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CREATED FACTS AND THE FLAWED ONTOLOGY OF COPYRIGHT LAW

*Justin Hughes**

It is black letter doctrine that facts are not copyrightable: facts are discovered, not created—so they will always lack the originality needed for copyright protection. As straightforward as this reasoning seems, it is fundamentally flawed. Using the “social facts” theory of philosopher John Searle, this Article explores a variety of “created facts” cases—designation systems, systematic evaluations, and privately written laws—in which original expression from private individuals is adopted by social convention and generates facts in our social reality. In the course of this discussion, the paper places facts in their historical and philosophical context, explores how courts conflate facts with expressions of fact, and explains the difference between social facts created by expression and the “facts” of literature and fiction.

Having established that the copyrighted works discussed in these cases produce facts, the question arises whether copyright’s merger doctrine eliminates the copyright protection—a result that is both seemingly harsh and seemingly necessary. This Article proposes a recalibration of the merger doctrine to acknowledge that “created facts” are a unique situation in which the incentive of copyright is needed not just to generate the expression, but also needed to generate the facts.

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INTRODUCTION

The writ of copyright reaches all *original expression*, a phrase that contains the two principal boundaries of copyright’s realm. On one side, copyright law protects only expression, never ideas—no matter how imaginative those ideas are. On the other side, faithfully retype nineteenth-century poems to your heart’s content, but you will not get a copyright—because the expression you have produced is not original.

It is equally black letter law that facts are outside the realm of copyright because they similarly fail the originality requirement. As

the Supreme Court told us in the 1991 *Feist Publications, Inc. v. Rural Telephone Service Co.*¹ case, “facts do not owe their origin to an act of authorship”² and, therefore, they will always fail the minimal creativity requirement of copyright law. The unanimous *Feist* opinion says little as to the nature of facts, but it is clear that the Justices view a “fact” as something we discover, as something that might happen to us, not something that originates with us.³ A person might experience a fact; she does not create it.

The problem with the *Feist* analysis is that it is wrong—and that error has produced over a decade of distortion in copyright doctrine. *Feist* is wrong because many facts clearly owe their origin to discrete acts of human originality. These human-created facts function in the social discourse no differently than the temperature in downtown Chicago on a particular date or the frequency with which “Old Faithful” erupts in Yellowstone Park. Indeed, the facts most unimpeachably *discovered*—ice core depths in Antarctica, planets orbiting distant stars, new species of animals—are often less important to your daily life than many facts that are human-created—such as the credit rating that Equifax gives you or the valuation your insurer gives your car after an accident.

This Article explores the strange world of “created facts,” a world in which the expressive work brings the very facts themselves into existence. There are two incompatible characteristics of these situations: First, if the copyright incentive is needed to produce the expression, copyright is also needed for the facts to exist. Second, if the expression really produces facts, then one of copyright’s core principles—the “merger” doctrine—is likely to denude the expression of any protection. To avoid this second outcome, the discussion below proposes that we modestly amend how the merger doctrine works.

As an initial matter, Part I places facts in their historical and epistemological context, showing how copyright law—and the legal system generally—adheres to a view of facts that is out of sync with much philosophy and social theory. But accepting “facts” as an inevitable construct of the legal system, Part II then explores how facts can arise in social life, following the work of philosopher John Searle. Parts III, IV, and V turn to the case law that has been percolating around three kinds of facts created by original expression: when private individuals create expression which becomes law; when people create evaluations, judgments, or opinions that become widely accepted as true; and sim-

1 499 U.S. 340 (1991).

2 *Id.* at 347.

3 *Id.*

ply when people name things. We will see that until quite recently, courts have been unwilling to recognize that these original expressions produce “facts” because, per *Feist*, such recognition would largely destroy any copyright protection.

Different commentators have analyzed some of these cases in different ways. Lawrence Cunningham has discussed some of these cases as the integration of private expression into *public law*;⁴ Dennis Karjala has approached some of these cases recognizing the establishment of copyright over taxonomic systems;⁵ Pamela Samuelson has critiqued some of these cases as establishing copyright over standards;⁶ and I have separately criticized some of these cases for creating independent copyright protection over “microworks.”⁷ But the emphasis here is on the fact-creating characteristic of these expressive works. To that end, Part VI explores further how expressive works can produce “facts” as real—much more real for most of us—as the temperatures on the Martian surface or what we know happened from the fossil record.

Having established that the copyrighted works discussed in these cases produce facts, the question arises whether copyright’s merger doctrine eliminates the copyright protection—a result that is both seemingly harsh and seemingly necessary. Part VII considers fair use, implied licenses, and merger doctrines as limiting principles for copyright protection in such works. I propose a recalibration of the merger doctrine borrowing from antitrust’s “essential facilities” doctrine to produce a result that makes the created facts accessible without eliminating the copyright incentive that leads to the facts’ very creation.

I. *FEIST*, FACTS, AND EXPRESSIONS OF FACTS

The 1991 *Feist* case is now synonymous with the proposition that facts are outside the gamut of copyright protection. The defendant, Feist Publications, had sought to create a regional telephone directory for northwest Kansas.⁸ To that end, Feist had copied entries from Rural Telephone’s white pages telephone directory without authoriza-

4 Lawrence A. Cunningham, *Private Standards in Public Law: Copyright, Lawmaking and the Case of Accounting*, 104 MICH. L. REV. 291, 296–307 (2005).

5 Dennis S. Karjala, *Distinguishing Patent and Copyright Subject Matter*, 35 CONN. L. REV. 439, 495–500 (2003).

6 Pamela Samuelson, *Questioning Copyright in Standards*, 48 B.C. L. REV. 193, 196–203 (2007).

7 Justin Hughes, *Size Matters (or Should) in Copyright Law*, 74 FORDHAM L. REV. 575, 576–82, 591–616 (2005).

8 *Feist*, 499 U.S. at 340.

tion—over 1300 entries verbatim and an additional 3600 entries in part.⁹ Rural Telephone sued for copyright infringement.¹⁰

Interestingly, the word “fact” does not appear in the Court’s description of the disputants’ activities. The Court characterizes Rural as refusing “to license its listings,” tells us that Feist “verified the data reported by Rural,” and even describes its own action as “grant[ing] certiorari . . . to determine whether the copyright in Rural’s directory protects the names, towns, and telephone numbers copied by Feist.”¹¹ It is only when Justice O’Connor turns to doctrine—and the very moment she turns to doctrine—that we are told that the case involves the interaction of two fundamental propositions of copyright law: “The first is that facts are not copyrightable; the other, that compilations of facts generally are.”¹²

But what are these facts? Perhaps the only important thing the Court tells us about the nature of facts is that they are discovered, not created:

Facts do not owe their origin to an act of authorship. The distinction is one between creation and discovery: The first person to find and report a particular fact has not created the fact; he or she has merely discovered its existence. To borrow from *Burrow-Giles*, one who discovers a fact is not its “maker” or “originator.”¹³

Exemplary of how facts are discovered, the *Feist* Court described how “[c]ensus takers . . . do not ‘create’ the population figures that emerge from their efforts” because these facts are “figures from the world around them.”¹⁴ It follows that the one unifying characteristic of “all facts—scientific, historical, biographical, and news of the day” is that they “are not ‘original’ in the constitutional sense.”¹⁵ In other words, if facts are always discovered, then they always lack originality; if they always lack originality, then they are always beyond the ambit of copyright. This unanimous decision,¹⁶ cast at the constitutional level

9 *Id.* at 343.

10 *Id.*

11 *Id.* at 343–44.

12 *Id.* at 345.

13 *Id.* at 347 (citing *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 58 (1884)).

14 *Id.* Because “[f]acts are never original,” *id.* at 358, the *Feist* Court concluded that “[t]he only conceivable expression is the manner in which the compiler has selected and arranged the facts,” *id.* at 349.

15 *Id.* at 347–48.

16 See, e.g., Marci A. Hamilton, *Copyright at the Supreme Court: A Jurisprudence of Deference*, 47 J. COPYRIGHT SOC’Y U.S.A. 317, 321 (2000) (discussing the rarity of unanimous decisions in copyright).

when it could have been easily decided at the statutory level,¹⁷ had a powerful impact on copyright law, both here and abroad.

Philosophically, the Feistian view of facts as “out there,” waiting to be discovered (and capable of being discovered) is *realism*, a realism that is basic to our entire legal system.¹⁸ The view of facts laid out in *Feist* could be drawn right from criminal law, negligence doctrine, jury instructions, and the deference appellate courts have for triers of fact.¹⁹ Our legal system requires a notion of facts as having what Willard Van Orman Quine described as “unvarnished objectivity . . . a certain accessibility to observation . . . and the hint of bruteness.”²⁰ This is precisely what Los Angeles police Sgt. Joe Friday meant on *Dragnet* whenever he implored female witnesses to provide “just the facts, ma’am.”²¹ In just this spirit, the *Feist* Court understood “wholly factual information” to be “raw data.”²²

17 The Court could have achieved the same result at the statutory level, and much of Justice O’Connor’s opinion is devoted to the conclusion that purely factual works are not “original works” under the statute. *Feist*, 499 U.S. at 354–59. Some scholars identify 17 U.S.C. § 102(b)’s prohibition on copyright in “discoveries” as the prohibition on copyright in facts. See 1 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 2.11[A], at 2-178.9 (2007) (“The current Act has codified the rule precluding copyright in facts by providing that its protection does not extend to any ‘discovery.’”). But § 102(b)’s preclusion of any “discovery” from copyright protection may refer to patentable inventions, not facts. Justice O’Connor does not pin her statutory interpretation on the word “discovery,” but rather says only that “[s]ection 102(b) is universally understood to prohibit any copyright in facts.” *Feist*, 499 U.S. at 356.

18 Simon Blackburn describes realism as holding the view that statements describe the world; they answer to or represent (independent) facts of a particular kind These facts are discovered, not created, and they have their own ‘ontological’ and ‘metaphysical’ natures, about which reflection can inform us.

...

The facts or aspects of the world that make commitments true or false [are] ‘mind independent,’ or not of our own making.

SIMON BLACKBURN, TRUTH 117–18 (2005).

19 Cf., e.g., Orin S. Kerr, *Rethinking Patent Law in the Administrative State*, 42 WM. & MARY L. REV. 127, 145 (2000) (“Questions of fact describe the state of affairs in the world, such as the time of day when an event occurred or the temperature at a particular time in a particular place.”).

20 WILLARD VAN ORMAN QUINE, WORD AND OBJECT 247 (1960). In this common understanding of facts, “facts . . . make sentences true.” *Id.* Simon Blackburn characterizes this as the “absolutist” view of truth—which seems a good characterization of that for which law aims. BLACKBURN, *supra* note 18 at xv. Of it, he says, “We like plain, unvarnished objective fact, and we like it open, transparent, and unfiltered.” *Id.*

21 *Dragnet* (NBC television broadcast 1951–59, 1967–70).

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

A. *A Very Short History of Facts*

Our judicial system's foundation on factfinding is a reflection of the long development of the fact in science, commerce, and public policy. Scholars have studied how late seventeenth- and then eighteenth-century thinkers sought to emphasize the need for observational particulars, for separating theory from the collection of observational data, and for privileging these "facts" until they became, in Mary Poovey's apt description, "the epistemological unit that organizes most of the knowledge projects of the past four centuries."²³ At the beginning of this historical path, the fact or "factum" simply meant an "event or occurrence," particularly one whose truth had been established by observation.²⁴

This observable fact that is "out there" became foundational for empiricism, for the kind of public policy debates that took hold in the West in the eighteenth century, and, arguably, for democratic self-governance itself. This is because cleaving observed particulars from (apparently more) theoretical arguments allowed learned men to agree on something, while they disagreed strenuously on issues of theory, method, ideology, or policy.²⁵ As one philosopher turned reasoning entrepreneur commented recently at a conference on the presentation of evidence, "[e]very argument bottoms out with some-

23 MARY POOVEY, *THE HISTORY OF THE MODERN FACT* xiii (1998); see also PETER DEAR, *DISCIPLINE AND EXPERIENCE* 1 (1995) ("The cultural and intellectual prerequisites for the nineteenth-century explosion of organized science were the operational ideal, which made the world into something to be mastered, and a quantitative epistemology, which held that such an ideal exhausted everything accessible to human knowing."); Lorraine Daston, *Baconian Facts, Academic Civility, and the Prehistory of Objectivity*, 8 *ANNALS OF SCHOLARSHIP* 337, 338 (1991) [hereinafter, Daston, *Baconian Facts*] ("Facts came to be detached from the context of theory and observation because of anomalies of all sorts preoccupied late Renaissance natural philosophers."); Lorraine Daston, *Objectivity and the Escape from Perspective*, 22 *SOC. STUD. SCI.* 597, 600 (1992) ("[A]perspectival objectivity first made its appearance . . . in the moral and aesthetic philosophy of the latter half of the eighteenth century."). Poovey refers to this scholarship as "historical epistemology," *supra*, at 7.

24 Mary Poovey argues that in the seventeenth and early eighteenth centuries, there were different "epistemological units called 'a fact'" and that "natural *historians* . . . did collect deracinated particulars . . . for whom *factum* retained its old connotations of 'event or occurrence,' 'a particular truth known by actual observation' . . ." POOVEY, *supra* note 23, at 9 (quoting 5 *THE OXFORD ENGLISH DICTIONARY* 651 (2d ed. 1989)).

25 *Id.* at 111 (noting that seventeenth and eighteenth century English writers and scholars argued that facts were separable "from both theory and method *in order to decrease the likelihood of civil dispute*"); see also HANNAH ARENDT, *BETWEEN PAST AND FUTURE* 259–60 (1968) (describing how the "fact-finder"—witness or reporter—needs to be outside the community debating issues and differing in opinions).

thing that is not argumentative . . . with a nonargumentative move.”²⁶ Those nonargumentative moves are typically appeals to agreed-upon facts.

In the view of Poovey and historian Lorraine Daston, this use of observed particulars as the support structure for theories and generalizations became the distinguishing epistemic characteristic of science and public policy from the eighteenth century onward. For Daston, the rise of empiricism created a situation in which the fact—as a “deracinated particular”—was elevated to the status of “the indubitable core of knowledge, more ‘certain and immutable’ than axioms and syllogistic demonstrations.”²⁷ The *Feist* Court’s mention of census data²⁸ echoes how very much American culture, from its inception, embraced the notion of facts as gathered observations of the disinterested. For example, by the time Thomas Malthus was preparing the second edition of his *Essay on the Principle of Population* in 1803, a very large chunk of his statistical source materials came from the United States.²⁹ Embodying the thinking of his time, Max Weber considered a “sharp fact/value dichotomy as something inseparable from modern scientific sophistication.”³⁰ In the early twentieth century, Walter

26 Tim van Gelder, Remarks at the Graphic and Visual Representations of Evidence and Inference in Legal Settings Conference, Cardozo School of Law (Jan. 28, 2007).

27 Daston, *Baconian Facts*, *supra* note 23, at 345. The struggle between pure theorists and the new, empirically-based science epitomized by Bacon and the Royal Society, was a powerful intellectual theme of the seventeenth century. See generally MARGARET GULLAN-WHUR, *WITHIN REASON* 115–18 (2000) (detailing controversies among Bacon, the Royal Society, mechanical philosophers, Henry Oldenburg, and Spinoza on scientific work and debate).

28 *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 347 (1991).

29 The first edition of the book appeared in 1798 and was substantially revised with extensive empirical information for later editions. See THOMAS ROBERT MALTHUS, *Essay on Population: Godwin on Malthus* (1821), reprinted in 4 *THE WORKS OF THOMAS ROBERT MALTHUS*, at 165–69 (E.A. Wrigley & David Souden eds., William Pickering 1986). The American statistical material in the later edition included Adam Seybert’s *Statistical Annals of the United States*, John Bristed’s *America and Her Resources*, and the American *National Calendar*. POOVEY, *supra* note 23, at 290. The Seybert material was the U.S. Census. ADAM SEYBERT, *STATISTICAL ANNALS* 15–53 (Philadelphia, Thomas Dobson & Son 1818). Seybert, a Pennsylvania Congressman, looked at the 120 official volumes of census data published by Congress and concluded that the data was “too much diffused to be made the subjects of immediate reference.” SEYBERT, *supra*, at vi. In a civic-minded, albeit private, capacity, Seybert then published *Statistical Annals*. In comparison to America’s focus on statistically understanding its New World, the British did not conduct their first national census until 1801. POOVEY, *supra* note 23, at 291.

30 Hilary Putnam, *Are Moral and Legal Values Made or Discovered?*, in 1 *LEGAL THEORY* 5, 12 (1995); see also, e.g., Max Weber, *Science as a Vocation*, in *THE VOCATION*

Lippmann noted how news—the facts of the day—“‘comes from a distance’”³¹ and from beyond one’s own “‘self-contained community,’”³² thereby providing a basis for public debate. Indeed, one of the most fundamental critiques of the George W. Bush administration has been its “assault on reason” in which the Bush “team seemed to approach every question of fact as a partisan fight to the finish.”³³

The fact as the foundation of modern empiricism was closely aligned with David Hume’s “pictorial semantics” view of facts—facts are things people can see and of which they can form clear, mental pictures.³⁴ This Humean view was the ancestor of twentieth-century logical positivism³⁵ and scientific realism.³⁶ Broadly understood, most of us adhere most of the time to this “extra-lingual” or “mind-independent” view of facts, at least to the degree that there is *something* out there to which an expression of fact corresponds. In this “correspondence theory,” true statements are statements which correspond to

LECTURES I, 21 (David Owen & Tracy B. Strong eds., Rodney Livingstone trans., 2004) (“I am willing to demonstrate from the writings of our historians that whenever an academic introduces his own value judgment, a complete understanding of the facts comes to an end.”).

31 Robert C. Post, *The Constitutional Concept of Public Discourse: Outrageous Opinion, Democratic Deliberations and Hustler Magazine v. Falwell*, 103 HARV. L. REV. 603, 635 (1990) (quoting WALTER LIPPMANN, LIBERTY AND THE NEWS 38 (1920); WALTER LIPPMANN, PUBLIC OPINIONS 263–75 (1922)).

32 *Id.*

33 AL GORE, THE ASSAULT ON REASON 56 (2007). Former Vice President Gore argues that “[t]he Bush administration has demonstrated contempt for the basic tenets of a rational decision-making process, defined as one in which an honest emphasis is placed on getting good facts and then letting good facts drive decisions.” *Id.* at 62.

34 See, e.g., HILARY PUTNAM, THE COLLAPSE OF THE FACT/VALUE DICHOTOMY AND OTHER ESSAYS 15 (2002).

35 For Rudolph Carnap a “fact” could be established by observation of the physical world only. RUDOLF CARNAP, THE LOGICAL CONSTRUCTION OF THE WORLD (Rolf A. George trans., 2d ed. 1967); see also Rudolf Carnap, *Testability and Meaning*, in THEORIES AND OBSERVATION IN SCIENCE 27, 43 (Richard E. Grandy ed., 1973) (“As empiricists . . . we require that descriptive predicates and hence synthetic sentences are not to be admitted unless they have some connection with possible observations . . .”). This position had to be modified quickly to account for atomic theory and modern (pre-quantum) physics. See CARNAP, THE LOGICAL CONSTRUCTION OF THE WORLD, *supra*, at viii–ix.

36 For example, Michael Devitt defines “scientific realism” as holding that “[m]ost of the essential unobservables of well-established current scientific theories exist mind-independently and mostly have the properties attributed to them by science.” Michael Devitt, *Scientific Realism*, in THE OXFORD HANDBOOK OF CONTEMPORARY PHILOSOPHY 767, 769 (Frank Jackson & Michael Smith eds., 2005).

real world facts; facts are states of the world.³⁷ “Santa Claus lives at the North Pole” is not a true statement because it does not correspond to any fact (state of the world), but “Santa Claus is commonly depicted as living at the North Pole” is a true statement of fact because it corresponds to the contents of innumerable films, books, and holiday displays.

B. *A World(view) Without Facts*

This neat worldview was always subject to doubt and caveat, but came under increasing attack in the twentieth century. While a law review article is not the place to review these schools of thought, a general sense of the intellectual topography helps place copyright’s ontology in context.

A main line of critique has been against the fact/value distinction itself, i.e., to question whether there are any facts (or truths) independent of our theories. As Hilary Putnam puts it, “Perception is not innocent; it is an exercise of our concepts,”³⁸ or as Jose Ortega y Gasset wrote, “Reality is not a datum, not something given or bestowed, but a construction which man makes out of the given material.”³⁹ Rooted at least as far back as Francis Bacon,⁴⁰ this rich, arguably dominant, body of twentieth-century philosophy and social science concluded, in one way or another, that facts are not pebbles waiting to be picked up; the size and shape of the pieces of reality we see are just the result of how we hammer and chisel the world.⁴¹ As Thomas

37 See, e.g., ROBERT NOZICK, *THE NATURE OF RATIONALITY* 107–14 (1993); JOHN R. SEARLE, *THE CONSTRUCTION OF SOCIAL REALITY* 199–226 (1995); see also BLACKBURN, *supra* note 18, at 56 (“This is the idea that truth can be understood and explained in terms of correspondence with the facts. It is not merely the idea that ‘true’ means ‘corresponds with the facts’; this may be a harmless synonym. . . . But for the phrase to work as a philosophical explanation of truth, more is needed. It is needed that ‘corresponds’ means something on its own, and ‘facts’ are identifiable in some special way, and then we can put them together and see correspondence with the facts as a special kinds of success.”); E.J. LOWE, *Fact*, in *THE OXFORD COMPANION TO PHILOSOPHY* 287 (Ted Honderich ed., 2d ed. 2005) (“A fact is, traditionally, the worldly correlate of a true proposition, a state of affairs whose obtaining makes that proposition true.”).

