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THE MARKETPLACE OF IDEAS AND THE IDEA–EXPRESSION DISTINCTION OF COPYRIGHT LAW

> 'The first axiom of copyright is that copyright protection covers only the expression of ideas and not ideas themselves...The second axiom of copyright is that the first axiom is more of an amorphous characterization than it is a principled guidepost.'
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> *Chuck Blore & Don Richman Inc v 20/20 Advertising Inc* 674 F Supp 671, 676 (1987)

ABSTRACT

The subject of this paper is how the social good of a marketplace of ideas, in so far as it is dependent upon an open and free communicative sphere, may be affected by the idea–expression dichotomy of copyright law. It is argued here that the marketplace of ideas and, in consequence, the social discovery of truth, suffer from the widespread rhetorical adherence to a legal dichotomy which is in fact radically indeterminate and largely without function or efficacy. The dichotomy and copyright law's interdiction against the copyrighting of ideas cannot in fact ensure that ideas freely circulate within the marketplace, competing for social acceptance, because neither the dichotomy nor the interdiction is able, as a substantive matter, to achieve what it promises. The protection of freedom of speech which is said to exist by reason of the idea–expression dichotomy is accordingly largely illusory.

INTRODUCTION

Freedom of speech is said to create and sustain at least three important social goods, namely, autonomous and self-fulfilled individuals, a 'marketplace of ideas', by which truth is discovered and disseminated, and a democratic dialogue, by which a representative government informs and is informed.[1] The aim of this paper

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1 The literature on this subject is voluminous and of great interest and influence, but useful summaries and discussions may be found in, for example, M Chesterman, *Freedom Of Speech In Australian Law* (Ashgate: Dartmouth, 2000) 20; T Campbell, 'Rationales for Freedom of Communication', in T Campbell and W Sadurski (eds), *Freedom Of Communication* (Aldershot: Dartmouth, 1994) 17; F Schauer, *Free Speech: A Philosophical Enquiry* (Cambridge: Cambridge

is to consider one of those three social goods, namely, the marketplace of ideas, in the particular context of copyright law's 'first axiom', that is, its structural principle that there is no copyright in an idea. It will not actually be argued here that copyright law does inhibit freedom of speech. That copyright owners are legally able to constrain the speech of non-owners is a fairly self-evident proposition and will be largely assumed.[2] The subject of this paper is specifically how the social good of a marketplace of ideas, in so far as it is dependent upon an open and free communicative sphere, may be affected by the idea–expression dichotomy which is central to the copyright law of Australia and many other nations.

It will be argued here that the marketplace of ideas and, in consequence, the social discovery of truth, suffer from the widespread rhetorical adherence to a dichotomy which is in fact radically indeterminate and largely without function or efficacy in copyright law. The idea–expression dichotomy and copyright law's interdiction

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University Press, 1982) Chapters 3 and 4;

2 In the recent case of *Ashdown v Telegraph Group Ltd* [2001] Ch 685, 693, where the interaction between copyright law and the right to freedom of expression guaranteed by Article 10 of the *European Convention for the Protection of Human Rights and Fundamental Freedoms* was considered for the first time by an English court, the particular free speech constraints of copyright were expressly recognised:

> Copyright does not protect ideas, only the material form in which they are expressed. It is therefore a restriction on the right to freedom of expression to inhibit another from copying the method of expression … of the same idea. It must follow that intellectual property rights in general and copyright in particular constitute a restriction on the exercise of the right to freedom of expression.

In *Harper & Rowe, Publishers, Inc. v Nation Enterprises* 471 US 539 (1985), the most significant decision by the Supreme Court of the United States on the matter of copyright and the First Amendment, the Court itself acknowledged that, although it may be otherwise justified, the law of copyright does lead to suppression of speech:

> [C]opyright ultimately serves to further First Amendment purposes by providing a financial incentive for creative speech, but the fact remains that in order to provide that incentive for some speech, other speech is restrained.

In the *Ashdown* case, the *Sunday Telegraph* published a series of articles in which substantial sections of a confidential minute of a meeting with the Prime Minister and others which had been made by the plaintiff were extracted without authorisation. The newspaper was found to have breached the plaintiff's literary work copyright. In *Harper & Rowe*, the *Nation*, a weekly magazine, was liable for copyright infringement as a result of its unauthorised publication of extracts from former President Gerald Ford's unpublished memoirs.

against the copyrighting of ideas cannot ensure that ideas freely enter into and circulate within the marketplace, competing for social acceptance, because neither the dichotomy nor the interdiction is able, as a substantive matter, to achieve what it promises. Copyright law, in current theory and doctrine, protects against considerably more than just literal copying and the extent to which it goes beyond protecting literal copying is the exact extent to which it encroaches upon the sphere of ideas and takes them out of free public circulation. The perimeters of that encroachment inevitably vary because the interpretation of the idea–expression dichotomy in the legal order at any given time is essentially a reflection of shifting political choices in a particular jurisdiction and era about what should be able to be privately owned and what should be kept in the public domain.

