

## Commentary

### Copyright Law and the Restoration of Beauty

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THÉBERGE v. GALERIE D'ART DU PETIT CHAMPLAIN (*Théberge*)<sup>1</sup> has long struck me as perfectly poised to raise textbook issues of what is a “copy.” The case arose out of the purchase of an authorized poster whose ink was then chemically removed (leaving the paper substrate blank); subsequently, the ink was transferred to a canvas without the copyright holder’s permission. The Supreme Court of Canada’s opinion included the memorable line denying that “Canadian copyright law lives in splendid isolation from the rest of the world”<sup>2</sup> (a fitting launching pad for some transnational observations), and also cited Professor David Vaver’s scholarly works.<sup>3</sup> Professor Vaver’s retirement from Oxford University therefore provided the happy occasion to exhume the file and finally commit my ruminations on *Théberge* to paper.<sup>4</sup>

But a funny thing happened on the way to the filing cabinet. Pack rat that I am, limitless detritus of past decades presented itself, relating to almost every country on earth, and raising a myriad of copyright conundrums. But nowhere to be found were all the snippets that I had laboriously collected regarding Canadian cases.

So I started to resign myself to the unhappy fate of having been foiled again—until a mental light bulb flashed, and the trap into which I had fallen

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1. [2002] 2 S.C.R. 336 [*Théberge*].

2. *Ibid.* at para. 6.

3. *Ibid.* at para. 30. Crucially, Justice Binnie quotes Professor Vaver on the need for balance in copyright interpretation—a theme to which the thoughts below often recur. See also Teresa Scassa, “Originality and Utilitarian Works: The Uneasy Relationship Between Copyright Law and Unfair Competition” (2004) 1 U. Ottawa L. & Tech. J. 53 at 59.

4. Of course, it is an added privilege to be able to pay tribute to him in the Osgoode Hall Law Journal, given David’s longtime attachment to this institution.

manifested itself:

(a1) I wished to praise Justice Binnie for setting the Court on the path of decoupling the copyright holder's right from its maximalist conception. The right to "multiply copies" is not violated when the owner sells one authorized copy (a poster) that later finds itself (via a special resin or laminating liquid)<sup>5</sup> made into a different copy (canvas)—even if that latter had not been specifically authorized—when there is still only one copy extant in the universe;<sup>6</sup>

(a2) That ruling forms part of the larger framework of copyright, where protection does not attach to particular material objects, but instead inheres in conceptual types, regardless of the particular substrate in which they might happen to be embodied;<sup>7</sup>

(b1) I was going to conclude that my plans to honour David with an appropriate article had been frustrated by the disappearance of all my notes regarding Canadian copyright law;

(b2) Meaning that I was effectively elevating the substrate over the conception.

"This is too extravagant to be maintained,"<sup>8</sup> I said to myself, reinvigorated in my desire to compose.

Ahead I plowed. Though my past writings have inevitably drawn me to Professor Vaver's scholarship,<sup>9</sup> I had never allowed myself the pleasure of a sustained reading of his accumulated works. A thing of beauty it was! Perfectly does his oeuvre meet the definition that Robert Grosseteste propounded in the Middle

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5. *Théberge*, *supra* note 1 at para. 33.

6. A useful summary of the ruling in *Théberge* is: "In copyright, as in biology, reproduction usually means adding one more unit to the species beyond what existed before." David Vaver, "Need Intellectual Property Be Everywhere?: Against Ubiquity and Uniformity" (2002) 25 Dal. L.J. 1 at 4 [Vaver, "Against Ubiquity and Uniformity"].

7. This is a point that I myself have elaborated. See David Nimmer, "Copyright in the Dead Sea Scrolls" (2001) 38 Hous. L. Rev. 1 at 98–100.

8. *Marbury v. Madison*, 5 U.S. (1 Cranch) 137 at 149 (1803).

9. See *e.g.* David Vaver, "Moral Rights Yesterday, Today and Tomorrow" (2000) 7 Int'l J.L. & Info. Tech. 270 at 275, cited in David Nimmer, "The Moral Imperative Against Plagiarism (Without a Moral Right Against Reverse Passing Off)" (2004) 54 DePaul L. Rev. 1 at 19, n. 96.

Ages:<sup>10</sup> “For beauty is a concordance and fittingness of a thing to itself and of all its individual parts to themselves and to each other and to the whole, and of that whole to all things.”<sup>11</sup>

How pointed is the contrast with copyright doctrine, which suffers at present from a severe absence of fittingness to itself and of all its individual parts. Concordance is markedly absent in its whole and in its relationship to all things.

Recent copyright litigation in my own home district is emblematic. At issue was not something brand new, but a technology whose copyright status had seemingly been resolved: video cassette recorders (VCRs).<sup>12</sup> The Chief Executive Officer (CEO) of Turner Broadcasting testified that VCRs which allow ad skipping amount to “theft,” gilding that thought with the pronouncement that: “Any time you skip a commercial ... you’re actually stealing the programming.” When the interviewer inquired, “What if you have to go to the bathroom or get up and get a Coke?” the grudging concession emerged: “I guess there’s a certain amount of tolerance for going to the bathroom.”<sup>13</sup>

Maximalist sentiments of that nature are so overstated that they call into question the noble ends that copyright law is designed to serve.<sup>14</sup> If turning on a television obligates the viewer to the extent that the call of nature must find excuse via special pleading in the guise of fair use, then copyright law itself is headed for the toilet.<sup>15</sup> Happily, though, an antidote to those sentiments exists:

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10. Our honoree stands little risk of getting a *Fat Head*, citations to *Grosseteste* notwithstanding. Note that, like our honoree, the latter taught at Oxford, albeit during the 1229-30 term (one imagines that their paths seldom intersected).
  11. Umberto Eco, *Art and Beauty in the Middle Ages* (New Haven: Yale University Press, 1986) at 48.
  12. See *Sony Corp. v. Universal City Studios Inc.*, 464 U.S. 417 (1984) [*Sony v. Universal*].
  13. Brief of Amici Curiae Civil Liberties and Consumer Groups in support of Defendants’ Objections to Magistrate Judge’s Discovery Order at 3, n. 5, *Paramount Pictures Corp. v. ReplayTV, Inc.*, No. CV 01-09358 (C.D. Cal. 13 May 2002).
  14. David Vaver, “Publishers and Copyright: Rights Without Duties?” (2006) 40 *Bibliotheksdienst* 743 at 749. “Rights without responsibility are wonderful things, especially for monopolists.”
  15. All of this is not to deny that philosophical lessons can emerge from television technology. With due respect to the CEO of Turner Broadcasting, though, they lie in domains far afield from potty breaks. Umberto Eco imagines that light signals reflected by a mirror “can in some way be ‘dematerialized’ and then recomposed at their destination.” Umberto Eco, *Kant and the Platypus* (Orlando: Harcourt, 1997) at 371. Those musings correspond in gross form to the magic technology that the Supreme Court of Canada confronted in *Théberge*. But Eco goes further, to posit that: “[t]his is what happens with the television image. The television

it is the Vaverian prescription.<sup>16</sup> We will reach it presently.<sup>17</sup>

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Sadly, the statement by Turner Broadcasting's CEO is not an isolated turn toward the vulgar in copyright jurisprudence. Around the same time that it was put into evidence in Los Angeles, a district court in Chicago<sup>18</sup> preliminarily enjoined distribution of *Pull My Finger Fred*, a figure "lounging in a chair that has a vibrating fart and makes scatological cliches when his finger is pulled."<sup>19</sup> It turns out that neither plaintiff nor defendant pioneered this exalted genre,<sup>20</sup> which the trial court traced back to Emile Zola in 1887.<sup>21</sup>

