

No. 24-537

In the Supreme Court of the United States

CANADIAN STANDARDS ASSOCIATION, PETITIONER

v.

P.S. KNIGHT COMPANY, LTD., ET AL.

*ON PETITION FOR A WRIT OF CERTIORARI
TO THE UNITED STATES COURT OF APPEALS
FOR THE FIFTH CIRCUIT*

REPLY BRIEF FOR THE PETITIONER

MICHAEL A. PARKS
KATHERINE E. COLVIN
ALEX D. WEIDNER
THOMPSON COBURN LLP
*55 East Monroe Street
Chicago, IL 60603*

WARREN DEAN, JR.
KATHLEEN KRAFT
THOMPSON COBURN LLP
*1909 K Street, N.W.,
Suite 600
Washington, DC 20006*

KANNON K. SHANMUGAM
Counsel of Record
MATTEO GODI
MIKAELA MILLIGAN*
THOMAS E. NIELSEN
PAUL, WEISS, RIFKIND,
WHARTON & GARRISON LLP
*2001 K Street, N.W.
Washington, DC 20006
(202) 223-7300
kshanmugam@paulweiss.com*

* Admitted in Texas and practicing law in the District of Columbia pending application for admission to the D.C. Bar under the supervision of bar members pursuant to D.C. Court of Appeals Rule 49(c)(8).

TABLE OF CONTENTS

	Page
A. The decision below is irreconcilable with this Court's precedents and implicates an existing circuit split	2
B. The decision below is erroneous	6
C. The question presented is exceptionally important and warrants review in this case	8

TABLE OF AUTHORITIES

Cases:

<i>Code Revision Commission v. Public.Resource.Org, Inc.</i> , 906 F.3d 1229 (11th Cir. 2018).....	3, 4
<i>Feist Publications, Inc. v. Rural Telephone Service Co.</i> , 499 U.S. 340 (1991).....	5
<i>Georgia v. Public.Resource.Org, Inc.</i> , 590 U.S. 255 (2020).....	1-4, 7, 8
<i>Google LLC v. Oracle America, Inc.</i> , 593 U.S. 1 (2021).....	6, 11
<i>Mason v. Montgomery Data, Inc.</i> , 967 F.2d 135 (5th Cir. 1992)	5
<i>Oracle America, Inc. v. Google Inc.</i> , 750 F.3d 1339 (2014), cert. denied, 576 U.S. 1071 (2015).....	5
<i>Veeck v. Southern Building Code Congress International, Inc.</i> , 293 F.3d 791 (5th Cir. 2002), cert. denied, 539 U.S. 969 (2003).....	2, 4-7

Constitution and statutes:

U.S. Const. Amend. I.....	8
Copyright Act of 1976, 17 U.S.C. 101-1511:	
17 U.S.C. 102(a).....	5
17 U.S.C. 102(b).....	6, 7
17 U.S.C. 302(a).....	7

Miscellaneous:

63 Fed. Reg. 8546 (Feb. 19, 1998)	9
---	---

In the Supreme Court of the United States

No. 24-537

CANADIAN STANDARDS ASSOCIATION, PETITIONER

v.

P.S. KNIGHT COMPANY, LTD., ET AL.

*ON PETITION FOR A WRIT OF CERTIORARI
TO THE UNITED STATES COURT OF APPEALS
FOR THE FIFTH CIRCUIT*

REPLY BRIEF FOR THE PETITIONER

Respondents seek to profit from the unauthorized sale of copies of petitioner's concededly copyrighted and copyrightable works. Under respondents' view, not only can copyright pirates relocate to the United States to infringe valid copyrights granted by signatories to the Berne Convention for the Protection of Literary and Artistic Works, but thousands of copyrighted works are no longer entitled to protection under the Copyright Act once they are incorporated by reference into some law or regulation anywhere in the world. That cannot be correct.

The decision below is inconsistent with this Court's recent decision in *Georgia v. Public.Resource.Org, Inc.*, 590 U.S. 255 (2020). Respondents claim that, under *Georgia*, a copyrighted work loses its protection once it has the

force of law. But, in *Georgia*, this Court expressly foreclosed precisely that inquiry.

