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Copyright--Protection Denied to Verbal Expression of Simple Subject Matter--*Morrissey v. Proctor & Gamble Co.*

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RECENT DEVELOPMENTS

COPYRIGHT—Protection Denied to Verbal Expression of Simple Subject Matter—*Morrissey* *v. Procter & Gamble Co.**

The plaintiff copyrighted a series of rules for a sales promotional contest in which contestants' social security numbers were used as the basis for a "sweepstakes." In 1959 he submitted the contest rules and game suggestions to several companies, including the defendant Procter & Gamble Company, to see if they were interested in using his scheme. The defendant failed to accept or even to respond to the plaintiff's solicitation. However, three years later Procter & Gamble initiated a "Shopping Fling Sweepstakes" which utilized contestants' social security numbers as the basic element of the game. Plaintiff brought an action for copyright infringement in the United States District Court for the District of Massachusetts, claiming that the defendant's first contest rule was copied from rule 1 of his copyrighted game. The district court granted summary judgment to the defendant, holding that defendant had proved that it had not had access to the copyrighted material, and that in any event the rule was not copyrightable since it was based on a relatively simple idea and evidenced no "original creative authorship."¹ On appeal to the Court of Appeals for the First Circuit, *held*, affirmed on other grounds. The First Circuit concluded that the district court's analysis of both the access issue and the question of originality was incorrect. However, the court affirmed on the ground that so "straightforward and simple" a matter could be expressed in only a "limited number" of ways;² therefore, to permit copyright protection of a "mere handful of forms" would exhaust all future use of the substance or idea of the contest.

This reluctance to uphold patent-like protection under the Copyright Act³ was first expressed in *Baker v. Selden*,⁴ decided by the United States Supreme Court in 1879. In *Baker*, the plaintiff had copyrighted a bookkeeping text consisting of an explanation of "T" accounting and an appendix of various forms to be utilized in applying the system. The Supreme Court ruled that although the explanation of the system was copyrightable, the appended "blank" forms were not:

* *Morrissey v. Procter & Gamble Co.*, 379 F.2d 675 (1st Cir. 1967) [hereinafter principal case].

1. *Morrissey v. Procter & Gamble Co.*, 262 F. Supp. 737 (D. Mass. 1967).

2. Principal case at 676.

3. 17 U.S.C. chs. 1-3 (1964).

4. 101 U.S. 99 (1879).

The description of the art in a book, though entitled to the benefit of copyright, lays no foundation for an exclusive claim to the art itself. The object of the one is explanation; the object of the other is use. The former may be secured by copyright. The latter can only be secured, if it can be secured at all, by letters-patent.⁵

The main purpose of the explanation-use dichotomy established in *Baker* was to prevent individuals from securing "back-door" patents through the use of the copyright laws. The Court was concerned about the potential "blocking" effect of granting copyright protection; such a monopoly upon the forms which comprised the accounting system would obviously have inhibited the use and development of the process described in the text. *Baker* was applied easily to temperature charts,⁶ tax record sheets,⁷ and other blank forms.⁸ The cases are far from consistent, however, and copyrightability has been upheld in clear "use" situations even without the presence of the additional complicating factor of some form of verbal expression. Thus discount charts for negotiable instruments,⁹ freight tariff indices,¹⁰ trade catalogues,¹¹ and the like¹² were distinguished from the forms in *Baker* and found worthy of copyright protection.

While there were writings on the accounting forms in *Baker*, they were merely column headings, not verbal explanations. In *Morrissey*, on the other hand, outright verbal expression was at issue, thereby distinguishing *Baker* on its facts. This extension of the *Baker* principle into the context of purely verbal expression conflicts with the analytical approach taken earlier by the Court of Appeals for the

5. 101 U.S. at 105. See also 37 C.F.R. § 202.1(c) (1968) (regulations of the Copyright Office); H.R. REP. No. 83, 90th Cong., 1st Sess., at 15 n.1 (1967) which indicate that under the present and proposed Copyright Acts respectively, blank forms are not copyrightable.

M. NIMMER, COPYRIGHT §§ 37.3-37.4 (1966), disagrees with the *Baker* conclusion as to noncopyrightability of blank forms. He feels that there was a sufficient difference between Selden's and Baker's forms to have simply held no infringement. He bases his conclusion partially on a Supreme Court comment in *Mazer v. Stein*, 347 U.S. 201, 217 (1954): "We find nothing in the copyright statute to support the argument that the intended use in industry of an article eligible for copyright bars or invalidates its registration. We do not read such a limitation into the copyright law."