But none of this would come as a surprise to Professor Vaver, who adeptly illustrates from another common law jurisdiction:

The concept of indirect copying was graphically illustrated in the early 1970s in New Zealand when the manufacturer of a toilet pan connector sued another manufacturer for infringing copyright by copying the plaintiff's connector—and won. Here was déjà-vu all over again, for was it not Marcel Duchamp who, in a turn-of-the-century art exhibition in New York, shocked the art world by exhibiting an upside down urinal as a piece of art? Duchamp's ghost must have been smiling as he gazed down on a judge in an Auckland courtroom, solemnly admitting a toilet pan connector into the New Zealand Pantheon.<sup>22</sup>

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can be seen as an electronic mirror that shows us what is happening at distances that our sight could not otherwise reach." *Ibid.*

16. Thus does Professor Vaver immunize himself from the accusation, often hurled against academics of the tenured variety, of writing articles "to convince skeptical colleagues they are still alive and breathing." David Vaver, "Copyright and the State in Canada and the United States" (1996) 10 I.P.J. 187 at 193, n. 13 [Vaver, "Copyright and the State"].
17. En route, it is worth pausing to reflect that the executive's ruminations about bathroom breaks is of a piece with David Vaver's imagination when he conjured up "an artist [who] takes the *Copyright Act* and, after copying it, proceeds to do unspeakable things to it in the name of art." *Ibid.* at 201.
18. *JCW Invs. Inc. v. Novelty Inc.*, 222 F. Supp.2d 1030 at 1034-35 (N.D. Ill. 2002).
19. *Ibid.* at 1034.
20. *Ibid.* at 1030 (recounting an earlier radio sketch using the same elements).
21. *Ibid.* at 1030, 1036 (*La Terre* features a farting peasant in the French countryside named, of all things, "Jesus-Christ").
22. David Vaver, "Creating a Fair Intellectual Property System for the 21st Century" (2001) 10 Otago L. Rev. 1 at 8 [Vaver, "Fair Intellectual Property System"]. See also J. Alex Ward, "Copyrighting Context: Law for Plumbing's Sake" (1993) 17 Colum.-V.L.A.J.L. & Arts 159.

Much of the problem stems from the seemingly unlimited range of products that can claim copyright protection. In the United States, recent years have witnessed cases seeking copyright protection for a bewildering variety of productions:

- the design of go-kart tracks at an amusement park;<sup>23</sup>
- a self-propelled agricultural sprayer;<sup>24</sup>
- the disposable paper inserts used in plastic picture frames;<sup>25</sup>
- “header bags” used in supermarkets, featuring “a meat design, corn design, fish design, and bakery design”;<sup>26</sup>
- a dinette containing a table and chairs, plus bar stools;<sup>27</sup>
- the labels used on tanning products;<sup>28</sup>
- the Voice, which later identified itself as Jesus,<sup>29</sup> that gave “rapid inner dictation” to a clinical psychologist at Columbia Presbyterian, filling thirty stenographic notebooks;<sup>30</sup>
- the marketing plan for “‘Rumba Caribbean Bar & Cuisine,’ which was intended to capture Puerto Rican traditions and folklore through food, drinks, salsa music and dance”<sup>31</sup>; and so on.<sup>32</sup>

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23. *Fun Spot of Florida Inc. v. Magical Midway of Central Florida Ltd.*, 242 F. Supp.2d 1183 at 1186 (M.D. Fla. 2002) (granting partial motions for summary judgment; not reaching a remedy).
24. *Walker Mfg. Inc. v. Hoffmann Inc.*, 261 F. Supp.2d 1054 (N.D. Iowa 2003) (denying summary judgment on the copyright and reverse palming off/unfair competition claims; not reaching copyright remedies).
25. *Baker v. Urban Outfitters, Inc.*, 254 F. Supp.2d 346 at 348 (S.D.N.Y. 2003), aff’d mem., 249 Fed. Appx. 845 (2d Cir. 2007) [*Baker*] (resolution discussed below).
26. *Cannon Group Inc. v. Better Bags Inc.*, 250 F. Supp.2d 893 at 895, 897 (S.D. Ohio 2003). (granting summary judgment and validating the copyright infringement claim; not reaching a remedy).
27. *Collezione Europa U.S.A., Inc. v. Hillsdale House Ltd.*, 243 F. Supp.2d 444 at 448 (M.D.N.C. 2003) [*Collezione*] (granting summary judgment and validating the copyright subsistence; not reaching a remedy).
28. *S&L Vitamins, Inc. v. Australian Gold, Inc.*, 521 F. Supp.2d 188 (E.D.N.Y. 2007) (dismissing the copyright claim, and thereby rendering the remedy issue moot).
29. It was presumably the Real McCoy, not the character created from *La Terre*. See *supra* note 21.
30. Because the psychologist was embarrassed by the visitation, she kept the work a secret to preserve her professional reputation. *Penguin Books U.S.A., Inc. v. New Christian Church of Full Endeavor, Ltd.*, 288 F. Supp.2d 544 at 548 (S.D.N.Y. 2003) (invalidating the copyright and dismissing the copyright claim, and thereby rendering the remedy issue moot). See also *Penguin Books U.S.A. Inc. v. New Christian Church of Full Endeavor, Ltd.*, 262 F. Supp.2d 251 (S.D.N.Y. 2003).

Going back a few years more, we can see that such cases as those complaining of copying tanning labels are not at all distinctive: *Quality King Distribs., Inc. v. L'Anza Research Int'l, Inc.*<sup>33</sup> was a case that reached the US Supreme Court in which the plaintiff sought copyright protection for the labels affixed to “shampoos, conditioners, and other hair care products.”<sup>34</sup> The decision below had ruled in favour of the copyright owner, allowing it to bar importation of the items bearing the infringing label.<sup>35</sup> The Supreme Court reversed the decision—but not out of any consideration that copyright protection is somehow deficient when attached to a label. Instead, its reasoning had to do with the interplay of the doctrines of exhaustion and importation in the context of gray market goods.<sup>36</sup>

We have not yet reached the dystopia of a copyright claim over the stylized word: *COPYRIGHT*<sup>37</sup> (an extreme-stance situation that Professor Vaver was moved to adopt in response to the baleful example of an English court granting copyright protection to a pedestrian business letter “comprising all of three perfectly ordinary sentences that would have made any literary stylist blench”).<sup>38</sup> But we are not necessarily far away.<sup>39</sup>

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31. *Rodriguez v. Casa Salsa Rest.*, 260 F. Supp.2d 413 at 415 (D.P.R. 2003) [*Rodriguez*] (dismissing the copyright claim, and thereby rendering the remedy issue moot).
32. Although the foregoing cases are all recent, the trend itself is not necessarily so. Consider also those who have sought protection for:
- the phrase “most personal sort of deodorant.” See *Alberto-Culver Company v. Andrea Dumon, Inc.*, 466 F.2d 705 (7th Cir. 1972);
  - the instructions for using “pizza stones,” which are rocks claimed to give “pizza prepared at home the same texture and flavor as pizza cooked in a professional brick oven.” See *Sassafras Enterprises, Inc. v. Roshco, Inc.*, 889 F. Supp. 343 at 344 (N.D. Ill. 1995) [*Sassafras*];
  - a pharmaceutical machine used to place medicinal pills into blister packs. See *Gemel Precision Tool Co. v. Pharma Tool Corp.*, 35 U.S.P.Q.2d 1019 (E.D. Pa. 1995) [*Gemel*].
33. 523 U.S. 135 (1998) [*Quality King*].
34. *Ibid.* at 138.
35. *L'Anza Research International, Inc. v. Quality King Distributors, Inc.*, 98 F.3d 1109 (9th Cir. 1996).
36. For a discussion, see Melville B. Nimmer & David Nimmer, *Nimmer on Copyright*, looseleaf (New York: Matthew Bender & Company, 1963) vol. 2, § 8.12[B][6][c] [*Nimmer on Copyright*].
37. David Vaver, “Rejuvenating Copyright” (1996) 75 Can. Bar Rev. 69 at 75, n. 15 [Vaver, “Rejuvenating Copyright”].
38. *Ibid.* at 74.
39. A photographer, for instance, sought exclusive rights in photographs of naked babies against

