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# Commercial Speech Jurisprudence and Copyright in Commercial Information Works

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# COMMERCIAL SPEECH JURISPRUDENCE AND COPYRIGHT IN COMMERCIAL INFORMATION WORKS

ALFRED C. YEN\*

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## I. INTRODUCTION

This Essay uses the First Amendment jurisprudence of commercial speech to explain in a partial and preliminary fashion why courts should interpret doctrines like originality and the idea/expression dichotomy to limit copyright protection for works that convey basic commercial information about goods or services. These works, which the Essay calls “commercial information works,” include advertisements (or at least certain aspects thereof), numbering systems, contracts, financial prospectuses, and commercial labels.

Commercial information works are interesting to study because they differ in two ways from the books, music, movies, and other works at the heart of copyright. First, commercial information works often present weak cases for copyright because they exhibit relatively low levels of the originality required for copyright.<sup>1</sup> Insurance policies must accurately portray the commercial terms of the financial transactions being promoted, and labels have to depict the commercially significant

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1. See 17 U.S.C. §102(a) (2000) (“Copyright protection subsists . . . in original works of authorship . . .”); *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345–47 (1991) (explaining that originality is a prerequisite to copyright).

properties of the works in question. Authors therefore have fewer choices to make when creating these works, making them less expressive than most other works. By contrast, the vast majority of books, music, and movies fit comfortably within copyright subject matter because they display copious amounts of the originality and creativity required for copyright.

Second, copyright protection for commercial information works frequently is problematic from the standpoint of copyright policy. Copyright generally operates on the assumption that authors create works for the purpose of selling copies for profit. However, people create commercial information works to promote the sale of other things, so they do not expect profits from the sale of commercial information works. Moreover, commercial information works frequently convey information that competitors of the copyright holder will want or even need to repeat. Thus a mutual fund company will create a commercial information work (a prospectus) to inform potential investors about the salient features of the fund in question. A competitor who decides to offer an identical fund will also need its own prospectus containing the same information, and that prospectus will necessarily resemble closely the first company's prospectus. If copyright allows the first company to disrupt the sale of the second company's mutual fund shares,<sup>2</sup> then the first company will have gained a competitive advantage unrelated to copyright's purpose of encouraging the production of new works.<sup>3</sup>

Courts do not agree about how much these observations matter when applying copyright to commercial information works. Some courts worry about the consequences of copyrighting commercial information works and give them little or no protection. Others seem reluctant to distinguish commercial information works from other works and grant copyright to commercial information works more freely.<sup>4</sup>

The First Amendment becomes relevant to copyright in commercial information works because copyright restricts free speech. Copyright tells people that, in certain situations, they may not freely reproduce or distribute particular books, essays, music, or art.<sup>5</sup> Granted, this restriction need not render copyright

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2. This would likely happen through an injunction against distribution of the defendant's prospectus, a remedy that would routinely follow a finding of infringement. See Mark A. Lemley & Eugene Volokh, *Freedom of Speech and Injunctions in Intellectual Property Cases*, 48 DUKE L.J. 147, 158–65 (1998); see, e.g., *LGS Architects, Inc. v. Concordia Homes*, 434 F.3d 1150, 1155–57 (9th Cir. 2006) granting a temporary injunction preventing use of copyrighted building plans where the defendant exceeded the scope of the licensing agreement; *Lexmark Int'l, Inc. v. Static Control Components*, 387 F.3d 522, 532–33 (6th Cir. 2004) (vacating a preliminary injunction granted in software copyright action); *Triad Sys. Corp. v. Se. Express Co.*, 64 F.3d 1330, 1335 (9th Cir. 1995) (affirming an injunction granted in software copyright action).

3. See *Boyle v. Stephens, Inc.*, No. 97 Civ. 1351, 1998 WL 80175, at \*5 (S.D.N.Y. Feb. 25, 1998) (Copyright in plaintiff's prospectus and other materials “does not preclude others from also describing such fund characteristics as the availability of individual-specific ‘series’ and the shifting investment composition. Otherwise, plaintiff could prevent competitors from fully describing the mutual fund concept in a prospectus or other selling materials—a result the copyright laws do not contemplate.”).

4. See *infra* Part II.

5. See 17 U.S.C. § 106 (2000) (defining exclusive rights of copyright holders).

inconsistent with the First Amendment. As many courts have noted, the pro-speech benefits of appropriately constructed copyright, particularly its stimulation of new speech, outweigh the costs associated with its suppression of speech.<sup>6</sup> Copyright therefore remains constitutional as long as courts interpret it with due regard for the First Amendment.<sup>7</sup> Failure to interpret copyright this way may not violate the Constitution in any given case, but it surely raises the long-term possibility of a constitutionally problematic copyright regime that does not serve society's best interests. Courts should therefore draw lessons from First Amendment jurisprudence when interpreting copyright.<sup>8</sup>

As this Essay discusses, the First Amendment can help courts decide whether to limit copyright in commercial information works. There are, of course, perfectly understandable reasons to grant broad copyright in these works. Modern copyright doctrine grants copyright liberally, in part because courts do not want to distinguish works on the basis of their aesthetic or creative content.<sup>9</sup> Moreover, the basic explanation of copyright's constitutionality makes no distinction between various types of speech affected by copyright. No one asks whether the encouragement of computer programs matters more to the First Amendment than the suppression of fine art. It is therefore easy to understand why some courts overlook the distinctive characteristics of commercial information works and treat them as if they were books, movies, or music.

However, additional reflection suggests that this practice may not make sense if copyright truly takes its interpretive cues from First Amendment jurisprudence. Courts may express reluctance to distinguish between various types of speech in copyright, but they do the opposite when deciding First Amendment cases. Indeed, First Amendment jurisprudence divides speech into a number of constitutionally significant categories. Obscenity and fighting words receive no First Amendment protection,<sup>10</sup> while indecent speech, defamation, and commercial speech receive less protection than do most other forms of speech.<sup>11</sup> If courts distinguish between various forms of speech in First Amendment cases, perhaps courts should follow suit in copyright.

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6. See *Eldred v. Ashcroft*, 537 U.S. 186, 219 (2003) (noting that copyright does not conflict with the First Amendment because it encourages new speech); *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 558–60 (1985) (noting copyright is an “engine of free expression” and rejecting concerns about conflict between copyright and the First Amendment).

