) (citations omitted); *Palmer v. Braun*, 287 F.3d 1325, 1330 (11th Cir. 2002) (“Two works are substantially similar if an average lay observer would recognize the alleged copy as having been appropriated from the copyrighted work.”) (citation omitted); *Yankee Candle Co. v. Bridgewater Candle Co.*, 259 F.3d 25, 33 (1st Cir. 2001) (“Whether there is substantial similarity between copyrightable expressions is determined by the ‘ordinary observer’ test.”); *Educ. Testing Servs. v. Katzman*, 793 F.2d 533, 541 (3d Cir. 1986) (“A finding of substantial similarity is an ad hoc determination. We apply the reasonable person standard, under which ‘the test is whether the accused work is so similar to the plaintiff’s work that an ordinary reasonable person would conclude that the defendant unlawfully appropriated the plaintiff’s protectable expression by taking material of

ordinary observer test that mandates both dissection of the work<sup>41</sup> and application of the doctrines of merger and *scènes à faire*.<sup>42</sup> The D.C. Circuit adopted, in *Sturdza v. United Arab Emirates*, a two-part test that is quite similar to the approach taken by the First Circuit.<sup>43</sup> Under the *Sturdza* approach, a court first determines the protectable aspects of the plaintiff's work and then compares these to the infringing work using the ordinary observer test.<sup>44</sup> Alternatively, some circuits rely upon the "total concept and feel test."<sup>45</sup> This test is used to attach liability to infringers who copy a work that, although meriting protection as a whole, contains many elements that are not afforded copyright protection individually. Finally, the Eleventh Circuit employs "fragmented literal similarity"<sup>46</sup> and "comprehensive nonliteral similarity"<sup>47</sup> as part of its ordinary observer test.<sup>48</sup>

## 2. The Extrinsic/Intrinsic Test

The extrinsic/intrinsic test parallels the "total concept and feel test" used primarily in the Second Circuit and very clearly has roots in the *Arnstein* test described above.<sup>49</sup> Under this test for "substantial similarity," a court considers two inquiries.<sup>50</sup> The first portion of this

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substance and value.") (citation omitted).

41. *CMM Cable Rep, Inc. v. Ocean Coast Props.*, 97 F.3d 1504, 1514 (1st Cir. 1996) ("[W]e note that the Copyright Act itself seems to mandate the 'dissection' of works into copyrightable and uncopyrightable elements.").

42. *Yankee Candle Co.*, 259 F.3d at 34 ("[After dissection], we apply the doctrines of merger and *scènes à faire* to determine how 'substantially similar' the copy must be to infringe.").

43. *Sturdza v. United Arab Emirates*, 281 F.3d 1287, 1295-1300 (D.C. Cir. 2002).

44. *Id.*

45. *See, e.g., Matthews v. Freedman*, 157 F.3d 25, 28 (1st Cir. 1998); *Knitwaves, Inc. v. Lollytogs Ltd.*, 71 F.3d 996, 1003-04 (2d Cir. 1995).

46. "In many cases an allegedly infringing work will evince 'fragmented literal similarity.' In other words, the work may copy only a small part of the copyrighted work, but do so word-for-word. If this fragmented copy is important to the copyrighted work, and of sufficient quantity, then it may support a finding of substantial similarity." *Palmer v. Braun*, 287 F.3d 1325, 1330 (11th Cir. 2002) (quoting 4 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 13.03[A][2] (2001)).

47. "Nonliteral similarity is more difficult to define. A work may be deemed substantially similar to another work when it evinces what Nimmer calls 'comprehensive nonliteral similarity.' This comprehensive nonliteral similarity is evident where 'the fundamental essence or structure of one work is duplicated in another.'" *Palmer*, 287 F.3d at 1330 (quoting 4 NIMMER § 13.03[A][1] (2001)).

48. *Palmer*, 287 F.3d at 1330.

49. *Sid & Marty Krofft Television Prods., Inc. v. McDonald's Corp.*, 562 F.2d 1157, 1164 (9th Cir. 1977).