Indeed, “once short business letters written in commercialese and internal office memoranda qualify as original literary works, the gates are flung open to admit anything into the fold. Business forms, contracts drawn by lawyers, answers to puzzles, any collocation of symbols meaningful to someone, are called original literary works.”<sup>40</sup> Thus has copyright law become a catch-all for everything from bags to bar stools.

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We have already moved into the Vaverian prescription:

If copyright is there to encourage the production of work that would not be produced without this incentive, then this test should straightforwardly be applied to works for which copyright is claimed. The result would no doubt be to exclude a large quantity of work: not just trivial correspondence and simple drawings, but probably much industrial design. We know that firms all over the world kept producing new designs and other innovations even when no law protected them against copying. They were content to gain a competitive edge by being first in the market with their new product. Giving long protection in fact discourages innovation, since firms now have an incentive to rest on their laurels for the duration of the copyright instead of diverting time and money into investing in a continuous innovation programme.<sup>41</sup>

Our mantra can be that “a fair scheme would ensure that intellectual property deserves its ‘intellectual’ epithet and is not a cover for protecting the trivial, the ephemeral, and the opportunistic.”<sup>42</sup>

Thus armed, we can attempt to hack away from copyright’s core those trivial and opportunistic elements that do not belong. Books, movies, sculptures, and other traditional forms of expression all remain welcome. But such products as tanning labels and picture frame inserts—perhaps the essence of ephemera—can be, if not courteously ushered out the door, then at least relegated to a domain

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a white background. “Given the impermissibly expansive nature of Gentieu’s claims,” Judge Shadur noted dryly, “it is only surprising that she has not asserted a copyright in the universe of babies as well.” *Gentieu v. Tony Stone Images/Chicago, Inc.*, 255 F. Supp.2d 838 at 859 (N.D. Ill. 2003).

40. David Vaver, “Some Agnostic Observations on Intellectual Property” (1991) 6 I.P.J. 125 at 145 [Vaver, “Agnostic Observations”] (The result is “that legislatures all over the world felt unable to resist the ultimate reductionist logic, pressed on them by the computer industry, to classify and protect computer programs in their electronic state as literary works: invisible, unreadable, utilitarian—but literary nonetheless”).

41. Vaver, “Fair Intellectual Property System,” *supra* note 22 at 10.

42. *Ibid.* at 15.

where their presence will not choke the proper development of protection for the core items enumerated above.

Indeed, this lament regarding the expansion of American copyright cases to such matters as a self-propelled agricultural sprayer arises from the same considerations that occasioned Professor Vaver to lament the English decision whereby a newspaper commits copyright infringement by publishing stills taken from a surveillance camera. “Do we believe that the use of surveillance cameras would drop if such films had no copyright at all? Perhaps the films should be protected for reasons of privacy; but, if so, should not privacy be protected directly, rather than obliquely and erratically through copyright?”<sup>43</sup> At the end of the day, those willy-nilly expansions have led us to “what might be called the intellectual crisis of intellectual property.”<sup>44</sup>

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The solution to the crisis is to return beauty to copyright law. The aim here, one must hasten to add, is not to draw aesthetic judgments. Justice Holmes’s admonition remains pointed: “It would be a dangerous undertaking for persons trained only to the law to constitute themselves judges of the worth of pictorial illustrations.”<sup>45</sup> Anyone tempted to doubt that wisdom should simply take note of the English copyright case that attempted to offer various views on what constitutes “art.”<sup>46</sup> The results were “not surprisingly, not one is able to agree with any of the five members on the panel.”<sup>47</sup>

So, if aesthetics are not the goal, wherein does beauty lie? We must recall that “copyright and patent laws are not isolated and immutable pieces of legislation.”<sup>48</sup> Instead, they are rife for scrutiny to weigh whether their means achieve the intended aims.<sup>49</sup> What we need is a sensible difference between how various works are treated when all claim the copyright mantle.

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43. David Vaver, “Intellectual Property: State of the Art” (2000) 116 Law Q. Rev. 621 at 631 [Vaver, “State of the Art”].

44. *Ibid.* at 627.

45. *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239 at 251 (1903).

46. *George Henscher Ltd. v. Restawhile Upholstery (Lancs.) Ltd.*, [1976] A.C. 64, cited in Vaver, “Agnostic Observations,” *supra* note 40 at 133.

47. Vaver, “Agnostic Observations,” *ibid.*

48. *Ibid.* at 153.

49. *Ibid.* (“To the extent that our society seeks some semblance of social justice, intellectual property laws, as an important and growing part of that vision, cannot escape scrutiny”).

On the one hand, people buy books to read them, rent movies to view them, and stream songs to listen to them. In those domains, copyright acts to protect the expression that the public values. It is appropriate, therefore, to afford those works the full panoply of copyright law's protections (limited, of course, by all its exceptions).<sup>50</sup> We can call copyright in this context *inherently expressive*.

Different considerations apply, by contrast, to the expansive line of cases cited above, in which the copyright can be called *incidental* to the purpose for which the plaintiff wields it. Let us start with the marketing plan for a "Rumba Caribbean Bar & Cuisine." As a collocation of words, the "Market Study for a Hypertheme Restaurant in San Juan" deserves protection.<sup>51</sup> But the plaintiff in that case did not file suit to prevent copying of the wording of his plan. Instead, he sought to shut down the Casa Salsa restaurant in South Beach, Florida.<sup>52</sup> The same considerations apply to the blueprints used to create a pharmaceutical machine used to stuff medicinal pills into blister packs.<sup>53</sup> As a graphic work, the markings on the blueprint deserve protection. Again, however, the plaintiff did not wish to prevent copying of the blueprints; instead, it sought to prevent any competitor from manufacturing a rival pharmaceutical machine.

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A few more words are needed regarding the distinction between suits that seek to vindicate the *expressive* value of a work versus those that deploy the copyright only for some *incidental* purpose. Let us start with the copyrighted text on the label for a tanning product. In contrast to a novel, which is purchased by readers who wish to experience its content, we may presume that customers at the cosmetics counter are not after the joy afforded by the sparkling prose and literary devices used to describe the lotion. At most, they are after the uncopyrightable information about proper dosages and application techniques, blithely unconcerned with any alliteration or synecdoche with which they may be expressed.

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50. To cite but two examples, the proprietor enjoys exclusive rights to its work—but not to prevent fair use by members of the public. *Copyrights*, 17 U.S.C. § 107 (2006). By the same token, the owner can treat its copyright as its own property—but not in a manner that violates antitrust laws. See *Nimmer on Copyright*, *supra* note 36 at vol. 4 § 13.09[B].

51. *Rodriguez*, *supra* note 31 at 415.

52. *Ibid.* at 415-16.

53. *Gemel*, *supra* note 32.