7. *Nation Enters.*, 471 U.S. at 559–60 (explaining how application of doctrines such as fair use and the idea/expression dichotomy keep copyright within constitutional limits).

8. The Supreme Court has recently stated that “it is appropriate to construe copyright’s internal safeguards to accommodate First Amendment concerns.” *Eldred*, 537 U.S. at 221 n.24.

9. See *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345, 359 (1991) (noting the level of creativity needed to support copyright is “extremely low” and copyright’s requirement of originality “is not particularly stringent”); *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 250–52 (1903) (stating that courts should not judge the artistic merit of works and suggesting there is no need for meaningful assessment of originality).

10. See *Miller v. California*, 413 U.S. 15, 23 (1973) (regarding obscenity); *Chaplinsky v. New Hampshire*, 315 U.S. 568, 571–72 (1942) (regarding fighting words).

11. See *Gertz v. Robert Welch, Inc.*, 418 U.S. 323, 341 (1974) (regarding defamation).

The First Amendment jurisprudence of commercial speech is of particular interest in this regard because it rests on observations particularly germane to copyright. Commercial speech gets First Amendment protection because it plays an important role in our market economy.<sup>12</sup> At the same time, however, commercial speech does not get full First Amendment protection because existing monetary incentives make the production of commercial speech quite likely, even if government tries to discourage or suppress it.<sup>13</sup>

When one applies these observations to copyright in commercial information works, some interesting insights emerge. First, existing commercial incentives for the production and dissemination of commercial speech imply that copyright has little effect on the production of commercial speech. Second, the importance of accurate commercial signals to our economy implies that those signals should be freely disseminated, not restricted by copyright. Together, these insights imply that copyright in commercial information works should be carefully limited.<sup>14</sup>

The Essay proceeds in three steps. Part II quickly summarizes copyright's application to works conveying basic commercial information. Part III studies the First Amendment jurisprudence of commercial speech. Part IV explains how the First Amendment affects the application of copyright to commercial information works. Part V concludes with some thoughts about how insights gleaned from the First Amendment jurisprudence of commercial speech might affect other parts of copyright law.

## II. COPYRIGHT IN COMMERCIAL INFORMATION WORKS

Two doctrines, originality and the idea/expression dichotomy, heavily influence the application of copyright to commercial information works. This part describes how courts interpret these doctrines to reach strikingly different results.

### A. *Originality and Commercial Information Works*

Copyright protects a work only if the work exhibits originality.<sup>15</sup> The Supreme Court has established that the requirement of originality is modest.<sup>16</sup> It is therefore fairly easy for most works to gain copyright protection. Nevertheless, copyright defendants often argue that commercial information works lack sufficient originality to sustain copyright. Courts differ in their responses to this contention.

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12. *See infra* note 104 and accompanying text.

13. *See infra* notes 113–15 and accompanying text.

14. *See* Lisa P. Ramsey, *Intellectual Property Rights in Advertising*, 12 MICH. TELECOMM. & TECH. L. REV. 189, 217–23, 229–33, 246–49 (2006) (noting these characteristics of advertising and using them to suggest limiting the scope of copyright in advertisements); Note, *Rethinking Copyright for Advertisements*, 119 HARV. L. REV. 2486, 2490–92, 2501–07 (2006) (noting that advertisements do not require copyright incentives to ensure production and suggesting limitations on copyright for advertisements on the basis of the useful article doctrine).

15. *See supra* note 1.

16. *See supra* note 9.

*Sassafras Enterprises, Inc. v. Roshco, Inc.*<sup>17</sup> exemplifies cases that have interpreted originality to deny copyright to commercial information works. The plaintiff, Sassafras, sold pizza stones that came with pamphlets describing the stones and giving instructions for use, recipes, and promotional statements touting the quality of the product and relating the history of breadmaking.<sup>18</sup> The defendant, Roshco, also sold pizza stones accompanied by pamphlets that resembled those of Sassafras.<sup>19</sup> Sassafras objected and sued for, among other things, copyright infringement.<sup>20</sup> Roshco moved for summary judgment on the issue of copyright infringement,<sup>21</sup> and the court granted the motion on the ground that Sassafras's works lacked sufficient originality.<sup>22</sup> According to the court, Sassafras's writing about the care and use of its pizza stones "flow[ed] from the characteristics and intended use of the product, not from the imagination of any independent author."<sup>23</sup> Even the recipes and promotional writings touting the quality of the product failed to exhibit sufficient originality.<sup>24</sup>

*Sassafras* is a mildly surprising decision, for Sassafras had an entirely plausible claim that could easily have survived summary judgment on the issue of copyrightability. As has already been noted, leading cases state that the copyright's requirement of originality is lenient.<sup>25</sup> The creation of Sassafras's pamphlet surely involved at least a small amount of originality, and a jury could easily have found in favor of Sassafras. Why then did this not happen? The answer lies in the court's understanding of the relationship between Sassafras's reasons for suing and copyright policy.

The court began its copyright analysis by describing the case as one in which an established commercial enterprise responded to competition by suing for copyright infringement.<sup>26</sup> Later, the court noted that Sassafras did not sue to protect incentives provided by copyright.<sup>27</sup> The court expressed certainty that Sassafras would have produced its pamphlets with or without copyright because commercial imperatives and the nature of its product made the pamphlets necessary.<sup>28</sup> It therefore made little sense to use copyright to protect Sassafras's pamphlets because doing so would give Sassafras "an unwarranted economic advantage."<sup>29</sup>

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17. 889 F. Supp. 343 (N.D. Ill. 1995).

18. *Id.* at 344.

19. *Id.* at 344–45.

20. *Id.* at 343–44.

21. *Id.* at 344.

22. *Id.* at 346–47.

23. *Id.* at 347.

24. *Id.*

25. *See supra* note 9.