6. *Brown Instrument Co. v. Warner*, 161 F.2d 910 (D.C. Cir.), cert. denied, 332 U.S. 801 (1947); *Taylor Instrument Co. v. Fawley-Brost Co.*, 139 F.2d 98 (7th Cir. 1943), cert. denied, 321 U.S. 785 (1944).

7. *Aldrich v. Remington Rand, Inc.*, 52 F. Supp. 732 (N.D. Tex. 1942).

8. See, e.g., *Brief English Sys., Inc. v. Owen*, 48 F.2d 555 (2d Cir.), cert. denied, 283 U.S. 858 (1931) (stenographic short-type system and speedwriting booklets); *Amberg File & Index Co. v. Shea Smith & Co.*, 82 F. 314 (7th Cir. 1897) (indexing system).

9. *Edwards & Deutsch Lithographing Co. v. Boorman*, 15 F.2d 35 (7th Cir.), cert. denied, 273 U.S. 738 (1926).

10. *Gutherie v. Curlett*, 36 F.2d 694 (2d Cir. 1929).

11. *B & B Auto Supply, Inc. v. Plesser*, 205 F. Supp. 36 (S.D.N.Y. 1962).

12. See, e.g., *Gordon v. Weir*, 111 F. Supp. 117 (E.D. Mich. 1953), aff'd, 216 F.2d 508 (6th Cir. 1954) (dot-counting contest), *New Jersey Motor List Co. v. Barton Business Serv.*, 57 F.2d 353 (D.N.J. 1931) (list of applications for motor vehicle registrations).

Second Circuit in *Continental Casualty Co. v. Beardsley*.¹³ In *Continental Casualty*, the defendant Beardsley had copyrighted a six-page pamphlet incorporating three pages of explanatory essays and three pages of forms which were to be used in writing insurance against the loss of securities. Continental Casualty had adopted similar forms, and sought a declaratory judgment that Beardsley's copyrights were invalid and an injunction to prevent Beardsley from bringing an infringement suit. The District Court for the Southern District of New York granted the injunction on the alternate grounds of noncopyrightability and divestitive publication.¹⁴ The Second Circuit affirmed the judgment, but disagreed with the district court on the question of whether the forms were copyrightable; the court refused to extend the *Baker* rationale to verbal expressions, even when their subject matter was very limited. The court attempted to distinguish *Baker* by concluding that Beardsley's expression of the idea had been inextricably incorporated with the forms, thereby combining "explanation" with "use."¹⁵ To avoid the obvious disadvantages of granting monopoly protection to ideas for a system or process, the *Continental Casualty* court imposed a strict test of infringement, stating that "[t]o constitute infringement in such cases a showing of appropriation in exact form or substantially so of the copyrighted material should be required."¹⁶ The court concluded that the simi-

13. 253 F.2d 702, cert. denied, 358 U.S. 816 (1958).

14. 151 F. Supp. 28 (S.D.N.Y. 1957).

15. The logic of the *Continental Casualty* approach is somewhat impaired by the fact that the explanatory language, which the court found distinguished *Continental Casualty* from the *Baker* case, was used merely to accomplish the functional purpose of the form; that is, the words on the form serve both as exposition and application of the insurance plan. But the accounting forms in *Baker* served the same dual purpose, and that decision prevented copyright protection for accounting forms from being used to limit use of the related accounting plan. While the same kind of limitation was not placed on the scope of protection in *Continental Casualty*, the test of infringement applied may have the same effect, even though copyrightability was found. Recent Development, *Copyright Protection for "Blank Forms"*, 47 CALIF. L. REV. 174, 177 (1959).

16. 253 F.2d at 705. This combination of an easy test for copyrightability and a strict standard for infringement had been criticized earlier in *Crume v. Pacific Mut. Life Ins. Co.*, 140 F.2d 182, 184-85 (7th Cir.), cert. denied, 322 U.S. 755 (1944) [quoting *Dorsey v. Old Sur. Life Ins. Co.*, 98 F.2d 872, 874 (10th Cir. 1938)]:

To say that an idea, plan, method or art described in a copyright is open to the public, but that it can only be used by the employment of different words and phrases which mean the same thing borders on the preposterous. It is to exalt the accomplishment of a result by indirect means which could not be done directly. It places a premium upon evasion and makes this the test of infringement. . . . [T]here is no room for the skill of the mechanic or artisan in utilizing the plan or method disclosed. Its use, to which the public is entitled, can be effected solely by the employment of words descriptive thereof. In our view, where the use can be effected only in such manner, there can be no infringement even though the plan or method be copied. We realize that such a view leaves little, if any, protection to the copyright owners; in fact it comes near to invalidating the copyright.

