

# INTELLECTUAL PROPERTY RIGHTS IN AN ATTORNEY'S WORK PRODUCT

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*"Can you tell me," asked Sir John, "how long it took you to knock out that nocturne?"*

*"Two days," replied Whistler.*

*"The labour of two days, then, is that for which you ask two hundred guineas?"*

*"No," replied Whistler, "I ask it for the knowledge of a lifetime."<sup>1</sup>*

## INTRODUCTION

This paper addresses the main intellectual property consequences of practicing law and whether attorneys can prevent others from using their work-product. The article does not assume that the reader is an expert in intellectual property law; instead, it is designed to answer the types of questions practitioners have about their rights.

There is one primary legal code that impacts attorneys' rights to their work-product: the copyright law.<sup>2</sup> As a broad

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<sup>1</sup> EDWARD PARRY, MY OWN WAY 40 (1932).

<sup>2</sup> The current copyright law, the Copyright Act of 1976, is found in Title 17 of the U.S. Code.

There is increasing controversy about whether another intellectual property law system will become important to the practice of law – the patent law. See Gary C. Bubb, *Patented Tax Strategies – Are You Serious?*, MASS. LAWYERS WEEKLY, Aug. 6, 2007, at 47. Some law practice-related patents have been issued. See Establishing and Managing Grantor Retained Annuity Trusts Funded by Nonqualified Stock Options, U.S. Patent No. 6,567,790 (filed Dec. 1, 1999).

It is unclear if this type of patent will survive legal challenges to the appropriateness of the patent. In *In re Comiskey*, 499 F.3d 1365 (Fed. Cir. 2007), a patent was claimed on a method of imposing mandatory arbitration

statement, copyright law protects how an author expresses ideas.<sup>3</sup> It is the system that is used to prevent others from copying a book, a movie, a musical composition, or even a computer program.<sup>4</sup> It is almost exclusively a federal statutory remedy as comparable state protections have been preempted.<sup>5</sup> As much of what an attorney does is expressing ideas in writing, the copyright system is the most important method of protecting an attorney's work-product.

To clarify the discussion of copyright law and how it applies to legal drafting, three hypotheticals will be used. In each of these cases, the drafting attorneys may feel that their rights have been or will be impinged.

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within a legal document such as a contract. *See id.* at 1368. The claims were ultimately rejected by the PTO as being obvious. *See id.* at 1370–71. When this determination was appealed to the Federal Circuit, the court affirmed the denial of the patent, but on grounds that call many legal practice patents into question. *See id.* at 1371. The Court ultimately held that

[i]t is thus clear that the present statute does not allow patents to be issued on particular business systems – such as a particular type of arbitration – that depend entirely on the use of mental processes. In other words, the patent statute does not allow patents on particular systems that depend for their operation on human intelligence alone, a field of endeavor that both the framers and Congress intended to be beyond the reach of patentable subject matter. Thus, it is established that the application of human intelligence to the solution of practical problems is not in and of itself patentable.

*Id.* at 1378–79. Under this standard, it is highly doubtful that the '790 patent would be sustained if challenged in court.

<sup>3</sup> *See, e.g.,* *Comty. for Creative Non-Violence v. Reid*, 490 U.S. 730, 737 (1989).

<sup>4</sup> *See* 17 U.S.C. § 102(a) (2000).

<sup>5</sup> *See id.* § 301(a).

## I. HYPOTHETICALS

### A. *The Brenda Maxim Hypothetical — Litigation Work-Products*

Brenda Maxim is a brilliant trial attorney in private practice. One of her cases, the *Applejack* case, presented an issue of whether the Rule Against Perpetuities was preempted by ERISA. She drafted and filed a memorandum of law<sup>6</sup> that succinctly defined both areas of law and argued that such preemption did not occur. The judge was persuaded by the memorandum and ruled in favor of Brenda's client Applejack following the reasoning Brenda had presented; indeed, the judge freely quoted from Brenda's memorandum without attributing the quotes to her. Several months later, as Brenda was reading the week's case summaries, she saw a synopsis of a litigation in another circuit that was based on the same law that had been decided in *Applejack*. Out of curiosity, she went online using her legal research service to read the new opinion. One of the options she was presented with was to read the brief that had been submitted to the court in the new case. She chose this option and found that the brief had quoted most of the one she had submitted in *Applejack* without attribution to her and certainly without her permission. When she then looked up the *Applejack* case she found that her brief had been loaded into the research system, again without her consent.

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<sup>6</sup> The choice of a memorandum of law for this hypothetical is intentional as it is generally seen as among the most creative of the litigation documents an attorney prepares. See Davida H. Isaacs, *The Highest Form of Flattery? Application of the Fair Use Defense Against Copyright Claims for Unauthorized Appropriation of Litigation Documents*, 71 MO. L. REV. 391, 406–10 (2006). Other legal documents – the motion to dismiss rather than the memorandum filed in support, for example – tend to be of such a set form that finding the minimal creativity required by *Feist Publications, Inc. v. Rural Telephone Service Co., Inc.*, 499 U.S. 340, 346 (1991), would be impossible, or at least improbable. See Davida H. Isaacs, *supra*.

*B. The David Smith Hypothetical –  
Transactional Work-Products*

David Smith's reputation as a transactional attorney matches Brenda's as a trial attorney.<sup>7</sup> He drafted a complicated sale and lease-back contract for one of his clients, Onetime Development LLP, a major real estate developer. Several months later, when representing another client, he was surprised to receive a contract from the opposing attorney, Howard, that was an exact copy of the Onetime contract with only the names, property address and purchase and lease amounts changed. When asked, Howard told David that his brother-in-law is the C.E.O. of Onetime and had given him the contract. When David questioned Howard about why Howard thought he could use the contract that had been drafted by another attorney, Howard gave him two answers: "Everybody does it," and "Onetime paid for the contract and gave me permission to use it."

*C. The Henry King Hypothetical –  
Work-Products and Termination of  
Representation*

Henry King was retained by the Welbuilt Construction Company to represent it in a variety of matters. After a falling out between the parties, based in part on Welbuilt's failure to pay Henry's bills, Welbuilt terminated Henry as its attorney. Because of the nature of the representation, Henry has developed a wide variety of legal documents, some completed but others in various states of being drafted. Several days after his representation was terminated, he received a demand from Welbuilt's new counsel that all documents being prepared be turned over immediately.

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<sup>7</sup> The idea for this hypothetical came from Stanley F. Birch, Jr., *Copyright Protection for Attorney Work Product: Practical and Ethical Considerations*, 10 J. INTELL. PROP. L. 255 (2003).

## II. HOW COPYRIGHT LAW WORKS

Copyright law is a system that protects the expression contained within an author's work without protecting the underlying ideas and concepts that were expressed.<sup>8</sup>

Distinguishing between the two, the protectable expression from the unprotectable idea, is not easy. As Learned Hand stated in the leading precedent on the difference:

Upon any work, . . . a great number of patterns of increasing generality will fit equally well, as more and more of the incident is left out. The last may perhaps be no more than the most general statement of what the [work] is about, and at times might consist only of its title; but there is a point in this series of abstractions where they are no longer protected, since otherwise the [author] could prevent the use of his 'ideas', to which, apart from their expression, his property is never extended. Nobody has ever been able to fix that boundary, and nobody ever can. In some cases the question has been treated as though it were analogous to lifting a portion out of the copyrighted work; but the analogy is not a good one, because, though the skeleton is a part of the body, it pervades and supports the whole. In such cases we are rather concerned with the line between expression and what is expressed.<sup>9</sup>

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<sup>8</sup> See 17 U.S.C. § 102; H.R. REP. NO. 94-1476, at 56 (1976), *as reprinted in* 1976 U.S.C.C.A.N. 5659, 5670 ("Copyright does not preclude others from using the ideas or information revealed by the author's work. It pertains to the literary, musical, graphic, or artistic form in which the author expressed intellectual concepts.").

<sup>9</sup> *Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 121 (2d Cir. 1930) (citations omitted).

As an example, consider *Romeo and Juliet*. On the idea side of the dichotomy is the basic plot line of boy meets the wrong girl and they both come to a tragic end. Any author is free to write a story based on that idea.<sup>10</sup> On the other side are the actual words chosen by Shakespeare to tell his version of the story. The words and other details of the telling would be protected by the copyright.

Copyright in the United States is an automatic system. No application for a copyright need be filed; instead, copyright protection is automatic whenever a "work of authorship [is] fixed in [a] tangible medium of expression."<sup>11</sup> There are only two requirements to obtain automatic copyright protection, therefore: (1) that a "work of authorship" be created and (2) that it is "fixed." As fixation is the easier of the two requisites, it will be discussed first.

#### *A. Is an Attorney's Work-Product "Fixed?"*

In order for a work to be "fixed" under the Copyright Act, it must be placed in some tangible form for more than a transitory period.<sup>12</sup> When the three hypothetical attorneys typed their respective work-products into their computer, or dictated it on a tape or digital recorder, or wrote it out on legal pads, the work would be considered fixed.<sup>13</sup> With the computer, the work is fixed in memory as it is typed in and on the disk when it is saved.<sup>14</sup> Similarly, for the tape or

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<sup>10</sup> See, e.g., WILLIAM STYRON, *SOPHIE'S CHOICE* (1979); ARTHUR LAURENTS, LEONARD BERNSTEIN, & STEPHEN SONDHEIM, *WEST SIDE STORY* (1957).

<sup>11</sup> 17 U.S.C. § 102(a) (2000). The Copyright Act uses the word "subsist" to describe the existence of a copyright. "Subsist" means "[t]o exist . . . to remain or continue in existence." AMER. HERITAGE DICT. 1791 (3d Ed. 1992).

<sup>12</sup> See *id.* §§ 102(a) and 101 ("A work is 'fixed' in a tangible medium of expression when its embodiment in a copy or phonorecord, by or under the authority of the author, is sufficiently permanent or stable to permit it to be perceived, reproduced, or otherwise communicated for a period of more than transitory duration . . .").

<sup>13</sup> See 1 MELVILLE B. NIMMER & DAVID NIMMER, *NIMMER ON COPYRIGHT* § 2.03[B] (2007) [hereinafter "NIMMER ON COPYRIGHT"].

<sup>14</sup> See, e.g., *Stern Elecs., Inc. v. Kaufman*, 669 F.2d 852, 855-56 (2d

digital recorder, it is fixed when the analog signals are magnetically recorded by the tape recorder or when the digital equivalents are stored in the memory of the digital recorder.<sup>15</sup> The legal pad fixes the work when the ink binds with the paper substrate.<sup>16</sup> For all of these methods, the expression made can be observed again which establishes fixation.

In contrast, if the attorneys merely thought of the words or spoke them without recording them, no fixation would have occurred. When words are thought or spoken, they disappear and cannot be recaptured.<sup>17</sup> The copyright act requires that the words that constitute the work be "perceiv[able], reproduc[ible], or . . . communic[able]"<sup>18</sup> for fixation to have occurred. As words that are just spoken or just conceived cannot be, fixation has not occurred.

Consequently, most of the work-product of an attorney is fixed and has cleared the first hurdle towards copyrightability. Certainly, the memorandum, contract, and other documents in the three presented hypotheticals have been fixed.

*B. Is an Attorney's Work-Product a "Work of Authorship?"*

For a copyright to subsist, the creation must be a "work of authorship." Although Congress did not define "work of authorship" in the Copyright Act, the legislative history

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Cir. 1982) (holding that a video game was "fixed" in the memory chips of the computer); *Williams Electronics, Inc. v. Arctic Intern., Inc.*, 685 F.2d 870, 873-74 (3d Cir. 1982) (same).