50. *Taylor Corp. v. Four Seasons Greetings, LLC*, 315 F.3d 1039, 1043 (8th Cir. 2003)

test, the “extrinsic” portion, focuses on “specific expressive elements” including “plot, themes, dialogue, mood, setting, pace, characters, and sequence of events.”<sup>51</sup> If the plaintiff can demonstrate a material issue of triable fact at this juncture, then the defendant’s likely motion for summary judgment will be denied, and the case will be sent to a jury.<sup>52</sup> The intrinsic test parallels the ordinary observer test, in that, the inquiry focuses on whether “the works at issue are so dissimilar that ordinary ‘reasonable minds cannot differ as to the absence of substantial similarity in expression.’”<sup>53</sup> A jury cannot find substantial similarity without a sufficient evidentiary showing on both tests.<sup>54</sup>

### 3. Abstraction-Filtration-Comparison

In *Gates Rubber Co. v. Bando Chemical Industries, Ltd.*,<sup>55</sup> the Tenth Circuit adopted the abstraction-filtration-comparison test as a primary method for analyzing infringement in cases dealing with computer programs. As its name suggests, this test has three primary phases, appropriately named abstraction, filtration, and comparison—of which all are performed on the protected work. The first phase of this test, the abstraction test, has its roots in *Nichols v. Universal Pictures Corp.*<sup>56</sup> In this incarnation of the test, the court is to “separate ideas from expression.”<sup>57</sup> This portion of the test will not guide a court towards the

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(affirming the district court’s grant of the plaintiff’s preliminary injunction).

51. *Kouf v. Walt Disney Pictures & Television*, 16 F.3d 1042, 1045 (9th Cir. 1994) (citation omitted) (affirming the district court’s finding of a lack of substantial similarity between the two works).

52. *Id.*

53. *Taylor Corp.*, 315 F.3d at 1043 (citing *Hartman v. Hallmark Cards, Inc.*, 833 F.2d 117, 120 (8th Cir. 1987)).

54. *Id.*

55. 9 F.3d 823, 834-39 (10th Cir. 1993).

56. 45 F.2d 119 (2d Cir. 1930). In this decision, the abstraction test was designed to determine that no infringement occurred even though two plays centered around a family feud between an Irish family and a Jewish family that is exacerbated by the marriage of two children and quelled by the birth of a grandchild. Judge Hand described this test as follows:

[W]hen the plagiarist does not take out a block in suit, but an abstract of the whole, decision is more troublesome. Upon any work, and especially upon a play, a great number of patterns of increasing generality will fit equally well, as more and more of the incident is left out. The last may perhaps be no more than the most general statement of what the play is about, and at times might consist only of its title; but there is a point in this series of abstractions where they are no longer protected, since otherwise the playwright could prevent the use of his ‘ideas,’ to which, apart from their expression, his property is never extended.

*Id.* at 121 (citation omitted).

57. *Gates Rubber*, 9 F.3d at 834 (citation omitted).

protectable elements, but merely “divides the . . . program segments into layers of abstraction and determine whether the contents of that segment depict an idea, process or method.”<sup>58</sup> Upon completion of abstraction, a court should proceed to the filtration phase, where it is to focus on the elimination of unprotectable elements, including those elements that are specified in § 102(b)<sup>59</sup> or judicially-created, as in merger or *scènes à faire*.<sup>60</sup> Ideally, this process will isolate those elements of the work that are protectable for comparison in the final phase, comparison.<sup>61</sup> At this point, the court should compare the protectable elements against the infringing work and determine if they have been copied and if the copying “constitute[s] a substantial part of the original work.”<sup>62</sup>

### C. The Idea/Expression Dichotomy and Related Exclusionary Devices

Common throughout all of the various tests for infringement described above is the assumption of protectable material. As stated earlier, copyright protection does not extend to every element of a copyrighted work. Section 102(b) of the Copyright Act specifically forbids the extension of copyright protection “to any idea, procedure, process, system, method of operation, concept, principle, or discovery.”<sup>63</sup> Although each exception enumerated by the statute is worthy of mention, the dichotomy between ideas and expressions is especially relevant. Generally, the idea/expression dichotomy is invoked to prevent an author from gaining a monopoly over an idea, the antithesis of copyright protection.<sup>64</sup> The courts have delineated two other doctrines essential to guarding the boundaries between ideas and expressions.

#### 1. The Merger Doctrine

As seen in *Nichols v. Universal Pictures Corp.*, ideas by themselves

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58. *Computer Mgmt. Assistance Co. v. Robert F. DeCastro, Inc.*, 220 F.3d 396, 401 (5th Cir. 2000).

59. These include “idea[s], procedure[s], process[es], system[s], method[s] of operation, concept[s], principle[s], [and] discover[ies].” 17 U.S.C. § 102(b) (2006).

60. *Computer Mgmt. Assistance*, 220 F.3d at 401.

61. *Gates Rubber*, 9 F.3d at 838-39.

62. *Id.* at 839.

63. 17 U.S.C. § 102(b) (2006).