The same considerations would seem to apply to images of artichokes emblazoned on rolls of plastic bags. Customers may reach for them for the purpose of wrapping a dozen peaches; however, that goal differs fundamentally from the impulse that causes the selection of a pleasing photograph or painting at a gallery.

In short, copyright, at its core, may involve high-brow, middle-brow, or even low-brow works of expression. It remains true to its core justification when that expression is desired (regardless of its aesthetic merit). But it departs from its core purpose when the only desire is to bag produce or to procure Sun Protection Factor # 25 to lather on the skin. If copyrightable content passes in those latter contexts, it is entirely accidental to the consumer's focus and desire. In short, copyright arises there only incidentally.

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The problem of incidental copyright protection is particularly pronounced in the case of the tanning label. Indeed, *SmithKline Beecham Consumer Healthcare, L.P. v. Watson Pharms., Inc.*<sup>54</sup> took note of the generic problem arising out of copyright protection for labels:<sup>55</sup>

Although commercial labeling is clearly copyrightable, it has been recognized that the “danger lurking in copyright protection for labels is that the tail threatens to wag the dog—proprietary at times seize on copyright protection for the label in order to leverage their thin copyright protection over the text ... on the label into a monopoly on the typically uncopyrightable product to which it is attached.”<sup>56</sup>

“Used in that fashion, the copyright serves ‘primarily as a means of harassing competitors,’ and thus fails ‘nine times out of ten.’”<sup>57</sup>

In *SmithKline* itself, the plaintiff obtained copyright over the label used to market Nicorette-brand gum, an aid used to quit smoking. Such aids are marketable only with permission from the Food and Drug Administration (FDA) of the US government.<sup>58</sup> Previously, *SmithKline* had a patent that offered it the exclusive ability to market the gum. After the patent expired, it proceeded

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54. 211 F.3d 21 (2d Cir.), cert. denied, 531 U.S. 872 (2000) [*SmithKline*].

55. *Ibid.* at 29, n. 5 [citations omitted].

56. *Nimmer on Copyright*, *supra* note 36, vol. 1, § 2.08[G][2].

57. *Ibid.*, vol. 1, § 2.08[G][2], quoting *Sassafras*, *supra* note 32 at 345, 348.

58. *Smithkline*, *supra* note 54 at 23.

against its competitor under copyright law.<sup>59</sup> But the putative copyright violation was for disseminating the same labeling with the gum—which pertinent FDA regulations required!<sup>60</sup> As the Second Circuit recognized, “the copyrighted text was submitted to obtain FDA approval”<sup>61</sup> and, as a result, conveyed market exclusivity.

When copyright law is used to prevent a competitor from selling a rival gum, opening a rival restaurant, building a rival machine, or selling a rival tanning product—regardless of the implicated expression—then it is being used for an ugly purpose, indeed. Focusing on the first case, when a customer wants medicinal gum, and the only way to sell that gum is to use particular expression, then the goals of copyright law do not favour denying the customer that gum. The situation stands fundamentally apart from a customer who wants to hear a particular song; in that instance, someone who purveys the song without authorization has provided the customer with the expression that she wants, thereby sensibly invading the domain that copyright law was intended to protect.

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By now, the tail wagging the dog (as described above) has become a “familiar scenario.”<sup>62</sup> It is particularly familiar on the Canadian scene, given a successor to *Theberge*, namely *Euro-Excellence Inc. v. Kraft Canada Inc.*<sup>63</sup> This case exhibits what I like to call the age-old struggle between the Greek *nomos* and *logos*—but with a modern twist.<sup>64</sup> First, though, some words of background.

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59. That stance promiscuously mixes the genres: “Copyright protects persons who work in garrets, patents protect those who work in basements.” Vaver, “Agnostic Observations,” *supra* note 40 at 130, n. 5.

60. In other words, during the period of SmithKline’s patent protection, it had the exclusive right to sell Nicorette gum, along with the labeling that it had created for that purpose and which had received FDA approval. After expiration of the patent, anyone could sell Nicorette gum—which is exactly what Watson did. But, under FDA regulations, the gum had to be accompanied by the safety information contained in the approved labeling, which could not be altered.

61. *SmithKline*, *supra* note 54 at 29, n. 5 [citations omitted].

62. *Sassafras*, *supra* note 32 at 345. The defendant avoided infringement by altering the precise language that described its competitive pizza stone, which possessed the same features as the plaintiff’s. Note that this is the case quoted by *SmithKline*, *supra* note 54.

63. [2007] 3 S.C.R. 20 [*Euro-Excellence*].

64. See Carl Schmitt, *The Nomos of the Earth in the International Law of Jus Publicum Europaeum* (New York: Telos Press, 2003) at 342 (noting that Cicero translated *nomos* as *lex* and

We have already encountered *Quality King*, the US Supreme Court case about labels attached to shampoo bottles purchased abroad in the gray market. *Euro-Excellence*, for its part, deals with Côte d'Or and Toblerone chocolate bars imported into Canada after purchase abroad in the gray market, likewise bearing labels subject to copyright protection. Both the US Supreme Court and the Supreme Court of Canada reversed the judgment below in favour of the plaintiff copyright owner, based on their readings of the scope of direct and secondary liability in the context of gray market goods (the manufacture of which, by definition, is authorized by the pertinent copyright owner, but outside the relevant jurisdiction). But it is not that aspect of the rulings that warrants comment here.

Let us start with the approach of Justice Bastarache (joined by Justices LeBel and Charron). Building on the objectives of the *Copyright Act*<sup>65</sup> as articulated in *Théberge*<sup>66</sup> and subsequent cases,<sup>67</sup> he concluded:

[I]f a work of skill and judgment (such as a logo) is attached to some other consumer good (such as a chocolate bar), the economic gains associated with the sale of the consumer good must not be mistakenly viewed as the legitimate economic interests of the copyright holder of the logo that are protected by the law of copyright. ... Thus s. 27(2)(e) [of the Canadian *Copyright Act*] is meant to protect copyright holders from the unauthorized importation of works which are the result of their skill and judgment. It is not meant to protect manufacturers from the unauthorized importation of consumer goods on the basis of their having a copyrighted work affixed to their wrapper, this work being merely incidental to their value as consumer goods. ... The laws of trade-mark and passing off provide protection to manufacturers who fear the importation of cheap imitations of their products with a copy of the logo of the real product affixed to them.<sup>68</sup>

How is the line to be drawn? Justice Bastarache conceded that it will not always be easy to determine when a work is merely incidental to consumer goodwill, but posited that: "If a reasonable consumer undertaking a commercial trans-

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postulating that: "The connection between *logos* and *nomos* meant that the *logos*, as something lacking passion and thus reason, was placed above the instinctive and emotional character of the human individual"). See also Fred Lawrence, "David Novak on Natural Law: An Appraisal" (1999) 44 Am. J. Juris. 151 at 158 (invoking "the classical passage from conventional *nomos* to explanatory *logos*").

65. R.S.C. 1985, c. C-42.

66. *Euro-Excellence*, *supra* note 63 at 76.

67. *Ibid.* at paras. 80-81.

68. *Ibid.* at paras. 85-87.

action does not think that the copyrighted work is what she is buying or dealing with, it is likely that the work is merely incidental to the consumer good.”<sup>69</sup>

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Onward to the promised struggle.

