

IN THE UNITED STATES COURT OF APPEALS  
FOR THE THIRD CIRCUIT

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SOUTHCO INC.,

Appellant,

v.

KANEBRIDGE CORP.,

Appellee.

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ON APPEAL FROM THE UNITED STATES DISTRICT COURT  
FOR THE EASTERN DISTRICT OF PENNSYLVANIA

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BRIEF AMICUS CURIAE OF THE UNITED STATES OF AMERICA  
IN SUPPORT OF APPELLEE KANEBRIDGE CORP.

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**STATEMENT OF INTEREST**

The United States has numerous responsibilities related to the proper administration of the intellectual property laws, and those responsibilities give it a substantial interest in the resolution of this appeal. When the Register of Copyrights determines that deposited material “constitutes copyrightable subject matter,” the Register must “register the claim and issue to the applicant a certificate of registration under the seal of the Copyright Office.” 17 U.S.C. § 410. The panel’s ruling regarding the possible copyrightability of product identification numbers is

contrary to a long-standing practice of the Copyright Office that bars registration of all part numbers and other short phrases. See 37 C.F.R. § 202.1(a) (barring registration of short phrases).<sup>1</sup> We submit this brief pursuant to the first sentence of Fed. R. App. P. 29(a) and Third Circuit Local Rule 29.1.

### **QUESTION PRESENTED**

Whether part numbers are copyrightable subject matter.

### **STATEMENT**

1. Copyright protection is available for “original works of authorship fixed in any tangible medium of expression.” 17 U.S.C. § 102(a). Among other rights, the owner of a copyright “has the exclusive rights” “to reproduce the copyrighted work.” 17 U.S.C. § 106. But the scope of copyright protection is limited: “In no case does copyright authorship extend to any idea, procedure, process, system, [or] method of operation \* \* \* regardless of the form in which it is described, explained, illustrated, or embodied \* \* \* .” 17 U.S.C. § 102(b). In particular, Section 103 makes clear that the “subject matter of copyright as specified by section 102 includes compilations,” but the “copyright in a compilation \* \* \* extends only to the

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<sup>1</sup> In an earlier appeal in this case (No. 00-1102), we filed a brief that addressed both the copyrightability of part numbers and whether use of part numbers in comparative advertising constitutes protected “fair use.” In view of this Court’s disposition of the current appeal, we direct this brief to the issue of copyrightability and rest on our prior submission regarding fair use.



material contributed by the author of such work, as distinguished from the preexisting material employed in the work.” 17 U.S.C. § 103.<sup>2</sup>

2. Southco manufactures and sells hardware, including “retractable captive-screw assemblies” designated as Southco’s “47” series of fasteners. JA 222. There are over 1,000 different 47 series fasteners. JA 222. Each item in this series is identified by a nine-digit number that begins with 47. JA 222. Since 1972, Southco has published Handbooks containing, among other things, the numbers associated with the hardware. JA 222 – 223. The Handbooks are registered with the Copyright Office. JA 223.

Kanebridge is a hardware distributor, selling to other distributors panel fasteners it obtains from a manufacturer, Matdan America Corp., but labels with its own part numbers, not Matdan numbers. JA 223. Kanebridge uses its own numbering system, but wants to do comparative advertising that lists Kanebridge numbered parts next to corresponding Southco numbered parts. JA 225 – 226.

Southco sued Kanebridge alleging copyright infringement. JA 23. Southco’s Complaint list 51 part numbers that Kanebridge allegedly copied. JA 24. “Southco

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<sup>2</sup> A “compilation” is defined as “a work formed by the collection and assembling of preexisting materials or of data that are selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes an original work of authorship.” 17 U.S.C. § 101.

argues its copyright in the part numbers entitles it to a complete ban against Kanebridge copying for any purpose.” JA 226. Southco also alleged Lanham Act violations, state law unfair competition violations, trademark infringement, and trademark dilution. JA 25 – JA 29.

Ruling only on the copyright claim, the district court (Norma Shapiro, S.D.J.) granted a preliminary injunction preventing Kanebridge from using Southco part numbers in any way. JA 243. The district court viewed the underlying issue in the case as “whether Kanebridge may use Southco numbers in comparison charts, or whether Kanebridge is prohibited from using Southco’s numbers in any way, at any time.” JA 226. The court concluded that “Southco is likely to succeed in establishing that its product identification numbers are copyrightable.” JA 232.