<sup>15</sup> See *Baltimore Orioles, Inc. v. Major League Baseball Players Ass'n*, 805 F.2d 663, 668 (7th Cir. 1986) (telecast of baseball game was "fixed" as it was videotaped as it was broadcast).

<sup>16</sup> See *John G. Danielson, Inc. v. Winchester-Conant Properties, Inc.*, 322 F.3d 26, 31 & 35 n.4 (1st Cir. 2003) (upholding copyright in architectural drawings).

<sup>17</sup> If the speech is being recorded, on the other hand, fixation might occur. A good analogy for this is a radio broadcast. Without more—using some form of recording device—once the broadcast completes it is no longer possible to recapture the original broadcast. See 1 NIMMER ON COPYRIGHT § 2.03[B][2]. Consequently, it is not fixed.

<sup>18</sup> 17 U.S.C. § 101 (2000) (defining "fixed").

makes it clear that Congress intended to adopt the definition that the courts had developed under earlier versions of the copyright act.<sup>19</sup> That definition requires that a work of authorship:

be original to the author. Original, as the term is used in copyright, means only that the work was independently created by the author (as opposed to copied from other works), and that it possesses at least some minimal degree of creativity. To be sure, the requisite level of creativity is extremely low; even a slight amount will suffice. The vast majority of works make the grade quite easily, as they possess some creative spark, "no matter how crude, humble or obvious" it might be.<sup>20</sup>

Thus, a work that is created by its author rather than copied and one that has some creativity within it<sup>21</sup> will be copyrighted as soon as it is fixed.<sup>22</sup>

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<sup>19</sup> See H. REP. NO. 94-1476, at 51 (1976), as reprinted in 1976 U.S.C.C.A.N. 5659, 5664 ("The phrase 'original works of authorship,' which is purposely left undefined, is intended to incorporate without change the standard of originality established by the courts under the present copyright statute.").

<sup>20</sup> *Feist Publ'n, Inc. v. Rural Tel. Serv. Co., Inc.*, 499 U.S. 340, 345 (1991). The definition in *Feist* carries over the definition that had been established in earlier cases, see, e.g., *The Trademark Cases*, 100 U.S. 82 (1879); *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53 (1884); *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239 (1903), although it has placed a different emphasis on the amount of creativity needed. See Ralph D. Clifford, *Random Numbers, Chaos Theory, and Cogitation: A Search for the Minimal Creativity Standard in Copyright Law*, 82 DENV.U. L. REV. 259, 262-70 (2004) [hereinafter "Clifford, *Minimal Creativity Standard*"]. See generally, 1 NIMMER ON COPYRIGHT § 2.01[A].

<sup>21</sup> There is split of authority among the circuits about how much creativity is sufficient, compare *Satava v. Lowry*, 323 F.3d 805 (9th Cir. 2003) (disallowing copyright in an artistic glass jellyfish sculpture) with *Boisson v. Banian, Ltd.*, 273 F.3d 262 (2d Cir. 2001) (allowing copyright in much simpler quilt design), and, for that matter, what creativity means. For a full discussion of this issue, see Clifford, *Minimal Creativity Standard* and Ralph D. Clifford, *Intellectual Property in the Era of the*



When examined under these requirements, much, although not all, of the work-product of an attorney will qualify for copyright. A detailed consideration of the two requirements will differentiate between works that are protectable and those that are not.

### 1. Do Work-Product Documents Originate from the Attorney?

This requisite is typically satisfied when most documents are created by an attorney. When the hypothetical attorneys being discussed in this article created the documents, they presumably decided on what words would best express the concepts with which they were working. Whether through keyboarding, dictation or longhand, these words were fixed as required by the Copyright Act. Although nothing more than this is required to satisfy this first requisite for copyrightability, some further analytical examination is necessary as some parts of the legal document may have been copied from another work.

When Brenda wrote her brief in the *Applejack* case, for instance, it is probable that she extracted some parts of it from other attorneys or commercially available form books.<sup>23</sup> It is very typical, after all, for the *pro forma* sections of a brief to be reused in all of an attorney's briefs.<sup>24</sup> The original author of these sections may not be the primary author of the brief which would disallow any copyright claim<sup>25</sup> or, even if

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*Creative Computer Program: Will the True Creator Please Stand Up?*, 71 TUL. L.R. 1675 (1997).

<sup>22</sup> See *JCW Investments, Inc. v. Novelty, Inc.*, 482 F.3d 910, 914 (7th Cir. 2007).

<sup>23</sup> Such compilations of legal forms are generally considered to be copyrightable, although the protection for any given form may not exist. See *Ross, Brovins & Oehmke, P.C. v. Lexis Nexis Group, a Div. of Reed Elsevier Group, PLC*, 463 F.3d 478, 482 (6th Cir. 2006).

<sup>24</sup> When a brief supporting the grant of summary judgment is drafted, for example, the section of the brief that sets forth the standards used by the court in evaluating whether the case is appropriate for summary judgment is rarely custom-drafted; instead, the appropriate paragraphs are used out of the attorney's or a commercially available form bank.

<sup>25</sup> The only possible claim would be as a "collective work," see 17

the brief author wrote the *pro forma* sections, the copyright would be limited to a copyright in a derivative work which is limited to any newly added material that contains sufficient creativity to be considered original.<sup>26</sup>

This analysis is likely to be more limiting to David's ability to claim a copyright in his contract. Unlike briefs, contracts have more provisions that do not differ significantly from those found in any form book.<sup>27</sup> Much of a contract, after all, is comprised of stock clauses<sup>28</sup> that do not differ from contract to contract. Consequently, these prototype sections of a contract rarely owe their origin to the drafting attorney and would not be protected by a copyright.<sup>29</sup> For the sections of the contract that are not drafted using the legal cookie cutter, on the other hand, and are custom drafted for the particular contract in question, this first requisite is satisfied.

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U.S.C. § 101 (2000) (defining "collective work"), although that type of work is intended to be associated with such things as periodicals. As a practical matter, however, the courts are unlikely to see the brief as a compilation as there were no significant modifications made to the *pro forma* sections of the brief. As a compilation, it is only the selection and arrangement of the preexisting material that is protected. See 1 NIMMER ON COPYRIGHT § 3.02. As the content and order of these *pro forma* sections is always the same – a brief for summary judgment will set forth the standards for granting the motion first, if the standards are addressed at all – there is insufficient creativity to support the compilation copyright. See *Feist Publications, Inc. v. Rural Telephone Service Co., Inc.*, 499 U.S. 340 (1991) (disallowing a copyright in the white pages of a phone book as insufficient creativity is demonstrated).

<sup>26</sup> See 1 NIMMER ON COPYRIGHT § 3.01.

<sup>27</sup> See *Donald v. Zack Meyer's T.V. Sales & Serv.*, 426 F.2d 1027, 1029–30 (5th Cir. 1970) (finding attorney's contract clauses "identical" to those found in published form books).

<sup>28</sup> Examples of such a clause include merger, choice of law, arbitration and other similar clauses.

<sup>29</sup> See *Feist Publications, Inc. v. Rural Telephone Service Co., Inc.*, 499 U.S. 340, 345–46 (1991).

## 2. Do Work-Product Documents Contain Sufficient Creativity?

Unfortunately, determining whether a work has sufficient creativity to be copyrighted is not simple as the circuits have two different standards for how exceptional a work must be before a copyright subsists.<sup>30</sup> In *Feist*, the Supreme Court described the needed amount of creativity as “minimal” and stressed that novelty was not required.<sup>31</sup> Most circuits,<sup>32</sup> the Second being a good example, seem to have focused on the word “minimal” and have not imposed strict standards for creativity.<sup>33</sup> Other circuits,<sup>34</sup> with the Ninth being the leading proponent, have ignored this warning and imposed potentially onerous requirements before creativity will be found.<sup>35</sup> Consequently, to determine if a work-product of an attorney is protected, the alternate circuit standards must be evaluated—the majority minimalist standard and the minority high novelty standard.

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<sup>30</sup> Compare *Satava v. Lowry*, 323 F.3d 805 (9th Cir. 2003) (disallowing copyright in an artistic glass jellyfish sculpture) with *Boisson v. Banian, Ltd.*, 273 F.3d 262 (2d Cir. 2001) (allowing copyright in much simpler quilt design). See Clifford, *Minimal Creativity Standard* at 279–80 (2004).

<sup>31</sup> See *Feist Publications, Inc. v. Rural Telephone Service Co., Inc.*, 499 U.S. 340, 345 (1991).

<sup>32</sup> See *CMM Cable Rep, Inc. v. Ocean Coast Properties, Inc.*, 97 F.3d 1504 (1st Cir. 1996); *Boisson v. Banian, Ltd.*, 273 F.3d 262 (2d Cir. 2001); *Masquerade Novelty, Inc. v. Unique Indus., Inc.*, 912 F.2d 663 (3d Cir. 1990); *Superior Form Builders, Inc. v. Dan Chase Taxidermy Supply Co.*, 74 F.3d 488 (4th Cir. 1996); *Engineering Dynamics, Inc. v. Structural Software, Inc.*, 26 F.3d 1335 (5th Cir. 1994), *as modified* 46 F.3d 408 (5th Cir. 1995); *Assessment Technologies of WI, LLC v. WIREdata, Inc.*, 350 F.3d 640 (7th Cir. 2003); *Mitel, Inc. v. Iqtel, Inc.*, 124 F.3d 1366 (10th Cir. 1997); *Atari Games Corp. v. Oman*, 979 F.2d 242 (D.C. Cir. 1992).

<sup>33</sup> See *Boisson v. Banian, Ltd.*, 273 F.3d 262 (2d Cir. 2001).

<sup>34</sup> See *J. Thomas Distributors, Inc. v. Greenline Distributors, Inc.*, 100 F.3d 956 (6th Cir. 1996) (table, opinion at 1996 WL 636138); *Stuart Entertainment, Inc. v. American Games, Inc.*, 205 F.3d 1347 (8th Cir. 1999) (table, opinion at 1999 WL 1144831) (“we thus affirm on the basis of the district court’s memorandum and ruling without further discussion”); *Satava v. Lowry*, 323 F.3d 805 (9th Cir. 2003).

<sup>35</sup> See *Satava v. Lowry*, 323 F.3d 805 (9th Cir. 2003).

(a) The Creativity Required in a  
Minimalist Jurisdiction

Most circuits have recognized how little creativity is needed to meet the *Feist* requirement. For example, the Second Circuit held that:

Originality does not mean that the work for which copyright protection is sought must be either novel or unique, it simply means a work independently created by its author, one not copied from pre-existing works, and a work that comes from the exercise of the creative powers of the author's mind, in other words, the fruits of the author's intellectual labor.<sup>36</sup>

As the court applied this definition of originality, its focus was on the intellectual choice-making in which the author engaged.<sup>37</sup> For example, when the *Boisson* court examined the layout of the letters on the alphabet quilt design in question in the case, it determined that there was sufficient creativity in their layout because there was a wide range of possible layouts that could be used, only one of which was chosen by the author.<sup>38</sup> As the court stated, "an author is entitled to copyright protection for an independently produced original work despite its identical nature to a prior work, because it is independent creation, and not novelty that is required."<sup>39</sup>

Under this standard of creativity, most of the work-product produced by the hypothetical attorneys would be sufficiently creative for copyright protection to be available. There are obviously many words that can be chosen to express most legal concepts. By selecting from the choices,

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<sup>36</sup> *Boisson v. Banian, Ltd.*, 273 F.3d 262, 268 (2d Cir. 2001) (citations and quotation marks omitted).

