

**WHO'S AFRAID OF THE COMMON LAW?
GEORGIA V. PUBLIC.RESOURCE.ORG AND THE
SUPREME COURT'S RECENT "STRAIGHTFORWARD"
COPYRIGHT JURISPRUDENCE**

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ABSTRACT

In Georgia v. Public.Resource.Org, the U.S. Supreme Court held that no copyright existed in statutory annotations authored by the State of Georgia and incorporated into the official Georgia state code. Although the result has much to recommend it, the Court reached it in profoundly unsatisfying fashion. In this Article, I argue that the Court's approach fails to capture, or indeed grapple with, the compelling policy reasons for finding the annotations unprotected, and that this failure is the direct result of a fundamental misunderstanding about the judicial role in copyright cases. Specifically, the Court fails to recognize that, in many areas, the Copyright Act is not a source of definitive answers, but a delegation of authority to find the answers, and that a refusal to fully exercise this authority is not laudable deference to legislative supremacy, but an abdication of judicial responsibility. More broadly, the Court's decision exemplifies its recent copyright jurisprudence, one characterized by appeals to legislative authority, a reluctance to engage with policy, a curious flattening of complexity, and a misguided desire to find "straightforward" rules where none exist.

INTRODUCTION

Why is this opinion so unsatisfying? This question came immediately to mind when reading the U.S. Supreme Court's recent opinion in *Georgia v. Public.Resource.Org*,¹ and it is a question that has come to mind increasingly often when reading the Court's recent copyright opinions. It is not that the case is wrongly decided — indeed, there is much to recommend the result it reaches. Nor is it a question of aesthetics or presentation. Rather, there is something about the opinion's approach to the issue raised in that case — the copyrightability of statutory annotations authored by the State of Georgia — that seems to leave out, or relegate to secondary status, everything that is potentially interesting and important about it. The opinion fails to adequately grapple or engage with the inter-

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¹ 140 S. Ct. 1498 (2020).

esting policy issues and broader implications raised by the case, instead finding that a number of precedents provide a “straightforward” rule that resolves the case.

In this Article, I take a close look at the Court’s opinion and make two arguments. First, I argue that, although it reaches a fine result, the Court’s opinion is flawed in a number of respects as a matter of doctrine and policy: (1) in its curiously uncritical application of its own precedents; (2) in its impoverished policy analysis of the issue; and (3) in its unconvincing account of legislative adoption and incorporation of prior precedents. Second, I argue that these flaws stem from a fundamental misunderstanding about the proper judicial role in copyright cases, one that is reflected in a number of other recent Supreme Court opinions on copyright law. I use this last observation as the basis for examining the development of the Court’s copyright jurisprudence since passage of the 1976 Act.

I. THE OPINION

In *Georgia v. Public.Resource.Org*, the Supreme Court addressed a topic it had last addressed more than 100 years ago: the copyrightability of annotations to sources of law. The State of Georgia, like many other states, publishes an official state code — the *Official Code of Georgia Annotated* (“OCGA”) — consisting of the text of enacted and operative state statutes, along with nonbinding annotations for each statutory provision. The annotations consist of brief summaries of judicial opinions interpreting the provision, summaries of opinions of the state attorney general regarding the provision, and lists of relevant law review articles and other reference materials.²

The OCGA is put together by the Georgia Code Revision Commission (“CRC”), a state entity made up largely of state legislators, staffed by Georgia’s Office of Legislative Counsel, and funded by legislative branch appropriations. The CRC does not itself write the annotations for the OCGA, however. Instead, it commissions Matthew Bender & Co., a division of Lexis/Nexis, to write the annotations under a work made for hire agreement, which vests authorship, and therefore the copyright, in the State of Georgia. The resulting annotations are then combined with the statutory text and published.

The dispute arose when Public.Resource.Org (“PRO”), a public interest organization dedicated to ensuring public access to government documents, posted online a freely accessible copy of the entire OCGA and distributed unauthorized copies to various organizations. These copies included both the statutory provisions and the annotations. The CRC filed suit on behalf of the State of Georgia, claiming PRO’s actions infringed

² See, e.g., OCGA §§ 51-1-1, 53-4-2 (2019).

upon its copyright in the annotations. *PRO* counterclaimed, seeking a declaration that the entire OCGA, including the annotations, was not copyrighted and therefore fell into the public domain.

The Supreme Court, in an opinion authored by Chief Justice Roberts, held that the annotations were not protected by copyright. In reaching this result, the Court looked to a trio of Supreme Court precedents decided in the 1800s. In *Wheaton v. Peters*,³ the Court's third Reporter of Decisions, Wheaton, claimed a copyright in the Supreme Court's judicial opinions. The Court in *Wheaton* rejected the claim, unanimously holding, without much discussion, that the Court's opinions could not be copyrighted. Nearly fifty years later, the Court elaborated upon this result in *Banks v. Manchester*,⁴ which involved a similar copyright claim by the reporter for the Ohio State Supreme Court over judicial opinions and non-binding annotations written by the justices. Again, the Court rejected the claim, explaining: "the judge who, in his judicial capacity, prepares the opinion or decision, the statement of the case and the syllabus or head note" cannot "be regarded as their author or their proprietor" within the meaning of the Copyright Act. Instead, the "whole work done by the judges constitutes the authentic exposition and interpretation of the law, which, binding every citizen, is free for publication to all." Finally, in *Callaghan v. Myers*,⁵ decided later that same term, the Court reiterated that judicial opinions were not copyrightable, but held that annotations (such as syllabi, headnotes, tables of contents, etc.) written, not by the judges themselves but by reporters, could be copyrighted, since they were not created by someone who had the authority to speak with the force of law.

From this trio of early cases, the Court in *Georgia v. PRO* derived a "straightforward rule," called the "government edicts doctrine":

Because judges are vested with the authority to make and interpret the law, they cannot be the "author" of the works they prepare "in the discharge of their judicial duties." *Banks*, 128 U.S. at 253, 9 S.Ct. 36. This rule applies both to binding works (such as opinions) and to non-binding works (such as headnotes and syllabi). *Ibid*. It does not apply, however, to works created by government officials (or private parties) who lack the authority to make or interpret the law, such as court reporters.⁶

The Court identified the "animating principle behind this rule" as the idea that "no one can own the law. 'Every citizen is presumed to know the law,' and 'it needs no argument to show . . . that all should have free access' to its contents. *Nash*, 142 Mass. at 35, 6 N.E. at 560."⁷ According to

³ 33 U.S. (8 Pet.) 591 (1834).

⁴ 128 U.S. 244 (1888).

⁵ 128 U.S. 617 (1888).

⁶ *PRO*, 140 S. Ct. at 1507.

⁷ *Id*.

the Court, this principle is given effect through construction of the statutory term “author”: “The doctrine bars the officials responsible for creating the law from being considered the ‘author[s]’ of ‘whatever work they perform in their capacity’ as lawmakers. Because these officials are generally empowered to make and interpret law, their ‘whole work’ is deemed part of the ‘authentic exposition and interpretation of the law’ and must be ‘free for publication to all.’”⁸

Having derived this “straightforward rule” from its own precedents, the Court then extended the rule to cover legislators as well. Just as judges have the authority to “speak the law” when writing opinions, so too do legislators when they enact legislation. And just as a judge’s annotations are “work they perform in their capacity as lawmakers,” so too are the legislature’s annotations to their own enactments. Thus, the Court extended the rule to cover, not just the legislative enactments themselves, but also any “explanatory and procedural materials legislators create in the discharge of their legislative duties, . . . (for example) their floor statements, committee reports, and proposed bills. These materials are part of the ‘whole work done by [legislators],’ so they must be ‘free for publication to all.’”⁹

The Court then went on to apply this rule to the facts of this case. The Court first found that Georgia’s CRC qualified as a “legislator” for purposes of its rule, as it was an arm of the Georgia state legislature, funded by legislative appropriations, and staffed largely by legislators. And although the annotations were technically prepared by Matthew Bender, this was done under supervision by the CRC pursuant to a work made for hire agreement, which vested authorship in the CRC on behalf of the state of Georgia. Furthermore, the annotations were then “approved” by the state legislature and “merged” with the statutory text before being published in the OCGA, thus lending additional support to the view that they were authored by the legislature.

The Court then held that the annotations were created as part of the legislature’s discharge of its official duties. Although not officially enacted into law, and therefore nonbinding, the annotations were commissioned by the legislature as an act of legislative authority. The Court thus analogized the annotations to the syllabus or headnotes of a judicial opinion, which are similarly nonbinding but still unprotected when authored by the judge. Accordingly, the Court held the annotations unprotected by copyright law.

⁸ *Id.*

⁹ *Id.* at 1508 (quoting *Banks*, 128 U.S., at 253 (brackets in the original)).

II. PROBLEMS WITH THE OPINION

The Court's decision in *Georgia v. PRO* arrives at a reasonable and defensible conclusion. The result itself — finding the annotations unprotected by copyright — seems broadly consistent, or at least can be squared, with the trio of early precedents that the Court relies upon. All of those opinions recognize the unusual copyright status of legal materials authored by government officials, as they are unlike traditional works of authorship and implicate tricky issues regarding access to the law. The Court's reasoning also seems to follow pretty directly and logically, in a “straightforward” fashion, from its analysis of the underlying precedents. There is a syllogistic quality to the Court's reasoning that seems very direct and appealing. Finally, the actual result, by making the official annotations available to anyone for free, is likely to please those who support broader public access to government documents.