*Nomos*, according to the first line of the *Harvard Law Review*'s 1982 round-up of Supreme Court cases, connotes “a normative universe.”<sup>70</sup> But that is not the sense implied here. Rather, the term has been domesticated, by which I mean that it has been brought into the house. The Greek roots for “house” (*oikos*) and “custom” (*nomos*) combine (*oikonomos*) to yield a common English word: *economics*. That term (together with its cognates) recurs thirty-five times in the various opinions in *Euro-Excellence*. Indeed, the crux of the disagreement among the justices boiled down to disparate views of “legitimate economic interests”—a phrase drawn from *Théberge*.<sup>71</sup>

*Logos*, according to the first line of the *Gospel of John*, connotes The Word (Incarnate). But that is not the sense implied here. Rather, it is simply the plural of logo, the emblem of a commercial brand. A logo is the subject matter of purported copyright in *Euro-Excellence*.

The “economy of logos” perfectly maps the issue presented. Justice Bastarache elaborates that a t-shirt emblazoned with the reproduction of a painting may constitute the sale of a copyrighted work—and distinguishes that situation from the sale of a t-shirt bearing a small logo on the shirt pocket.<sup>72</sup> He nicely illustrates the distinction between incidental and inherently expressive works. In the latter case, the logo is simply incidental to the shirt that the customer wants. In economic terms, the logo serves the classic trademark function of letting the consumer know the origin of the goods. By contrast, if the customer wants to display the painting (by wearing it or otherwise), she presumably wishes to do so for its expressive content. In that context, she is not choosing the painting by reference to the source of origin of the goods (though that concern might separately animate her purchasing decision).

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69. *Ibid.* at para. 94.

70. Robert Cover, “Nomos and Narrative” (1983) 97 Harv. L. Rev. 4. Professor Cover notes that the Septuagint translated “Torah” into Greek as “nomos.”

71. *Euro-Excellence*, *supra* note 63 at paras. 7, 8, 76, 79-81.

72. *Ibid.* at para. 95.

Sometimes, however, the customer wants the logo precisely for its expressive content. Imagine that Major League Baseball has licensed Fun Industries to sell t-shirts of every member team. A customer who wishes to purchase a t-shirt emblazoned with the logo of the Toronto Blue Jays values the t-shirt for its expressive context, and will not be equally satisfied with one emblazoned with the logo of the Los Angeles Dodgers (even if legitimately manufactured by Fun Industries).<sup>73</sup> In that context, the logo deserves copyright protection no less than the painting. In short, the logo's content is hardly incidental in that context. Again, the "economy of logos" captures this distinction. Justice Bastarache distills the essence of the matter when noting that "a copyrighted instruction booklet included in the box of some consumer good would, as copyrighted work, be merely incidental to the good."<sup>74</sup> His conclusion follows inexorably:

[T]he protected works in question—the Côte d'Or and Toblerone logos, considered as copyrighted works—cannot be seen as anything other than merely incidental to the chocolate bars to which they are affixed. Therefore, Euro-Excellence's dealings with the chocolate bars are not caught within the language of s. 27(2) of the Act.<sup>75</sup>

This is not to deny the copyrightable status of the logos; the plaintiff would have prevailed if it had complained about a sale of posters of the logo.<sup>76</sup> But Justice Bastarache drew the necessary distinctions "to ensure that this legitimate copyright protection is not illegitimately leveraged into a protection for a market in consumer goods."<sup>77</sup>

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73. One particular piece of litigation in the United States over the usage of logos of a sports team in that manner has been protracted, implicating myriad doctrines of copyright law. See *Bouchat v. Baltimore Ravens, Inc.*, 228 F.3d 489 (4th Cir. 2000), amended, 241 F.3d 350 (4th Cir. 2001), cert. denied, 532 U.S. 1038 (2001), on remand, 215 F. Supp.2d 611 (D. Md. 2002), 327 F. Supp.2d 537 (D. Md. 2003), aff'd, 506 F.3d 315 (4th Cir. 2007), cert. denied, 128 S. Ct. 2054 (2008).

74. *Euro-Excellence*, *supra* note 63 at para. 95.

75. *Ibid.* at para. 99.

In this appeal, the logos, considered as copyrighted works, are inarguably best described as merely incidental to the chocolate bars themselves. It cannot be reasonably maintained that in the course of a commercial transaction in which a customer buys a Côte d'Or or a Toblerone chocolate bar from a merchant, the customer is actually paying for a copyrighted work. This is not a situation in which the copyrighted work, as such, is an important aspect of the consumer transaction: it is a logo on a wrapper for a product which serves to identify the product's origins, nothing more.

76. *Ibid.* at para. 103.

77. *Ibid.* His analysis does not deny (at para. 104)

Notwithstanding my own encomium set forth above, the opinion of Justice Bastarache did not win approval from a majority of the Supreme Court in *Euro-Excellence*. In particular, Justice Abella, writing in dissent (and joined by Justice McLachlin), took issue with it fundamentally.<sup>78</sup> Even the majority opinion, authored by Justice Rothstein, sets forth its reasons at the outset for rejecting the approach of Justice Bastarache.<sup>79</sup> Although conceding that disallowing protection for “incidental works” harmonizes well with Australian copyright law, the majority saw no warrant for reading that distinction into the handiwork of the Canadian Parliament.<sup>80</sup>

Ironically, the majority opinion was joined by Justices Binnie and Deschamps.<sup>81</sup> Thus, I find myself in the position of simultaneously celebrating Justice Binnie’s focus on “legitimate economic interests” in *Théberge* and lamenting his limitation of that doctrine in *Euro-Excellence*. Which is the better statutory interpretation of the words enacted in Ottawa, I leave to others. My point here is to approve on policy grounds the initial thrust of Justice Binnie in *Théberge* and extended by Justice Bastarache in *Euro-Excellence*: copyright policy should value inherent expression and, in the process, devalue incidental utilizations, without placing it wholly outside copyright protection on that basis. Beauty lies in that realization. More power to Canberra, if its legislature is the only one to formalize that distinction to date.

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the possibility—indeed, the certainty—that the logos, as trade-marks, can play a large role in the sale of the chocolate bars and are of great value to KCI. It is not disputed that part of the reason that a consumer buys a Côte d’Or bar or a Toblerone bar is because of the reputation and goodwill associated with each brand. But that is not a consideration which is relevant under the *Copyright Act*. It cannot be reasonably maintained that anyone buys a Côte d’Or or Toblerone because of the logos as works of art.

78. *Ibid.* at para. 111.

To inject an exception for logos on the basis that they are “incidental” would be to introduce unnecessary uncertainty, inviting case-by-case judicial explorations into the uncharted area of what is “merely” incidental, “somewhat” incidental, or not incidental at all. Such an approach also takes insufficient account of the reality that many products are, to a significant extent, sold on the basis of their logo or packaging.

79. *Ibid.* at para. 1. Justice Rothstein went on to say: “I see no statutory authority for the proposition that ‘incidental’ works are not protected by the *Copyright Act*” (at para. 4).

80. *Ibid.* at para. 5.

81. One should add that the majority opinion, like *Théberge* before it, cites to *Vaver*. See *ibid.* at para. 26. In fact, this later case even cites to *Nimmer on Copyright*. See *ibid.* at para. 43.

Given the glut of copyright litigation arising at the periphery of desired expression, as exemplified by all of the cases cited above, some relief is in order. The relief that is needed is to limit the available remedies. Copyright holders who bring suit to vindicate protection for such matters as the design of their go-kart tracks are not seeking the moral victory of a judgment in their favour. Instead, their goal is to benefit in the real world. That benefit typically takes two forms: monetary recovery and injunctive relief.

