

## Darden v. Peters: Giving Deference Where Deference May Not Be Due

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# Recent Decisions

## THE UNITED STATES COURT OF APPEALS FOR THE FOURTH CIRCUIT

### ***DARDEN v. PETERS*: GIVING DEFERENCE WHERE DEFERENCE MAY NOT BE DUE**

In *Darden v. Peters*,<sup>1</sup> the United States Court of Appeals for the Fourth Circuit considered the standard of review that courts should apply when reviewing a denial of copyright protection by the Register of Copyrights (the Register).<sup>2</sup> The court held that if such a denial is challenged under the judicial review provisions of the Administrative Procedure Act (the APA),<sup>3</sup> an abuse of discretion standard is necessary.<sup>4</sup> Although the court correctly interpreted and applied the standard set forth in the APA,<sup>5</sup> its holding raises the question of whether the Register's determinations as to copyrightability warrant an abuse of discretion standard, given that determinations of copyrightability require no technical expertise.<sup>6</sup> The court should have applied a de novo standard of review for copyright protection, thereby eliminating separation of powers concerns that potentially arise when the judiciary gives deference to the Register on questions of law.<sup>7</sup>

#### I. THE CASE

William Darden developed a website named “appraisers.com,” a referral service through which users could locate real estate appraisers in the United States by navigating and clicking on digital maps.<sup>8</sup> Darden hired Sean Pecor to design the maps so as to enable users to find appraisers in particular locations by clicking on regions of the

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1. 488 F.3d 277 (4th Cir. 2007).

2. *Id.* at 283–86.

3. 5 U.S.C. §§ 701–706 (2000).

4. *Darden*, 488 F.3d at 286.

5. *See infra* Part IV.A.

6. *See infra* Part IV.B.

7. *See infra* Part IV.C.

8. *Darden*, 488 F.3d at 280.

maps.<sup>9</sup> Pecor began with a digital Census map of the United States and added coloring and shading to achieve a three-dimensional effect.<sup>10</sup> Pecor also labeled each state and delineated counties within each state, which, if clicked on, would reveal a listing of local appraisers.<sup>11</sup> Pecor assigned to Darden any copyright interest he possessed in the completed maps and website design.<sup>12</sup>

In May 2002, Darden filed two applications for copyright registration with the United States Copyright Office (the Copyright Office).<sup>13</sup> In the first application, Darden sought to register his website as a technical drawing, based on “graphics, text, colors, and arrangement” that Pecor had added to the original Census maps.<sup>14</sup> In the second application, Darden sought to register the maps as derivative works, based on “font and color selection; visual effects such as relief, shadowing, and shading; labeling; [and] call-outs”<sup>15</sup> that altered the original Census maps.<sup>16</sup>

The Copyright Office rejected both applications.<sup>17</sup> The examiner, citing lack of authorship that would have merited copyright protection of the maps, explained that the minor variations to the original Census maps were insufficient to add the minimum amount of originality required.<sup>18</sup> With respect to registration of the website as a technical drawing, the examiner noted that APPRAISERSdotCOM contained neither a technical drawing nor the minimum amount of originality required and, thus, was ineligible for copyright protection.<sup>19</sup> The examiner suggested, however, that Darden file an amended application for APPRAISERSdotCOM based on the text and level of compilation, which, the examiner noted, could “support a copyright claim, if they [were] original.”<sup>20</sup>

Reasserting the originality of the alterations to the maps, Darden requested reconsideration of his applications.<sup>21</sup> Darden also filed an amended application to register APPRAISERSdotCOM as a compila-

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9. *Id.*

10. *Id.*

11. *Id.*

12. *Id.*

13. *Id.*

14. *Id.* (internal quotation marks omitted).

15. A “call-out” is “a letter, word, number or other symbol identifying a specific part of an illustration.” THE OXFORD COLLEGE DICTIONARY 201 (2d ed. 2007).

16. *Darden*, 488 F.3d at 280 (internal quotation marks omitted).

17. *Id.*

18. *Id.* at 280–81.

19. *Id.* at 281.

20. *Id.* (internal quotation marks omitted).

