


to be regarded as equivalent to the shape of the goods within the meaning of section 3(2) MarkenG where the packaging is not identical to the shape of the goods but merely visually similar to it remains open, which may lead to uncertainty amongst trade mark applicants for goods with unique packaging as part of their marketing strategy.

It should be noted that, considering the circumstances of this case, it is odd that the Applicant withdrew its application for cancellation under section 3(2), No 2 MarkenG. The square shape of the packaging arguably has functional uses (ie fitting into pockets easier, or allowing for easier breaking of chocolate), and the Proprietor even used an advertising slogan ‘Quadratisch. Praktisch. Gut.’ which translates to ‘Square-shaped. Practical. Good.’ Therefore, it seems that an application for cancellation would have been more likely to succeed on the basis that the shape was necessary to obtain a technical result.

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## Copyright

### ■ US Supreme Court holds that US state codes and annotations thereto are not eligible for copyright protection

*Georgia v Public.Resource.Org, Inc*, 140 S Ct 1498 (US 27 April 2020)

**On 27 April 2020, the US Supreme Court extended the government edicts doctrine, which holds that works authored by judges in the course of their official duties are in the public domain, to similar works created by the legislatures of US states, territories and the District of Columbia. The decision clarifies that this doctrine applies even to annotated versions of legal codes, to prevent a situation where there is ‘first class’ versus ‘economy class’ access to the law. That said, this decision will not stop states and territories from charging for access to such materials. However, those states and territories will no longer be able to prevent third parties from providing free access to such materials by invoking copyright restrictions.**

#### Legal context

It has long been clear under US law that the text of legal codes is not eligible for copyright protection. However, given the nature of the common law system, US legal publishers have been able to profit for just as long a time by

compiling and selling annotated versions of such codes, which provide useful summaries of case law interpreting the codes’ text. More recently, legal publishers began partnering with state legislatures to do so. Publishers benefitted from obtaining official sanction for their particular annotated code versions. State legislatures benefitted by being able to offload the cost of making annotated codes onto legal publishers. In some US states, such annotated codes are now the only available official codes. This development has been challenged by civil rights organizations and advocates, which post such codes openly on the Internet without permission.

#### Facts

Georgia’s sole official code is the Official Code of Georgia Annotated (OCGA). The OCGA includes the text of all current Georgia statutes as well as annotations thereto. The annotations, which are not officially binding, typically include summaries of judicial opinions construing the provisions of the statutes. The annotations to the current version of the OCGA were produced as a work for hire by Matthew Bender & Co., a private publisher of law books, for the Georgia Code Revision Commission (CRC). The CRC is a state entity composed mostly of state legislators, funded by legislative branch appropriations and staffed by Georgia’s Office of Legislative Counsel.

In 2013, non-profit organization Public.Resource.Org, Inc. (‘PRO’) purchased a full copy of the OCGA and posted it online, allowing free public access to the OCGA on various websites. After sending PRO several cease-and-desist letters, the CRC filed an action for infringement of its copyright in the OCGA annotations in the US District Court for the Northern District of Georgia. The Northern District ruled in favour of the CRC, reasoning that the annotations were eligible for copyright protection because they were not enacted by the legislature. The US Court of Appeals for the Eleventh Circuit reversed, rejecting the CRC’s argument under the government edicts doctrine, whose animating principle is that no one person can own the law. The CRC then appealed the appeals court’s decision to the US Supreme Court.

#### Analysis

In a 5-4 decision not along party lines, the US Supreme Court affirmed the Eleventh Circuit’s ruling. Chief Justice Roberts delivered the majority opinion of the Court, which was joined by Justices Sotomayor, Kagan, Gorsuch and Kavanaugh.

The Court found that the annotations in the OCGA were not eligible for copyright protection under the government edicts doctrine, which holds that ‘officials empowered to speak with the force of law cannot be the authors of—and therefore cannot copyright—the works they create in the course of their official duties’. The

doctrine, based on the Court's earlier decisions in *Wheaton v Peters*, 33 US 591 (1834) (rejecting a federal court reporter's arguments that federal judges had implicitly granted him copyright in the judicial opinions that he published), *Banks v Manchester*, 128 US 244, 253 (1888) (rejecting a state court reporter's similar argument with respect to state judges, since the 'whole work done by the judges constitutes the authentic exposition and interpretation of the law, which, binding every citizen, is free for publication to all') and *Callaghan v Myers*, 128 US 617 (1888) (rejecting a state court reporter's ownership of state judicial opinion, but upholding the court reporter's copyright in headnotes and syllabi that he wrote), derives from the basic principle that, in a democracy, the people are 'the constructive authors' of the law and judges and legislators are merely draftsmen 'exercising delegated authority' 140 S Ct 1506 (quoting the Eleventh Circuit's opinion). Accordingly, the doctrine 'applies both to binding works (such as [judicial] opinions) and to non-binding works (such as [case] headnotes and syllabi),' but not to government officials or private parties who do not have authority to make or interpret the law (such as court reporters).