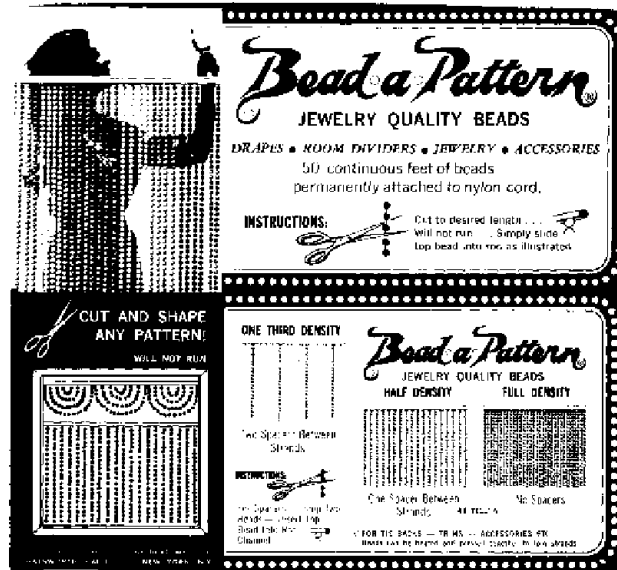
26. *Id.* at 345.

27. *Id.* at 346.

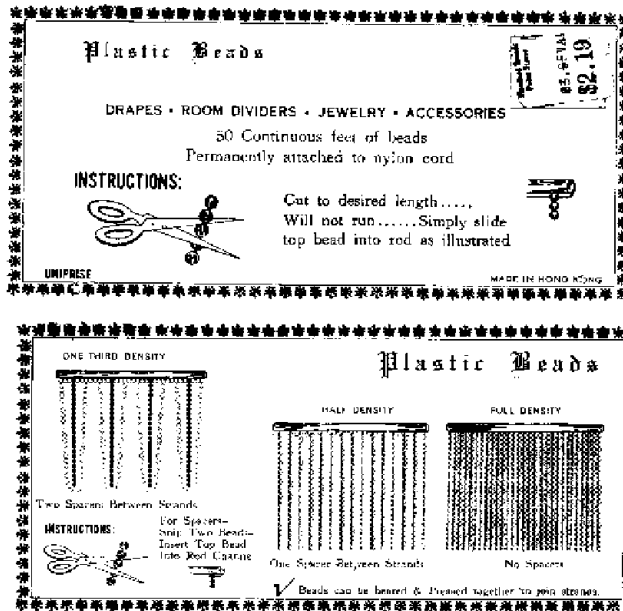
28. *Id.*

29. *Id.* Other cases have denied copyright to commercial information works on grounds of insufficient originality. *See Toro Co. v. R & R Products Co.*, 787 F.2d 1208, 1213 (8th Cir. 1986) (holding an arbitrarily designed parts numbering system lacks originality); *Alberto-Culver Co. v. Andrea Dumon, Inc.*, 466 F.2d 705, 711 (7th Cir. 1972) (holding that merely descriptive language on

By way of contrast, consider the case of *Abli, Inc. v. Standard Brands Paint Co.*<sup>30</sup> In *Abli*, the plaintiff sold strings of plastic beads in packages with these labels<sup>31</sup>:



The defendant, who sold substantially identical strings of beads,<sup>32</sup> copied from the plaintiff's labels to produce these labels<sup>33</sup>:



product label, including the phrase “most personal sort of deodorant,” was uncopyrightable for lack of originality).

30. 323 F. Supp. 1400 (C.D. Cal. 1970).

31. *Id.* at 1402, 1406.

32. *Id.* at 1402.

33. *Id.* at 1407.

In response to the plaintiff's claim for copyright infringement, the defendant argued that the plaintiff's labels were not copyrightable because the labels were merely descriptive and functional considerations dictated the form of the text.<sup>34</sup>

Examination of the works at stake in *Abli* reveals that the defendant had at least as good a case as Roshco had in *Sassafras*. As an initial matter, it is hard to see how phrases like "50 continuous feet of beads permanently attached to nylon cord" exhibit any originality when they exactly describe the product being sold. Surely these phrases and *Abli*'s labels did not contain more originality than the pamphlets authored by *Sassafras*. Additionally, *Abli*'s suit raised the same policy concerns that carried the day in *Sassafras*, for *Abli* sued to disrupt a competitor's sales of beads and not to protect copyright incentives derived from the sale of labels.

Despite all of this, the court decided in *Abli*'s favor.<sup>35</sup> Tellingly, the court did not even mention the policy concerns raised by the case. Instead, the court apparently believed that the defendant's appropriation was an intrinsic wrong that had to be stopped. The court stated that "[a]ppropriation of the fruits of another's labor and skill in order to publish a rival work without the expenditure of the time and effort required for independently arrived at results is copyright infringement."<sup>36</sup> Accordingly, the court asserted that the only obstacle to copyright was the modest and easily met requirement of originality, and the plaintiff's victory quickly followed.<sup>37</sup>

### *B. The Idea/Expression Dichotomy and Commercial Information Works*

Section 102(b) of the copyright code denies copyright to a work's ideas.<sup>38</sup> Copyright contains this limitation because the public would suffer if individuals could own ideas. All authors borrow ideas from one another. If they had to pay for the privilege of doing so, the creation of new works would suffer. Accordingly, copyright strikes a balance between the need to encourage speech through copyright incentives and the need to make authorship possible by leaving ideas in the public domain while allowing authors to claim copyright in their individual expression of ideas.<sup>39</sup>

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34. *Id.* at 1403.

35. *Id.* at 1405.

36. *Id.* at 1404 (quoting *Orgel v. Clark Boardman Co.*, 301 F.2d 119, 120 (2d Cir. 1962)).

37. *Id.* at 1403–04 (quoting *Doran v. Sunset House Distrib. Corp.*, 197 F. Supp. 940, 944 (S.D. Cal. 1961)). Cases reaching results similar to *Abli* include *Drop Dead Co. v. S.C. Johnson & Son*, 326 F.2d 87, 93 (9th Cir. 1963) (upholding copyright in aerosol wax label); *Kitchens of Sara Lee, Inc. v. Nifty Foods Corp.*, 266 F.2d 541, 544–45 (2d Cir. 1959) (holding defendant infringed the pictures on plaintiff's product labels); *X-IT Products, LLC v. Walter Kidde Portable Equipment, Inc.*, 155 F. Supp. 2d 577, 608–11 (E.D. Va. 2001) (holding product's box cover art is copyrightable); *Sebastian Int'l, Inc. v. Consumer Contact (PTY) Ltd.*, 664 F. Supp. 909, 913 (D.N.J. 1987) (finding text on shampoo bottle copyrightable), *rev'd on other grounds*, 847 F.2d 1093, 1099 (3d Cir.1988).