21. *Id.*

tion and derivative work.<sup>22</sup> The Copyright Office denied both requests and again rejected Darden's applications.<sup>23</sup> In support of the denial, the examiner clarified that, in order for copyright protection to apply to derivative works, the added portion must be sufficiently original.<sup>24</sup> The examiner further explained that, with respect to AP-PRASERSdotCOM, changes to layout, size, format, spacing, and coloring did not render the website eligible for copyright protection as a compilation.<sup>25</sup>

Darden appealed the denial of his applications to the Copyright Office Board of Appeals (the Board), which affirmed the denial of registration for both the maps and the website.<sup>26</sup> The Board echoed the reasoning of the examining division, finding that the maps lacked creativity and that Darden's application for registration of the website elements was "too broad."<sup>27</sup>

Darden then filed an action under the APA in the District Court for the Eastern District of North Carolina against Marybeth Peters, the Register of Copyrights.<sup>28</sup> The district court, applying an abuse of discretion standard pursuant to section 706(2)(A) of the APA,<sup>29</sup> granted the Register's motion for summary judgment.<sup>30</sup> Darden appealed to the United States Court of Appeals for the Fourth Circuit, claiming that the district court should have applied a *de novo* standard of review and that his maps and website met the minimum standard of originality required for copyright protection.<sup>31</sup>

## II. LEGAL BACKGROUND

Any copyright applicant may challenge a denial of copyright registration in one of two ways: (1) the applicant may bring an infringement action under section 411(a) of the Copyright Act<sup>32</sup> if there is potential infringement;<sup>33</sup> or (2) the applicant may bring a direct ac-

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22. *Id.*

23. *Id.* at 282.

24. *Id.*

25. *Id.*

26. *Id.*

27. *Id.* (internal quotation marks omitted).

28. *Id.* at 282–83.

29. Section 706(2)(A) requires courts to give substantial deference to the determinations of agencies, which may be overturned if the agency abused its discretion. 5 U.S.C. § 706(2)(A) (2000).

30. *Darden*, 488 F.3d at 283 (citing 5 U.S.C. § 706(2)(A)).

31. *Id.* at 283–84.

32. 17 U.S.C. §§ 101–1332 (2000).

33. *Id.* § 411(a).

tion for judicial review of the denial under the APA.<sup>34</sup> In an infringement action, the issue of copyrightability is reviewed *de novo*.<sup>35</sup> In an action under the APA, by contrast, the Register's denial of registration is reviewed under the more deferential "abuse of discretion" standard.<sup>36</sup> The Supreme Court of the United States has also extended APA deference to decisions by the United States Patent and Trademark Office (the PTO), citing the PTO's technical expertise in issues of patentability.<sup>37</sup>

A. *A Majority of Courts Review the Issue of Copyrightability in Infringement Actions Using a De Novo Standard of Review*

If a copyright applicant elects to bring an action for copyright infringement under Section 411(a), the issue of copyrightability is a question of law to be determined by the courts.<sup>38</sup> A claimant alleging infringement must establish "copying of constituent elements of the work that are copyrightable."<sup>39</sup> Addressing the standard of review in infringement cases, the United States Court of Appeals for the Second Circuit, in *Carol Barnhart Inc. v. Economy Cover Corp.*, opined that "the mute testimony of [the work] put[s the court] in as good a position as the Copyright Office to decide the issue [of copyrightability],"<sup>40</sup> and denied relief to the claimant upon independently determining that

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34. *Id.* § 701(d); *see also* *Atari Games Corp. v. Oman (Atari I)*, 888 F.2d 878, 880 (D.C. Cir. 1989).

35. *See infra* Part II.A.

36. *See infra* Part II.B.

37. *See infra* Part II.C.

38. *Carol Barnhart Inc. v. Econ. Cover Corp.*, 773 F.2d 411, 414 (2d Cir. 1985); *see also* *Gaiman v. McFarlane*, 360 F.3d 644, 648 (7th Cir. 2004) (holding that copyrightability "is strictly an issue for the court"); *Yankee Candle Co. v. Bridgewater Candle Co.*, 259 F.3d 25, 34 n.5 (1st Cir. 2001) ("The extent to which [the work] contain[s] protected expression is a matter of law, determined by the court"); *Publ'ns Int'l v. Meredith Corp.*, 88 F.3d 473, 478 (7th Cir. 1996) (reasoning that the question of whether a work constitutes copyrightable subject matter involves statutory interpretation and is, therefore, subject to *de novo* review); *Newton v. Diamond*, 204 F. Supp. 2d 1244, 1253 (C.D. Cal. 2002) (holding that "[t]he protectability of elements of a copyrighted work is a question of law for the court"), *aff'd*, 349 F.3d 591 (9th Cir. 2003), *amended on other grounds by* 388 F.3d 1189 (9th Cir. 2004). *But see* *John Muller & Co. v. N.Y. Arrows Soccer Team*, 802 F.2d 989, 990 (8th Cir. 1986) (*per curiam*) (applying an abuse of discretion standard to the Register's decision as to copyrightability); *Norris Indus. v. Int'l Tel. & Tel. Corp.*, 696 F.2d 918, 922 (11th Cir. 1983) (same).

39. *Compaq Computer Corp. v. Ergonome Inc.*, 387 F.3d 403, 407 (5th Cir. 2004).