38 PUTNAM, *supra* note 34, at 102.

39 JOSE ORTEGA Y GASSET, *MAN AND CRISIS* 13 (Mildred Adams trans., 1958).

40 FRANCIS BACON, *THE NEW ORGANON*, bk. I, aphorism XLI, at 41 (Lisa Jardine & Michael Silverthorne eds., 2000) (“The human understanding is like an uneven mirror receiving rays from things and merging its own nature with the nature of things, which thus distorts and corrupts it.”).

41 Just a small sample of thinkers along these lines include WILLIAM JAMES, *The Will to Believe and Other Essays in Popular Philosophy*, in *WRITINGS* 445, 466 (Gerald E. Myers ed., Library of America 1992) (1987) (“Objective evidence and certitude are doubtless very fine ideals to play with, but where on this moonlit and dream-visited

Kuhn noted, a “fact” which does not fit the current scientific theory does not count as a fact at all: it is a mistake or an anomaly until our theory is adjusted to deal with it.⁴²

Of course, all this sits quite uncomfortably with the law’s reliance on “facts” and, yet again, *Feist* provides a simple example whose complexity was overlooked by the Court. When census workers gather information on literacy, occupations, and incomes of respondents, these are facts created by humans in the regular course of living—and “discovered” subsequently by other humans. But when the census enumerators start compiling facts about race, things become murkier. The abiding debates about census racial categories show that racial facts are very much constructed by our judgments about categories.⁴³

planet are they found?”); 1 RICHARD RORTY, OBJECTIVITY, RELATIVISM, AND TRUTH 141 (1991) (“If the truth *itself* is to be an explanation of something, that explanandum must be of something which can be caused by truth, but not caused by the content of true beliefs.”); RICHARD RORTY, PHILOSOPHY AND THE MIRROR OF NATURE 364 (1979) (noting that the distinction between facts and values is “disastrous” because it “forces us to pretend that we can split ourselves up into knowers of true sentences on the one hand and choosers of lives or actions or works of art on the other”) [hereinafter RORTY, PHILOSOPHY]; R.W. SLEEPER, THE NECESSITY OF PRAGMATISM 141 (1986) (arguing that John Dewey followed William James to seek “to demonstrate that there is no conceptually valid basis for the disjunction between factual judgment and value judgment”). Other attacks on the fact/value distinction have come from MARTIN HEIDEGGER, BEING AND TIME 133 (Joan Stambaugh trans., State University of New York Press 1996) (1953) and JEAN-PAUL SARTRE, BEING AND NOTHINGNESS 71–78, 147–55 (Hazel E. Barnes trans., 1956). Wittgenstein’s own views were so subtle or ambiguous that he can sometimes be claimed by realists and sometimes by truth relativists. See BLACKBURN, *supra* note 18, at xix, 129–33.

42 THOMAS S. KUHN, THE STRUCTURE OF SCIENTIFIC REVOLUTIONS 53 (3d ed. 1996) (“Assimilating a new sort of fact demands a more than additive adjustment of theory, and until that adjustment is completed—until the scientist has learned to see nature in a different way—the new fact is not quite a scientific fact at all.”). To be fair, Kuhn is giving an example where the observation of *X* occurs and we have to make adjustments to conclude *X* is a fact, KUHN, *supra*, at 53–58, while Rorty, Putnam, and others describe the observation occurring or not occurring because of the perceptual tools with which we have equipped ourselves, RORTY, PHILOSOPHY, *supra*, note 41, at 306–11; Putnam, *supra* note 30, at 12–16.

43 Over the history of the census, it has offered at least twenty-six different racial or ethnic characterizations for respondents. In recent times, the process left many people feeling that they were pigeonholed, i.e., that their racial status (the actual reality about their race) was not accurately captured. See Agustin Gurza, *In Search of a Census Pigeonhole*, L.A. TIMES, July 6, 1999, at B10; Orlando Patterson, *America’s Worst Idea*, N.Y. TIMES BOOK REV., Oct. 22, 2000, at 15 (reviewing SCOTT MALCOMSON, ONE DROP OF BLOOD (2000) and noting that “the nation’s Census Bureau has had such a thoroughly bizarre history of racial categorization that recently, out of sheer conceptual and political exhaustion, it gave up and asked people to classify themselves in any and as many racial ways as the spirit moved them”); see also Steven A. Holmes, *The*

Similarly, when the 1920 Census reported that 51.2% of the American population was living in urban areas,⁴⁴ it sounds like a pretty hard-boiled fact until you learn that the Census Bureau decided that anyone in a town with over 2500 inhabitants was a “city” dweller⁴⁵—an evaluation quite different from what we might make today.

C. Another World(view) Without Facts

In a more radical contrast to the traditional correspondence theory, a number of twentieth-century philosophers have reasoned that facts are *only* linguistic elements or propositional elements⁴⁶ and that our notion of a “fact” should be reduced to that of a true statement (and effectively eliminated). As Quine succinctly observed, “In ordinary usage ‘fact’ often occurs where we could without loss say ‘true sentence’ or . . . ‘true proposition.’”⁴⁷ The reduction of “facts” to true statements led many philosophers to conclude that the nature of facts is an ancillary issue—if an issue at all—for inquiries into the nature of truth and knowledge.⁴⁸ As Colin McGinn writes of his own epistemo-

Confusion over Who We Are, N.Y. TIMES, June 3, 2001, § 4, at 1 (describing issues surrounding racial categories on census).

44 Helen B. Shaffer, *Population Profile of the United States*, in EDITORIAL RESEARCH REPORTS ON THE URBAN ENVIRONMENT 1, 12 (Richard M. Boeckel & William B. Dickinson eds., Congressional Quarterly, Inc. 1969) (“The 1920 census was first to tip the balance with 51.2 per cent counted as city dwellers.”).

45 MARGO J. ANDERSON, *THE AMERICAN CENSUS* 134 (1988).

46 For example, in the 1950s, P.F. Strawson advanced the view that “facts” were linguistic elements. Strawson thought that in order to specify a fact—in order to answer the question “which fact?”—one would have to have a true statement already. P.F. Strawson, *Truth*, 34 PROC. ARISTOTELIAN SOC’Y 129, 134 (1950). Strawson believed that facts were linguistic in that “[f]acts are what statements (when true) state; they are not what statements are about.” *Id.* at 136.

47 QUINE, *supra* note 20, at 247. Of course, for many philosophers a “true sentence” and a “true proposition” differ in that propositions are nonlinguistic entities expressed by sentences. See, e.g., Michael Dummett, *Truth*, in PHILOSOPHICAL LOGIC 49, 50 (P.F. Strawson ed., 1967). In that view, “it rains” and “*il pleut*” express the same proposition. Frege held to a view of this sort, defining a fact as “a thought [*gedanke*] that is true.” Gottlob Frege, *The Thought: A Logical Inquiry*, in PHILOSOPHICAL LOGIC, *supra*, at 17, 35. Here *gedanke* seems to mean proposition, not a mental state—a point that Frege clarifies later on the page. *Id.* My thanks to David Dolinko for this clarification.

48 See, e.g., LAURENCE BONJOUR, *THE STRUCTURE OF EMPIRICAL KNOWLEDGE* 87–89 (1985) (dealing very little with “facts” in its analysis of knowledge); QUINE, *supra* note 20, *passim*; see also WILLARD VAN ORMAN QUINE, *QUIDDITIES* 3–5, 213 (1987) [hereinafter QUINE, *QUIDDITIES*] (“The world is full of things, variously related, but what, in addition to all that, are facts? . . . The sentence ‘Snow is white’ is true if and only if it is a fact that snow is white. Now we have worked the fact, factitious fiction that it is, into a corner where we can deal it the coup de grace. The combination ‘it is a fact

logical views, “To explain the concept of truth we therefore do not need to appeal to obscure relations of correspondence and dubious entities called facts.”⁴⁹

D. *What Courts Say About Facts and Expressions of Facts*

Among these three possibilities—facts being “out there,” facts arising from subjective perspectives, and facts being nothing more than true statements—it seems pretty clear that the legal system adheres to a correspondence theory: the facts are out there, quite separate from subjective viewpoints. When we speak of a jury being charged with “finding” the facts, we mean that the jury makes determinations about prior states of the world “mind-independent” of the jurors themselves.⁵⁰ When practicing law or thinking about the legal system, perhaps we are, in Felix Cohen’s phrase, “prisoners of common sense, which is usually the metaphysics of 500 years back.”⁵¹

And yet if lawyers, judges, and jurors hold to a correspondence theory of facts, there is a certain lack of rigor in any judicial pronouncement that “facts are not copyrightable,”⁵² that “there can be no valid copyright in facts,”⁵³ or that “[n]o author may copyright . . . the facts he narrates.”⁵⁴ If a fact is “out there” in the world, then quite typically it is not “fixed in [a] tangible medium.”⁵⁵ That it rained in Chicago last night, that Ella Fitzgerald played a concert at Deutschlandhalle, Berlin on February 13, 1960,⁵⁶ that you said “I love you” to someone yesterday—none of these facts “out there” are fixed at all.

that’ is vacuous and can be dropped; ‘It is a fact that snow is white’ reduces to ‘Snow is white.’”).

49 COLIN MCGINN, *THE MAKING OF A PHILOSOPHER* 93 (2003).

50 Defamation and negligent misrepresentation are bodies of law that also run on a fact/opinion distinction. As limited by our First Amendment jurisprudence, there is no defamation liability if one makes “a general statement of opinion, not a positive assertion of fact.” *Gentry v. eBay, Inc.*, 121 Cal. Rptr. 2d 703, 718 (Cal. Ct. App. 2002); see also *Ollman v. Evans*, 750 F.2d 970, 979 (D.C. Cir. 1984) (establishing a four-part test for distinguishing factual assertions from statements of opinion in defamation cases). Under the common law, statements of opinion could be grounds for defamation, but over time a “fair comment” privilege arose to protect public debate. See RESTATEMENT (SECOND) OF TORTS § 566 cmt. a (1977).

51 Felix S. Cohen, *Dialogue on Private Property*, 9 RUTGERS L. REV. 357, 361 (1954).

52 *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 344 (1991).

53 *Id.*

54 *Id.* at 345 (quoting *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 556 (1985)).

55 17 U.S.C. § 102(a) (2000).

56 ELLA FITZGERALD, *MACK THE KNIFE—THE COMPLETE ELLA IN BERLIN* (Verve Records 1960).

There may be fixed, historical recordations of the facts, but it is not the recordations which make the facts facts. That the wingspan of a Boeing 767-400 aircraft is 51.9 meters⁵⁷ or that the Todaiji temple in Nara, Japan is the largest wood structure in the world⁵⁸ are facts that are “fixed” in a sense, although not as traditionally understood in copyright law. In other words, if facts are out there, then broadly speaking, they are not even in the ballpark of copyright.

By the lights of the correspondence theory, what judges and legal scholars are actually discussing are *representations* or *statements* of facts. Occasionally, judicial opinions capture this point precisely. Thus, Judge Roney on the Fifth Circuit wrote that “[i]t is well settled that copyright protection extends only to the author’s *expression of facts* and not to the *facts* themselves,”⁵⁹ and Judge Easterbrook on the Seventh Circuit noted that “core equations, such as the famous $E=MC^2$, *express* ‘facts.’”⁶⁰

On the other hand, when a distinguished judge or scholar just says *facts* are not protected by copyright law, he or she is engaged in a form of shorthand that is more than just imprecision. It is a subconscious application of copyright’s merger doctrine. With most ideas, there seems to be many ways to express each idea, so that cleaving expression and idea is relatively easy. But facts are a different matter. Cleaving the fact and its expression is not so easy because “generally speaking, there are few ways of depicting, rendering, or expressing facts.”⁶¹ This is particularly true with quantitative conclusions. With any fact or idea expressed in Hindu-Arabic numbers, the idea or fact seems inextricably “merged” with its expression because there is no other reasonable way to express the idea/fact.⁶²

57 Boeing, 767 Family: Technical Characteristics, Boeing 767-400ER, http://www.boeing.com/commercial/767family/pf/pf_400prod.html (last visited Oct. 22, 2007).

58 See, e.g., BETH REIBER & JANIE SPENCER, FROMMER’S JAPAN 6 (8th ed. 2006).

59 Miller v. Universal City Studios, Inc., 650 F.2d 1365, 1368 (5th Cir. 1981) (emphasis added); see also Feist, 499 U.S. at 348 (“Others may copy the underlying facts from [a] publication, but not the precise words used to present them.”).

60 Am. Dental Ass’n v. Delta Dental Plans Ass’n, 126 F.3d 977, 979 (7th Cir. 1997) (emphasis added).

61 Skinder-Strauss Assocs. v. Mass. Continuing Legal Educ., Inc., 914 F. Supp. 665, 672–73 (D. Mass. 1995).

62 At least not in this time and culture. See ALFRED W. CROSBY, THE MEASURE OF REALITY 115 (1997) (describing the gradual triumph of Hindu-Arabic numbers over Roman numbers as western European societies became increasingly sophisticated in mathematics and commerce); CHARLES SEIFE, ZERO 67–81 (2000) (same). Of course, as discussed above, in a few cases the idea and its expression in Hindu-Arabic numbers seem *less* merged, i.e., where a temperature can be expressed in Fahrenheit or

Loose discussion that “facts” are not protected by copyright inadvertently points to the “tightness” between facts (out there) and the expression of facts. Consider this statement from *Feist*:

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. . . . Where the compilation author adds no written expression but rather lets the facts speak for themselves, the expressive element is more elusive.⁶³

Under this standard, when I write, “*That first morning in February on Park Avenue, the temperature nudged just above freezing and stuck there,*” I have “clothed” a fact in protectable “expression.” But imagine my journal instead showing the following: Feb. 1, 2004, morning—Park Avenue—33° F. For Justice O’Connor, the expressive element here is “elusive.” But it is not elusive at all. There is “expression”—words fixed on paper—unoriginal, but expression nonetheless. The tightness between fact and statement of fact is summarized well by John Searle: “Because statements determine their own truth conditions and because the term ‘fact’ refers to that in virtue of which statements are true, the canonical way to specify the fact is the same as the way to specify the statement, by stating it.”⁶⁴

If we substitute the copyright term “expression” for the philosopher’s “statement,” we have a succinct rendering of the problem in copyright law: the canonical way to specify the fact is the same as the way to specify the expression of the fact, i.e., by expressing it.

II. HUMAN FACTS—HISTORICAL, SOCIAL, CREATED

The *Feist* characterization of facts fits well with the geographic facts explorers discovered when mapping the coast of the New World or with the when and where a particular animal died (leaving behind fossil remains).⁶⁵ These are features of the world that are “*intrinsic* to

Centigrade (or Kelvin); where the Super Bowl designation is common in either Roman or Hindu-Arabic numbers. In the musical *The Hidden Sky*, in a future society the few allowed to learn mathematics at all are forced to use Roman numbers but secretly learn and practice the dark art of Hindu-Arabic numbers. Videotape: *The Hidden Sky* (Prince Music Theater 2000) (based on URSULA K. LE GUIN, *The Masters, in THE WIND’S TWELVE QUARTERS* 41 (1975)).

63 *Feist*, 499 U.S. at 348–49.

64 SEARLE, *supra* note 37, at 219.

65 For discussions of the fossil record, see generally STEPHEN JAY GOULD, *Wonderful Life* 64–79 (1989) (describing the setting of the Burgess Shale); SIMON CONWAY MORRIS, *The Crucible of Creation* 53–56 (1998) (discussing the development of a

nature.”⁶⁶ Contrast these with the height of the Chrysler Building or a Mayan temple, the itinerary of a political candidate or of a soccer mom—these facts are the result of human agency. Among such “human facts,” some facts result from the cumulative, uncoordinated actions of humans (the population of Los Angeles on July 4, 2007) and some result from the intentional actions of individual people or coordinated groups of people (those who wrote the script for the film *L.A. Confidential*). For either kinds of human fact, some seem to become permanent, independent features of the world. As Lawrence Friedman writes, “No doubt the average person in France or Italy thinks there is something quite specific about French or Italian nationality; that these are clear-cut categories of the world, as real as mountains and rivers; and that somehow the nation was always meant to be.”⁶⁷ Of course, divisions among nationalities are facts created by all kinds of human interactions over years. On the other hand, street names and street addresses are facts created by an identifiable individual or individuals. As Wendy Gordon writes, “[O]ne’s address does not cease to be a fact upon a showing that the name of one’s street originated in the fancy of a housing developer.”⁶⁸

This immediately puts us in a position to see how things are much more complicated than the *Feist* opinion suggests. With street addresses collected in the census, some human(s) create the facts and another human collects them—there is both creation and “discovery.” And when a local telephone company publishes a telephone directory, it collects some human facts that pre-existed (customer names) and other facts that it itself created (the phone numbers). The person who is publishing the expressions of the telephone number facts seems to be the same person who “created” those facts.⁶⁹ The same

hypothesis for the evolution of ancient worms from the fossil record in Burgess Shale).

66 SEARLE, *supra* note 37, at 9.

67 LAWRENCE FRIEDMAN, *THE HORIZONTAL SOCIETY* 82–83 (1999).

68 Wendy J. Gordon, *On Owning Information: Intellectual Property and the Restitutory Impulse*, 78 VA. L. REV. 149, 154 n.21 (1992). The mini-taxonomy of facts in these paragraphs does not correspond to the classic distinctions that have been developed in philosophy, such as the concept of a “brute fact” or a “social fact.” For the classic formulation of the former, see generally G.E.M. Anscombe, *On Brute Facts*, 18 ANALYSIS 69 (1958). A “brute fact” is also used more generally to describe “the terminus of a series of explanations” that is itself not further reducible. John Haldane, *Brute Fact*, in *THE OXFORD COMPANION TO PHILOSOPHY*, *supra* note 37, at 111, 111. For a classic theory of social facts separate from Searle, see EMILE DURKHEIM, *THE RULES OF SOCIOLOGICAL METHOD* 50–60 (Steven Lukes ed., W.D. Halls trans., 1982).

69 At least for those local service customers whose telephone companies print their own telephone books. The process of creating the number may, of course, still

could even be said of what our legal system calls “mixed questions of law and fact,” i.e., where the raw facts are admitted (the car plowed into the storefront; *X* was driving the car) and “the issue is whether the facts satisfy the statutory standard”⁷⁰ (*X* was negligent). When the court makes such a determination and certifies its opinion for publication, the entity publishing the expression (the opinion) is the same person who “created” the fact (*X* was negligent).

A. *The “Created Fact” as a Kind of Human Fact*

Still this does not yet focus on the “created fact” problem. For one thing, the telephone company probably created the telephone number well before it published the expression of the telephone number. For another thing, the telephone company would have created the telephone numbers even if there was to be no telephone book; telephone numbers are necessary for telephone switching equipment to work. Unlisted telephone numbers are created—and are “facts”—even if they are never expressed.

So, let us draw one further distinction. Most human facts are “side effects” of human activity—as in the Ella Fitzgerald concert, “I love you,” and Los Angeles population examples. Contrast this with human facts that result from an act that was the *intentional creation of information qua information* through the *intentional creation of expression qua expression*. I will call these “created facts” or “authored facts.”⁷¹ For example, computer modeling and simulation now generate much of our social science and public policy data. Numbers for current population, traffic flows, or economic levels are treated as facts although they are often numbers extrapolated from sampling (real Feistian observational facts) combined with human guesses/judgments/opinions.⁷² Complex computer simulations that provide esti-

lack originality. See David Nimmer, *Copyright in the Dead Sea Scrolls: Authorship and Originality*, 38 HOUS. L. REV. 1, 97–98 (2001) (noting that the telephone numbers were not antecedent facts, but still can lack originality).

⁷⁰ *Pullman-Standard v. Swint*, 456 U.S. 273, 289 n.19 (1982).

⁷¹ Thus, this is a much narrower idea than Wendy Gordon’s use of the phrase “created fact” to refer to facts related to human-created artifacts. See Wendy J. Gordon, *Reality as Artifact: From Feist to Fair Use*, 55 LAW & CONTEMP. PROBS. 93, 98–100 (Spring 1992).

⁷² An example of this is the “Transportation Analysis Simulation System” (TRANSIMS) developed at Los Alamos National Laboratory. TRANSIMS “extrapolates US Census data to create a synthetic population, which is assigned activities—such as driving to work—based on diaries kept by selected residents of the studied area. TRANSIMS then factors in transit-system constraints and simulates traffic flow . . .” *Verge*, WIRE, Jan. 2001, at 236, 236; see also Gina Kolata, *Why Some Numbers Are Only Very Good*

mates of prehistoric animal migration patterns or dispersal patterns for explosive devices that have never been constructed give us datapoints that are “created,” but which we treat as facts.⁷³ But created facts need not be so esoteric, as we will see in Parts III, IV, and V.