<sup>37</sup> Cf. Clifford, *Minimal Creativity Standards* at 295-96.

<sup>38</sup> See *Boisson*, 273 F.3d at 269.

<sup>39</sup> *Id.* at 270.

sufficient creativity for copyright protection is found.<sup>40</sup> The only expressions excluded in these jurisdictions would be those copied from another, pre-existing source<sup>41</sup> or one where the author had no choices.<sup>42</sup>

(b) The Creativity Required in a  
High Novelty Jurisdiction

Unfortunately, there is a minority of circuits that impose a significantly higher hurdle before they will find sufficient creativity.<sup>43</sup> The Ninth Circuit in *Satava v. Lowry*,<sup>44</sup> for example, demanded a great deal of novelty before a work will qualify for a copyright.<sup>45</sup> In *Satava*, the court examined the copyrightability of a glass jellyfish sculpture.<sup>46</sup> Despite the holding in *Feist* that novelty was not required,<sup>47</sup> the Ninth Circuit nevertheless required it.<sup>48</sup>

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<sup>40</sup> See *id.* See generally Clifford, *Minimal Creativity Standards*.

<sup>41</sup> *Boisson*, 273 F.3d at 270–71. The *pro forma* sections on the standards for granting summary judgment, for example, may well be unprotectable if they are copied from a form book or other source.

<sup>42</sup> See *id.* at 271. Where there is no choice among expressions, a copyright lawyer would say that “merger” prevents a copyright from being claimed. See *Herbert Rosenthal Jewelry Corp. v. Kalpakian*, 446 F.2d 738, 742 (9th Cir. 1971) (“When the ‘idea’ and its ‘expression’ are thus inseparable, copying the ‘expression’ will not be barred, since protecting the ‘expression’ in such circumstances would confer a monopoly of the ‘idea’ upon the copyright owner free of the conditions and limitations imposed by the patent law.”).

<sup>43</sup> See Note 34, *supra*.

<sup>44</sup> 323 F.3d 805 (9th Cir. 2003).

<sup>45</sup> See *id.* at 810 (9th Cir. 2003) (“expressions that are standard, stock, or common to a particular subject matter or medium are not protectable under copyright law.”). Cf. *id.* at 812 (“These elements are so commonplace in glass-in-glass sculpture and so typical of jellyfish physiology that to recognize copyright protection in their combination effectively would give *Satava* a monopoly on lifelike glass-in-glass sculptures of single jellyfish with vertical tentacles.”).

<sup>46</sup> See *id.* at 807.

<sup>47</sup> See *Feist*, 499 U.S. at 345 (“Originality does not signify novelty; a work may be original even though it closely resembles other works so long as the similarity is fortuitous, not the result of copying.”).

<sup>48</sup> See *Satava*, 323 F.3d at 810 (copyright was rejected as sculpture was made of “standard, stock, or common” elements).

If novelty rather than expressive choice is required, significantly less of an attorney's work-product will be protected by copyright. In Brenda's brief, for example, a court would likely find that large sections of it are comprised of "expressions that are standard, stock or *common to a particular subject matter*."<sup>49</sup> As before, the *pro forma* sections on the standards for granting summary judgment would likely be unprotectable,<sup>50</sup> but unlike in minimalist circuits, significantly more may be excluded from copyright protection. In the discussion on the Rule Against Perpetuities or ERISA in Brenda's brief, much of what Brenda said would be "common to [those] subject matter[s]."<sup>51</sup> As a consequence, no protection would be available. This impact is even more likely to affect the protection available to David's contract as contracts are even more limited in the expression of their subject matter than briefs are.

### (c) Where You Bring Suit Controls

The inescapable conclusion of the analysis is that where you are (or, more accurately, where a suit for copyright infringement is commenced)<sup>52</sup> is going to control what rights you have. In the high novelty circuits such as the Ninth, much of what an attorney produces is likely to be found creatively wanting and thus unprotectable. In most other circuits, the opposite result is likely. Until the Supreme Court decides to resolve the circuit split,<sup>53</sup> an attorney whose work is

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<sup>49</sup> *Id.* (emphasis added).

<sup>50</sup> See note 41, *supra*.

<sup>51</sup> See *Satava*, 323 F.3d at 810.

<sup>52</sup> Personal jurisdiction in a copyright case is no different than most other actions and is based on Rule 4 of the Federal Rules of Civil Procedure. See 3 NIMMER ON COPYRIGHT § 12.01[C]. Venue, on the other hand, has a specific statutory definition — a "district in which the defendant or his agent resides or may be found." 28 U.S.C. § 1400(a) (2000). Determining where someone can be "found" is often less than simple. See generally 3 NIMMER ON COPYRIGHT § 12.01[D].

<sup>53</sup> The Supreme Court denied certiorari in *Satava v. Lowry*, 540 U.S. 983 (2003).

appropriated can only hope that personal jurisdiction and venue exist in a district<sup>54</sup> within a minimalist circuit.

### III. COPYRIGHT OWNERSHIP AND USE

The Copyright Act vests ownership of a copyright in a work in the person or people who are the authors of it.<sup>55</sup> “As a general rule, the author is the party who actually creates the work, that is, the person who translates an idea into a fixed, tangible expression entitled to copyright protection.”<sup>56</sup>

Applying this rule to the practice of law establishes that the attorney is presumptively the author and will be recognized as the owner of the resulting copyright.<sup>57</sup> There are three things that could alter this conclusion, however. First, in appropriate circumstances, the person who pays for a work to be produced may be considered the author under the “work-made-for-hire” provision of the Copyright Act.<sup>58</sup> Second, for some works, someone in addition to the attorney may be able to claim ownership as a “joint work” under the

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<sup>54</sup> Subject matter jurisdiction for a claim of copyright infringement is exclusively in the U.S. District Courts. 28 U.S.C. § 1338(a) (2000). *See generally* 3 NIMMER ON COPYRIGHT § 12.01[A].

<sup>55</sup> *See* 17 U.S.C. § 201(a) (2000). For the purpose of the analysis in this paper, it is assumed that the work-product in question was created on or after January 1, 1978, the effective date of the current Copyright Act. *See* Copyright Act of 1976, Pub. L. No. 94-553 § 102, 90 Stat. 2541, 2598-99 (1976). The ownership determination for works created before 1978 is more complicated as the transitory sections of the 1976 Act must be evaluated. *See generally*, 1 NIMMER ON COPYRIGHT § 5.01[B].

<sup>56</sup> *Community for Creative Non-Violence v. Reid*, 490 U.S. 730, 737 (1989).

<sup>57</sup> It is important to distinguish between the copyright – the set of rights established to the intangible work of authorship under the Copyright Act – and a copy of the copyrighted work – the physical embodiment of the intangible work of authorship. *See* 17 U.S.C. § 202 (2000). Under most states’ laws, the copy belongs to the client. *See Jones v. C.I.R.*, 129 T.C. 146, at 154-55 (2007) (citing cases). This article, on the other hand, addresses the broader question of the ownership and use of the copyright.

<sup>58</sup> *See* 17 U.S.C. § 201(b) (2000) (establishing the employer as the owner of a work-made-for-hire work) & *id.* § 101 (defining “work made for hire”).

statute.<sup>59</sup> Finally, the Code of Professional Conduct must be evaluated to determine if the rules of practice dictate a different answer.<sup>60</sup> Each of these areas will be addressed in turn.

*A. Are Work-Product Documents "Works  
Made for Hire" under the Copyright Act?*

Although normally the person who fixes an expression is its author under the Copyright Act, this rule is changed for a "work made for hire."<sup>61</sup> A work will be one made for hire if either:

- (1) [the] work [is] prepared by an employee within the scope of his or her employment; or
- (2) [the] work [is] specially ordered or commissioned for use as a contribution to a collective work, as a part of a motion picture or other audiovisual work, as a translation, as a supplementary work, as a compilation, as an instructional text, as a test, as answer material for a test, or as an atlas, if the parties expressly agree in a written instrument signed by them that the work shall be considered a work made for hire.<sup>62</sup>

As a practical matter, attorney-prepared documents would have to qualify as having been created pursuant to employment as the second test—a specially ordered or commissioned work—does not often apply to the work of an attorney. Congress specified a list of nine categories of works

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<sup>59</sup> See *id.* § 201(a) (establishing a co-ownership for jointly produced works) & *id.* § 101 (defining "joint work").

<sup>60</sup> See, e.g., MODEL RULES OF PROF'L CONDUCT (2007), available at <http://www.abanet.org/cpr/mrpc/home.html> [hereinafter MODEL RULES].

<sup>61</sup> See 17 U.S.C. § 201(b) (2000).

<sup>62</sup> *Id.* § 101.



that could be specially ordered or commissioned as a work made for hire: (1) collective works, (2) parts of audiovisual works, (3) translations, (4) supplementary works, (5) compilations, (6) instructional texts, (7) tests, (8) answers to tests, or (9) atlases.<sup>63</sup> A work fixed by a non-employee that is not in these nine categories cannot be a work made for hire.<sup>64</sup>

Most of these statutory examples—specifically number two, three, six, seven, eight and nine—do not describe the kinds of materials attorneys normally create. Consequently, if the specially ordered or commissioned category is to apply, the work must be a collective work, a supplementary work or a compilation.

Very few works of lawyers qualify as a “collective work” which requires that “a number of contributions, constituting separate and independent works in themselves, are assembled into a collective whole.”<sup>65</sup> The illustrative examples given in the definition are “periodical issue[s], antholog[ies and] encyclopedia[s].”<sup>66</sup> In distinction, a lawyer’s work-product is a unified whole; indeed, even where multiple attorneys work on the same product, the individual contributions rarely stand on their own as articles in a magazine do. Once the work is done, a single work exists, not a collection of smaller pieces.

Similarly the definition Congress provided for a supplementary work (found within the definition of a work made for hire) indicates that it must be a “secondary adjunct” to another author’s work such as a forward.<sup>67</sup> This does not describe a contract, brief, or other typical work-product.

Finally, a work-product is not usually a compilation as that requires the “assembl[y] of preexisting materials . . .”<sup>68</sup> Although there might be some pre-existing material contained within a work-product, most of the typical work-

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<sup>63</sup> *Id.* § 101 (2000) (defining “work made for hire”).

<sup>64</sup> *See* *Community for Creative Non-Violence v. Reid*, 490 U.S. 730, 738 (1989) (acknowledging that a sculpture could not be a specially ordered or commissioned work as it was not one of the nine categories).

<sup>65</sup> 17 U.S.C. § 101 (defining collective work).

<sup>66</sup> *Id.*

<sup>67</sup> *Id.* (defining “supplementary work” within the definition of “work made for hire”).

