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Comment on Dennis S. Karjala's Article

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A COMMENT ON DENNIS S. KARJALA'S COPYRIGHT AND MISAPPROPRIATION

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Professor Karjala argues for a new framework of analysis for copyright protection based on the statutory concept of originality in copyright law[1] and the suggestion of commentators and judges that misappropriation—or "piracy," to use the language of the Statute of Anne[2]—often plays a role in determining whether infringement has occurred.

Professor Karjala suggests that originality of a work can occur not only in the expression of the intellectual content of a work, but also in the method of fixation of the work. His analytical framework has precedent in copyright law. For example, new sound recordings of public domain musical works are protected by today's copyright laws, even though the original musical composition is not protectable. Karjala suggests that similar protection should be available to other works, including collections of facts, reproductions of public domain art works, photographs of natural objects or other works, maps, new typographic arrangements of public domain works, and electronically stored public domain texts. He finds the comparison to existing copyright law easiest for these works. Indeed, the reader finds it easy to follow the argument that originality in the process of fixation is separate from originality (or lack of it) in the underlying work, and that protection of originality in the process of fixation fits into our current framework of copyright law and notions of fair play (antimisappropriation).

Professor Karjala next examines misappropriation as an underlying notion of copyright protection in literary works (other than computer programs), industrial designs, and copyright protected functional works including computer programs, standardized test questions, and blank forms. Here he abandons his concept of originality in the method of fixation and generally discusses the social benefits of providing protection from copying to authors of functional works which advance the knowledge of society in a particular area. He argues that permitting piracy of functional works will inhibit and not advance intellectual pro-

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1. Copyright Act of 1976, § 102, 17 U.S.C. § 102 (1988).
2. 8 Anne Ch. 19 (1709).

gress. Courts or the legislature should therefore explicitly, not implicitly, consider antimisappropriation theories in deciding what degree of protection these works should have under copyright.

Professor Karjala's theories lead to the possibility of a statutory amendment for protecting certain types of works against certain types of copying. Generally, his stand for admitting misappropriation explicitly to infringement analysis in copyright cases leads to a logical conclusion: copying by mechanical means, such as photocopying, in order to produce a competitive work nearly always yields a finding of infringement. In his framework of according originality to the method of fixation, different types of works are given different levels of protection, so that protection for works in which copyright is admittedly "thin" (e.g., factual compilations) is limited to the grossest forms of copying such as electronic downloading for electronically stored databases and photocopying for maps. Professor Karjala agrees with Professor Raskind[3] that different works require different levels of originality. The type of protection that the copyright laws should give to works should be commensurate with the "value added" originality contributed by the author. Therefore, if the value added to a public domain sculpture work by a photographer was the selection of the camera angle, lighting, lens, and film speed, the resulting photograph should not be allowed to be reproduced mechanically. Similarly, since the value added by the author of an electronic version of public domain works is the access to the work through a computer, the database should not be allowed to be reproduced electronically.

Professor Karjala's theory of originality in the method of fixation has great appeal for electronic publishers such as Mead Data Central, Inc. If his theory were adopted by courts or by the legislature, electronic versions of public domain works would not be subject to misappropriation—"piracy"—by others seeking to provide competitive electronic products. However, copying all or individual parts of the works would be permitted if the purpose of the copying were to produce a book of the database or of parts of the database. Under Professor Karjala's theory of value added originality in the method of fixation, a book would not compete with an electronic database.