64. “Congress shall have Power To 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.” U.S. CONST. art. I, § 8, cl. 8.

are not protected by copyright,<sup>65</sup> and when the idea intertwines with the expression such that it is impossible to separate them, the expression is said to have “merged” with the idea.<sup>66</sup> The necessity of the merger doctrine was first observed in the late 1960s by the First Circuit in *Morrissey v. Proctor & Gamble Co.*<sup>67</sup> Merger arises when “the topic necessarily requires, if not only one form of expression, at best only a limited number, to permit copyrighting would mean that a party or parties, by copyrighting a mere handful of forms, could exhaust all possibilities of future use of the substance.”<sup>68</sup>

In *Morrissey*, the court was faced with two parties who each claimed rights in a set of rules for a contest.<sup>69</sup> Of course, the challenges in a case like this lie in both the application of the law to the facts at issue and the policy concerns that develop from overprotection and underprotection. A court in this position faces two choices: (1) protect the senior user’s “expression” and require subsequent authors to reinvent rules for contests, or (2) declare that the senior user’s expressions were so fundamentally tied to the ideas that protection could not be extended.<sup>70</sup> The *Morrissey* court recognized the impossible nature of the first option and established the merger doctrine.<sup>71</sup>

Returning to Pete and the NFL, the merger doctrine prevents copyright protection from attaching to any individual record within the NFL’s data collection. Furthermore, even if the data collection were able to receive protection as a whole, the information would itself be unprotectable, and if Pete could show the court that the statistics (ideas and facts) could not be expressed in any other way than the data records, then the merger doctrine would operate to render the NFL’s collection unprotectable.

However, determining whether an idea and its expression have merged requires “considerable care” on the part of the courts because too liberal an application of the doctrine can result in underprotection while too sparing an application could end in overprotection.<sup>72</sup> While

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65. *Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 121 (2d Cir. 1930) (Hand, J.). See *supra* note 56.

66. Lichtman, *supra* note 8, at 735.

67. *Morrissey v. Proctor & Gamble Co.*, 379 F.2d 675, 678-79 (1st Cir. 1967).

68. *Id.* at 678.

69. *Id.* at 676.

70. See Lichtman, *supra* note 8, at 735-36.

71. *Morrissey*, 379 F.2d at 678 (“We cannot recognize copyright as a game of chess in which the public can be checkmated.”).

72. *Kregos v. Associated Press*, 937 F.2d 700, 705 (2d Cir. 1991).

the doctrine itself is fairly well settled, its application is not without controversy, as seen below.<sup>73</sup>

## 2. *Scènes à Faire*

The doctrine of *scènes à faire* has its roots both in the idea/expression dichotomy and the fundamental copyright requirement of originality. This doctrine was first recognized in *Schwartz v. Universal Pictures Co.*,<sup>74</sup> where the court imported this French phrase—which literally means “scenes which ‘must’ be done,”—to prevent a finding of infringement “merely because both [parties] made use of an old situation.”<sup>75</sup> In a more modern setting, the Seventh Circuit has interpreted *scènes à faire* to mean that infringement will not be found on the basis of elements that are so “rudimentary, commonplace, standard, or unavoidable that they do not serve to distinguish one work within a class of works from another.”<sup>76</sup>

Instead of foreclosing expression *per se*, as merger does, *scènes à faire* is rooted in the public domain and has been traditionally based upon “expression through similarities of treatment, details, scenes, events and characterization.”<sup>77</sup> In *Gaiman v. McFarlane*, the Seventh Circuit considered *scènes à faire* as it applied to an “unexpectedly knowledgeable old wino” in the plaintiff’s work.<sup>78</sup> Even though a character like this would not normally be copyrightable, the court afforded protection because the plaintiff had provided sufficient literary detail for the character to acquire a “distinctive” nature.<sup>79</sup> Although Judge Posner used the word “distinctive,” the key to the wino’s protection rested in the author’s ability to differentiate this wino from the public domain wino by imbuing the character with sufficient *originality* so as to merit copyright protection. *Gaiman*’s wino contrasts nicely with this Comment’s nondescript Pete. By utilizing only minimally descriptive techniques, the author has relied on the reader to use stereotypical sports fan qualities to “flesh out” Pete’s details.

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73. *Lexmark Int’l, Inc. v. Static Control, Inc.*, 387 F.3d 522, 557 (6th Cir. 2004) (Feikens, J., dissenting) (discussing the growing circuit split and advocating that the Sixth Circuit join the Second and Ninth Circuits in its approach).

74. 85 F. Supp 270 (S.D. Cal. 1945).

75. *Id.* at 275.

76. *Gaiman v. McFarlane*, 360 F.3d 644, 659 (7th Cir. 2004) (quoting *Bucklew v. Hawkins, Ash, Baptie & Co.*, 329 F.3d 923, 929 (7th Cir. 2003)).