Let us begin by looking at the former domain. When we examine the US cases canvassed above, ranging from the go-kart to the Caribbean Bar, an interesting phenomenon emerges. Under current law, cases with plaintiffs who attempt to wield copyrights *incidentally* for collateral benefits do not result in meaningful financial recovery. Indeed, those cases, with one exception, have actually resulted in no damages at all.<sup>82</sup>

The sole exception is *Collezione Europa U.S.A., Inc. v. Hillsdale House, Ltd.*<sup>83</sup>—the case that involved the copying of a dinette set. That opinion validated copyright protection for the designs at issue, holding them to pass the *Copyright Act's* separability test.<sup>84</sup> Inasmuch as the defendant, for all intents and purposes, copied those designs identically, the court upheld the plaintiff's claim, which then proceeded to the damages stage.

It should be noted that *Collezione Europa* filed suit not to prevent Hillsdale House from selling furniture, but rather to stop it from selling the exact design that the plaintiff had originated. As such, this suit properly<sup>85</sup> arose to vindicate the *expressive* ingredients of the copyright, not the *incidental* purpose of interfering with the defendant's business outside that expressive realm. This case furnishes the exception that therefore proves the rule.

Further vindication for the rule that cases alleging copyright infringement *incidentally* do not financially benefit their proponents emerges from *Baker v.*

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82. See *supra* notes 23-32.

83. *Collezione*, *supra* note 27.

84. Under US law, a "useful article" cannot obtain copyright protection unless it contains elements that are separable from its utilitarian features. Depending on the law of the applicable circuit, that separability may be either physical or conceptual. See *Nimmer on Copyright*, *supra* note 36, vol. 1, § 2.08[B][3].

85. A background issue exists as to whether copyright law should extend into the arena of industrial designs. If not, then this result is unfortunate on that basis. But that domain is analytically separate from the matter currently under investigation, *viz.* the distinction between expressive and incidental invocations of copyright protection.

*Urban Outfitters, Inc.*<sup>86</sup>—the case that involved frame inserts. In that instance, the plaintiff was not truly concerned with any appropriation of the expressive elements that it had imbued into those disposable inserts. It is doubtful, to say the least, whether any customers had bought frames because of the aesthetic appeal of those inserts, which were headed for the trash as soon as the purchasers were able to display photos of their own daughters blowing out candles.

The plaintiff, Kent Baker, prevailed on his copyright claim, demonstrating the sale of 862 unlicensed inserts, on which the defendant earned gross profits of \$3,896. Baker's past practice was to license such uses for less than \$100. The court initially granted partial summary judgment to limit damages to a maximum of \$3,896.<sup>87</sup> Then, because of Baker's "contumacious and disruptive" behaviour, the court awarded Urban Outfitters \$20,000 for opposing Baker's meritless motions.<sup>88</sup> Ultimately, Judge Preska awarded the defendant almost \$400,000 in fees under the *Copyright Act*, plus additional sums on other bases.<sup>89</sup> She reached that determination to deter future plaintiffs from figuring "that they can score big if they win and that there will be no adverse consequences if they lose."<sup>90</sup> Most telling in that regard was the statement by the plaintiff's agent to the plaintiff's lawyer that "his case is 'great' because it involves 'a lot of *STUPID*,<sup>91</sup> obstinate, deep pocketed, WILLFUL INFRINGERS."<sup>92</sup>

Viewed from this perspective, the law has done a decent job of preventing windfalls to plaintiffs who seek to benefit from *incidental* enforcement of their copyrights. Why, then, have such cases continued to proliferate?

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The answer is that the plaintiffs count on the presumption that they will win injunctive relief if they prevail. Under those circumstances, the pain to the defen-

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86. *Baker*, *supra* note 25.

87. *Baker*, *supra* note 25 at 359.

88. *Baker v. Urban Outfitters, Inc.*, 431 F. Supp.2d 351 at 356 (S.D.N.Y. 2006) [*Baker* (2006)].

89. *Ibid.* at 358.

90. *Ibid.* at 359.

91. The discerning will recognize that stylization as a thinly-veiled rip-off of the celebrated Vaverian *COPYRIGHT*. See text accompanying note 37. If not consciously copied, it evidences, at a minimum, *cryptomesia*. See *e.g.* Vaver, "Agnostic Observations," *supra* note 40 at 131, n. 7.

92. *Baker* (2006), *supra* note 88 [emphasis and capitalization in original].

dant of complying with the injunction will be too great, and the plaintiff will have won itself a “blank cheque.” In a case arising from the label on tanning butter, the plaintiff typically is not honestly seeking to impose new verbiage on the defendant’s rival label. Instead, the plaintiff is banking on the fact that an injunction against further distribution of the product bearing the offending label will prove ruinous to the defendant, to the extent that it already has in the pipeline hundreds of thousands of canisters pressed with the subject label.<sup>93</sup>

Historically, that was a safe bet, for courts have routinely ruled that “a prevailing copyright holder is *entitled* to a permanent injunction.”<sup>94</sup> In other words, once a plaintiff prevailed in an infringement case, the entry of an injunction became automatic. Moreover, all that the plaintiff needed to obtain a preliminary injunction pending resolution was the likelihood of prevailing at trial.<sup>95</sup>

Accordingly, there was every incentive to file suit quickly. As long as the incidental usage of the copyright seemed likely to lead to judgment in favour of the plaintiff, the court’s equitable powers could be enlisted to obtain an injunction. Thereafter, the defendant’s only live option in many cases would be to salvage its marketing via the payment of vast tribute to the plaintiff. It was good business for lucky owners of copyrights that had been abused in ancillary fashion, such as appearing in the label for a popular tanning lotion.

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But success has not always been preordained. Some courts have rebelled against that construction.

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93. The most striking example of this phenomenon actually unfolded in a context involving an expressive, rather than an incidental, invocation of copyright. A Swiss artist complained that part of his imagery was used in Terry Gilliam’s film *12 Monkeys*. Although the infringing material occupied less than 5 minutes of the defendants’ 130-minute film, the district court ordered a preliminary injunction against its exploitation. See *Woods v. Universal City Studios, Inc.*, 920 F. Supp. 62 (S.D.N.Y. 1996). Inasmuch as prints had already been struck, it was impossible to meet the theatrical distribution schedule for the film consonant with an injunction, meaning that the artist obtained a blank cheque from the studio. It remains only to add the irony that the defendant, Gilliam, who argued in this case that any appropriation was minimal, is the same individual who had previously been a plaintiff shouting righteous indignation when Hollywood had dared to tamper with his own sacrosanct “Monty Python” television show. See *Gilliam v. American Broad. Cos.*, 538 F.2d 14 (2d Cir. 1976).

94. *Robinson v. Random House, Inc.*, 877 F. Supp. 830 at 844 (S.D.N.Y. 1995) [*Robinson*] [emphasis added]. See generally *Nimmer on Copyright*, *supra* note 36, vol. 4, § 14.06[B][1][a].