Yet a closer look at the Court's opinion highlights ways in which the opinion is not as straightforward as the Court suggests. First, the Court's grounding of the public domain status of legislative annotations in a particular understanding of “authorship” leads to a number of doctrinal puzzles. Most immediately, this mechanism for finding the annotations unprotectible would appear to be easily side-stepped by legislatures in the future. For example, say that the Georgia CRC now amends its contract with Matthew Bender to make it clear that the annotations are no longer a work made for hire,¹⁰ and that Matthew Bender then assigns the copyright to the CRC. Under this scenario, Matthew Bender is now the author of the annotations, and under the Court's logic (and its interpretation of *Callaghan*) the annotations are fully protected by copyright. Thus, Georgia and all of the other states that commission annotations in a similar fashion can easily sidestep the ruling in the case, effectively rendering the Court's opinion a dead letter.

Perhaps the Court would accept this result, but there is something deeply unsatisfying about it, as it suggests that the public domain status of the annotations is easily manipulable. To the extent the opinion purports to vindicate the “animating principle” that the public must have access to the law, this result suggests that the protection for that grand principle is rather thin and easily circumvented. Alternatively, perhaps the Court would find a way to reject this result, as it seems like such a clear attempt to undercut its opinion. Yet because the Court grounds its opinion so firmly on a particular view of “authorship,” and also on Congress's statutory reenactment of that term, there appears to be no easy way for the Court to reach this result without overturning much of its own reasoning.

¹⁰ See 17 U.S.C. § 101 (definition of “work made for hire”).

The precise scope of the Court's rule is also unclear. According to the Court, the government edicts doctrine applies not just to legislative enactments, but all works created by legislators "in the course of their official duties." It thus applies to the annotations, and, as the Court later suggests, other "explanatory and procedural materials," such as "floor statements, committee reports, and proposed bills."¹¹ What, then, about other works created by legislators that are more tenuously connected to legislation, but still part of a legislator's "official duties"? For example, purely internal memos discussing legislation? Or correspondence with other legislators? Or handwritten notes? Are these all part of the legislator's "official duties"? What principle governs whether these documents are protected? These other documents may be less important for the public to understand the nature of the legislation. But that interest does not seem to be anywhere captured in the Court's definition of "official duties."¹²

This unsatisfactory situation follows directly from a mismatch between the "animating principle" behind the Court's decision and the doctrinal vehicle, "authorship," it uses to vindicate that principle. According to the Court, the animating principle behind the government edicts doctrine is the principle that "no one can own the law. 'Every citizen is presumed to know the law,' and 'it needs no argument to show . . . that all should have free access' to its contents."¹³ Yet the Court's definition of "authorship" does not map cleanly onto this interest. Identifying an author does not depend upon the nature of the copyrighted materials or the need for public access, interests that one would think would be relevant to vindicating the public interest in access, but instead upon the identity of the author. Similarly, whether a work is created as part of a legislator's "official duties" does not map cleanly on to the underlying interest, since many works created by legislators as part of their "official duties" may not be required to fully understand or comprehend the law. This leads to the possibility, as described above, that the Court's test may be over or under-inclusive in its ability to further public access to law.

Indeed, one might expect that, if the animating principle is "all should have free access" to the law, then the critical question for copyrightability is not who is the author of the work in question, or whether the work is created in the course of the author's "official duties," but whether the work has the status of law or is necessary to understand the law. This would avoid the problem of mismatch and offer a far more direct way to

¹¹ *PRO*, 140 S. Ct. at 1508.

¹² Indeed, Justice Ginsburg in her dissenting opinion argues that the annotations at issue in the case were not created as part of the legislature's "official duties," highlighting the ambiguity in the scope of the majority opinion's rule. See *id.* at 1523 (Ginsburg, J., concurring).

¹³ *PRO*, 140 S. Ct. at 1507 (quoting Nash, 6 N.E. at 560).

vindicate the underlying interest. And in fact, this was the argument advanced by the State of Georgia and adopted by Justice Thomas in dissent — that the government edicts doctrine should apply only to government works that have the “force of law.”¹⁴ Yet the majority expressly rejected this approach. The Court, in explaining its rule, expressly noted that “[r]ather than attempting to catalog the materials that constitute ‘the law,’ the doctrine bars the officials responsible for creating the law from being considered the ‘author[s]’ of ‘whatever work they perform in their capacity’ as lawmakers.”¹⁵

Why, then, does the Court use this particular understanding of “authorship” to vindicate the interest in public access to the law, when it would seem to be such a roundabout method and such an imperfect fit? The Court expressly addresses this question in rejecting the dissent’s proposed standard, and this is in many ways the most revealing portion of the Court’s opinion. The Court initially notes that the dissent’s view — looking to whether a work has “the force of law” — cannot be squared with the Court’s trio of early precedents. In particular, the Court noted that those three cases found unprotected materials that did not have the force of law. For example, dissenting opinions and concurrences were unprotected, despite the fact that they had no binding force. Similarly, annotations such as syllabi, headnotes, outlines, etc., have no force of law, but were also found unprotected when authored by judges.¹⁶

Next, and more importantly, the Court argued that the dissent’s approach cannot be squared with the text of the Copyright Act, since the dissent’s approach does not depend on an interpretation of the statutory term “author.” The requirement that a work have the “force of law” does not have a statutory hook, whereas the majority’s approach does, in the form of the term “author:” “The textual basis for the doctrine is the Act’s ‘authorship’ requirement, which unsurprisingly focuses on—the author.”¹⁷ In a revealing passage, the Court further explained:

Justice THOMAS urges us to dig deeper to “the root” of our government edicts precedents. Post, at 1515. But, in our view, the text is the root. The Court long ago interpreted the word “author” to exclude officials empowered to speak with the force of law, and Congress has carried that meaning forward in multiple iterations of the Copyright Act. This textual foundation explains why the doctrine distinguishes between some

¹⁴ *Id.* at 1515 (Thomas, J., dissenting).

¹⁵ *Id.*

¹⁶ *Id.* at 1511. Justice Thomas in dissent argued that, although dissenting and concurring opinions did not technically have the force of law, they are important to understanding the scope, limitations, and potential future direction of the law, and therefore should be encompassed within his proposed standard. *Id.* at 1520-21 (Thomas, J., dissenting).

¹⁷ *Id.* at 1512.

authors (who are empowered to speak with the force of law) and others (who are not). Compare Callaghan, 128 U.S. at 647, 9 S.Ct. 177, with Banks, 128 U.S. at 253, 9 S.Ct. 36. But the Act's reference to "authorship" provides no basis for Georgia's rule distinguishing between different categories of content with different effects.¹⁸

Here we see most clearly why the Court relies upon "authorship" to vindicate the underlying interest in public access to the law, despite the ill fit. The early Supreme Court cases grounded the doctrine in the concept of authorship. And Congress later reenacted the term "author" into successive versions of the Copyright Act, thus "carr[ying] forward" the meaning from those earlier cases. The Court's role today, then, is simply to effectuate the rule that was created by the earlier Court precedents and adopted by Congress. Digging deeper for "the root" of the precedents, i.e. by looking for the underlying history or justification as Justice Thomas suggests, is not the proper role of the Court.¹⁹ Instead, the role is simply to apply the "straightforward" rule laid out by the earlier precedents.

This passage highlights my second major criticism of the opinion, and the reason the opinion is so unsatisfactory — its extremely cramped and narrow vision of the proper judicial role in copyright cases. As an initial descriptive matter, the Court's reasoning is based on an implausible reading of what Congress did when it continued to use the term "author" in successive revisions of the Copyright Act. Under the majority's view, consistent and repeated reenactment of the term "author" means that the legislature expressly incorporated the specific meaning that term had been given by the courts prior to each enactment. In this case, that meant that Congress intended for the government edicts doctrine to be based on a particular understanding of authorship, thus precluding any attempt to alter or reconsider that doctrine.

This is an implausible understanding of what the legislature has done. As Justice Thomas notes in dissent, it is highly unlikely that the legislatures enacting the various revisions of the Copyright Act specifically had in mind the government edicts doctrine when continuing to use the statutory term "author" in the Copyright Act.²⁰ (Indeed, the majority deli-

¹⁸ *Id.*

¹⁹ *Id.* at n. 4 ("Instead of accepting our predecessors' textual reasoning at face value, Justice THOMAS conjures a trinity of alternative "origin[s] and justification[s]" for the government edicts doctrine that the Court *might* have had in mind.").