Accordingly, the protection of freedom of speech which is said to exist by reason of the idea–expression dichotomy is largely illusory. Ideas are taken out of the public sphere by the law of copyright and the degree to which that is tolerable is, and ought openly to be, a matter of a social choice, not legal principle. Expressive freedom and, in particular, the marketplace of ideas would be better and more reliably defended by either a jettisoning of the idea–expression distinction or by a more sophisticated and judicially open understanding of its actual function.

One proviso should perhaps be made here. The particular focus of this quite brief and abstract paper is on demonstrating logically that the social good of a vast marketplace of ideas is more significantly encroached upon by the law of copyright than is widely acknowledged, given the prominence of the idea–expression dichotomy in those statements by judges and commentators which appear to be almost solely aimed at legitimating copyright regimes which are unfettered by free speech concerns. I do not mean to suggest, by the presentation of this focused argument, that, in my view, the interests protected by copyright law are not legitimate and substantial, or that the removal of some ideas from the marketplace by the law of copyright is not justifiable, or to deny that copyright law, through its incentive- creation function, can actually contribute greatly to the formation and functioning of the marketplace of ideas.

COPYRIGHT AND THE MARKETPLACE OF IDEAS

The premise here is essentially that the discovery or possibly the construction of truth is dependent upon the free creation, dissemination and competition of ideas; that freedom of speech is conducive and indeed essential to the development of a marketplace in which ideas can circulate and be assessed; and that the ideas and information in the marketplace should be sought 'from diverse and antagonistic

sources'.[3] The marketplace of ideas theory been described as 'the predominant and most persevering' of justifications for the special protection of freedom of speech.[4] The theory, and in particular the grand metaphor of 'marketplace', are strongly associated, in the constitutional jurisprudence of the First Amendment in the US, with the dissenting judgment of Holmes J in *Abrams v United States*: [5]

> When men have realized that time has upset many fighting faiths, they may come to believe …that the ultimate good desired is better reached by free trade in ideas…that the best test of truth is the power of the thought to get itself accepted in the competition of the market and that truth is the only ground upon which their wishes can safely be carried out.

The theory behind the marketplace metaphor is that when many different ideas and perspectives are circulating in the public sphere, then we as a society are more likely to discover truth and truth is more likely to prevail over falsehood as many distinct and contending ideas are compared with each other and debated by rational and truth-loving minds.[6]

There has been considerable recent criticism of the classical marketplace of ideas theory, on the grounds that the theory is based on outdated understandings of reason and truth, that it is unduly structured around truth-oriented speech,[7] that it entails a repudiation of belief in objective truth,[8] that it is based on a false assumption of equality (given that access to the marketplace is not open to everyone equally), that an ideologically neutral marketplace of ideas cannot exist, and that the shape of debate is determined from the beginning by elite groups.[9]

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3 *Associated Press v United States*, 326 US 1, 20 (1945)

4 F Shauer, 'Free Speech In A World Of Private Power' 1, 2 in T Campbell and W Sadurski (eds), above n 1.

5 *Abrams v United States*, 250 US 616, 630 (1919) (holding that there was no First Amendment protection for pamphlets which were distributed during war-time and which were critical of President Wilson's actions).

6 See F Schauer, above n 1; M Chesterman, above n 1, 21; R H Coase, 'The Market for Goods and the Market for Ideas' (1974) 64 *American Economic Review* 384.

7 T Campbell, in T Campbell and W Sadurski (eds), above n 1, 23.

8 Barendt, Eric 'Importing United States Free Speech Jurisprudence?' in T Campbell and W Sadurski (eds), above n 1, 57, 64;

9 See S Ingber, 'The Market-Place Of Ideas: A Legitimizing Myth' (1984) *Duke Law Journal* 1; M Powell, 'The Mythological Marketplace Of Ideas: *R.A.V. Mitchell,* And Beyond' (1995) 12 *Harvard Blackletter Law Journal* 1, 10:
At the heart of the First Amendment's self-governance ideal is the pluralist notion that groups of individuals will organise, press their specific interests, and be heard in the marketplace. However this theory fails to recognise how elites structure the debate from the outset — what is important to a member of the decision-making elite is considerably less important to an outsider.

Despite the evident cogency of many of these arguments, the description of the marketplace of ideas theory as 'the predominant and most persevering' of justifications for the special protection of freedom of speech [10] probably remains viable and valid, and it will, at least for the purposes of further argument, be accepted here as a legitimate and still persuasive justification for such protection.

