



Roth Cards (left) and United Cards (right)

cute moppet suppressing a smile and, on the inside, the words “i wuv you.” With the exception of minor variations in color and style, defendant’s card . . . is identical. Likewise, Roth’s card entitled “I miss you already,” depicts a forlorn boy sitting on a curb weeping, with an inside message reading “. . . and You Haven’t even Left . . .” . . . , is closely paralleled by United’s card with the same caption, showing a forlorn and weeping man, and with the identical inside message. . . .

KILKENNY, J., dissenting: The majority agrees with a specific finding of the lower court that the words on the cards are not the subject of copyright. By strong implication, it likewise accepts the finding of the trial court that the art work on the cards, although subject to copyright, was not infringed. Thus far, I agree.

I cannot, however, follow the logic of the majority in holding that the uncopyrightable words and the imitated, but not copied art work, constitutes such total composition as to be subject to protection under the copyright laws. The majority concludes that in the overall arrangement of the text, the art work and the association of the art work to the text, the cards were copyrightable and the copyright infringed. This conclusion, as I view it, results in the whole becoming substantially greater than the sum total of its parts. With this conclusion, of course, I cannot agree.

Feeling, as I do, that the copyright act is a grant of limited monopoly to the authors of creative literature and art, I do not think that we should extend a 56-year monopoly* in a situation where neither infringement of text, nor infringement of art work can be found. On these facts, we should adhere to our historic philosophy requiring freedom of competition. I would affirm.

Mason v. Montgomery Data, Inc.
967 F.2d 135 (5th Cir. 1992)

REAVLEY, J.: . . . Mason created and published 118 real estate ownership maps that, together, cover all of Montgomery County. The maps . . . pictorially portray the location, size, and shape

*[As described in detail in Chapter 3, copyright in a work created by an individual now lasts for the life of the author plus 70 years. — Eds.]

of surveys, land grants, tracts, and various topographical features within the county. Numbers and words on the maps identify deeds, abstract numbers, acreage, and the owners of the various tracts. Mason obtained the information that he included on the maps from a variety of sources.³ Relying on these sources, Mason initially determined the location and dimensions of each survey in the county, and then drew the corners and lines of the surveys onto topographical maps of the county that were published by the United States Geological Survey (USGS). He then determined the location of the property lines of the real estate tracts within each survey and drew them on the USGS maps. Finally, Mason traced the survey and tract lines onto transparent overlays, enlarged clean USGS maps and the overlays, added names and other information to the overlays, and combined the maps and overlays to print the final maps. Mason testified that he used substantial judgment and discretion to reconcile inconsistencies among the various sources, to select which features to include in the final map sheets, and to portray the information in a manner that would be useful to the public. . . .

. . . [Defendant] Landata purchased a set of Mason's maps and reorganized them by cutting and pasting them into 72 map sheets. Landata then attached a transparent overlay to each of the 72 sheets, and depicted on these overlays numerous updates and corrections to the information on Mason's maps. . . . Landata created an inked mylar "master overlay" for each of the 72 reorganized map sheets. . . .

The district court determined that Mason's idea, "which includes drawing the abstract and tract boundaries, indicating the ownership name, the tract size, and the other factual information" on a map of Montgomery County, was "to create the maps, based on legal and factual public information." *Mason*, 765 F. Supp. at 356. Mason argues that the court clearly erred in finding that this idea can be expressed in only one or a limited number of ways. We agree. The record in this case contains copies of maps created by Mason's competitors that prove beyond dispute that the idea embodied in Mason's map is capable of a variety of expressions. . . . The record also contains affidavits in which licensed surveyors and experienced mapmakers explain that the differences between Mason's maps and those of his competitors are the natural result of each mapmaker's selection of sources, interpretation of those sources, discretion in reconciling inconsistencies among the sources, and skill and judgment in depicting the information. . . .

Landata contends that, even if the merger doctrine does not apply, Mason's maps are uncopyrightable because they are not "original" under *Feist*. . . .

Mason's maps pass muster under *Feist* because Mason's selection, coordination, and arrangement of the information that he depicted are sufficiently creative to qualify his maps as original "compilations" of facts. . . .

Mason's maps also possess sufficient creativity to merit copyright protection as pictorial and graphic works of authorship. . . .

NOTES AND QUESTIONS

1. In *Feist*, the standard the Court sets for originality is quite low. Do you think the fact that *Feist* involved a compilation had an effect on the Court's articulation of the standard?

3. These sources included tax, deed, and survey records from Montgomery County; data provided by the San Jacinto River Authority; survey records, maps, and abstracts of land titles from the Texas General Land Office; title data and subdivision information provided by Conroe Title; a map from the city of Conroe, Texas; and maps from the United States Coast and Geodetic Survey.

2. Do you agree with the *Feist* Court that the result it reached was “neither unfair nor unfortunate”? Is copyright an appropriate legal vehicle for protecting collections of information?

3. After *Feist*, what exactly must a compiler do to qualify the resulting collection of material for copyright protection? This question is a vital one for enterprises that seek to market, and protect, compilations of factual information. We consider the post-*Feist* jurisprudence concerning the copyrightability of databases in Chapter 4.

4. Do you agree with the *Mason* court that Mason’s maps satisfied the *Feist* originality standard? Were the maps properly characterized as “compilations”? Note that the tradition of copyright protection for maps extends back to the first Copyright Act of 1790. In light of this tradition, and of the court’s conclusion that the maps were protectible as “pictorial, graphic or sculptural works” anyway, why bother to characterize the maps as compilations?