38. 17 U.S.C. § 102(b) (2000).

39. *See Eldred v. Ashcroft*, 537 U.S. 186, 219 (2003) (explaining contrast between protection of expression and promotion of ideas); *Baker v. Selden*, 101 U.S. 99, 104–05 (1879) (differentiating between the idea of an accounting system and a particular book's expression of the proper use of the



The idea/expression dichotomy narrows the scope of copyright in a work by leaving portions of the work free for borrowing. In some cases, the idea/expression dichotomy even requires the denial of copyright to an otherwise copyrightable work. This happens when an idea has merged with its expression.

An idea merges with its expression when the idea can be expressed in only a limited number of ways. In situations like this, allowing individuals to claim copyright in the expression of such an idea would be tantamount to allowing individuals to own the idea. For example, if an idea could be expressed in only three ways, the three people who held copyright in those expressions would effectively own the idea because no one else could express the idea without committing infringement. Courts have responded to this possibility by severely limiting or denying copyright to works whose ideas have merged with their expression.<sup>40</sup>

The seminal case, *Baker v. Selden*,<sup>41</sup> illustrates how the idea/expression dichotomy sometimes requires limitation of copyright in an otherwise copyrightable work. The *Baker* plaintiff owned the copyright in a book explaining a particular method of double-entry bookkeeping.<sup>42</sup> The book included a number of blank forms that illustrated and could be used to carry out the particular method described in the plaintiff's book.<sup>43</sup> The defendant also produced forms to carry out the same system of bookkeeping, and these forms were similar, but not identical, to the plaintiff's.<sup>44</sup> The plaintiff sued for copyright infringement and won in the lower courts, but the Supreme Court reversed.<sup>45</sup>

The Court's decision rested on the distinction between the system of bookkeeping and the plaintiff's description of the system. A person could claim copyright in such a description, but copyright did not protect the system being described.<sup>46</sup> The system therefore remained in the public domain, free for all to use.<sup>47</sup> The Court worried that copyright in the plaintiff's explanation would prevent free use of the underlying system, and it responded by denying copyright to the

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accounting system); *Computer Assocs. Int'l Inc. v. Altai, Inc.*, 982 F.2d 693, 696 (2d Cir. 1992) (describing "delicate equilibrium" between level of copyright that gives authors incentives to create and limiting such copyright to avoid stagnation from monopoly).

40. See *Herbert Rosenthal Jewelry Corp. v. Kalpakian*, 446 F.2d 738, 742 (9th Cir. 1971) (holding the idea of jewel-encrusted "bee" pin was indistinguishable from the expression of that idea, and therefore there was no copyright protection for plaintiff's pin); *Morrissey v. Procter & Gamble Co.*, 379 F.2d 675, 676, 678–79 (1st Cir. 1967) (holding the idea of distributing rules for sweepstake contest had merged with the expression of that idea, and therefore there was no copyright protection for plaintiff's rules); *Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 122 (2d Cir. 1930) (holding the abstract plot and characters in a play constituted ideas rather than expression, and therefore there was no copyright protection for plaintiff's plot and characters).

41. 101 U.S. 99 (1879).

42. *Id.* at 99–100.

43. *Id.* at 100.

44. *Id.* at 100–01.

45. *Id.* at 100, 107.

46. *Id.* at 104–05.

47. *Id.* at 105.

plaintiff's blank forms.<sup>48</sup>

*Baker v. Selden* has influenced many courts to limit or deny copyright in commercial information works.<sup>49</sup> For example, in *Crume v. Pacific Mutual Life Insurance Co.*,<sup>50</sup> the plaintiff claimed copyright in four pamphlets describing the reorganization of insolvent insurance companies.<sup>51</sup> According to the plaintiff's complaint, the defendant published a "Rehabilitation and Reinsurance Agreement" that contained "many clauses, paragraphs and parts" of the plaintiff's pamphlets.<sup>52</sup> The plaintiff sued for copyright infringement, the district court granted the defendant's motion to dismiss, and the plaintiff appealed.<sup>53</sup>

In affirming the dismissal, the Seventh Circuit effectively denied copyright in the language borrowed by the defendant, even though the plaintiff duly copyrighted its pamphlets.<sup>54</sup> Citing *Baker*, the court distinguished the reorganization plans from the plaintiff's description of the plans.<sup>55</sup> The court then observed that the plaintiff's claim amounted to a denial of the defendant's ability to use the specific words that implemented the plans in question.<sup>56</sup> In situations like this, the defendant's use of the plaintiff's language could not amount to copyright infringement because such a result would give ownership of the relevant plans to the plaintiff.<sup>57</sup> The court recognized that this result effectively denied copyright in the plaintiff's works,<sup>58</sup> but

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48. *Id.* at 105–06 (quoting *Clayton v. Stone*, 5 F. Cas. 999, 1003 (S.D.N.Y. 1829) (No. 2872)); see also *Lotus Dev. Corp. v. Borland Int'l Inc.*, 49 F.3d 807, 816 (1st Cir. 1995) (applying reasoning from *Baker* to computer programs functioning as "methods of operation" and finding no copyright protection); *Bibbero Sys., Inc. v. Colwell Sys., Inc.*, 893 F.2d 1104, 1108 (9th Cir. 1990) (denying copyright in medical claim forms); *Mannion v. Coors Brewing Co.*, 377 F. Supp. 2d 444, 452–54 (S.D.N.Y. 2005) (describing qualities of photographs that indicate protectable originality, which must exist because the subject, or idea, of a photograph usually cannot be protected).

49. See *ATC Distribution Group, Inc. v. Whatever It Takes Transmissions & Parts, Inc.*, 402 F.3d 700, 707–10 (6th Cir. 2005) (applying merger of idea and expression to deny copyright to a parts numbering and classification system and noting policy reasons for doing so); *Southco, Inc. v. Kanebridge Corp.*, 390 F.3d 276, 282 (3d Cir. 2004) (parts numbers lack originality because they are dictated by the logic of an idea, namely the plaintiff's parts numbering system); *Sassafras Enters., Inc. v. Roshco, Inc.*, 889 F. Supp. 343, 346–37 (N.D. Ill. 1995) (promotional materials accompanying pizza stone lack originality and idea/expression dichotomy requires limitation on breadth of possible infringement claims by plaintiff). The *Baker* Court would likely have approved of these results, for it cited *Cobbett v. Woodward*, (1872) 14 L.R. Eq. 407, an English case denying copyright in drawings from a furniture catalog—a form of commercial information work—on the ground that the drawings merely depicted works for sale. *Baker*, 101 U.S. at 106.