²⁰ *Id.* at 1519 (Thomas, J. dissenting) ("[T]he majority's textual analysis hinges on accepting that its construction of 'authorship,' i.e., all works produced in a judge's or legislator's official capacity, was so well established by our 19th-century precedents that Congress incorporated it into the multiple revisions of the Copyright Act. See ante, at 1509 – 1510. Such confidence is questionable, to say the least It is risible to presume that Congress had knowledge of and incorporated a 'set-

cately refers to the legislature "carrying forward" the term, rather than adopting a specific meaning.)²¹ The majority's reasoning might apply in other statutory contexts, when a particular statutory term has a specific meaning that is clearly known to and adopted by the legislature. But the term "author" in this case would seem to be a singularly inappropriate example of such a phenomenon, as the government edicts doctrine is such an obscure doctrine, having remained untouched for more than 100 years. And as Justice Thomas notes, the particular meaning adopted by the Court in this case was not so well-established, insofar as many state legislatures did not believe it applied to them.²²

More broadly, the majority's view fails to recognize the way that the Copyright Act delegates authority to the courts to give content to broad terms like "author." Many original doctrines in copyright were created by the courts in a common law-like fashion. The government edicts doctrine is just one minor example. Other major examples include such fundamental issues as the definition of "author" more broadly (which is nowhere defined in the statute),²³ the standard for "originality,"²⁴ the elements of infringement,²⁵ the doctrine of third-party liability,²⁶ and the entire fair use doctrine.²⁷ The "roots" of copyright law in these areas are in the common law development of doctrine by the federal courts, not in the text of the copyright statute, as the majority suggests.

This is entirely to be expected, given the way the copyright act in many places uses a broad property entitlement to further the underlying policies of copyright, namely creating incentives for original authorship. Broad property entitlements are, by their nature, over and underinclusive. The broad entitlement in copyright applies, across the board, to a diverse range of works (from books to sound recordings to sculpture to motion pictures to computer software) and a wide range of industries, each with its own particular and unique circumstances. An essential part of the judi-

ted' meaning that eluded a multitude of States and Territories, as well as at least four Article III judges.").

²¹ *Id.* at 1512.

²² *Id.* at 1513 (Thomas, J. dissenting) ("This ruling will likely come as a shock to the 25 other jurisdictions — 22 States, 2 Territories, and the District of Columbia — that rely on arrangements similar to Georgia's to produce annotated codes.").

²³ See Committee for Creative Non-Violence v. Reid, 490 U.S. 730 (1989).

²⁴ See Burrow Giles Lithographic v. Saroni, 111 U.S. 53 (1884); Bleistein v. Donaldson Lithographing, 188 U.S. 239 (1903); Feist Publ'ns v. Rural Tel. Serv. Co., 499 U.S. 340 (1991).

²⁵ See Nichols v. Universal Pictures Corp., 45 F.2d 119 (2d Cir. 1930); Arnstein v. Porter, 154 F.2d 464 (2d Cir. 1946); Roth Greeting Cards v. United Card Co., 429 F.2d 1106 (9th Cir. 1970).

²⁶ See Sony v Universal City Studios, 464 U.S. 417 (1984); MGM Studios v. Grokster, 545 U.S. 913 (2005).

²⁷ See Folsom v. Marsh, 9 F. Cas. 342 (C.C.D. Mass. 1841) (No. 4,901).

cial role, then, is adapting the property entitlement to specific situations, to make sure that the underlying policies are vindicated.

Moreover, subsequent revisions of the copyright act reflect an understanding and accommodation of these common law roots. The Copyright Act reflects a sophisticated interplay between federal case law and statutory provisions. In many instances, the Act has explicitly incorporated judicial developments and has continued to leave room for further development. The fair use doctrine is the most famous example, created from whole cloth by the federal courts and loosely incorporated into the 1976 Act, with the express legislative intent that the courts would continue to elaborate upon and develop the doctrine over time.²⁸ In other areas, Congress has been content for the courts to continue developing such broad doctrines as “originality” and the standards for infringement. The Court’s narrow view of the judicial role would seem to suggest that in these areas the courts should not continue to develop the doctrine as they see fit, since Congress has frozen the doctrine in place after each enactment.

It is true that this is not the case in every area of copyright law. In some areas, Congress has stepped in to expressly overrule prior judicial development of the law.²⁹ And in still other areas, Congress has more recently begun to enact detailed statutory provisions for particular industries that reflect highly specific and detailed legislative compromises.³⁰ In these areas, the judicial role is properly more restrained.³¹ However, broad sections of the copyright act still reflect an understanding that the courts will continue to develop the law in a principled, common law fashion, and the definition of “authorship” as well as the interplay between copyright and government works would appear to be just such an area.

Yet the Court steadfastly refuses to take up this invitation in this case. When confronted with Justice Thomas’s suggestion that the Court look into the original rationale for the government edicts doctrine, in Justice Thomas’s terms “the root” of the precedents, the Court writes “the text is the root.”³² With respect, this is entirely backwards. The root of the government edicts doctrine cannot be found anywhere in the text of the current 1976 Act or the original 1790 Act, which the Court interpreted in *Wheaton*. The root of the doctrine is found in the trio of Supreme Court

²⁸ See *Folsom*, 9 F. Cas. 342; 17 U.S.C. § 107; H.R. REP. NO. 94-1476, at 9-10 (1976).

²⁹ See, e.g., *Fortnightly Corp. v. United Artists Tel.*, 392 U.S. 390 (1968); *Teleprompter Corp. v. Columbia Broad. Sys.* 415 U.S. 394 (1974); 17 U.S.C. § 101 (definition of “perform”).

³⁰ See, e.g. Music Modernization Act, Public Law 115-264, 132 STAT. 3676 (2018).

³¹ See Joseph P. Liu, *Regulatory Copyright*, 83 N.C. L. REV. 87 (2004).

³² *Georgia v. Public.Resource.Org*, 140 S. Ct. 1498, 1512 (2020).

cases that recognized an underlying principle that was nowhere required by the text of the statute, but rather identified as a matter of common law judicial development. It is particularly odd, given the origins of the doctrine in the Court's own case law, that the Court finds itself so constrained many years later.

The constrained nature of the majority's view of the Court's role can be seen most clearly in footnote four of the opinion. Responding to Justice Thomas's call to examine the root of the government edicts doctrine, Roberts writes:

Instead of accepting our predecessors' textual reasoning at face value, Justice THOMAS conjures a trinity of alternative "origin[s] and justification[s]" for the government edicts doctrine that the Court might have had in mind. See post, at 1515 – 1517. . . . Regardless, it is more "[consistent with the judicial role]" to apply the reasoning and results the Court voted on and committed to writing than to speculate about what practical considerations our predecessors "may have had . . . in mind," what history "may [have] suggest[ed]," or what constitutional concerns "may have animated" our government edicts precedents. *Ibid.*³³

Under the majority's view, then, the Court should accept the textual reasoning of its own precedents at "face value," rather than looking for the underlying rationale. Moreover, the judicial role is limited to simply "apply[ing] the reasoning and results the Court voted on," rather than trying to understand and articulate the underlying principle behind the precedents. This is an extremely cramped view of the Court's role.

There is, within the case, thus an interesting debate about the proper relationship between the courts and Congress in this area of copyright law, and the interplay between judicial precedents and later legislation. The State of Georgia advanced an argument that the Court should ignore the earlier cases completely in favor of the text of the current statute, insofar as those earlier cases reflected an improper balancing of "public policy" and an older view of the judicial role in this area that is not reflected in the modern understanding of legislative supremacy.³⁴ The Court rightly rejected this view, as it is historically inaccurate; the Court did look at its earlier precedents. But the Court then erred in viewing the later legislative revisions of the Copyright Act as limiting its ability to continue to develop the doctrine and fully grapple with the underlying policy interests.

In dissent, Justice Thomas offers yet another view of the relationship between the older cases and the current statute. Thomas criticizes the ma-

³³ *Id.* at n.4.

³⁴ *Id.* at 1510 ("Georgia suggests that we should resist applying our government edicts precedents to the OCGA annotations because our 19th-century forebears interpreted the statutory term author by reference to "public policy" — an approach that Georgia believes is incongruous with the "modern era" of statutory interpretation.")

majority's "reflexive" acceptance of the Court's earlier precedents, "without examining the origin or the validity of the rule they announced."³⁵ He suggests that the Court must instead look to "the root" of the earlier precedents to understand the scope of the government edicts doctrine.³⁶ In searching for the root, Justice Thomas focuses on the different possible understandings of "authorship" that existed at the time of enactment. He also notes the possibility that the early Court was motivated in part by due process concerns related to access to the law. From this, he derives from the early precedents his rule that the doctrine only applies to works that have "the force of law." According to Thomas, if the doctrine is to be expanded beyond this narrow understanding, then it is up to the legislature, not the courts. Applying this approach to the annotations at issue, Justice Thomas would have found them protected by copyright, since they were nonbinding and did not have "the force of law."

Justice Thomas's view of the judicial role runs into many of the same problems. On the one hand, he is correct that the Court should have looked to "the root" of the earlier precedents, i.e. the original justifications for the doctrine, rather than simply applying the textual reasoning at "face value" as the majority suggested. But he then errs in confining his inquiry to a narrow historical understanding from the 1800s, rather than exploring the potentially broader principles underlying those precedents. Like the majority, he appears to believe that any subsequent changes to or development of the doctrine must be made by Congress, that the meaning of the doctrine was frozen in place after the opinions were decided.³⁷ Yet he never adequately explains why that should be, given that the doctrine initially was, once again, created solely by the courts. If the Court created the initial doctrine, why should it later be barred from reconsidering it or developing it further? Indeed, as suggested above, the better view is that Congress has continued to give the courts discretion to develop concepts like "authorship" in a common law fashion.