B. *Facts, Values, and Social Reality*

The “factness” of the original expression at issue in the copyright cases discussed below comports with John Searle’s broader project of showing how social reality relates to the rest of reality, i.e., how some facts arise from human agreement.⁷⁴ Searle’s basic thesis is that “there are portions of the real world, *objective facts in the world*, that are only facts by human agreement.”⁷⁵ Searle analyzes this human agreement, i.e., the establishment of social conventions, as what he calls “collective intentionality.”⁷⁶

Institutions, occupations, membership in groups, our particular jobs, our familial relations and status are all established by social conventions which require representations, language, and—almost always—fixed expressions. A basic characteristic of these “social facts” is that they are language dependent (for our purposes, we could say “expression dependent”). In Searle’s proposal, a social fact depends on mental representations which, in turn, require expressive communication among persons. As Searle notes, “[M]arriages and money, unlike mountains and atoms, do not exist independently of *all* representations.”⁷⁷ The representations (or expressions) constitute communication among people; when that communication leads to collective acceptance of the new, additional reality, we have a “social fact.”⁷⁸ Thus, Searle’s overall project is to show how additional, human-created, intention-laden reality gets overlaid on top of “brute” reality, producing different sorts of facts through social agreement. Those commonly accepted facts are distinct from all the beliefs, theo-

Guesses, N.Y. TIMES, Mar. 11, 2001, § 4, at WK5 (describing the reason for the estimating process in census).

⁷³ Poovey makes a similar observation and calls such datapoints “a post-modern variant of the fact.” POOVEY, *supra* note 23, at 2–3.

⁷⁴ SEARLE, *supra* note 37, at 1–6; JOHN R. SEARLE, *SPEECH ACTS*, 50–53 (1969) [hereinafter SEARLE, *SPEECH ACTS*].

⁷⁵ SEARLE, *supra* note 37, at 1 (emphasis added).

⁷⁶ *Id.* at 26, 122.

⁷⁷ *Id.* at 190. For Searle, “a fact is language independent if that very fact requires no linguistic elements for its existence.” *Id.* at 61.

⁷⁸ *See id.* at 111 (describing the “primitive logical operation” by which institutional reality is created).

ries, opinions, and ideas on which we differ *and we know we differ*.⁷⁹ This distinction between such “facts” and opinions is commonplace, but as Robert Post says in the context of defamation law, “it is also deeply obscure, and it has proved resistant to most analytic attempts at clarification.”⁸⁰ More or less unnoticed, this is a deep and fundamental problem in the series of cases we now consider.

III. THE PROTECTION OF NAMING FACTS

When an individual or group gives a name to something—and that name sticks—we have perhaps the most basic of social facts. When Augustine and Mary Ball Washington named their first child “George,”⁸¹ when Spanish settlers called their encampment “El Pueblo de Nuestra Señora la Reyna de los Angeles del Rio Porciuncula” (shortened by an early tourist board to Los Angeles), or when an Apple researcher dubbed one of their projects “Carl Sagan,”⁸² each of these acts produced a social fact. These acts of naming can have great importance (as in Malvinas versus Falklands or with new corporate names like Verizon or Exxon).⁸³

In the face of this importance, copyright law has a long-standing rule that “[w]ords and short phrases such as names, titles, and slogans” are not copyrightable.⁸⁴ Elsewhere, I have discussed reasons for this bar, including how adequate incentives for these short expressions are already provided by markets, law (trademark law), and

79 This connects nicely with Robert Post’s argument that a public discourse of the kind protected by the First Amendment is characterized by discourse across ethnic, religious, and social communities which requires agreement on certain things, but not all things. “The conduct of public discourse,” Post wrote, “requires persons to share standards, but not the kind of standards that fuse them into a [single] community.” Post, *supra* note 31, at 636. Post further makes a persuasive argument that “facts” as the Court has described them in defamation law are things on which we can *expect* agreement or “convergence.” *Id.* at 657–58.

80 *Id.* at 649–50.

81 See, e.g., JOSEPH J. ELLIS, *HIS EXCELLENCY* 7–8 (2005).

82 See *Sagan v. Apple Computer, Inc.*, 874 F. Supp. 1072, 1074 (C.D. Cal. 1994) (describing how Apple had allegedly given a development project the internal name “Carl Sagan,” but when this fact was publicized Sagan demanded his name not be used; Apple technicians changed the project’s code name to “Butt-Head Astronomer”).

83 Or as experienced by the character in Johnny Cash’s 1968 classic “A Boy Named Sue.” JOHNNY CASH, *AT FOLSOM PRISON* (Columbia Records 1968).

84 37 C.F.R. § 202.1(a) (2007) (indicating that “[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” are not copyrightable).

noneconomic motives.⁸⁵ But another ground to justify the bar on copyrighted names and titles' is that they function as social facts in which the fact and expression are always merged. You cannot say "X is called Y" without expressing Y. And having names for things—both general and proper names—is fundamental to communicating any other facts.⁸⁶ To name something is to establish a fact,⁸⁷ and yet there is no sensible way to argue that these are acts of "discovery" unless we are prepared to reduce all creativity to an act of discovery.⁸⁸

If you cannot copyright "THX-1138" as the name of a feature film⁸⁹ or "TVC15" as the name of a song,⁹⁰ then you should get no copyright protection for "THX" as the name of a sound system or for "1138" as a designation for a replacement part. Yet this bar against copyrighting names has been threatened by disputes involving what are basically designation systems. Let us consider three such cases.

A. *The AMA and ADA Cases*

Beginning in the 1960s, the American Medical Association (AMA) developed a coding system for medical procedures, the Physi-

85 Hughes, *supra* note 7, at 610–19.

86 So, it is no wonder that in Genesis Adam names all the animals even before Eve is created. *Genesis* 2:19 (King James) ("And out of the ground the LORD God formed every beast of the field, and every fowl of the air; and brought *them* unto Adam to see what he would call them: and whatsoever Adam called every living creature, that *was* the name thereof."). My thanks to David Nimmer for this interesting point.

87 Naming as establishment of a social fact has the same structure as government declarations. Searle gives the example of money: "When the Treasury says it is legal tender, they are *declaring* it to be legal tender, not announcing an empirical fact that it already is legal tender." SEARLE, *supra* note 37, at 55. Naming one's child, one's pet, or one's new car part has the same structure; by convention, we agree that you are entitled to declare the name of this thing.

88 The "discovery" notion of creativity pops up repeatedly, particularly in regard to great art. For example, Einstein is said to have characterized Mozart's music as "so pure that it seemed to have been ever-present in the universe, waiting to be discovered by the master." Arthur I. Miller, *A Genius Finds Inspiration in the Music of Another*, N.Y. TIMES, Jan. 31, 2006, at F3. In Orhan Pamuk's novel *Snow*, the main character believes that the better poems he is writing "always seem[] to come from outside, from far away.'" ORHAN PAMUK, *SNOW* 122 (2004); see also QUINE, *QUIDDITIES*, *supra* note 48, at 39 ("Creation and discovery, here as in theoretical science, are all of one piece."); Justin Hughes, *The Personality Interest of Artists and Inventors in Intellectual Property*, 16 CARDOZO ARTS & ENT. L.J. 81, 142–46 (1998) (criticizing the artistic notions of "capture," "the muses," and "creativity-as-discovery" as paradigms).

89 For George Lucas' 1971 feature film directorial debut, see THX-1138 (Warner Bros. Pictures 1971).

90 DAVID BOWIE, *STATION TO STATION* (RCA Records 1976).

cians' Current Procedural Terminology (CPT).⁹¹ The CPT gives five-digit codes to various medical procedures.⁹² For example, "90717" designates a yellow fever vaccination, and "92950" designates "[c]ardiopulmonary resuscitation."⁹³ A decade later, Congress instructed the Medicaid program to develop a uniform code for identifying physicians' services.⁹⁴ Rather than creating a coding system de novo, the Department of Health and Human Services sensibly adopted the CPT.⁹⁵

For years, Practice Management made bulk purchases of the CPT for resale, but following a dispute about its discount from the AMA, Practice Management filed suit to have the CPT copyright declared invalid. In *Practice Management Information Corp. v. American Medical Ass'n*, Practice Management first argued that the AMA forfeited the CPT copyright when it allowed the CPT to be integrated into Medicaid regulations.⁹⁶ The Ninth Circuit disagreed, concluding, first, that the incentive structure was different: while "judges' salaries provided adequate incentive to write opinions . . . [the] copyrightability of the CPT provides the economic incentive for the AMA to produce and maintain the CPT."⁹⁷ As to due process concerns about availability of the legally mandated codes, the appellate panel concluded that there was no evidence that the AMA had foreclosed public access to the codes and that there were adequate, less draconian tools to ensure such access.⁹⁸

The appellate panel was much more sympathetic to Practice Management's second argument—that the AMA had "misused" its copy-

91 *Practice Mgmt. Info. Corp. v. Am. Med. Ass'n*, 121 F.3d 516, 517 (9th Cir. 1997), *amended by* 133 F.3d 1140 (9th Cir. 1998).

92 *Id.*

93 AM. MED. ASS'N, CURRENT PROCEDURAL TERMINOLOGY 299, 311 (2007).

94 *Practice Mgmt.*, 121 F.3d at 517.

95 *Id.* at 518; *see also* CAL. CODE REGS. tit. 22, § 51050 (2007) ("HCPCS [Health Care Financing Administration's Common Procedure Coding System] consists of the Physicians' Current Procedural Terminology (CPT) To the extent not elsewhere adopted in these regulations, HCPCS, and each of its subsequent updates, is herein incorporated by reference into these regulations.")

96 *Practice Mgmt.*, 121 F.3d at 518.

97 *Id.* The court pointed out the increasing trend of governments, on cost savings grounds, to rely on "model" codes and statutes written by nongovernmental entities, which would lend a note of irony to any holding that such privately-created works should lose their copyright protection on adoption. *See id.* at 518–19 nn.4–5.

98 *Id.* at 519. Such tools included fair use, due process defenses for infringers on a case-by-case basis, mandatory licensing, the federal government adopting a different code if the AMA became too restrictive in its distribution practices (de-lawing the work, as it were), and the federal government "by regulation or contract requir[ing] the AMA to provide greater access." *Id.* at 519 n.7.

right by obtaining a commitment from the federal authorities to use the CPT designations *exclusively* for Medicaid forms.⁹⁹ The panel's "copyright misuse" conclusion may be factually suspect,¹⁰⁰ but this resolution prevented the *Practice Management* panel from applying any fine-toothed analysis to the issue of *what* was protected by the copyright over the CPT. That job was taken up by Judge Easterbrook in the contemporaneous and curiously parallel *American Dental Ass'n v. Delta Dental Plans Ass'n*.¹⁰¹

Just as the AMA had created the CPT, the American Dental Association had created the *Code on Dental Procedures and Nomenclature* ("ADA Code")—a taxonomy in which each dental procedure has (a) a long description, (b) a short description, and (c) a number designation.¹⁰² Delta Dental published *Universal Coding and Nomenclature*, a work which "include[d] most of the numbering system and short descriptions from the ADA's Code."¹⁰³ When the ADA sued, the district court concluded that the ADA Code was not copyrightable subject matter, reasoning that the ADA Code was only a "useful" taxonomy and, therefore, lacked the modicum of creativity necessary for copyright.¹⁰⁴

Judge Easterbrook rejected this reasoning, pointing to the many useful works (software, architectural drawings, maps) protected by copyright law¹⁰⁵ and opining that "[c]lassification is a creative endeavor."¹⁰⁶ He concluded that the long descriptions in the ADA Code were unquestionably copyrightable and that the "original long

99 *Id.* at 520.

100 This conclusion may be suspect because there was apparently no evidence that the AMA *had insisted* upon this contractual term. In its appellate brief to the Ninth Circuit, Practice Management argued that "[t]he AMA purposely sought and obtained the government's promise to mandate the CPT as the only way to collect federal health care money" but did not cite to any evidence adduced at trial supporting this point. Brief of Appellant, Practice Management Information Corp. at 5, Practice Mgmt. Info. Corp. v. Am. Med. Ass'n, 121 F.3d 516 (9th Cir. 1995) (No. 94-56774). Practice Management recognized that the district court determined "that 'the AMA did not coerce' [the government] to adopt the CPT," *id.* at 6, and that, at trial, Practice Management had "never argued the AMA coerced HCFA," *id.* at 33. Just because a term is in a contract, it does not follow that the copyright holder "conditioned" entering into the contract on that term; the federal government might have made the original offer to use the CPT designations exclusively—since it would be inefficient to have two code systems.

101 126 F.3d 977 (7th Cir. 1997).

102 *Id.* at 977.

103 *Id.*

104 *Id.* at 978.

105 *Id.* at 978-79.

106 *Id.* at 979.

descriptions make the work as a whole copyrightable”¹⁰⁷—two vanilla-plain conclusions. Judge Easterbrook’s analysis then moved in a much more troubling direction, opining that “even the short descriptions and the numbers are original works of authorship.”¹⁰⁸ Notice that he says “works”;¹⁰⁹ the ADA numbers were, in effect, *names* for dental procedures, and Easterbrook’s language suggests that each name merits independent copyright protection. Elsewhere I have extensively criticized Judge Easterbrook’s suggestion that a single number could be an independently copyrighted “literary work,” and Judge Easterbrook’s opinion takes a couple steps back from this precipice.¹¹⁰ But the important point here is to see that copyright is being recognized either in a set of names or in individual names and that these names function as facts as surely as street addresses—they are the only practical way to refer to the particular medical and dental procedures just as your home address is the only practical way to refer to the particular place where you live. In both of these cases, the taxonomies produce facts.

B. Southco, Inc. v. Kanebridge Corp.

Southco manufactured hardware, including a line of fasteners.¹¹¹ Each of its fastener models was designated with a nine-digit number in which different digits “denote[d] functional characteristics of each product, for example, installation type, thread size, recess type (phil-

107 *Id.*

108 *Id.* This statement, implying individual “work” status for each number, actually appears in the opinion before the more general and less worrisome conclusion that “all three elements of the [ADA] Code—numbers, short descriptions, and long descriptions, are copyrightable subject matter.” *Id.*

109 *Id.*

110 Although this passage of the opinion expressly says that *each* short description and *each* number is an original work of authorship, the opinion then throws some doubt on the statement that short descriptions and numbers are original works of authorship by stating that it was not finding that the ADA Code was a compilation work under 17 U.S.C. § 103. *Id.* at 980. Judge Easterbrook also reasons that the § 102(b) bar on copyright in ideas, systems, and processes would “permit[] Delta to disseminate forms inviting dentists to use the ADA’s Code when submitting bills to insurers” and also “precludes the ADA from suing, for copyright infringement, a dentist whose office files record treatments using the Code’s nomenclature.” *Id.* at 981. But if each number were an independent “work,” it makes less sense that a dentist copying just a few number designations (each a separate “work”) would be protected by § 102(b)’s bar on copyrighting methods of operation. For further criticism, see Hughes, *supra* note 7, at 577 (contending that the *quantity* of protected material should factor into its copyrightability).

111 Southco, Inc. v. Kanebridge Corp., No. 99-4337, 2000 U.S. Dist. LEXIS 112, at *1 (E.D. Pa. Jan. 12, 2000), *rev’d*, 258 F.3d 148 (3d Cir. 2001).

lips or slotted), grip length, type of material and knob finish.”¹¹² The Southco numbering system had become, to some degree, an industry standard.¹¹³ Nonetheless, there was no evidence that Southco had ever licensed the numbering system to third parties or that it had developed the numbering system with a mind to marketing it as such.¹¹⁴

The defendant Kanebridge published comparison charts showing Southco part numbers with their counterpart Kanebridge part numbers.¹¹⁵ On occasion, Kanebridge also labeled its parts with Southco numbers. Southco alleged that Kanebridge had “copied some or all” of fifty-one particular part numbers from a Southco handbook which contained over one thousand discrete part numbers.¹¹⁶ The U.S. District Court for the Eastern District of Pennsylvania granted a preliminary injunction against Kanebridge, concluding that “Southco [was] likely to succeed in establishing that its product identification numbers are copyrightable” (notice, again, the plural) and that Kanebridge could be liable for copying “Southco’s numbering system.”¹¹⁷

In the first of three trips to the Court of Appeals, the appellate panel reversed on the grounds that the numbers “fail[ed] to satisfy the originality requirement,”¹¹⁸ that the district court had not distinguished between copyright in “the numbering system” and “the actual numbers produced by the system,”¹¹⁹ and that the rigorous nature of

112 *Id.* at *2.

113 *Id.* at *9; see *Southco, Inc. v. Kanebridge Corp.*, 258 F.3d 148, 150 (3d Cir. 2001).

114 *Southco*, 258 F.3d at 152.

115 *Id.* at 150.

116 *Southco*, 2000 U.S. Dist. LEXIS 112, at *3, *13. The “copied” Southco numbers came either from a Southco “Handbook” or a supplement to one of the company Handbooks. *Id.* at *3.

117 *Id.* at *13 (emphasis added). In prior part number cases, courts had concluded that the taxonomies lacked originality because of randomness. *Mitel, Inc. v. Iqtel, Inc.*, 124 F.3d 1366, 1373–74 (10th Cir. 1997) (“Mitel’s arbitrary selection of a combination of three or four numbers required de minimis creative effort. Mitel’s own witnesses testified to the arbitrariness of the command codes We agree with the district court that the random and arbitrary use of numbers in the public domain does not evince enough originality to distinguish authorship.”); *Toro Co. v. R & R Prods. Co.*, 787 F.2d 1208, 1213 (8th Cir. 1986) (holding that there was no copyright in part numbers because the numbering system was “arbitrary and random,” as opposed to a system that used symbols according to a meaningful pattern).

118 *Southco*, 258 F.3d at 151.

119 *Id.* (acknowledging the same distinction drawn in the amicus brief from the U.S. Government). The author participated in the drafting of that brief. After drawing the distinction above, the U.S. amicus brief also raised the issue whether any use

Southco's numbering system "makes it impossible for the numbers themselves to be original."¹²⁰ On remand, the trial court granted summary judgment for the defendant despite a new declaration from a Southco employee asserting that he did indeed apply judgment and creativity in establishing new parts numbers for Southco.¹²¹ On this basis, a different Third Circuit panel reversed the grant of summary judgment, saying a genuine issue of copyrightability in the parts numbers had been raised.¹²²

Prompted by U.S. government intervention, the Third Circuit granted rehearing en banc, and an opinion written by now Justice Alito put to rest the claim that individual numbers designating (naming) parts could be individually copyrighted. The en banc *Southco III* decision¹²³ announced that Southco's part numbers were not copyrightable for two separate reasons: (a) "the Southco product numbers are not 'original' because each number is rigidly dictated by the rules of the Southco [numbering] system";¹²⁴ and (b) "[t]he Southco part numbers are also excluded from copyright protection because they are analogous to short phrases or the titles of works."¹²⁵ Although the court of appeals recognized that the part numbers were "analogous to . . . titles,"¹²⁶ none of the parties pursued the obvious next step: if these part names had become industry standards, the names were social facts—facts by common agreement just as that green rectangular paper is commonly agreed to be a twenty dollar bill—that had become basic to carrying out nonexpressive activities.

of Southco's "system" could infringe a protectable copyright interest given the bar to the protection of methods of operation in 17 U.S.C. § 102(b). Brief Amicus Curiae of the United States of America Urging Reversal in Support of Appellant Kanebridge Corp. at 14 & n.12, *Southco, Inc. v. Kanebridge Corp.*, 258 F.3d 148 (3d Cir. 2001) (No. 00-1102) [hereinafter Brief Amicus Curiae].

120 *Southco*, 258 F.3d at 153. The U.S. had argued that the Southco numbers lacked creativity because each number was the result of the "mechanical application of a set of rules to well-defined physical characteristics of a retractable captive-screw assembly," Brief Amicus Curiae, *supra* note 119, at 12, such that, as the trial court found, once a third party was familiar with Southco's rules for numbering, that person would know the part's "size, finish, and utility" based "on the content and arrangement of its product number." *Southco*, 2000 U.S. Dist. LEXIS 112 at *11, *13.

121 *Southco, Inc. v. Kanebridge Corp. (Southco II)*, 324 F.3d 190, 194 (3d Cir. 2003), *rev'd en banc*, 390 F.3d 276 (3d Cir. 2004).

122 *Id.* at 196.

123 *Southco, Inc. v. Kanebridge Corp. (Southco III)*, 390 F.3d 276 (3d Cir. 2004) (en banc).

124 *Id.* at 282.

125 *Id.* at 285. Interestingly, three Third Circuit judges (Becker, McKee, and Smith) did not join this portion of the en banc decision. *See id.* at 277 n.*.

126 *Id.* at 285.

IV. THE PROTECTION OF EVALUATIVE FACTS

While the drift toward protecting names was stopped in the Third Circuit, eerily similar trends have not clearly abated in the Second and Ninth Circuits. In these cases, private parties have made evaluations—qualitative or quantitative—and courts have intimated that such original evaluations may be individually protected under copyright law. Obviously “evaluations” and “designations” overlap to some degree; the CPT and ADA Codes were also “evaluative” in their many taxonomic decisions.¹²⁷ As with designations, the evaluations in the cases below can become so widely accepted and so relied upon for substantial nonexpressive activities that they become social facts.