The idea–expression dichotomy, which provides 'the dominant principle of copyright law',[11] namely, that copyright can be granted for a form of expression but not for an idea, is certainly one of copyright law's most resonant and foundational concepts. The dichotomy has long been described, in case law and in commentary, as a key to safeguarding free speech from the depredations of copyright and it is probably fair to say that the argument is part of the conventional wisdom, the legitimating rhetoric of copyright law. It was, for example, held by the Supreme Court of the United States in *Harper & Rowe Publishers v Nation Enterprises* that the idea–expression dichotomy, 'strikes a definitional balance between the First Amendment and the Copyright Act by permitting free communication of facts while still protecting an author's expression'.[12] Similarly, in the High Court of Australia, Mason J, in *Commonwealth of Australia v John Fairfax & Sons Ltd.*, rejected arguments that the use of copyright law to suppress the publication of extracts from government documents interfered with the free speech interests of the defendant and amounted to a suppression of the facts themselves.[13] In the words of one commentator, 'lying behind the idea-expression dichotomy appears to be a policy commitment to the desirability of ideas circulating freely'. [14] According to

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10 F Shauer, 'Free Speech In A World Of Private Power' 1, 2, in T Campbell and W Sadurski W (eds), above n 1.

11 *Autodesk Inc v Dyason (No.2)* (1993) 176 CLR 300, 303 (Mason CJ). The principle which the dichotomy support is phrased in varying ways depending on the immediate context. See below for examples of the formulations.

12 *Harper & Rowe, Publishers v Nation Enterprises* 723 F2d 195, 203 (2nd Cir, 1985).

13 *Commonwealth of Australia v John Fairfax & Sons Ltd* (1980) 147 CLR 39.

14 See F Patfield, 'Legal Policy and the Limits of Literary Copyright' in Parrinder and Cherniak (eds), *Textual Monopolies, Literary Copyright and the Public Domain* (Office for Humanities Communication, London, 1997) 121; see also E Volokh and B McDonnell, 'Freedom of Speech and Independent Judgment Review in Copyright Cases' (1998) 107 *The Yale Law Journal* 2431, 2431:

> Of course the Supreme Court has held that copyright law is a valid speech restriction. Because the law stimulates entry into the marketplace of ideas and because the law prohibits only the use of other's expression, not their ideas or the facts they've uncovered, the *Copyright Act* doesn't violate the First Amendment.

Nimmer On Copyright, para 1.10[B][2] 'On the whole, therefore, it appears that the idea-expression line represents an acceptable definitional balance as between

this view, since only expressions are controlled by the law of copyright and potentially kept out of the public arena by private owners, the marketplace of ideas is entirely safe from threat by the law of copyright. The particular speech inhibition effected by copyright law may have other negative consequences but these do not impact on the social good under consideration here, a free and vital marketplace of ideas.

The argument is a very powerful one, but much, if not all, of its force depends upon the validity, the efficacy, the functionality of the idea–expression dichotomy. The argument is based on an underlying assumption that ideas and expressions are distinguishable and separable. As will be discussed below, if the law of copyright does not or can not effectively separate ideas from expressions, then it can not be persuasively argued that ideas are not controlled by the law of copyright and thereby removed from free circulation in the public sphere.

The idea–expression principle is authoritative, but what exactly is it? Since its scope is actually even broader than initially appears, a digression into that scope might be in order here. Although the basic principle is that copyright protection is confined to the expression of ideas and does not extend to the ideas themselves, formulations of the dichotomy are not necessarily or even usually restricted to the exclusion of 'ideas' from copyright protection. An authoritative nineteenth-century formulation of the dichotomy in English law, for example, states that copyright, 'does not extend to ideas, or schemes, or systems, or methods', [15] and the relevant section in the American *Copyright Act* of 1976 is extensive in its articulation of what is excluded:[16]

> In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle or discovery, regardless of the form in which it is described, explained, illustrated or embodied in such work.

The World Trade Organisation's Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS) which, (arguably, anyway), reflects a kind of international consensus on the point, states that:[17]

> Copyright protection shall extend to expressions and not to ideas, procedures, methods of operation or mathematical concepts as such.

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copyright and free speech interests'; J Ginsburg, '"No Sweat" Copyright And Other Protection Of Works Of Information After *Feist v Rural Telephone*', (1992) *Columbia Law Review* 338.

15 *Hollinrake v Truswell* [1894] 3 Ch 420, 427.

16 *Copyright Act of 1976*, 17 USC 102(b) (1982).