The court of appeals' decision also implicates a circuit conflict over whether the merger doctrine should be analyzed at the time of creation or at the time of infringement. Respondents wave away that conflict and its relevance to this case. But because the en banc court of appeals has already spoken on the issue, respondents' efforts to rely on earlier circuit precedent are unavailing. And because it is undisputed that petitioner's standards were not incorporated by reference at creation, but only at (or after) publication, the conflict is plainly material here.

Respondents do not dispute that this case is a suitable vehicle to address an important issue of copyright law that affects thousands of copyrights and has serious foreign-relations implications. Nor do they dispute that the court of appeals' approach is at odds with the longstanding views of the Executive Branch and the Solicitor General. The petition for a writ of certiorari should be granted.

A. The Decision Below Is Irreconcilable With This Court's Precedents And Implicates An Existing Circuit Split

Respondents claim (Br. in Opp. 7-13) that the court of appeals' decision, which applied its earlier en banc decision in *Veeck v. Southern Building Code Congress International, Inc.*, 293 F.3d 791 (5th Cir. 2002), cert. denied, 539 U.S. 969 (2003), is consistent with this Court's precedents and does not implicate a circuit conflict. Respondents' arguments lack merit.

1. Respondents seek to characterize this Court's decision in *Georgia* as standing for the proposition that whether a copyrighted work gains the "force of law" is a sufficient condition to divest it of copyright protection. See Br. in Opp. 11-13. But the Court made clear in *Georgia* that focusing on "whether a particular work has 'the

force of law’ * * * cannot be squared with the reasoning or results of [the Court’s government-edicts] cases” or with the text of the Copyright Act. 590 U.S. at 272-273. Unable to come to grips with that statement, respondents simply ignore it—while still embracing the court of appeals’ distinction between copyrighted works that become “the law” and those that are not incorporated by reference. See Br. in Opp. 11-14; Pet. App. 10a.

To the extent that respondents rely on other aspects of *Georgia*, their arguments do not pass the straight-face test. To be sure, respondents are correct (Br. in Opp. 1-2) that the Court found the “animating principle” behind the government-edicts doctrine to be that “no one can own the law.” 590 U.S. at 265. But as the Court proceeded to make clear, that principle is “rooted” not in any atextual inquiry concerning the “force of law,” but rather in the Copyright Act’s “authorship” requirement, under which judges and legislators “may not be considered the ‘authors’ of the works they produce in the course of their official duties.” *Id.* at 259, 263. For that reason, the government-edicts doctrine applies to “binding works (such as opinions)” and “non-binding works (such as headnotes and syllabi)” alike. *Id.* at 265.

Respondents further contend that “the plaintiff in *Georgia* did not even attempt to argue that the binding portions of the Georgia Code were protected by copyright.” Br. in Opp. 11. But that is because the dispute in *Georgia* concerned only non-binding annotations to the Georgia Code. See *Code Revision Commission v. Public.Resource.Org, Inc.*, 906 F.3d 1229, 1231-1232 (11th Cir. 2018). While the State had argued the annotations were copyrightable because they lacked the force of law, the court of appeals *rejected* that argument, refusing to draw a “bright line distinction between edicts that have the force of law and those that do not” and focusing instead on

“whether a work is attributable to the constructive authorship of the People.” 906 F.3d at 1242 (citing *Veeck*, 293 F.3d at 796). This Court likewise held that the annotations were ineligible for copyright protection, but it rejected the “constructive authorship” theory that the court of appeals had borrowed from *Veeck*. See *Georgia*, 590 U.S. at 263. “Rather than attempting to catalog the materials that constitute ‘the law,’” the Court continued, the government-edicts doctrine “bars the officials responsible for creating the law from being considered the ‘author[s]’ of *whatever work* they perform in their capacity as lawmakers.” *Id.* at 265-266 (internal quotation marks and citation omitted).