40. 773 F.2d at 414 (internal quotation marks omitted); *see also* *Atari I*, 888 F.2d 878, 886-87, 889 (D.C. Cir. 1989) (Silberman, J., concurring) (distinguishing the APA's deferential standard of review from "an infringement action in which the court [is] not obliged to defer to an agency's action or interpretation").

the allegedly infringed work was not copyrightable.<sup>41</sup> As such, copyrightability can be decided as a matter of law.<sup>42</sup>

The chief consideration in this analysis is whether the work is original.<sup>43</sup> The Supreme Court has held that the United States Constitution requires originality as a prerequisite for copyright protection.<sup>44</sup> In *Feist Publications, Inc. v. Rural Telephone Service Co.*,<sup>45</sup> the Supreme Court described the requirements of originality and denied copyright protection for a telephone book on the ground that facts are generally not copyrightable.<sup>46</sup> The Court clarified that the level of originality required is “extremely low” and will be met if there is even “a slight amount” of creativity.<sup>47</sup> As such, the Court observed, “compilations of facts are within the subject matter of copyright”<sup>48</sup> if their “selection, coordination, and arrangement” meet the originality standard.<sup>49</sup> The Court, however, recognized that there is a category of works not susceptible to copyright protection because “the creative spark is utterly lacking.”<sup>50</sup> Finally, the Court noted that originality does not require that the work be novel and, indeed, that two authors may independently compose identical works that are equally copyrightable.<sup>51</sup>

*B. Courts Review the Issue of Copyrightability in Actions Under the APA Using an Abuse of Discretion Standard*

Contrary to judicial review of copyrightability in an infringement action, courts will apply an abuse of discretion standard of review to

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41. *Carol Barnhart*, 773 F.2d at 412, 414.

42. *Id.*; see also, e.g., *Collezione Europa U.S.A., Inc. v. Hillsdale House, Ltd.*, 243 F. Supp. 2d 444, 451–52 (M.D.N.C. 2003).

43. *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345 (1991) (“The *sine qua non* of copyright is originality.”).

44. *Id.* at 346.

45. 499 U.S. 340 (1991).

46. *Id.* at 344–45, 364.

47. *Id.* at 345. However, the *Feist* Court held that the copied elements of the telephone book at issue consisted exclusively of uncopyrightable factual data and that the compilation did not exhibit sufficiently original selection, coordination, or arrangement to merit copyright protection. *Id.* at 361–62.

48. *Id.* at 345. The Court stressed, however, that facts alone are not subject to copyright protection. *Id.*

49. *Id.* at 362; see also *Satava v. Lowry*, 323 F.3d 805, 811 (9th Cir. 2003) (“[A] combination of unprotectable elements is eligible for copyright protection only if those elements are numerous enough and their selection and arrangement original enough that their combination constitutes an original work of authorship.”); *Dam Things from Den. v. Russ Berrie & Co.*, 290 F.3d 548, 563 (3d Cir. 2002) (noting that copyright protection of derivative works applies only to “elements . . . added to the work” and may not extend to “the underlying work”).

50. *Feist*, 499 U.S. at 359.

51. *Id.* at 345–46.

the Register's decisions if they are challenged under the APA.<sup>52</sup> The plain language of the APA, as well as the Supreme Court's interpretation of it, mandates an abuse of discretion standard for actions that directly challenge the Register's denial of copyright protection.<sup>53</sup> Despite being widely accepted, judicial deference to agency determinations under the APA nevertheless implicates the notion of separation of powers.<sup>54</sup>

### 1. *The APA*

The Copyright Act specifies that all challenges to the Register's actions and determinations regarding copyrightability under the Copyright Act are subject to review under the Administrative Procedure Act.<sup>55</sup> The APA, codified in title 5 of the United States Code, provides that action by government agencies is subject to judicial review "except to the extent that . . . statutes preclude judicial review; or . . . agency action is committed to agency discretion by law."<sup>56</sup>

Unlike the court's unfettered *de novo* analysis in infringement actions under section 411(a) of the Copyright Act, the APA confines courts to a more limited role.<sup>57</sup> Specifically, the APA allows a court to overturn an agency's decision if it is "arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with law."<sup>58</sup>

In the landmark case of *Citizens to Preserve Overton Park v. Volpe*,<sup>59</sup> the Supreme Court defined the parameters of APA review, affirming

52. *Atari Games Corp. v. Oman (Atari II)*, 979 F.2d 242, 243 (D.C. Cir. 1992); *OddzOn Prods., Inc. v. Oman*, 924 F.2d 346, 348 (D.C. Cir. 1991); *Coach, Inc. v. Peters*, 386 F. Supp. 2d 495, 497 (S.D.N.Y. 2005).

53. *See infra* Part II.B.1.

54. *See infra* Part II.B.2.

55. 17 U.S.C. § 701(e) (2000).

56. 5 U.S.C. § 701(a) (2000).