<sup>68</sup> *Id.* (defining “compilation”).

product is created specifically for the matter at hand. An exception to this would be a fill-in-the-blank type of form contract or other document where no drafting is done. If all the attorney does is to fill in the name, it could be a compilation under the statute. In this case, however, the other requirement of the statute for a specially ordered or commissioned work—that “the parties expressly agree in a written instrument signed by them that the work shall be considered a work made for hire”<sup>69</sup>—is rarely satisfied. Although many attorneys use written retainer agreements, they are unlikely to address the copyright ownership issue in a way that would vest ownership in the client.<sup>70</sup>

Consequently, for an attorney’s work-product to belong to anyone other than the attorney, it will have to qualify as one produced during employment. To do this, the work had to be prepared by an employee as that term is understood under the common law.<sup>71</sup> The Court expressly held that this determination is one of federal rather than state common law.<sup>72</sup> In defining an employee, the Court relied heavily on the RESTATEMENT (SECOND) OF AGENCY.<sup>73</sup>

The RESTATEMENT lists eight criteria that need to be evaluated to determine if someone is an employee (in a master-servant relationship under the RESTATEMENT):

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<sup>69</sup> *Id.* (defining “work made for hire”).

<sup>70</sup> It is also important for a fill-in-the-blank document to evaluate whether there is sufficient creativity contained for it to be an original work of authorship at all. *See infra* § II.B.2.

<sup>71</sup> *See* *Community for Creative Non-Violence v. Reid*, 490 U.S. 730, 740–41 (1989).

<sup>72</sup> *See id.* at 740 (“Establishment of a federal rule of agency, rather than reliance on state agency law, is particularly appropriate here given the Act’s express objective of creating national, uniform copyright law by broadly preempting state statutory and common-law copyright regulation.”).

<sup>73</sup> *See id.* at 740, 751–52 and nn.18–31. It is unclear if the Court would similarly rely on the Third Restatement as its definition of an employee is much less specific. *Compare* RESTATEMENT (SECOND) OF AGENCY § 220(2) (1958) *with* RESTATEMENT (THIRD) OF AGENCY § 7.07(3)(a) (2006). This imprecision is somewhat ameliorated by the comments to the section. *See* RESTATEMENT (THIRD) OF AGENCY § 7.07, cmt. f. The comments in the Third Restatement seem to set forth a similar set of considerations as were found in the section in the Second.

- (a) the extent of control which, by the agreement, the master may exercise over the details of the work;
- (b) whether or not the one employed is engaged in a distinct occupation or business;
- (c) the kind of occupation, with reference to whether, in the locality, the work is usually done under the direction of the employer or by a specialist without supervision;
- (d) the skill required in the particular occupation;
- (e) whether the employer or the workman supplies the instrumentalities, tools, and the place of work for the person doing the work;
- (f) the length of time for which the person is employed;
- (g) the method of payment, whether by the time or by the job;
- (h) whether or not the work is a part of the regular business of the employer;
- (i) whether or not the parties believe they are creating the relation of master and servant; and
- (j) whether the principal is or is not in business.<sup>74</sup>

While some attorneys can satisfy these criteria in relation to their client—in-house corporate counsel, for example—it is clear that most do not.<sup>75</sup> It is the attorney, not the client, that controls the details of the work.<sup>76</sup> Attorneys are clearly

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<sup>74</sup> RESTATEMENT (SECOND) AGENCY § 220(2) (1958).

<sup>75</sup> The analysis here is of the relationship between the individual attorney and the client. Many attorneys who are in private practice are employees of their law firms. If this is true, the law firm would most likely be the owner of the copyright in the work-product rather than the individual attorney.

<sup>76</sup> See RESTATEMENT (SECOND) AGENCY § 220(2)(a). Cf. MODEL RULES, *supra* note 60, R. 1.2, cmts. [1] & [2] (2007) (“Clients normally defer to the special knowledge and skill of their lawyer with respect to the means to be used to accomplish their objectives, particularly with respect

“engaged in a distinct occupation,”<sup>77</sup> work as a specialist without direct supervision,<sup>78</sup> and require a high level of skill<sup>79</sup> to accomplish the client’s task. The next three factors also disfavor the private practice attorney being an employee as the work will most typically be done at the attorney’s office<sup>80</sup> and the relationship and payment will most typically be task-oriented rather than salary<sup>81</sup> (without an expectation that the attorney will be an employee of the client<sup>82</sup>). Generally, an attorney’s clients are not also lawyers.<sup>83</sup> The final factor—whether the client is in business<sup>84</sup>—is the only one that is often true as many attorneys do represent businesses rather than individuals. It would seem unlikely that this factor, alone, is sufficient to alter the conclusion that attorneys are not, in general, employees of their clients. Consequently, the client cannot claim that the copyright belongs to the client under the work made for hire provision of the copyright act.

The consequence of this conclusion can be seen in the Smith hypothetical. Even if Onetime gave Howard the contract that had been drafted by David, that did not allow Howard to reuse it as it is David, not Onetime, that owns the copyright. The right to reproduce the contract, or make modifications to it, belongs to David.<sup>85</sup>

### *B. Are Work-Product Documents Joint Works Under the Copyright Act?*

The Copyright Act recognizes that more than one person can collaborate to create an expressive work—a “joint work”

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to technical, legal and tactical matters.”).

<sup>77</sup> See RESTATEMENT (SECOND) AGENCY § 220(2)(b).

<sup>78</sup> See *id.* § 220(2)(c).

<sup>79</sup> See *id.* § 220(2)(d).

<sup>80</sup> See *id.* § 220(2)(e).

<sup>81</sup> See *id.* §§ 220(2)(f) & 220(2)(g).

<sup>82</sup> See *id.* § 220(2)(i).

<sup>83</sup> Cf. § 220(2)(h).

<sup>84</sup> See *id.* § 220(2)(j).

<sup>85</sup> See 17 U.S.C. § 106(1) & (3) (2000). Even though David has this basic right, the various copyright defenses must still be evaluated. See *infra* § IV.

under the statute.<sup>86</sup> Such works belong equally to both authors and either can control its use.<sup>87</sup> As a claim could be made that the client and the attorney are joint authors of the attorney's work-product,<sup>88</sup> the standards for being a coauthor must be examined. These standards are not insignificant, however, and lead to the conclusion that work-products are not often the result of joint authorship. For a work to be a joint work under the Copyright Act, two requisites must be met: the purported joint authors must be authors under the copyright act and they must each intend to work together to prepare a joint work.<sup>89</sup>

As discussed in section III.B above, to be an author, one has to fix a work of sufficient creativity to constitute a work of authorship. In the case of a joint work, each of the collaborators must do this.<sup>90</sup> This is rarely true for an attorney's work-product as the one who does the "fixing"—and almost all of the creation of the expression—is the lawyer. At most, the client may contribute some or all of the ideas that underlie the document or may offer editing suggestions. Neither is sufficient to make the client an author.<sup>91</sup> In the hypotheticals, it is unlikely that any of the clients participated in any meaningful way with their respective attorneys to produce the documents.

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<sup>86</sup> See *id.* § 101 ("A 'joint work' is a work prepared by two or more authors with the intention that their contributions be merged into inseparable or interdependent parts of a unitary whole.").

<sup>87</sup> See *id.* § 201(a) ("The authors of a joint work are coowners of copyright in the work."). See, e.g., *Erickson v. Trinity Theatre, Inc.*, 13 F.3d 1061, 1068 (7th Cir. 1994) ("Each author as co-owner has the right to use or to license the use of the work, subject to an accounting to the other co-owners for any profits.").

<sup>88</sup> The author could not find a reported case where such a claim was made. The closest case may be *Khandji v. Keystone Resorts Management, Inc.*, 140 F.R.D. 697 (D. Colo. 1992), where the court acknowledged that the attorney's work-product was the appropriate subject of a copyright claim. See *id.* at 700.

<sup>89</sup> See *Erickson v. Trinity Theatre*, 13 F.3d at 1069.

<sup>90</sup> See *id.* at 1070–71 & the cases cited at 1070, n.8.

<sup>91</sup> See *Childress v. Taylor*, 945 F.2d 500, 509 (2d Cir. 1991) (holding that an actress's contribution of the research that was used to write a play and her suggestions about incidentals associated with the play were insufficient to make her a coauthor).

Similarly, it is unlikely that the necessary intent was present. For a joint work, *all* of the joint authors must individually intend to produce a joint work.<sup>92</sup> In the hypotheticals, such mutual intent seems to be lacking. Consequently, a work-product does not constitute a joint work.

*C. Do the Ethics of Practice Dictate Who Owns  
the Work-Product or How It Can Be Used?*

Anyone who practices law knows that a primary consideration in all decision-making is the dictates of the rules of practice.<sup>93</sup> These rules—or more accurately, the version of them adopted in the jurisdiction in which the attorney is practicing<sup>94</sup>—establish the framework of the attorney's obligation to his or her client and society. Not surprisingly, the MODEL RULES address the issue of the rights to a work-product, but fail to provide any clear guidance about who owns the work-product of an attorney. The relevant rule as proposed by the ABA states: "Upon termination of representation, a lawyer shall take steps to the extent reasonably practicable to protect a client's interests, such as . . . surrendering papers and property to which the client is entitled . . . The lawyer may retain papers relating to the client to the extent permitted by other law."<sup>95</sup> But is a

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<sup>92</sup> See *Erickson v. Trinity Theatre*, 13 F.3d at 1068–69.

<sup>93</sup> See, e.g., MODEL RULES, *supra* note 60. Almost every state has adopted some version of the MODEL RULES as their ethical code. See *id.* (listing dates of adoption), available at [http://www.abanet.org/cpr/mrpc/alpha\\_states.html](http://www.abanet.org/cpr/mrpc/alpha_states.html).

<sup>94</sup> Compare MODEL RULES, *supra* note 60, R. 1.16(d) ("The lawyer may retain papers relating to the client to the extent permitted by other law.") with ARIZ. ETHICS RULES ER 1.16(d) ("The lawyer may retain documents reflecting work performed for the client to the extent permitted by other law only if retaining them would not prejudice the client's rights."). An even greater difference is found in the Massachusetts version of the rule where the final sentence in Rule 1.16(d) has been omitted and a new subsection (e) has been added. See MASS. RULES OF PROF'L CONDUCT R. 1.16, available at <http://www.mass.gov/obcbbbo/rpc1.htm> (2003).

<sup>95</sup> MODEL RULES, *supra* note 60, R. 1.16(d).

client "entitled" to the attorney's work-product or do "other law[s]" allow the attorney to maintain it? Equally, are the rules of practice addressing ownership of copyright rights or are they just addressing the possession and use of a copy?<sup>96</sup>

### 1. The Rules of Practice Cannot Transfer Ownership of the Copyright to the Client

The Copyright Act vests initial ownership of the copyright in the author.<sup>97</sup> As discussed above, unless the lawyer is a common law employee of the client, this means that lawyer is the initial copyright owner. Consequently, absent an express written agreement to the contrary,<sup>98</sup> the client does not own the copyright and cannot, therefore, use ownership as the basis for a claim of entitlement under the rules of practice. Further, the rules of practice of a state cannot alter this rule and establish that the client owns the copyright because of the limitation on the involuntary transfer of a copyright that is contained within the Act:

When an individual author's ownership of a copyright, or of any of the exclusive rights under a copyright, has not previously been transferred voluntarily by that individual author, no action by any governmental body or other official or organization purporting to seize, expropriate, transfer, or exercise rights of ownership with respect to the copyright, or any of the exclusive rights under a copyright,

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<sup>96</sup> The Copyright Act expressly distinguishes between the "copyright" and a "copy." See 17 U.S.C. § 202 (2000). The copyright is associated with the rights established by the Act to do such things as reproduce the work while the copy is associated with a physical, material object on which the work is recorded. See, e.g., *U.S. v. Smith*, 686 F.2d 234, 239-40 (5th Cir. 1982).