Brightley v. Littleton, 37 F. 103 (C.C.E.D. Pa. 1888) was the only case which totally supported *Continental Casualty* on the copyrightability of the forms. The plaintiff therein was the author of a series of blank forms intended to be filed by applicants

larity of the two sets of forms did not meet the enunciated criterion; accordingly, it decided that there was no infringement.

Morrissey and *Continental Casualty* represent distinct analytical approaches to the problem of how to prevent statutory copyright from securing a patent-like monopoly of an idea, system, or process. *Morrissey* is an extension of the principle of *Baker v. Selden* to the verbal expression of subject matter which can be explained only in a limited number of ways; but because of its facts, *Morrissey* does cast doubt on the viability of the explanation-use dichotomy expressed in *Baker*. Still, in suggesting that the mathematical finiteness of the forms of expression is an appropriate test of copyrightability, the First Circuit provided a significant analytical tool for other courts to use in efforts to avoid the undesirable blocking of the practice of an art. Unlike the *Continental Casualty* approach, which allows copyrightability in the first instance and then tests for "substantial" similarity, the *Morrissey* rationale denies copyrightability from the outset if there are only a few ways to express the particular subject matter. The *Morrissey* approach seems both to yield more predictability and to express more forthrightly the courts' concern about stifling the practice of the "useful arts."

The mathematical-finiteness concept provides a relatively objective criterion for determining when the grant of copyright protection would prove to be an impediment to further development and use of an art. In the past, although the courts have been hesitant to grant copyright protection in all situations for this very reason, highly subjective tests of copyrightability have been employed. For example, Professor Kaplan has isolated the constituent elements of literary works into something of a continuum: "language, incident, plot, theme, and ideas."¹⁷ Obviously, the continuum runs from the specific—language or "expression"—which is protectible, to the general—ideas—which are not.¹⁸ The idea-expression dichotomy, although designed to serve the same ends as the *Morrissey* principle, is really little more than a labeling technique applied to the results of particular cases. It is an unpredictable approach and, unless employed carefully, it can result in upholding the statutory grant of protection in inappropriate circumstances. Nevertheless, in some cases where authors have sued for infringement of elements of incident, plot, or

for a retail liquor license under an 1887 Pennsylvania law. The clerk of a court drafted up some similar forms. The court held that the forms were copyrightable as a book and that there had been an infringement.

17. B. KAPLAN & R. BROWN, COPYRIGHT 245 (1960).

18. For a dissent from the proposition that "ideas"—particularly in the television format field—should not be protectible, see Libott, *Round the Prickly Pear: The Idea-Expression Fallacy in a Mass Communications World*, in ASCAP, COPYRIGHT LAW SYMPOSIUM 30 (1968).

theme of their copyrighted works, the courts have stressed the commonplace nature of the appropriated elements and have held that such parts of the whole are not entitled to copyright protection.¹⁹ Whatever the difficulties of defining what parts of a literary work are protectible, it is apparent that those parts which are *not* protectible are being preserved for other authors to draw upon. This rationale would argue against granting copyright protection to something that might be viewed as a "stock" literary device.²⁰ Similarly, in the rather confused area of copyright protection of characters, the courts have exhibited concern about tying up the use of "stock characters" through statutory copyright.²¹

As has been suggested, these kinds of concerns closely parallel

19. See *Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 121 (2d Cir. 1930), *cert. denied*, 282 U.S. 902 (1931), where Judge Hand stated:

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 be perhaps 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 when 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. Nobody has been able to fix that boundary, and nobody ever can. [Citation omitted.]

In commenting upon the similarity in theme of plaintiff's play and defendant's movie, Hand said:

[T]here is no monopoly in such a background. Though the plaintiff discovered the vein, she could not keep it to herself; so defined, the theme was too generalized an abstraction from what she wrote. It was only a part of her ideas . . . [H]er copyright did not cover everything that might be drawn from her play; its content went to some extent into the public domain.

