

“Cases Discussing Copyright and Incorporation by Reference”

PRO Codes proponents suggest that courts are mixed on copyright in standards that have been incorporated by reference into law. To the contrary, virtually every court to squarely address the issue has expressed deep concern about treating codes/standards as copyrightable. This isn't a “handful of district courts.” It's a large and growing number of district and appellate courts, going back decades. *BOCA* was in 1980. *Veeck* was in 2002. And yet Standards Development Organizations (SDOs) continue to develop model codes, with enough profit to pay CEO salaries in the high 6-7 figures.

➤ *Georgia v. Public.Resource.Org, Inc. (“PRO”), 590 U.S. ___, 140 S. Ct. 1498 (2020).*

“The animating principle behind [the government edicts rule] is that no one can own the law. Every citizen is presumed to know the law and it needs no argument to show that all should have free access to its contents.” 140 S.Ct at 1507

The Copyright Alliance claims:

In the context of deciding whether annotations included in the Official Code of Georgia Annotated were eligible for copyright protection, the Supreme Court clarified the scope of the government edicts doctrine.

The Court held that the government edicts doctrine provides that works are not eligible for copyright protection if they are (1) created by judges or legislators (2) in the course of the judicial and legislative duties. *Georgia v. PRO*, 140 S. Ct. 1498, 1508 (2020). The Court clarified that the government edicts doctrine does not apply to works authored by private parties. *Id.*¹

What's missing from Copyright Alliance “summary”:

- 1) Overstates and mischaracterizes – the Supreme Court decided the issue before it—an annotated set of statutes, not standards incorporated by reference.
- 2) On the SDOs characterization, lobbyists would retain copyright in laws they drafted.
- 3) The animating principles are crucial to how it would apply to copyrightability of mandatory standards.

Rejected division between “economy class” and “first class” access to the law. 140 S.Ct at 1512. Here, PRO Codes would endorse “economy class” reading rooms.

Overarching point: The IBR process IS lawmaking. Rigorous, detailed, creates a mandate. Regulators are sometimes sloppy, but this is not the way to handle it. Get rid of incorporation by reference instead.

➤ *Building Officials & Code Administrators International, Inc. (“BOCA”) v. Code Technology, Inc., 628 F.2d 730 (1st Cir. 1980).*

¹ H. Rep. No. 94-1476, at 60 (1976).

² *International Code Council (“ICC”) v. UpCodes, Inc.*, 1:17-cv-6261, 2020 WL 2750636 (S.D.N.Y. May 27, 2020).

³ Courts have uniformly held that the government edicts doctrine as clarified in the *Georgia* case does not dictate the result in those cases involving the copyrightability of privately developed codes and standards. See *Facility Guidelines Inst., Inc. v. UpCodes, Inc.*, 2023 WL 4026185, at *3 (E.D. Mo. June 15, 2023) (“Because FGI is a private entity that lacks the authority to make or interpret the law, the government edicts doctrine does not apply.”); *International Code Council v. UpCodes, Inc.*, 2020 WL 2750636, at *8 (S.D.N.Y. May 27, 2020) (the government edicts doctrine “clearly is not dispositive of this case” because “ICC is a private party that lacks the authority to make or interpret the law.”).

[C]itizens must have free access to the laws which govern them.... [I]t is hard to see how the public's essential due process right of free access to the law (including a necessary right freely to copy and circulate all or part of a given law for various purposes), can be reconciled with the exclusivity afforded a private copyright holder....

The Copyright Alliance claims:

The First Circuit reversed an order granting a preliminary injunction entered against the publisher of a Massachusetts building code that copied from BOCA's copyrighted building code without authorization. The court questioned whether BOCA could successfully enforce a copyright interest in a code that had been adopted into law. *BOCA v. Code Technology, Inc.*, 628 F.2d 730, 735 (1st Cir. 1980).

The court, however, declined to rule definitively on the merits of the issue without a complete evidentiary record given that SDOs "serve an important public function; arguably they do a better job than could the state alone in seeing that complex yet essential regulations are drafted, kept up to date and made *available*" and in light of the fact that "the rule denying copyright protection to judicial opinions and statutes grew out of a much different set of circumstances than do these technical regulatory codes." *Id.* at 736. The district court did not issue a subsequent decision on the issue, suggesting that the parties settled.

What's missing from Copyright Alliance "summary":

See quote in bold above. The court's remand order explicitly recognized the due process implications of allowing copyright ownership in IBR standards.

"Citizens are the authors of the law, and therefore its owners, regardless of who actually drafts the provisions, because the law derives its authority from the consent of the public, expressed through the democratic process."

Id. at 734, 736.