<sup>97</sup> See 17 U.S.C. § 201(a) (2000).

<sup>98</sup> See *id.* §§ 204(a) & 101 (defining "transfer of copyright ownership"). Any transfer of the ownership of a copyright, whether by assignment, mortgage or exclusive license, requires a written and signed document. See *id.* § 204(a).

shall be given effect under this title, except as provided under title 11.<sup>99</sup>

Consequently, any rule contained in a state's Code of Professional Conduct that purports to transfer an attorney's copyright would be preempted.<sup>100</sup>

## 2. The Rules of Practice May Be Able to Provide the Client with Limited Rights to Use the Work Product

The limitation against a state mandated transfer of the copyright does not apply, however, if all that it seeks to transfer is a nonexclusive right to use the copyrighted work as

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<sup>99</sup> *Id.* § 201(e). The reference to title 11 is a reference to a Bankruptcy Court's power to seize a copyright as an asset of a bankrupt. *See* 11 U.S.C. § 541 (2000).

Even without this limitation expressed in the Act, it is highly unlikely that state adopted rules of practice could designate the client as the owner of the copyright in an attorney's work-product as such a rule would likely be preempted under the *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141 (1989), decision. In *Bonito Boats*, the Supreme Court established that a state rule that "regulate the use of . . . intellectual property in any manner . . . inconsistent with federal law" would be preempted. *Id.* at 156 (*quoting* *Aronson v. Quick Point Pencil Co.*, 440 U.S. 257, 262 (1979)). The Copyright Act designates the actual author of the work as the owner of the rights, based on a carefully crafted congressional compromise. *See* H.R. Rep. 94-1476, at 121, *as reprinted in* 1976 U.S.C.C.A.N. 5659, 5736 ("The work-made-for-hire provisions of this bill represent a carefully balanced compromise . . ."). A state is not allowed to alter the legislatively established balance. Consequently, the attorney, not the client, owns the copyright.

*See generally*, Ralph D. Clifford, *The Federal Circuit's Cruise to Uncharted Waters: How Patent Protection for Algorithms and Business Methods May Sink the UCITA and State Intellectual Property Protection*, 73 TEMP. L. REV. 1241 (2000).

<sup>100</sup> *See* H.R. Rep. No. 94-1476, at 123 (1976), *as reprinted in* 1976 U.S.C.C.A.N. 5659, 5739 ("The purpose of [17 U.S.C. § 201(e)] is to reaffirm the basic principle that the United States copyright of an individual author shall be secured to that author, and cannot be taken away by any involuntary transfer."). *Cf.* *Advance Magazine Publishers, Inc. v. Leach*, 466 F.Supp. 2d 628, 635-36 (D. Md. 2006) (holding that state adverse possession law has been preempted by the Copyright Act and cannot be deemed to be a transfer by "operation of law").



Section 201(e) only applies to transfers of ownership.<sup>101</sup> The definition of “transfer of copyright ownership” in Section 101 of the act expressly excludes “a nonexclusive license.”<sup>102</sup> Because nonexclusive rights to use a copyrighted work are not transfers under the Act, involuntary transfers of nonexclusive rights can be mandated; indeed, copyright law has developed a judicial doctrine known as an implied license that does exactly that.

The implied license doctrine has been expressly accepted in most circuits.<sup>103</sup> As the rule has been set forth by the Seventh Circuit:

an implied nonexclusive license has been granted when (1) a person (the licensee) requests the creation of a work, (2) the creator (the licensor) makes that particular work and delivers it to the licensee who requested it, and (3) the licensor intends that the licensee-requestor copy and distribute his work.<sup>104</sup>

The three requirements of this rule are probably met by an attorney’s work-product—it is developed for the client,<sup>105</sup> is copied and distributed either to or on behalf of the client,

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<sup>101</sup> See, e.g., *John G. Danielson, Inc. v. Winchester-Conant Props., Inc.*, 322 F.3d 26, 40 (1st Cir. 2003).

<sup>102</sup> 17 U.S.C. § 101 (2000) (defining “transfer of copyright ownership”).

<sup>103</sup> See *John G. Danielson, Inc. v. Winchester-Conant Props., Inc.* 322 F.3d 26, 40 (1st Cir. 2003); *Graham v. James*, 144 F.3d 229, 235 (2d Cir. 1998); *Lowe v. Loud Records*, 126 F. App’x. 545, 547 (3d Cir. 2005) (not precedential); *Nelson-Salabes, Inc. v. Morningside Dev., LLC*, 284 F.3d 505, 514 (4th Cir. 2002); *Lulirama Ltd., Inc. v. Axxcess Broad. Serv., Inc.*, 128 F.3d 872, 879 (5th Cir. 1997); *I.A.E., Inc. v. Shaver*, 74 F.3d 768, 775 (7th Cir. 1996); *Effects Assoc., Inc. v. Cohen*, 908 F.2d 555, 558 (9th Cir. 1990); *Atkins v. Fischer*, 331 F.3d 988, 991–92 (D.C. Cir. 2003).

<sup>104</sup> *I.A.E., Inc.*, 74 F.3d at 776. This statement of the law is consistent with the rule adopted by most circuits. See cases cited in note 103, *supra*.

<sup>105</sup> Even though the client probably does not request the specific document to be created, i.e., a brief supporting summary judgment, the client does request the representation which, in turn, leads to the development of the necessary documents.

and, at least as far as the directly intended work is concerned, is given to the client with the intent that copies be made and distributed. Consequently, when the rules of practice establish that the client is "entitled" to the attorney's work-product,<sup>106</sup> it is appropriate to conclude that the client is entitled to an implied nonexclusive license to the work-product. In the hypotheticals, therefore, all of the clients will have rights to some use of the works that were drafted on their behalf, but having a nonexclusive license is only the starting point of the analysis. A nonexclusive license only allows specific uses of the work to be made.<sup>107</sup>

Use outside of the scope of the license or by a party who was not a party to the license still constitutes infringement.<sup>108</sup> Consequently, the limits of the nonexclusive licenses to the work-product must be established.

(a) Using the Work-Product as it was  
Originally Intended to be Used

There is not any legitimate doubt that using the work-product for the precise purpose for which it was originally generated would be within an implied license given to the client.<sup>109</sup> Many of the cases on implied licenses involve another profession, specifically, architects' claims of infringement when their plans were used to construct a project even though their services had been terminated before construction.<sup>110</sup> In these cases, the courts seem to have consistently held that the plans can be used notwithstanding the termination unless the contract with the client expressly

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<sup>106</sup> See MODEL RULES, *supra* note 60, R. 1.16(d).

<sup>107</sup> See *Gilliam v. American Broadcasting Companies, Inc.*, 538 F.2d 14, 20-21 (2d Cir. 1976); *Oddo v. Ries*, 743 F.2d 630, 634 (9th Cir. 1984); *MacLean Assocs., Inc. v. Wm. M. Mercer-Meidinger-Hansen, Inc.*, 952 F.2d 769, 779 (3d Cir. 1991).

<sup>108</sup> See *Gilliam*, 538 F.2d at 20-21; *Oddo*, 743 F.2d at 634; *MacLean Assocs.*, 952 F.2d at 779.

<sup>109</sup> See *Nelson-Salabes, Inc. v. Morningside Dev., LLC*, 284 F.3d 505, 514 (4th Cir. 2002).

<sup>110</sup> See *id.* at 515 (citing cases).

prohibited the client from doing so.<sup>111</sup> Although no reported case could be found that so held, a similar implied license to continue using an attorney's work-product as that work was originally intended would be a probable conclusion were the matter to be litigated. It is fair to assume, therefore, that once the document has been produced, the client has the right to use it. Consequently, in the apropos Henry King hypothetical, any document Henry completed must be made available to Welbuilt so that it can use it as the parties originally intended. This would be true even if Henry has not been fully compensated as Welbuilt's nonexclusive license to use the documents will not be abrogated for non-payment as that is not generally seen as terminating the license.<sup>112</sup>

#### (b) Modifying or Reusing the Work-Product

If the work-product is used exactly as intended and is not modified by either the client or the client's replacement counsel, the implied license doctrine would almost certainly prevent the use from being considered infringing. The situation becomes much more complicated, however, if the original work is modified (which would include completing a draft document) or if it is used in a way that is different than what was originally intended.

In *Oddo v. Ries*,<sup>113</sup> for example, an author was deemed to have created an implied license when he submitted an article to a partnership he had formed with the defendant for ultimate publication as part of a book.<sup>114</sup> Subsequently, being dissatisfied with the plaintiff Oddo's efforts, the defendant Ries hired another writer who finished the book which included modifying the material that Oddo had submitted.<sup>115</sup> Ries then published the book.<sup>116</sup> The court held that this was

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<sup>111</sup> *See id.*

<sup>112</sup> *Cf. Graham v. James*, 144 F.3d 229, 237 (2d Cir. 1998) (holding obligation to pay royalties a covenant not a condition thus not constituting a material breach).

<sup>113</sup> 743 F.2d 630 (9th Cir. 1984).

<sup>114</sup> *See id.* at 634.

<sup>115</sup> *See id.* at 632.

<sup>116</sup> *See id.*

improper, stating that "the implied license to use the articles in the manuscript does not give [the defendant] the right to use the articles in any work other than the manuscript itself."<sup>117</sup> In other words, the implied license gave the right to use the work as submitted, but did not allow changes to be made to the submitted work.

If the *Oddo* rule could simply be applied to the use of an attorney's work-product, the analysis would not be difficult—no changes can be made. For example, if the original attorney wrote a memorandum in support of summary judgment, under *Oddo*, it would be improper for a later counsel to modify the memorandum into a memorandum addressing judgment as a matter of law and would certainly be improper to use it to develop an appellate brief. Similarly, if the attorney drafts a contract for one agreement, it would be improper for the client to modify it for another. Unfortunately, things in copyright law are rarely that simple.<sup>118</sup>

To begin with, complexity is introduced by the problem of determining what the actual terms of the nonexclusive license are as the typical attorney and client will not have expressed any agreement concerning each party's respective intellectual property rights.<sup>119</sup> From the perspective of the copyright law, a licensee (client) only obtains the specific copyright rights that the licensor (attorney) intended to transfer.<sup>120</sup> Where no intent is expressed—in words or in conduct—no rights transfer, effectively requiring implied licenses to be narrowly construed. From the perspective of the rules of practice, however, the licensor (attorney) is under

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<sup>117</sup> *Id.* at 634.

<sup>118</sup> In addition to the complexity suggested by the implied terms to the nonexclusive license being discussed in this section, the consequences of the fair use defense, discussed in section IV below, must also be evaluated.

<sup>119</sup> Most times, the nonexclusive rights are created by implication based on the parties' conduct rather than on their words. *See* *Lulirama Ltd., Inc. v. Axxess Broadcast Services, Inc.*, 128 F.3d 872, 879 (5th Cir. 1997) ("When the totality of the parties' conduct indicates an intent to grant . . . permission [to use a copyrighted work], the result is a legal nonexclusive license. . . ." (quotation marks omitted)).

<sup>120</sup> *See* *Gilliam v. American Broadcasting Companies, Inc.*, 538 F.2d 14, 20 (2d Cir. 1976).

an affirmative obligation to "take steps to the extent reasonably practicable to protect a client's interests . . ." <sup>121</sup> This could easily cause a court to broadly construe the implied license.