A panel of this Court (hereinafter, the “first panel”) reversed the preliminary injunction, holding that the part numbers are not protected. JA 244 – 258. The first panel distinguished the “numbering system itself” from “the actual numbers produced by the system.” JA 250. The first panel held that Southco’s part numbers “are examples of work that fall short of the minimal level of creativity required for copyright protection.” JA 251. The first panel emphasized that “there is only one possible part number for any new panel fastener that Southco creates” and that number “results from the mechanical application of the system, not creative

thought.” JA 252. Because Southco “has no likelihood of success in its infringement action,” the first panel held that the “entry of the preliminary injunction in its favor was not proper.” JA 258.

Returning to district court, Kanebridge moved for summary judgment to dismiss the copyright infringement claim. JA 274. In opposition, Southco submitted a declaration from Robert H. Bisbing. See JA 261 (filed under seal). The district court granted summary judgment for Kanebridge, stating that the Bisbing declaration related to the creation of the numbering system and therefore did nothing to show that assigning individual product numbers involved creative thought. JA 310 – 315.

Southco appealed. A different panel (hereinafter, the “second panel”) of this Court reversed. Southco, Inc. v. Kanebridge Corp., 324 F.3d 190 (3d Cir. 2003). In the second panel’s view, the Bisbing declaration raises a genuine issue of material fact that assigning product numbers to the retractable captive screw involved “creativity and choice.” Id. at 196. The Court ordered the case remanded to the district court for consideration of the Bisbing declaration.

## SUMMARY OF ARGUMENT

1. The federal intellectual property laws strike a careful balance between protecting, and thereby promoting, new intellectual work and encouraging the public to use new and existing intellectual knowledge. As relevant here, copyright law strikes this balance by protecting “original works of authorship fixed in any tangible medium of expression.” So long as a work is “original” – i.e., it has a modest amount of creativity – it is protected for an extended length of time against unauthorized copying. But work that displays less than a minimal amount of creativity is not protected, even if it is new. Moreover, the copyright protection extends only to the work’s “expression.” Ideas and facts, no matter how much creativity and effort went into their discovery, are not protected by copyright law. Although it may appear unfair that the public can copy uncreative work, new ideas, and newly discovered facts, the very purpose of intellectual property laws is to encourage just such copying. In so doing, the laws promote the “Progress of Science and useful Arts” that is the object of the Copyright and Patent Clause of the Constitution.

2. Under the longstanding practice of the Copyright Office, short phrases, including part numbers, are denied registration because they are not subject to copyright protection. Short phrases such as part numbers do not typically involve

sufficient creative expression to warrant granting the author the right to preclude copying of that phrase. Moreover, even a creative short phrase is not protected by copyright. As with ideas and facts, copyright law leaves unprotected all short phrases to allow the public to make use of the phrases. To the extent protection of a short phrase is necessary to avoid public confusion as to the source of a product, unfair competition and trademark laws may provide the necessary relief. Congress's decision not to disturb the Copyright Office's long-standing practice against registering short phrases, despite repeated and extensive revisions of the copyright code, establishes that Congress approves of the complete bar on short phrases.

3. In this case, Southco seeks copyright protection of individual part numbers. But part numbers are uncopyrightable short phrases. Moreover, the 51 individual parts numbers allegedly copied are not in the least bit creative. Instead, the part numbers are the result of the mechanical application of a set of rules to well-defined physical characteristics of a retractable captive-screw assembly. The Bisbing declaration relied on by the second panel concerns the expansion of Southco's nine-digit numbering system to create new rules for a new line of screws; it has nothing to do with the application of those new rules to a particular screw. The second panel also erred when it failed to distinguish between Southco's part numbers and

Southco's system for generating part numbers. To the extent Southco's part numbers are protectable, it is under unfair competition or trademark law. In any event, Southco cannot use copyright law to deprive the public of unhindered access to a string of numbers.