³⁵ *Id.* at 1515 (Thomas, J. dissenting).

³⁶ *Id.* at 1515 (Thomas, J. dissenting) ("[T]o understand the scope of the doctrine, we must explore its underlying rationale. In my view, the majority's uncritical extrapolation of precedent is inconsistent with the judicial role. An unwillingness to examine the root of a precedent has led to the sprouting of many noxious weeds that distort the meaning of the Constitution and statutes alike. Although we have not been asked to revisit these precedents, it behooves us to explore the origin of and justification for them, especially when we are asked to apply their rule for the first time in over 130 years.")

³⁷ *Id.* at 1514-15 (Thomas, J. dissenting) ("Because I believe we should "leave to Congress the task of deciding whether the Copyright Act needs an upgrade," *Am. Broad. Cos. v. Aereo, Inc.*, 573 U.S. 431, 463 (2014) (Scalia, J., dissenting), "I respectfully dissent.")

In a characteristically insightful essay on the case, Professor Shyamkrishna Balganesh discusses precisely this debate over the continuing role of common law development in copyright.³⁸ Balganesh views the Court's decision as reflecting a potential turning point in the judicial attitude toward the Copyright Act. According to Balganesh, the dominant approach of courts since the passage of 1976 Act has been to defer to the text of the Act and to limit their own role in developing doctrine.³⁹ The case thus potentially stands for a reinvigorated role of the courts in copyright cases, developing the law in a common law fashion through the use of principled reasoning. By rejecting calls to ignore those earlier cases, as the State of Georgia suggests, or to read them narrowly in light of historical understandings, as Justice Thomas suggests, the Court reasserts the importance of the continuing development of doctrine.

While I agree with much of Balganesh's analysis and am sympathetic to his view, I part ways with him in his optimistic assessment of the case. As an initial matter, unlike Balganesh, I do not think that courts since the 1976 Act have so completely abandoned the task of continuing to interpret and articulate copyright doctrine in a principled and common law way. Although I agree that some of the most recent Court opinions adopt this approach (as described in the next section of this Article), both the lower federal courts and the Supreme Court have, in many areas of copyright, continued to develop the doctrine in a principled fashion since passage of the 1976 Act. Much of copyright doctrine today remains judge-made.

But more importantly, I do not view the Court's opinion in *Georgia v. PRO* as standing for a broad and reinvigorated role for common law reasoning. Balganesh correctly notes the Court's rejection of Georgia's argument that there is no role at all for this kind of principled development of doctrine. In this respect, the Court's opinion does represent an assertion of the importance of this judicial role. Yet Balganesh does not focus as much attention on the Court's subsequent cabining of that role in response to legislative revisions of the Copyright Act. This latter aspect of the opinion suggests a far more limited and cramped understanding of the Court's role in exercising these common law powers, one limited to merely applying "at face value" its own precedents rather than developing any broader principles underlying those precedents.⁴⁰ I hope that Balganesh's more

³⁸ Shyamkrishna Balganesh, *Long Live the Common Law of Copyright!* Georgia v. Public.Resource.Org., Inc. and the Debate over Judicial Role in Copyright, 121 COLUM. L. REV. F (forthcoming 2021).

³⁹ See generally Shyamkrishna Balganesh, *Copyright as Legal Process: The Transformation of American Copyright Law*, 168 U. PA. L. REV. 1101 (2020).

⁴⁰ See *PRO* at n.4. In some sense, the disagreement is less about the result, and more about the means. The Court in the end does expand the "government edicts doctrine" to encompass the annotations at issue in this case. Yet by characterizing

optimistic view is correct, but I fear that it is not since, for the reasons I explain in Part IV, I believe this more limited understanding is reflected in other more recent Court opinions on copyright.

The fundamental mistake that the majority's opinion makes, then, is in treating the Copyright Act as a definitive source of answers rather than a delegation of authority to the courts to find the answers. In this light, the Court's deference to the legislature looks less like a properly modest view of the judicial role, and more like an abdication of the authority granted to it by the legislature.

III. WHAT IT SHOULD HAVE DONE

What, then, should the Court have done in this case? The Court should have started by recognizing its proper role in continuing to develop copyright doctrine in a case-by-case fashion in this area. The origins of the government edicts doctrine are found, not in the text of the Copyright Act of 1790, but in the early cases that first articulated the doctrine. The doctrine is thus, at its root, a judge-made doctrine, like many other doctrines in copyright law. Moreover, later reenactments of the copyright act, in continuing to use the statutory term "author," reflected no specific intent to freeze the doctrine in place. Instead, later enactments of the broad term, without any attempt to define it with more specificity, more plausibly evince an intent for courts to continue to develop the doctrine in response to new circumstances, as they have been doing in other areas of copyright law.

Having recognized this role, the Court would then have to, as Justice Thomas suggested, look to "the root" of the doctrine found in the early precedents, to see if it warrants extension to the facts of this case. This is not a straightforward task. Although Justice Thomas correctly identifies the need to look at the root of the doctrine, his approach focuses too narrowly on the way legislation, and authorship thereof, were understood at the time of the original Copyright Act. And like the majority, he too believes that these early understandings should be frozen in place, and that any changes to the doctrine need to be made by Congress. For the reasons mentioned above, this is far too narrow a view of the judicial role in copyright cases. Instead, the Court should have fully taken up the invitation to continue to develop the doctrine in response to current needs and the broader policies and principles underlying the government edicts doctrine.

this as no more than a "straightforward" application of its prior precedents, the Court leaves itself open to Justice Thomas's in my view valid critique that this is by no means straightforward, but rather a sub rosa extension of the doctrine. There may well be good reasons to extend the doctrine, but the Court should have been upfront about this, and in doing so, should have acknowledged its proper role in developing and advancing the doctrine.

What policies and principles, then, should the Court have considered? One principle was already identified by the Court as the “animating principle” behind the government edicts doctrine: “no one can own the law. ‘Every citizen is presumed to know the law,’ and ‘it needs no argument to show . . . that all should have free access’ to its contents. *Nash*, 142 Mass. at 35, 6 N.E. at 560.”⁴¹ As the quoted passage indicates, early cases found the principle so obvious that it “need[ed] no argument” to justify it. And in many ways, the Court’s opinion in *Georgia v. PRO* does not do much more to explain the source or implications of this principle. Instead, the Court moves immediately to doctrinal analysis, deriving its “straightforward rule” from the “face value” of its precedents, and does little to further articulate or develop the underlying principle.

This is one reason the Court’s opinion is so unsatisfactory. While it is true that the principle – all should have free access to the law – may be entirely obvious, its application and the implications that flow from that principle may not be so obvious. Indeed, that is precisely the issue presented by the case, as it requires an extension of the underlying principle, from judicial opinions and annotations to legislative enactments and annotations. Are annotations to legislative enactments commissioned by the legislature necessary or important in order for citizens to “know the law?” Does it matter that the legislature incorporated these annotations into its “official code?” Can this be distinguished from unofficial annotations? Without a fuller understanding of the principle, it becomes difficult to know how it should be applied to a new situation. And appeals to “straightforward rules” in the doctrine are not terribly convincing.

Other lower court decisions involving cases with similar facts have done a better job of addressing the underlying interests at stake. For example, in *Veck v. Southern Building Code Congress Int’l*,⁴² the U.S. Court of Appeals for the Fifth Circuit, sitting en banc, considered the copyrightability of local building codes authored by private parties and then subsequently enacted into law by municipalities. The Fifth Circuit ultimately held that such codes were not protected by copyright, and in reaching this result, considered the same trio of early Supreme Court cases, but did more to examine and develop the underlying policies and principles. The court derived from those cases the broad principle that “no one can own the law.” The court then articulated a theory based on the idea that the law was effectively “authored” by the people when it was enacted, regardless of who initially drafted the law.⁴³

⁴¹ *PRO*, 140 S. Ct. at 1507.

⁴² 293 F.3d 791 (5th Cir. 2002) (en banc).

⁴³ Note on this score, the Supreme Court in *Georgia v. PRO* could have given more weight to the fact that the Georgia legislature expressly enacted the statutory provisions of the OCGA into law, merged the statutory provisions with the anno-

Although the court in *Veeck*, like the Court in *Georgia v. PRO*, based its ruling on the statutory term authorship, it did not restrict itself to applying a “straightforward rule” from Supreme Court precedents. Instead, the court engaged in a wide-ranging consideration of various policy arguments and tensions underlying those precedents. It grappled more thoroughly with the potential implications of copyright protection for legal codes and the corresponding concern about access to the law. It considered more explicitly the potential due process concerns raised by protecting the law. Opinions from other circuits also evince this kind of careful consideration of underlying principles.⁴⁴ It is particularly odd, then, that the Supreme Court’s opinion so heavily constrains itself so that these discussions are not fully articulated.