The considerations that might lead a court to broadly construe the license are re-enforced further by the "Implied Grant of Collateral Rights" doctrine. <sup>122</sup> The doctrine requires a license to be interpreted broadly enough that its purpose can be achieved. <sup>123</sup> For example, the doctrine would give a licensee the right to distribute records that were made pursuant to a license to record them even where the original license was silent about distribution. <sup>124</sup>

When the collateral rights doctrine is considered together with the rules of practice, it is likely that a court would make a broad interpretation of the nonexclusive license. Consequently, at a minimum, the license likely includes the right for the client to complete the document being prepared so that it can be used as intended. After all, the rules of practice express a strong preference in favor of the client's continued use of the work-product material; indeed, it would not be surprising if a court deemed the rules as part of the implied contract between the attorney and client. Beyond merely completing the document, because the basic relationship between the attorney and client calls for the attorney to represent the client in a particular matter, the collateral rights grant would seem to cover additional uses of the work-product within the same matter. <sup>125</sup>

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<sup>121</sup> MODEL RULES, *supra* note 60, R. 1.16(d). *See id.* cmt. 9 ("Even if the lawyer has been unfairly discharged by the client, a lawyer must take all reasonable steps to mitigate the consequences to the client.").

<sup>122</sup> *See Werbungs Und Commerz Union Austalt v. Collectors Guild, Ltd.*, 728 F.Supp. 975, 977 (S.D.N.Y. 1989). The term "Implied Grant of Collateral Rights" appears to owe its origin to Professor Nimmer as presented in NIMMER ON COPYRIGHT § 10.10[C].

<sup>123</sup> *See* NIMMER ON COPYRIGHT § 10.10[C].

<sup>124</sup> *Cf. Royal v. Radio Corp. of America*, No. Civ. 65-391, 1955 U.S. Dist. LEXIS 4195, at \*1-2 (S.D.N.Y. Oct. 11, 1955).

<sup>125</sup> Of course, if the relationship between the attorney and client does not match the typical ones being discussed in this article, the results of the analysis would differ. If, for example, the attorney is hired only to write a particular document, rather than engage in a generalized representation of

As a consequence, the most probable outcome is that the client will be able to use the work-product throughout the conclusion of the matter for which the attorney was originally hired. This, of course, assumes that the attorney doesn't terminate the license, if he or she has that right. This requires an exploration of when licenses can be terminated.

### (c) Terminating an Implied License

The final factor that can complicate the analysis of the effect of an implied license on an attorney's work-product is whether the license is terminable. Under copyright law, a license that is not supported by consideration from the licensee (client) is revocable.<sup>126</sup>

Obviously, therefore, if the attorney has been fully compensated for developing the work-product, the implied license could not be terminated, leaving the client free to use it in accordance with the implied terms of the license. Where compensation has not been paid, as at-will employment does not constitute consideration,<sup>127</sup> and an attorney's employment by a client is at will by the rules of practice,<sup>128</sup> the nonexclusive license granted to the client to use the attorney's work-product would be revocable.

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the client, the client's argument for a broad license is weaker. An example of this would be where the lawyer directly representing the client hires another attorney to write a memorandum of law.

<sup>126</sup> See *Avtex Systems, Inc. v. Peiffer*, 21 F.3d 568, 574 n.12 (4th Cir. 1994); NIMMER ON COPYRIGHT § 10.02[B][5].

<sup>127</sup> See *Carson v. Dynegy, Inc.*, 344 F.3d 446, 452 (5th Cir. 2003) (holding that "[c]onsideration for a promise, by either the employee or the employer in an at-will employment, cannot be dependent on a period of continued employment. Such a promise would be illusory because it fails to bind the promisor who always retains the option of discontinuing employment in lieu of performance."). See generally 17B C.J.S. *Contracts* § 441 (1999) ("Contracts of employment, whose only consideration is the services to be performed thereunder and which are silent as to duration, are terminable at will . . .").

<sup>128</sup> See MODEL RULES, *supra* note 60, R. 1.16(a)(3) & *id.* cmt. 4 ("A client has a right to discharge a lawyer at any time, with or without cause . . .").

Where a license is revocable, the procedure the licensor (attorney) uses to terminate it is defined by state contract law.<sup>129</sup> This will generally empower the licensor to terminate it at will, although some states have begun to require a reasonable amount of notice to be provided before termination.<sup>130</sup>

The ability of an attorney to terminate the nonexclusive license will differ depending on the contract law of the jurisdiction. If the state follows the more traditional rule that allows termination with minimal notice, the attorney could inform the client of the revocation which would then require the client to stop using the work-product immediately. If, on the other hand, as is much more probable, the state requires reasonable notice to terminate,<sup>131</sup> the client would maintain the right to continue using the work-product for at least some time, presumably the amount of time that it would take the client to replace it with a new one. In either case, though, the client's ability to continue using the work-product as a source

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<sup>129</sup> See *Walthal v. Rusk*, 172 F.3d 481, 485 (7th Cir. 1999); *Korman v. HBC Florida, Inc.*, 182 F.3d 1291, 1294 (11th Cir. 1999); *Invessys, Inc. v. McGraw-Hill Companies, Ltd.*, 369 F.3d 16, 19 (1st Cir. 2004); NIMMER ON COPYRIGHT § 11.10[B]. But see *Rano v. Sipa Press, Inc.*, 987 F.2d 580, 585 (9th Cir. 1993) (holding that federal law—17 U.S.C. § 203—controls the termination of copyright licenses). But cf. *Quinn v. City of Detroit*, 23 F.Supp.2d 741 (E.D. Mich. 1998) (holding that the City was entitled to a reasonable period of time after notice before the license could be revoked without doing an *Erie* analysis).

Although state law controls the termination of a license in most circuits, the Copyright Act also provides an absolute right to terminate a license, generally after thirty-five years. See 17 U.S.C. § 203(a)(3) (2000). As a practical matter, however, for an attorney's work-product, the value is likely to be absent after that long of a period. If a work-product license is terminated, therefore, it is likely to be under the provisions of state law.

<sup>130</sup> See, e.g., 17B C.J.S. *Contracts* § 439 (1999) ("If there is nothing in the nature or the language of a contract for an indefinite period to indicate that it is perpetual, the courts will interpret the contract to be terminable at will . . . . Some courts require, however, that such contracts be terminated only on reasonable notice.").

<sup>131</sup> For the license between an attorney and client, it is likely that states would adopt this reasonable notice requirement because of the dictates contained within the rules of practice that an attorney take reasonable steps to protect the client when the employment relationship terminates. See MODEL RULES, *supra* note 60, R. 1.16(d).

for newly developed ones—transforming a summary judgment memorandum into an appellate brief, for example<sup>132</sup>—would be terminated.

When applied to the hypotheticals, only Henry King would have a right to terminate the nonexclusive license. In both the Brenda Maxim and David Smith hypotheticals, the attorneys were compensated, making the license irrevocable. Their clients, therefore, have a continuing right to use the works, only limited as discussed in the two proceeding subsections. Henry King, on the other hand, would have to do a work-product by work-product analysis to determine if he could terminate the nonexclusive license. If, for example, the work-product in question could not practically be replaced—an executed contract or time-critical court document, for example—the client would maintain a right to use them. But where the document can be replaced, Henry's termination would be effective and the client's right to use the document would cease.

#### IV. THE COPYRIGHT DEFENSE OF FAIR USE

The analysis of copyright rights is never complete without examining the "fair use" defense.<sup>133</sup> Fair use constitutes an affirmative defense to a copyright infringement claim.<sup>134</sup> Unfortunately, an easy comprehension of the defense is

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<sup>132</sup> Again, here, it is important to remember the distinction that copyright law makes between the idea and the expression of it that comprise a work of authorship. See Section II, *supra*. The client, replacement counsel, or anyone else, for that matter, are free to examine the work-product and extract from it the ideas that underlie it. Thus, for example, the new attorney could use the original document as a source for the relevant cases and statutes that apply to the client's matter. Similarly, the legal theory under which the original counsel developed the case could be used without worries about copyright infringement. What is protected by copyright is how the original attorney expressed the legal theory, not the theory itself.

<sup>133</sup> See 17 U.S.C. § 107 (2000).

<sup>134</sup> See *id.* § 106 ("Subject to sections 107 . . . , the owner of copyright under this title has the exclusive rights to do and to authorize any of the following . . .").



unlikely as it is both open-ended and imprecise.<sup>135</sup> The statute dictates that four specific factors “shall [be] include[d]” in the evaluation,<sup>136</sup> but the definition of “includ[e]” that is contained within the statute indicates these four factors are “illustrative and not limitative.”<sup>137</sup> Consequently, although an analysis of the four statutory factors must always be done, there is nothing to stop a court from defining and applying some new fifth rule.<sup>138</sup>

Unfortunately, the four primary considerations are not exercises in elucidative legislative drafting.<sup>139</sup> According to the Copyright Act, fair use is found based primarily on:

- (1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes;
- (2) the nature of the copyrighted work;
- (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and
- (4) the effect of the use upon the potential market for or value of the copyrighted work.<sup>140</sup>

Each of these statutory factors will be examined next, followed by a discussion of whether the courts are likely to

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<sup>135</sup> See H.R. REP. NO. 94-1476, at 65 (1976), as reprinted in 1976 U.S.C.C.A.N. 5659, 5679.

<sup>136</sup> 17 U.S.C. § 107 (2000).

<sup>137</sup> *Id.* § 101 (defining “including”). Normal statutory interpretation reaches the opposite result and limits the general term to those items specified in the list. See 2A NORMAN J. SINGER, SUTHERLAND STATUTORY CONSTRUCTION § 47:17 (7th ed. 2007).

<sup>138</sup> *Cf.* Campbell v. Acuff-Rose Music, Inc., 510 U.S. 569, 579 (1994) (“[T]ransformative works . . . lie at the heart of the fair use doctrine’s guarantee of breathing space within the confines of copyright . . .”).

<sup>139</sup> See H.R. REP. NO. 94-1476, at 65 (1976), as reprinted in 1976 U.S.C.C.A.N. 5659, 5679 (“no real definition of the concept [of fair use] has ever emerged. Indeed, since the doctrine is an equitable rule of reason, no generally applicable definition is possible, and each case raising the question must be decided on its own facts.”).

<sup>140</sup> 17 U.S.C. § 107 (2000).

find a fifth factor outside of the statutory framework when examining work-products. After this discussion, they will be applied collectively to the hypothetical work-product documents.

*A. Purpose and Character of the Use of the Work-Product*

This "purpose of the use" statutory factor evaluates how the copyrighted work was used by the appropriator.<sup>141</sup> In effect, it evaluates whether there is a high enough societal gain achieved by the appropriation that requiring the author to forego his or her normal compensation is appropriate. Three types of uses are apropos to work-products:

1. Advancing the Public Interest

The statute specifies that uses "for purposes *such as* criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research [are] not an infringement of copyright."<sup>142</sup> A work-product document being used in litigation would seem to at least touch on the sort of purpose that Congress indicated is more likely to be fair use. As with the categories expressly stated, litigation advances democracy, a core value to be preserved by appropriate application of the fair use defense as imprecisely described as "criticism, comment, [and] news reporting" in the statute.<sup>143</sup>

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<sup>141</sup> See 17 U.S.C. § 107(1) (2000).