A. CCC Information Services v. Maclean Hunter

Maclean Hunter publishes the well-known *Red Book*, listing used car valuations for different parts of the United States.¹²⁸ These valuations were “the editors’ projections of the values for the next six weeks of ‘average’ versions of most of the used cars (up to seven years old) sold in that region.”¹²⁹ The court recognized that the *Red Book* was one of two leading valuation books, so much so that some state laws mandated the use of valuations from both books in calculating required insurance payments for the loss of a vehicle.¹³⁰ The defendant CCC Information Services distributed an online database of used car valuations to its customers by “loading major portions of the Red Book onto its computer network and republishing Red Book information in various forms to its customers.”¹³¹ The trial court found that

127 Complex labeling systems, particularly of technical or technological matters, tend toward the evaluative. But there are no hard and fast rules. Technical equipment can be given names that are evaluative (BMW’s automobiles—325Ci, 540i, 740iL) or very evocative (Chevrolet’s “Impala,” “Corvair,” and “Malibu”). Newly discovered comets and planetoids receive a numeric designation from the International Astronomical Union’s Committee on Small Bodies Names; the object can later have a more evocative name chosen by the discoverer and approved by the committee. See, e.g., Livia Giacomini, *From 2000WR106 to Varuna: How are Asteroids Named?*, *TUMBLING STONE*, Mar. 15, 2001, <http://spaceguard.esa.int/tumblingstone/issues/nom2/varuna.htm>.

128 CCC Info. Servs., Inc. v. Maclean Hunter Mkt. Reports, Inc., 44 F.3d 61, 63 (2d Cir. 1994).

129 *Id.*

130 *Id.* at 64 (discussing the National Automobile Dealers Association’s “Bluebook” and noting that “the laws of certain states use th[e] average figure [from the two books] as a minimum for insurance payments upon the ‘total loss’ of a vehicle”).

131 *Id.*

“numerous Red Book customers ha[d] canceled their subscriptions, opting instead to purchase CCC’s services.”¹³²

Nonetheless, the trial court granted summary judgment for CCC, finding that the valuations were unprotectable facts or, alternatively, expressions of ideas which had merged with the underlying ideas.¹³³ The Second Circuit reversed, reasoning that the selection and arrangement of the *Red Book* was protectable, that the *Red Book* numbers were themselves protectable expression, and that merger did not apply.¹³⁴ As did Judge Easterbrook, Judge Leval moved from unremarkable propositions about copyright law to intimations of alarmingly broad copyright protection.

As a first step, the court found sufficient originality in the selection and arrangement of the *Red Book*’s valuations. Judge Leval found that originality was expressed in the particular regions into which Maclean had divided the country, implying that the selection of regions was “original” because it produces inaccurate car values:

A car model does not command the same value throughout a large geographic sector of the United States A 1989 Dodge Caravan will not command the same price in San Diego as in Seattle. In furnishing a single number to cover vast regions that undoubtedly contain innumerable variations, the Red Book expresses a loose judgment that values are likely to group together with greater consistency within a defined region than without. The number produced is necessarily both approximate and original.¹³⁵

The court also pointed to other “selection” decisions that appeared to manifest originality, including Maclean’s “selection of the number of years’ models to be included in the compilation” (seven years) and “the selection and manner of presentation of optional features for inclusion.”¹³⁶ This reasoning that choices that do not seem to be dictated by extrinsic considerations are *original* is, again, straightforward copyright doctrine,¹³⁷ although Leval’s connection—that such

132 *Id.*

133 *Id.*

134 *Id.* at 64–73.

135 *Id.* at 67.

136 *Id.* Judge Leval also considered that “the adjustment of mileage by 5,000 mile increments (as opposed to using some other breakpoint and interval)” was a creative choice, *id.* at 67–68, but this seems wrong. Five thousand and/or ten thousand mile increments seems like an unoriginal, pedestrian choice.

137 The same reasoning can be seen in two pre-*Feist* decisions recognizing copyright in nonfiction database products. In *Dow Jones & Co. v. Board of Trade*, 546 F. Supp. 113 (S.D.N.Y. 1982), the court recognized copyright in Dow Jones’ list of what companies produce the Dow Jones average because “Dow’s lists evidence a high degree of selectivity and subjective judgment.” *Id.* at 116. Similarly, in *Eckes v. Card*

choices will produce inaccurate evaluations—is more candid than usual.

But were the *Red Book* valuations, as the trial court thought, (expressions of) “facts”?¹³⁸ Judge Leval quickly and correctly concluded that the items in the *Red Book* were not Feistian facts because the *Red Book* entries were not “pre-existing facts that had merely been discovered by the Red Book editors. To the contrary, Maclean’s evidence demonstrated without rebuttal that its valuations were neither reports of historical prices nor mechanical derivations of historical prices or other data.”¹³⁹

Instead, they were “predictions . . . based not only on a multitude of data sources, but also on professional judgment and expertise.”¹⁴⁰ As such, “[t]he valuations themselves [were] original creations of Maclean.”¹⁴¹

By honing to the Feistian definition, Leval avoided addressing how people use these numeric valuations as *facts*: the car salesman tells you that your car is worth *X* dollars or the state insurance adjuster says its replacement value is *Y*. But even while rejecting the “factness” of these values, Leval recognized that the numbers were nonetheless subject to a merger argument: “[E]ach entry in the Red Book expresses the authors’ *idea* of the value of a particular vehicle . . . [and] such expression is indispensable to the statement of the idea and therefore merges with the idea, so that the expression is also not protectible.”¹⁴² Given what the merger doctrine is supposed to do—keep facts and ideas from being propertized—it is hard to see how the merger doctrine could not apply in such circumstances. Indeed, Judge Leval recognized that this merger argument was “not easily rebutted.”¹⁴³

Price Update, 736 F.2d 859 (2d Cir. 1984), the defendant was accused of copying plaintiff’s selection of which cards counted as “premium” cards in the world of collecting baseball cards. *Id.* at 862. The court found that there was “no doubt that appellants exercised selection, creativity and judgment in choosing among the 18,000 or so different baseball cards in order to determine which were the 5,000 premium cards.” *Id.* at 863. *See generally* Hughes, *supra* note 88, at 111–19 (reasoning that “[s]omething will be considered ‘creative’ only when it appears to come from neither a purely mechanical process, nor a purely random one”).

138 The trial court also called them “interpretations of facts.” *Maclean Hunter*, 44 F.3d at 64.

139 *Id.* at 67.

140 *Id.*

141 *Id.*

142 *Id.* at 68.

143 *Id.*

Leval's direct rebuttal was a standard tactic: identify the "idea" as being at a more abstract level. He notes that the *Red Book* tells the reader that "[y]ou, the subscriber, must be the final judge of the actual value of a particular vehicle,"¹⁴⁴ a statement almost certainly intended to limit Maclean Hunter's legal liability, not engender creative deviations from its estimates. Nonetheless, Leval leverages it to launch the proposition that the "idea" at issue is *making some valuation* of a particular used car, the idea is not *this particular valuation*.¹⁴⁵ If the *Red Book* says "\$6550," then protecting the expression "\$6550" proprietizes neither the general idea of a numeric valuation for this particular car nor different specific ideas that have expressions like "\$6575," "\$6500," or "\$6485."

Judge Leval realized that this was not particularly satisfying reasoning and presented a more practical way to avoid the merger doctrine's "not easily rebutted" implications: a two-level hierarchy of ideas. The first level is "building block" ideas and the second is "ideas of [a] weaker category, infused with opinion."¹⁴⁶ The court reasoned that merger is not such a bad thing with ideas of "the weaker, suggestion-opinion category."¹⁴⁷ Given copyright's intended incentive for compilations, protection of the expressions of opinion-infused ideas can be tolerated because restricting access to such expressions "will not inflict injury on the opportunity for public debate, nor restrict access to the kind of idea that illuminates our understanding of the phenomena that surround us or of useful processes to solve our problems."¹⁴⁸ On this utilitarian calculus, the court held that the merger doctrine should be "withheld" from application to Maclean Hunter's valuations.¹⁴⁹

B. *CDN Inc. v. Kapes*

The immediate sequel to *Maclean Hunter* was the Ninth Circuit's 1999 decision in *CDN Inc. v. Kapes*.¹⁵⁰ In *Kapes*, the plaintiff published the *Coin Dealer Newsletter*, a weekly report of wholesale prices for collectible United States coins, which "include[d] prices for virtually all collectible coins and [was] used extensively by dealers."¹⁵¹ Defendant Kapes operated an internet webpage with a "Fair Market Coin Pricer"

144 *Id.* at 73.

145 *Id.* at 72.

146 *Id.*

147 *Id.*

148 *Id.*

149 *Id.*

150 197 F.3d 1256 (9th Cir. 1999).

151 *Id.* at 1258.

(Pricer) that provided retail prices for many collectible coins.¹⁵² The retail prices in Kapes' Pricer were derived from the CDN prices by consistent application of a simple algorithm.¹⁵³ The parties stipulated that the issue of copyrightability of the CDN prices was dispositive of the case and the trial court concluded CDN's "prices are original creations, not uncopyrightable facts."¹⁵⁴ On appeal, the Ninth Circuit panel recognized that the sole issue before it was "whether the *prices* are copyrightable."¹⁵⁵

Both the trial and appellate courts recognized that the nature of the numbers in the *Coin Dealer Newsletter* was quite distinct from that of the numbers in the *Feist* telephone books: the CDN wholesale coin prices were the result of "a process that involves using [the editors'] judgment to distill and extrapolate from factual data."¹⁵⁶ Whereas the numbers in the telephone book lacked any creative spark, the Ninth Circuit panel was clear that "[t]his spark glows in CDN's prices, which are compilations of data chosen and weighed with creativity and judgment."¹⁵⁷ As with *Maclean Hunter* and *Delta Dental*, this is regrettable dicta suggesting that *single* prices in the respective publications would count as independently protectable "works."¹⁵⁸

After a succinct exposition of the merger doctrine, the court concluded simply that "accepting the [merger] principle in all cases . . . would eviscerate the protection of the copyright law,"¹⁵⁹ the same basic conclusion as in *Maclean Hunter*. The next steps in the reasoning could have been that the prices are "expressions" of CDN editors' judgments, that the judgments are the abstract, unprotected ideas (Judge Leval's first reason to avoid the merger doctrine), and that the court did not believe merger should apply. Instead, the court (a) implicitly said that the prices were ideas and (b) explicitly said that copyright law sometimes protects ideas:

CDN does not, nor could it, claim protection for its idea of creating a wholesale price guide, *but it can use the copyright laws to protect its idea of what those prices are. . . .* Drawing this line preserves the balance between competition and protection: it allows CDN's competi-

152 *Id.* at 1257.

153 For example, a twenty-five percent markup means that a CDN wholesale value of \$10.00 would become Kapes' retail price of \$12.50, and a CDN \$300.00 value would become Kapes' retail price of \$375.00.

154 *Id.* at 1258.

155 *Id.* at 1259 (emphasis added).

156 *Id.* at 1261.

157 *Id.* at 1260.

158 See Hughes, *supra* note 7, at 592-95.

159 *Kapes*, 197 F.3d at 1261.

tors to create their own price guides . . . but protects CDN's creation, thus giving it an incentive to create such a guide. . . . The doctrine of merger does not bar copyright protection in this case.¹⁶⁰

Even treating this language concerning copyright protecting ideas as dicta, *Kapes* broadened the scope of protection for such judgments/evaluations by extending the protection to *derivatives* from the plaintiff's evaluations, not just reproducing the *expressions* of the plaintiff's evaluations.

While *Kapes* seems like a fairly bare-knuckled application of anti-misappropriation sentiments without sufficient concern for the integrity of copyright doctrine,¹⁶¹ in another sense *Kapes* did not aggravate the "created facts" problem beyond *Maclean Hunter*. There was no evidence that the CDN wholesale prices were mandated for use in law and there was less evidence that the CDN prices had become de facto industry standards than the evaluations in *Maclean Hunter*. It would take a few more years before another case again brought the *Maclean Hunter* analysis under scrutiny.

C. NYMEX v. IntercontinentalExchange

This case came in 2005 and was brought by the New York Mercantile Exchange (NYMEX), the world's largest exchange for the trading of commodity futures contracts and an entity regulated by the Commodity Futures Trading Commission (CFTC).¹⁶² People trading NYMEX futures contracts (members) must deposit an initial margin deposit—a performance bond—to cover any losses they suffer.¹⁶³ As explained by the district court:

On each day on which a futures contract remains open and unexpired, the amount of the required margin deposit changes as the price of the underlying commodity—and thus the value of the contract—changes. These changes in the value of the contract are determined by reference to the end-of-day "settlement prices" for the futures contract.¹⁶⁴

160 *Id.* at 1262 (emphasis added).

161 *See, e.g.,* Karjala, *supra* note 5, at 480 ("It is evident that *CDN* simply uses anti-misappropriation notions to force the defendant to do its own work in determining the value estimates rather than to protect the creative selection or arrangement of compiled data, paying only lip service to *Feist's* elimination of the 'sweat of the brow' basis for copyright originality.").

162 *N.Y. Mercantile Exch., Inc. v. IntercontinentalExchange, Inc.*, 389 F. Supp. 2d 527, 533 (S.D.N.Y. 2005), *aff'd*, 497 F.3d 109 (2d Cir. 2007).

163 *Id.*

164 *Id.* at 530.

The parties disputed how much judgment and creativity went into these settlement prices, although there was no dispute that they are not actual prices of single transactions and that the daily settlement prices are established by a NYMEX “committee.”¹⁶⁵

IntercontinentalExchange (ICE) has its own over-the-counter futures contracts on two popular NYMEX commodities, and each day ICE relies on the NYMEX settlement prices for the processing of the ICE futures contracts.¹⁶⁶ NYMEX claimed that this activity violates its copyright in the settlement prices.¹⁶⁷ When ICE sought declaratory judgment against NYMEX on the copyright issue, NYMEX “urged the Court to consider a NYMEX settlement price as a ‘creative copyrightable work’”¹⁶⁸—a result that follows unsurprisingly from Judge Leval’s reasoning in *Maclean Hunter* (as well as Easterbrook’s reasoning in *Delta Dental*).¹⁶⁹ NYMEX conceded that “market participants often provide that the parties will refer to a NYMEX settlement price to serve as the final settlement price in [over-the-counter] contracts.”¹⁷⁰ At the same time, NYMEX counsel expressly argued that “[w]hat is done with [a settlement price], what we permit to be done with it,”¹⁷¹ had no bearing on it becoming a fact—an argument obviously at odds with the claims made here about the nature of social facts.

The district court found that the settlement prices were facts,¹⁷² but it is clear that Judge Koeltl understood he was treading in an uncharted quadrant of the *Feist* universe. On the one hand, the district court opined that “NYMEX’s settlement prices are the actual prices,”¹⁷³ suggesting that the holding relied on placing the NYMEX settlement prices in the camp of *Feistian* facts. On the other hand,

165 *Id.* at 530–31.

166 *Id.* at 533 (“According to ICE, an OTC swap is generally defined as an agreement whereby a floating price is exchanged for a fixed price over a specified period, thus allowing a buyer or seller of energy products to ‘lock in’ a specific price and avoid the risk of floating prices. The financial purpose of an OTC transaction, therefore, is usually the same as the financial purpose of a NYMEX transaction.”).

167 *Id.* In March 2002, NYMEX sought copyright registration for its settlement prices, expressly comparing the settlement prices to the valuations in *Maclean Hunter* and *Kapes*. When it became clear that the Copyright Office would not grant registration over the “prices” expressly mentioned as such, NYMEX obtained registration over publications that include the prices. *Id.*

168 *Id.* at 541.

169 *See supra* Parts IV.A, III.A.

170 *N.Y. Mercantile Exch.*, 389 F. Supp. 2d at 533.

171 *Id.* at 541.

172 *Id.* (“The argument that NYMEX settlement prices do not embody facts is without merit.”).

173 *Id.* at 542 (“NYMEX’s settlement prices are the actual prices and are the only way to express the idea of a settlement price stated in numbers.”).

the court adopts a page from Searle's theory on why the prices are (social) facts: "NYMEX settlement prices are widely publicized and used as benchmarks by market participants. NYMEX settlement prices are thus real-world facts used by commodities traders to value their open positions and trigger margin calls or margin reductions."¹⁷⁴ Judge Koeltl then found that the facts and expression of facts had merged, but carefully hedged his bets throughout the opinion, framing the problem also as one of "idea" and expression having merged.¹⁷⁵

On appeal, NYMEX continued to follow *Maclean Hunter*, arguing that each NYMEX settlement price is the "expression of an informed, consensus opinion of persons at NYMEX as to what the fair market value of the contract at the close of trading was"; that the nature of trading makes the actual prices—the Feistian facts—impossible for NYMEX to obtain.¹⁷⁶ Not surprisingly, NYMEX's arguments for why there is no "merger" in this situation—despite widespread external reference to the settlement prices—tracked Judge Leval's analysis in *Maclean Hunter*.¹⁷⁷ The U.S. Government intervened against NYMEX, but was also a little ambivalent in its embrace of the district court conclusion that "facts" had been created.¹⁷⁸

174 *Id.* at 542; *see also id.* at 543 ("NYMEX settlement prices are a matter of basic market fact, and therefore, they are not copyrightable.").

175 *See id.* at 541. Interestingly, Koeltl makes no citation to the *Veck* decision, although that majority en banc decision concluding that the model code had become "fact" was over two years old by the time of Koeltl's decision. *See infra* Part V.B.

176 Public Version of Brief for Plaintiff-Counter-Defendant-Appellant at 7, *N.Y. Mercantile Exch., Inc. v. IntercontinentalExchange, Inc.*, No. 05-5585 (2d Cir. 2007) [hereinafter NYMEX Appeal Brief]. NYMEX's argument acknowledged that the settlement prices are generated pursuant to elaborate rules (a reason used in the *Southco* litigation to deny originality to the parts numbers), *id.* at 10, but continued to claim that each settlement price was set "virtually entirely in the discretion, judgment and opinion by the Settlement Price Committee," *id.* at 12.

177 NYMEX argued that because the opinions used in arriving at the settlement price can vary from person to person "the idea can result in several different expressions." *Id.* at 33. The U.S. Government brief savaged this NYMEX argument: "NYMEX's claim that a settlement price is just one possible expression of a broad, all-embracing concept is a transparent effort to avoid the merger doctrine." Brief Amicus Curiae of the United States of America in Support of Defendant-Appellee IntercontinentalExchange, Inc. at 29, *N.Y. Mercantile Exch., Inc. v. IntercontinentalExchange, Inc.*, No. 05-5585 (2d Cir. 2007) [hereinafter USG Brief]. Adopting Judge Leval's distinction, NYMEX also argued that it does not seek to protect "building block ideas" but rather ideas in the category of "'approximative statements of opinion.'" NYMEX Appeal Brief, *supra* note 176, at 35 (quoting *CCC Info. Servs., Inc. v. Maclean Hunter Mkt. Reports, Inc.*, 44 F.3d 61, 72 (2d Cir. 1994)).

178 The brief emphasizes idea/expression merger:

In August 2007, the Second Circuit affirmed the lower court on merger grounds only.¹⁷⁹ Viewing the NYMEX Committee's activities, the court pointed to the *Feist* example of census-takers (as discoverers of fact) and noted that "[w]hile the line between creation and discovery is often clear-cut, we recognize that it is a difficult line to draw in this case."¹⁸⁰ This left the originality—hence copyrightability—question unresolved. Similarly, while the appellate panel noted how the settlement prices are treated after their creation as facts,¹⁸¹ it did so as almost an estoppel point against NYMEX—and without any recognition, as in the *Veeck* case discussed below in Part V.B, of the "created facts" doctrinal dilemma.

While NYMEX seemed to test the basic soundness of *Maclean Hunter*, the court avoided directly confronting its own precedent—and *Kapes*—in a couple of ways. First, the court noted that *Maclean Hunter's* statement that "[t]he valuations themselves are original creations" was "arguably dicta" unnecessary to the decision because the defendant had copied the entire compilation.¹⁸² Distinguishing the merger analysis of *Maclean Hunter* was a more difficult task.

As an earlier version of this manuscript predicted,¹⁸³ the court distinguished the NYMEX evaluative process from the *Maclean Hunter*

NYMEX has avowed that its settlement prices are the "cornerstone of the clearing process" and are the basis for calculating whether its customers made or lost money on a particular day. Given this reality, it is simply not credible for NYMEX to argue that its settlement prices reflect only one expression (among many) of the sweeping idea that market values can be derived from market transactions. To the contrary, as the district court correctly ruled, a NYMEX settlement price is the expression of a much more specific idea

USG Brief, *supra* note 177, at 28–29. On the other hand, the USG Brief emphasizes that some "judgment" going into a number does not undermine its basic factual nature: "All measurement involves some amount of judgment and estimation" and "NYMEX is therefore wrong to suggest that applying judgment to a measurement destroys the factual nature of the result." *Id.* at 9–10.

179 *N.Y. Mercantile Exch., Inc. v. IntercontinentalExchange, Inc.*, 497 F.3d 109, 116–18 (2d Cir. 2007).

180 *Id.* at 114.

181 *Id.* at 115 n.6 ("While NYMEX now argues that settlement prices are merely opinions, we note that NYMEX itself treats the prices as news of the day. . . . NYMEX also provides the prices to newspapers which publish them alongside other market facts.").

182 *Id.* at 115 n.6 ("[I]n *CCC* a subscriber could not rely solely on the Red Book in valuing any particular used car. . . . Similarly, *CDN Inc. v. Kapes* . . . is distinguishable because the prices for collectible coins in that case were estimates, not discovered market facts." (citations omitted)).