50. 140 F.2d 182 (7th Cir. 1944).

51. *Id.* at 182.

52. *Id.* at 183.

53. *Id.* at 182.

54. *Id.* at 184.

55. *Id.* at 184 (citing *Baker v. Selden*, 101 U.S. 99, 104 (1879)).

56. *Id.*

57. *Id.*

58. *Id.*

it could see no other reasonable course of action.<sup>59</sup>

On similar grounds, the District of Massachusetts, in *Yankee Candle Co. v. Bridgewater Candle Co.*,<sup>60</sup> denied a copyright claim by plaintiff Yankee Candle against its competitor. The suit involved copyright in the labels for Yankee Candle's popular "Housewarmer" line of candles.<sup>61</sup> These rectangular labels contained the Yankee Candle name at the top and "Housewarmer" at the bottom.<sup>62</sup> The labels also depicted the scent of the candles in question with a photograph and the name of the fragrance.<sup>63</sup> Thus, a eucalyptus scented candle would have a label depicting eucalyptus leaves.<sup>64</sup> In 1998, Bridgewater began marketing a competing line of candles with labels that depicted the scent of the candles with Bridgewater's own photographs and the name of the fragrance.<sup>65</sup> Yankee Candle objected and sued for, among other things, copyright infringement.<sup>66</sup> The court granted summary judgment for Bridgewater on the copyright claim.<sup>67</sup>

The court reasoned that the ideas behind the Yankee Candle labels merged with their expression.<sup>68</sup> In the court's opinion, very few ways existed for depicting cinnamon or other fragrances.<sup>69</sup> Yankee Candle therefore had no cause of action for copyright against Bridgewater unless Bridgewater's photographs were practically identical to Yankee Candle's.<sup>70</sup> Such similarity did not exist, so Yankee Candle's claim had to fail.<sup>71</sup>

For purposes of contrast, consider *FMC Corp. v. Control Solutions, Inc.*,<sup>72</sup> a case that demonstrates how courts sometimes reach results inconsistent with *Crume* and *Yankee Candle*. In *FMC*, the plaintiff and defendant were competitors selling essentially the same pesticide.<sup>73</sup> FMC, the plaintiff, marketed the pesticide first under a patent.<sup>74</sup> That marketing involved the use of a product label whose general contents were partially required by the federal government.<sup>75</sup> After the patent

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59. *Id.* at 184–85 (“To hold that an idea, plan, method or art described in a copyright is open to the public but that it can be used only by the employment of different words and phrases which mean the same thing, borders on the preposterous. It is to exalt the accomplishment of a result by indirect means which could not be done directly. It places a premium upon evasion and makes this the test of infringement. Notwithstanding some authorities which support a theory permitting such a result, we think it is wrong and disapprove it.”).

60. 99 F. Supp. 2d 140 (D. Mass. 2000).

61. *Id.* at 143.

62. *Id.*

63. *Id.*

64. *Id.* at 148.

65. *Id.* at 143.

66. *Id.*

67. *Id.*

68. *Id.* at 144–45.

69. *Id.*

70. *Id.* at 146.

71. *Id.* at 147–50.

72. 369 F. Supp. 2d 539 (E.D. Pa. 2005).

73. *Id.* at 542.

74. *Id.* at 545.

75. *Id.* at 543.

expired, the defendant Control Solutions began selling a generic version of the formerly patented pesticide.<sup>76</sup> Control Solutions also had to include a product label with the same required information that FMC had provided, and it complied by copying FMC's label.<sup>77</sup> FMC objected to this and sued for infringement.<sup>78</sup>

Control Solutions had a very plausible argument for merger of idea and expression. The required information for the product labels included information about hazards and directions for use, identification of the pests against which the pesticides were effective, and the application and mixing rates of the pesticides for many uses.<sup>79</sup> Many expressions of such information may exist, but relatively few would effectively convey the necessary information in a concise manner. If FMC gained one or more copyrights that forced competitors to use less effective labels, it would gain competitive advantages of the sort not contemplated by copyright. Competitors forced to use less effective language might not receive government approval to sell the pesticide, or their less effective warnings might increase their exposure to product liability suits. And, of course, competitors who wanted to use FMC's language would wind up paying a license fee that would serve as a de facto royalty for a previously patented product now in the public domain.

Despite this, the court found no merger.<sup>80</sup> It correctly noted that the issue was whether the label's ideas could be expressed in many ways,<sup>81</sup> but it did not consider that many possible expressions of the label's ideas would not effectively express the ideas. This had the effect of multiplying significantly the number of available expressions for the ideas, and the possibility of multiple expressions thus removed any concerns about merger.<sup>82</sup> Additionally, the court seemed unconcerned about the possibly anti-competitive effects of giving FMC copyright, for it characterized the merger of idea and expression as a "somewhat metaphysical issue" unrelated to commerce and competition.<sup>83</sup>

The divergent results of *Sassafras*, *Abli*, *Crume*, *Yankee Candle*, and *FMC* expose the disagreement over the treatment of copyright in commercial information works. The five cases shared many important similarities. All involved commercial information works and plaintiffs who sued not for the purpose of protecting copyright incentives for the creation of their works, but to hinder the lawful marketing of a competitor's products. Deciding these cases in the plaintiffs' favor therefore meant harming the public interest through the disruption of properly

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76. *Id.*

77. *Id.* at 543, 549.

78. *Id.* at 553.

79. *Id.* at 543.

80. *Id.* at 556.

81. *Id.* at 566 (citing *Dymow v. Bolton*, 11 F.2d 690, 691 (2d Cir. 1926)).

82. *Id.* at 567.

83. *Id.* ("Understandably, CSI may well wish to demonstrate to its potential customers that its product is identical in makeup and applications as TalstarOne, however, 'that is a commercial and competitive objective which does not enter into the somewhat metaphysical issue of whether particular ideas and expressions have merged.'"(quoting *Apple Computer, Inc. v. Franklin Computer Corp.*, 714 F.2d 1240, 1253 (3d Cir. 1983))).

functioning markets. The *Sassafras*, *Crume*, and *Yankee Candle* courts understood this, and they refused to go along with the plaintiffs' claims. However, the *Abli* and *FMC* courts seemed uninterested in these policy issues, and they reached very different results.