It is true that the Court in *Georgia v. PRO* does eventually get around to discussing the potential implications of finding the legislative annotations protected. In responding to Georgia’s and the dissent’s minimization of the annotations as nonbinding, the Court at the very end of its opinion finally makes the affirmative policy case for not protecting the annotations:

Imagine a Georgia citizen interested in learning his legal rights and duties. If he reads the economy-class version of the Georgia Code available online, he will see laws requiring political candidates to pay hefty qualification fees (with no indigency exception), criminalizing broad categories of consensual sexual conduct, and exempting certain key evidence in criminal trials from standard evidentiary limitations—with no hint that important aspects of those laws have been held unconstitutional by the Georgia Supreme Court. See OCGA §§ 21–2–131, 16–6–2, 16–6–18, 16–15–9 (available at www.legis.ga.gov). Meanwhile, first-class readers with access to the annotations will be assured that these laws are, in crucial respects, unenforceable relics that the legislature has not bothered to narrow or repeal. See §§ 21–2–131, 16–6–2, 16–6–18, 16–15–9 (available at <https://store.lexisnexis.com/products/official-code-of-georgia-annotated-skuSKU6647> for \$412.00).

If everything short of statutes and opinions were copyrightable, then States would be free to offer a whole range of premium legal works for those who can afford the extra benefit. A State could monetize its entire suite of legislative history. With today’s digital tools, States might even launch a subscription or pay-per-law service.⁴⁵

Here at last we see some development of the principle underlying the Court’s decision. The Court suggests that the “animating principle” behind

tations, and published the final merged product “by authority of the state” as “the Official Code of Georgia Annotated.” *PRO* at 1504.

⁴⁴ *E.g.*, *Bldg. Officials & Code Adm’rs v. Code Tech., Inc.*, 628 F. 2d 730 (1st Cir. 1980) (exploring the due process implications of copyright protection of administrative building code).

⁴⁵ *PRO*, 140 S. Ct. at 1512.

the government edicts doctrine – that all should have free access to the law – should be read to encompass official materials necessary to understand the law, and that this includes the annotations in this case. Yet this development of the principle comes at the very end of the opinion, in response to a specific argument, and only after much more extensive discussion about why a contrary result is at odds with the “straightforward rule” from the earlier precedents and the supremacy of the legislative text. The principle is an afterthought, rather than the central feature of the opinion. The Court thus missed an opportunity to fully develop the “government edicts doctrine” to extend beyond works that have the “force of law” to include government works that are necessary or important for citizens to fully understand the law, thereby articulating a principle that would have provided guidance for future cases.⁴⁶

The Court could also have broadened its view to consider other copyright interests beyond access to the law. Another interesting question presented by the case, and one largely ignored by the Court, is whether the incentives of copyright are necessary for the creation of the annotations. Copyright is, of course, fundamentally about providing incentives for the creation of original works. Yet the application of this principle to works created by the government is by no means obvious, since the government directly funds the works it creates. The early Court precedents understood this peculiar state of affairs, in holding that judicial opinions and annotations were not protected by copyright. The early copyright act had no equivalent to the current section of the copyright act that divests U.S. government works of copyright protection.⁴⁷ Yet the early Court recognized implicitly the principle that works authored by the government had special status under copyright.

How this principle would have applied to the facts of this case is by no means clear, and in fact presents an interesting area of potential ambiguity. On the one hand, judicial opinions and legislative enactments would appear to clearly not require additional copyright incentives, since these activities have been funded by state and federal governments and thus

⁴⁶ The Court itself indirectly noted the possibility that it could have arrived at the same result through a closer examination of the rationale for its earlier precedents: “But a Court motivated by Justice THOMAS’s three-fold concerns might just as easily have read them as supporting a rule that prevents the officials responsible for creating binding materials from qualifying as an ‘author.’” *Id.* at n. 4. The Court rejected this approach, however, as being not “consistent with the judicial role.” *Id.* See also Shyamkrishna Balganesh & Peter Menell, *The Uncopyrightability of Edicts of Government* (amicus brief) (arguing that “government edicts” should be understood more broadly than simply materials that have the “force of law”); Charles Duan, *Copyright in the Texts of the Law: Historical Perspectives*, 9 *NYU J. INTELL. PROP. & ENT. L.* 191 (2020).

⁴⁷ 17 U.S.C. § 105.

would be produced regardless. But the annotations in this case raise trickier questions, since there is at least some evidence in the record that copyright protection provided some incentive to the state government's commissioning of the annotations. Justice Thomas, in dissent, argues that copyright protection for the annotations ultimately had the effect of making these annotations available to the public at a lower price. Absent protection, the State of Georgia would likely not have been able to afford commissioning the annotations from Matthew Bender, and the public would have had access only to privately-produced annotations at a higher cost.⁴⁸

The incentive impact would, of course, have to be balanced against the potential limitation in free access to the annotations. The court in *Veeck* grappled with this issue, since the model building codes at issue in that case were costly to create, insofar as they relied upon industry expertise that was not necessarily available to the enacting legislatures. Nevertheless, the court in *Veeck* found that incentive impact outweighed by the public interest in access to the law. How that balance plays out in the context of legislative annotations is a more complicated question that would have been important to consider in this case.

Yet the majority's opinion once again fails to address any of these implications. Instead, the Court summarily rejects this argument, referring the issue once again to Congress:

Georgia also appeals to the overall purpose of the Copyright Act to promote the creation and dissemination of creative works. Georgia submits that, without copyright protection, Georgia and many other States will be unable to induce private parties like Lexis to assist in preparing affordable annotated codes for widespread distribution. That appeal to copyright policy, however, is addressed to the wrong forum. As Georgia acknowledges, "[I]t is generally for Congress, not the courts, to decide how best to pursue the Copyright Clause's objectives." *Eldred v. Ashcroft*, 537 U.S. 186, 212, 123 S.Ct. 769, 154 L.Ed.2d 683 (2003). And that principle requires adherence to precedent when, as here, we have construed the statutory text and "tossed [the ball] into Congress's court, for acceptance or not as that branch elects." *Kimble*, 576 U.S. at 456, 135 S.Ct. 2401.⁴⁹

Although deference to legislative policymaking can in many instances be warranted, once again, this would seem to be a poor context for such deference. The kind of general balancing of incentives and access that is raised in this case is not some kind of complex, detailed policy analysis of the type that Congress is uniquely positioned to resolve. Rather, it is exactly the kind of policy balancing that courts in copyright cases do all the time when addressing basic questions such as the level of originality re-

⁴⁸ *PRO*, 140 S. Ct. at 1522 (Thomas, J. dissenting).

⁴⁹ *Id.* at 1511.

quired for protection, whether a work is “substantially similar” to another, and whether a use of a work is “fair.” Like these other doctrines, “authorship” is a broad concept that the courts are charged with the responsibility for developing, and the potential need for incentives for government works would once again seem to be an appropriate place for these considerations. The Copyright Act makes use of a concept, authorship, and applies it to a wide range of situations. The courts are then charged with deciding precisely how it should be applied, particularly in cases where it is not a perfect fit.

A more thorough consideration of the competing policies might have led the Court to the same place, but with a far richer and well-supported opinion. Considering both the need for public access and the potential impact of copyright incentives, the Court could have construed “authorship,” not in a limited and ill-fitting way, but as vindicating a broader interest in access to not only law, but other official materials necessary to understand the law or given official imprimatur by the courts or legislatures. Thus, the Court could have ventured beyond the dissent’s argument, that the government edicts doctrine only applies to works that have the “force of law,” and along the way, articulated a broader principle that would have served to guide future cases in a manner more consistent with the underlying animating principle. And it could have done so without feeling constrained by the need to read “authorship” so narrowly, in a way dictated by its eighteenth and nineteenth century precedents. There is nothing inherent in the broad concept of “authorship” that precludes consideration of these broader policy interests. It just requires an accurate appreciation of the proper judicial role in this area of copyright.

IV. BROADER COPYRIGHT JURISPRUDENCE

The narrow judicial role in copyright cases evinced in *Georgia v. PRO* is, unfortunately, part of a larger and troubling recent pattern in the Court’s copyright jurisprudence. In a number of recent cases, the Court has adopted a similarly narrow and cramped vision of its role in copyright cases, choosing to adhere closely to precedent or statutory language and refusing to consider the broader policy implications of its rulings, all in favor of “simple” or “straightforward” rules. This approach stands in sharp contrast with some of its earlier copyright jurisprudence interpreting the 1976 Act and also poses real risks for future copyright cases.