In a final effort to reconcile their argument with *Georgia*, respondents reach beyond the record here to argue that, because petitioner has received “government funding,” it is “an arm of the legislature” “like LexisNexis” in *Georgia*, and thus “falls within the category of authors whose works—under the government edicts doctrine, as interpreted by the Court in *Georgia*—cannot be protected by copyright.” Br. in Opp. 13. But the Court never held that LexisNexis was an “arm of the legislature.” The only “arm of the legislature” in *Georgia* was a commission that was “created by the legislature, for the legislature, and consist[ed] largely of legislators.” 590 U.S. at 267. That commission “supervise[d] [LexisNexis’s] work and specify[d] what the annotations must include in exacting detail.” *Id.* at 261. And the parties did not dispute that the Copyright Act “deems the Commission the sole ‘author’” of the annotations. *Id.* at 267. Here, by contrast, it is undisputed that petitioner was not created or controlled by the legislature. See Pet. App. 34a. Petitioner is a “private part[y] who lack[s] the authority to make or interpret the law.” 590 U.S. at 265. The government-edicts doctrine simply does not apply.

2. Respondents downplay the existence of a circuit conflict as to whether the merger doctrine considers the circumstances at the time of infringement or at the time of creation. See Br. in Opp. 7-11. In the alternative, they argue that, even if such a conflict exists, it is irrelevant to this case. See *ibid.* Both arguments lack merit.

Respondents first argue that there is no conflict over the relevant timeframe for the merger analysis, because an earlier Fifth Circuit decision that “analyzed merger at the time of creation of the work” demonstrates that the Fifth Circuit does not apply the merger doctrine solely based on the circumstances at the time of infringement. Br. in Opp. 10-11 (citing *Mason v. Montgomery Data, Inc.*, 967 F.2d 135, 138-141 (1992)). But, a decade after that decision, the en banc Fifth Circuit in *Veck* rejected that approach and applied the merger doctrine based on the circumstances at the time of infringement. See 293 F.3d at 802. *Veck* is obviously the law of the Fifth Circuit, and it conflicts with *Oracle America, Inc. v. Google Inc.*, 750 F.3d 1339 (2014), cert. denied, 576 U.S. 1071 (2015), where the Federal Circuit held that it was erroneous to assess merger as of the time of copying. See Pet. 18-19; see also ANSI Br. 15-18 (collecting cases).

Respondents alternatively argue that, even if there is a circuit conflict over the relevant timeframe for the merger analysis, that issue is “immaterial” because petitioner’s model standards are “created and become law simultaneously.” Br. in Opp. 8. Not so. Even those jurisdictions that have prospectively incorporated revised versions of petitioner’s standards peg incorporation to the time of *publication*. See *id.* at 9-10. And publication logically occurs only after creation. See 17 U.S.C. 102(a); *Feist Publications, Inc. v. Rural Telephone Service Co.*, 499 U.S. 340, 355 (1991).

Respondents’ remaining arguments are similarly unavailing. *First*, echoing the court of appeals, respondents contend that the merger doctrine applies to petitioner’s standards because “[t]here is no alternative means for expressing language incorporated into binding law.” Br. in Opp. 7. But that presupposes that the merger analysis is focused on the time of infringement and not on the time of creation. And standards-development organizations routinely publish competing versions of the same model standards, proving that there are indeed multiple ways of expressing the same “idea” of a standard. See ANSI Br. 18; see also *Veck*, 293 F.3d at 807 (Higginbotham, J., dissenting); *id.* at 821 (Wiener, J., dissenting).

Second, respondents suggest that petitioner’s “purpose for writing the codes” somehow supports applying the merger doctrine to strip model standards of copyright protection once incorporated by reference into law. Br. in Opp. 8. But petitioner’s purpose is irrelevant. The merger doctrine—“if [it] exists”—“appli[es]” Section 102(b) of the Copyright Act by barring copyright protection over an existing “idea” that is itself uncopyrightable when “there is only one way to express” that idea. *Google LLC v. Oracle America, Inc.*, 593 U.S. 1, 48 (2021) (Thomas, J., dissenting).