In some ways Professor Karjala's framework builds directly on Leo Raskind's essay *The Misappropriation Doctrine as a Competitive Norm of Intellectual Property Law*.[4] Professor Raskind would analyze the type, amount and purpose of the copying of a copyrighted work

3. Leo J. Raskind, *The Misappropriation Doctrine as a Competitive Norm of Intellectual Property Law*, 75 MINN. L. REV. 875 (1991).

based on competitive norms. Specifically, he would examine in each case the "extent to which a competitor may lawfully enter the market arena without incurring the same cost structure as a rival."[5] Professor Raskind argues that misappropriation is an implicit underpinning of copyright cases, and if traditional analysis does not produce the result the court feels is just, the court should openly use concepts of economic cost of competition, and unfair competition, in its analysis.[6] Professor Raskind's theories have the benefit of precedent in the trade regulation area and the cases analyzing unfair competition in its many forms. Professor Karjala's theory, however, would introduce a new method of analysis, one which builds on traditional copyright themes ("originality"), to reach the same results as Professor Raskind. That is, that courts could use misappropriation as a basis for finding copyright infringement.

Other commentators have taken different approaches. Patterson and Joyce, in *Monopolizing the Law: The Scope of Copyright Protection for Law Reports*,[7] argue forcefully that misappropriation has a role in copyright law enforcement and analysis, but that it must be balanced by the public's need for dissemination.[8] Professor Ginsburg[9] argues that existing copyright law cannot be applied in a unitary scheme to the two very different types of works that copyright protects; she calls them works of "high" authorship and "low" authorship.[10] Professor Ginsburg would divide copyright law into two schemes: one to protect the original works of authors, and the other to protect the information (or "fact") intensive works which are becoming difficult to fit into copyright law.[11]

Professor Ginsburg advocates a system of compulsory licensing for derivative versions of fact compilations.[12] This system would provide the necessary incentives for collection of public domain data as well as for its dissemination.

Advances in technology and the public's desire for information have created a favorable climate for information products of many different formats and delivery systems. Technological advances, however, have also led to easy copying—starting with the photocopy machine

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5. *Id.* at 886.

6. *Id.* at 905-06.

7. L. Ray Patterson & Craig Joyce, *Monopolizing the Law: The Scope of Copyright Protection for Law Reports and Statutory Compilations*, 36 UCLA L. REV. 719 (1989).

8. *Id.* at 807.

9. Jane C. Ginsburg, *Creation and Commercial Value: Copyright Protection of Works of Information*, 90 COLUM. L. REV. 1865 (1990).

10. *Id.* at 1866-68.

11. *Id.*

12. *Id.* at 1914-27.

and progressing to the computer with its ability to download information in electronic form to other computers, facsimile machines and printers.

Professor Karjala's theory of originality in the method of fixation would prevent wholesale direct copying of most factual works, presuming the dicta of the *Feist Publications v. Rural Telephone Service Co.*[13] decision is either not followed by the courts or is counteracted by statute. But it starts a new framework of legal reasoning which, by Professor Karjala's own admission, is not applicable to all copyrighted functional or fact-intensive works. Professor Karjala is trying to restore the balance between property rights and dissemination that he feels has been unbalanced by the *Feist* decision. The misappropriation doctrine explicitly or implicitly prevented piracy of certain factual works prior to *Feist*. Professor Karjala's theory, like Professor Raskind's, attempts to provide a framework for analysis which would permit judges to protect expression of some types of works not intrinsically "original" in expression. Professor Karjala acknowledges, however, that his framework fits poorly with the area of compilation of facts after the *Feist* decision, and suggests that statutory amendment may be necessary to revive copyright protection for fact compilations.

Producers of compilations of facts and public domain materials need to analyze the various methods suggested by commentators for protection of their works. If copyright law is ever to be the vehicle of protection after *Feist*, then statutory amendment will be necessary, and Professors Karjala and Ginsburg have suggested two possible schemes for that course. In the alternative, producers need to examine contract protection. Other methods available for electronic publishers might include state statutes defining theft (or piracy or misappropriation) of electronically accessed information. Of course, the doctrine of federal pre-emption might block state legislative activity, but since *Feist*, it is arguable that factual and public domain material compilations are not protectible by federal copyright law and therefore the states may be free to act in those limited areas.

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[13] 111 S. Ct. 1282 (interim ed. 1991).