Merger as a Matter of Extrinsic Constraints

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I am here to talk to you about merger. What is merger? Let's first take a look at what the Second Circuit says merger is. The Second Circuit says merger happens "in those instances where there is only one or so few ways of expressing an idea that protection of the expression would effectively accord protection to the idea itself."[1] A situation where, if you've got a monopoly on a particular way of expressing something, you've effectively got a monopoly on that thing—and we don't want you to have a monopoly on that thing. I'll talk in a little bit about what the kinds of things are. Why only one "*or so few*" ways? To avoid a situation where there are three ways of expressing it, and three people express it in all of those three ways, and all get exclusive rights in their particular way. Now there is still no available way for the public to express that thing that we want the public to be able to express without the interference of copyright.

The way that I think about it—and I think Josh may think about it differently[2]—is that there is some external factor that effectively requires some later individual, some later user, to copy expression in order to use that idea or fact. And it's got to be an external factor. Not just aesthetic preference; there's got to be something effectively forcing you to use the same otherwise copyrightable original expression of that earlier author.

What are those things? The Second Circuit said merger is where protecting the expression "would effectively accord protection to the idea itself."[3] But unfortunately, when the courts talk about this, they use the word "idea" in two different ways. They use it to refer to the thing we would refer to as an idea or concept—a thought. And they use it to refer to any uncopyrightable matter that we want everyone to be able to use. So I'm going to exclude the word "idea" from my discussion of the merger doctrine, and I think we should just think about it in a little bit more of a granular way. Getting rid of "idea," there's certainly *concept*-expression merger. If there's only one or a few ways to express a particular concept

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1. Kregos v. Associated Press, 937 F.2d 700, 705 (2d Cir. 1991).

2. *See generally* Joshua L. Simmons, *The Five* W*'s of Merger*, 43 COLUM. J.L. & ARTS 407 (2020).

3. *Kregos*, 937 F.2d at 705.

or thought, those particular ways won't be subject to copyright and people will be free to express that concept.

But it's not limited to concepts. Another one that one frequently sees is *fact*-expression merger. What is the external constraint here if there is only one or a few ways to express a fact? The external constraint is that the fact is objectively true in the world. The constraint is that this is something that is actually the case, and people should be able to say and express things that are the case in the world.

Process-expression merger: If there is only one way to say what this set of steps is, or how to do something, there's a reason to exclude that from protection. That won't necessarily be the case for every process. Not every process will necessarily merge. There are many processes that have lots of different ways that you can express them. But sometimes there is only one, and in those cases, merger will step in. The same is true of methods of operation. For many, many methods of operation, there are innumerable ways to express them and there's no reason to use particular expression to talk about a particular method of operation. However, when we're talking about something like a spreadsheet program and you're saying what commands to use and in what order, there might be only one way to say it—because if you don't say those commands, and you make up your own commands, it just won't work.[4] That's not the method of operation.

Another one, and this is one that might get some attention from the Supreme Court in its upcoming case involving the State of Georgia,[5] is *law*-expression merger. What's the external constraint here, on the different ways to express something? Where you could have expressed it just about any way? The external constraint here is that *it's the law*. And if you paraphrase the law or express it in a different way or say it differently, it's no longer the law. It's something different. It's your interpretation of the law or your thoughts on the law. It's not the text of the law.

The thing that I want to think about, particularly in the context of law-expression merger and some of these other kinds of merger is: *When* do we look at the merger question? Do we think about it at the time of fixation? That is, can we answer every question that we might want to answer about whether there is some external constraint that effectively requires copying of expression? Can we answer all of those questions at the time of fixation? Or are there some of those questions that we can't answer until after fixation—until some events have occurred in the world? Until some things have happened, extrinsic to the four corners of the fixed work, that might tell us things about whether there are external constraints that effectively require the use of certain expression in order to express a fact or concept or method of operation?