95. See generally *Nimmer on Copyright*, *ibid.*, vol. 4, § 14.06[A][2][c].

Consider *American Direct Marketing, Inc. v. Azad Int'l, Inc.* (*American Direct Marketing*), a case concerning competing tooth-whitening products.<sup>96</sup> If the defendant violated the plaintiff's trade dress, relief could be found on that basis. But, instead, the plaintiff alleged violation of the copyright of an insert to the product that was a trivial addition to its salability. The true purpose of the injunction sought by the plaintiff was to interfere with the defendant's sales of the underlying product, which was itself uncopyrightable.<sup>97</sup> The court declined to issue that remedy, instead stating: "the proper remedy for infringement of the copyright in the images on a package which has withstood a trade dress claim between the same parties is most likely a fee based on the shown value of the image."<sup>98</sup>

*American Direct Marketing's* resolution calls attention to the beauty of the common law's development of rules through successive cases. As authority for its approach, the opinion continued, "[t]he copyright statute allows but does not command injunctive relief."<sup>99</sup> At the time the court articulated that language, the statement flew in the face of typical pronouncements (noted above) that "a prevailing copyright holder is *entitled* to a permanent injunction."<sup>100</sup> But the court bolstered its conclusion by citing a slender line of cases that had picked up on the flexibility urged by *Nimmer on Copyright* in the 1980s, arguing that, under special circumstances, an injunction could be denied, and the plaintiff could be remitted to payment pursuant to what essentially amounted to a judicially ordered compulsory license.<sup>101</sup>

Lo and behold, that trickle of cases later became a tidal wave: in 2006, the US Supreme Court ruled, as a general matter, that copyright injunctions are not mandatory.<sup>102</sup> As a consequence, courts at present may order ongoing monetary payments in lieu of an injunction in all types of cases.<sup>103</sup> Accordingly, it is no

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96. 783 F. Supp. 84 (E.D.N.Y. 1992) [*American Direct Marketing*].

97. *Ibid.* at 96-98.

98. *Ibid.* at 97.

99. *Ibid.*

100. *Robinson, supra* note 94.

101. See *Nimmer on Copyright, supra* note 36, vol. 4, § 14.06[B][1][b].

102. *eBay Inc. v. MercExchange, L.L.C.*, 547 U.S. 388 (2006). See generally *ibid.*, vol. 4, § 14.06[B][1][c].

103. Some courts vociferously deny that they are ordering a "judicially-created compulsory license." *Christopher Phelps & Assocs. v. Galloway*, 492 F.3d 532 at 546 (4th Cir. 2007). I

longer revolutionary to rule that “the proper remedy for infringement of the copyright ... is most likely a fee.”<sup>104</sup>

I respectfully urge that the rule be generalized beyond *American Direct Marketing*-like cases of a defendant prevailing on trade dress grounds. Instead, the dividing line should be the one posited above, between claims intended to vindicate the *expressive* aspects of a copyrightable work, and those in which the copyright happens to be *incidental* to the complaint. In *American Direct Marketing*, the insert was strictly incidental; the plaintiff’s true goal was to inhibit the defendant from selling its rival tooth-whitening product. Given that such products stand outside copyright protection, the copyright infringement claim was essentially pretextual.

When *American Direct Marketing* articulated its standard, it had little precedential warrant. Today, its application can properly be applied across the board. Courts should now routinely withhold injunctive relief in all *incidental* copyright cases.

The *American Direct Marketing* experience shows the benefit of the common law tradition, by which US courts are free to craft the law according to their own notions of optimal results. Indeed, the pressures that arise in a common law system to find the appropriate solution under all circumstances are inevitably great:

[R]eal people live in copyrightable structures, get married in copyrightable garments, and discuss their most intimate life experiences in copyrightable prose. In a system rooted in equity that strives for justice (if only occasionally), those disparate circumstances cannot help but percolate into the structure of decision-making in the copyright arena. The myriad rules [of US copyright law] are accordingly subject to innumerable caveats and tailored loopholes, as judges in the common law system attempt to reconcile fidelity to Congress’ words and stare decisis with sensitivity to the actual litigants pleading their cases in concrete circumstances.<sup>105</sup>

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have urged that “a less defensive interpretation would be” to acknowledge that license for what it is. *Nimmer on Copyright, ibid.*, vol. 4, § 14.06[B][1][c].

104. As usual, David Vaver was ahead of the curve. Contemporaneous with the *Sony* ruling in the United States, a Canadian case suggested that refusing an injunction was “tantamount” to granting a compulsory license without statutory authority. *R. v. James Lorimer & Co.*, [1984] 1 F.C. 1065. Our friend criticized the Court of Appeal’s ruling as “nonsense.” Vaver, “Copyright and the State,” *supra* note 16 at 204, n. 48 (“But an injunction is always discretionary. On the court’s theory, any time an injunction is refused the court is issuing an unauthorized compulsory licence; which is nonsense”).

105. *Nimmer on Copyright, supra* note 36, vol. 1, Overview [citations omitted].

The phenomenon is not to be lamented, but celebrated. The strength of the common law system is its ability to find the solution appropriate to its precise circumstances. In turn, cross-system comparisons may deepen our knowledge: the solutions to problems before US courts inevitably differ from those adopted north of the border, as well as on the far side of the Atlantic or Down Under.

Happily, the considerations ventilated above help us in another way as well. They point out the way to restore beauty to at least one aspect of copyright law: to the extent that cases arise to vindicate not the expressive elements of a copyrightable work, but, instead, the incidental purposes, courts should routinely deny injunctive relief and should minimize the award of damages. Those expedients will presumably serve to minimize complaints alleging copyright infringement of most labels, header bags, frame inserts, and the like. Copyright law will instead be able to focus on its core purpose of protecting expression that human beings actually want.<sup>106</sup>

Two critiques of this distinction may arise: (1) it discriminates against certain types of copyright; and (2) it allows third parties to “free ride” with impunity on others’ efforts.

(1) In a sense, this proposal will benefit certain copyrights over others. That stance offends the egalitarian sensibilities that have arisen in common law countries with regard to copyright protection. As David Vaver notes, we tend to “treat copyright as a capacious church that admits almost anyone—sound recorders, broadcasters, cablecasters, even printers—into its congregation of ‘authors’ and anoints them all with a ‘copyright.’”<sup>107</sup> Discrimination is bad, so this type of prejudice has no place in a civilized system, the argument concludes.

That conclusion should be rejected. As Professor Vaver<sup>108</sup> himself recognizes, apropos of *Théberge*, “[u]biquity and uniformity are not always virtues in

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106. Of course, this solution is far from a panacea. One court protected computer software in a context when no human being wished to benefit from its expression. See *Ticketmaster L.L.C. v. RMG Techs., Inc.*, 507 F. Supp.2d 1096 (C.D. Cal. 2007). This writer has condemned that approach at length elsewhere. See *ibid.*, vol. 3, § 13.05[D][3][b]. But that particular conundrum would not be solved by distinguishing intrinsic from incidental utilizations. Instead, it is inherent in the very process of embracing computer software in the copyright ambit—a deficit which David Vaver has already called to our attention. Vaver, “Agnostic Observations,” *supra* note 40.

107. David Vaver, “The Copyright Mixture in a Mixed Legal System: Fit for Human Consumption?” (2001) 5 E.J.C.L. 2, online: <<http://www.ejcl.org/52/art52-3.html>>.

108. Vaver, “Against Ubiquity and Uniformity,” *supra* note 6 at 3.

law.”<sup>109</sup> Proceeding from the *aperçu* that “a step backwards is a step in the right direction if you are facing the wrong way to begin with,” he offers, “[w]e should start stepping backwards in the right direction. We should ask ourselves whether extra intellectual property (IP) protection is really needed, and, where it is not, repeal it.”<sup>110</sup>

Happily, the task at hand is easier. Far from needing to convene the legislature to repeal an existing statute, it simply involves concerted judicial action (in line with *American Direct Marketing* and similar precedents) to deny injunctive and large monetary relief to copyrights that are invoked incidentally rather than intrinsically. The current scheme of copyright protection, with all its attendant remedies, such as large monetary awards and the coercive force of an injunction, is the fruit of hundreds of years of development, largely aimed at such productions as printed books, theatrical motion pictures, and recorded music. Those remedial devices may work well in the paradigmatic cases for which they were designed; but, at the same time, they can be recognized as ill-suited for other applications along the lines of go-kart track blueprints.<sup>111</sup>

In other words, we need not go quite as far as “trimming copyright back to its traditional *belles lettres* and *beaux arts* vocation, while establishing a parallel *quasi* copyright system that is designed to protect investment in useful innovation.”<sup>112</sup>

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109. Our good don mobilizes the point to defend cross-border variations: “A nation should, within broad limits, be free to strike its own balance in its IP laws to suit its own circumstances: Fewer and more varied IP laws should be considered virtues, not vices.” *Ibid.* at 3. But so sensible is that perspective that this article applies it within one nation’s domestic scheme to variations between different species of copyrights, whenever the current scheme is “incoherent and morally indefensible.” *Ibid.*

110. *Ibid.* at 26.