183 Justin Hughes, *The Flawed Ontology of Copyright Law* 38 (July 27, 2007) (unpublished manuscript, on file with the Notre Dame Law Review).

evaluative process on the grounds that NYMEX attempts to establish/reconstruct *past* facts while the prices in *Maclean Hunter* and *Kapes* were judgments as to future events.¹⁸⁴ Of course, reconciling application of the merger doctrine in *Maclean Hunter*, *Kapes*, and *NYMEX* in this way required more or less treating the NYMEX settlement prices as discovered facts—something the court said it was not deciding.¹⁸⁵ (Not to mention that this temporal distinction is grounded in a common sense worldview also challenged by modern physics and metaphysics.¹⁸⁶) The court also appeared to distinguish application of merger on the grounds that used car or collector coin values would not apply *directly* to any particular used car or coin. In contrast, even if the NYMEX settlement price was “created,” once the settlement price exists, it is the “fair market value for each NYMEX contract” and “any dissension [from that number] would be exceptionally narrow.”¹⁸⁷ Of course, that is an unsatisfactory way to distinguish the *NYMEX* ruling from *Maclean Hunter*; dissension from the *Red Book* used car values may also be “exceptionally narrow,” particularly on insurance compensation where the *Red Book* is mandated as the valuation authority. Finally, the court distinguished *Maclean Hunter* from the *NYMEX* case on policy grounds that have heretofore only obliquely been stated in merger doctrine: whether or not the putative copyright holder needed the incentive of copyright to produce the work.¹⁸⁸ We will return to that theme in Part VII.

V. LEGAL FACTS—WHEN PRIVATE PERSONS AUTHOR LAWS

Dating back to the 1834 *Wheaton v. Peters*¹⁸⁹ and 1888 *Banks v. Manchester*¹⁹⁰ decisions, it has been black letter American copyright doctrine that expressions of law cannot be copyrighted. One rationale is that the public “authors” the law, not particular judges or legis-

184 This is a theme in David Nimmer’s exploration of the reconstruction of the Dead Sea Scrolls. In a sense, the NYMEX numbers are like a conservator trying to restore art, judging what *was* there. See generally Miles Unger, *A Mysterious St. John, Found in the Attic*, N.Y. TIMES, Feb. 18, 2007, § 2 (Arts & Leisure), at 31.

185 See *N.Y. Mercantile Exch.*, 83 U.S.P.Q.2d (BNA) at 1613.

186 See, e.g., MICHAEL LOCKWOOD, *THE LABYRINTH OF TIME* 10, 53, 64 (2005) (contrasting the “tensed conception” of reality against the “tenseless conception,” in which there is no significant difference between the past, present, and future).

187 *N.Y. Mercantile Exch.*, 83 U.S.P.Q.2d (BNA) at 1615.

188 After discussing the incentive function of copyright, particularly in respect of *Maclean Hunter*, the court noted “NYMEX needs no such incentives here.” *Id.*

189 33 U.S. (8 Pet.) 591 (1834).

190 128 U.S. 244 (1888).

lators.¹⁹¹ Another is that the incentive of copyright is unneeded because the expression of judges, as employees of the state, has already been bought and paid for by the citizenry (a kind of public work-for-hire doctrine, if you will).¹⁹² A third reason is a pure due process requirement of open access to the law: “The whole work done by judges constitutes the authentic exposition and interpretation of the law, which, binding every citizen, is free for publication to all.”¹⁹³

But this bar to copyright in law has been attacked on the flanks in cases concerning privately developed “model codes” that are adopted into law. These model codes are usually the result of an intense, quasi-private deliberative process by a professional body that then claims copyright in the final expression of the model code.¹⁹⁴ At the moment the code is completed (and not yet adopted as law), the copyright claim is as unremarkable as a movie studio claiming copyright in a big budget picture on which hundreds of people worked. Only a couple of courts have confronted the problems that begin when the model code is adopted whole cloth as law.¹⁹⁵ In the most recent of these controversies, the federal courts have finally recognized that when a privately written code is adopted as law, the private expression becomes “in one sense, a ‘fact’”¹⁹⁶ and that these “codes are ‘facts’ under copyright law.”¹⁹⁷

A. BOCA v. Code Technology, Inc.

The First Circuit was the first to wade into this thicket in the 1980 *Building Officials & Code Administrators v. Code Technology, Inc.*¹⁹⁸ decision. Building Officials and Code Administrators International, Inc. (BOCA), a private group, had developed and published a model

191 As the majority noted in *Wheaton*, “It may be proper to remark that the court are unanimously of opinion, that no reporter has or can have any copyright in the written opinions delivered by this court; and that the judges thereof cannot confer on any reporter any such right.” *Wheaton*, 33 U.S. (8 Pet.) at 668.

192 See, e.g., *Veck v. S. Bldg. Code Cong. Int’l, Inc.* (*Veck II*), 293 F.3d 791, 794 (5th Cir. 2002) (en banc).

193 *Banks*, 128 U.S. at 253.

194 See, e.g., *Veck II*, 293 F.3d at 793–94 (describing Southern Building Code Congress International’s code promulgation and copyrighting).

195 See, e.g., *id.*; *Bldg. Officials & Code Adm’rs v. Code Tech., Inc.*, 628 F.2d 730, 734–35 (1st Cir. 1980).

196 *Veck v. S. Bldg. Code Cong. Int’l, Inc.* (*Veck I*), 241 F.3d 398, 408 n.49 (5th Cir. 2001), *rev’d en banc*, 293 F.3d 791 (5th Cir. 2002) (“The global enactment of a code does make that code the law of the enacting municipality and hence, in one sense, a ‘fact.’”).

197 *Veck II*, 293 F.3d at 801.

198 628 F.2d 730 (1st Cir. 1980).

building code; it copyrighted the code and then “encourage[d], through a licensing program, public authorities such as states to adopt the BOCA Code.”¹⁹⁹ After Massachusetts adopted the BOCA Code with some minor modifications,²⁰⁰ BOCA published it as the *Commonwealth of Massachusetts State Building Code*; it appears that there was no official state publication of the state building code.²⁰¹ When the defendant, Code Technology (CT), sought to publish its own edition of the Massachusetts Code, BOCA sued, and the trial court granted a preliminary injunction.²⁰²

After reviewing the case law on copyright in law from *Wheaton* and *Banks* forward, the First Circuit reversed the injunctive relief.²⁰³ The appellate panel concluded that it was “far from persuaded that BOCA’s virtual authorship of the Massachusetts building code entitles it to enforce a copyright monopoly over when, where, and how the [code] is to be reproduced and made publicly available,”²⁰⁴ but “stop[ped] short . . . of ruling definitely on the underlying legal issues.”²⁰⁵

B. *Veeck v. Southern Building Code Congress*

Twenty years later, the Fifth Circuit gave a much more thorough treatment of this problem in *Veeck v. Southern Building Code Congress International, Inc. (Veeck I)*,²⁰⁶ concluding that privately drafted codes adopted as law had, indeed, become “facts.”²⁰⁷ The nonprofit Southern Building Code Congress International (SBCCI) was formed in 1940 with its primary mission being to “develop, promote, and promulgate model building codes.”²⁰⁸ Along with many other municipalities, the Texas towns of Savoy and Anna had adopted versions of an

199 *Id.* at 732.

200 *Id.*

201 *Id.*

202 *Id.* at 731.

203 *Id.* at 732–36.

204 *Id.* at 735.

205 *Id.* at 732. The First Circuit left open the possibility that BOCA could persuade the trial court that its copyright in the model code should lead to damages. *Id.* at 736 (“Since the rule denying copyright protection to judicial opinions and statutes grew out of a much different set of circumstances than do these technical regulatory codes, we think BOCA should at least be allowed to argue its position fully on the basis of an evidentiary record, into which testimony and materials shedding light on the policy issues discussed herein may be placed.”).

206 241 F.3d 398 (5th Cir. 2001), *rev’d en banc*, 293 F.3d 791 (5th Cir. 2002).

207 *Id.* at 408 n.49.

208 *Veeck v. S. Bldg. Code Cong. Int’l, Inc. (Veeck II)*, 293 F.3d 791, 793 (5th Cir. 2002) (en banc).

SBCCI code as their own.²⁰⁹ When Peter Veeck posted the town building codes on his noncommercial website promoting north Texas, SBCCI sued for copyright infringement.²¹⁰

The trial court granted summary judgment on Veeck's infringement of the SBCCI copyright, a result the court of appeals initially affirmed in *Veeck I*.²¹¹ The *Veeck I* appellate panel concluded (a) that the incentive of copyright was needed to continue production of these useful model codes;²¹² (b) that there was no evidence that Veeck had been denied access to the town building codes;²¹³ and (c) that there was no merger because "contrary to Veeck's insistence—there remain many ways to write model building codes, not just one."²¹⁴ Each of these conclusions, of course, echoes similar reasoning in *Practice Management* and/or *Maclean Hunter*.

Rehearing en banc produced a strong split among the Fifth Circuit judges with a majority finding both that the *Wheaton/Banks* reasoning required that Veeck have unfettered access to the law²¹⁵ and that "the codes are 'facts' under copyright law."²¹⁶ As to the first of these two grounds, until *Veeck II*, due process/access claims in these cases had been diffused through an understanding that the *minimum* due process need is for people to *know* the laws, not for people to *republish* the laws. For example, the *Practice Management* panel focused on the *access* side of a work being "available":

There is no evidence that anyone wishing to use the CPT has any difficulty obtaining access to it. Practice Management is not a potential user denied access to the CPT, but a putative copier wishing to share in the AMA's statutory monopoly. Practice Manage-

209 *Veeck I*, 241 F.3d at 401.

210 *Id.*

211 *Id.* at 402, 411.

212 *Id.* at 402–03.

213 *Id.* at 403–04 n.17 (noting that "had Veeck in fact been unable to obtain a copy of the enacted building codes because of SBCCI's copyright, we would likely conclude that due process provides grounds to invalidate such copyright").

214 *Id.* at 407.

215 *Veeck v. S. Bldg. Code Cong. Int'l, Inc. (Veeck II)*, 293 F.3d 791, 799–800 (5th Cir. 2002) (en banc). The majority disagreed that *Wheaton* and *Banks* embodied the pecuniary/incentives argument that judges "do not need the 'incentives' that copyright affords in order to write opinions." *Id.* at 797. Instead the majority viewed the *Banks* holding as based on a "'metaphorical concept of citizen authorship'" together with the need for citizens to have free access to the laws. *Id.* at 799 (quoting *Bldg. Officials & Code Adm'rs v. Code Tech., Inc.*, 628 F.2d 730, 734 (1st Cir. 1980)).

216 *Id.* at 801.

ment does not assert the AMA has restricted access to users or intends to do so in the future.²¹⁷

Thus, the *Practice Management* court addressed the access issue and did not opine on the other half of *Banks*—that the law be “free for publication to all.”²¹⁸

Of course, the ability of third parties to republish a code can be linked with increased general access, but not all of the situations in these disputes lend themselves to that kind of analysis. Practice Management had, until the dispute, been reselling AMA-produced copies of the CPT, so it was not obvious that Practice Management republishing the CPT was going to trigger any meaningful increase in access.²¹⁹ In *BOCA*, the plaintiff sold copies of its *Commonwealth of Massachusetts State Building Code (3d ed.)* for twenty-two dollars each while the defendant was selling an edition that included the state code and other materials for thirty-five dollars—hardly an increase in accessibility.²²⁰ It is only in the internet-based cases—*Maclean Hunter* and *Veeck*—that “free for publication” obviously increases access.

The second ground for the *Veeck II* holding was a clear endorsement of the thesis here. In ruling that “the codes are ‘facts’ under copyright law,” the en banc majority reasoned, “It should be obvious that for copyright purposes, laws are ‘facts’: the U.S. Constitution is a fact; the Federal Tax Code and its regulations are facts; the Texas Uniform Commercial Code is a fact.”²²¹ In the courtroom, we may functionally distinguish law and facts, but otherwise what the court says

217 *Practice Mgmt. Info. Corp. v. Am. Med. Ass’n*, 121 F.3d 516, 519 (9th Cir. 1997), *amended by* 133 F.3d 1140 (9th Cir. 1998). The court added that the AMA “has no incentive to limit or forgo publication” and that the federal government had ample remedies if the AMA did, including “terminat[ing] its agreement with AMA.” *Id.*

218 *Banks v. Manchester*, 128 U.S. 244, 253 (1888). The *Practice Management* court cited similar reasoning from the Fifth Circuit. In *Texas v. West Publishing Co.*, 882 F.2d 171 (5th Cir. 1989), the court turned back Texas’ argument against West’s claim of copyright over its own arrangement of Texas laws. *Id.* at 175–76. After finding that Texans had access to Texas’ arrangement of its own state statutes, the court reasoned that, as to West’s “Vernon’s Annotated Texas Statutes,” there was “no evidence that anyone is being denied access to Vernon’s or that West intends to deny access in the future. Accordingly, Texas residents are not being deprived of any due process right they could conceivably have to access Texas laws.” *Id.* at 177.

219 *Practice Mgmt.*, 121 F.3d at 518.

220 *BOCA*, 628 F.2d at 732.

221 *Veeck II*, 293 F.3d at 801. This gave a ringing endorsement to Judge Little’s dissent in *Veeck I*. Judge Little had recognized that “there is merit to Veeck’s argument that *once enacted*, the codes do become a fact or idea, in that there is only one accurate way to express an enacted law. . . . By its very nature, an enacted law enters the public realm as a concrete, definite fact/idea.” *Veeck v. S. Bldg. Code Cong. Int’l*,

here comports with our intuitions. Most of us would say that income tax returns being due on April 15 is a fact; the speed limit on the highway you take to work is a fact; that parents are responsible for the torts of their minor children is a fact. If all of these are facts—and become so as a matter of statutes on the law books—how can these official building codes not be treated as massive compilations of fact à la *Feist*?

With this result, the majority reasonably felt compelled to distinguish the building codes which had “become law” from things “the law requires citizens to consult . . . in the process of fulfilling their obligations,” like the *Red Book* valuations or CPT medical codes.²²² This is the same distinction that Lawrence Cunningham draws between “strong” (or “semi-strong”) and “soft” adoption into the law²²³—and the reason I do not consider evaluation cases like *Practice Management* to be true “legal fact” situations. But the en banc dissent rightly criticized this line drawing and, as I will argue in the next Part, it is a distinction without much difference: the legal codes, the CPT, and the *Red Book* car valuations are all social facts in the Searlean sense.²²⁴ The groupings here (of naming, evaluative, and legal facts) have been for convenience; the key issue is status as a social fact. The argument then becomes that a law is a (social) fact that can be expressed in only one or a very limited number of ways, producing merger of expressive work and fact.²²⁵

While the due process argument can be limited as the courts in *Practice Management* and *Veck I* limited it (access means “access” and use, not reproduction), the traditional merger doctrine cannot be so limited. If there is merger of expression and fact, the copyright disappears, raising a colorable claim that the government decision to integrate or reference the privately created work produces a compensable “taking.”²²⁶ Part VI aims to convince the reader that this radical con-

Inc. (*Veck I*), 241 F.3d 398, 415 (5th Cir. 2001) (Little, J., dissenting), *rev'd en banc*, 293 F.3d 791 (5th Cir. 2002).

222 *Veck II*, 293 F.3d at 804–05.

223 See Cunningham, *supra* note 4, at 293.

224 See *infra* Part VI.

225 *Veck I*, 241 F.3d at 407. As the *Veck I* panel feared, “the adoption of SBCCI’s code into law was a transformative event that instantly denuded the work of copyright protection.” *Id.*

226 *Practice Mgmt. Info. Corp. v. Am. Med. Ass’n*, 121 F.3d 516, 520 (9th Cir. 1997) (quoting CCC Info. Serv., Inc. v. Maclean Hunter Mkt. Reports, Inc., 44 F.3d 61, 74 (2d Cir. 1994)), *amended by* 133 F.3d 1140 (9th Cir. 1998). The government would have to compensate the private party for the full value of the copyright, an ironic twist for sure, since governments adopt such privately created works to save costs. See Revision of OMB Circular No. A-119, Notice of Implementation, 58 Fed.

clusion is warranted in the sense that these are facts; Part VII aims to convince the reader that this radical conclusion can be avoided by judicious recalibration of the merger doctrine to take account of situations in which creation of the expression entails creation of the facts.

VI. BUT ARE THESE “FACTS”? AND, IF SO, WHAT HAPPENS?

In *Maclean Hunter*, Judge Leval announced a new distinction between “building-block” and opinion “infused” ideas, shielding expressions of the latter from copyright’s merger doctrine.²²⁷ In a 1999 speech, Judge Jon Newman offered the same distinction but inadvertently admitted that this device allows copyright to protect ideas:

[F]or copyright purposes, simply labeling an aggregation of facts as an idea does not help decide whether a particular aggregation is protectable. All ideas are not created equal. The unprotectable category includes those that undertake to advance the understanding of phenomena or the solution of problems, while the protectable category includes those that reflect the author’s taste and opinion.²²⁸

To use Judge Leval’s language, the problem with each *Red Book* car valuation is that it is both an opinion-infused idea *and* a necessary building block for lots of further human activity. To use Judge Newman’s distinction, car valuations both “reflect the author’s . . . opinion” and are “undertake[n] to advance . . . the solution of problems.”²²⁹ Used coin prices, restaurant ratings, medical procedure designations, settlement prices, and privately drafted model laws may be (initially) very much matters of opinion, but opinions systematically undertaken/formulated to solve problems.

Of course, that does not mean that these designations, evaluations, and privately drafted laws are facts in our copyright doctrine, let alone in our metaphysics. But anyone who wants to deny “factness” to designations, evaluations, and privately drafted laws has to reconsider all types of facts established through social institutions. Just as we may

Reg. 57,643, 57,644–45 (Oct. 26, 1993) (directing federal agencies to adopt private standards “whenever practicable” to “eliminate[] the costs to the Government of developing its own standards”). See generally Thomas F. Cotter, *Do Federal Uses of Intellectual Property Implicate the Fifth Amendment?*, 50 FLA. L. REV. 529, 558–65 (1998) (illustrating the difficulty of defining what constitutes a “taking” in merging expression and fact in intellectual property law).

227 *Maclean Hunter*, 44 F.3d at 72–73.

228 Jon O. Newman, *New Lyrics for an Old Melody: The Idea/Expression Dichotomy in the Computer Age*, 17 CARDOZO ARTS & ENT. L.J. 691, 698 (1999) (footnote omitted).

229 *Id.*

question whether a 2005 Chevy Malibu is really worth \$10,250 or a “Henry Hub natural gas futures contract is worth \$25,”²³⁰ we can ask—in the same philosophical tone of voice—the same question about *any* social fact. John Searle raises just the same objection to all social facts as we might make to a state’s bond rating or a used car valuation:

Our sense that there is an element of magic, a conjuring trick, a sleight of hand in the creation of institutional facts out of brute facts derives from the nonphysical, noncausal character of the relation of the X and Y terms In our toughest metaphysical moods, we want to ask “But is an X really a Y?” For example, are these bits of paper really *money*? Is making certain noises at a ceremony really *getting married*? Surely when you get down to brass tacks, these are not real facts.²³¹

Searle’s answer is that a social fact arises when (a) someone declares or states that such and such is the case, and (b) it becomes widely accepted that such and such is the case.²³² That green, rectangular piece of paper is twenty dollars because the U.S. Treasury declares it to be²³³ and we all accept that.²³⁴

Similarly, a designation—whether an airplane type (“787”) or a person (“Rock Hudson”²³⁵)—is only treated as a fact when it is widely accepted by the relevant community. The same is true with credit ratings²³⁶ and other numeric evaluations. In the *Kapes* case, CDN was alleged to have promoted its wholesale coin prices as facts²³⁷—a charge also leveled against NYMEX.²³⁸ And if those used coin values were widely accepted, CDN was right to do so. Widespread accept-

230 *N.Y. Mercantile Exch., Inc. v. IntercontinentalExchange, Inc.*, 497 F.3d 109, 117 (2d Cir. 2007).

231 SEARLE, *supra* note 37, at 45.

232 *Id.* at 45–46.

233 As Searle observes, “When the Treasury says [this piece of paper] is legal tender, they are *declaring* it to be legal tender, not announcing an empirical fact that it already is legal tender.” *Id.* at 55.

234 *See id.* at 112 (“We have nothing but the ability to impose a status, and with it a function, by collective agreement or acceptance.”).

235 Born Roy Scherer. *See* KEITH BOYKIN, *BEYOND THE DOWN LOW* 71 (2006).

236 For example, there has never been any doubt that credit ratings are “customer information of a financial institution” under 15 U.S.C. § 6827(2) (2000), defined as “any information maintained by or for a financial institution which is derived from the relationship between the financial institution and a customer of the financial institution and is identified with the customer,” *id.*

237 *CDN Inc. v. Kapes*, 197 F.3d 1256, 1262 (9th Cir. 1999).