Both sides of this disagreement have plausible support for their positions. Obviously those who favor the *Sassafras*, *Crume*, and *Yankee Candle* position would point to the negative consequences of extending copyright to commercial information works. Those rejecting that position would argue that doctrinal interpretations necessary to limit copyright in commercial information works would have negative consequences in other parts of copyright. If courts want to limit copyright in commercial information works, they will have to interpret the copyright doctrine in a way that resolves doubts about copyrightability against plaintiffs. While this might be a good idea for commercial information works, courts would have to do the same thing for other works because copyright has no doctrinal basis for treating commercial information works and other works separately. This would mean denying copyright to some works, perhaps computer programs or compilations of information, that should perhaps be copyrighted in order to ensure their continued production.<sup>84</sup>

The foregoing shows that conflict over copyright in commercial information works amounts to disagreement about singling commercial information works out for the kind of treatment to which other works might not be subject. Those favoring limited copyright see no problem with making the suggested distinction, while those taking the opposite position question its possibility and wisdom. This seemingly intractable disagreement sets the stage for this Essay's inquiry about wisdom the First Amendment may provide.

### III. THE FIRST AMENDMENT'S SPECIAL TREATMENT OF COMMERCIAL SPEECH

The distinct First Amendment jurisprudence of commercial speech began in the case of *Valentine v. Chrestensen*.<sup>85</sup> In that case, Chrestensen owned and exhibited for profit an old United States Navy submarine.<sup>86</sup> Chrestensen discovered that his attempted distribution of the handbill advertising the ship violated a local ordinance prohibiting distribution in the streets of commercial and business advertisements.<sup>87</sup>

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84. The outline of this argument appears in *FMC*. Recall that the *FMC* court did not interpret the idea/expression dichotomy with much concern for overbroad copyright. Instead, the court cited the case of *Apple Computer*, in which the Third Circuit resolved doubts about the copyrightability of operating system software in favor of the plaintiff Apple Computer. *FMC*, 369 F. Supp. 2d at 566–67 (citing *Apple Computer*, 714 F.2d at 1240, 1245). Finally, the court asserted that extending copyright to *FMC* served the public interest because *FMC*'s investment deserved protection. *Id.* at 578. This assertion was, in candor, rather dubious. As noted earlier, *FMC* surely did not need the protection of copyright to have sufficient incentive for creating the label in question. Accordingly, the court's assertion about the public interest can best be understood as an argument that copyright best serves the public interest by resolving doubts about copyrightability in favor of copyright.

85. 316 U.S. 52 (1942).

86. *Id.* at 52.

87. *Id.* at 53.

Christensen then created a handbill that displayed an advertisement for the submarine on one side and a protest against the ordinance on the other.<sup>88</sup> The police told Christensen that his handbill still violated the ordinance, but that a handbill displaying only the protest would not.<sup>89</sup> Christensen distributed the handbills anyway, and the police stopped him.<sup>90</sup> Christensen sued, alleging violation of the Fourteenth Amendment.<sup>91</sup> He prevailed in both the District Court and Circuit Court of Appeals,<sup>92</sup> but the Supreme Court reversed.<sup>93</sup>

In reversing, the Court stated that “the streets are proper places for the exercise of the freedom of communicating information,” and that government may not unduly burden free speech in public places.<sup>94</sup> However, the Court also stated that the Constitution imposed “no such restraint” with respect to “purely commercial advertising.”<sup>95</sup> The Court understood that one side of Christensen’s handbill communicated something besides advertising. However, the Court worried that deciding in Christensen’s favor would effectively destroy the law because circumvention would become easy.<sup>96</sup>

*Valentine* suggested that “purely commercial advertising” receives no First Amendment protection at all, but later courts have not interpreted the First Amendment so narrowly. Instead, they have held that the First Amendment protects commercial speech, but to a lesser extent than other “ordinary” speech.<sup>97</sup> In the leading case of *Virginia State Board of Pharmacy v. Virginia Citizens Consumer Council, Inc.*,<sup>98</sup> the Supreme Court explained why the First Amendment offers less protection to commercial speech. The case involved a consumer challenge to the constitutionality of a law providing that pharmacists committed “unprofessional conduct” by advertising the price or amount of prescriptions drugs.<sup>99</sup> According to the Court, the law effectively prohibited such advertisement.<sup>100</sup> Not surprisingly, the defendant-appellant Virginia State Board of Pharmacy contended that the First Amendment did not protect commercial speech.<sup>101</sup> The Court disagreed and characterized the defendant’s suggested approach as “simplistic.”<sup>102</sup> Instead, the

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88. *Id.*

89. *Id.*

90. *Id.*

91. *Id.* at 54.

92. *Id.*

93. *Id.* at 55.

94. *Id.* at 54.

95. *Id.*

96. *Id.* at 55.

97. See 44 *Liquormart v. Rhode Island*, 517 U.S. 484, 502 (1996); *Cincinnati v. Discovery Network*, 507 U.S. 410, 422 (1993); *Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm’n*, 447 U.S. 557, 562–63 (1980); *Va. State Bd. of Pharmacy v. Va. Citizens Consumer Council, Inc.*, 425 U.S. 748, 772 & n.24 (1976).

98. 425 U.S. 748 (1976).

99. *Id.* at 749–50.

100. *Id.* at 752.

101. *Id.* at 758.

102. *Id.* at 759.