111. Again, the antecedent is Vaverian, along two planes:

- (1) “It would be remarkable . . . if a system of protection introduced for books nearly three centuries ago is adequate for the task of stimulating desirable levels of production in the cultural sector today.” Vaver, “Rejuvenating Copyright,” *supra* note 37 at 76–77.
- (2) “Intellectual property rights have become more intense and all encompassing. Thus, starting modestly in the eighteenth century to control the unauthorised reprints of books, the law of copyright steadily grew to encompass partial reprints, then subtler forms of imitation and then expanded exponentially throughout the twentieth century. With each fresh logical step in one direction, a vista of new paths appeared and further steps were taken along them to intensify the rights.” Vaver, “State of the Art,” *supra* note 43 at 625.

112. Vaver, “Rejuvenating Copyright,” *supra* note 37 at 77.

Instead, we simply need to trim the remedies that are granted at the periphery in those instances where the value in the copyright inheres not in its intrinsic expression,<sup>113</sup> but instead arises adventitiously insofar as it is tethered to a business advantage.<sup>114</sup>

(2) What about the free ride that this proposal would allow second-comers on the header bags, frame inserts, and tanning labels laboriously developed by their predecessors? That cavil can be disposed of summarily: “Simply to ‘free-ride’ on another’s business efforts or investment is not wrong” in and of itself.<sup>115</sup> Or, as the US Supreme Court has phrased the matter, “[copyright] protection has never accorded the copyright owner complete control over all possible uses of his work.”<sup>116</sup> The courts of other nations likewise favour free competition<sup>117</sup> when there has been no overt trespass.<sup>118</sup>

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113. The distinction offered here is not simply between artistic and utilitarian works. See *e.g.* Scassa, *supra* note 3. A tanning label is presumably utilitarian, but may be used in a given context to exploit its expressive aspects, in which case it deserves as much protection as a work of great art.

114. To revert to the tanning label, its expression presumably falls short of *belle*, rendering it unlikely to become the *beau* of the ball. Yet, by itself, those considerations do not place it on either side of the current divide.

- If, as seems likely, consumers have no interest in the content of the label, and the manufacturer treats that content merely as information, then a lawsuit alleging its infringement can be placed on the *incidental* side of the ledger. Available remedies in that case are to be severely circumscribed.
- Nonetheless, expectations may be confounded. Perhaps the cosmetic company desires to turn the label into op art, or produces flyers that contain the label as an ode to kitsch or to celebrate business prose of an earlier era. It could be that empty canisters might even be sold as attractive sculptures. Should those hypothetical instances be realized, a subsequent infringement suit would arise on the *expressive* side.

In short, the label itself is not prejudiced by its failure to achieve literary and artistic prowess. The totality of the circumstances surrounding the work’s exploitation indicates whether the subject lawsuit should be treated as incidental or expressive.

115. Vaver, “Rejuvenating Copyright,” *supra* note 37 at 73.

116. *Sony v. Universal*, *supra* note 12 at 432.

117. Illustrative cases include the one with which we started. As an artist, M. Théberge claimed that the defendant had made “an abusive commercialization of my work, without authorization.” *Théberge*, *supra* note 1 at para. 20. Of course, as recited at the outset, the Supreme Court of Canada denied his claim.

118. “We were recently reminded of how deeply the principle of freedom to compete is engrained in the national psyche by some English litigation a few years ago, where a company claimed

But there has been exactly overt trespass, some may respond, in the cases of copied header bags and instructional labels. The answer to that point of view is that copyright “cannot be treated as an absolute value,” such that copying something is automatically viewed as trespass.<sup>119</sup> Indeed, we would not even invoke the label of trespass but for the notion that “intellectual property is property,” a circularity to which David Vaver has already sensitized us.<sup>120</sup>

The need for balance is paramount here. As Justice Binnie observed in *Théberge*, “excessive control by holders of copyrights and other forms of intellectual property may unduly limit the ability of the public domain to incorporate and embellish creative innovation in the long-term interests of society as a whole, or create practical obstacles to proper utilization.”<sup>121</sup>

Often throughout history, copyright has expanded. Contraction can be equally necessary<sup>122</sup> to achieve the proper social goal.<sup>123</sup>

The best line-drawing pays heed to balance and gains public respect for intellectual property laws.<sup>124</sup> Indeed, the alternative to achieving balance is “cyni-

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damages for various alleged business wrongs, including an act of unfair competition. In rejecting the suit, Justice Harman said that the claim amounted ‘to saying that there has been competition, and adding the old nursery cry “It’s unfair!” To that I would only cite my nanny’s great nursery proposition: “The World is a very unfair place and the sooner you get to know it the better.”’ Whereas the theories of John Maynard Keynes may come and go, the dicta of Sir Jeremiah Harman’s former nanny may indelibly leave their mark on judicial policy.” Vaver, “Fair Intellectual Property System,” *supra* note 22 at 5 [citations omitted].

119. Vaver, “State of the Art,” *supra* note 43 at 637.

120. *Ibid.* at 636. Justice McLachlin of the Supreme Court of Canada is quoted to similar effect in Fara Tabatabai, “A Tale of Two Countries: Canada’s Response to the Peer-to-Peer Crisis and What It Means for the United States” (2006) 73 *Fordham L. Rev.* 2321 at 2321 (“We must stop thinking of intellectual property as an absolute and start thinking of it as a function”).

121. *Théberge*, *supra* note 1 at para. 32. See Margaret Ann Wilkinson, “National Treatment, National Interest and the Public Domain” (2004) 1 *U. Ottawa L. & Tech. J.* 23 at 37.

122. “It is in the nature of the subject that intellectual property concepts have to evolve to deal with new and unexpected developments in human creativity.” *Théberge*, *supra* note 1 at para. 75.

123. Professor Vaver has already wickedly skewered the Eurotopia fantasy that if “copyright is good, ... then more copyright is even better.” David Vaver, “Copyright Developments in Europe: The Good, the Bad and the Harmonized” in Niva Elkin-Koren & Neil Weinstock Netanel, eds., *The Commodification of Information* (The Hague: Kluwer Law International, 2002) 223 at 225.

124. Vaver, “State of the Art,” *supra* note 43 at 637.

cism, disregard and avoidance.”<sup>125</sup> Copyright law needs to draw a line. On one side, full protection (subject to all applicable limitations and defenses) should continue to apply to works copied for the purpose of experiencing their expressive content. On the other, highly circumscribed remedies will be all that a plaintiff can hope to obtain when she seeks not to vindicate that expression, but to obtain advantage in a realm that is not itself subject to copyright protection.

Hopefully, this modest change will restore some lost beauty to copyright doctrine. If it does, the credit belongs to a lifetime of insights that emerge from David Vaver’s extraordinary corpus of copyright scholarship.

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125. *Ibid.*