238 *N.Y. Mercantile Exch., Inc. v. IntercontinentalExchange, Inc.*, 497 F.3d 109, 115 n.6 (2d Cir. 2007).

ance may take time; but social facts can also arise abruptly. Indeed, the example Searle gives of social facts arising abruptly is “where legislation is passed or the authorities change the rules of the game”²³⁹—just as the *Veck* en banc majority understood.²⁴⁰ But even in those cases there must be acceptance (or at least not general, active rejection) by the society.²⁴¹

A. *Fact or Fiction?*

One might ask how all this relates to the “facts” created by works of literature. Indeed, the only American court to use the phrase “created facts” did so in relation to “facts” within a fictional storyline,²⁴² and it is fair to say that well-known literary or artistic narratives establish widely known, socially accepted details, e.g., that Ahab lost a leg to the white whale;²⁴³ that ground control lost contact with Major Tom;²⁴⁴ that Bruce Wayne is Batman²⁴⁵—as surely as Peter Parker is

239 SEARLE, *supra* note 37, at 125.

240 *Veck v. S. Bldg. Code Cong. Int'l, Inc. (Veck II)*, 293 F.3d 791, 799 (5th Cir. 2002) (en banc).

241 Simon Blackburn also observes this point when he writes of facts arising from law: “In the case of human law,” it “ought to be the command of a properly constituted authority—but then, what kind of fact is it that some group of people makes up such an authority?” BLACKBURN, *supra* note 18, at 110–11. Of course, a statement becomes law—and a fact—through a “performative” speech utterance. *See generally* J.L. AUSTIN, *HOW TO DO THINGS WITH WORDS* 53–66 (J.O. Urmson & Marina Sbisa eds., 2d ed. 1975) (distinguishing the performative from the constative utterance); SEARLE, *SPEECH ACTS*, *supra* note 74, at 37–39 (discussing “performative” verbs); Justin Hughes, *Group Speech Acts*, 7 *LINGUISTICS & PHIL.* 379, 380 (1984) (describing court decisions as speech acts from groups). If the “performative” is accepted—that Jane and Peter are now married, that Charles is now coronated King, etc.—then it is “felicitous”; only then does it become a social fact. And as Derrida noted, “There are cases in which it is not known for generations if the performative of the violent founding of a state is ‘felicitous’ or not.” Jacques Derrida, *Force of Law: The “Mystical Foundation of Authority,”* 11 *CARDOZO L. REV.* 919, 993 (Mary Quaintance trans., 1990).

242 *See Castle Rock Entm’t, Inc. v. Carol Publ’g Group, Inc.*, 150 F.3d 132, 139 (2d Cir. 1998) (recognizing that the “original, protected expression” at issue—character and event details from the television series *Seinfeld*—were “created facts”). Scholars who have used the phrase “created facts” are few too, but include Karjala, *supra* note 5, at 477.

243 HERMAN MELVILLE, *MOBY DICK* (Arion Press 1979) (1851).

244 DAVID BOWIE, *Space Oddity*, on *SPACE ODDITY* (Philips 1969).

245 One could cite literally thousands of sources for this, but although Bob Kane created Batman in 1939, *see* MARK S. REINHART, *THE BATMAN FILMOGRAPHY* 5 (2005), my favorite is FRANK MILLER ET AL., *THE DARK KNIGHT RETURNS* (10th anniversary ed. 1996).

Spiderman;²⁴⁶ that Marge is married to Homer²⁴⁷—as surely as Wilma is married to Fred.²⁴⁸ To consider the widely known, socially accepted nature of these details conduct a thought experiment: if there had been no footnotes in this paragraph, would you have known these things to be “true?” And yet, as Jeanette Winterson says, “The truth of fiction is not the truth of railway tables.”²⁴⁹

I have repeatedly said that the created fact cases above generate designations, evaluations, and propositions that are necessary for further activity, expressive and nonexpressive. It is tempting to say that this distinguishes them from facts in a fictional storyline because elements of fiction are rarely needed for *nonexpressive activity*. You might need *Star Trek* for your “Slash” stories—this is the whole “recoding” debate in copyright scholarship²⁵⁰—but you do not need any details from Faulkner or *Star Wars* to sell your used car, get reimbursed for medical services rendered, or engage in construction as a line of work. Not only do people *rely* upon authored designations, evaluations, and laws for subsequent nonexpressive activity, but we normatively accept and expect such reliance across the board; we believe that such reli-

246 Spider-Man first appeared in 15 AMAZING FANTASY (Aug. 1962), see EDWARD GROSS, SPIDER-MAN CONFIDENTIAL 8 (2002), and is the subject of three blockbuster films creatively titled, SPIDER-MAN (Columbia Pictures 2002), SPIDER-MAN 2 (Columbia Pictures 2004), and SPIDER-MAN 3 (Columbia Pictures 2007).

247 See, e.g., CHRIS TURNER, PLANET SIMPSON 77 (2004).

248 *The Flintstones* (ABC television broadcast 1960–66). Although there were only 166 episodes in the original cartoon series, see Internet Movie Database, *The Flintstones*, <http://www.imdb.com/title/tt0053502> (last visited Oct. 22, 2007), it has enjoyed wildly successful and continuous syndication—plus network specials, spin-off series like *The Pebbles and Bamm-Bamm Show* (Hanna-Barbera Productions television broadcast 1971–76), and two feature films starring John Goodman and, in one film or the other, a bunch of actors who should have known better (including Rosie O'Donnell, Kyle MacLachlan, Halle Berry, Elizabeth Taylor, Stephen Baldwin, Joan Collins, and Alan Cumming), see, e.g., THE FLINTSTONES IN VIVA ROCK VEGAS (Universal Pictures & Amblin Entertainment 2000).

249 JEANETTE WINTERSON, ART OBJECTS 54 (1995).

250 See, e.g., Keith Aoki, *Adrift in the Intertext: Authorship and Audience “Recoding” Rights—Comment on Robert H. Rotstein, “Beyond Metaphor: Copyright Infringement and the Fiction of the Work,”* 68 CHI.-KENT L. REV. 805, 811–16 (1993); James Boyle, *A Theory of Law and Information: Copyright, Spleens, Blackmail and Insider Trading*, 80 CAL. L. REV. 1413, 1426–27 (1992); Rosemary J. Coombe, *Author/izing the Celebrity: Publicity Rights, Postmodern Politics, and Unauthorized Genders*, 10 CARDOZO ARTS & ENT. L.J. 365, 387 (1992); Justin Hughes, *“Recoding” Intellectual Property and Overlooked Audiences*, 77 TEX. L. REV. 923, 926 (1999); Peter Jaszi, *On the Author Effect: Contemporary Copyright and Collective Creativity*, 10 CARDOZO ARTS & ENT. L.J. 293, 294 (1992); Jessica Litman, *The Public Domain*, 39 EMORY L.J. 965, 1007 (1990); Rebecca Tushnet, *Legal Fictions: Copyright, Fan Fiction, and a New Common Law*, 17 LOY. L.A. ENT. L. REV. 651, 659–64 (1997).

ance is (nearly?) always useful. In contrast, undue reliance on details from popular film and television to manifest the expressive activities of one's life is often considered suboptimal: Radin might say this is not "human flourishing";²⁵¹ William Shatner might tell Trekkies to "get a life."²⁵² For good reason, we might not want to treat these details of literature as facts.²⁵³

Of course, even if utility can distinguish the created facts in designations, evaluations, model laws, etc. from the details created in literature and the arts, utility should not be an indicator of "factness" or truth-status. As Simon Blackburn notes, "Truth has rights and privileges of its own, and they are not just the same as utility";²⁵⁴ indeed, when it comes to utility, "in many circumstances an adaptive illusion will do just as well as truth."²⁵⁵

For one who adheres to the correspondence theory of truth, the difference between these created fact cases and "fictional facts" is, in some sense, where the fact is "located." If someone says, "Is Marge really the wife of Homer?" we are likely to disabuse them of the notion that Marge and Homer are real, living people with something like, "Marge is really the wife of Homer on *The Simpsons* show."²⁵⁶ In contrast, the CPT codes, the *Red Book* valuations, and the building code of Savoy, Texas, take on a life outside the expressive work where they first appear. Fictional facts can be inconsistent—they do not have to "cohere" because they are understood to be located within and only within the expressive work.²⁵⁷

251 See MARGARET JANE RADIN, *CONTESTED COMMODITIES* 79–102 (1996) (discussing market rhetoric and its effect on "human flourishing").

252 WILLIAM SHATNER WITH CHRIS KRESKI, *GET A LIFE!* (1999). The title comes, as Amazon.com says, from Shatner "[p]oking fun at *Star Trek*'s gung-ho fans and conventions in a now infamous *Saturday Night Live* sketch." Amazon.com, Book Review of *Get a Life!*, <http://www.amazon.com/Life-Star-Trek-William-Shatner/dp/0671021311> (last visited Oct. 22, 2007).

253 My thanks to David McGowan for this observation.

254 BLACKBURN, *supra* note 18, at 9.

255 *Id.* at 105 (discussing Nietzsche).

256 Although, as one scholar notes, "[f]ans seemingly blur the boundaries between fact and fiction, speaking of characters as if they had an existence apart from their textual manifestations." HENRY JENKINS, *TEXTUAL POACHERS* 18 (1992).

257 As Blackburn writes about believing something to be true:

A belief is given its identity by what it excludes.

A fiction is not. We can happily read one story about a fictional character, and then a different story, without finding it necessary to reconcile them. True, aficionados can get very shirty if in one story it is said that the hero has fair hair and in the next story he is said to have black hair, but that is because they are trying to join the two stories together, which they don't

B. Facts, Utility, and Processes

In keeping with what I have just said, it is tempting to focus on the functional aspect or “essentiality” of created facts. As with many other social facts, in a created fact situation the expression becomes important, if not essential, to functional, nonexpressive activities in the society.²⁵⁸ Just as that rectangular green paper being a twenty dollar bill has functional implications, credit ratings, economic valuations, estimates of material strength, and designations (particularly those in classificatory taxonomies) are all used by people to do things—purchase cars, trade baseball cards, build buildings, decide where to eat, order the right size and kind of parts, etc. Private expression integrated into the law is the most straightforward example of expressions becoming essential to functional activities. If the law is precise—that the walls of two-storied wood frame buildings must have two-inch by four-inch studs that are centered at sixteen inches or closer—then access to the expression is necessary for nonexpressive activity (construction).

But the analysis here is quite different from Lawrence Cunningham’s analysis of these cases as private expression being integrated into *public law*.²⁵⁹ The argument here focuses on *expression becoming fact*—of which *expression becoming law* (Cunningham’s concern) is just

have to do. Whereas if the stories were histories of one actual man, they would have to be reconciled.

BLACKBURN, *supra* note 18, at 192.

258 Defining what is “functional” or “utilitarian” has plagued jurists—as well as scholars—for some time. For example, in *Computer Associates International, Inc. v. Altai, Inc.*, 982 F.2d 693 (2d Cir. 1992), in trying to identify the “functional,” Judge Walker compared the Humpty Dumpty story to a recipe for scrambled eggs by saying the latter is “a more process oriented text.” *Id.* at 704. A recipe, of course, is aimed at a nonexpressive human activity.

259 Professor Cunningham distinguishes between “weak,” “semi-strong,” and “strong” adoption of private expression into public law. Cunningham, *supra* note 4, at 293. His paradigmatic examples are “ex ante government designation of the standard setter as an officially recognized body (strong form),” *id.*; standards “incorporate[ed] into law after creation” by a private entity (semi-strong form), *id.*; and adoption through “passing reference in legal materials (weak form),” *id.* He posits that access to the expression is most needed in cases of “strong” adoption, less with “semi-strong,” and even less with “weak.” *Id.* I do not find that this tripartite division adequately captures the important differences and similarities among the ways private expression is adopted into law. For example, he says that with “strong form” adoption the “distinguishing feature” is that the privately generated expressions “constitute the fabric of that law,” *id.* at 299, but that is apparently true of the semi-strong too. Cunningham posits an inverse relationship between how much people need access to these codes and how much copyright incentive is needed to produce, i.e., the more access is needed, the less copyright incentive is needed. *Id.* at 299–300. This might

one form. Indeed, in *Practice Management*, *Delta Dental*, *Maclean Hunter*, and *Veeck* the private expression was adopted (one way or another) into law because it was already widely agreed upon as the standard. Governments adopt existing, privately created standards not just to avoid (the cost of) reinventing the wheel: they adopt existing, privately created standards because those standards have legitimacy and social reference already. A cardiopulmonary resuscitation had already become a 92950 by the time Medicaid adopted the AMA taxonomy; the value of your ten-year-old, driven-only-on-Sundays sedan had already become whatever value the *Red Book* said it was when the values were adopted by reference into state insurance laws.

The ADA code designations, the CDN coin valuations, and the Southco parts numbers were all social standards—and created facts—without needing to be integrated into law. Peter Menell has explored how courts from the mid-1980s forward have declined to find copyright protection (often on the grounds of merger) in cases where similarity in computer programs has been dictated (a) by standard practices in the industry for which the software programs are designed,²⁶⁰ (b) by methods or practices that a large population has come to rely upon for daily activities,²⁶¹ and (c) by the need to operate on common hardware or with common software.²⁶² The functionality of such computer programs, communications protocols, and software interfaces is usually—and profitably—analyzed in terms of the § 102(b) bar on processes and methods of operation.²⁶³

be generally right, but this appears to be an empirical question that deserves careful attention.

260 See *Plains Cotton Coop. Ass'n v. Goodpasture Computer Serv., Inc.*, 807 F.2d 1256, 1260–61 (5th Cir. 1987) (denying plaintiff's request for a preliminary injunction in a copyright suit in light of evidence showing that software was created based on personal skills and knowledge of the industry).

261 See *Lotus Dev. Corp. v. Borland Int'l, Inc.*, 49 F.3d 807, 815 (1st Cir. 1995) (finding that a computer command hierarchy was an unprotectable method of operation); Peter Menell, *An Epitaph for Traditional Copyright Protection of Network Features of Computer Software*, 43 ANTITRUST BULL. 651, 684–703 (1998).

262 See *Batesman v. Mnemonics, Inc.*, 79 F.3d 1532, 1542 (11th Cir. 1996) (“[E]xternal considerations such as compatibility may negate a finding of infringement.”); *Computer Assocs. Int'l, Inc. v. Altai, Inc.*, 982 F.2d 693, 714–15 (2d Cir. 1992) (holding that functional elements are not protected). See generally Peter Menell, *An Analysis of the Scope of Copyright Protection for Application Programs*, 41 STAN. L. REV. 1045, 1101–03 (1989) (arguing that a careful application of the merger doctrine can create incentives for the development of better computer application programs); Peter Menell, *Tailoring Legal Protection for Computer Software*, 39 STAN. L. REV. 1329, 1353–71 (1987) (analyzing the economic effects of using copyright doctrine to provide legal protection for computer software).

263 17 U.S.C. § 102 (2000).

Social facts are like standardized industry practices, particularly as to a social fact's existence being conditioned on widespread acceptance in the society or relevant portion of the society. It is easy to see that some protocols—like the generally accepted accounting principles (GAAP) become both social facts and “methods of operation”: it becomes impossible to do the process (accounting) without the expression. This is true as long as schools teach GAAP, businesses use GAAP, and markets expect businesses to use GAAP—GAAP is then integral to the process of accounting regardless of the integration of GAAP into law. It is not as obvious how a used car valuation or a parts designation can be an uncopyrightable “process,” but there is some parallelism: once it is widely accepted, a designation (like “787” or “Rock Hudson”) is a social convention—a communication standard, so to speak. Like technical or industry standards, it becomes the only reasonable way to do something—in this case, the only reasonable way to refer to *X* is using *X*'s name.²⁶⁴ So it might be possible to subsume the recognition of created facts into recognition of expressions which become communication “protocols” that are necessary for nonexpressive activity.

Nonetheless, as long as we subscribe to facts and a correspondence theory of truth (in the way our legal system generally does), the designation and evaluation cases discussed above feel like something more than communication protocols. In these cases, original expression becomes the basis for universally accepted propositions of the form “this is *X*,” “that is *Y*,” “*A* is *B*” that seem to have truth values. These are social facts generated directly from what copyright calls “original expression” and from what copyright calls “authors.” That is the created facts problem—and the gaping hole in the Feistian scheme of things.

The problem is that an honest assessment that these evaluations, judgments, and designations produce social facts can lead to blunt application of the merger doctrine—and, thereby, eliminate any pos-

²⁶⁴ It is for this reason that “nominative uses” of words and short phrases are shielded from liability under Lanham Act analysis. See *New Kids on the Block v. News Am. Publ'g, Inc.*, 971 F.2d 302, 308 (9th Cir. 1992) (“[N]ominative use of a mark—where the only word reasonably available to describe a particular thing is pressed into service—lies outside the strictures of trademark law.” (emphasis omitted)); *Chambers v. Time-Warner, Inc.*, 123 F. Supp. 2d 198, 202 (S.D.N.Y. 2000) (dismissing, on summary judgment, a Lanham Act claim for use of musicians' names to identify musicians' works in online service because “the above-described [use] is simply a permissible ‘nominative use,’ *i.e.*, a fair use of the artist's name as a *necessary means of accurately identifying the inventory in question* offered by MP3.com”) (second emphasis added), *vacated*, 282 F.3d 147 (2d Cir. 2002).

sible copyright incentive. To understand this, we have to recognize that the merger doctrine works differently with what we call “ideas” and what we call “facts.”

The merger doctrine is notoriously malleable. With ideas, the doctrine’s indeterminacy comes from trying to apply an either/or dichotomy—with draconian implications—to a multilayered world. Resting on top of any given expression, there is, metaphorically, a stack of increasingly abstract ideas.²⁶⁵ At the bottom of the stack, there may be a *least* abstract, most precise idea expressible only in the words chosen—if that’s the “idea” in merger doctrine, there would be no copyright.²⁶⁶ At the other end, one can always find an idea so abstract that there is definitely no merger. For example, the original brain-in-a-vat science fiction story, “Donovan’s Brain,”²⁶⁷ became, according to its author, “the acknowledged basis for three movies, as well as perhaps 50 more that appropriated the basic idea.”²⁶⁸ Distinguishing between the three films and the fifty films makes sense to us because we know that the reference to a “basic idea” is a reference to a *highly abstracted, very general* idea. It is the same notion that Judge Hand presented in saying that a filmmaker would not infringe a stage play if he used “only the more general patterns” of the play.²⁶⁹

But notions of the “basic idea” or the “general pattern” are not useful when it comes to facts and expressions of facts. We would not say that the expression of a specific temperature reading in Chicago at

265 This vertical metaphor of ideas on top of expressions should be intuitive for most people thinking about this issue, i.e., in *Sid & Marty Krofft Television Productions, Inc. v. McDonald’s Corp.*, 562 F.2d 1157 (9th Cir. 1977), the court describes liability as occurring only when the defendant’s own expression of ideas shared with the plaintiff’s work “*descends* so far into what is concrete in a work as to invade its expression,” *id.* at 1163 (emphasis added), a description which has appealed to other courts, see *Hartman v. Hallmark Cards, Inc.*, 639 F. Supp. 816, 819 (W.D. Mo. 1986); *Perma Greetings, Inc. v. Russ Berrie & Co.*, 598 F. Supp. 445, 447 (E.D. Mo. 1984). And, of course, the discussion of “levels” of abstraction related to an expression also implies this vertical metaphor. See, e.g., *Feder v. Videotrip Corp.*, 697 F. Supp. 1165, 1173 (D. Colo. 1988). On other occasions, courts have employed the vertical metaphor in the other direction, finding the idea *underneath* the expression. See, e.g., *Cont’l Cas. Co. v. Beardsley*, 253 F.2d 702, 706 (2d Cir. 1958) (discussing the need for “free use of the thought *beneath* the [copyrighted] language” and the “use of the underlying idea”) (emphasis added).

266 Cf. John Shephard Wiley Jr., *Copyright at the School of Patent*, 58 U. CHI. L. REV. 119, 123 (1991) (suggesting that if copyright law protected only the literal expression of an idea, then every admitted copier would have a defense).

267 See Douglas Martin, *Curt Siodmak Dies at 98; Created Modern “Wolf Man,”* N.Y. TIMES, Nov. 19, 2000, § 1, at 56.

268 *Id.*

269 *Sheldon v. Metro-Goldwyn Pictures Corp.*, 81 F.2d 49, 54 (2d Cir. 1936).

noon on May 4, 2007 (say, “sixty-three degrees Fahrenheit”) is protectable because, after all, it does not propertize the *basic idea* of a temperature in Chicago at noon on May 4, 2007 (or of a temperature in Chicago, more generally). There is something irrelevant about this kind of reasoning: we are not concerned about more abstract levels when it comes to facts. An *abstract fact* is a classification, a theory, a law of nature, i.e., that there will be a *temperature* in Chicago on May 4, 2007. This is what is so dissatisfying about Judge Leval’s comment in *Maclean Hunter* that the plaintiff’s “ideas” were general ideas of used car valuations²⁷⁰—and why the same argument did not fly in *NYMEX*. What matters to us are the precise valuations.²⁷¹ Those precise valuations are social facts; the social facts and the expression of those facts are merged.

In many cases—as in *Feist*—drawing a distinction between facts and expression of facts is an extra, pointless step. Facts are always unprotected and, at least in databases, there is almost always merger between them and their expressions. That is what produces the bind with created facts. After *Feist*, if a court recognizes that the expressions in a nonfictional database are as much expression of facts as the phone numbers in *Feist*, the merger doctrine proceeds swiftly and surely to denude the work of any copyright protection beyond selection and arrangement.²⁷²

VII. PRESERVING INCENTIVES WHEN INCENTIVES ARE NEEDED

As postindustrial economic development proceeds, valuable nonfictional databases filled with evaluations, judgments, and designations (and business models based on these databases) will only proliferate. As will the likely disputes about who controls the contents and how. If being honest about “facts” means the merger doctrine will knock out copyright protection for many of these works, is that a problem? Arguably yes, for a discrete subset of these information products. For such products, we will need to find ways to curb and/or probably recalibrate the merger doctrine. To that end, let’s consider what kinds of “created fact works” may need the incentive of copyright and what limiting doctrines of copyright can be brought to bear in

270 *CCC Info. Servs., Inc. v. Maclean Hunter Mkt. Reports, Inc.*, 44 F.3d 61, 71 (2d Cir. 1994).