45 F.2d at 122. See 17 U.S.C. § 1 (1964) for the full scope of protection available under the Copyright Act.

Dellar v. Samuel Goldwyn, Inc., 150 F.2d 612 (2d Cir.), *cert. denied*, 327 U.S. 790 (1945) at 612 summed up the prior Second Circuit decisions thus: "The principle . . . is that only in the 'expression' of a copyrighted work does any monopoly inhere; the 'theme,' the 'plot,' the 'idea' may always be freely borrowed." See also *Columbia Broadcasting Sys., Inc. v. DeCosta*, 377 F.2d 315 (1st Cir. 1967); *Arnstein v. Porter*, 154 F.2d 464 (2d Cir. 1946); *RCA Mfg. Co. v. Whiteman*, 114 F.2d 86 (2d Cir.), *cert. denied*, 311 U.S. 712 (1940); *Guthrie v. Curlett*, 36 F.2d 694 (2d Cir. 1929); *Dymow v. Bolton*, 11 F.2d 690 (2d Cir. 1926).

20. Cf. *Sheldon v. Metro-Goldwyn-Mayer Pictures Corp.*, 81 F.2d 49 (2d Cir.), *cert. denied*, 298 U.S. 669 (1936), where the court did extend protection to a series of events employing what might be called stock literary devices. However, in speaking of "parallelism of incident" Judge Hand stressed that the *sequence* of the details involved constituted "the very web of the authors' dramatic expression; and copying them is not 'fair use.'" 81 F.2d at 55.

21. See *Warner Bros. Pictures, Inc. v. Columbia Broadcasting Sys., Inc.*, 216 F.2d 945, 950 (9th Cir. 1954), *cert. denied*, 348 U.S. 971 (1955), where the court stated:

It is conceivable that the character really constitutes the story being told, but if the character is only the chessman in the game telling the story he is not within the area of protection afforded by the copyright . . .

We conclude that even if the [copyright] owners assigned their complete rights in the copyright to the [defendant], such assignment did not prevent the author from using the characters used therein, in other stories. The characters were vehicles for the story told, and the vehicles did not go with the sale of the story. See also *Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 122, where Judge Hand indicated that copyright protection for stock characters would be improper.

the reasoning in *Morrissey*. If the purpose of the copyright statute is to "promote . . . useful Arts,"²² decisions about the extent of copyright protection must be considered carefully. A stock character or a stock device is described in a book or play in discrete verbal form, but to permit an author to secure through his copyright a monopoly on the use of the device or character in other works seems to impede rather than promote the practice of the literary art. And, determining that a character or a device is "stock" certainly implies the acceptability of a mathematical-finiteness test of copyrightability.²³

The usefulness of the *Morrissey* test as an analytical tool will be slight if its limitations are not recognized. Thus, while *Morrissey* is not restricted, as was the *Baker* case, to works which require independent textual explanation, caution must be exercised in attempting to apply the *Morrissey* principle to "nonutilitarian" works. The "low parameter" art forms—those in which the range of expression is necessarily limited—provide illustrations of works for which the mathematical-finiteness principle is appropriate and those for which it is not. Architecture is a field in which present copyright standards limit protection to blueprints and allow copying of the final product, the building.²⁴ This limited protection may be an implicit recognition of the mathematical-finiteness principle: it would be unfortunate to allow a "mere handful of forms," or even ten thousand forms, to exhaust all future use of many utilitarian architectural innovations. Music, on the other hand, is "nonutilitarian" in the sense that it lays no claim to being functional; its importance lies within itself rather than in communicating rules or directing the construction of buildings. Thus, the danger which *Morrissey* seeks to forestall—blocking the use of underlying utilitarian ideas—is not present when passing

22. U.S. CONST. art. I, § 8, cl. 8 states: "The 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." Clause 8 is both the copyright and the patent clause. For a detailed analysis of the meaning, historical background, and evolution of the various words and phrases in the copyright clause, see M. NIMMER, COPYRIGHT §§ 1-9 (1966). For the early history of copyright see R. BOWKER, COPYRIGHT, ITS HISTORY AND LAW 1-34 (1912). See B. KAPLAN, AN UNHURRIED VIEW OF COPYRIGHT 1-37 (1967), for an excellent historical overview.