Court noted that advertisers do not lose First Amendment protection simply because they speak to earn money.<sup>103</sup> Moreover, the Court considered commercial speech indispensable to a free market economy and consideration of how to regulate or modify such an economy.<sup>104</sup> The Court therefore held that the First Amendment protects commercial speech.<sup>105</sup>

This did not mean, however, that the First Amendment protected commercial speech as vigorously as other speech. The Court identified some “commonsense differences between speech that does ‘no more than propose a commercial transaction’ and other varieties.”<sup>106</sup> First, disseminators of commercial speech can verify the truth of their statements with relative ease.<sup>107</sup> Second, commercial speech “may be more durable than other kinds.”<sup>108</sup> The Court considered these characteristics significant because they affected the likelihood that commercial speech needed full First Amendment protection to flourish.<sup>109</sup>

In the case of ordinary speech, the First Amendment prohibits government from suppressing speech it deems false because such regulation creates a “chilling effect.”<sup>110</sup> Speakers do not know if they will face prosecution because it is often difficult to ascertain the truth of controversial statements. Speakers become risk-averse to the possibility of prosecution because they worry that courts will mistakenly find their speech false or that they themselves will unintentionally speak falsely. Such risk aversion means that some speakers who would otherwise speak the truth refrain from speaking at all, and the loss of such truthful speech harms public discourse. The First Amendment remedies this problem by prohibiting government from suppressing false speech with impunity.<sup>111</sup> When speakers realize that government cannot prosecute them simply because their speech is false, they become more willing to speak. In short, the First Amendment requires that government tolerate at least some false speech to ensure the dissemination of true speech.<sup>112</sup>

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103. *Id.* at 762.

104. *Id.* at 765 (“Advertising, however tasteless and excessive it sometimes may seem, is nonetheless dissemination of information as to who is producing and selling what product, for what reason, and at what price. So long as we preserve a predominantly free enterprise economy, the allocation of our resources in large measure will be made through numerous private economic decisions. It is a matter of public interest that those decisions, in the aggregate, be intelligent and well informed. To this end, the free flow of commercial information is indispensable. And if it is indispensable to the proper allocation of resources in a free enterprise system, it is also indispensable to the formation of intelligent opinions as to how that system ought to be regulated or altered.” (citations omitted)).

105. *Id.* at 770.

106. *Id.* at 771 n.24 (quoting *Pittsburgh Press Co. v. Pittsburgh Comm’n on Human Relations*, 413 U.S. 376, 385 (1973)).

107. *Id.*

108. *Id.*

109. *Id.*

110. See *New York Times Co. v. Sullivan*, 376 U.S. 254, 300–01 (1964) (Goldberg, J., concurring).

111. *New York Times*, 376 U.S. at 269–70, 279–80; *Gertz v. Robert Welch, Inc.* 418 U.S. 323, 339–40 (1974).

112. *New York Times*, 376 U.S. at 271–72, 278–79; *Gertz*, 418 U.S. at 340–41.

By contrast, there is little risk of such chill when the government prohibits false commercial speech. As an initial matter, commercial speakers know if they speak the truth, for they have accurate information about the goods and services that they sell. This implies that commercial speakers worry less about being mistakenly prosecuted than ordinary speakers because neither they nor the government will likely err about the legality of commercial speech. Additionally, commercial speakers will probably quickly overcome any chilling effect that may exist because commercial imperatives give speakers particularly strong reasons to speak.<sup>113</sup> Thus, there are fewer reasons to avoid suppressing false commercial speech for fear of silencing speakers,<sup>114</sup> and this led the *Virginia State Board of Pharmacy* Court to conclude that government could freely prohibit false or misleading commercial speech.<sup>115</sup>

#### IV. A COMMERCIAL SPEECH PERSPECTIVE ON COPYRIGHT IN COMMERCIAL INFORMATION WORKS

The jurisprudence of commercial speech affects copyright in commercial information works in three ways. First, it supports a distinction between commercial information works and other works in copyright. Remember that the case for not limiting copyright in commercial information works rests in part on concerns that courts cannot single such works out for special treatment. However, if courts do this in First Amendment cases, it seems entirely reasonable for courts to do likewise in copyright cases.

Second, it weakens the justification for granting copyright in commercial information works. In cases explaining why copyright is constitutional, the Supreme Court has clearly operated on the belief that copyright's economic incentives significantly encourage the production of speech.<sup>116</sup> The importance of this belief can hardly be understated. If society does not have significantly more speech with copyright than without, the Court would find it difficult to describe copyright as pro-speech. In short, copyright's constitutionality rests on the assumption that significant amounts of speech would not exist but for copyright.

Things are very different for commercial speech. In *Virginia State Board of Pharmacy*, the Court observed that commercial speech is a hardy form of speech that will likely flourish even when regulated.<sup>117</sup> If commercial speech exists primarily to stimulate commercial interest in goods or services, then commercial speakers communicate with the expectation of profiting from the sale of those goods or services. To the extent that money motivates and enables speech, commercial speech has plenty of motivation behind it, and government regulation

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113. See *Va. State Bd. of Pharmacy*, 425 U.S. at 771 n.24.

114. *Id.*

115. *Id.* at 771–73.

116. See *Eldred v. Ashcroft*, 537 U.S. 186, 219 (2003) (quoting *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 558 (1985)) (copyright's purpose is to promote creation of new works).

117. 425 U.S. at 772 n.24.



will have relatively little effect on its existence.<sup>118</sup> This observation has huge implications for copyright in commercial information works, for if people already have strong motives for creating them, it is highly unlikely that copyright is necessary to encourage their production. This strengthens the case for denying or limiting copyright in commercial information works because society has little to gain from copyright in those works.<sup>119</sup>

Third, the jurisprudence of commercial speech identifies reasons that society would want people to repeat commercial information works and commit what would otherwise be infringement. In *Eldred*, the Supreme Court stated that once a person has created and disseminated speech, society has little to gain by having another person repeat the message.<sup>120</sup> Accordingly, to the extent that copyright limits those who copy the speech of others, the Court could safely minimize the First Amendment significance of that suppression.

Here too, things are different with respect to commercial information works. The *Virginia State Board of Pharmacy* Court noted that commercial speech gets First Amendment protection because of the role it plays in disseminating information to the public in our marketplace economy.<sup>121</sup> Thus, if a person sells goods identical to those sold by a competitor, the public needs to know; there is a First Amendment interest in ensuring dissemination of that information as long as the speaker does not deceive the public.