B. The Decision Below Is Erroneous

Tellingly, respondents devote little attention to the text and structure of the Copyright Act itself. Instead of engaging with petitioner’s textual arguments, respondents contend that, in this context, courts should apply distorted versions of judge-made doctrines over the textually enumerated fair-use doctrine. See Br. in Opp. 13-14, 18-19. That contention is meritless.

1. Respondents suggest that the court of appeals’ “application of the merger doctrine is [] consistent with * * *

Section 102(b).” Br. in Opp. 2. But, as respondents later acknowledged (*id.* at 17-18), that interpretation of Section 102(b) requires crediting the court of appeals’ erroneous application of the merger doctrine based on circumstances that arise *after* the time of creation. See Pet. 18-22. Respondents’ argument is thus circular.

It is also erroneous. “Copyright in a work * * * subsists from its creation and[] * * * endures for [the copyright] term.” 17 U.S.C. 302(a). In other words, “copyright protection is both instant and automatic” and “vests as soon as a work is captured in a tangible form.” *Georgia*, 590 U.S. at 275. As the Solicitor General has long recognized, where a work “was concededly entitled to [copyright] protection at the time it was written,” “[n]othing in the Copyright Act * * * would permit a termination of copyright protection.” U.S. Br. at 7 & n.9, *Practice Management Information Corp. v. American Medical Association*, 525 U.S. 810 (No. 97-1254) (Aug. 7, 1998).

2. Contrary to respondents’ suggestion, petitioner is not inviting this Court to “lead with” fair use. See Br. in Opp. 18-19. Respondents argue that ruling in favor of petitioner would require citizens to “pay a monopoly holder for access to the laws.” *Id.* at 15. But that concern, as petitioner has noted (Pet. 22-23), is squarely addressed by the doctrine of fair use. See *Veeck*, 293 F.3d at 806-807 (Higginbotham, J., dissenting); *id.* at 817 (Wiener, J., dissenting). Refusing to apply those doctrines would allow respondents to continue profiting from its sales of unauthorized, commercial copies of petitioner’s copyrighted works.

Respondents claim that reliance on the fair-use doctrine is misplaced, because, as this Court has recognized, it is “notoriously fact sensitive and often cannot be resolved without a trial.” Br. in Opp. 18 (quoting *Georgia*, 590 U.S. at 275). By recognizing that reality, however, the

Court was surely not writing the fair-use doctrine out of the Copyright Act altogether. That is especially so where, as here, respondents seek to avoid the fair-use analysis in the name of the “First Amendment concerns” that the fair-use doctrine is “designed to accommodate.” *Georgia*, 590 U.S. at 275.

At bottom, respondents’ objections to the application of the fair-use doctrine reflect nothing more than a recognition that, if the doctrine were applied here, respondents would lose in light of their “egregious” conduct. See Pet. App. 18a, 20a (Douglas, J., dissenting). The court of appeals should have analyzed this case through the lens of fair use, and its failure to do so was erroneous.

C. The Question Presented Is Exceptionally Important And Warrants Review In This Case

Respondents do not meaningfully dispute that this case presents an important question of copyright law and is a suitable vehicle to address it. See Br. in Opp. 14-18, 19. Respondents dispute only the propositions that petitioner’s continued ability to develop model standards depends on the revenue generated from the sale of its copyrighted works and that respondents’ conduct raises serious foreign-relations concerns. Respondents are mistaken on both scores.

1. Respondents readily acknowledge the importance of the question presented. Indeed, according to respondents, the court of appeals’ decision stands for the proposition that the copyrights over the works underlying the “7,000 references to privately developed codes and standards” in the Code of Federal Regulations “cannot be infringed.” Br. in Opp. 15-16. So understood, the court of appeals’ holding has extraordinary implications. For one, it undermines the explicit position of the Office of Management and Budget, which has long instructed that, “[i]f

a voluntary standard is used and published in an agency document, [the] agency must observe and protect the rights of the copyright holder and any other similar obligations.” 63 Fed. Reg. 8546, 8554-8555 (Feb. 19, 1998). For another, it impairs “[t]he continued ability of private standards organizations to develop and update their materials at a high level of quality and integrity”—a matter that the Solicitor General has recognized to be “of substantial importance to the federal government.” U.S. Br. at 18, *Veeck v. Southern Building Code Congress International, Inc.*, 539 U.S. 969 (2003) (No. 02-355) (May 30, 2003).