4. Both panels devote considerable attention to the Seventh Circuit's ADA case. In our view, that case, like other cases discussed by the parties, is best understood as holding that copyright protection can extend to an original compilation of numbers. Although a compilation of part numbers can be registered, the copyright protection extends only to the arrangement and selection of part numbers. It does not extend to the part numbers themselves.

## **ARGUMENT**

### **SOUTHCO'S PART NUMBERS ARE NOT PROTECTED BY COPYRIGHT**

#### **A. Authors Enjoy Extraordinary Protections During The Life Of The Copyright, But That Protection Is Limited To Original Works**

The Nation's copyright and patent systems reflect a precise calibration of private and public legal rights designed to “promote the Progress of Science and useful Arts.” See Bonito Boats, Inc. v. Thunder Craft Boats, Inc., 489 U.S. 141, 150-151 (1989); Eldred v. Ashcroft, 123 S. Ct. 769, 786 (2003). Article I, § 8, cl. 8, of the Constitution authorizes Congress to “promote the Progress of Science and

useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.” Accordingly, to encourage innovation, the copyright and patent laws grant the creators of works that qualify for a patent or copyright an exclusive right to use and benefit from their works for a period of years. See 17 U.S.C. § 301-305; 35 U.S.C. § 154. But on expiration of a patent or copyright, the creation inures to the public, which is generally entitled to copy it and profit from its use. See TraFFix Devices, Inc. v. Marketing Displays, Inc., 532 U.S. 23, 29 (2001); Harper & Row Publishers, Inc. v. Nation Enters., 471 U.S. 539, 545 (1985).

In copyright law, the careful elaboration of private and public rights includes whether the work is one of sufficient original expression to warrant protection. Protection of an unoriginal expression would do nothing to “promote the Progress of Science and useful Arts.” To the contrary, by making it difficult or impossible to use expressions that were previously available, such protection would hinder new intellectual work. Accordingly, the Supreme Court has long interpreted the terms “Authors” and “Writings” to “presuppose a degree of originality.” Feist Publ’ns, Inc. v. Rural Tel. Serv. Co., Inc., 499 U.S. 340, 345 (1991), citing Trade-Mark Cases, 100 U.S. 82, 94 (1879) (“while the word *writings* may be liberally construed \* \* \* it is only such as are *original*, and are founded in the creative powers of the

mind”) and Burrow-Giles Lithographic Co. v. Sarony, 111 U.S. 53, 58-59 (1884) (copyright limited to “original intellectual conceptions of the author”). For purposes of copyright law, a work is not original unless it “possesses at least some minimal degree of creativity.” Feist, 499 U.S. at 345.<sup>3</sup> Moreover, even if a work as a whole has sufficient creativity to be protectable, the law’s concern for promoting public use of existing intellectual knowledge limits that protection to “those components of a work that are original to the author.” Id. at 348.

In addition to the requirement of a minimal amount of creativity, the balance struck by the copyright laws extends protection only to expressions and does not protect the ideas or facts contained therein. Baker v. Selden, 101 U.S. 99 (1879). Arguably, protection of a new idea or newly discovered facts would “promote the Progress of Science and useful Arts” by providing incentives for those valuable activities. But the copyright right law does not so hold. Although denying copyright protection to new ideas or newly discovered facts “may seem unfair,” it “encourages others to build freely upon the ideas and information conveyed by a work.” Feist, 499 U.S. at 349-350. “This principle, known as the idea/expression

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<sup>3</sup> An early example of a case in which the requisite amount of creativity was found lacking is Higgins v. Keuffel, 140 U.S. 428 (1891). There, copyright protection was sought for a label describing the contents of a bottle of ink. Citing the Trademark Cases, the Court held that the label lacked sufficient “value as a composition” to warrant protection. Id. at 431.



or fact/expression dichotomy, applies to all works of authorship.” *Id.* at 350. See, e.g., *Eldred*, 123 S. Ct. at 787 (“A reader of an author’s writing may make full use of any fact or idea she acquires from her reading. See § 102(b).”).

### **B. All Short Phrases, Including Part Numbers, Are Excluded From Copyright Protection**

In this case, the carefully crafted balance between private copyright protection and public use of works focuses on the exclusion of “short phrases” from copyright protection. A short phrase such as a part number typically lacks any creativity whatsoever. To provide copyright protection to a part number, therefore, would hinder “the Progress of Science and useful Arts” by denying the public ordinary access to a string of numbers. To the extent some legal protection of a short phrase is necessary to avoid public confusion of the source of a commercial product, protection is provided by the laws of trademark and unfair competition.