17 TRIPS Article 9 (2).

Although 'facts' are not specifically mentioned in these formulations, factual information is clearly in the public domain and powerful expressions of the exclusion of facts from copyright protection can be readily found in case law and commentary.[18] One of the strongest recent statements of the function of the idea–expression distinction in keeping information itself in the public domain was made by the Supreme Court of the United States in *Feist Publications, Inc. v Rural Telephone Service Co,* where copyright protection for a telephone directory was denied:[19]

> This principle, known as the idea/expression or fact/expression dichotomy, applies to all works of authorship. As applied to a factual compilation, assuming the absence of original written expression, only the compiler's selection and arrangement may be protected; the raw facts may be copied at will. This result is neither unfair nor unfortunate.

The exclusion from copyright protection has recently been expressly extended to the 'function' of a computer program, because '...the idea of a utilitarian work is its purpose or function'.[20] However, the issue of which aspects of software should

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18 See, for example, in *Feist Publications, Inc v Rural Telephone Service Co., Inc.* (1991) 59 LW 4251, 4252 (O'Connor J), 'That there can be no valid copyright in facts is universally understood'. See also *Victoria Park Racing and Recreation Grounds Co Ltd v Taylor* (1937) 58 CLR 479, 498 (Latham CJ):

> The law of copyright does not operate to give any person an exclusive right to state or to describe particular facts. A person cannot by first announcing that a man fell off a bus or that a particular horse won a race prevent other people from stating those facts.

See also S Ricketson, *The Law Of Intellectual Property* (Law Book Co. 1984) 185; 'While it is a truism that there is no property in facts, just as there is no property in ideas...'

19 *Feist Publications, Inc. v Rural Telephone Service Co.* (1991) 111 S.Ct.1282, 1290. It should be noted that the reasoning in *Feist* was not found to be compelling by Finklestein J of the Federal Court of Australia in *Telstra Corporation Ltd v Desktop Marketing Systems Pty Ltd.* ([2001]AIPC 39,613. Copyright protection for the plaintiff's telephone directory was granted on the basis of reward for the labour and investment involved in compiling the directory and the idea–expression distinction was barely touched upon, except to emphasise that there is no copyright in facts and information. Given the result in the case, the emphasis was rather clearly for rhetorical effect.

20 *Autodesk Inc v Dyason* (1991) 104 ALR 563, 572 (Dawson J), referring to *Whelan Associates v Jaslow Dental Laboratory* (1986) 797 F2d 1222, 1236, which decided that non-literal aspects of a computer program could be protected as expression. The specific principles articulated in the *Whelan* case for determining how to characterise ideas and expression in software cases have, however, long been surpassed by the American courts. See, for example, below, n.21.

be characterised as 'function' has generated much difficulty and controversy over the degree to which copyright protection ought to extend to the non-literal aspects of software; that is, which of those non-literal aspects ought to be viewed as the 'ideas' of the software and which as the 'expression'.[21]

When all these exclusions are listed, quite a formidable array results. Ideas, schemes, systems, functions, facts, procedures, methods, mathematical concepts, processes, methods of operation, concepts, principles, and discoveries are all taken out of the reach of copyright protection and it indeed appears that most of the vast endeavour of human intellectual effort is included on the list. That which is withdrawn from the marketplace of ideas by the law of copyright seems to be quite limited and discrete. Given that ideas remain free (and a great deal is contained within the legal concept of 'ideas'), copyright law seems particularly reasonable in its interface with the public communicative sphere.

The question, however, is whether or not copyright law, with its unique form of inhibition of free speech, does nevertheless interfere with the creation and function of the marketplace of ideas and accordingly with the social discovery and generation of truth. The matter is, if anything, becoming more urgent as countries enact legislation specifically designed to control and inhibit the digital transmission of copyright material over the Internet, given that the Internet is a particularly successful facilitator of the marketplace of ideas.[22]

Does copyright law keep ideas out of the marketplace through its most basic and simple interdiction — that one person shall not copy the expression of another?

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21 See, for example, *Computer Associates International Inc v Altai, Inc* 982 F 2d 693 (2nd Cir 1992); *Lotus Development Corporation v Borland International Inc* 49 F 3d 807 (1st Cir 1995) aff'd 116 S Ct 804 (1996) (holding that Lotus' menu command hierarchy was a 'method of operations' and therefore not protected).

22 See S C Jacques, '*Reno v ACLU*: Insulating The Internet, The First Amendment, And The Marketplace Of Ideas' (1997) 46 *American University Law Review* 1945, 1989:

> ...[T]he Internet does more to facilitate Holmes' marketplace of ideas than any other form of communication in history. The chief criticism of Holmes' theory over the years has been that it is too utopian and impractical due to the economic barriers associated with having one's voice heard in the marketplace. The Internet, however, breaks down these barriers, offering an egalitarian form of communication where the cost is little or nothing and an opinion is instantaneously distributed worldwide.