The Court here clarified that the appropriate test is based on the identity of the author: 'judges—and, we now confirm, legislators—may not be considered the "authors" of works that they produce in the course of their official duties as judges and legislators'. Just as judges who have the authority to interpret the law cannot claim copyright in their decisions under *Banks*, the same holds true for legislative bodies who have the authority to make the law. 'Moreover', the Court explained, just as the doctrine applies not just to a judge's opinions, but also to whatever work they perform in their official capacities, the doctrine also applies not just to legal codes drafted by legislators, but also to 'explanatory and procedural materials legislators create in the discharge of their legislative duties', such as floor statements, committee reports, proposed bills and the like. In short, the decision notes that 'copyright does not vest in works that are (1) created by judges and legislators (2) in the course of their judicial and legislative duties' 140 S Ct 1508.

Applying this two-step test to the facts of the case, the Court found that Georgia's annotations are not protectable by copyright. First, the Court determined that the CRC 'is not identical to the Georgia Legislature, but functions as an arm of it for the purpose of producing the annotations'. This was clear from the membership, staffing, funding and procedure followed by the CRC in approving the annotations. In particular, the CRC is staffed mostly by legislators. The CRC's funding and staff were allocated as part of Georgia's legislative branch under the state's appropriation bills. Annotations produced by the CRC must be approved by the legislature prior to being published in the OCGA. Further, in a 1979 decision in which a legal publisher had challenged the CRC's authority to award publishing

rights to a different legal publisher, Georgia's Supreme Court explicitly found the CRC to be 'within the sphere of legislative authority' *Harrison Co v CRC*, 24 Ga 325, 330 (1979). The Court then noted that, although the annotations were initially prepared by a private law publisher, they were produced pursuant to a work-for-hire agreement. Accordingly, under 17 USC section 201(b), the Court deemed that the CRC was the sole author of the annotations.

Turning to the second factor, the Court found that, although the annotations are not enacted into law, their preparation is an act of 'legislative authority' and they provide 'commentary and resources that the legislature has deemed relevant to understanding its laws'. That is, the CRC was created by the legislature, for the legislature, and the CRC's actions are, quoting *Harrison Co*, acts of 'legislative authority'. Although the annotations are not authoritative and largely summarize other materials, that fact does not suffice to take them outside the exercise of legislative duty because the annotations do provide commentary and resources that the legislature has determined are relevant to understanding its laws.

The Court rejected Georgia's argument that, by listing 'annotations' as copyright-protected works in section 101 of the Copyright Act, Congress specifically exempted this type of work from the government edicts doctrine. The majority ruled that section 101 only applied to 'annotations ... which ... represent an original work of authorship'. The Court explained that, while the reference to annotations in the Copyright Act 'help explain why supplemental, explanatory materials are copyrightable when produced by a private party ... it does not speak to whether those same materials are copyrightable when prepared by a judge or a legislator'.

The Court also rejected Georgia's argument that a negative inference should be made from the fact that the Copyright Act explicitly precludes copyright protection for the works of federal officials prepared as part of their duties, but not for state officials. Instead, the Court opined, 'the federal rule does not suggest an intent to displace the much narrower government edicts doctrine with respect to the States'.

With respect to Georgia's policy argument that, absent copyright protection for annotations, Georgia and other states will be unable to induce legal publishers to assist in preparing affordable annotated codes, the Court regretted that the argument was addressed to the wrong forum. '[I]t is generally for Congress, not the courts, to decide how best to pursue the Copyright Clause's objectives' 140 S Ct at 1511 (quoting *Kimble v Marvel Entertainment, LLC*, 576 US 446, 456 (2015)).