The Copyright Office’s “practice of denying registration to words and phrases dates back at least to 1899.” 1 W. Patry, *Copyright* 333 n. 89 (1994). In 1958, the Copyright Office issued Circular No. 46, titled Copyright In Commercial Prints and Labels. The circular explained that “[t]o be entitled to copyright protection, a work must contain something capable of being copyrighted – that is, an appreciable amount of original text or pictorial material.” “Brand names, trade names, slogans,

and other short phrases or expression cannot be copyrighted, even if they are distinctively arranged or printed.” (A copy of Circular No. 46 is included in the addendum to this brief.)

Soon thereafter, the Copyright Office first published its short-phrases regulation. The regulation, issued under 17 U.S.C. § 702, currently provides:

§ 202.1 Material not subject to copyright.

The following are examples of works not subject to copyright and applications for registration of such works cannot be entertained:

- (a) Words and short phrases such as names, titles, and slogans; familiar symbols or designs; mere variations of typographic ornamentation, lettering or coloring; mere listing of ingredients or contents;
- (b) Ideas, plans, methods, systems, or devices, as distinguished from the particular manner in which they are expressed or described in a writing;
- (c) Blank forms, such as time cards, graph paper, account books, diaries, bank checks, scorecards, address books, report forms, order forms and the like, which are designed for recording information and do not in themselves convey information;
- (d) Works consisting entirely of information that is common property containing no original authorship, such as, for example: Standard calendars, height and weight charts, tape measures and rulers, schedules of sporting events, and lists or tables taken from public documents or other common sources.
- (e) Typeface as typeface.

37 C.F.R. § 202.1 (emphasis added).

The regulation was immediately endorsed by the Second Circuit in Kitchens of Sara Lee, Inc. v. Nifty Foods Corp., 266 F.2d 541, 544 (2d Cir. 1959). There, a copyright was sought on standard instructions on “how to serve” a cake. In rejecting

that claim, the Second Circuit quoted the above regulation and described it as a “fair summary of the law.” *Ibid.* Accord, e.g., Alberto-Culver Co. v. Andrea Dumon, Inc., 466 F.2d 705, 711 (7th Cir. 1972) (applying Sara Lee, holding “most personal sort of deodorant” an “ordinary phrase” lacking “appreciable amount of original text” and therefore not protected by copyright); CMM Cable Rep, Inc. v. Ocean Coast Properties, Inc., 97 F.3d 1504, 1519 (1st Cir. 1996) (“It is axiomatic that copyright law denies protection to ‘fragmentary words and phrases’ and to ‘forms of expression dictated solely at functional considerations’ on the grounds that these materials do not exhibit the minimal level of creativity necessary to warrant copyright protection.”) (holding unprotectable “if you’re still ‘on the clock’ at quitting time” and “clock in and make \$50 an hour”); Murray Hill Publ’ns, Inc. v. ABC Communications, Inc., 264 F.3d 622, 633 (6th Cir. 2001) (holding unprotectable “Good morning, Detroit. This is J.P. on JR in the A.M. Have a swell day.”).

Relying on short phrases regulation, the Register of Copyrights routinely determines that a part number does not “constitute[] copyrightable subject matter.” 17 U.S.C. § 410. For the Court’s information, we attach two publicly available letters from the Examining Division of the Copyright Office that illustrate the Copyright

Office's treatment of requests to register part numbers.<sup>4</sup> In the first letter, the Examining Division rejects a first appeal from a request to register the parts price list of Conway Technologies. The price list contains three columns: part numbers, a two or three word description, and a suggested price. In rejecting the request to register the "text" of the work, the Examining Division explained that short phrases are not protected because they lack a sufficient amount of creative expression. The Examining Division noted the availability of a "compilation" copyright registration, but explained that it would "not extend to the part numbers, part prices, and short descriptive phrases." See Letter of Nov. 16, 2001 from Virginia Giroux, Attorney Advisor, Examining Division, to Marsha Gentner (reproduced in the addendum to this brief). In the second letter, the Examiner initially rejects a request to register part number KP2062-3 for a drag cup. Letter of May 19, 2003 from Doris V. Berry, Examiner, Literary Section, to Mr. Floyd (reproduced in addendum).