See also J Berman and D J Weitzner, 'Abundance And User Control: Renewing The Democratic Heart Of The First Amendment In The Age Of Interactive Media' (1995) 104 *Yale Law Journal* 1619, 1624.

There is at least one apparently strong reason, which will be pursued here, to think that it does not, that the particular inhibitions on expressive freedom which are brought about by copyright law are not in fact sufficient to negatively affect this specific social good.[23] The reason is this. When an idea is already in the marketplace, there appears to be no social benefit, no contribution to the content of the marketplace of ideas, in having it introduced again in the same form; that is, with the same expression. Public discourse is not substantively enriched by copied expression:[24]

> The expression of an opinion already expressed by another — on the same words used by that other — adds nothing to the search for truth. It is merely the repetition of an opinion that was already available from its original source.

There is no net gain in ideas, no further possibility for the discovery of any truth simply by letting in copies of what is already there and the copyright prohibition

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23 There is another argument, which will not be further dealt with in this paper, namely, that copyright law contributes to the diversity of sources within the marketplace of ideas by the incentive which it provides for works to be created, produced and disseminated. This argument was made (famously) by the Supreme Court of the United States in *Harper & Rowe, Publishers, Inc. v Nation Enterprises* (1985) 471 US 539, 558, a case which denied First Amendment protection to a magazine publisher which had published extracts from the memoirs of former President Ford without authorisation from the copyright owner.

'The Framers [of the Constitution] intended copyright itself to be the engine of free expression. By establishing a marketable right to use one's expression, copyright supplies the economic incentive to create and disseminate ideas.'

The counter-argument is that the law of copyright tends to concentrate information production and favour monopolies of copyright owners, which means that there is a reduction in the number of contributors to the marketplace of ideas, with a consequent detrimental effect on the marketplace and therefore on its truth-discovering potential.

See also Y Benkler, 'Free As The Air To Common Use: First Amendment Constraints On Enclosure Of The Public Domain' (1999) 74 *New York University Law Review* 354.

24 Y Sobel, 'Copyright and the First Amendment: A Gathering Storm?' 119 *Copyright Law Symposium (ASCAP)* 43, 72 (1971); See also M J Haungs, 'Copyright of Factual Compilations: Public Policy and the First Amendment' (1990) 23 *Columbia Journal of Law & Social Problems* 347, 366, fn 122:

> Similarly, public participation in discussion and decision-making requires only participation of one's self: views that have already been expressed in copyrighted form are available for discussion so that copyright's ban on their being parroted by others in the exact same form does nothing to chill debate.

accordingly does not appear to interfere with entry into or existence within the marketplace of ideas.

Take, for example, the facts of *Ashdown v Telegraph Group Ltd.*,[25] a case which involved the unauthorized reproduction by a newspaper of a minute of a meeting between political figures which was of considerable interest to the public. Had the *Sunday Telegraph* simply published the information about the meeting which it gleaned from the minute without reproducing the minute itself, it would not have infringed the literary work copyright in the minute, the law of copyright would not have been engaged and the relevant information would still have entered the marketplace for the perusal and edification of the public. The reproduction of the exact form of words of the minute added nothing to the social search for truth and yet it was only the reproduction of the exact form of words which was stopped by the law of copyright.[26]

It is ideas that are central to the marketplace, to the public sphere, to the discovery of truth, not expressions, and only expressions are kept out of the marketplace by copyright.[27] Accordingly, the marketplace cost of copyright law is minimal and if that is the case, it is a matter relevant both to the achievement of a social consensus on the appropriate limits of copyright law and to specific issues arising in the formulation or interpretation of that law.

The problem with that argument however is that it only works if the idea–expression principle itself works and there are strong indications within the law that the principle does not work. It is at least arguable that the idea–expression dichotomy is radically indeterminate, that its validity can therefore not easily be

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25 *Ashdown v Telegraph Group Ltd.* [2001] Ch 685.

26 If, in *Ashdown*, the information contained in the plaintiff's minute were to be characterised by the court as 'expression', rather than 'idea', then the information itself in the minute could be suppressed by the copyright owner and accordingly kept out of the marketplace of ideas from which social truth and knowledge emerge. Such a characterisation has not taken place as yet and perhaps it never will, but the prospect is not unthinkable, given decisions in which, arguably anyway, copyright has been granted over information itself. See, for example, *Elanco Products Ltd v Mandops (Agrochemical Specialists) Ltd* (1980) RPC 213; *British Columbia Jockey Club v Standen* (1986) 22 DLR (4th) 467; and *Independent Television Publications Ltd v Time Out* [1984] FSR 64.