23. See notes 16, 20-21 *supra* and accompanying text.

24. See 37 C.F.R. § 202.12 (1968) for a Copyright Office regulation which indicates that architectural blueprints are to be copyrighted as "drawings or plastic works of a scientific or technical character." This means that the exclusive rights granted to the holder of copyrighted blueprints are not governed by 17 U.S.C. § 1(b), which states that a copyright holder has the exclusive right "to complete, execute, and finish it if it be a model or design for a work of art." Therefore, the copyright proprietor of a blueprint has exclusive rights under § 1(a) "[t]o print, publish, copy, and vend the copyrighted work," but no exclusive rights as to execution of the design. See generally *De Silva Constr. Corp. v. Herald*, 213 F. Supp. 184 (M.D. Fla. 1962); *Muller v. Triborough Bridge Authority*, 43 F. Supp. 298 (S.D.N.Y. 1942); Strauss, *Copyright in Architectural Works*, Study No. 27, in 1 STUDIES ON COPYRIGHT 87 (1963).

on the copyrightability of a musical work.²⁵ Nonetheless, while caution is indicated in applying mathematical finiteness to the field of music, the principle should not be ignored altogether in consideration of musical works.²⁶ Use of the *Morrissey* approach might have produced the opposite result in *Fred Fisher Inc. v. Dillingham*,²⁷ where Judge Learned Hand held that a mere eight-note bass ostinato²⁸ in Jerome Kern's "Kalua" had infringed the bass ostinato in "Dardanella." In reaching this unfortunate result, Hand discounted the clear differences between the *melodies* of the two songs and the rather mechanical way in which the bass was used. But most important, he seemed to ignore the full import of the brevity of the eight-note series: the shorter a sequence of notes, the more likely it is that it will be needed in other compositions. The extreme case of a two-note sequence illustrates the principle—every two-note sequence has been needed, and used, thousands of times. If the *Dillingham* principle were in common use today, substantial limitations on musical creation might result. The finiteness test, limited by recognition that the protected idea is a musical idea and not "utilitarian," would be useful in avoiding such consequences. To use the principle, the courts must be willing to break down musical compositions into component parts—in effect looking for "stock" elements which should be preserved for later composers to incorporate into their works. In applying the concept, however, the courts should recall Justice Holmes' comment in *Bleistein v. Donaldson Lithographing Co.*²⁹—one that is still relevant to the establishment and application

25. This is not to say that there is no danger in the exhaustion of musical ideas by the overly broad extension of copyright protection. Such a danger exists, but it is a danger of restricting ideas *within* the art form and is reasonably manageable under established rules. *Morrissey* seeks to protect ideas which are *not* inherent in the expression—ideas concerning contest rules are not ideas of English prose, but merely ideas *expressed* in English prose.

26. Music is really quite limited, mathematically, as an art form. L. HILLER & M. ISAACSON, *EXPERIMENTAL MUSIC* 11 (1959), quoting Cassiodorus (circa 485-575) defined the mathematical quadrivium as follows:

Mathematical science is that science which considers abstract quantity. By abstract quantity we mean that quantity which we treat in a purely speculative way, separating it intellectually from its material and from its other accidents, such as evenness, oddness, and the like. It has these divisions: arithmetic, *music*, geometry, astronomy. Arithmetic is the discipline of absolute numerable quantity. Music is the discipline which treats of numbers in their relation to those things which are found in sound. [Emphasis added.]

If this attitude appears a bit peculiar today, perhaps it is only a result of nineteenth century Romantic conditioning to think of music completely in terms of its emotional appeal.

27. 298 F. 145 (S.D.N.Y. 1924).

28. The ostinato bass is a set of repeated notes along a bass line. Actually, only a four-note pattern was involved, and it was repeated in two successive measures. The melody prevailed over the bass in aural perception, as would be expected.

29. 188 U.S. 239 (1903).

of any test substantially limiting the copyrightability of artistic works:

It would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations outside the narrowest and most obvious limits. At the one extreme works of genius would be sure to miss appreciation. Their very novelty would make them repulsive until the public had learned the new language in which their author spoke. It may be more than doubted, for instance, whether the etchings of Goya, or the paintings of Manet would have been sure of protection when seen for the first time. At the other end, copyright would be denied to pictures which appealed to a public less educated than the judge.³⁰

The finiteness test is most easily applied to games, game rules, and to any legal or quasi-legal forms³¹ where the choice of language is restricted because the imprimatur of the courts has been applied to only a few select phrases. It is precisely in this area that the *Continental Casualty* approach appears to break down. If infringement consists of "appropriation in exact form or substantially so of the copyrighted material," use of legal forms—which requires exact "tracking" of the operative language—seems to be impossible without infringement. Application of the principle of mathematical finiteness to deny copyrightability to such forms avoids this difficulty.