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<sup>4</sup> When an examiner rejects an application for registration, the applicant may appeal that decision. The first appeal is handled in the Examining Division, by the Examining Division's staff attorney. She consults with the Chief of the Examining Division in each case. The applicant (usually through counsel) writes a letter brief arguing why registration should have been made. An applicant whose application is rejected on first appeal may seek a second appeal, which is decided by an Appeals Board consisting of the Register, the General Counsel, and the Chief of the Examining Division (or their designees). See Notice of Policy Decision; Modification of Appeal Procedure, 60 FR 21983 (May 4, 1995).

The contrary rule – finding that a part number may “constitute[] copyrightable subject matter” – does not make sense. To accord copyright protection to part numbers would be to accord copyright protection to a particular sequence of numbers regardless of their use. Unlike trademark law, copyright law’s protection is not limited to particular contexts. The owner of a copyright “has the exclusive rights” “to reproduce the copyrighted work.” 17 U.S.C. § 106. If part numbers were protected, any reproduction of that number – in a computer program, in a math problem, in a lottery number – would potentially infringe the copyright if the author had access to the copyright work. Although the fair use defense could (and, if necessary, should) be used to exonerate the use, parties should not be forced to prove an affirmative defense to copyright infringement for the mere use of numbers. See generally Smithkline Beechum Consumer Healthcare, I.P. v. Watson Pharmaceuticals, Inc., 211 F.3d 21, 29 n.5 (2d Cir. 2000) (the “danger lurking in copyright protection for labels is that the tail threatens to wag the dog – proprietors 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 [unprotectable] product to which it is attached”) (citation omitted).

Moreover, we note that the Copyright Office will not register even a creative short phrase. Circular 34 (June 2002) (available at <http://www.copyright.gov>

/pubs.html) provides further elaboration of the Copyright Office’s practice regarding short phrases. In particular, the circular explains that “[e]ven if a name, title, or short phrase is novel or distinctive or if it lends itself to a play on words, it cannot be protected by copyright.” In other words, even a creative short phrase is not protected by copyright. See also Compendium of Copyright Office Practices, Compendium II, § 305 (“short phrases or expressions are not copyrightable, even if such expressions are novel”). Just as ideas and facts are not protected by copyright in order that the public may use this information, so too all short phrases, even creative ones, are not protected so that the phrases are available for the public to use.

Instead of copyright law, short phrases, at least when used in association with commercial products, are appropriately handled under trademark law. Circular 46 notes that “[u]nder certain circumstances, a name, slogan, phrase, symbol, or label may be entitled to protection under the general rules of law relating to unfair competition, or to registration under the federal trademark law.” Likewise, Circular 34 explains that short phrases may be entitled to protection “under the general rules of law relating to unfair competition, or they may be entitled to protection and registration under the provisions of state or federal trademark laws.” The circular notes that the “federal trademark statute covers trademarks and service marks –

those words, phrases, symbols, or designs that identify the source of the goods or services of one party and distinguish them from those of others.”

Congress’s decision not to disturb the Copyright Office’s long-standing practice against registering short phrases, despite repeated and extensive revisions of the copyright code, establishes that Congress approves of the complete bar on short phrases. When Congress was considering substantially revising the copyright laws before 1976, it recognized that short phrases would continue to be outside of copyright protection. See H.R. Rep. No. 90-83, at 14-15 n.1 (1967) (describing “other areas of existing subject matter that this bill does not propose to protect but that future Congresses may want to” and including in the list of “areas of subject matter now on the fringes of literary property but not intended, solely as such, to come within the scope of the bill[:] ...titles, slogans, and similar short expressions”). Congress’s acquiescence in the longstanding administrative rule against registering short phrases reflects Congress’s approval of the rule. See J.E.M. AG Supply, Inc. v. Pioneer Hi-Bred Int’l, Inc., 534 U.S. 124, 145 (2001) (noting that Congress was long aware of the Patent & Trademark Office’s practice of issuing utility patents on plants which “suggests a recognition on the part of Congress” that the practice was authorized by statute).