The Court’s recent opinion in *Star Athletica v. Varsity Brands*⁵⁰ is another example of the Court’s recent approach to copyright cases. In that case, the plaintiff, Varsity Brands, registered copyrights in 200 different cheerleading outfit designs consisting of combinations of lines, chevrons,

⁵⁰ 137 S. Ct. 1002 (2017).

and patterns in different colors. The defendant Star Athletica, a competitor, made and sold similar cheerleading outfits, and Varsity Brands sued alleging copyright infringement. Star Athletica defended, arguing that Varsity Brands' designs were not copyrightable under the "useful article doctrine." Under the copyright act, the design of a useful article, such as a cheerleading outfit, can be protected as a pictorial, graphical, or sculptural work "only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article."⁵¹

Star Athletica was an eagerly anticipated case, insofar as the lower federal courts had long struggled with how to draw the line between protectable and unprotectable elements of the design of a useful article. Specifically, courts had struggled to articulate a workable test for when design elements "can be identified separately from" the utilitarian aspects of a useful article. The result was an extensive body of conflicting case law, proposing a number of different tests for separability. Some courts asked whether an "ordinary observer" would detect a design separate from function. Others looked at whether the object was viewed or marketed as art.⁵² Still others looked at the creator's intent or design process.⁵³ Other courts rejected the subjective views of the creator, focusing instead on how the work was objectively perceived. In all, the lower federal courts had proposed more than nine different tests.⁵⁴ Unsettled questions thus existed about how to determine what was or was not separable, and from whose perspective.

The case also implicated fundamental policy questions about the proper relationship between copyright and patent. The useful article doctrine in copyright serves a vital policing function between the two areas of law.⁵⁵ Copyright law, both here and elsewhere, evinces a consistent concern with not inadvertently protecting useful ideas, concepts, methods, etc. This is found in the express statutory exclusions in section 102(b),⁵⁶ and it

⁵¹ 17 U.S.C. § 101 (definition of pictorial, graphical, and sculptural work).

⁵² *Kieselstein-Cord v. Accessories by Pearl*, 632 F.2d 989, 993-94 (2d Cir. 1980).

⁵³ *Brandir Int'l, Inc. v. Cascade Pacific Lumber Co.*, 834 F.2d 1142, 1145 (2d Cir. 1987).

⁵⁴ Barton Beebe, *Star Athletica and the Problem of Panaestheticism*, 9 UC IRVINE L. REV. 275, 281 (2019); *Varsity Brands, Inc. v. Star Athletica, LLC*, 799 F.3d 468, 484-85 (6th Cir. 2015), *aff'd sub nom.*, *Star Athletica, L.L.C. v. Varsity Brands, Inc.*, 137 S. Ct. 1002 (2017); Robert Kirk Walker & Ben Depoorter, *Unavoidable Aesthetic Judgment in Copyright Law: A Community of Practice Standard*, 109 NW. U. L. REV. 343, 363-67 (2015).

⁵⁵ Christopher Buccafusco & Mark A. Lemley, *Functionality Screens*, 103 VA. L. REV. 1293 (2017).

⁵⁶ See 17 U.S.C. § 102(b); *Baker v. Selden*, 101 U.S. 99 (1880).

is also a theme found throughout much of the case law involving copyright protection for computer software.⁵⁷ The concern is that copyright protection could permit automatic protection for useful things without meeting any of the more stringent requirements for patent and for a far longer time period. Thus, the precise scope of the useful article doctrine had real implications for competition in many markets.

It was against this backdrop that the Supreme Court, through Justice Thomas, issued a profoundly unsatisfying opinion in *Star Athletica*, one that, like *Georgia v. PRO*, seemed to go out of its way to avoid addressing any of the complexities in the doctrine or the difficult underlying policy questions. The Court ultimately found the designs protectable, and in doing so articulated the following test:

“We hold that a feature incorporated into the design of a useful article is eligible for copyright protection only if the feature (1) can be perceived as a two- or three-dimensional work of art separate from the useful article and (2) would qualify as a protectable pictorial, graphic, or sculptural work — either on its own or fixed in some other tangible medium of expression — if it were imagined separately from the useful article into which it is incorporated.⁵⁸

The Court derived this test directly from a plain reading of the statutory language quoted above. As to the first element, the Court wrote: “The first requirement — separate identification — is not onerous. The decisionmaker need only be able to look at the useful article and spot some two- or three-dimensional element that appears to have pictorial, graphic, or sculptural qualities.”⁵⁹ As to the second element, the Court wrote: “The independent-existence requirement is ordinarily more difficult to satisfy. The decisionmaker must determine that the separately identified feature has the capacity to exist apart from the utilitarian aspects of the article. In other words, the feature must be able to exist as its own pictorial, graphic, or sculptural work as defined in § 101 once it is imagined apart from the useful article.”⁶⁰

The Court then proceeded to apply its test to the facts of the case: “Applying this test to the surface decorations on the cheerleading uniforms is straightforward. First, one can identify the decorations as features having pictorial, graphic, or sculptural qualities. Second, if the arrangement of colors, shapes, stripes, and chevrons on the surface of the cheerleading uniforms were separated from the uniform and applied in another medium — for example, on a painter’s canvas — they would qual-

⁵⁷ *Computer Assocs. v. Altai*, 982 F.2d 693 (2d Cir. 1992); *Lotus Dev. Corp. v. Borland*, 49 F.3d 807 (1st Cir. 1995) (Boudin, J., concurring).

⁵⁸ *Star Athletica*, 137 S. Ct. at 1007.

⁵⁹ *Id.* at 1010.

⁶⁰ *Id.*

ify as ‘two-dimensional . . . works of . . . art.’”⁶¹ The Court thus concluded that the designs on the cheerleading uniforms could be protected under copyright.

The Court’s opinion in *Star Athletica* has been the subject of extensive critical commentary.⁶² Much of this commentary focuses, quite rightly, on the failure of the Court’s proposed test to provide a workable framework for resolving or even addressing the policy tensions inherent in the useful article doctrine. My purpose in this article is not to restate those criticisms, many of which I agree with. Instead, my aim here is to focus more on the methodology the Court used to reach this result, and suggest that this methodology is potentially part of a larger and troubling trend in the Court’s recent copyright jurisprudence, when viewed in light of the Court’s later decision in *Georgia v. PRO*.

Although the Court in *Star Athletica*, after articulating its proposed test, proceeded to consider and dismiss a number of counterarguments, the above analysis in fact represents the core of the Court’s reasoning in support of its ruling. Missing from the opinion was any acknowledgement of the difficulty that the lower courts had encountered in coming up with a proper test. Indeed, the Court’s opinion cites none of the many appellate court cases that raised particularly difficult fact patterns.⁶³ Also missing from the opinion was any real discussion of the underlying purpose behind the useful article doctrine and how the Court’s proposed test furthers that purpose.

In place of such considerations, the Court substituted little more than a plain text reading of the statute.⁶⁴ Just as in *Georgia v. PRO*, the Court looked for a “straightforward” test, derived this time from the plain lan-

⁶¹ *Id.* at 1012.

⁶² See, e.g., Christopher Buccafusco, Mark A. Lemley & Jonathan S. Masur, *Intelligent Design*, 68 DUKE L.J. 75 (2018); Christopher Buccafusco & Jeanne Fromer, *Fashion’s Function In Intellectual Property Law*, 93 NOTRE DAME L. REV. 51 (2017); Mark McKenna, *Knowing Separability When We See It*, 166 U. PA. L. REV. ONLINE 127 (2017); Peter Menell & Charles Yablon, *Star Athletica’s Fissure In The Intellectual Property Functionality Landscape*, 166 U. PA. L. REV. ONLINE 137 (2017); Christopher Buccafusco & Jeanne C. Fromer, Essay, *Forgetting Functionality*, 166 U. PA. L. REV. ONLINE 119, 121 (2017).

⁶³ See Rebecca Tushnet, *Shoveling A Path After Star Athletica*, 66 UCLA L. REV. 1216 (2019) (“I decided to talk about *Star Athletica* because I didn’t know what I thought about the case definitively announcing that cheerleading uniform designs could be protected by copyright and that decades’ worth of lower courts’ attempts to interpret the copyright statute’s treatment of ‘useful articles’ were worthless.”).

⁶⁴ Beebe, *supra* note 43 (“I’m tempted to say that we’ve all known that, putting aside the legislative history, Justice Thomas’s reading may very well be the most loyal to the actual words of the Copyright Act — perhaps primarily because he just rephrases them.”).

guage of the statute rather than the Court's own precedents, and then applied the test to the facts of the case, much like a lower court dutifully following instructions from a higher court. And just as in *Georgia v. PRO*, the Court refused to engage in any sustained policy reasoning or acknowledgement of the potentially complex nature of the problem.

Indeed, Justice Thomas expressly rejected the relevance of such considerations in the face of the plain language of the statute. Both *Star Athletica* and the U.S. government had argued that the Court should look to the policy behind the useful article doctrine, and that the relevant question in determining "separability" was whether protecting a design element would have the effect of protecting a useful feature of the article. More specifically, both proposed that a relevant consideration is whether, without the design element, the article would be equally or similarly useful. The Court expressly rejected this argument:

The debate over the relative utility of a plain white cheerleading uniform is unnecessary. The focus of the separability inquiry is on the extracted feature and not on any aspects of the useful article that remain after the imaginary extraction. The statute does not require the decisionmaker to imagine a fully functioning useful article without the artistic feature. Instead, it requires that the separated feature qualify as a nonuseful pictorial, graphic, or sculptural work on its own.