77. *Reyher v. Children’s Television Workshop*, 533 F.2d 87, 91 (2d Cir. 1976).

78. *Gaiman*, 360 F.3d at 660.

79. *Id.*

Whereas the wino was afforded protection for being sufficiently distinctive, Pete possesses no details that differentiate him from the stereotypical sports fan. Therefore, Pete is not sufficiently original and the author will not likely be able to protect Pete using copyright law.

In traditional media, *scènes à faire* refers to treatments of characters, plots, or other elements that are so basic as to be considered “indispensable.”<sup>80</sup> However, as copyright has been expanded to computer programs, this doctrine now applies to programming elements that are necessitated by hardware and mechanical restrictions.<sup>81</sup> Because of their involuntary or even mandatory nature, elements that qualify as *scènes à faire* are not afforded any protection under copyright.

#### D. The DMCA

Congress incorporated the DMCA into the Copyright Act in 1998 for two primary reasons. First, the DMCA was perceived as required for compliance with the United States’ World Intellectual Property Organization (WIPO) Copyright Treaty<sup>82</sup> obligations.<sup>83</sup> Additionally, Congress was lobbied by the various entertainment industries to promulgate the DMCA in order to bulk up their rights in digital media.<sup>84</sup> The effect of this legislation has been to provide copyright owners with an additional cause of action if an infringer bypasses a “technological measure” in order to infringe on the owner’s copyright.<sup>85</sup>

The DMCA provides this protection through three primary

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80. *Atari, Inc. v. N. Am. Philips Consumer Elecs. Corp.*, 672 F.2d 607, 616 (7th Cir. 1982).

If a drunken old bum were a copyrightable character, so would be a drunken suburban housewife, a gesticulating Frenchman, a fire-breathing dragon, a talking cat, a Prussian officer who wears a monocle and clicks his heels, a masked magician, and . . . a riotous knight who kept wassail to the discomfort of the household, or a vain and foppish steward who became amorous of his mistress. It would be difficult to write successful works of fiction without negotiating for dozens or hundreds of copyright licenses, even though such stereotyped characters are the products not of the creative imagination but of simple observation of the human comedy.  
*Gaiman*, 360 F.3d at 660 (citations omitted).

81. *Gates Rubber Co. v. Bando Chem. Indus., Ltd.*, 9 F.3d 823, 838 (10th Cir. 1993). The Third Circuit refers to this specific application of *scènes à faire* as “the doctrine of externalities.” *Dun & Bradstreet Software Servs., Inc. v. Grace Consulting, Inc.*, 307 F.3d 197, 214 (3rd Cir. 2002).

82. WIPO Copyright Treaty, Dec. 20, 1996, S. Treaty Doc. No. 105-17, 36 I.L.M. 65 (1997).

83. Marcus Howell, Note, *The Misapplication of the DMCA to the Aftermarket*, 11 B.U.J. SCI. & TECH. L. 128, 139 (2005).

84. Lipton, *supra* note 4, at 493.

85. *Universal City Studios, Inc. v. Corley*, 273 F.3d 429, 435 (2d Cir. 2001).

methods. While the first line of defense prohibits any person from “circumvent[ing] a technological measure” in order to gain access to a protected work,<sup>86</sup> the other two limitations ban “trafficking” of anti-circumvention measures.<sup>87</sup> The two anti-trafficking provisions are surprisingly similar on a textual level, but they each protect a distinct aspect of anti-circumvention technology. On the one hand, §1201(a)(2) protects “technological measure[s] that effectively control *access* to a [copyrighted] work.”<sup>88</sup> On the other hand, § 1201(b)(1) protects “technologies designed to permit access to a work but prevent[ing] copying of the work or some other act that infringes a copyright.”<sup>89</sup>

Although the robust protection that the DMCA offers has enabled copyright holders to expand their sales to the digital world (i.e., the Internet), the DMCA is not without its critics. First, plaintiffs suing under the DMCA need not show that there is a valid copyright infringement claim underlying the DMCA claim.<sup>90</sup> This has led to manufacturers stifling competition by threatening costly lawsuits<sup>91</sup> and has some commentators contemplating whether the archaic copyright misuse doctrine should be invoked.<sup>92</sup>

## II. WHAT DO WE DO WITH A DOCTRINE LIKE MERGER?

The doctrines of merger and *scènes à faire* generally play important roles in preserving Congress’s constitutional mandates.<sup>93</sup> Accordingly, any encroachment into this territory should be accepted only after careful and skeptical consideration. As indicated above, one such putative invasion has risen in a seemingly innocuous form: the DMCA.<sup>94</sup> To be certain, the collision that this Comment foresees is not centered

86. 17 U.S.C. § 1201(a)(1) (2006); *Corley*, 273 F.3d at 435.