<sup>142</sup> *Id.* § 107 (emphasis added). Although this sentence from the statute makes it appear as if these types of uses are absolutely allowed, the next sentence makes it clear that all of the factors must be examined, *see id.*; indeed, these uses have been used by the courts to clarify the first of the statutory factors contained in Section 107(1). *See Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 561 (1985) ("[T]he examples enumerated in § 107 . . . give some idea of the sort of activities the courts might regard as fair use under the circumstances." (quotation marks and citation omitted)).

<sup>143</sup> *See Nat'l Rifle Ass'n of America v. Handgun Control Fed'n of Ohio*, 15 F.3d 559, 562 (6th Cir. 1994) ("The scope of the fair use doctrine is wider when the use relates to issues of public concern."); *Sega Enters. Ltd.*

## 2. Creating a Transformative Work

A highly determinative factor in evaluating the purpose of the use is whether the copying and use of the original work resulted in a new work that:

adds something new, with a further purpose or different character, altering the first with new expression, meaning, or message; ... in other words, whether and to what extent the new work is "transformative." . . . [T]he more transformative the new work, the less will be the significance of other factors, like commercialism, that may weigh against a finding of fair use.<sup>144</sup>

In other words, the "copyrightable expression in the original work [must be] used as raw material, transformed in the creation of new information, new aesthetics, new insights and understandings . . ."<sup>145</sup> The closer the copy is to the original expression, the less likely it is to be fair use.

## 3. Using a Work Non-Commercially

A commercial use of another's copyrighted work raises a rebuttable presumption that the use is not fair.<sup>146</sup> "The crux of the profit/nonprofit distinction is not whether the sole motive of the use is monetary gain but whether the user stands to profit from exploitation of the copyrighted material without paying the customary price."<sup>147</sup> As with all other fair use

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v. Accolade, Inc., 977 F.2d 1510, 1523 (9th Cir. 1992) ("Public benefit need not be direct or tangible, but may arise because the challenged use serves a public interest."). Cf. *Pac. & S. Co., Inc. v. Duncan*, 744 F.2d 1490, 1495 (11th Cir. 1984) ("Where strict enforcement of the rights of a copyright holder . . . would conflict with . . . some other important societal value, courts should be free to fashion an appropriate fair use exemption.").

<sup>144</sup> *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 579 (1994).

<sup>145</sup> *Castle Rock Entm't. v. Carol Publ'g. Group, Inc.*, 150 F.3d 132, 142 (2d Cir. 1998) (quotation marks and citation omitted).

<sup>146</sup> See *Harper & Row Publishers, Inc.*, 471 U.S. at 562.

<sup>147</sup> *Id.*

factors, however, the presumption of unfair use can be overcome where the other fair use considerations outweigh the commercial nature of the use.<sup>148</sup>

### *B. Nature of the Work-Product*

The "nature of the work" statutory factor requires consideration of the kind of work that was copied.<sup>149</sup> Two relevant aspects of work-products merit discussion:

#### 1. Work Within Core of Copyright

The essence of this factor addresses whether the copyrighted work is considered within the "core" of works that obtain copyright protection.<sup>150</sup> The Supreme Court has indicated that "some works are closer to the core of intended copyright protection than others, with the consequence that fair use is more difficult to establish when the former works are copied."<sup>151</sup>

The works that are at the core of copyright are those that required the most creativity in their creation or were generated in an expectation of returning a profit.<sup>152</sup> Consequently, works of fiction are less likely to support a finding of fair use than works of non-fiction<sup>153</sup> as are works that were expressed because of their inherent economic value.<sup>154</sup>

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<sup>148</sup> See *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 584 (1994).

<sup>149</sup> See 17 U.S.C. § 107(2) (2000).

<sup>150</sup> See *Campbell*, 510 U.S. at 586.

<sup>151</sup> *Id.*

<sup>152</sup> See *Rogers v. Koons*, 960 F.2d 301, 310 (2d Cir. 1992).

<sup>153</sup> See *id.*

<sup>154</sup> See *id.* A copyrighted novel returns a reward to the author because people are interested in obtaining and reading the novel itself. This differs from a work-product as it is rarely of intrinsic value; instead, the value comes from its ability to achieve a particular legal result.

## 2. Unpublished Work

Another relevant consideration in evaluating the nature of the work is whether it is published.<sup>155</sup> When a work has not been published, a finding of fair use is much less likely.<sup>156</sup>

"Publication" is a term-of-art within copyright law. As the statute defines it, "[p]ublication" is the distribution of copies . . . of a work to the public by sale or other transfer of ownership, or by rental, lease, or lending."<sup>157</sup> Very few work-products meet this statutory definition.

### *C. Amount of the Work-Product Used*

The "amount copied" statutory factor evaluates the quantity of the copyrighted work that is used in the new work.<sup>158</sup> "As a general matter, as the amount of the copyrighted material that is used increases, the likelihood that the use will constitute a 'fair use' decreases."<sup>159</sup> It is important to recognize, however, that there are no absolutes—copying all of an expression might be fair,<sup>160</sup> just as copying a small, but fundamental part of the expression might not be.<sup>161</sup> Consequently, both the quantity and the quality of what is copied must be evaluated.

### *D. Effect of Work-Product Copying on the Marketplace*

The final "effect of copying" factor evaluates the impact that the type of copying done would have on the copyright

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<sup>155</sup> See *Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 554 (1985).

<sup>156</sup> See *id.*

<sup>157</sup> 17 U.S.C. § 101 (2000) (defining "publication").

<sup>158</sup> See 17 U.S.C. § 107(3) (2000).

<sup>159</sup> *Bond v. Blum*, 317 F.3d 385, 396 (4th Cir. 2003).

<sup>160</sup> See *Sundeman v. Seajay Society, Inc.*, 142 F.3d 194, 205 (4th Cir. 1998).

<sup>161</sup> See *Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 564–65 (1985).

owner's overall market for the work.<sup>162</sup> This factor is, without doubt, the most important of the four statutory factors.<sup>163</sup> At the extreme, copying that destroys an author's ability to obtain reasonable value for the work is unfair.

As this analysis is done, it is necessary to have an appropriately broad perspective. As the Supreme Court held:

It requires courts to consider not only the extent of market harm caused by the particular actions of the alleged infringer, but also whether unrestricted and widespread conduct of the sort engaged in by the defendant . . . would result in a substantially adverse impact on the potential market for the original. The enquiry must take account not only of harm to the original but also of harm to the market for derivative works.<sup>164</sup>

In other words, the analysis requires that an assumption is made that all other people who are similarly situated with the appropriator—other attorneys, for the purpose of this paper—are also copying the work in a similar way. It is the overall consequence this copying causes that forms the basis for the effect of copying factor analysis.

Additionally, Congress required two evaluations of the effects, one on "the potential market for" the copyrighted work and the other on the "value of" it.<sup>165</sup> Consequently, while the analysis must determine the economic impact on the copyright owner, it must also determine the other, non-economic consequences of the copying.<sup>166</sup> An example of this can be found in *Weissmann v. Freeman*.<sup>167</sup> In the case, the defendant copied some of the plaintiff's academic work.<sup>168</sup>

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<sup>162</sup> See 17 U.S.C. § 107(4) (2000).

<sup>163</sup> *Harper & Row*, 471 U.S. at 566.

<sup>164</sup> *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 590 (1994).

<sup>165</sup> 17 U.S.C. § 107(4) (2000).

<sup>166</sup> See *Video Pipeline, Inc. v. Buena Vista Home Entm't, Inc.*, 342 F.3d 191, 202 (3d Cir. 2003).

<sup>167</sup> 868 F.2d 1313 (2d Cir. 1989).

<sup>168</sup> See *id.* at 1326.

The court determined that the effect of copying factor did not favor a fair use finding despite the lack of economic impacts as the appropriation would "create[] a distinct disincentive for [the plaintiff] to continue to research and publish in the field of nuclear medicine"<sup>169</sup> The district court was expressly criticized for focusing on the "dollars received, rather than upon the realities of promotion and tenure in an academic setting."<sup>170</sup>

*E. The Fifth Factor—Legal System  
Considerations*

As discussed above, the four statutory factors are not exclusive and the courts can examine any other consideration that is relevant to determining whether the appropriation was fair.<sup>171</sup> When examining fair use in the context of a work-product document, a probable fifth factor exists: the needs of the legal system itself. While, to a certain extent, the "public interest" aspect of the purpose of the use factor addresses similar considerations, the fact that an attorney's work is so central to the administration of justice magnifies the importance of the work to society, with a correspondingly higher probability of a fair use finding. The fair use defense, after all, has an important purpose of limiting an author's copyright rights when this is necessary to advance democracy.<sup>172</sup> Work-product documents, particularly those that are used within the judicial system, have this consequence.<sup>173</sup> Without the pleadings, briefs, and other work-products, it is unclear how a system of justice could function.

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<sup>169</sup> *Id.*

<sup>170</sup> *Id.*

<sup>171</sup> See discussion in the beginning of Section IV, *supra*; *Haberman v. Hustler Magazine, Inc.*, 626 F.Supp. 201, 214 (D. Mass. 1986) (holding that appropriator's good faith is relevant to a fair use analysis).

<sup>172</sup> See *supra* note 143 and accompanying text.

<sup>173</sup> *Cf.*, e.g., *J.E.B. v. Alabama ex rel. T.B.*, 511 U.S. 127, 145–46 (1994).

### *F. Application to the Fair Use Hypotheticals*

In this final part of the section, the fair use defense will be applied to the copying that occurred in the two relevant hypotheticals. This is necessary as a fair use analysis requires a case-by-case application of the facts to the law.<sup>174</sup> Thus, the Brenda Maxim hypothetical will be considered first and the David Smith hypothetical will follow. The third hypothetical involving Henry King will not be discussed in this section as it involves issues of implied licenses rather than fair use.<sup>175</sup>

#### 1. Brenda Maxim Hypothetical— Litigation Work-Products

The Brenda Maxim hypothetical shows copying by three separate appropriators: the court, the attorney in the second case, and the research system. Each will be discussed in turn.

##### (a) Court Copying of Her Expression

The court's use of Brenda's expression, even without attribution, is likely to be considered fair use. The analysis:

##### (1) Purpose of the Use

This factor largely favors fair use. First, the judge's use of Brenda's expression was not commercial. Neither the judge nor the legal system receive compensation because of the unattributed quote. Second, the purposes of the quote serves to advance the public interest as definitions of the law in court opinions are critical to democracy in a common law country and they further serve the educational function of explaining the law. Slightly contradicting a fair use finding, on the other hand, is that the quote is not a transformative use of Brenda's work-product as the court opinion would closely match the brief. Overall, the first two positive considerations,

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<sup>174</sup> See, e.g., *Arca Institute, Inc. v. Palmer*, 970 F.2d 1067, 1077 (2d Cir. 1992).

<sup>175</sup> For a discussion of this hypothetical, see Section III.C.2.c, *supra*.



particularly the public interest served, seem to outweigh the one negative, however. This factor favors fair use, therefore.

## (2) Nature of the Work

The nature of the work factor, too, generally favors fair use. As a work of non-fiction, a fair use finding is more likely established than it would be for a fictional one.<sup>176</sup> This finding is made even more probable by the law being the subject matter of the brief. On the other hand, the work is not a published work, at least as that term is defined in the Copyright Act.<sup>177</sup> An unpublished work is significantly less likely to support a fair use finding.<sup>178</sup>

In balancing these contradictory considerations, there are two reasons why the balance is likely to tip in favor of fair use. First, there is a significant chance that the courts would not use the statutory definition of publication for a fair use analysis, as the work's distribution out of the control of the author seems more apropos to fair use analysis than the traditional copyright publication analysis.<sup>179</sup> Second, even though the work was not "published," it was distributed by the author into a forum that maintains public records. Both of these increase the probability that this factor favors fair use.

