



## Legal Issues Forum

two thousand and six



## Lessons Learned: Overview of a recent copyright case involving standards

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# The Case: ICC v. NFPA

- International Code Council, Inc. v. National Fire Protections Association, Inc., 2006 WL 850879 (N.D. Ill. March 27, 2006)
  - ICC alleges that NFPA's building code, NFPA 5000, infringes ICC's copyright in its International Building Code (IBC 2000).
  - "Of more than 5,000 provisions of the IBC 2000, Plaintiff has identified just 300 sections and 20 tables (approximately 6 percent of the Plaintiff's model code) that it believes are infringed by the NFPA 5000." (Op. at 12).



# The Case: ICC v. NFPA

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- NFPA moves for Summary Judgment on grounds that:
  - The allegedly infringed language is not copyrightable;
  - The ICC does not own the allegedly infringed language;
  - NFPA did not copy the allegedly infringing language.
  
- Court denies motion and sends the case for trial making several important rulings of law of importance to all standards developers. The parties settle prior to trial.



# The Case: ICC v. NFPA

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- In its decision, the Court makes some helpful observations about model standards.
- BUT, if you are an SDO, there is also much of concern.



# The Issues: Are Model Codes & Standards Copyrightable at all?

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- Veeck v. SBCCI, 293 F.3d 791 (Fifth Circuit 2002)
- The Merger Doctrine



# The Issues: Veeck

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- Veeck Holding: No infringement where a third party copies provisions of a model building code that has been adopted as law.
- “As model codes, however, the organization’s work retain their protected status” and “model building codes . . . qua model building codes, are facially copyright protected.”  
Veeck, 293 F.3d at 800.
- Since this is a case about model codes AS model codes, Veeck issue not raised.
- **But Beware:** Any case involving model standards may raise the Veeck issue, even if you don’t want it to and neither party raises it!



# The Issues: The Merger Doctrine

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- The doctrine: Ideas cannot be copyrighted, only the original expression of ideas. Therefore, when there is only one way to express an idea, its expression cannot be protected by copyright.



# The Issues: The Merger Doctrine

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- Could an entire code or standard be uncopyrightable by virtue of the merger doctrine?
- “Recipe” case raised possibility that code or standard is too prescriptive to be entitled to copyright. Publications Int’l Ltd v. Meredith Corp., 88 F.3d 473, 475 (7th Cir. 1996). (the purely prescriptive part of a recipe NOT copyrightable)





# The Issues: The Merger Doctrine

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- Court says that the merger doctrine does NOT make a model standard uncopyrightable as a matter of law.
- “The model building codes at issue here are not expressionless “recipes” for creating a particular building, but instead carefully-drafted minimum standards for building construction.”
- Example: The idea of a “deck” is expressed in the IBC 2000 as “[a]n exterior floor supported on at least two opposing sides by an adjacent structure, and/or posts, piers or other independent supports,” and, in the dictionary, as “a flat-floored roofless area adjoining a building,” This ability to choose among possible means of expression “suggests that Plaintiff’s expression is sufficiently original and creative to be the proper subject matter of copyright protection.” Op. at 15.



# The Issues: The Merger Doctrine

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- But **BEWARE**: Although a standard may not lose its copyright because of merger, the copyright is “thin:
- “The mandatory or proscriptive language commonly employed in model codes arguably *reduces* the number of potential expressions for any idea contained in a copyrighted code. . . . [T]here may be a limit to the number of ways a particular construction standard may be expressed.” The court, therefore, only declined to declare *all* the challenged building code provisions were uncopyrightable as a matter of law.
- The Court left for trial which if any of the allegedly infringed text was in fact protected by copyright.



# The Issues: Copyright Ownership - Registration

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- **BEWARE:** Registration of your copyright may not be enough to prove ownership. Registration creates a presumption of ownership that can be rebutted.
- The presumption of ownership was rebutted here and the burden then fell to ICC to prove at trial that it owned the IBC 2000.