87. 17 U.S.C. §§ 1201(a)(2), (b)(1) (2006); *Corley*, 273 F.3d at 435.

88. 17 U.S.C. §1201(a)(2) (2006); *Corley*, 273 F.3d at 441 (emphasis added).

89. *Corley*, 273 F.3d at 441 (discussing the protections afforded by 17 U.S.C. § 1201(b)(1)).

90. Lipton, *supra* note 4, at 544.

91. Howell, *supra* note 83, at 152.

92. “Misuse is an equitable doctrine, with roots in the patent world, in which a defendant in an infringement action may prevail if he can show, as a defense, that the patent owner has attempted to extend his patent into areas not protected by the governmental grant.” Heather, A. Sapp, Note, *Garage Door Openers and Toner Cartridges: Why Congress Should Revisit the Anti-Circumvention Provisions of the DMCA*, 3 BUFF. INTELL. PROP. L.J. 135, 159 (2006).

93. This includes not only the preamble to the IP Clause (“to promote the Progress of Science and useful Arts”), U.S. CONST. art. I, § 8, cl. 8, but also the restrictions placed upon the regulation of free speech preserved by the First Amendment, U.S. CONST. amend. I.

94. 17 U.S.C. §§ 1201-05 (2006).



on the DMCA exclusively, but on the intersection of that Act with the judicial doctrines of merger and *scènes à faire*. To be even more precise, it is only the methods in which a few circuits are approaching this intersection that are troublesome.

*A. The DMCA and Its Collision with the Idea/Expression Dichotomy*

What this all boils down to is that when the merger and *scènes à faire* doctrines interact with any type of anti-circumvention protocol designed to protect copyrightable material, certain applications of the doctrines create liability under the DMCA even where there is no liability under traditional infringement statutes. The federal Courts of Appeals are currently split over when to apply the merger and *scènes à faire* doctrines—before or after infringement analysis.<sup>95</sup> For the most part, this detail of the infringement analysis has remained a curio of copyright law, but when the DMCA enters the picture, this seemingly minute detail makes all the difference in the world.

1. Merger and *Scènes à Faire* as Affirmative Defenses to Copyright Liability

Despite courts' general reliance on the axiom that an idea cannot be copyrighted, a few commentators maintain that despite the language of § 102(b), copyright protection is properly extended to unprotectable elements while the idea/expression dichotomy (and the various related doctrines) merely serves as a defense to liability.<sup>96</sup> Courts relegate the merger and *scènes à faire* doctrines to the realm of affirmative defenses for a few primary reasons.<sup>97</sup> First, some courts argue that predicating copyrightability on these doctrines will actually invalidate copyright law somehow.<sup>98</sup> Alternatively, circuits that utilize the extrinsic/intrinsic or "total look and concept" tests for substantial similarity (e.g., the Second and Ninth Circuits) are more prone to apply merger and *scènes à faire* as affirmative defenses.<sup>99</sup>

The Second Circuit seems to be the strongest judicial advocate for

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95. Jacqueline D. Lipton, *IP's Problem Child: Shifting the Paradigms for Software Protection*, 58 *HASTINGS L.J.* 205, 213 n.46 (2006).

96. 2 MELVILLE B. NIMMER & DAVID NIMMER, *NIMMER ON COPYRIGHT*, § 2.03[D] (2007).

97. For the purposes of this Comment, this argument will be referenced as the "affirmative defense" approach.

98. *Kregos v. Associated Press*, 937 F.2d 700, 705-06 (2d Cir. 1991).

99. *Lexmark Int'l, Inc. v. Static Control Components*, 387 F.3d 522, 557-59 (6th Cir. 2004) (Feikins, J., dissenting).

the extreme position that the “misapplication” of the merger and *scènes à faire* doctrines somehow act to invalidate copyright. In *Kregos v. Associated Press*, the plaintiff created, and registered with the Copyright Office, a form that was used to publish pitching statistics in baseball games.<sup>100</sup> When the AP published a form that was nearly identical, Kregos filed suit in the Southern District of New York, where the court granted the AP’s summary judgment motion.<sup>101</sup> On review, the Court of Appeals reversed the District Court’s decision holding that the Second Circuit “consider[s] [the] so-called ‘merger’ doctrine in determining whether actionable infringement has occurred, rather than whether a copyright is valid.”<sup>102</sup> In coming to this holding, the Second Circuit argued that an examination of merger in this light would allow for a “more detailed and realistic basis for evaluating the claim.”<sup>103</sup> The court also felt that when merger is applied to prevent copyrightability (or as the court claimed, copyright invalidity), there is a danger of over or underprotection of copyrighted works.<sup>104</sup>