57. Section 706(2) of the APA states that courts should set aside agency actions if they are "(A) arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with law; (B) contrary to constitutional right, power, privilege, or immunity; (C) in excess of statutory jurisdiction, authority, or limitations, or short of statutory right; [or] (D) without observance of procedure required by law." *Id.* § 706(2)(A)–(D); *see also* *United States v. Mead Corp.*, 533 U.S. 218, 227–28 (2001) (applying a deferential standard to review agency action under the APA); *Citizens to Preserve Overton Park v. Volpe*, 401 U.S. 402, 413–14 (1971) (same), *abrogated on other grounds by Califano v. Sanders*, 430 U.S. 99, 105 (1977); *Yale-New Haven Hosp. v. Leavitt*, 470 F.3d 71, 79 (2d Cir. 2006) (same); *Sierra Club v. Marsh*, 976 F.2d 763, 769 (1st Cir. 1992) (same); *Hickory Neighborhood Def. League v. Skinner*, 910 F.2d 159, 162 (4th Cir. 1990) (same); *Wilkinson v. Abrams*, 627 F.2d 650, 662 (3d Cir. 1980) (same).

58. 5 U.S.C. § 706(2)(A).

59. 401 U.S. 402 (1971), *abrogated on other grounds by Califano*, 430 U.S. at 105. The *Overton Park* Court ultimately remanded the case to the district court for a determination

that agency action reviewed under the APA is entitled to deference.<sup>60</sup> Although APA review is narrow,<sup>61</sup> the Court in *Overton Park* clarified that it does not allow an agency to omit a satisfactory explanation for a challenged decision.<sup>62</sup> The Court further explained that the reviewing court will examine whether the agency properly considered all relevant factors in making its determination.<sup>63</sup> It has also been established that a court may overturn an agency's decision if the agency applied the wrong legal standard<sup>64</sup> or considered factors it should not have considered.<sup>65</sup>

The APA identifies two exceptions to judicial application of a deferential standard of review: courts have no jurisdiction to review agency action that is committed to agency discretion by law; and courts may undertake expanded, non-deferential review of agency action if the agency action was unwarranted by the facts.<sup>66</sup> First, the Supreme Court has clarified that the statutory exception for cases in which action is committed to agency discretion by law is limited to those cases in which the statutory language is so broad that, in effect, "there is no law to apply."<sup>67</sup> Second, the Court has also narrowly con-

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of whether the Department of Transportation's explanation for its challenged action was sufficient. *Id.* at 420–21.

60. *Id.* at 413–14.

61. *Motor Vehicle Mfrs. Ass'n v. State Farm Mut. Auto. Ins. Co.*, 463 U.S. 29, 43 (1983).

62. 401 U.S. at 420–21; *see also Motor Vehicle Mfrs.*, 463 U.S. at 43 (clarifying that the agency must "articulate a satisfactory explanation for its action including a rational connection between the facts found and the choice made" (internal quotation marks omitted) (quoting *Burlington Truck Lines, Inc. v. United States*, 371 U.S. 156, 168 (1962))).

63. *Overton Park*, 401 U.S. at 420–21; *see also Motor Vehicle Mfrs.*, 463 U.S. at 43 (explaining the need for a court to examine the pertinent factors).

64. *Turgeon v. Admin. Review Bd.*, 446 F.3d 1052, 1057 (10th Cir. 2006). In *Turgeon*, the United States Court of Appeals for the Tenth Circuit reviewed a decision of the Administrative Review Board (the ARB) where the ARB had found that the petitioner's state law claim was completely preempted by a federal law claim and had subsequently granted summary judgment to the petitioner's employer. *Id.* at 1054–55. The court of appeals held that because a completely preempted state law claim states a federal claim as a matter of law, the ARB was wrong in dismissing the petitioner's claim. *Id.* at 1054, 1060.

65. *Motor Vehicle Mfrs.*, 463 U.S. at 43 (holding that an agency decision is also arbitrary if the agency "offered an explanation for its decision that runs counter to the evidence before the agency, or is so implausible that it could not be ascribed to a difference in view or the product of agency expertise").

66. *Overton Park*, 401 U.S. at 410, 414.

67. *See id.* at 410, 413 (quoting S. REP. NO. 79-752, at 212 (1945)) (rejecting an argument that the Secretary of Transportation's decision was committed solely to agency discretion by emphasizing that this was not a case where there was no law to apply). The respondents in *Overton Park* argued that the statute at issue, which directed the Secretary of Transportation to balance competing interests regarding the use of public parkland, committed the inquiry to the Secretary's complete discretion because it was merely a general directive for the Secretary to consider all interests. *Id.* at 411–13. The Court rejected this argument on the ground that "the very existence of the statutes indicates that protection of

strued the exception contained in section 706(2)(F) of the APA, which allows de novo review for agency action “unwarranted by the facts.”<sup>68</sup> In analyzing this exception, the Court has emphasized two situations in which it applies: (1) when agency action is “adjudicatory in nature and the agency factfinding procedures are inadequate”; and (2) when issues that are raised to “enforce nonadjudicatory agency action” were not before the agency and, thus, require “independent judicial factfinding.”<sup>69</sup>