271 And, similarly, this is what seems so irrelevant about the *Veck I* court telling us that “there are at least two other sets of building codes that currently compete with SBCCI’s.” *Veck v. S. Bldg. Code Cong. Int’l, Inc. (Veck I)*, 241 F.3d 398, 407 (5th Cir. 2001), *rev’d en banc*, 293 F.3d 791 (5th Cir. 2002).

272 *See Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 363 (1991).

balancing the need to have incentives for the expression with the need to have access to the facts created by the expression.

A. *Determining Where Incentives Are Needed*

In considering whether the copyright incentive is needed, we must recognize that many facts will be “created” by people for noneconomic incentives, such as a sense of civic or professional duty. Within the economic realm, we should also distinguish between economic incentives dependent on copyright and other economic incentives. Without delving into the minefield about whether such determinations should affect copyright protection more broadly (there are lots of reasons to think they shouldn’t), let us consider these issues in relation to the eight cases discussed above.

The most obvious of the cases are *Southco* and *NYMEX*. For-profit *Southco* had a strong business incentive to give designations to its parts—indeed, it could not carry on a parts-selling business without doing so. No copyright protection is needed for that economic incentive to remain stable. The *NYMEX* litigation also seems a simple case because (a) preparation of the settlement prices is mandatory for NYMEX to carry on its business and (b) disclosure of the prices is legally required—by the Commodity Futures Trading Commission²⁷³—for NYMEX to be in that business.²⁷⁴ In contrast, *Maclean Hunter* seems at the other extreme: the copyright owner’s for-profit business was producing and selling the expression, not to mention that substantial numbers of its customers were migrating to the cheaper service that the defendant was able to offer by freely copying *Maclean Hunter*’s expressions.²⁷⁵ This persuasive distinction clearly animated the Second Circuit’s decision in *NYMEX*: after recognizing the fear thirteen years earlier that without copyright *Maclean Hunter* “‘might direct their energies elsewhere, depriving the public of their creations,’” the court concluded that “NYMEX needs no such incentives.”²⁷⁶

The rest of the cases seem to fall somewhere between these two, potentially pointing to the need to make careful determinations whether the copyright incentive is needed in situations involving “cre-

273 See 17 C.F.R. § 16.01 (2007).

274 See *N.Y. Mercantile Exch., Inc. v. IntercontinentalExchange, Inc.*, 497 F.3d 109, 110 (2d Cir. 2007).

275 *CCC Info. Servs., Inc. v. Maclean Hunter Mkt. Reports Inc.*, 44 F.3d 61, 64 (2d Cir. 1994).

276 *N.Y. Mercantile Exch.*, 497 F.3d at 118 (quoting *Maclean Hunter*, 44 F.3d at 66 (2d Cir. 1994)).

ated fact” works. In *Practice Management* and *Delta Dental*, the courts expressly concluded that the copyright holder needed the incentive of copyright,²⁷⁷ but the status of each as a nonprofit, professional association raises the legitimate issue of whether that was really true. The nonprofit status hardly settles the issue—nonprofit organizations can certainly depend on publication sales for their operations;²⁷⁸ in *Veeck* this precise point was contested among the various opinions.²⁷⁹ The status of the group as a professional association—intent on rendering beneficial services to the profession—seems a stronger argument for why the copyright incentive is not needed. Further along this spectrum, the case against copyright incentive being genuinely needed seems even stronger when the “author” is a professional association intent on getting its expression enacted into law (as in *BOCA*); at that point, professional prestige and public service seem to be the driving forces. This was an important argument for the *Veeck II* majority.²⁸⁰

In these types of cases, perhaps district courts need to do a more thorough job developing evidence of the copyright holder’s business model—presumably they would do so if they knew that the way in which they were to apply the merger doctrine turned on whether copyright was needed to bring the expression (and, hence, the facts) into existence.

B. *Fair Uses, Implying Licenses, and Recalibrating the Merger Doctrine*

If there remains a kernel of situations where the copyright incentive seems quite important for production of the expression and, therefore, the facts, what are we to make of copyright’s limiting principles in such situations? Before turning to the merger doctrine—and

277 See *Am. Dental Ass’n v. Delta Dental Plans Ass’n*, 126 F.3d 977, 981 (7th Cir. 1997); *Practice Mgmt. Info. Corp. v. Am. Med. Ass’n*, 121 F.3d 516, 518–19 (9th Cir. 1997), amended by 133 F.3d 1140 (9th Cir. 1998).

278 The finances are often hard to figure out. For example, roughly eighteen percent of the revenues of the American Institute of Certified Public Accountants (AICPA) come from sales of accounting standards. AM. INST. OF CERTIFIED PUB. ACCOUNTANTS, 2002–2003 ANNUAL REPORT 17 (2003). But Professor Cunningham discusses how the AICPA sales operation sustained deficits in the early 2000s. Cunningham, *supra* note 4, at 320.

279 In *Veeck II*, the majority characterized the evidence that copyright revenues were needed as “self-serving affidavits from [SBCCI] officers and employees and proof that it earns perhaps 40% of its revenue” from selling copies of its model codes. *Veeck v. S. Bldg. Code Cong. Int’l, Inc. (Veeck II)*, 293 F.3d 791, 805 n.21 (5th Cir. 2002) (en banc).

280 See *id.* at 805; see also Cunningham, *supra* note 4, at 304 (analyzing the *Veeck II* majority’s emphasis on the inherent incentive industry experts have to get codes enacted in law).

how it sweeps too broadly in *Maclean Hunter*-type situations—let us consider what happens with fair use and the doctrine of implied licenses when we understand these works as “factual works.”

1. Fair Use and Implied Licenses for Created Fact Works

Concluding that a copyrighted work is principally a (created) factual work affects the fair use analysis because “[t]he scope of fair use is greater with respect to factual than non-factual works.”²⁸¹ Mechanically, a determination that a plaintiff’s work is a created fact work would impact the fair use analysis principally through the second factor.²⁸² In *Harper & Row v. Nation Enterprises*,²⁸³ the Court told us that this factor, the nature of the copyrighted work, recognizes “a greater need to disseminate factual works than works of fiction or fantasy.”²⁸⁴ The Court quoted Professor Gorman approvingly for the notion that “[t]he extent to which one must permit expressive language to be copied, in order to assure dissemination of the underlying facts, will thus vary from case to case.”²⁸⁵ With created fact works of the sort considered in this Article, the expression is probably the only way to “assure dissemination of the underlying facts.”²⁸⁶ Thus, one could argue that the fair use doctrine, by itself, would permit extensive copying of a created facts work. This could cover the activities of the defendants in *Southco*, *Kapes*, and perhaps *NYMEX*.

On the other hand, in many of these opinions with grand propositions about access to factual works—*Harper & Row*, *American Geophysical*—fair use is *not* found. This is probably because the fourth fair use factor—effect on the plaintiff’s market²⁸⁷—has been both doctrinally and descriptively dominant.²⁸⁸ If that is correct, it suggests that

281 *New Era Publ’ns, Int’l v. Carol Publ’g Group*, 904 F.2d 152, 157 (2d Cir. 1990); *see also Stewart v. Abend*, 495 U.S. 207, 237 (1990) (“In general, fair use is more likely to be found in factual works than in fictional works.”); *Am. Geophysical Union v. Texaco Inc.*, 60 F.3d 913, 925 (2d Cir. 1994) (adopting the same reasoning).

282 *See* 17 U.S.C. § 107(2) (2000). The first factor, “the purpose and character of the [defendant’s] use,” *see id.* at § 107(1), is sufficiently open-ended that we could include “for compliance with the law” as a characteristic of the circumstances that should weigh in the defendant’s favor. But this effect on the fair use analysis is not directly related to understanding the expressive works as producing facts.

283 471 U.S. 539 (1985).

284 *Id.* at 563.

285 *Id.* (quoting Robert A. Gorman, *Fact or Fancy? The Implications for Copyright*, 29 J. COPYRIGHT SOC’Y U.S.A. 560, 563 (1982)).

286 *Id.*

287 *See* 17 U.S.C. § 107(4) (2000).

288 Barton Beebe, *An Empirical Study of U.S. Copyright Fair Use Opinions, 1978–2005*, 156 U. PA. L. REV. (forthcoming 2007) (manuscript at 55–59), available at <http://ssrn>.

wholesale copying as in *Maclean Hunter*, *Delta Dental*, *Veech*, and *BOCA*, or as was sought in *Practice Management*, would not be tolerated under fair use.²⁸⁹ In contrast, the implied license doctrine may both cover the most important created fact cases and prompt a certain amount of self-selection on the question of copyright incentives.

As the name indicates, implied licenses in copyright may be inferred from words or conduct.²⁹⁰ The model code cases seem particularly apt for this treatment: once the model code is written, the professional association effectively “hands it over” to the government knowing that the government will reproduce and distribute the expression. In the case law, these are paradigmatic indicators of an implied license,²⁹¹ particularly “the delivery of the copyrighted material without warning that its further use would constitute copyright infringement.”²⁹² Further, it is reasonable to think that the association’s agreement—or lack of objection—to integration of its model code into law grants an implied license for derivative works, i.e., amendment and modification of the code.²⁹³

com/abstract=998421 (concluding that the fourth factor of § 107 is dispositive in most cases).

289 The Nimmer treatise reasons that adoption of a private work into law may enlarge the range of private copying which is protected by the fair use doctrine, but should not immunize a commercial publisher who wants to compete with the copyright owner, since this would “prove destructive of the copyright interest in encouraging creativity in connection with the increasing trend toward state and federal adoptions of model codes.” 1 NIMMER & NIMMER, *supra* note 17, § 5.12[A], at 5-92 to -93.

290 3 NIMMER & NIMMER, *supra* note 17, § 10.03[A][7], at 10-49 (“[N]onexclusive licenses may . . . be granted orally, or may even be implied from conduct.”).

291 See, e.g., *Effects Assocs. v. Cohen*, 908 F.2d 555, 558 (9th Cir. 1990) (“Effects created a work at defendant’s request and handed it over, intending that defendant copy and distribute it.”); see also *I.A.E., Inc. v. Shaver*, 74 F.3d 768, 776 (7th Cir. 1996) (“In the case before us, as in *Effects*, Mr. Shaver created a work at Joint Venture’s request and handed it over, intending Joint Venture to copy and distribute it for the Airport Project.”).

292 *Effects*, 908 F.2d at 559 n.6. When an association has “encourage[d], through a licensing program, public authorities such as states to adopt” its model code, *Bldg. Officials & Code Adm’rs v. Code Tech., Inc.*, 628 F.2d 730, 732 (1st Cir. 1980), the only alternative to the association anticipating the widespread reproduction of the adopted law would be the unsavory scenario in which the association would plan to charge monopoly rents after state adoption, see *id.* at 732–35. In other words, the state adoption was like the state awarding a supply contract, except that the citizens, instead of the state coffers, pay directly for the state’s supply of “law.”

293 *Gracen v. Bradford Exch.*, 698 F.2d 300, 303 (7th Cir. 1983) (indicating that a contest to prepare derivative works was the basis for an implied nonexclusive license to contestants).

A tantalizingly similar case where implied license through government use might have been inferred is the 2000 *SmithKline Beecham v. Watson Pharmaceuticals*²⁹⁴ case in which SmithKline sued a generic drug manufacturer for copying SmithKline's copyrighted labels and user guides, despite the generic drug manufacturer being *required* to copy the materials by the Food & Drug Administration.²⁹⁵ Although the defendant raised the issue of implied license, the court decided that the Hatch-Waxman Act directly obviated the copyright claim without need to pass through implied license or fair use analyses.²⁹⁶ Not satisfied with its strict legal analysis—and in keeping with the discussion here—the court engaged in a substantial analysis and concluded that SmithKline did not need copyright incentive for the preparation of the labels, user's guide, etc.²⁹⁷

Such an implied license obviously seems to cover government and government-authorized publishers—and it is not difficult to extend it to other publishers based on a general understanding that “law” may be freely copied.²⁹⁸ The implied license argument reasonably extends to situations like *NYMEX* (and *SmithKline*) where both the expression and its publication were legally required to engage in an otherwise lucrative business.²⁹⁹ (In all these cases, for sure, there are counterarguments.) But the implied license argument seems to have little traction with cases like *Maclean Hunter*, *Kapes*, and *Southco*—in which the putative copyright holder did no single act to “hand over”

294 211 F.3d 21 (2d Cir. 2000).

295 *Id.* at 23. Although there was some back and forth between Watson and the FDA, “the FDA ‘determined that Watson had to copy verbatim substantially all of the text used in the SmithKline user’s guide.’” *Id.* at 24 (quoting *SmithKline Beecham Consumer Healthcare, L.P. v. Watson Pharms., Inc.*, No. 99 Civ. 9214, 1999 WL 1243894, at *4 (S.D.N.Y. Dec. 22, 1999)).

296 *SmithKline*, 211 F.3d at 25 (“The Hatch-Waxman amendments to the FDCA not only permit but require producers of generic drugs to use the same labeling as was approved for, and is used in, the sale of the pioneer drug [T]he FDA’s requirement that Watson use much of SmithKline’s label precludes a copyright infringement action [W]e need not address either the fair use or implied license defenses.”).

297 *Id.* at 28–29.

298 On the theory that “there is ample support for the proposition that implied license scope in general is determined by considering the reasonable expectations of the parties in view of all of the circumstances, including the parties’ conduct.” Mark D. Janis, *A Tale of the Apocryphal Axe: Repair, Reconstruction, and the Implied License in Intellectual Property Law*, 58 MD. L. REV. 423, 502 (1999).

299 Although it is fair to ask what would happen if a professional association then tried to withdraw its implied license. See *Jacob Maxwell, Inc. v. Veeck*, 110 F.3d 749, 753 (11th Cir. 1997) (withdrawing an implied license after several months’ use of a song).

its copyrighted work. To extend the doctrine to those situations would really involve either some kind of laches or acquiescence argument (more familiar to trademark law) or a kind of the-value-is-the-public's-investment argument that has surfaced in scholarship,³⁰⁰ but has not been well formulated in jurisprudence.³⁰¹

2. Recalibrating the Merger Doctrine for Created Fact Works

The merger doctrine responds to a fundamental concern for property theory, a concern identified initially by (and, now, with) John Locke. In Locke's philosophy, one condition for the acquisition of private property is that after particular property rights have been granted to one person, there must still be "enough, and as good" to be propertized by others.³⁰² This "enough and as good" proviso ameliorates tension between Locke's propositions that each person "plots a course for his own preservation," while still being "under a natural obligation to ensure that this conduces to the preservation of all."³⁰³ Across the spectrum of modern political philosophy, there is widespread recognition that any adequate theory of property—or just dis-

300 See Jessica Litman, *Breakfast with Batman: The Public Interest in the Advertising Age*, 108 YALE L.J. 1717, 1730 (1999) (arguing that advertisers and consumers engage in an "active collaboration" to increase the value of certain trade symbols). One might also interpret Rochelle Dreyfuss' argument about expressive genericity along these lines. See Rochelle Cooper Dreyfuss, *Expressive Genericity: Trademarks as Language in the Pepsi Generation*, 65 NOTRE DAME L. REV. 397, 407 (1990) (suggesting that when consumers increase the value of a trademark by finding a use for the trademark other than for signaling, the consumers, and not trademark owners, should reap any economic benefit).

301 One of the best-known efforts might be Judge Boudin's concurrence in *Lotus Development Corp. v. Borland International, Inc.*, 49 F.3d 807, 821 (1st Cir. 1995) (Boudin, J., concurring) ("But if a better spreadsheet comes along, it is hard to see why customers who have learned the Lotus menu and devised macros for it should remain captives of Lotus because of an investment in learning made by the users and not by Lotus."), *aff'd by an equally divided court*, 516 U.S. 233 (1996).

302 See JOHN LOCKE, *Second Treatise of Government*, in TWO TREATISES OF GOVERNMENT 265, 291 (Peter Laslett ed., Cambridge Univ. Press 1988) (1690). Locke establishes this condition in describing how people convert pre-society land (and immovables) into private property. *Id.* at 287–91; see also C.B. MACPHERSON, *THE POLITICAL THEORY OF POSSESSIVE INDIVIDUALISM* 201 (1962) (arguing that Locke's "enough and as good" limit is justified by the fact that "each man has a right to his preservation and hence to appropriating the necessities of his life"); GERAINT PARRY, *JOHN LOCKE* 64–73, 153–60 (1978) (analyzing Locke's conception of property).

303 JAMES TULLY, *A DISCOURSE ON PROPERTY* 47 (1980); see also RUTH W. GRANT, *JOHN LOCKE'S LIBERALISM* 67–71, 91 (1987) (discussing Locke's views on self-preservation and slavery).

tribution of goods—will contain some version of the requirement that “enough and as good” be left for others.³⁰⁴

Needless to say, there are questions about how the “enough and as good” condition applies or does not apply to modern society. What is clear is that (a) the condition is unworkable if applied too stringently (for example, if highly personal judgments drive the proviso, then as soon as a particularly attractive meadow or beach is proprotized, then “enough and as good” will not remain) and (b) the condition does little for social justice if “as good” is interpreted too loosely.

Obviously, this parallels our problem with application of the merger doctrine to ideas. Pick the specific idea “sitting” immediately on top of the expression and there arguably is *always* merger, i.e., recognizing the copyright would create an “enough and as good” problem in access to that specific idea. The merger doctrine then becomes useless. On the other hand, consistently picking an extremely abstract idea means that there will never be merger and the doctrine will do nothing to ensure that “enough and as good” remains in the public domain for others.³⁰⁵

As I said earlier, with things that strike us as “facts,” the ability to slide up and down the scale of abstractness disappears; there is a precise fact that we want to be available for everyone to use.³⁰⁶ Access to

304 Robert Nozick interprets the “enough and as good requirement” as a principle meant “to ensure that the situation of others is not worsened” by the appropriation of property from the commons. ROBERT NOZICK, *ANARCHY, STATE, AND UTOPIA* 175 (1974). Peter Singer sees the “enough and as good” proviso playing a key role in the just distribution of the world’s natural resources. See PETER SINGER, *ONE WORLD* 27–30 (2d ed. 2002); see also MICHAEL OTSUKA, *LIBERTARIANISM WITHOUT INEQUALITY* 22–29 (2003) (endorsing the “enough and as good” principle); David Schmidtz, *The Institution of Property*, 11 *SOC. PHIL. & POL’Y* 42, 44–50 (Summer 1994). Many believe that Locke’s proviso, *stricto sensu*, is a *sufficient* condition, while a more general, harm-based version of the proviso is a *necessary* condition. See Jeremy Waldron, *Enough and as Good Left for Others*, 29 *PHIL. Q.* 319, 320 (1979); Clark Wolf, *Contemporary Property Rights, Lockean Provisos, and the Interests of Future Generations*, 104 *ETHICS* 791, 795–99 (1995). Nozick’s reinterpretation can be taken this way. I think that I have fortunately dodged the bullet on this point in prior writings. See Justin Hughes, *The Philosophy of Intellectual Property*, 77 *GEO. L.J.* 287, 297–98 (1988) [hereinafter Hughes, *Philosophy*]; Hughes, *supra* note 250, at 966–67.

305 This assumes that broadly permitted proprotization of ideas would produce an “enough and as good” problem. See Hughes, *Philosophy*, *supra* note 304, at 314 (“Stated simply, some ideas and facts cannot be removed from the common because there would not be the slightest chance of there being ‘enough and as good’ afterwards.”). Even recognizing that patent law permits proprotization of ideas, there are good reasons to think that copyright—a system with a very low threshold for the receipt of exclusive rights and no *ex ante* examination before creation of the rights—is a different issue.

306 See *supra* Part I.C.

such facts seems necessary for there to be “enough and as good” after a copyright is recognized. Yet assuming that some economic incentive was needed for creation of the expressions (which created the facts), if the merger doctrine strips away the copyright protection, we will destroy the incentive for the creation of the next iteration of the *Red Book* or the *CDN Coin Dealer*—the very thing that brought the facts into existence.

The resolution of this problem lies in understanding the temporal difference. The merger doctrine comes into play *ex post facto* when recognizing property rights stemming from some *existing work* would make *ideas* and/or *facts* unavailable to the broader society.³⁰⁷ In contrast, the incentive rationale of copyright comes into play *ex ante* when *failure* to recognize (or make a commitment to recognize) property rights stemming from some *yet to exist work* would make *expressions* unavailable to the broader society.³⁰⁸ The two can be reconciled with a simple presumption: facts and expressions of fact *should not* be found to have merged if *ex ante* knowledge of the merger doctrine applying to the *expression* would have prevented creation of the *facts* at issue. In other words, we must ask two questions. First, is the project of bringing the expression into existence also *a project that brings the fact into existence?* Second, does this project of bringing the expression into existence need the incentive provided by the copyright system? If the answer to these two questions is “yes,” then in the absence of copyright incentives there will be neither expressions nor facts to have “merged.” The question is how we might recalibrate the merger doctrine to deal with—and not completely eliminate copyright in—situations where the incentive of copyright is needed to generate the *facts*. There may be profitable insights from comparing merger doctrine with the “essential facilities” doctrine in antitrust law.