Alternatively, courts that apply the “total look and concept test” argue that merger and *scènes à faire* should only be applied as affirmative defenses. The Second Circuit suggests that “courts may lose sight of the forest for the trees [b]y factoring out similarities based on non-copyrightable elements.”<sup>105</sup> Along similar lines, in applying the intrinsic/extrinsic test, the Eighth and Ninth Circuits also argue that the affirmative defense line of reasoning is essential to protecting the work as a whole. Finally, the Seventh Circuit is also concerned with protecting the author who relies on utilizing “nonprotectable” *scènes à faire* themes in her works.<sup>106</sup>

## 2. Applying Merger and *Scènes à Faire* at the Threshold of Copyright

The alternative application of the merger and *scènes à faire* doctrines occurs before infringement is even determined, so as to prevent copyright from ever attaching.<sup>107</sup> Proponents of this application rely

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100. *Kregos*, 937 F.2d at 702.

101. *Id.* at 703.

102. *Id.* at 705.

103. *Id.*

104. *Id.*

105. *Hoehling v. Universal City Studios, Inc.*, 618 F.2d 972, 979 (2d Cir. 1980).

106. *Reed-Union Corp. v. Turtle Wax, Inc.*, 77 F.3d 909, 914 (7th Cir. 1996).

107. Because this argument applies the idea/expression dichotomy (and related doctrines) at the outset of the copyright determination, this Comment will refer to the argument as the “threshold” approach.

principally on the text of the Copyright Act and the landmark decision *Baker v. Selden*.<sup>108</sup> The argument, simplistic in its design, centers on the fact that § 102(b) of the Copyright Act prevents copyright protection. The language in question provides that “[i]n no case does copyright protection for an original work of authorship extend to any idea.”<sup>109</sup> As the Fifth Circuit held in *Kern River*:

When the “idea” and its “expression” are thus inseparable, copying the “expression” will not be barred, since protecting the “expression” in such circumstances would confer a monopoly of the “idea” upon the copyright owner free of the conditions and limitations imposed by the patent law.<sup>110</sup>

This rationale underpins the very reasoning for using the merger doctrine. Furthermore, as the Court noted in *Baker v. Selden*, giving an author monopoly rights in the ideas she expresses works “a fraud upon the public.”<sup>111</sup>

*B. Lexmark International v. Static Control Components*<sup>112</sup>

Lexmark International, Inc. (Lexmark) is a manufacturer of printers and ink cartridges that brought suit against Static Control Components (SCC), a manufacturer of microchips.<sup>113</sup> Lexmark’s action was based on SCC’s duplication of programs Lexmark used in its ink cartridges to calculate toner level, which included a “Toner Loading Program” (TLP).<sup>114</sup> In selling its printers, Lexmark created a classification of “Prebate” cartridges, which were sold to the consumer, but carried a contractual provision that required the consumer to use the cartridge just once and return it to Lexmark where it could be refilled.<sup>115</sup> Without this type of system, it is common for these cartridges to be refilled by a third party and reused.<sup>116</sup> Lexmark enforced the prebate agreement by installing a microchip on the printer that functioned like a “lock” and a

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108. 101 U.S. 99, 103 (1890) (holding that blank accounting forms are ideas in and of themselves, and therefore not entitled to copyright protection).

109. 17 U.S.C. § 102(b) (2006).

110. *Kern River Gas Transmission Co. v. Coastal Corp.*, 899 F.2d 1458, 1463 (5th Cir. 1990) (quoting *Herbert Rosenthal Jewelry Corp. v. Kalpakian*, 446 F.2d 738, 742 (5th Cir. 1971) (citing *Baker*, 101 U.S. at 103)).

111. 101 U.S. at 102.

112. *Lexmark Int’l, Inc. v. Static Control Components, Inc.*, 387 F.3d 522 (6th Cir. 2004).

113. *Id.* at 529.

114. *Id.*

115. *Id.* at 530.