In general, the APA’s abuse of discretion standard comports with the Supreme Court’s broader view, articulated in *Chevron U.S.A. Inc. v. Natural Resources Defense Council*,<sup>70</sup> that agencies are entitled to deference in their decisionmaking.<sup>71</sup>

## 2. Separation of Powers Implications of the APA

While judicial deference to agencies under the APA is firmly established and universally recognized,<sup>72</sup> the APA’s abuse of discretion standard nevertheless implicates the doctrine of separation of powers because the APA addresses the review by one branch of government of the decisions of another branch.<sup>73</sup> The notion of separation of powers is fundamental to the American system of government.<sup>74</sup> It

parkland was to be given paramount importance” and, thus, that there was “law to apply.” *Id.* at 412–13 (internal quotation marks omitted).

68. 5 U.S.C. § 706(2)(F) (2000).

69. *Overton Park*, 401 U.S. at 415. An example of nonadjudicatory agency action is a public hearing regarding distribution of local funds for infrastructure, such as highway construction. Such a hearing is quasi-legislative in nature and “not designed to produce a record that is to be the basis of agency action.” *Id.* at 414–15.

70. 467 U.S. 837 (1984).

71. *Id.* at 844. The *Chevron* Court, however, did not mention or cite to the APA in its opinion. *United States v. Mead Corp.*, 533 U.S. 218, 241–42 & n.2 (2001) (Scalia, J., dissenting).

72. The volume of federal cases that have applied a deferential standard under the APA supports this conclusion. *See, e.g., supra* note 57.

73. *See, e.g.,* *Pinho v. Gonzales*, 432 F.3d 193, 202 (3d Cir. 2005) (discussing the significance of judicial review of agency decisions and observing that such review implicates separation of powers principles).

74. *See* *Mistretta v. United States*, 488 U.S. 361, 372, 380–81 (1989) (discussing the constitutional understanding of separation of powers and holding that Congress had not upset the doctrine by requesting assistance from the other branches); *see also* *Cheney v. U.S. Dist. Court*, 542 U.S. 367, 381–82 (2004) (recognizing embarrassment to the executive branch and “intrusion by the federal judiciary” on “federal-state relations” as “separation-of-powers considerations” (citations and internal quotation marks omitted)); *Vieth v. Jubelirer*, 541 U.S. 267, 302 (2004) (plurality opinion) (noting the existence of “lines of separation drawn by the Constitution between the three departments of the government” (citations and internal quotation marks omitted)); *Youngstown Sheet & Tube Co. v. Sawyer*, 343 U.S. 579, 635 (1952) (Jackson, J., concurring) (observing that the Constitution “enjoins upon [the branches of government] separateness but interdependence, auton-

requires that the three branches of government maintain some degree of separation and prohibits “intrusion”<sup>75</sup> of one branch into the affairs of another.<sup>76</sup>

The APA was enacted in part due to separation of powers concerns and, indeed, the statute reflects such considerations.<sup>77</sup> For example, one justification for prohibiting reviewing courts from substituting their judgment for that of the agency is the theory that the executive branch, to preserve separation of powers, must possess independent authority in certain areas.<sup>78</sup> As such, one court has reasoned that de novo judicial review of decisions made pursuant to this authority would constitute “interference” into the affairs of the Executive.<sup>79</sup> Conversely, a complete lack of judicial review of agency action would also violate separation of powers because the Executive would have unchecked authority to act through its agencies.<sup>80</sup>

*C. The Supreme Court Has Extended the APA’s Deferential Standard to Actions Challenging a Denial of Patent Protection by the United States Patent and Trademark Office*

In *Dickinson v. Zurko*,<sup>81</sup> the Supreme Court considered whether the APA’s discretionary standard of review should apply to decisions of the PTO.<sup>82</sup> The United States Court of Appeals for the Federal Circuit contended, in particular, that the PTO should be exempt from APA abuse of discretion review based on section 559 of the APA, which states that the APA does not repeal “additional [judicial review]

omy but reciprocity”). The Supreme Court has held that the judiciary’s power is to “say what the law is.” *Marbury v. Madison*, 5 U.S. (1 Cranch) 137, 177 (1803).

75. *Cheney*, 542 U.S. at 381 (internal quotation marks omitted).

76. *Youngstown*, 343 U.S. at 635 (Jackson, J., concurring). In practice, courts apply the doctrine flexibly and do not require complete separation of the branches. *United States v. Nixon*, 418 U.S. 683, 706 (1974) (citing *Youngstown*, 343 U.S. at 635 (Jackson, J., concurring)), *superseded by rule on other grounds*, FED. R. EVID. 104(a). As such, each branch accords the other two branches some amount of deference. *Id.* at 704, 706.