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<sup>176</sup> See *Video Pipeline, Inc. v. Buena Vista Home Entm't, Inc.*, 342 F.3d 191, 200 (3d Cir. 2003).

<sup>177</sup> See 17 U.S.C. § 101 (2000) (defining "publication" as "the distribution of copies . . . of a work to the public by sale or other transfer of ownership, or by rental, lease, or lending.").

<sup>178</sup> See *Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 554 (1985).

<sup>179</sup> Cf. *American Visuals Corp. v. Holland*, 239 F.2d 740, 743 (2d Cir. 1956).

Historically, publication was the time when federal copyright protection became operative. See *Estate of Martin Luther King, Jr., Inc. v. CBS, Inc.*, 194 F.3d 1211, 1214 (11th Cir. 1999). This changed with the adoption of the 1976 Copyright Act. See note 11, *supra* with accompanying text. For a brief discussion of the history of "publication" under the Copyright Acts, see generally RayMing Chang, "Publication" Does Not Really Mean Publication: the Need to Amend the Definition of Publication in the Copyright Act, 33 AIPLA Q.J. 225, 226-31 (2005).

### (3) Amount Copied

Of the four statutory factors, this is the one that leans most strongly against a fair use finding. The most significant portion of the brief was the sections that defined both the Rule Against Perpetuities and ERISA and clarified their interrelationship. Copying the core of the brief disfavors a fair use finding.<sup>180</sup>

### (4) Effect of Copying on Brenda's Market

The court's use of the quote is unlikely to have a significant effect on Brenda's marketplace for her brief. First, there is no real economic market for briefs after their use in the case for which they were written. Although a submitted brief may sometimes be used in academia to study the subject briefed,<sup>181</sup> monetary compensation is not paid. Consequently, even if every judge quoted attorney's briefs without permission, there would be no economic impact on the attorney.

Although there is a slightly higher impact on the non-monetary reward the attorney would receive—presumably the enhanced reputation an attorney would develop by having a judge publicly acknowledge the attorney's abilities by using an approved quotation written by the attorney—the injury does not stem from copyright rights but from the court's failure to attribute the quote to the attorney. This right of attribution, however, is not protected by the Copyright Act.<sup>182</sup>

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<sup>180</sup> See *Sundeman v. Seajay Society, Inc.*, 142 F.3d 194, 205–06 (4th Cir. 1998); *Bond v. Blum*, 317 F.3d 385, 396 (4th Cir. 2003).

<sup>181</sup> See <http://www.ischool.utexas.edu/~i385tpd/385tpage.html>, at class 6 (last visited March 31, 2008) (assigning the author's *amicus* brief to a class).

<sup>182</sup> The Copyright Act only establishes a right of attribution for “work[s] of visual art.” 17 U.S.C. § 106A(a)(1)(A) (2000) (protecting an artist's right to maintain his or her name on a work of visual art). A “work of visual art” is “a painting, drawing, print, . . . sculpture, [or] still photographic image . . .” *Id.* § 101. A brief is none of these. See also *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23 (2003) (holding that a failure to attribute a public domain work to its author does not violate 15 U.S.C. § 1125(a)).

Additionally, although Brenda was not given credit for the quote itself, she would be listed as counsel of record, thus giving her much of the credit for the case.

Both the monetary and non-monetary analysis reach the same result: There is no significant impact on Brenda's market. This most important factor also favors fair use, therefore.

#### (5) The Fifth Factor— Legal System Considerations

The probable fifth factor also strongly favors fair use. Brenda's brief was developed with the primary purpose of influencing a judge to render a favorable decision. This, of course, is how our common law system develops the law.<sup>183</sup> Disallowing a judge to quote from a brief without the permission of the brief's author would seem to serve as a major impediment in the functioning of the legal system. Consequently, courts are much more likely to consider brief copying to be fair use.

#### (6) Conclusion

Three of the four statutory factors favor a finding of fair use as do the extra-statutory considerations. It is probable, therefore, that a court would find that the judge's appropriation of Brenda's work-product was fair and, consequently, not a violation of the Copyright Act.<sup>184</sup>

#### (b) Other Attorneys Copying Her Expression

The other attorney appropriating Brenda's expression without permission is less likely to be a fair use. The analysis:

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<sup>183</sup> See LAWRENCE M. FRIEDMAN, A HISTORY OF AMERICAN LAW 17-20 (1973). See generally, OLIVER WENDELL HOLMES, THE COMMON LAW (1881).

<sup>184</sup> Although judicial plagiarism is not prevented by the Copyright Act, it is not suggested that this conduct is appropriate. See ABA MODEL CODE OF JUDICIAL CONDUCT, R. 1.2 (2007), available at [http://www.abanet.org/judiciaethics/ABA\\_MCJC\\_approved.pdf](http://www.abanet.org/judiciaethics/ABA_MCJC_approved.pdf).

## (1) Purpose of the Use

This factor no longer favors fair use. First, unlike when the judge appropriated Brenda's work-product, the second attorney's use of it was commercial as the attorney was being paid for writing the second brief.<sup>185</sup>

Second, the new brief was not significantly transformative as it was briefing the same legal issues in the same way. On the other hand, the use does serve a similar educational and law making purpose as before except that, of course, it is now being used to influence the development of the law rather than to announce it. With the educational role weakened and the commercialization increased, this factor now tips against fair use.

## (2) Nature of the Work

The nature of the work factor's analysis is the same as when the judge appropriated Brenda's expression,<sup>186</sup> so it favors fair use.

## (3) Amount Copied

Again, the amount copied analysis is identical to the one of the court's use of Brenda's brief,<sup>187</sup> so the factor disfavors fair use.

## (4) Effect on Brenda's Market

The effect of copying factor differs from the analysis of the court's use of the brief. If an attorney who feels compelled to copy another attorney's brief on a complicated issue is not allowed to do so, there is a significant chance that

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<sup>185</sup> Only if the second attorney was functioning purely as a *pro bono* counsel would this not be true. If the attorney received any benefit – credit towards promotion in a firm's *pro bono* program or a salary from an advocacy group, etc. – the purpose of the use will be tainted with commercialism.

<sup>186</sup> See Section IV.F.1.a.(2), *supra*.

<sup>187</sup> See Section IV.F.1.a.(3), *supra*.

more experienced counsel will be retained.<sup>188</sup> Of these consultations, some of them would likely be with attorneys in Brenda position.<sup>189</sup> As a consequence, this factor tips away from fair use.

(5) The Fifth Factor—  
Legal System Considerations

This factor, as when the judge quoted Brenda's brief,<sup>190</sup> favors a fair use finding.

(6) Conclusion

In the case of the second attorney copying Brenda's brief, three of the four factors weigh against a fair use finding. Particularly because the use is commercial without a countervailing transformation of the copied work,<sup>191</sup> a court is unlikely to determine that the defense has been established. Consequently, a violation of the Copyright Act most likely occurred.

(c) Research System Copying Her Expression

A fair use finding is least likely for the research system's copying of Brenda's brief. The analysis of most of the factors is the same as when the attorney copied the work,<sup>192</sup> but the purpose of the use factor now clearly suggests that the use is not fair. As research services are not free, their use of the brief becomes commercial. A commercial use is only fair where the other fair use factors overcome the author's normal

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<sup>188</sup> Cf. MODEL RULES 1.1, cmt. 2 ("Competent representation can also be provided through the association of a lawyer of established competence in the field in question.").

<sup>189</sup> A market effect is found if all copyright producers who are similarly situated would likely lose value. See note 165, *supra* with accompanying text.

<sup>190</sup> See Section IV.F.1.a.(5), *supra*.

<sup>191</sup> See *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 578–79 (1994).

<sup>192</sup> See Section IV.F.1.b, *supra*.

entitlement to compensation.<sup>193</sup> This is most likely to be true where the appropriated work is highly transformed by the copier,<sup>194</sup> something that is not true in this hypothetical as an exact copy was made.

## 2. David Smith Hypothetical— Transactional Work-Products<sup>195</sup>

The fair use situation changes when non-litigation documents are analyzed. Overall, the probability of a fair use finding decreases.

### (a) Purpose of the Use

This first factor strongly indicates that Howard's copying of and modifications to David's contract were not fair. First, unlike a litigation work-product, no strong public interest is served by its subsequent use as contracts are not generally shared with the public at large and, consequently, serve no educational purpose. Second, although names and addresses may have been changed, the "copyrightable expression in the original work [was not] used as raw material, transformed in the creation of new information, new aesthetics, new insights and understandings,"<sup>196</sup> meaning that no significant transformation occurred. Finally, the use of the contract by a competing attorney is a fundamentally commercial use.<sup>197</sup> These three facts establish that the purpose of the use factor disfavors fair use.

### (b) Nature of the Work

As with a litigation work-product, a contract is a work of non-fiction, thus increasing the chances of a fair use finding.

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<sup>193</sup> See *Campbell, Inc.*, 510 U.S. at 585.

<sup>194</sup> See *id.* at 578-79.

<sup>195</sup> The facts of this hypothetical can be found in Section I.B, *supra*.

<sup>196</sup> *Castle Rock Entm't v. Carol Pub. Group, Inc.*, 150 F.3d 132, 142 (2d Cir.1998) (quotation marks omitted).

<sup>197</sup> Cf. *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 579 (1994).

In distinction with a litigation document, however, a contract is not distributed into a system that maintains public records. As a consequence, a contract represents a work that is neither published nor distributed which generally implies that a fair use finding is not appropriate.<sup>198</sup> Although it is possible that this statutory factor would be considered to be neutral, most courts would likely find that it disfavors a fair use finding.

(c) Amount Copied

Again, as the entire contract was copied, this factor disfavors a fair use finding.

(d) Effect on David's Market

The market effect of copying such as Howard did in the hypothetical is likely to adversely affect David's financial and reputational markets. Howard, or any other attorney who is similarly situated, has avoided the necessity of either referring the matter to a more experienced attorney who could draft the complicated contract or arranging to have a seasoned mentor assist in the drafting of it. Both of these impact on the more seasoned attorney's market.

(e) The Fifth Factor—Legal System Considerations

Unlike a litigation document which has a direct connection to the public interest in the development of the law, transactional documents are associated with private orderings. A contract serves to establish the details of a legal relationship between its parties, but does not serve the broader purpose of educating the judge and public about the definition of the law. Consequently, there is no interest outside of the four statutory factors that is likely to cause a court to find fair use.

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<sup>198</sup> See *Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 554 (1985).

(f) Conclusion

None of the factors in the statute favor a fair use finding. There is no outside consideration that would compel a court to develop a fifth factor. A finding of fair use, therefore, is extraordinarily unlikely.

V. CONCLUSION

The determination of whether an attorney's legal rights have been violated by another's appropriation of a work product is not an easy analysis. Most times, the attorney will need to consider the competing equitable considerations of a copyright fair use analysis and may have to attempt to divine the terms of an agreement that were never expressed. Even after an analysis is done, the conclusion may be unclear and even contradictory.

As a practical matter, pursuing legal rights may be unwise outside of a direct appropriation by another attorney or a commercial enterprise. For other parties, an attorney would be wise to resolve the issue with due regard for the broader, public service considerations of the practice of law.