This observation affects copyright in commercial information works because plaintiffs generally assert copyright in those works to disrupt the commercial messages of competitors. The *Abli* plaintiff objected because he did not want others to know that the defendant was selling the same beads.<sup>122</sup> Similarly, the *FMC* plaintiff sued to force the defendant to change informative messages placed in the defendant's pesticide labels.<sup>123</sup> In both of these cases, the free dissemination of the defendants' messages would have served the public interest by informing the public about the characteristics of the goods for sale. This is the very reason that the First Amendment values commercial speech, and it runs counter to the conventional assertion that repeated messages have little constitutional value. Moreover, when combined with the observation that commercial information works will be created in the absence of copyright incentives, it strengthens the case for limiting copyright in those works because the public has more to gain from the copying and

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118. *Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm'n*, 447 U.S. 557, 564, n.6 (1980); *Va. State Bd. of Pharmacy*, 425 U.S. at 772, n.24.

119. See Lisa P. Ramsey, *Intellectual Property Rights in Advertising*, 12 MICH. TELECOMM. & TECH. L. REV. 189, 217–23 (2006) (noting that copyright incentives do little to encourage production of advertisements because parties recoup the cost of production through the sales of other goods or services).

120. See *Eldred*, 537 U.S. at 221 (“[The First Amendment] bears less heavily when speakers assert the right to make other people’s speeches.”).

121. 425 U.S. at 765.

122. See *Abli, Inc. v. Standard Brands Paint Co.*, 323 F. Supp. 1400, 1402–03 (C.D. Cal. 1970).

123. See *FMC Corp. v. Control Solutions, Inc.*, 369 F. Supp. 2d 539, 542–43, 543 n.2 (E.D. Pa. 2005).

dissemination of commercial information works than it does from copyrighting them.

## V. CONCLUSION

This Essay explains how the First Amendment jurisprudence of commercial speech strengthens the case for limiting copyright in commercial information works when plaintiffs sue to disrupt the nonmisleading commercial messages of competitors. However, there is plenty of work to do before these suggestions become firm conclusions.

Some of the problems are definitional and conceptual. This Essay considers commercial information works because their purpose of conveying basic commercial information is similar to the Supreme Court's definition of commercial speech as "speech that does 'no more than propose a commercial transaction.'"<sup>124</sup> By doing so, the influence of commercial speech jurisprudence on copyright becomes clear. But what happens when courts confront the messy reality that some works will convey basic commercial information about goods or services while also providing entertainment of the sort associated with movies?<sup>125</sup>

For example, consider advertisements of the sort made by Volkswagen to promote its GTI automobile.<sup>126</sup> These ads do much more than convey basic information about Volkswagens, for they also offer stylized, image-oriented entertainment. When compared to cases like *Sassafrass*, *Crume*, *Yankee Candle*, *Abli*, and *FMC*, it is much harder to say that the advertisements lack originality or that their ideas merge with their expression. Nevertheless, it also seems quite likely that these works would exist without copyright's incentives. Should courts therefore interpret the law to limit copyright in these works?

While it might be tempting to answer questions like this in the affirmative, this Essay chooses to leave its resolution for another day. Concepts like originality and the idea/expression dichotomy may be slippery, but that does not preclude the existence of works like the Volkswagen advertisements whose copyrightability seems clear as a matter of doctrine. The policy observations associated with commercial speech jurisprudence obviously raise provocative questions about the wisdom of continuing to protect works like these with copyright, but it seems premature to definitively conclude that copyright should not protect such works.

Other questions will arise as contexts change. For example, what happens when the plaintiff has produced a commercial information work and the defendant has

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124. *Va. State Bd. of Pharmacy*, 425 U.S. at 771 n.24 (quoting *Pittsburgh Press Co. v. Human Relations Comm'n*, 413 U.S. 376, 385 (1973)).

125. This problem corresponds to ambiguity in the definition of commercial speech itself. See Alex Kozinski & Stuart Banner, *Who's Afraid of Commercial Speech?*, 76 VA. L. REV. 627, 639–48 (1990) (discussing examples of commercial speech that do more than propose a commercial transaction).

126. See GTIMkV, <http://www.vw.com/gti/en/us/#> (last visited May 22, 2007) (allowing visitors to the advertisement to view photos, take a 360° tour of the car, and watch commercials and videos of the product).

used the plaintiff's work in a work that is "regular" speech? In situations like this, one might argue that the case for limiting copyright becomes even stronger because the First Amendment implications of suppressing the defendant's speech are more serious than those associated with cases in which the defendant produces only a commercial information work. Such policy, if ultimately accepted, could greatly affect application of doctrines not considered in this Essay, such as fair use, perhaps through determinations made about the nature of the copyrighted work and the effect on the market for the copyrighted work.<sup>127</sup>

Similarly, what happens if the plaintiff has produced a regular, noncommercial work, and the defendant has produced a commercial information work? It may be appropriate to strongly enforce copyright in cases like this because the commercial nature of the defendant's work lowers the First Amendment concerns over its suppression. This might influence the fair use interpretation of the purpose for the borrowing, and it may explain the existing pro-plaintiff implications of a finding that a defendant's use is for commercial purposes.<sup>128</sup>

Finally, it is interesting to consider the impact of commercial speech jurisprudence in cases beyond commercial speech. If observations about the hardness of speech and the importance of its repetition suggest limiting copyright in commercial information works, perhaps similar conclusions follow for other types of speech. For example, copyright presently protects works authored by state governments.<sup>129</sup> However, those works probably do not need copyright incentives to assure their production, and society has a very strong interest in their free reproduction and dissemination. Taxes, not copyright revenues, support state reports about polluted rivers or laws created by state legislatures, and the public ought to receive these reports freely. Given Congress's failure to deny copyright to such works, it may be impossible to completely prevent state attempts to copyright them. However, it would seem quite sensible to apply the fair use doctrine vigorously on behalf of defendants who copy and disseminate such works.

Unfortunately, limitations of space and time prevent this Essay from exploring these issues adequately. Nevertheless, it is hoped that the Essay has shown that the First Amendment jurisprudence of commercial speech raises important points about copyright law and can help courts interpret the law to society's advantage.

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127. This could happen in a number of interesting scenarios. A social critic might write a book about the effect of advertisements and include reproductions to illustrate her point. Alternatively, a movie maker might include a commercial information work as part of a movie's scenery.

128. See 17 U.S.C. § 107(1) (2000) (making the applicability of fair use partially dependent on whether a defendant's use is for a commercial purpose); *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 578–79 (1994) (noting commercial purpose is one of several relevant factors to consider in the analysis of fair use and is not dispositive).

129. Copyright explicitly excludes federal works from protection, but not state works. 17 U.S.C. § 105 (2000).