77. *See, e.g., Bd. of Trade v. SEC*, 883 F.2d 525, 530 (7th Cir. 1989) (interpreting the “committed-to-agency-discretion” provision in the APA as “in large measure a restatement of the separation-of-powers problem”).

78. *Local 2855 v. United States*, 602 F.2d 574, 579 (3d Cir. 1979).

79. *County of Esmeralda v. U.S. Dep’t of Energy*, 925 F.2d 1216, 1223 (9th Cir. 1991) (Wallace, C.J., concurring in part and dissenting in part) (citing *Local 2855*, 602 F.2d at 579).

80. *See Pinho v. Gonzales*, 432 F.3d 193, 202 (3d Cir. 2005) (explaining that the absence of judicial review of deportation proceedings would violate separation of powers); *see also Peretz v. United States*, 501 U.S. 923, 929 n.6 (1991) (emphasizing the importance of an “independent judiciary” in maintaining the governmental structure of checks and balances (citations and internal quotation marks omitted)).

81. 527 U.S. 150 (1999).

82. *Id.* at 152–54.

requirements.”<sup>83</sup> The Court concluded that the APA’s abuse of discretion standard nevertheless applied, emphasizing that the PTO’s technical expertise enables it to examine the issue of patentability better than the judiciary and, thus, that its decisions must be granted deference.<sup>84</sup> The Court also acknowledged a long line of precedent where courts had recognized the particular expertise of the PTO and other agencies, and accorded them deference.<sup>85</sup>

### III. THE COURT’S REASONING

In *Darden v. Peters*,<sup>86</sup> the United States Court of Appeals for the Fourth Circuit affirmed the judgment of the District Court for the Eastern District of North Carolina and held that judicial review of copyright determinations under the APA is confined to an abuse of dis-

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83. *Id.* at 154 (citing 5 U.S.C. § 559 (2000)). The Federal Circuit claimed that a different standard of review had been in place for review of PTO decisions at the time the APA was adopted and, hence, that the stricter “clearly erroneous” standard was an “additional requirement” within the meaning of Section 559. *Id.* at 153–54.

84. *Id.* at 152, 160. The Court observed, however, that the Federal Circuit has acquired some expertise in the area of patents. *Id.* at 163. See generally *Voda v. Cordis Corp.*, 476 F.3d 887, 903 (Fed. Cir. 2007) (observing that the Federal Circuit has “exclusive jurisdiction of appeals on patent claims”).

85. *Dickinson*, 527 U.S. at 160–61 (citing *NLRB v. Link-Belt Co.*, 311 U.S. 584, 597 (1941); *Rochester Tel. Corp. v. United States*, 307 U.S. 125, 145–46 (1939); *Interstate Commerce Comm’n v. Louisville & Nashville R.R. Co.*, 227 U.S. 88, 98 (1913)); see also *Turner Broad. Sys. v. FCC*, 520 U.S. 180, 196 (1997) (equating deference to Congress with “deference owed to administrative agencies because of their expertise”); *Thomas Jefferson Univ. v. Shalala*, 512 U.S. 504, 512 (1994) (stating, in review of a decision by the Secretary of Health and Human Services, that “[the APA’s] broad deference is all the more warranted when, as here, the regulation concerns a *complex and highly technical* regulatory program, in which the identification and classification of relevant criteria necessarily require significant expertise and entail the exercise of judgment grounded in policy concerns” (emphasis added) (citations and internal quotation marks omitted)); *Martin v. Occupational Safety & Health Review Comm’n*, 499 U.S. 144, 151 (1991) (“[A]pplying an agency’s regulation to complex or changing circumstances calls upon the agency’s unique expertise . . . .”); *Fed. Power Comm’n v. Fla. Power & Light Co.*, 404 U.S. 453, 464–66 (1972) (indicating that the technical expertise of agencies justifies application of a deferential standard of judicial review).

Courts have further justified a more deferential standard of review in the context of PTO decisions by pointing out that the PTO conducts a substantive evaluation of each patent application prior to issuing a patent, a process not undertaken by the Register. *Stein v. Mazer*, 111 F. Supp. 359, 360–61 (D. Md. 1953), *rev’d on other grounds*, 204 F.2d 472 (4th Cir. 1953).

Moreover, some courts have recognized the Register’s “expertise” in interpreting copyright laws. *Mays & Assocs. Inc. v. Euler*, 370 F. Supp. 2d 362, 369 (D. Md. 2005). Such recognition, however, is countered by the general expertise of courts in “interpreting and applying the law” to the pertinent facts. *Van Ooteghem v. Gray*, 628 F.2d 488, 492 (5th Cir. 1980); see also *Vermont v. New York*, 417 U.S. 270, 277 (1974) (per curiam) (noting that the judiciary’s role is in interpreting and applying law).