27 This is not of course to suggest that that which is characterised as 'expression' and subject to copyright does not circulate in the marketplace of ideas. The point here is simply that that which is 'expression' does not circulate freely but remains within the control of a private owner who may or may not choose to allow its circulation and who may choose the terms and conditions of that circulation.

made evident to reason[28] and that it is therefore largely symbolic and non-functional in fact. There is a substantial body of critical opinion, drawn from both academic and judicial sources, that the idea–expression dichotomy is impossible to apply, and largely non-functional as a principle of law except as a way of rationalising and justifying decisions on copyright issues actually reached on other grounds. If that is the case, then the apparent preservation of free speech which the principle represents and embodies, the apparent protection for the free circulation of ideas in the very marketplace in which truths may be discovered and debated, is illusory.

Many of the judges, legal commentators, and lawyers who constitute copyright law's interpretive community have become profoundly skeptical about the distinction between ideas and expressions. There have certainly been many judicial admissions about the incapacity of the idea–expression principle to determine the outcome of cases without having recourse to factors external to the logic of the dichotomy. One of the most famous and frequently cited of such admissions was that of Learned Hand J in *Nichols v Universal Pictures Corporation*: [29]

> It is of course essential to any protection of literary property, whether at common law or under the statute, that the right cannot be limited literally to the text, else a plagiarist would escape by immaterial variations. That has never been the law, but as soon as literal appropriation ceases to be the test, the whole matter is necessarily at large, so that, as was recently well said by a distinguished judge, the decisions cannot help much in a new case…[n]obody has ever been able to fix that boundary and nobody ever can.

In *Herbert Rosenthal Jewelry Corp v Kalpakian*, for example, it was openly stated of the idea–expression distinction that, 'at least in close cases, one may suspect, the classification the court selects may simply state the result reached rather than the reason for it'.[30] A great many commentators have now argued, and even proved reasonably conclusively, in so far as 'proof' is possible in such arguments, that where a court is minded to find copyright infringement of a work, the work will be

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28 The submerged reference here is to this: 'No one should be forcibly compelled to submit to norms whose validity cannot be made evident to reason', 'Die Wurzeln radikaler Demokratie' *Deutsche Zeitschrift fur Philosophie* 41 (1993) 327, quoted in J Habermas, *Between Facts And Norms*, (first appeared in German, 1992,) (1996; The MIT Press, Cambridge, Massachusetts, trans. William Rehg) 456.

29 *Nichols v Universal Pictures Corporation* 45 F 2d 119 at 121 (2nd Cir.1930), cert denied, 282 US 902 (1931). The last sentence in this passage was approved by the Full Federal Court in *Powerflex Services Pty Ltd v Data Access Corp* (1997) 75 FCR 108, 123.

30 *Herbert Rosenthal Jewelry Corp v Kalpakian* 446 F 2d 738, 742 (1971).

found to be 'expression'; where the opposite outcome is desired, the characterisation will be 'idea'.[31]

Cornish has suggested that the vagueness of the principle means that in any particular case the answer can only lie in a court's 'innate sense of fairness',[32] and judges have openly admitted to *ad hoc* and unprincipled decision-making on the issue:[33]

> Obviously no principle can be stated as to when an imitator has gone beyond copying the idea and has borrowed its expression. Decisions must therefore inevitably be *ad hoc*.

Ad hocery is not necessarily shameless, but it always raises questions. That a principle of law should be interpreted and applied differently by different courts at different times is in general neither particularly surprising nor any particular cause for concern, but a principle may nonetheless be shown to have a looseness and generality, an indeterminacy so radical as to call its legitimacy as an effective and functioning principle of law into question.

It is suggested here, based on both the statements of judges and the extensive, painstaking work of scholars noted above, that that level of radical indeterminacy which de-legitimates a principle of law within the legal, interpretive community may well exist in respect of the principles of law generated by the idea–expression

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31 E Samuels, 'The Idea-Expression Dichotomy In Copyright Law' (1989) 56 *Tennessee Law Review* 321, 324. See also R H Jones, 'The Myth of the Idea/Expression Dichotomy in Copyright Law' (1990) 10 *Pace Law Review* 551; P Drahos, 'Decentring Communication: The Dark Side of Intellectual Property' in T Campbell and W Sadurski (eds), above n 1, 249; and E C Wilde, 'Replacing The Idea/Expression Metaphor With A Market-Based Analysis In Copyright Infringement Actions' (1995) 16 *Whittier Law Review* 793, 817:

> The idea/expression metaphor does not contain an inherent principle to determine where to draw the line between idea and expression; therefore, the court must look outside the metaphor for guidance.

Also J S Wiley Jr, 'Copyright At The School Of Patent' (1991) 58 *University of Chicago Law Review* 119, 123 ('…a doctrine that announces results but does not determine or justify them').