To be sure, Nimmer on Copyright suggests that “even a short phrase may command copyright protection if it exhibits sufficient creativity.” 1 Melville B. Nimmer & David Nimmer, Nimmer on Copyright, § 2.01[B] (2000). But, in view of the Copyright Office’s long-standing practice and the availability of trademark protection, that is not how the Copyright Office interprets the copyright laws, an interpretation entitled to due weight. See generally De Sylva v. Ballentine, 351 U.S. 570 (1956) (deference to the Copyright Office's interpretation of ambiguous provisions in the copyright statutes is ordinarily warranted); Morris v. Business Concepts, Inc., 283 F.3d 502 (2d Cir. 2002) (granting panel rehearing, finding persuasive Copyright Office’s view in Circular No. 62 – concerning registration of a serial – despite contrary statement in Nimmer on Copyright).

### **C. Southco Cannot Obtain Copyright Protection For Its Part Numbers**

The question presented by this case is whether Southco’s part numbers are protected by copyright law. “To establish infringement, two elements must be proven: (1) ownership of a valid copyright, and (2) copying of constituent elements of the work that are original.” Feist, 499 U.S. at 361. Here, the allegation is that Kanebridge unlawfully copied 51 part numbers. JA 24. Southco expressly seeks copyright protection for each individual part number. PB (No. 00-1102) at 13 (“[e]ach Southco part number is an original, unique, codified, composition \* \* \*”),



16 (“They are covered individually \* \* \* .”). For that reason, the district court framed the issue as “whether Kanebridge is prohibited from using Southco’s numbers in any way, at any time,” JA 226, and concluded that “Southco is likely to succeed in establishing that its product identification numbers are copyrightable.” JA 232. Accordingly, as the first panel correctly held, “given Southco’s allegations, the proper focus of our analysis must be on the actual part numbers.” JA 251.

The 51 individual parts numbers that Kanebridge allegedly copied are not protected by copyright law. Under the practice of the Copyright Office, all part numbers are denied registration because they are uncopyrightable short phrases. The source of the part numbers and the process by which they are derived are of no consequence. Short phrases, typically uncreative, cannot gain copyright protection. And where, as here, the short phrase at issue – mechanically generated part numbers – lacks any creativity whatsoever, the utility of the ban on short phrases is well-illustrated.

The 51 individual parts numbers do contain any creativity; “47-10-202-10” possesses no creative spark. The district court’s opinion makes clear that this string of digits is the product not of a creative “act of authorship,” Feist, 499 U.S. at 347, but rather of the mechanical application of a set of rules to well-defined physical characteristics of a retractable captive-screw assembly. The parts numbers “convey

specific properties of the products manufactured [and] are assigned based on the properties of the parts.” JA 232. This assignment is not left to human judgment: “Southco assigns numbers based on a system designed over twenty years ago and refined ever since.” *Id.* The result is that “each part number tells the story of a part’s size, finish, and utility.” *Id.* Thus, “[a]ny person, once familiar with the Numbering System, can identify a product based on the content and arrangement of its product number.” JA 230. In other words, each part number is determined by the characteristics of the part and the content of the rules; any creativity in assigning a number would defeat the purpose of the Numbering System, “a language, communicating functional details of the hardware it describes.” JA 223. Nothing in the assignment of a number to a particular part suggests “the existence of\* \* \* intellectual production, of thought, and conception,” *Feist*, 499 U.S. at 362, quoting *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 59-60 (1884), no matter how much thought and conception went into designing or refining the Numbering System.

The Bisbing declaration does not change this analysis. Bisbing’s declaration “discussed his invention of a new type of captive screw.” 324 F.3d at 193 (emphasis added). His testimony concerns the expansion of Southco’s nine-digit numbering system to a new line of screws. As the district court noted, Southco’s Numbering

System “is expandable as new products are developed;” “[a]s new products are introduced, new nine-digit part numbers are created.” JA 223, 229. In essence, Bisbing’s declaration describes a “subsystem” developed according to the rules of the Numbering System and applicable only to a new line of screws. See PB at 21 (describing Mr. Demrick’s testimony) (“numbering system would have to be expanded to accommodate those new characteristics”). The declaration does not describe any expression – i.e., the numbers in a particular part number. Indeed, the subsystem was by necessity complete before a single part number was actually generated by the system. His declaration, therefore, cannot show any creativity in assigning particular part numbers.