5. Does *Roth Greeting Cards* effectively treat the greeting cards as “compilations”? If copyright did not protect compilations, would these works be considered copyrightable under §102(a)? Under §102(b)? If copyright protected only collective works but not compilations, would these works be copyrightable?

Although *Roth Greeting Cards* predates *Feist*, courts within the Ninth Circuit frequently cite and rely on its “total concept and feel” standard. See, e.g., *Apple Computer, Inc. v. Microsoft Corp.*, 35 F.3d 1435, 1446 (9th Cir. 1994); *Litchfield v. Spielberg*, 736 F.2d 1352, 1357 (9th Cir. 1984), cert. denied, 470 U.S. 1052 (1985); *Sid & Marty Krofft Television Prods., Inc. v. McDonald’s Corp.*, 562 F.2d 1157, 1167 (9th Cir. 1977). Is this standard consistent with *Feist*? Does viewing a textual or graphic work as a compilation of its elements, rather than simply as a literary or pictorial work, make a finding of originality more or less likely? While the total concept and feel test can be relevant for determining originality for the purposes of the threshold question of copyrightability, courts also employ this test in the infringement analysis. See Chapter 5.B.1 *infra*.

6. Do you think that Mason’s maps or the greeting cards in *Roth Greeting Cards* would have qualified as copyrightable “[c]ollections of literary and artistic works” under the Berne Convention?

7. Is there a minimum number of preexisting elements that a creator must combine in order for there to be originality? The Compendium II of Copyright Office Practices ¶1307.01 (1984) states that “[a]ny compilation consisting of less than four selections is considered to lack the requisite original authorship.” The Ninth Circuit has also held that the combination of four preexisting elements in a lamp did not result in an original work of authorship. *Lamps Plus, Inc. v. Seattle Lighting Fixture Co.*, 345 F.3d 1140 (9th Cir. 2003); see also *Satava v. Lowry*, 323 F.3d 805 (9th Cir. 2003) (finding combination of six unprotectible elements in glass-in-glass jellyfish sculptures did not rise to the level of originality sufficient to merit copyright protection).

8. In *Darden v. Peters*, 488 F.3d 277 (4th Cir. 2007), the plaintiff had taken a U.S. Census map, added color and shading to give the map a three-dimensional effect, selected a font for labeling the states, and added additional labels as well. The Copyright Office rejected the application for registration and the Fourth Circuit agreed, concluding that: “Additions to the preexisting maps such as color, shading, and labels using standard fonts and shapes fall within the narrow category of works that lack even a minimum level of creativity. . . .” *Id.* at 287. The court noted that the contributions Darden alleged to constitute original authorship elements resembled the examples set forth in regulations issued by the Copyright Office of the types of works that lack a minimum level of creativity: “[w]ords and short phrases such as names, titles, and slogans; familiar symbols or designs; mere variations of typographic ornamentation, lettering or coloring; mere listing of ingredients or contents.” 37 C.F.R. §202.1(a);

see *supra* page 98. Why was Darden’s map denied protection when Mason’s maps were granted protection? In his application for registration Darden described his work as “a derivative work that . . . was based on preexisting ‘US Census black and white outline maps.’” Does the difference in treatment lie solely in Darden’s designation of his map as a “derivative work” instead of a compilation?

9. In *Atari Games Corp. v. Oman*, 979 F.2d 242 (D.C. Cir. 1992), the D.C. Circuit reversed the Register of Copyrights’ decision to deny registration as an audiovisual work to an early video game — Atari’s BREAKOUT. The game was fairly simple. Players would move a paddle to hit a square ball against a wall built of rectangles. See *id.* at 243. The size of the wall, paddle, and ball would change and the ball would increase in speed. See *id.* The court did not quarrel with the district court’s finding that “simple geometric shapes and coloring alone are not per se copyrightable.” See *id.* at 243-44. However, it emphasized that the Register should have focused on the “flow of the game as a whole,” keeping in mind *Feist*’s statement that the standard for originality is not high. See *id.* at 244-45. Are audiovisual works always compilations because the statute defines them as “a series of related images”? 17 U.S.C. §101. Do you think that most video game displays are copyrightable compilations under the *Feist* standard?

B. WHO IS AN AUTHOR?

Thus far, we have considered the requirements that flow from the constitutional authorization to grant exclusive rights in “Writings.” The Intellectual Property Clause also specifies that these rights are to be granted to “Authors.” Does this wording impose additional threshold requirements for the grant of copyright? What does it mean to be an “author”? The present Copyright Act suggests several different answers, depending on the circumstances of a work’s creation.

The Copyright Act recognizes three kinds of authorship: sole authorship, joint or co-authorship, and employer authorship of “works made for hire.” The determination of authorship has considerable practical importance, because the Act assigns initial ownership of the copyright to the party or parties deemed to be the “author” or “authors” of the work:

§201. Ownership of copyright

(a) **Initial ownership.** Copyright in a work protected under this title vests initially in the author or authors of the work. The authors of a joint work are co-owners of copyright in the work.

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

As you will see, the “works made for hire” provisions of the U.S. Copyright Act stand in stark contrast to the copyright laws of many other countries, which recognize only natural persons as authors. The major international copyright treaties — the Berne Convention, the TRIPS Agreement, and the WIPO treaties — refer simply to “authors,” and do not specify how authorship is to be defined.

As you read the second part of this chapter, identify the different understandings of authorship embodied in the Copyright Act’s categories and consider the extent to which