32 W R Cornish, *Intellectual Property: Patents, Copyright, Trade Marks and Allied Rights* (1999, 4th ed, Sweet & Maxwell) 417.

33 *Peter Pan Fabrics Inc v Martin Weiner Corp.* 274 F2d 487, 489 (2nd Cir 1960); see also *Shaw v Lindheim* 908 F2d 531, 534 (9th Cir 1990):

> It is thus impossible to articulate a definitive demarcation that measures when the similarity between works involves copying of protected expression; decisions must inevitably be *ad hoc*.

dichotomy. When one court can apply a principle to find that the entries in a telephone directory are facts which are in the public domain, and another court applies the same principle to find that the same entries are expressions of fact which are protected by copyright, then, even allowing for the fact that the courts are in different jurisdictions with different copyright traditions, it becomes clear that the principle is not functioning as a principle of law in any but the most broad, bland and, possibly, useless sense.[34] When the application of the same principle of law can at one time yield a decision that a word for word translation of a literary work does not infringe the work's copyright (because a translation is not a taking of the work's 'expression')[35] and at another time yield a decision that taking the information but none of the ordered words from the leaflet instructions for a packet of herbicide is an infringement of the literary work copyright in the words,[36] that principle begins to look questionable or at least very, very flexible. That which was 'idea' at one time and place has become 'expression' in another.

If the idea–expression distinction is in fact impossible to apply because the distinction can not exist[37] or is so indeterminate that it does not and cannot function

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34 See *Feist Publications, Inc. v Rural Telephone Service Co.* (1991) 111 S.Ct.1282, 1290, Supreme Court of the United States; *Telstra Corporation Ltd v Desktop Marketing Systems Pty Ltd.* [2001] AIPC 39, 613 Federal Court of Australia.

35 *Stowe v Thomas* 23 F Cas 201 (CCED Pa 1853) No 13, 514. In the United States at the time, there was, for literary works, only protection from literal copying and it was accordingly held that an unauthorised translation of *Uncle Tom's Cabin* into German did not infringe Stowe's copyright.

36 See *Elanco Products Ltd v Mandops (Agrochemical Specialists) Ltd*, above n 26. For other instances in which copyright has been granted over information itself, see *British Columbia Jockey Club v Standen* (1986) 22 DLR (4th) 467 and *Independent Television Publications Ltd v Time Out* [1984] FSR 64.

37 It has been argued that the dichotomy itself may rest upon a kind of metaphysical impossibility, namely, the impossibility of separating idea and expression. Commentators such as R H Jones, above n 31, 564; and P Drahos, 'Decentring Communication: The Dark Side of Intellectual Property' in T Campbell and W Sadurski (eds), above n 1, 257, have argued that the various proposals and suggested techniques for refining and applying the legal dichotomy must inevitably falter because the distinction between ideas and expression does not and can not exist in fact. The argument is that there is no idea apart from its expression; an idea, no matter how simple, can not exist apart from the way that it has been expressed by its originator. Judicial statements such as the following in *Continental Casualty Co v Beardsley* 253 F2d 702,706 (2nd Cir 1958) are, on this line of reasoning simply incoherent: ' …the proper standard of infringement is one which will protect as far as possible the copyrighted language and yet allow the free use of the thought beneath the language', because ideas do not float underneath or even on top of or around language. They are an inherent and integral part of the language used and, accordingly, no judge can grant private ownership for an expression without also

as a principle of law capable of determining outcomes in individual cases, then it may have a different function altogether. The dichotomy actually seems to function largely as a cover, a kind of legal mask for another, deeper division, namely, the division between that which is private (and deemed to be amenable to market relations and individual ownership), on the one hand, and that which is public (part of the public domain, beyond the reach of any private ownership) on the other. That which is characterised as 'idea' by the law of copyright is a part of the public domain; that which is characterised as 'expression' is not, but is instead eligible for copyright protection and private ownership, provided that the other requirements for that protection are met.[38] When, for example, the themes and the broad story outline of a dramatic work are found to be the 'ideas' of that work, they are free to be used by other playwrights for other purposes in other plays without fear of the law of copyright; when they are found to be the expression or the 'working out' of the idea., they are able to be taken out of the public sphere and privately owned. [39] When non-literal aspects of a computer program, like the program's 'look and feel', are found to be the program's 'expression' rather than its 'idea', those aspects of the program are removed from free use by others for the duration of the copyright period, but they can be bought and sold and licensed out by the copyright owner.[40] Expressions, in short, are commodifiable; ideas are not.