116. *Id.*

separate microchip on the cartridge that functioned like a “key.”<sup>117</sup> This system was designed so that users would only be able to use cartridges sold by Lexmark with Lexmark printers. However, SCC manufactured and sold a microchip (SMARTEK) to generic ink cartridge manufacturers that was not only designed to function like the “key” microchip in Lexmark’s cartridges, but also carried Lexmark’s TLP.<sup>118</sup> Lexmark, believing its printer programs to be protected by copyright, filed suit alleging copyright infringement and violations of the DMCA’s anti-circumvention provisions.<sup>119</sup>

Although the district court found SCC liable on all counts, the Sixth Circuit reversed.<sup>120</sup> The Sixth Circuit reasoned that Lexmark’s security protocol (the proverbial lock and key) was essentially a “lock-out code” to which copyright protection was denied by the doctrines of merger and *scènes à faire*.<sup>121</sup> Furthermore, because of the hardware constraints on the TLP, it was also considered nonprotectable because it constituted a *scènes à faire* element.<sup>122</sup> The court went on to determine that because the Printer Engine Program (PEP) on the cartridge was accessible without bypassing the security protocol, the DMCA was not implicated.<sup>123</sup> The court likened Lexmark’s “security protocol” to a house where the back door was locked but the front door was left open.<sup>124</sup>

However, the Sixth Circuit’s holding was qualified by all manner of provisos and caveats. First, the Sixth Circuit was only overturning a decision to grant a preliminary injunction; the court was careful to allow the District Court sufficient latitude on remand.<sup>125</sup> Furthermore, as noted above, the *Lexmark* decision evades the DMCA issues, and this opinion actually provides a recipe for holders who wish to use the DMCA to protect unprotectable material.<sup>126</sup> They need only utilize “[t]he combination of a powerful technological lock and contractual license terms forbidding purchases to access relevant code [to] create a

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117. *Id.*

118. *Id.*

119. *Id.* at 531.

120. *Id.* at 551.

121. *Id.* at 542.

122. *Id.* at 544.

123. The mere act of purchasing a Lexmark printer allowed the user to lawfully access the protected software. *Id.* at 546-47.

124. *Id.* at 547.

125. Lipton, *supra* note 4, at 509.

126. *Id.* at 506.

situation where . . . *Lexmark* would not apply.”<sup>127</sup>

### III. HARMONIZING THE INTERACTION

Although the debate surrounding the application of merger and *scènes à faire* has been primarily a scholarly one up until now, as evidenced in *Lexmark*, copyright owners’ increasing reliance upon technology-based protection of their works necessarily implicates a greater number of DMCA-based claims. Furthermore, that a defendant could be found liable under the DMCA even if there was no copyright infringement runs contrary to Congress’s intent.<sup>128</sup> Of course, some circuits have already adopted the approach necessary to prevent this bewildering liability. The Fifth Circuit, for example, expressly chose such a position in *Mason v. Montgomery Data Inc.*<sup>129</sup> in accordance with its *Kern River* decision.<sup>130</sup>

The logic behind the threshold option is overwhelming. In addition to actually complying with the basic constitutional and statutory constraints of copyright, which the affirmative defense option does not, the threshold option more accurately reflects the legislative intent of the DMCA. Furthermore, the threshold option avoids the confusing legal fictions that the affirmative defense option creates.

Applying the doctrines of merger and *scènes à faire* as affirmative defenses undermines the constitutional underpinnings of copyright. As stated above, the *Feist* Court confirmed that originality is the “*sine qua non* of copyright.”<sup>131</sup> With a doctrine like *scènes à faire*, which is at least partly justified as preventing unoriginal ideas from receiving copyright protection, this fundamental concept directly prevents copyright from attaching in the first place. This certainly explains why the Second Circuit, a staunch advocate for the affirmative defense application of merger, stated that “*scènes à faire* are not copyrightable as a matter of law.”<sup>132</sup> Furthermore, because facts “may not be copyrighted and are part of the public domain available to every person,”<sup>133</sup> *Feist* also prevents copyright from attaching to “merged” expression when the

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127. *Id.*

128. Howell, *supra* note 83, at 152.

129. 967 F.2d 135 (5th Cir. 1992).

130. *Kern River Gas Transmission Co. v. Coastal Corp.*, 899 F.2d 1458 (5th Cir. 1990).

131. *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co., Inc.*, 499 U.S. 340, 345 (1991).

132. *Hoehling v. Universal City Studios, Inc.*, 618 F.2d 972, 979 (2d Cir. 1980) (applying *scènes à faire* in justifying its refusal to extend copyright protection to “standard literary devices”).