The Copyright Alliance claims:

- ***CCC Information Services, Inc. ("CCC") v. Maclean Hunter Market Reports, Inc.*, 44 F.3d 61 (2d Cir. 1994).**

The Second Circuit addressed the issue of whether a state regulation's incorporation of the Red Book, which provides automobile valuations, destroyed the work's copyright. The court rejected CCC's argument that when a copyrighted work is IBR'd, the public need for access to the content of the laws precludes copyright protection for that work. *CCC v. Maclean Hunter Market Reports, Inc.*, 44 F.3d 61, 73 (2d Cir. 1994). In reaching its decision, the Second Circuit acknowledged public policy considerations, including that "a rule that the adoption of such a reference by a state legislature or administrative body deprived the copyright owner of its property would raise very substantial problems under the Takings Clause of the Constitution." *Id.* at 74.

- ***Practice Management Information Corp. v. American Medical Association*, 121 F.3d 516 (9th Cir. 1997).**

The Ninth Circuit held that a coding system developed by the American Medical Association did not lose its copyright protection when federal regulations required applicants for Medicaid reimbursement to use the codes. *Practice Management Information Corp. v. American Medical Association*, 121 F.3d 516, 518 (9th Cir. 1997). The court reasoned that to "vitate copyright, in such circumstances, could,

without adequate justification, prove destructive of the copyright interest, in encouraging creativity,” a matter of particular significance in this context because of “the increasing trend toward state and federal adoptions of model codes.” *Id.* (quoting 1 Melville B. Nimmer & David Nimmer, *Nimmer on Copyright* § 5.06[C], at 5-92 (1996)).

What’s missing from the Copyright Alliance “summary”:

CCC and *Practice Mgmt. Info. Corp. v. Am. Med. Ass’n*, 121 F.3d 516 (9th Cir. 1997), both involved “compilations of data that had received governmental approval, not content that had been enacted into positive law’.” *Veck*, 293 F.3d at 805

---*CCC* involved a book of automobile valuations. While an insurance regulation specified that the book was “approved for use,” the regulation did not incorporate the book. 44 F.3d at 74, citing N.J. Admin. Code § 11:3-10.4 (1988).

---*Practice Management* similarly involved a “regulation mandating use” of a privately authored set of medical codes in Medicaid reimbursement applications, but did not incorporate the codes. 121 F.3d at 518. Because the external works at issue in those cases were cited in regulations but not incorporated by reference, the government edicts doctrine did not apply.

➤ ***County of Suffolk v. First American Real Estate Solutions*, 261 F.3d 179 (2d Cir. 2001).**

The Second Circuit held that tax maps were entitled to copyright protection. *County of Suffolk v. First American Real Estate Solutions*, 261 F.3d 179, 184 (2d Cir. 2001).

With respect to notice considerations, the court noted that there had been no allegation of difficulty obtaining access to the relevant tax map, such that there were no notice concerns. *Id.* at 195. Thus, the court held that the tax maps were not in the public domain. *Id.* at 195.

Same issue as CCC/PMI

➤ ***Veck v. Southern Building Code Congress Int’l (“SBCCI”)*, 293 F.3d 791 (5th Cir. 2002).**

The Copyright Alliance claims:

A sharply-divided *en banc* Fifth Circuit held that when model codes are adopted into law, they become “the law,” which cannot be owned by any entity. *Veck v. SBCCI*, 293 F.3d 791, 793 (5th Cir. 2002).

The six judges who joined the strongly worded dissent indicated they would have held that the “public policy scale is tipped in favor of enforcing SBCCI’s copyright protection” in light of SBCCI’s need for economic incentives to continue creating and modifying its codes and the lack of evidence that any member of the public had been denied access to the SBCCI’s codes. *Id.* at 818.

What’s missing from the Copyright Alliance “summary”:

The majority said:

The very process of lawmaking demands and incorporates contributions by “the people,” in an infinite variety of individual and organizational capacities. Even when a governmental body consciously decides to enact proposed model building codes, it does so based on various legislative considerations, the sum of which produce its version of “the law.” In performing their function, the lawmakers represent the public will, and the public are the final “authors” of the law.... .

293 F.3d at 799.

Also: SDOs claimed then, as they do now, that this decision spelled doom for the industry. Instead, they

are doing just fine.

- ***John G. Danielson, Inc. v. Winchester-Conant Props., Inc.*, 186 F. Supp. 2d 1 (D. Mass. 2002), *aff'd on other grounds by John G. Danielson, Inc. v. Winchester-Conant Props., Inc.*, 322 F.3d 26 (1st Cir. 2003).**

The Copyright Alliance claims:

The court rejected Winchester's argument that architectural plans lost their copyright protection when they became part of a restrictive covenant by which the town approved a proposed development project. *John G. Danielson, Inc. v. Winchester-Conant Props., Inc.*, 186 F. Supp. 2d 22 (D. Mass. 2002). The court characterized the hypothetical notice concern the First Circuit expressed in BOCA as having been "proven largely to be a paper tiger, as matter of fact and law," based on the record demonstrating that copyright owners largely provide public access to their works that are adopted into law and the availability of fair use and due process defenses in the event that the public did not have access. *Id.* at 22.