It is reasonably clear that there has been a historical, interpretive shift in judicial characterisation of idea and expression, from a presumption in favour of characterising non-literal aspects of works as 'idea' (and therefore open to the public) to a presumption in favour of characterising them as 'expression' (and

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simultaneously granting private ownership for an idea. According to this line of argument, when the law of copyright prevents someone from using or reproducing or performing someone else's expression of an idea, it also simultaneously prevents that person from using or reproducing or performing that idea.

38 A similar division may be found in the law of patents, where that which is characterised as 'discovery' is a part of the public domain and that which is characterised as 'invention' is eligible for patent protection and private ownership. The invention–discovery dichotomy in patent law is every bit as indeterminate and difficult as the idea–expression distinction in copyright law, probably for the same reasons.

39 *Nichols v Universal Pictures Corporation* 45 F2d 119, 121 (2nd Cir.1930), cert denied, 282 US 902 (1931); *Zeccola v Universal City Studios Inc* (1982) 46 ALR 189:

> In general there is no copyright in the central idea or theme of a story or play, however original it may be; copyright subsists in the combination of situations, events and scenes which constitute the particular working out or expression of the idea or theme.

40 *Whelan Associates, Inc v Jaslow Dental Laboratory, Inc.* 797 F2d 1222 (3rd Cir. 1986), cert denied, 479 US 1031 (1987).

therefore not open to the public).[41] Protection of only the literal expression of a work has yielded to protection of more abstract features of those works through a process of defining such features as 'expression' when previously they had been characterised as 'idea'.[42] If the hypothesis articulated here is correct, then that historical shift from idea to expression is simply a reflection of a broader historical shift from public access to cultural forms to private sector ownership of those forms, from a privileging of the collective interest to a privileging of individual interests. The idea–expression distinction itself can provide no assistance to the resolution of the problem of what should be public and what should be private, because it essentially does no more than recast the terms in which the problem is described.[43]

CONCLUSION

If, as Holmes J believed, the best test of truth is the power of an idea to get itself accepted in the competition of the marketplace, then that test and, accordingly, the discovery of truth, depends upon ideas getting into the marketplace. But that in turn depends upon the principle of law that ideas cannot be privately owned and controlled and if that principle does not or cannot function, then the marketplace of ideas will itself not function as it should. It has been argued here (and elsewhere) that the legal norms generated by the dichotomy do not in fact function as predictive and precise legal principles, capable of being used to decide specific cases and calculate case outcomes. An analysis of cases and commentaries most closely concerned with the idea–expression dichotomy illustrates the dichotomy's essential indeterminacy and underlying irrationality. It also reveals a growing

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41 E Samuels, 'The Idea-Expression Dichotomy In Copyright Law' (1989) 56 *Tennessee Law Review* 321, 325.

42 A Yen, 'A First Amendment Perspective On The Idea/Expression Dichotomy And Copyright In A Work's "Total Concept And Feel"' (1989) 38 *Emory Law Journal* 393, 433 :

> Cases …started this trend by treating vague and general features of works as copyrightable expression. By defining features like "total concept and feel" to be expression and not idea, these cases made it easier for plaintiffs to state broader and broader claims of copyright.

43 Recognition of the essential uselessness of the idea–expression principle may help to explain why one of the most significant copyright cases in the area of computer software in recent years was decided by the High Court of Australia without any significant reference to or analysis of the idea–expression dichotomy, despite the fact that the dichotomy had been central to the analysis of the case at trial and in the Full Federal Court of Australia. See *Data Access Corp v Powerflex Services Pty Ltd* (1999) AIPC 91–514.

frustration with the rhetorical success and substantive failure of the conventional principle that copyright can be granted for a form of expression but not for an idea.

The fixing of the boundary between idea and expression is a fixing of the boundary between private and public and is not a matter capable of being resolved by deductive legal reasoning. If that is so, then the idea–expression divide cannot continue to be viewed as a way of safeguarding free speech from the inhibition of copyright. In so far as the continued co-existence of the law of copyright and a vital, dynamic and replete marketplace of ideas is based upon the assumed functioning of an effective legal principle that keeps ideas free, then that base must be viewed as conceptually and practically doubtful. The principle is only protecting a particular view of what should be able to be privately owned and what should not and that, I would suggest, is essentially and profoundly a political decision, which should be recognised as such. The fiction of the idea–expression distinction should not be able to forge a social or even a legal complacency about freedom of speech in an era of vastly expanding intellectual property rights.[44] Too much is at stake for the marketplace of ideas and for the process by which we as a society come to know what is true.

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44 This expansion has recently been described as 'a second enclosure movement…the enclosure of the intangible commons of the mind' by J Boyle in 'The Second Enclosure Movement and the Construction of the Public Domain', a paper delivered at the *Conference on the Public Domain,* Duke University School of Law, November 9–11, 2001 (papers available on-line at www.law.duke.edu/pd)