133. *Feist*, 499 U.S. at 346 (citation omitted).

involved “ideas” are facts. Proponents of the affirmative defense position will argue that this leaves a gap for merged opinions and fictions—those ideas that are not facts, but still merge with their expression.<sup>134</sup> As the Second Circuit correctly noted in *Castle Rock Entertainment v. Carol Publishing Group Inc.*, in many circumstances, these opinions or fictions will more closely resemble expression than anything else—in which case merger is not applicable anyway.<sup>135</sup>

The idea/expression dichotomy prevents authors from obtaining and maintaining monopolies over information.<sup>136</sup> As stated above, this goal is clearly articulated by § 102(b): “In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.”<sup>137</sup>

There is a valid argument that the affirmative defense approach to the application of merger and *scènes à faire* is also justified by the reading of the statute. After all, the text does not deny copyright, but copyright *protection*. Logically then, as the argument goes, Congress’s decision to only deny copyright protection tacitly stands for the proposition that Congress did not mean to deny copyright entirely. Therefore, the only method by which the courts can accurately reflect this distinction is by denying protection to unprotectable elements while maintaining protection in the work as a whole.

This argument, however, is deceiving for several reasons. Taking the constitutional argument into account, it is impossible for Congress to statutorily regulate outside of the scope that the Constitution allows.<sup>138</sup> But beyond the constitutional limits, this argument creates a unique

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134. *But see* *Castle Rock Entm’t v. Carol Publ’g Group Inc.*, 150 F.3d 132, 138-39 (2d Cir. 1998) (refuting the defendant’s contention that trivia derived from a television show’s fictitious storylines do not constitute “facts,” but protectable expression).

135. *Id.*

136. *Morrissey v. Proctor & Gamble Co.*, 379 F.2d 675, 678-79 (1st Cir. 1967).

137. 17 U.S.C. § 102(b) (2006).

138. *Marbury v. Madison*, 5 U.S. 137, 176-77 (1803). As the Court famously stated: The powers of the legislature are defined, and limited; and that those limits may not be mistaken, or forgotten, the constitution is written. To what purpose are powers limited, and to what purpose is that limitation committed to writing, if these limits may, at any time, be passed by those intended to be restrained? The distinction, between a government with limited and unlimited powers, is abolished, if those limits do not confine the persons on whom they are imposed, and if acts prohibited and acts allowed, are of equal obligation.

*Id.*

judicial paradox: “a court which finds that merger exists should hold that the two works in questions are not ‘substantially similar,’ even where they are in fact identical, a result which I view as a not useful variety of doublespeak.”<sup>139</sup> It seems, then, that this judicial doublespeak is tailored expressly to create liability where none should normally exist.<sup>140</sup>

Furthermore, Congress’s intent in enacting the DCMA was not to create additional liability by significantly altering the contours of copyright law. As stated above, Congress envisioned the DMCA to combat copyright piracy<sup>141</sup> and as satisfying U.S. treaty obligations.<sup>142</sup> Allowing copyright holders to successfully bring claims under the auspices of the DMCA when none of their exclusive copyrights have been violated certainly does not comply with either of these stated aims.

Finally, under the *Lexmark* majority’s holding, another interesting approach is engendered that ultimately supports the threshold approach. Under the Sixth Circuit’s approach in *Lexmark*, the circuit split is immaterial because parallel terminology is used in the relevant statutes. A literal reading of § 102(b) only affords copyright *protection* to those elements of a work on the expression side of the idea/expression dichotomy. The DMCA specifically only applies to those works that are *protected* by the Copyright Act.<sup>143</sup> Therefore, a work denied copyright protection by § 102(b) of the Copyright Act should also be denied protection under the DMCA. Accordingly, a very literal reading of both statutes, such as that one taken by the Sixth Circuit, renders the whole discussion quite one-sided, and the circuit split obsolete.

#### CONCLUSION

Courts have created several doctrines to enforce the idea/expression dichotomy, including merger and *scènes à faire*. Up until 1998, this

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139. *Kregos v. Associated Press*, 937 F.2d 700, 715 (2d Cir. 1991) (Sweet, J., dissenting) (footnote omitted).

140. See *Lexmark Int’l, Inc. v. Static Control Components, Inc.*, 387 F.3d 522, 558 (6th Cir. 2004) (Feikens, J., dissenting). “I would hold that in cases where the merger is with a method of operation, the merger doctrine should be applied as a defense to infringement only, and not as informing the question of copyrightability.” *Id.* Note that under this approach, merger would preclude copyrightability under all other circumstance but be modified just for this case so that liability would attach.

141. Lipton, *supra* note 4, at 493.

142. Howell, *supra* note 83, at 138-39.

143. 17 U.S.C. § 1201(a) (2006).

discourse has been more or less scholarly in its approach, but when Congress enacted the DMCA the realm of protectable works and their constituent elements began to play a much more important role. It is now possible for copyright holders to receive damages from an “infringing” defendant even when no copyright infringement has occurred. However, the arguments that support this putative liability lack proper constitutional, statutory, and logical support. Therefore, courts should ignore any doctrine that purports to protect unprotectable works and refuse to ascribe liability to defendants who have not violated any copyright laws.

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