The second panel also erred when it failed to distinguish between Southco’s part numbers and Southco’s system for generating part numbers. Southco correctly concedes that it can gain no copyright in its numbering system. JA 250 n.6; PB at 34 (“Southco itself disclaimed any claim of copyright in that system”). Copyright law protects expression, not the “idea” that is expressed. Baker v. Selden & 17 U.S.C. § 102(b). See Andrien v. Southern Ocean County Chamber of Commerce, 927 F.2d 132, 134 (3d Cir. 1991) (“Copyright is available only for the expression of a work of authorship, not for a mere idea.”). Accordingly, it is always necessary in a copyright case to focus on the “expression” – here, the particular numbers –

rather than on the “idea” – here, the numbering system – that generates the expression. Cf. Toro Co. v. R&R Prods. Co., 787 F.2d 1208, 1213 (8th Cir. 1986) (suggesting in dicta that a non-arbitrary part numbering “system” could be original, but failing to apply Baker v. Selden & Section 102(b)). Of course, not every expression is protected by copyright. But no idea is.

Instead of copyright law, Southco’s claims would appear to sound more appropriately in unfair competition or trademark law. Five out of Southco’s six counts are claims under these non-copyright laws. See JA 26 – 28 (Counts II, III & IV, Lanham Act violations); JA 26 (Count V, state unfair competition claim), JA 29 (Count VI, unregistered trademark claim). For example, Southco claims that its “part numbers for retractable screw fasteners are inherently distinctive” and have acquired “secondary meaning signifying Southco.” JA 27. To be sure, “[s]ubject matter used solely as a model, style or grade designation within a product line does not function as a trademark.” U.S.P.T.O. Trademark Manual of Examining Procedure, Model or Grade Designations, § 1202.10 (3rd Edition, rev. May 2003). But if a part number becomes associated with the source of the product, then trademark protection may be available to avoid customer confusion. See 15 U.S.C. § 1125(a). Compare, e.g., In re Dana Corp., 12 U.S.P.Q.2d 1748 (T.T.A.B. 1989) (alphanumeric designations, such as “5-469X,” held unregistrable for universal joint

couplings; evidence insufficient to establish distinctiveness and recognition as a mark), with In re Petersen Mfg. Co., Inc., 229 U.S.P.Q. 466, 468 (T.T.A.B. 1986) (letter-number combinations found registrable for locking hand tools, the Board stating, “[T]here is no question that such model designations can, through use and promotion, be perceived as marks indicating origin in addition to functioning as model designations.”).

In any event, Southco cannot obtain copyright protection for a string of numbers. By claiming copyright in individual part numbers, Southco asserts that it has exclusive rights to reproduce and distribute a series of digits. If such protection is recognized, any person who reproduces that series of digits and who can plausibly be alleged to have had access to Southco’s Handbook runs the risk that he will be sued for copyright infringement. For example, if a Southco customer who makes networking equipment happens to use digits that are also in Southco’s Handbook to represent its own data networking chassis, a prima facie case of copyright infringement would exist based on that customer’s mere reproduction of those digits and its access to Southco’s parts handbook. Nothing in copyright law provides a defense based on the fact that the customer’s products are very different from captive fasteners or that the use of the same number was not based on the use of Bisbing’s numbering system. If the number is protected expression, copying of

that number is copyright infringement. Although the fair use defense could (and, if necessary, should) be used to exonerate the customer, parties should not be forced to prove an affirmative defense to copyright infringement for the mere use of numbers. See generally Wal-Mart Stores, Inc. v. Samara Bros., Inc., 529 U.S. 205, 215 (2000) (“[c]ompetition is deterred, however, not merely by successful suit but by the plausible threat of successful suit \* \* \*”).