If we confine our inquiry to utilitarian works, the subject of greatest impact may be the computer program. Such programs have been copyrightable since 1964, under an administrative rather than a judicial or legislative decision.³² Basically, programming is a writing

30. 188 U.S. at 251-52.

31. Obviously the word "forms" includes complete forms for deeds, leases, trusts, wills, and contracts. It could also include the kind of insurance forms treated in *Continental Cas. Co. v. Beardsley* (see notes 13-16 *supra* and accompanying text) and other utilitarian forms (See notes 3-8 *supra* and accompanying text). There is also little reason to distinguish books which contain form clauses for deeds, leases, trusts, wills, and contracts, since these clauses, like complete forms, are included for the purpose of being "tracked" in their language.

32. See N.Y. Times, May 8, 1964, at 43. Programs are copyrightable if it can be shown that they have authorship (U.S. CONST., art. 1, § 8, cl. 8), that the statutory notice requirements have been met [17 U.S.C. § 10 (1964)], and that the version submitted to the Register is directly perceivable by humans. See Copyright Office Cir. 31D (Jan. 1965), and the original statement of position, Copyright Office, SML-47 (June 1964). Cf. the proposed revision of the Copyright Act, S. 597, 90th Cong., 1st Sess. § 102 (1967), which states that

Copyright protection subsists . . . in original works 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. [Emphasis added].

For an explanation of the importance of the concept of "fixation," see H.R. REP. No. 83, 90th Cong., 1st Sess. 15-16 (1967).

George D. Cary, Deputy Register of Copyrights, wrote in 1964 that the decision by the Copyright Office was "an administrative decision that, based upon existing judicial precedents and statutory law, the courts might agree that a computer program

technique that uses mathematical language to instruct the machine to complete certain operations with or upon the data stored in its cells.³³ The program passes through various physical transmutations before it can be employed in the computer: handwritten draft; flow chart; punched cards; and magnetic tape (possibly in several different computer languages).³⁴ Although much of the current debate about the copyrightability of computer programs correctly focuses on the difficult problems of which of these stages can qualify for copyright protection³⁵ and how the concept of infringement will be applied to such a staged process,³⁶ the *Morrissey* principle obviously goes to the question of whether programs are copyrightable at all. The inherent mathematical logic involved in formulating programmed instructions limits the possible number of efficient alternatives available in the construction of a particular program, unless the programmer wants to introduce superfluous functions into the sequence. Thus, the potential applicability of the *Morrissey* rationale should be obvious.

It has been suggested that copyright protection should be given to the "program package,"³⁷ without compelling an individual to obtain a copyright on all of the variations resulting either from different sequences of commands or from the addition of superfluous functions.³⁸ Such an approach would presumably make it impossible to "program around" a copyright,³⁹ and would lead to the kind of re-

is a 'writing' in the constitutional sense." Cary, *Copyright Registration and Computer Programs*, 11 BULL. COPYRIGHT SOC. 361, 362 (1964). See also Puckett, *The Limits of Copyright and Patent Protection for Computer Programs*, in ASCAP, COPYRIGHT LAW SYMPOSIUM (Number 16) 102-04 (1968).

33. For an explanation of programming, see Puckett, note 432 *supra*, at 136-42 (appendix entitled "An Introduction to Computer Programming").

34. *Id.* See also Note, *Copyright Protection for Computer Programs*, 64 COLUM. L. REV. 1274, 1276-77 (1964).

35. This debate centers on whether the program, at some or all of its stages of existence, is a "writing." See Note, *supra* note 34 (pro copyrightability); Jacobs, *Patents, Copyrights, and Trade Secrets*, in COMPUTERS AND THE LAW 90, 91 (Bigelow ed. 1966) (contra copyrightability). See also the proposed Copyright Act § 102, *supra* note 32.

36. At present, the Copyright Office takes the position that if someone reduces a copyrighted literary work, at the stage of input into the computer, to cards or magnetic tape, there has been infringement. This rigid position can be criticized because the output which the alleged infringer seeks to generate may very well not constitute an infringement despite the fact that the copyrighted work was fed into the computer in its entirety at the input stage.