Of course, because the removed feature may not be a useful article — as it would then not qualify as a pictorial, graphic, or sculptural work — there necessarily would be some aspects of the original useful article "left behind" if the feature were conceptually removed. But the statute does not require the imagined remainder to be a fully functioning useful article at all, much less an equally useful one.⁶⁵

The Court thus left open the possibility that, through application of its test, a useful feature of an article could in fact be protected by copyright.⁶⁶

We see here, just as in *Georgia v. PRO*, a very direct appeal to statutory authority and a refusal to consider the policy interests underlying the statutory terms as "unnecessary." This reflects the same narrow and cramped view of the role of the federal courts in interpreting the Copyright Act. Under this view, the rich body of case law developed by the lower federal courts is entirely beside the point, as the answers are to be found in a plain reading of the text of the statute. The judicial role thus does not include development of the concept of "separability" in light of the underlying policies. Yet, as discussed above, this view is at odds with the way that the Copyright Act, in its history, structure, and text, often assumes that courts will continue to develop broad statutory terms in light of the underlying policies. Appeals to the plain language of the statute,

⁶⁵ *Star Athletica*, 137 S.Ct. at 1013.

⁶⁶ See Buccafusco et al., *Intelligent Design*, *supra* note 51, at 189.

without any appreciation of those underlying policies or interests, are an abdication of judicial responsibility.

Both *Georgia v. PRO* and *Star Athletica* stand in sharp contrast with earlier Supreme Court cases interpreting the same 1976 Act. In the Court's own fair use cases, for example, the Court has been quite comfortable developing copyright law in a common law fashion, with repeated reference to the broad principles and policies underlying copyright. In *Campbell v. Acuff-Rose*,⁶⁷ the Court engaged in a detailed and sophisticated analysis of the nature of parody, and created within the fair use doctrine new developments that highlighted the importance of "transformation" as a relevant concept, while deemphasizing the impact on the market as a factor in such cases.⁶⁸ Similarly, in *Harper & Row v. Nation*,⁶⁹ the Court applied the fair use doctrine in a common law-like fashion, developing the various statutory factors and highlighting the underlying policies served by the doctrine. And in *Sony v. Universal City Studios*,⁷⁰ the Court dramatically extended the fair use doctrine to an entirely new context, allowing consumers to use a new technology to engage in certain personal copying of copyrighted works.

The obvious response to the above cases is that fair use is different, insofar as the legislative delegation of authority to the courts is more express. Yet the same phenomenon can be found in Supreme Court cases interpreting other copyright doctrines. For example, in *Sony*,⁷¹ the Court, in addition to ruling on fair use, reached out to create a new doctrinal test for applying indirect copyright liability to new technologies, a test found nowhere in the statute or legislative history of the Act. In doing so, the Court rested its opinion quite heavily on an analysis of the underlying policies.⁷² In *Feist v. Rural Telephone Co.*,⁷³ the Court addressed the protectability of compilations of data, ultimately finding that such compilations could be protected but only if there was sufficient originality in the selection and arrangement of the underlying data. The Court developed the concept of "originality" in the statute, and in doing so made express reference to the underlying policies supporting copyright more broadly. And in *Community for Creative Non-Violence v. Reid*,⁷⁴ the

⁶⁷ 510 U.S. 569 (1994).

⁶⁸ See Pierre Leval, *Toward a Fair Use Standard*, 103 HARV. L. REV. 1105 (1990).

⁶⁹ 471 U.S. 539 (1985).

⁷⁰ 464 U.S. 417 (1984).

⁷¹ *Id.*

⁷² See also *Metro-Goldwyn-Mayer, Inc. v. Grokster*, 545 U.S. 913 (2005) (recognizing inducement liability); *New York Times Co. v. Tasini*, 533 U.S. 483 (2001) (interpreting "revision" under provision allocating rights in collective works, in light of new technological uses).

⁷³ 499 U.S. 340 (1991).

⁷⁴ 490 U.S. 730 (1989).

Court interpreted the statutory term “author” in a broad, common-law-like fashion. These and other cases indicate that there is nothing inevitable about the current Court’s approach to copyright law. Indeed, if anything, the current approach stands in sharp contrast to how the Court has approached copyright cases in the past.

It should be noted that there are a number of other recent Supreme Court cases that have properly adopted a narrower, more statute-focused approach to copyright law. For example, in cases involving more detailed and narrow questions of copyright law, such as the meaning of “registration,”⁷⁵ or the definition of “full costs,”⁷⁶ or the application of laches,⁷⁷ it may be more appropriate to hew more closely to the text of the statute and the legislative intent, as Congress may well have had a more specific result in mind. In these cases, there is not the same delegation of broad authority to the courts. The point is that the proper scope of the judicial role depends on the part of the copyright act that is being interpreted, and that the Court in both *Georgia v. PRO* and *Star Athletica* applied the wrong approach.⁷⁸

Finally, the Court’s more recent approach to copyright raises significant concerns about how it will deal with future cases, and in particular one very important case currently before the Court: *Oracle v. Google*.⁷⁹ At issue in *Oracle v. Google* is the copyrightability of so-called software “application programming interfaces” or APIs. In that case, Oracle sued Google for copying a number of APIs from its Java programming lan-

⁷⁵ *Fourth Estate Public Benefit Corp. v. Wall-Street.com*, 139 S. Ct. 881 (2019).

⁷⁶ *Rimini Street, Inc. v. Oracle USA, Inc.*, 139 S. Ct. 873 (2019).

⁷⁷ *Petrella v. Metro-Goldwyn-Mayer, Inc.*, 572 U.S. 663 (2014); *see also* *Kirtsaeng v. John Wiley & Sons, Inc.*, 568 U.S. 519 (2013) (interpreting “under this Title” in the context of the first sale doctrine); *Reed Elsevier, Inc. v. Muchnick*, 559 U.S. 154 (2010) (exploring jurisdictional implications of failure to register under 17 U.S.C. § 411).

⁷⁸ On this last point, the Court’s recent opinion in *American Broadcasting Co. v. Aereo*, 573 U.S. 431 (2014) provides an interesting puzzle, as it straddles these two positions. In that case, the Court was tasked with interpreting the statutory terms “publicly” and “perform,” in light of a new technology that retransmitted over-the-air television broadcasts to individuals over the internet. This was a tricky issue, as the proper application of these terms to an entirely new technology was by no means entirely clear. One approach would have been to interpret these broad statutory terms in light of the underlying copyright interests. Yet this was complicated by the fact that, in this particular area, Congress had in fact legislatively overturned an earlier Court interpretation of those terms. *Fortnightly Corp. v. United Artists Television*, 392 U.S. 390 (1968). Thus the Court in *Aereo* had to confront both the underlying policies and the potential impact of later legislative action. *Aereo* thus highlights the fact that sometimes the line between these two competing approaches is not always clear.

⁷⁹ 750 F.3d 1339 (Fed. Cir. 2014); *Oracle Am. v. Google*, 886 F.3d 1179 (Fed. Cir. 2018), *cert. granted*, 886 F.3d 1179 (2019).

guage. The APIs consisted of the names of certain software functions commonly used by programmers when programming in Java, the brief snippets of software code necessary to invoke these functions in a program, and the organization and structure of libraries of such functions. Google had copied a number of these APIs in creating its own implementation of Java for its mobile phone platform, in order to make it easier for programmers familiar with Java to write software for its new mobile phone platform.

Doctrinally, the case raises a number of interesting questions, including: (1) whether the APIs are sufficiently “original” to be protected by copyright; (2) whether the APIs are a “method of operation” expressly excluded from copyright; and (3) whether Google’s use of the APIs constituted “fair use.” More broadly, the case will potentially have a significant impact on computer software markets, since APIs are ubiquitous in the software industry and many industry participants had long assumed that APIs were not copyrightable, based on a number of earlier appellate court cases.⁸⁰ Thus a decision in favor of copyrightability has the potential to disrupt settled expectations and dramatically impact computer software markets.

It is hard to imagine a case less suited to the Court’s recent, “straight-forward” approach to copyright. Computer software has always fit poorly into copyright law. Although it is defined as a “literary work,” consisting of letters, numbers, and symbols, it is a particular kind of literary work that is extremely functional, and copyright has long excluded from protection functional aspects of copyrighted works. Lower federal courts have repeatedly noted this tension expressly,⁸¹ and have thus had to significantly adapt, in a very self-conscious fashion, existing copyright doctrines in order to ensure that copyright law does not inadvertently lock up functional aspects of computer software. Moreover, Congress, in bringing computer software into copyright, expected that the courts would have to adapt the doctrine in this fashion. The application of copyright law to computer software in the lower courts has thus been characterized by extensive case-by-case, common law development with an eye toward the underlying principles behind copyright, rather than an overly-literal application of the text of the statute.

Yet the oral argument in *Oracle v. Google* raised some concerns that the Court might apply an overly literal statutory approach to this case.

⁸⁰ See *Lotus v. Borland*, 516 U.S. 233 (1st Cir. 1996), *aff’d by an equally divided court*, 516 U.S. 233 (1996); *Sega Enter., Ltd. v. Accolade, Inc.*, 977 F.2d 1510 (9th Cir. 1992).

⁸¹ See, e.g., *Computer Associates Int’l Inc. v. Altai, Inc.*, 982 F.2d 693 (2d Cir. 1992); *Lotus Dev. Corp. v. Borland Int’l, Inc.*, 516 U.S. 233 (1st Cir. 1996) (Boudin, J., concurring).