86. 488 F.3d 277 (4th Cir. 2007).

cretion standard.<sup>87</sup> Writing for a unanimous panel, Judge Traxler began by noting that the APA applies to judicial review of actions taken by the Register of Copyrights pursuant to section 701(e) of the Copyright Act.<sup>88</sup> The court then noted that the district court's decision to apply an abuse of discretion standard to the Register's denial of copyright protection was supported by the limited number of federal decisions addressing the issue.<sup>89</sup> Rejecting William Darden's claim that denial of copyright registration should be reviewed under a *de novo* standard because it has "constitutional ramifications,"<sup>90</sup> the court clarified that while Article I, Section 8 of the United States Constitution gives "Congress the power to provide copyright protection," it does not require that Congress do so.<sup>91</sup> Thus, the court reasoned, any rights or remedies that Darden possessed with respect to his copyright claim were based exclusively in statute and lacked the constitutional basis required to form an exception to abuse of discretion review.<sup>92</sup>

The court next dismissed Darden's claim that the Register's denial of his copyright application was "not in accordance with law" under section 706(2)(A) of the APA.<sup>93</sup> The court noted that Darden was simply arguing that the Register's result was incorrect, not that the Register "applied the wrong legal standard or misapprehended or ignored the controlling legal principles," and that the court, therefore, was only authorized to determine whether the Register considered all appropriate factors.<sup>94</sup>

The court also addressed Darden's contention that the court should apply the same standard of review both in infringement actions under section 411(a) of the Copyright Act<sup>95</sup> and in cases directly reviewing denial of registration under the APA "for the sake of efficiency and predictability."<sup>96</sup> The court reaffirmed that, although

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87. *Id.* at 286.

88. *Id.* at 283 (citing 17 U.S.C. § 701(e) (2000)).

89. *Id.* (citing *Atari II*, 979 F.2d 242, 243 (D.C. Cir. 1992); *OddzOn Prods., Inc. v. Oman*, 924 F.2d 346, 347–48 (D.C. Cir. 1991); *Coach, Inc. v. Peters*, 386 F. Supp. 2d 495, 497 (S.D.N.Y. 2005)).

90. *Id.* at 283–84. Specifically, Darden argued that the APA's mandate that the reviewing court "interpret constitutional . . . provisions" in cases where the agency action violated a claimant's constitutional rights required that the court analyze his claim *de novo*. *Id.* (citation and internal quotation marks omitted).

91. *Id.* at 284.

92. *Id.*

93. *Id.* (internal quotation marks omitted) (citing 5 U.S.C. § 706(2)(A) (2000)).

94. *Id.* at 284–85.

95. 17 U.S.C. § 411(a) (2000).

96. *Darden*, 488 F.3d at 285.

copyrightability of a claim is generally a question of law in copyright infringement actions under Section 411(a),<sup>97</sup> greater deference is given to the Register's decision when the claimant is merely seeking to set aside the denial of protection.<sup>98</sup> The court justified the distinction between the types of claims by noting that, although judicial review of the denial of copyright protection is governed by the APA, infringement actions are not, and that, thus, the APA's abuse of discretion standard does not apply to infringement actions.<sup>99</sup>

The court then articulated its conclusion that the Register did not abuse her discretion in deciding that neither of Darden's works exhibited the minimum level of original authorship, explaining that APPRAISERSdotCOM and the maps fell into the category of works that the Copyright Office considered uncopyrightable.<sup>100</sup> Darden's maps, the court observed, were virtually identical to the original Census maps except for changes in font, color, and shading, which did not render them sufficiently original to merit copyright protection.<sup>101</sup> The court distinguished from *Darden* cases where maps were found to be "categorically eligible for copyright registration"<sup>102</sup> and reasserted its agreement with the Register that Darden had not added any copyrightable elements to his maps.<sup>103</sup> The court further rejected Darden's argument that the confusion that his customers experienced when they saw his maps on competing websites indicated originality

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97. The court expressed ambivalence as to whether some deference is, indeed, accorded the Register even in infringement actions and noted that courts are split on the issue. *Id.* at 286 (citing *John Muller & Co. v. N.Y. Arrows Soccer Team*, 802 F.2d 989, 990 (8th Cir. 1986) (per curiam) (applying the abuse of discretion standard); *Carol Barnhart Inc. v. Econ. Cover Corp.*, 773 F.2d 411, 414 (2d Cir. 1985) (applying de novo review); *Norris Indus. v. Int'l Tel. & Tel. Corp.*, 696 F.2d 918, 922 (11th Cir. 1983) (applying the abuse of discretion standard)). In *Darden*, however, the court concluded that, because Darden sought review of the registration denial under the APA, the APA applied and the court did not need to reach the issue of which standard was proper in infringement actions. *Id.*

98. *Id.* at 285.