37. Katona, *Legal Protection of Computer Programs*, 47 J. PAT. OFF. SOC. 955, 967-71 (1965).

38. Even if program owners were forced to copyright each variation, this would be possible because there are computers that can supply all possible alternatives to the basic program for the performance of any given function.

39. See Bender, *Computer Programs: Should They Be Patentable?*, 68 COLUM. L. REV. 241, 250 (1968); notes 41-43 *infra* and accompanying text.

sults which the First Circuit found unacceptable in *Morrissey*. In arguing that *patent* is the appropriate form of protection for programs, Bender notes that copyright protection is unsatisfactory because it cannot "protect the principle underlying a mechanism or process as well as the specific form."⁴⁰ Though Bender suggests that "perhaps minor changes in form will not render a program sufficiently different to avoid a charge of 'substantial infringement,'"⁴¹ it seems clear that a strict application of the *Continental Casualty* approach could prove him wrong.⁴²

On the other hand, the *Morrissey* approach has some advantage in this area. The complexity of computer programs (in terms of the number of characters, assembled into sequential commands, involved) means that the finite number of variations of a given program is probably greater than the number of possible variations of expression of rule 1 of a shopping sweepstakes. However, at least if this greater finite number of variations of a computer program results simply from a reordering of the same commands present in the first program or from the addition of superfluous functions to the first program, it is clear that we are dealing with a subject matter susceptible of a limited number of forms of expression. Given this fact, the *Morrissey* principle, if applied, would deny copyrightability to the program and eliminate any chance that the original author could "appropriate" its subject matter. The *Continental Casualty* approach, because it allows copyright to attach in the first instance, is more risky; there is a chance that a court would understand that the program variant being tested for infringement incorporated only insignificant changes, albeit a large number of them, and that it would find infringement.

This analysis does not imply that all computer programs should be barred from copyright protection. The more complex the program—the more operations it includes and functions it performs—the more likely it is that the mathematical-finiteness test will indicate that the program should be protected. Programs to run hospitals, space centers, steel mills, or other large institutions are of such a creative nature and so expensive to develop that public policy may dictate some form of protection.⁴³ In this field, as in the others dis-

40. Bender, *Computer Programs: Should They Be Patentable?*, 68 COLUM. L. REV. 241, 250 (1968).

41. *Id.* at 249.

42. For a brief acknowledgement of the applicability of *Continental Casualty* to computer programs, see Puckett, *supra* note 32, at 101.

43. See Bender, *supra* note 40, at 245-46 (footnotes omitted):

Programs are expensive to develop. . . . Without the knowledge that it can earn royalties from the use of its products by others, a company is frequently reluctant to make the necessary investment of time and money. At present, the program must be useful enough to the developer himself to warrant the investment. If it is, he will frequently wish to prevent competitors from copying it. Secrecy results. . . . If the only available form of protection is secrecy . . . program hoarding will

cussed above, the concern should be to exclude from protection those elements which others may need to advance the art. If there are "building block" elements in computer programs, elements which are susceptible of a very few forms of expression, the *Morrissey* approach can assure that they will be freely available. This consideration is obviously very important in dealing with relatively new and undeveloped communications techniques such as those afforded by computer technology.

Admittedly the *Morrissey* principle looks more to the social detriment that would result from granting copyright protection than to an objective evaluation of the work's characteristics.⁴⁴ As suggested above, however, several other criteria should be considered in conjunction with this aspect of mathematical-finiteness test. Of course, these factors include: (1) the "sweat of the brow" exerted by the creator, and the extent of his financial investment;⁴⁵ (2) the creativity exemplified in the work;⁴⁶ and (3) the sophistication of the particular art involved.

Practical administration of the finiteness test should also be considered. Congress and the courts have never allowed the Copyright Office to play a significant supervisory role in determining the basic question of copyrightability. The judicial elimination, in effect, of the "originality" requirement as a test of copyrightability is an example of this.⁴⁷ Moreover, the draft of the new Copyright Act does

reduce the utility of new programs and choke off the sort of technical dialogue that nourishes the art.

See also Burck, *The Boundless Age of the Computer* (part II), *FORTUNE*, April 1964, at 141.