Finally, the Court noted its concern with Georgia's argument in favour of limiting the government edicts doctrine based on content (ie, to works with the force of law) and not authorship. Taken strictly, such an argument would exclude not just annotations but also concurring and

dissenting opinions, headnotes and syllabi prepared by judges, proposed bills and committee reports prepared by legislators and other materials supplementary materials that ‘do not have the force of law, yet . . . are covered by the doctrine’. These materials, although they are without the force of law, are greatly important. ‘Imagine a Georgia citizen’ reading an unannotated copy of Georgia’s Code ‘criminalizing broad categories of consensual sexual conduct . . . with no hint [from annotations] that important aspects of those laws have been held unconstitutional by the Georgia Supreme Court’ 140 S Ct at 1512. Adopting Georgia’s argument, the Court concluded, might lead to an unfair justice system based on the ability to pay for copyrighted material.

### Thomas dissent

Justice Thomas filed a dissenting opinion, joined in full by Justice Alito and joined in part by Justice Breyer.

Justice Thomas objected to the majority’s interpretation of the 19th Century cases that form the basis of government edicts doctrine. The narrower understanding of authorship and copyright protection current at the time may not have been broad enough to even possibly encompass judicial opinions. Under Justice Thomas’ analysis, ‘[a]llowing annotations to be copyrighted does not run afoul of any of [the underlying] justifications for the government edicts doctrine’ that he identified. In particular, annotations are not law, the creators of the annotations were incentivized by copyright laws to produce a desirable product, and lastly, the annotations do not impede fair notice of the laws. They should therefore, he opined, be copyrightable.

Justice Thomas also agreed with Georgia’s argument that the text of the Copyright Act supports the conclusion that the OCGA annotations are protectable. Because the Act includes ‘annotations’ as copyrightable material, and specifically excludes the official works of federal employees, but not those of state officials or employees, this suggests that ‘annotations’ drafted by state officials or employees may be copyrightable. “‘Congress’ use of explicit language in one provision”, he quoted, “cautions against inferring the same limitation” elsewhere in the statute’. 140 S Ct at 1518 (quoting *State Farm Fire & Casualty Co v US*, 137 S Ct 436, 442 (2016)). In response to the majority’s policy concerns, he noted that the practical effect of the majority’s decision may well be that states would stop producing annotated codes altogether, which would render obtaining quality legal assistance even more expensive than it is now.

### Ginsburg dissent

Justice Ginsburg issued a separate dissenting opinion, joined in full by Justice Breyer. Justice Ginsburg agreed with the two-part test set forth in the Majority Opinion as to whether the government edicts doctrine should apply. However, she disagreed with the majority’s finding with

respect to whether the OCGA annotations satisfied the second part of the test. In short, she argued that the annotations were not produced in a ‘legislative capacity’.

Although judges and legislators are both intimately involved in the law, judges ‘interpret and apply’ the law while legislators are involved in ‘making law’. In Justice Ginsburg’s opinion, these different roles suggest that annotations by legislators should be treated differently from annotations created by judges. In the first place, the annotations are not drafted together with the code provisions on which they are based. Instead, they are drafted ex post facto, ‘after lawmaking ends’. This distinguishes them from materials like committee reports, which are generated before lawmaking and tightly tied to the lawmaking process. Secondly, the annotations are ‘descriptive rather than prescriptive’. Instead of conveying the legislature’s understanding of the statutes, they convey others’ understanding of the statutes. Thirdly, the annotations were drafted for the convenience of the public generally and not legislators particularly. In other words, they are not aimed at guiding the lawmaking process, but have an ‘auxiliary, nonlegislative character’, do not satisfy the second part of the test and should be copyrightable.

### Practical significance

This decision makes it fairly clear that under the government edicts doctrine, official statutes promulgated by US States, territories and the District of Columbia are in the public domain and not copyright-eligible, even if annotated. This decision will likely affect those states and territories that have negotiated contracts with legal publishers regarding the issuance of official annotated copies of their statutes and may affect citizens of those states if the production of annotated codes diminishes. Additionally, the Supreme Court’s reasoning would seem to extend beyond annotated codes to more broadly reach and impact similar arrangements by the states with respect to other public documents, such as state zoning or flood maps.

One such pending case, *International Code Council, Inc v UpCodes, Inc*, No 17civ6261 (SDNY order denying cross-motions for summary judgment 27 May 2020), regards the status of model building codes drafted by private standards organizations but subsequently adopted by local government authorities. This case may be the first one where the Supreme Court’s *Georgia* ruling could prove to be outcome dispositive.

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