2. Respondents accuse petitioner of offering “vague and conclusory allegations” that allowing business competitors to copy and sell its copyrighted works without authorization “will impede its ability to create those model codes.” Br. in Opp. 14. But “[c]reating and updating standards is expensive,” and many standards development organizations “rely on a back-loaded funding model” that involves “generat[ing] revenue from selling and licensing their standards to the professionals who use them in their work.” ANSI Br. 5. That model prevents standards-development organizations from being “tethered to large funders” or eliminating standards that “serve narrower markets and, accordingly, cannot generate enough revenue to cover the cost of their creation.” *Id.* at 6, 10; see *National Fire Protection Association v. UpCodes, Inc.*, Civ. No. 21-5262, Dkt. 13-2, ¶ 42 (C.D. Cal. July 9, 2021).

Respondents ultimately acknowledge that the court of appeals’ approach may “disincentivize[] creation” of model standards, but they brush off that concern on the ground that legislatures can “pay standards organizations for that creation.” Br. in Opp. 15. But that just underscores the irrationality of respondents’ approach, which

would require legislatures (and, ultimately, taxpayers) to foot the cost of standards development simply so that respondents may continue profiting from the developers' work.

3. Finally, respondents argue that, because the Berne Convention protects foreign copyrights only to the extent of "the laws of the country where protection is claimed," and because the Copyright Act does not extend copyright protection to "idea[s]," the court of appeals' decision is not in conflict with the Nation's obligations under the Convention. Br. in Opp. 16-18. But that claim assumes that model standards become subject to the merger doctrine once they are incorporated by reference into law. They do not. See pp. 5-6, *supra*. What is more, respondents fail to consider that signatories have a strong interest in ensuring that their copyrights are protected in other jurisdictions.

If any copyright infringer could relocate to the Fifth Circuit in order to sell works authored and copyrighted by standards-development organizations—as long as the works have been incorporated by reference into *some* law in *some* jurisdiction—those would-be infringers could harness the borderless Internet to continue to market and sell those works to customers located in the jurisdiction under whose copyright law the works are protected. That troubling scenario is not as farfetched as respondents suggest (Br. in Opp. 19); it describes respondents' conduct *in this case*. See Pet. 7-10.

Respondents contend that, "if [Congress] wishes to expand copyright protection to match the protection of other countries, it should do so." Br. in Opp. 19. But that is not the question presented in this case. Instead, the question is whether the government-edicts and merger doctrines strip concededly copyrighted and copyrightable works of protection under the Copyright Act merely

because those works have been subsequently incorporated by reference into law. See Pet. i. Answering that question in petitioner’s favor does not require any expansion of the scope of protection under the Copyright Act; as it stands, it is “contrary to the basic design of the Copyright Act” to make copyright protection “turn on events that occurred years after its creation.” U.S. Br. at 19, 22, *Google LLC v. Oracle America, Inc.*, 593 U.S. 1 (No. 18-956) (Feb. 19, 2020).

* * * * *

The petition for a writ of certiorari should be granted. In light of the government’s previous briefs on related questions and the foreign-relations concerns presented here, the Court may wish to call for the views of the Solicitor General.

Respectfully submitted.

MICHAEL A. PARKS
 KATHERINE E. COLVIN
 ALEX D. WEIDNER
 THOMPSON COBURN LLP
*55 East Monroe Street
 Chicago, IL 60603*

WARREN DEAN, JR.
 KATHLEEN KRAFT
 THOMPSON COBURN LLP
*1909 K Street, N.W., Suite 600
 Washington, DC 20006*

KANNON K. SHANMUGAM
 MATTEO GODI
 MIKAELA MILLIGAN*
 THOMAS E. NIELSEN
 PAUL, WEISS, RIFKIND,
 WHARTON & GARRISON LLP
*2001 K Street, N.W.
 Washington, DC 20006
 (202) 223-7300
 kshanmugam@paulweiss.com*

DECEMBER 2024