44. See Recent Development, *supra* note 15, at 175.

45. See, e.g., *Amsterdam v. Triangle Publications, Inc.*, 189 F.2d 104 (3d Cir. 1951); *Leon v. Pacific Tel. & Tel. Co.*, 91 F.2d 484 (9th Cir. 1937); *PIC Design Corp. v. Sterling Precision Corp.*, 231 F. Supp. 106 (S.D.N.Y. 1964); Gorman, *Protection for the Collection and Representation of Facts*, 76 *HARV. L. REV.* 1569 (1963); *BahnzhaF, Copyright Protection for Computer Programs*, 64 *COLUM. L. REV.* 1274, 1286 (1964).

46. See REGISTER OF COPYRIGHTS, *COPYRIGHT LAW REVISION: REPORT ON THE GENERAL REVISION OF THE U.S. COPYRIGHT LAW*, 87th Cong., 1st Sess. 9 (1961):

It is well established, by a long line of court decisions that in order to be copyrightable under the statute a work must meet the following requirements:

(a) the work must be in form of a "writing"

(b) the work must be a product of original creative authorship.

Two interrelated elements are involved here: originality and creativity.

(1) The work must be original in the sense that the author produced it by his own

intellectual efforts as distinguished from merely copying a pre-existing work.

. . . .

(2) The work must represent an appreciable amount of creative authorship.

See also M. NIMMER, *COPYRIGHT* §§ 3.2, 6 (1967).

47. "Originality" as a criterion of copyrightability has come to mean merely that a given expression originated with the author; it does not refer to the novelty of the subject matter. See *Whist Club v. Foster*, 42 F.2d 782 (2d Cir. 1921); *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53 (1884); *Alfred Bell & Co. Ltd. v. Catalda Fine Arts, Inc.*, 191 F.2d 99 (2d Cir. 1951); *Withol v. Wells*, 231 F.2d 550 (7th Cir. 1956) (dictum); Yankwich, *Legal Protection of Ideas—A Judge's Approach*, 43 *VA. L. REV.* 375, 377 (1957).

not enlarge the Copyright Office's role in this area.⁴⁸ Nevertheless, the general arguments in favor of administrative agencies—arguments which stress the development of efficiency and expertise in dealing with particular kinds of problems—are applicable in the copyright field as well. The mathematical-finiteness test, if supplemented and clarified with administrative regulations, could be far less subjective than a test of "originality." It provides a real opportunity to shift the initiative for decisions about copyrightability from the courts, where it now rests and would continue to rest under a *Continental Casualty* approach, to the Copyright Office. The administrative body could be delegated authority to make the initial determination of copyrightability; judicial review would of course be preserved for applicants who were aggrieved by the decision of the Register of Copyrights.

Morrissey can be viewed as a subtle plea for a re-evaluation of the entire system of copyright protection rather than a minor refinement of traditional doctrine. The concept of mathematical finiteness is not a panacea for curing all copyright ills, but it should serve as a starting point for further discussion. Our rapidly expanding technology confronts us with many problems similar to those raised by the copyrighted contest rule or contract clause; because of the tremendous costs that a "back-door patent" in technology could engender in this area, however, the stakes are much higher. Near the end of *An Unhurried View of Copyright*, Professor Kaplan discusses the developing technology and suggests that in the future "copyright or the larger part of its controls will appear unneeded, merely obstructive, as applied to certain sectors of production and that here copyright law will lapse into disuse and may disappear."⁴⁹ *Baker v. Selden* recognized the need to eliminate copyright protection where it was obstructive. *Morrissey*, decided almost ninety years later, represents a very important step in fulfilling Kaplan's prophecy.

In comparison, the Patent Office has a considerable role to play in determining whether the statutory standards for patent (admittedly much more stringent than those for copyright) have been met. The standards for patent are set forth in 35 U.S.C. §§ 101-03 (1964). The Supreme Court has described the difficulty of qualifying for patent protection in *Burrow-Giles Lithographic Co. v. Saroni*, 11 U.S. 53 (1884) at 59: "In regard, however to the kindred subject of patents for invention, they cannot by law, be issued to the inventor until the novelty, the utility, and the actual discovery or invention by the claimants have been established by proofs before the Commissioner of patents"

48. See S. 597, 90th Cong., 1st Sess., ch. 7 (1967) ("Copyright Office").

49. B. KAPLAN, AN UNHURRIED VIEW OF COPYRIGHT 121 (1966).