**D. A Compilation Copyright Would Not Protect Individual Part Numbers**

Both panels of the Court devote considerable attention to American Dental Association v. Delta Dental Plans Ass’n, 126 F.3d 977 (7th Cir. 1997). There, the copied work was a “taxonomy” of the American Dental Association. The book classified dental procedures into groups; each procedure received a number, a short description, and a long description. The defendant “used most of the Code but made modifications.” 126 F.3d at 981. The Seventh Circuit ruled that “even the short description and the number are original works of authorship.” In the court’s view, “all three elements of the Code – numbers, short descriptions, and long descriptions, are copyrightable subject matter under 17 U.S.C. § 102(a).” Id. at 979.

The ADA case is best understood as a “compilation” case.<sup>5</sup> A “taxonomy” was almost entirely copied. The ADA panel made clear that “Section 102(b) precludes the ADA from suing, for copyright infringement, a dentist whose office files record treatments using the Code’s nomenclature.” 126 F.3d at 981. In recording those treatments, the dentist could presumably copy individual ADA procedure code numbers onto an invoice for services rendered, but not be liable for copyright infringement. The panel noted that its holding merely precluded copying of the “entire” Code. 126 F.3d at 980. To be sure, the ADA panel expressly stated that it was not holding that the taxonomy was a protected “compilation.” 126 F.3d at 980. But that was based on the mistaken view that a compilation must include “elements” that “existed independently.” Ibid. The statutory definition of compilation also includes collections of “data” (17 U.S.C. § 101), a term that includes dental procedure numbers.<sup>6</sup>

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<sup>5</sup> Many of the other cases discussed by the parties and the panels are compilation cases. See, e.g., CCC Info. Servs., Inc. v. Maclean Hunter Mkt. Reports, Inc., 44 F.3d 61, 72 (2d Cir. 1994), cert. denied, 516 U.S. 817 (1995) (copying of “virtually the entire compendium” rather than “copying of a few entries from a compilation”); Victor Lalli Enterprs., Inc. v. Big Red Apple, Inc., 936 F.2d 671, 672 (2d Cir. 1991) (“compilation of information gleaned from horse racing statistics”).

<sup>6</sup> Moreover, even if the case is read to protect an individual code, the ADA case made no mention of the “short phrases” doctrine. The short phrases doctrine was not directly relevant to the case because it involved copying of the entire treatise.  
(continued...)

Consistent with ADA and other cases, the Copyright Office will register a compilation of part numbers. See Compendium of Copyright Office Practices, Compendium II, § 307.02 (“Telephone books, directories, price lists, and the like may be registered if they contain sufficient authorship in the form of compilation or other copyrightable material.”); Copyright Office, Examining Division, Literary Online Practices, chap. 20 C.II. A.1.a. [2003] (defining a “compilation of data” as a “compilation of facts, terms, etc., in which there could be no separate copyright protection (e.g., parts catalogs, phone directories, real estate listings, prices lists, some genealogies).”). For example, the letter from the Examining Division concerning the Conway parts list notes that a compilation copyright was available. But the letter also noted that the compilation copyright would not extend to the “text” – i.e., the part numbers – contained in the compilation.

\* \* \*

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<sup>6</sup>(...continued)

But to the extent the Seventh Circuit’s dicta suggests that an individual number is protected, the court showed no awareness of the short phrases doctrine. Nor did we submit an amicus brief to the Seventh Circuit. Likewise, the Tenth Circuit did not mention the short phrases doctrine in suggesting that the command codes in Mitel, Inc. v. Iqtel, Inc., 124 F.3d 1366 (10<sup>th</sup> Cir. 1997) would have been creative enough to warrant copyright protection but for their functional uses.



## CONCLUSION

For the foregoing reasons, the Court should affirm the district court.

Respectfully submitted.

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## **CERTIFICATE OF COMPLIANCE WITH TYPE VOLUME LIMITATION**

I certify that this Brief Amicus Curiae of the United States of America complies with the applicable type volume limitation, determined pursuant to Rules 29(d) and 32(a)(7)(B) of the Federal Rules of Appellate Procedure. Exclusive of cover, captions, table of contents, table of authorities, and signature block, it contains 5,885 words, as counted by the word-processing system used to prepare this brief.

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Mark S. Davies  
May 22, 2003

## **CERTIFICATE OF SERVICE**

I certify that on this 22nd day of May, 2003, I caused two copies of the Brief Amicus Curiae of the United States of America in Support of Appellee Kanebridge Corp. to be served by Federal Express next day delivery to the following:

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