307 *John G. Danielson, Inc. v. Winchester-Conant Props., Inc.*, 322 F.3d 26, 43 (1st Cir. 2003) (“The [merger] doctrine aims to prevent the monopolization of facts or ideas that are present in nature; where ownership of the expression would remove such facts or ideas from the public domain, the doctrine disallows copyright.”).

308 *See, e.g., Twentieth Century Music Corp. v. Aiken*, 422 U.S. 151, 156 (1975) (“The immediate effect of our copyright law is to secure a fair return for an ‘author’s’ creative labor. But the ultimate aim is, by this incentive, to stimulate artistic creativity for the general public good.”).

Although often used by the courts,³⁰⁹ the essential facilities doctrine is much maligned in antitrust scholarship;³¹⁰ its status has been further complicated by the Supreme Court's 2004 refusal to either embrace or kill the doctrine.³¹¹ In that context, I propose the essential facilities doctrine only as a lens through which we might rethink the merger doctrine as a kind of "essential expression doctrine." While there are arguably a couple of American cases applying the essential facilities doctrine to information works broadly understood,³¹² neither the similarity between the merger and essential facili-

309 The doctrine was first applied to a railway bridge over the Mississippi, access to which was needed by the plaintiffs in order to compete with the defendant in the provision of rail services in the St. Louis area. See *United States v. Terminal R.R. Ass'n*, 224 U.S. 383, 394–413 (1912). Note, however, that Areeda and Hovenkamp point out that the Court did not actually use the phrase "essential facility" and that the case holding could arise from more traditional combination grounds. See 3A PHILLIP E. AREEDA & HERBERT HOVENKAMP, *ANTITRUST LAW*, ¶ 772b1, at 176–78 (2d ed. 2002). Since then, the doctrine has been applied most cleanly to expensive infrastructure which is not utilized to one hundred percent capacity by the defendant, i.e., electric transmission lines, natural gas pipelines, and sports stadiums. See *Otter Tail Power Co. v. United States*, 410 U.S. 366, 374–79 (1973) (electric transmission lines); *Fishman v. Wirtz*, 807 F.2d 520, 539–40 (7th Cir. 1986) (professional sports arena); *Hecht v. Pro-Football, Inc.*, 570 F.2d 982, 992–93 (D.C. Cir. 1977) (professional football stadium); *Woods Exploration & Producing Co. v. Aluminum Co. of Am.*, 438 F.2d 1286, 1302–10 (5th Cir. 1971) (natural gas pipelines).

310 See, e.g., 3A AREEDA & HOVENKAMP, *supra* note 309, ¶ 771b, at 174 (viewing the doctrine as "inconsistent with antitrust[']s . . . goals"); Gordon Downie & Laura MacGregor, *Essential Facilities and Utility Networks*, in *REGULATION AND MARKETS BEYOND 2000*, at 19, 38 (Laura MacGregor et al. eds., 2000) ("The essential facilities doctrine takes competition law to the very limits of its legitimate scope, and possibly across the border into regulation."); David Reiffen & Andrew N. Kleit, *Terminal Railroad Revisited: Foreclosure of an Essential Facility or Simple Horizontal Monopoly?*, 33 J.L. & ECON. 419, 420–21 (1990) ("[E]conomic theory suggest[s] that there is no need for an essential facilities doctrine . . .").

311 In *Verizon Communications, Inc. v. Law Offices of Curtis V. Trinko, LLP*, 540 U.S. 398 (2004), the Court held that its judgment "would be unchanged even if we considered to be established law the 'essential facilities' doctrine crafted by some lower courts We have never recognized such a doctrine and we find no need either to recognize it or to repudiate it here." *Id.* at 410–11 (citations omitted). Not surprisingly, the Court also stated that any "essential facilities" claim could not be distinct from a section 2 Sherman Act claim. *Id.* at 411 ("To the extent respondent's 'essential facilities' argument is distinct from its general § 2 argument, we reject it."); see also Michael A. Carrier, *Of Trinko, Tea Leaves, and Intellectual Property*, 31 J. CORP. L. 357, 361 (2006) (discussing the Supreme Court's refusal to recognize the essential facilities doctrine as established law).

312 One case, *Alaska Airlines, Inc. v. United Airlines, Inc.*, 948 F.2d 536 (9th Cir. 1991), arguably comes close because the computerized reservation systems at issue—United's "Apollo" and American's "SABRE" systems—were, in part, elaborate, constantly updated databases. *Id.* at 538. Those databases, however, probably fell outside

ties doctrine³¹³ nor application of the essential facilities doctrine to copyrighted works has been explored extensively in American legal literature.³¹⁴

The essential facilities cases involving unilateral action (section 2 of the Sherman Act³¹⁵) typically involve a vertically-integrated defendant who controls an input for some downstream market in which the defendant has or could have monopoly power.³¹⁶ As formulated in the Seventh Circuit's 1983 opinion in *MCI Communications Corp. v. AT&T*,³¹⁷ successful assertion of the essential facilities doctrine requires four elements:

1. That the defendant controls an upstream facility or resource that is essential to competition in the market where the defendant has (or could have) monopoly power;

post-*Feist* American copyright law. *Id.* at 542–46; *see also* *Intergraph Corp. v. Intel Corp.*, 3 F. Supp. 2d 1255, 1278 (N.D. Ala. 1998) (finding that “[r]easonable and timely access to critical business information . . . is an essential facility”), *vacated*, 195 F.3d 1346 (Fed. Cir. 1999). In the United Kingdom, the case of *Radio Telefis Eireann (RTE) & Independent Television Publications Ltd (ITP) v. Commission of the European Communities (Magill)*, Joined Cases C-241/91 P & C-242/91 P, 1995 E.C.R. I-743, concerned an information product. *Id.* at I-811. Commonly called the *Magill* case, the dispute concerned the provision of television programming information by the BBC, RTE, and ITP networks to daily newspapers under a license arrangement and their subsequent refusal to provide the information to Magill, a small independent publisher, who wanted to publish a comprehensive weekly television guide. *Id.* at I-812. The court reasoned that the television companies were the only source of this information, and their refusal to provide it prevented the introduction of a new product that would be advantageous to consumers. *Id.* at I-824; *see also* Downie & MacGregor, *supra* note 310, at 25 (discussing *Magill*).

313 *See, e.g.*, Dana R. Wagner, *The Keepers of the Gates: Intellectual Property, Antitrust, and Regulatory Implications of Systems Technology*, 51 HASTINGS L.J. 1073, 1122–24 (2000) (identifying the two doctrines as two distinct “possible doctrinal foundations” for creating liability for systems technology industries that fail to license or open their technology, but not identifying the similarity/sameness of the two doctrines).

314 Exceptions are Carrier, *supra* note 311, at 361; Michael A. Carrier, *Refusals to License Intellectual Property After Trinko*, 55 DEPAUL L. REV. 1191, 1207–08 (2006); David McGowan, *Regulating Competition in the Information Age: Computer Software as an Essential Facility Under the Sherman Act*, 18 HASTINGS COMM. & ENT. L.J. 771, 841–49 (1996) (discussing the essential facilities doctrine in the context of network effects); Peter S. Menell, *Tailoring Legal Protection for Computer Software*, 39 STAN. L. REV. 1329, 1366–67 (1987) (applying an essential facilities approach to compulsory licensing for innovative operating system features that become widely established); Melanie J. Reichenberger, Note, *The Role of Compulsory Licensing in Unilateral Refusals to Deal: Have the United States and European Approaches Grown Further Apart After IMS?*, 31 J. CORP. L. 549, 558–65 (2006).

315 15 U.S.C.A. § 2 (West 1997 & Supp. 2007).

316 3A AREEDA & HOVENCAMP, *supra* note 309, ¶ 771a, at 169–71.

317 708 F.2d 1081 (7th Cir. 1983).

2. That competitor(s) cannot practically or reasonably replicate the facility;
3. That the defendant denies use of the facility to the competitor(s); and
4. That granting access is feasible [and economically rational but for maintenance of the monopoly] because granting access would not disrupt the monopolist's own use of the facility.³¹⁸

Each of these requirements can have some resonance for copyright cases. For example, a requirement differentiating between upstream and downstream markets mirrors, in some respects, a strongly intuitive concern in fair use doctrine—the distinction between primary and ancillary markets: copyright scholars have focused much of their turn-of-the-century angst on the issue of how derivative works should be freed (or freer) of the upstream works from which they are derived.³¹⁹

But it is the second and fourth criteria of the essential facilities doctrine that should interest us with “created fact” works. The second criterion in the essential facility checklist is that “the competitors of the monopolist are unable to duplicate the facility.”³²⁰ As the Areeda treatise points out, in the context of antitrust law,

[T]he essential facility claim is about the duty to deal of a monopolist who is able to supply an input for itself in a fashion that is so superior to anything else available that others cannot succeed unless they can access this firm's input as well. For this reason a

318 *Id.* at 1132–33. The Ninth Circuit embraced the four elements. *Ferguson v. Greater Pocatello Chamber of Commerce*, 848 F.2d 976, 983 (9th Cir. 1988) (“[T]he plaintiffs must establish (1) that the defendant is a monopolist in control of the essential facility, (2) that competitors of the monopolist are unable to duplicate the facility, (3) that the monopolist has refused to provide the competitors access to the facility, and (4) that it is feasible for the monopolist to do so.”); *accord* *City of Malden v. Union Elec. Co.*, 887 F.2d 157, 160 (8th Cir. 1989) (listing the same factors); *see also* *Alaska Airlines, Inc. v. United Airlines, Inc.*, 948 F.2d 536, 542–45 (9th Cir. 1991) (discussing criteria for liability under “essential facilities” doctrine); *Aspen Highlands Skiing Corp. v. Aspen Skiing Co.*, 738 F.2d 1509, 1520–21 (10th Cir. 1984), *aff'd*, 472 U.S. 585, 611 (1985) (noting that affirmance on traditional monopolization theory made it “unnecessary” to analyze the essential facilities holding of the appellate court).

319 *See, e.g.*, Christopher S. Yoo, *Copyright and the Public Good Economics: A Misunderstood Relation*, 155 U. PA. L. REV. 635, 659 (2007) (“The absence of any independent copyright protection in derivative works leaves initial authors free to appropriate them without the follow-on authors' consent . . .”).

320 *Ferguson*, 848 F.2d at 983.

strict concept of objectively measured “essentiality” is critical to any rational essential facility doctrine³²¹

When expressions have taken on the glow of institutional facts because of integration into binding law, the case of essentiality seems straightforward. The Medicare and Medicaid programs would not permit a physician to seek reimbursement with any other procedure designations; a person whose car is totaled must use the *Red Book* number in seeking an insurance recovery. Although quite critical of the essential facilities doctrine in antitrust law, even Professor Areeda recognized that “the strongest claims of essentiality” include resources “whose duplication is forbidden by law.”³²² That is exactly the situation in the *BOCA*, *Veeck*, *Maclean Hunter*, and *Practice Management* cases.

For expressions which have taken on the glow of social facts as a matter of convention—*Kapes* and *Southco*—the case for essentiality is substantial, but not as strong. Still, if we have concluded that an author’s creations have become social facts or institutional facts in the Searlean sense, then generally speaking the expression of those social facts will be necessary, unique, and irreplaceable as to a range of activities distinct from the author’s primary market. “Factness” is essentiality in a society that places the emphasis on public discourse that ours does.

But it is the fourth requirement of the essential facilities doctrine which provides the most interesting payoff in how to apply the merger doctrine to created fact works. The fourth requirement of the essential facilities doctrine is “the feasibility of providing the facility”³²³ to others without undermining the defendant’s own commercial activities. At first blush, it appears that this fourth element is *automatically* satisfied with intellectual property: the public goods nature of information works means that the copyright owner will *always* be able to “provide” the information facility while continuing to use the expression herself.

321 3A AREEDA & HOVENCAMP, *supra* note 309, ¶ 771a, at 171; see also Phillip Areeda, *The “Essential Facilities” Doctrine: An Epithet in Need of Limiting Principles*, 58 ANTITRUST L.J. 841; 847–53 (1989) (discussing the implications of the legality of monopoly pricing on the essential facilities doctrine).

322 3A AREEDA & HOVENCAMP, *supra* note 309, ¶ 773a, at 196. But the Areeda treatise also notes that “when duplication is prohibited by law, forced sharing may be as well,” citing patent law. *Id.* at 196 n.2. While the federal government’s adoption of the CPT codes for Medicaid payments did not “forbid” the development of alternative codes, it does make such development pointless or, more strongly, it makes it impossible to develop a competitor facility.

323 See *MCI*, 708 F.2d at 1081, 1133.

But the situation is more complicated if we think, again, about *ex ante* and *ex post facto* perspectives. If the fourth requirement is that the property owner must be able to continue to enjoy use of the facility, then we should ask: *will the defendant, over the long term, be able to continue to use the created fact work for its own commercial activities?* And this is the key difference of eliminating exclusive rights in traditional merger analysis and what an essential facilities analysis would produce: a kind of compulsory license.

We have posited that in *some* situations *ex ante* knowledge of the merger doctrine applying to the *expression of facts* would have prevented creation of the *facts* at issue. In other words, if the publishers of the *Red Book* or the *Coin Dealer Newsletter* knew, in advance, that the merger doctrine would allow people to freely copy their publications, they “might direct their energies elsewhere, depriving the public of their creations”³²⁴—and, thereby, deprive the public of the (created) facts. In other words, the traditional merger doctrine might eliminate the next iteration of the “facility”—both for the producer of the work and for those who benefited (temporarily) from the merger doctrine. In antitrust law the essential facilities doctrine certainly does *not* require the defendant to give away access to the facility *so as to cause decline, waste, or destruction of the facility*.³²⁵ So, where we determine that the incentive structure of copyright is genuinely needed to generate the (created) facts, then our modified merger doctrine should require the producer of the created fact work to license the work on reasonable, nondiscriminatory, and still profitable terms.

Since merger is a judge-created doctrine, there is no ban to grafting onto it compelled licensing in these rare situations of created fact works for which the economic incentive of copyright has been judged necessary for creation of the work. This comports with a small, but growing body of intellectual property case law including the Ninth Circuit’s 1988 *Abend v. MCA, Inc.* decision,³²⁶ the Supreme Court’s

324 *CCC Info. Servs., Inc. v. Maclean Hunter Mkt. Reports, Inc.*, 44 F.3d 61, 66 (2d Cir. 1994).

325 *Cf. Areeda, supra* note 321, at 850, where Areeda points out that in the context of *MCI*, no court would order interconnection if it would harm the incumbent’s facilities. Some uses might do that to a work.

326 863 F.2d 1465 (9th Cir. 1988). The compulsory license nature of the court’s decision is made clear by the remand instructions that, in calculating the plaintiff’s portion of the defendant’s profits, “the district court must recognize” that “the tremendous success” of the film was “attributable in significant measure to . . . Grace Kelly and James Stewart—and the brilliant directing of Alfred Hitchcock.” *Id.* at 1478. The court was clearly of the mind that the plaintiff would take far less than one hundred percent of the studio’s profit from the film. *Id.* at 1480.

1995 *Campbell v. Acuff-Rose Music, Inc.* decision,³²⁷ and the Court's recent 2006 *eBay Inc. v. MercExchange, L.L.C.* decision,³²⁸ cases that, as many commentators have noted, constitute the germ of a case-by-case, judicially imposed compulsory licensing system.³²⁹

While a situation like *Abend* leaves the damage level to the judge's intuitions, decisions concerning the created fact works discussed above need not be so ad hoc. Created fact works are typically *iterated* works—works that are continually updated and for which any one edition has a limited shelf life of value. The *Red Book* and *Coin Dealer Newsletter* have extremely short shelf lives; the CPT, the ADA Nomenclature, and the model legal codes are more stable, but a party using the code is ill advised not to have a complete, up-to-date set. Thus, when a judge determines that “essential expression” should be made available to third parties, a price can be set that ensures that the copyright owner continues to keep the information facility in “good repair,” so to speak—not much differently than the owner of a bridge or power lines deserves adequate returns under the essential facilities doctrine to maintain the physical facilities.

In the occasional circumstances when this proposal will come into play, it is still subject to the same criticism that the Court recently leveled against any court-enforced sharing: it forces courts to identify the “proper price . . . and other terms of dealing—a role for which they are ill-suited.”³³⁰ If there is no visible market failure in, say, the used car or collector coin markets, why attempt this market interven-

327 510 U.S. 569, 578 n.10 (1994) (“[T]he goals of the copyright law . . . are not always best served by automatically granting injunctive relief when [defendants] are found to have gone beyond the bounds of fair use.”).

328 126 S. Ct. 1837, 1838–41 (2006) (concluding that injunctive relief in patent law is not automatic, but follows equitable consideration).

329 Wendy J. Gordon, *Assertive Modesty: An Economics of Intangibles*, 94 COLUM. L. REV. 2579, 2588 n.41 (1994) (noting that “[t]oday, judges are more open to exploring liability-rule avenues in copyright litigation” (citing *Campbell*, 510 U.S. at 578 n.10)); Alice Haemmerli, *Take It, It's Mine: Illicit Transfers of Copyright by Operation of Law*, 63 WASH. & LEE L. REV. 1011, 1020 (2006) (“In these cases, one could say that the court's refusal to grant injunctive relief for copyright infringement effectively results in a compulsory license in favor of the defendant.”); Karjala, *supra* note 5, at 462 n.88 (“If fair use were a reliable form of compulsory license, it could be an important counterweight to a copyright in functional works. Its use in this fashion, however, has little foundation other than a footnote in the Supreme Court's decision in *Campbell*.”); Timothy J. McClimon, *Denial of Preliminary Injunction in Copyright Infringement Cases: An Emerging Judicially Crafted Compulsory License*, 10 COLUM.-VLA J.L. & ARTS 277, 303 (1986) (“This type of implicit compulsory license is emerging in the courts on an increasing basis . . .”).

330 See *Verizon Commc'ns, Inc. v. Law Offices of Curtis V. Trinko, LLP*, 540 U.S. 398, 408 (2004) (“Enforced sharing also requires antitrust courts to act as central

tion? The answer comes in more or less summarizing the project here: (a) we generally make copyright available for these sorts of expressive works to avoid one sort of market failure; and (b) we have identified one limited set of situations (*Maclean Hunter*-like cases) where the intervention of copyright does seem needed to ensure that the market is supplied with the expression *and* the facts; (c) we have strong *non-market* reasons—related to democratic self-governance—for wanting to make “facts” available to all; yet (d) application of our usual doctrinal tool—merger—will negate (b) and, thereby, kill off the facts. The most reasonable course in these rare circumstances is to “dial back,” not turn off, the incentive of copyright.

CONCLUSION

In the thirteenth century, St. Bonaventure called the scribes of his time “compilers and weavers of approved opinions,”³³¹ an apt description for the activities—and resulting works—of companies like Maclean Hunter and nonprofit associations like the AMA, ADA, BOCA, and SBCCI. Sometimes privately generated opinions become so widely “approved” that they become necessary for subsequent expressive and nonexpressive activities. Based on such widespread—often legally mandated—use, these “opinions” become woven into the social fabric as facts, as or more significant to our lives than facts of nature. When an author’s intentional act of creating the *expression* produces the *social fact*, I call the results “created facts.”

The *Feist* decision’s definition of “facts” and its understanding of their unprotected nature fails to capture how created facts arise in our social reality. Copyrighted works can generate social facts via many avenues: the ones described in this Article have been evaluations, designations, and model provisions that become essential for others to use in subsequent expressive and nonexpressive activities. As our economy produces more and more “information products,” valuable nonfictional databases filled with evaluations, judgments, and designations will proliferate. Similarly, government reliance on privately created model codes “reflects a governmental off-balance sheet financing strategy”³³² and is not going to abate at a time when the public fisc is strained (if there ever was a time when it was not).

Skillful jurists like Judges Leval and Newman deftly avoided the “facts” issue in the years immediately following *Feist*, but courts are

planners, identifying the proper price, quantity, and other terms of dealing—a role for which they are ill-suited.”).

331 *DICTIONARY OF THE MIDDLE AGES* 56 (Joseph R. Strayer ed., 11th ed. 1988).

332 Cunningham, *supra* note 4, at 330.

now starting to recognize that expressions created by identifiable individuals produce social facts. The problem is that if we admit that these works generate “facts,” the merger doctrine seems to lead—almost inextricably—to elimination of the copyright in the works involved.

This Article suggests that the merger doctrine should be applied differently in created fact situations depending on whether the copyright incentive was truly needed for production of the created facts work. Where no copyright incentive is needed, the merger doctrine can be applied traditionally—as in situations like *Southco*—because those lists or designations would be created even if the creator knew that the results would not be protectable under copyright. But the merger doctrine should not apply to eliminate copyright when the ex ante elimination of copyright’s incentive for yet-to-be-created *expressions of fact* would prevent the social facts themselves from ever coming into existence. *Maclean Hunter* and *Kapes* probably fit this description. Instead, in such circumstances—as infrequent as they may be—the merger doctrine should produce a compulsory license/sharing result, as the essential facilities doctrine does. Instead of doctrine-distorting machinations to withhold application of the merger doctrine, we should apply it in a sensible way that does not destroy the future flow of *both* expressions of facts and the facts themselves.