What's missing from the Copyright Alliance "summary":

On appeal the First Circuit explicitly dismissed the holding of the lower court that "otherwise copyrightable works ... do not lose copyright protection when they are adopted by government bodies or incorporated by reference into public enactments." The court reserved the question as the facts did not present it. Instead, the court ruled that the architectural drawings never were incorporated into law because the restrictive covenant was a private agreement, albeit with the government.

- ***American Society for Testing & Materials ("ASTM") v. Public.Resource.Org, Inc. ("PRO")*, 82 F.4th 1262 (D.C. Cir. 2023).**

The Copyright Alliance claims:

Three Standard Development Organizations ("SDOs"), ASTM, NFPA, and ASHRAE, brought copyright claims against Public.Resource.Org ("PRO"), a non-profit organization, for reproducing hundreds of copyrighted standards and posting them on PRO's website and the Internet Archive where they could be downloaded, copied, and printed for free and unrestricted use. The district court held that the SDOs' works did not lose copyright protection upon incorporation by reference. *ASTM v. PRO*, 2017 WL 473822 (D.D.C. Feb. 2, 2017). It reasoned that Congress "carefully weighed the competing policy goals of making incorporated works publicly available while also preserving the incentives and protections granted by copyright." *Id.* at *10 (citing H. Rep. No. 94-1476, at 60 (1976) (stating that under § 105 "use by the Government of a private work would not affect its copyright protection in any way"). Congress had also balanced the need for access by ensuring that IBR'd materials are "reasonably available" to the public. *Id.* at *11 (quoting 5 U.S.C. § 552(a)(1)).

On appeal, the D.C. Circuit declined to reach PRO's argument that incorporation by reference stripped the SDOs' works of copyright protection, instead remanding the case to the district court to reconsider affirmative defenses based on a fuller record. *Id.* at 449.

What's missing from the Copyright Alliance "summary":

Re the first appeal

(1) The Court held that standards "fall at the factual end of the fact-fiction spectrum, which counsels in favor of finding fair use." And legal text "falls plainly outside the realm of copyright protection." *Id.* Because incorporated standards have legal force, they too fall, "*at best*, at the outer edge of copyright's

protective purposes.” (emphasis added)

(2) Judge Katsas wrote a powerful concurrence that said: “The Court’s fair-use analysis faithfully recites the governing four-factor balancing test, yet, in conducting the balancing, it puts a heavy thumb on the scale in favor of an unrestrained ability to say what the law is.” *Id.* at 459. He continued:

[W]here a particular standard is incorporated as a binding legal obligation, and where the defendant has done nothing more than disseminate it, the Court leaves little doubt that the dissemination amounts to fair use.

Id. Judge Katsas also noted that he joined the Court’s opinion with the understanding that, “in the unlikely event that disseminating ‘the law’ might be held not to be fair use,” the Court would revisit the question of copyrightability. *Id.*

Following remand, the district court found PRO liable for copyright infringement of 32 non-IBR’d copyrighted standards but permitted posting of the remaining works because the non-profit organization had posted them for a non-commercial purpose, which the D.C. Circuit affirmed. *ASTM v. PRO*, 82 F.4th 1262 (D.C. Cir. 2023).

Re the second appeal:

- (1) The district court did a full analysis of all four factors. As to 184 of the standards at issue, and a portion of one other, the court found no copyright infringement on the basis of fair use. As to the remaining 32 standards, the district court found that the standard posted by Public Resource differed from the version incorporated into law and on that basis granted summary judgment to the Plaintiffs on those standards. *Id.* However, it declined to permanently enjoin Public Resource from posting those standards, finding the factual record offered “meager evidence of irreparable harm” and recognizing “the possibility that these standards will be incorporated into law at a later date.”
- (2) The appeals court held Public Resource’s use is for nonprofit, educational purposes, and that this use serves a different purpose than that of the plaintiffs. It also held that:
 - a) “Public Resource posts standards that government agencies have incorporated into law—no more and no less . . . If an agency has given legal effect to an entire standard, then its entire reproduction is reasonable in relation to the purpose of the copying, which is to provide the public with a free and comprehensive repository of the law.” And that
 - b) Although Public Resource has been posting incorporated standards for 15 years, the plaintiffs hadn’t shown any evidence of financial harm, which it found “telling” and there were “substantial public benefits of free and easy access to the law.”
 - c) Reading rooms fail to provide convenient access. “Among other things, text is not searchable, cannot be printed or downloaded, and cannot be magnified without becoming blurry. Often, a reader can view only a portion of each page at a time and, upon zooming in, must scroll from right to left to read a single line of text. Public Resource’s postings suffer from none of these shortcomings.”