Usually, you'll be able to do this at the time of fixation. You'll be able to say, "I can see within the four corners of this document that there's only one way to express what's being expressed here, and that was true from the time of fixation to any time later." But sometimes, this will happen after fixation. Sometimes, in relatively rare instances, there are things that happen after the fixation of the work that change the

4. *See* Lotus Dev. Corp. v. Borland Int'l, Inc., 49 F.3d 807 (1st Cir. 1995).
5. Georgia v. Public.Resource.Org, Inc., 139 S. Ct. 2746 (2019).

extent to which there are extrinsic factors or extrinsic considerations that effectively require copying of a particular piece of expression, to make use of that fact or underlying concept that is common property.

One example of this is a situation where something is *shown* to be a fact: Something is speculation at the time that it's fixed, it's not stated to be a fact, but it is later *shown* to be a fact. Does the person who wrote the speculation have a monopoly in the expression of that thing that is now a fact? No, because now it's a fact, even if it wasn't shown to be a fact at the time of fixation.

Something could be shown to be more efficient. You could have made a choice in designing the flow of a computer program, for example; you could have had any number of choices at the time you were writing the computer program, and you didn't know which one was more efficient and you weren't doing it for the reason of making it more efficient. But later it turns out, maybe unbeknownst to you at the time of fixation, that the choice you made is actually the most efficient way to arrange those steps. That doesn't mean you're the only person who gets to use that structure, sequence, and organization that turns out to be more efficient. You could learn that later—we could all learn that later—and that might affect merger.

Separately, something might actually not have been more efficient, but it might *become* more efficient as computer technology or other extrinsic factors change around the copyrighted work and change the situation in which we are judging what the extrinsic factors are that are necessitating the use of what would otherwise be protected expression. And, of course, something can become an unlock code. We know this from the *Lexmark* case.[6] There are situations where copyrighted works—for example, the Sega logo[7]—are used not for their expressive purpose, but as an unlock code. When they were created, they might have been a nonfunctional, expressive work that could have been expressed in any way. But once they become an unlock code, or something that you need to input in order to make the thing go, now there's an extrinsic constraint that's been imposed.

And finally, there are things that *become* the law. You can write something down and it can be your personal expression of what you think the rule should be, but if that's enacted as the law, now everybody has to say it that way. The external constraint is, it's the law now. For example, this is a piece of the current, 2015 New York State Building Code for how high the handrail has to be over a stairway: "Handrail height, measured above stair tread nosings, or finish surface of ramp slope, shall be uniform, not less than 34 inches (864 mm) and not more than 38 inches (965 mm)."[8] This is not the most brilliant expression in the world, but it was probably protectable as part of an overall work, in the abstract, at the time it was written. But it's enacted into law, so now there's only one way to say it. Notably, this is not just Section 1014.2 of the 2015 New York State Building Code—this is also "Copyright International Code Council, Inc." It is Section 1014.2 of the 2015 International

6. Lexmark Int'l, Inc.v. Static Control Components, Inc., 387 F.3d 522 (6th Cir. 2004).

7. Sega Enters. Ltd. v. Accolade, Inc., 977 F.2d 1510 (9th Cir. 1992).

8. INT'L BLDG CODE § 1014.2 (INT'L CODE COUNCIL, INC. 2015) (3d printing as adopted by New York State).

Building Code that was incorporated by reference by New York State in its law.[9] The interesting question becomes: Was there something that happened after the International Code Council published its views on what the rules should be that caused merger to happen? And my answer to that is yes—what happened is that it got enacted into law. So that's just one example, and there are others, as I discussed, where merger can happen after the time of fixation and we should think about it as a question of extrinsic constraints both on the initial user and on later users, rather than something that can solely be intrinsic to the fixed work in the first instance.

What I'll leave you with is just the note that there's a case pending in the Southern District of New York, for which I am counsel for the defendant, against a company called UpCodes.[10] What UpCodes did is publish the New York State Building Code on its website, and it is now being sued for copyright infringement. One of the arguments at issue is merger. Thank you.

9. *See* N.Y. COMP. CODES R. & REGS. tit. 19, § 1221.1 (West, Westlaw through amendments included in the N.Y. State Reg., Vol. XXLII, Issue 9 dated Mar. 4, 2020).

10. Int'l Code Council, Inc. v. Upcodes, Inc., No. 1:17-cv-06261 (S.D.N.Y. filed Aug. 17, 2017).