# The Issues: Copyright Ownership

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- How does an entity such as an SDO come to own a copyright in its works?
  - Work Made for Hire:
    - through its employees as a “work for hire.”
    - through non-employees via a written, signed “work for hire” agreement
  - Copyright transfer: through a written assignment of the copyright by the author.



# The Issues: Copyright Ownership – Work For Hire – Volunteers as Employees

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- ICC produced virtually no “work for hire” agreements and no copyright assignments, either for committee members or submitters of public proposals.
- So, ICC’s principal argument was that the volunteer code officials and others who sat on its code drafting committees should be considered as “employees.”



# The Issues: Copyright Ownership – Work For Hire – Volunteers as Employees

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- There are obvious problems with proving that a volunteer committee member who is employed and paid by someone else is an “employee” of the SDO.
- The Court noted these problems but left open the question whether, for purposes of copyright law (the Reid case), volunteer members of a standards development committee could in some circumstances be considered “employees” of the SDO.



# The Issues: Copyright Ownership – Work For Hire – Volunteers as Employees

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- BUT, while committee members might be “employees,” the Court found that submitters of public proposals were definitely NOT employees.
- Since public submitters were not asked to sign work for hire agreements or copyright assignments: “This court must conclude that Plaintiff does not own any language it adopted without modification from public commentary into the IBC 2000.” Op. at 22.



# The Issues: Copying of protectable elements of the allegedly infringed standard.

- Even if the SDO can prove it owns a valid copyright in a standard, it must prove that the infringer copied protectable elements of the standard. Text is not protectable if, for example, it comes from:
  - A public domain source (e.g., a federal regulation)
  - A third party source (e.g. a pre-existing standard)
- “The probative value of striking similarity between two works of authorship, of course, is diminished to the extent that both works are similar to some third work that is already in the public domain or to which both parties had access.” “While access to the IBC 2000 is undisputed in this case, this court is unwilling to ignore evidence in the record attributing the origin of some of the disputed provisions of the NFPA 5000 to common sources to which both parties had access, such as the BCMC Reports.” (Op. at 24).





# The Issues: More on Copying.

- Similarity of text on similar subjects may not be proof of copying. For standards, virtual identity of text may be necessary.
  - “[P]laintiff has alleged that Defendant copied less than 6 percent of its model building code.... Even of those, not all of the provisions Plaintiff has targeted within NFPA 5000 are so similar to the corresponding IBC 2000 provisions as to suggest infringement.” Op. at 24.
  
- Copying must be more than *de minimis*. Court expresses skepticism that relatively small amount of copying of a model standard can constitute infringement. “[W]here each code is a collection of literally thousands of individual provisions . . . [, t]he court is not prepared to conclude that any single provision (or handful of provisions) will have the kind of significance that the key scene in a novel might have.” Op. at 25.



# Lessons Learned/Questions to Ask

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- Think hard about the risks BEFORE you sue anyone, including another SDO, claiming copyright infringement.
  - How much do you own?
  - How much can you prove you own?
    - Do you have the documentation to show assignments or work for hire agreements?
    - Was the infringing language taken from a third party or public domain source
    - Is the copyright in the language that is infringed too “thin” to warrant protection (Merger)
    - Is the amount of copying de minimus in relation to the whole work. Is the copying defensible as a “fair use”?



# Lessons Learned/Questions to Ask

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- What are the risks of suing? Can you end up with a decision:
  - that you don't own your copyright? You bet!
  - that no SDO owns a copyright in a model standard (Veeck)? You bet!



# Lessons Learned: some modest recommendations

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- Allow liberal Fair Use of your works in the public interest.
- Negotiate fair and reasonable licenses for others to use your works when it meets your business and mission objectives.
- Work cooperatively with other SDO's to allow participants who want to to share their work with more than one SDO. (consider joint ownership of some text or using text through non-exclusive licenses)
- Protect your copyright vigorously when you have to, but always ask yourself the question before you consider suing: **Have you really been harmed by the alleged infringement?**