Some of the questioning from the Justices focused on literal application of existing doctrines to the APIs, without giving sufficient consideration to the ways in which software raises tricky policy questions unique to software markets. A “straightforward” approach to the question, which looked to the plain meaning of the textual provisions without consideration of the special features of computer software, could very likely protect APIs and inadvertently lock up useful features of computer software, a result that is clearly at odds with copyright policy. The case thus highlights the potential future dangers of the Court’s recent approach.

So what explains the Court’s more recent approach to copyright questions, particularly since the Court has, in other earlier cases, treated copyright cases much differently? One possibility is that the recent cases, and their specific details, have lent themselves to the Court’s approach. Both *Georgia v. PRO* and *Varsity Brands* are, in some ways, relatively “easy” cases, as Supreme Court cases go. In *Varsity Brands*, the patterns on the cheerleading outfits were fairly easily separable from the underlying function of the outfits, regardless of which test the Court adopted. The case thus differed from some of the cases from the appellate courts, which involved works that mixed both function and form more tightly.⁸² Accordingly, the Court was able to resolve the case without having to grapple with any of the underlying difficult policy questions.

Similarly, in *Georgia v. PRO*, the result, while not perhaps completely obvious, found broad support in the earlier precedents and required only a modest extension of those precedents. It thus did not require a deep engagement with the underlying policies, as a harder case might have.⁸³ If this is the explanation, then both cases can still be critiqued for failing to fully deal with potential implications beyond the specific facts of the cases, and thus failing to provide more guidance for future cases. But the harm from this approach could be confined to relatively easy cases.

Another possible explanation could be found in the identities of the authors of the two opinions: Chief Justice Roberts and Justice Thomas. Neither Roberts nor Thomas are known for their copyright opinions, as Justice Thomas has authored only two prior copyright law opinions for the Court, both involving issues more peripherally related to core copyright concerns, i.e. the validity of settlements purporting to bind owners of unregistered works and the right to a jury trial in assessing statutory dam-

⁸² See, e.g., *Brandir Int’l v. Cascade Pac. Lumber Co.*, 834 F.2d 1142 (2d Cir. 1987); *Carol Barnhart, Inc. v. Economy Cover Corp.*, 773 F.2d 411 (2d Cir. 1985); *Kieselstein-Cord v. Accessories by Pearl, Inc.*, 632 F.2d 989 (2d Cir. 1980).

⁸³ See, e.g. *Veeck v. Southern Bldg. Code Cong.*, 293 F.3d 791 (5th Cir. 2002) (en banc).

ages.⁸⁴ Chief Justice Roberts has, to date, authored no other copyright law opinions for the Court.

By contrast, other Justices have evinced a far greater familiarity with, and interest in, the subject. Of the current or most recent members of the Court, Justices Ginsburg⁸⁵ and Breyer⁸⁶ are by far the most well-versed in copyright, as both have authored a significant number of important copyright opinions (and dissenting and concurring opinions as well⁸⁷). Perhaps not accidentally, their opinions have revealed a greater willingness to deal with the policies and principles underlying copyright. Similarly, former Justices O'Connor,⁸⁸ Stevens,⁸⁹ and Souter⁹⁰ evinced a greater interest in developing the law in a principled fashion, beyond the plain text of the statute or the requirements of past precedent. Thus, subject-matter familiarity may explain the very different approaches.

Part of this might also be attributed to broader differences in judicial philosophy, i.e. differing levels of comfort with moving beyond the plain text of the statute and considering broader policies and principles. To the extent that a particular justice prefers more plain text or originalist approaches to resolving open questions, this might create discomfort in cases where broad, principled, common law reasoning is authorized by the statute. Such a discomfort might well lead to finding restraint where none in fact exists.

It is also possible that the Court's docket has influenced the recent direction of its copyright jurisprudence. Looking at the pattern of Supreme Court copyright cases, most of the opinions dealing with broader

⁸⁴ *Reed Elsevier v. Muchnick*, 559 U.S. 154 (2010) (validity of settlement binding owners of unregistered works); *Feltner v. Columbia Pictures Television*, 523 U.S. 340 (1998) (Seventh Amendment right to jury trial on statutory damages).

⁸⁵ *Petrella v. Metro-Goldwyn-Mayer, Inc.*, 572 U.S. 663 (2014); *Golan v. Holder*, 565 U.S. 302 (2012); *Eldred v. Ashcroft*, 537 U.S. 186 (2003); *New York Times v. Tasini*, 533 U.S. 483 (2001).

⁸⁶ *Am. Broad. Co. v. Aereo*, 573 U.S. 431 (2014); *Kirtsaeng v. Wiley*, 568 U.S. 519 (2013).

⁸⁷ *Star Athletica v. Varsity Brands*, 137 S. Ct. 1002 (2017) (Breyer J. dissenting, Ginsburg J. concurring); *Petrella v. Metro-Goldwyn-Mayer, Inc.*, 572 U.S. 663 (2014) (Breyer J. dissenting); *Kirtsaeng v. Wiley*, 568 U.S. 519 (2013) (Ginsburg J. dissenting); *Golan v. Holder*, 565 U.S. 302 (2012) (Breyer J. dissenting); *Metro-Goldwyn-Mayer, Inc. v. Grokster*, 572 U.S. 663 (2014) (Breyer J. concurring, Ginsburg J. concurring); *Eldred v. Ashcroft*, 537 U.S. 186 (2003) (Breyer J. dissenting).

⁸⁸ *Feist Pub'ns v. Rural Tel. Serv. Co.*, 499 U.S. 340 (1991); *Stewart v. Abend*, 495 U.S. 207 (1990); *Harper & Row v. Nation Enters.*, 471 U.S. 539 (1985).

⁸⁹ *Quality King Distribs. v. L'Anza Research*, 523 U.S. 135 (1998); *Sony v. Universal City Studios*, 464 U.S. 417 (1984).

⁹⁰ *Metro-Goldwyn-Mayer, Inc. v. Grokster*, 572 U.S. 663 (2014); *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569 (1994).

questions of copyright law were issued immediately after passage of the 1976 Act and before the turn of the millennium. And many of these cases dealt with the broader portions of the new Act, thus requiring more common law-like development of new, untested provisions of the Act. Thus, these early cases dealt with the scope of the fair use defense, its availability for cases involving parody, its application to new technologies, the definition of "author," the application of third-party liability to new technologies, the meaning of "originality," etc. By contrast, the Supreme Court's recent docket, with a few notable exceptions including *Georgia v. PRO* and *Star Athletica*, has tended to focus on narrower questions, such as the definition of "full costs," the meaning of "registration," the applicability of laches, etc.

In some ways, this shift in the Court's copyright docket makes sense, as one might expect broader questions of interpretation to rise up soon after the passage of a new statute. As time passes, the broader issues are resolved, and the Court turns to narrower issues that remain unsettled.⁹¹ This trend may also have an impact on the familiarity of the justices with broader issues of copyright law. Justices who have grappled repeatedly with the broader issues addressed in the earlier cases may thus be more willing to engage with the policies and develop the law in a common law like fashion, while Justices less familiar with these issues may feel more reluctant to do so.

Relatedly, this pattern may also reflect differences in the structure of the 1976 Act as compared to the 1909 Act. The 1909 Act was a far shorter statute, with much left undefined. That Act thus relied more heavily upon the federal courts to develop copyright law in a common-law fashion, which the courts in fact did. Supreme Court opinions interpreting the 1909 Act were thus required to engage in a more broad-ranging analysis of the law, as the statute provided little guidance. By contrast, many parts of the 1976 Act are far more detailed, specific, and expressly statutory in nature, reflecting specific compromises and settlements between interest groups.⁹² Although these provisions co-exist with other provisions that retain their broad, common-law nature, the shift in the structure of the statute may explain the shift in approach to copyright law by some Justices. Justices unfamiliar with the 1909 Act may not fully appreciate the way copyright

⁹¹ Note, however, that this has not been the pattern in patent law, where the Court has recently addressed a number of broad and fundamental questions, despite the fact that the most recent statute was enacted in 1952.

⁹² See, e.g., 17 U.S.C. §§ 114, 115, etc.; see generally, Liu, *Regulatory Copyright*, *supra* note 31; Shyamkrishna Balganesh, *Copyright as Legal Process: The Transformation of American Copyright Law*, 168 U. PA. L. REV. 1101 (forthcoming 2020).

law, despite its statutory nature, relies heavily in places upon common law development.⁹³

Whatever the reasons for this shift, the opinion in *Georgia v. PRO*, combined with some of the other recent Court cases on copyright law, suggest that the Court may be moving to a more constrained and narrow view of its own role in interpreting the Copyright Act, one that is at odds with the text, structure, and history of copyright law in general.

⁹³ Along these lines, the Court's decision in *Stewart v. Abend*, 495 U.S. 207 (1990), is a nice example of an opinion that straddles these two statutory eras. The Court in that case had to decide how the 1909 Act's renewal provisions affected the ability of assignees to exploit derivative works based on the original copyrighted work. At the same time, the Court had to decide how, if at all, the 1976 Act's new termination provisions affected this same question.