➤ ***International Code Council (“ICC”) v. UpCodes, Inc.*, 1:17-cv-6261, 2020 WL 2750636 (S.D.N.Y. May 27, 2020).**

The Copyright Alliance claims:

ICC brought claims against the for-profit company UpCodes for, among other things, infringing its copyrighted codes by reproducing and distributing ICC’s codes (the “I-Codes”) and creating derivative works based on those codes, which it incorporated into its commercial products. The court held that posting of material that constitutes “only the law” does not constitute copyright infringement as a matter

of law. Id. at *19, 24-28. However, material questions regarding whether UpCodes had in fact accurately displayed only “the law,” required this issue to go to trial. The case is currently pending.

What’s missing from the Copyright Alliance “summary”:

The court definitively ruled that privately written codes, as adopted into law, can be freely disseminated and that doing so is not copyright infringement:

“At bottom, the controlling authorities make clear that a private party cannot exercise its copyrights to restrict the public's access to the law. Applying that principle to the facts of this case, ICC **cannot claim actionable infringement based only on Defendants' accurate posting of the I-Codes as Adopted, which are essentially enacted state and local laws.**”

The Court also recognized that “one of ICC’s foremost reasons for developing model codes **is for governments to enact them as law.**” (emphasis added)

The Court also that whatever ICC’s need for “economic incentives” was, that need could not outweigh the due process concerns with allowing a private entity to control the law.

➤ *National Fire Protection Association, Inc. (“NFPA”) v. UpCodes, Inc.*, 2:21-cv-05262-DSF-E, 2021 WL 4913276 (C.D. Cal. Aug. 9, 2021).

The Copyright Alliance claims:

NFPA sought a preliminary injunction prohibiting UpCodes from reproducing and distributing NFPA’s codes that had been IBR’d into state law and creating commercial derivative works based on those codes. The district court declined to reach the issue of whether IBR’d copyrighted material can be freely copied and distributed, and instead denied NFPA’s motion for a preliminary injunction, pointing to “uncertainties” regarding UpCodes’ affirmative defenses. *NFPA v. UpCodes*, 2021 WL 4913276 (C.D. Cal. Aug. 9, 2021). Following discovery, UpCodes filed a motion for summary judgment, which was fully briefed and is currently pending.

What’s missing from the Copyright Alliance “summary”:

In fact, the court in NFPA agreed with the court in ICC, holding: “The Court finds the same reasoning applies here, and therefore that UpCodes **reproduced the portion of the code that is law** with a transformative purpose.”

The Court also held that “NFPA has not established it is likely to succeed on its claim for copyright infringement.”

➤ *Facility Guidelines Inst., Inc. (“FGI”) v. UpCodes, Inc.*, No. 4:22-CV-01308-AGF, 2023 WL 4026185, at *1 (E.D. Mo. June 15, 2023).

The Copyright Alliance claims:

FGI sought a preliminary injunction prohibiting UpCodes from infringing three of its guidelines that had been IBR’d by reproducing and distributing these guidelines and creating commercial derivative works based on the guidelines. Although it recognized stripping copyright protection from IBR’d guidelines could “disincentivize private organizations from developing, publishing, and updating essential technical regulations and may raise significant concerns under the Takings Clause,” id., the court declined to extend these considerations in its holding that FGI was unlikely to succeed on the merits of its copyright infringement claim because of UpCodes’ successful affirmative defenses.

What's missing from the Copyright Alliance "summary":

In fact, the court said: "the Court is persuaded that UpCodes' posting of the FGI Guidelines that have been adopted into law likely constitutes fair use. As such, **there is not a fair chance that FGI will succeed** on its copyright infringement claim."

The court also held that there is a public interest in protecting copyrights: "But in this case, there is a competing public interest in unfettered access to the law. ... Here, **the public's interest in unfettered access to the law**"

Finally, here's what a state supreme court had to say when it was unable to obtain a copy of a standard at issue in a case before it: Here's what some other courts have had to say:

"If the rule of law means anything, it is that persons have meaningful access to the laws they are obliged to follow" ... "our concern here is not that the safety code is too complex, but that the code may not be accessible to those whose property interests it implicates, now that it has been adopted by a state regulatory agency and purports to carry the force of law"

-Bellwether v. Duke Energy, <https://law.justia.com/cases/indiana/supreme-court/2017/53s04-1703-ct-121.html>