99. *Id.*

100. *Id.* at 286–87 (citing 37 C.F.R. § 202.1(a) (2006)).

101. *Id.* at 287.

102. *Id.* (citing *Streetwise Maps, Inc. v. VanDam, Inc.*, 159 F.3d 739, 746–48 (2d Cir. 1998) (discussing the eligibility of maps in an infringement suit but ultimately finding that there was no infringement); *Mason v. Montgomery Data, Inc.*, 967 F.2d 135, 141–42 (5th Cir. 1992) (finding copyrightable topographical maps to which elements demonstrating originality had been added, including individual placement of numerous real estate surveys, lines denoting various information, and symbols "in particular relation to one another"))).

103. *Id.*

worthy of copyright protection, remarking that “[s]ource identification is the hallmark of trademark law, not copyright.”<sup>104</sup>

Finally, the court declined to grant copyright protection for Darden’s website, citing the examiner’s explanation that elements such as layout and formatting are not registrable and that AP-PRISERSdotCOM exhibited no other original elements.<sup>105</sup> Thus, the court concluded, the Register had correctly denied Darden’s request for copyright protection.<sup>106</sup>

#### IV. ANALYSIS

In *Darden v. Peters*,<sup>107</sup> the United States Court of Appeals for the Fourth Circuit held that in reviewing a copyright protection action brought under the Administrative Procedure Act, courts must apply a deferential standard of review to the Register’s decision.<sup>108</sup> In so holding, the court correctly interpreted the APA and existing case law and reached an appropriate conclusion in light of William Darden’s claims.<sup>109</sup> The court’s holding, however, raises the question of whether the Register’s decisions merit the same degree of deference as determinations by genuinely expert agencies, as copyrights do not require the same degree of technical expertise.<sup>110</sup> Although the result in *Darden* would not likely have changed with the application of a less deferential standard, the court should have applied a *de novo* standard of review for denials of copyright protection, thereby eliminating separation of powers concerns in future, more ambiguous cases.<sup>111</sup>

##### A. *The Court Correctly Interpreted the APA’s Deferential Standard and Existing Case Law in Denying William Darden Copyright Protection for His Website and Maps*

The *Darden* court’s analysis of the standard of review under the APA was proper for two reasons. First, the plain meaning of the APA mandates a deferential standard of review.<sup>112</sup> Second, existing case law concerning the standard of review under the APA indicates that a deferential standard is appropriate.<sup>113</sup> Further, the court properly ap-

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104. *Id.* (citing *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768–69 (1992)).

105. *Id.* at 287–88.

106. *Id.* at 288.

107. 488 F.3d 277 (4th Cir. 2007).

108. *Id.* at 286.

109. *See infra* Part IV.A.

110. *See infra* Part IV.B.

111. *See infra* Part IV.C.

112. *See infra* Part IV.A.1.

113. *See infra* Part IV.A.2.

plied this standard to the facts of Darden's case in denying copyright protection to his maps and website.<sup>114</sup>

1. *The Court Properly Concluded that the Plain Meaning of the APA Requires an Abuse of Discretion Standard of Review*

The *Darden* court correctly explained that the language of the APA mandates a deferential standard of review in actions brought under the APA. The APA states, in pertinent part, that the reviewing court will "hold unlawful and set aside agency action, findings, and conclusions found to be . . . arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with law."<sup>115</sup> The court's conclusion that the plain language of this provision allows only narrow review<sup>116</sup> comported with the Supreme Court's analysis of the statute's language in *Citizens to Preserve Overton Park v. Volpe*,<sup>117</sup> in which the Court emphasized that a reviewing court may not "substitute its judgment for that of the agency."<sup>118</sup>

2. *The Court Properly Concluded that Federal Case Law Supports Application of an Abuse of Discretion Standard of Review*

The *Darden* court's determination that the body of existing federal case law supported applying an abuse of discretion standard to the Register's decisions in actions under the APA was also appropriate. Although few federal courts have encountered the issue of the proper standard of review in actions challenging the Register's determinations under the APA, those that have addressed this question have unanimously applied an abuse of discretion standard to the Register's decisions.<sup>119</sup> Thus, the *Darden* court's conclusion that a deferential standard of review applied<sup>120</sup> comported with previous applications of a deferential standard in actions under the APA.

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114. See *infra* Part IV.A.3.

115. 5 U.S.C. § 706(2)(A) (2000).

116. *Darden v. Peters*, 488 F.3d 277, 286 (4th Cir. 2007).

117. 401 U.S. 402 (1971), *abrogated on other grounds by* *Califano v. Sanders*, 430 U.S. 99, 105 (1977).

118. *Id.* at 416.

119. See *Atari II*, 979 F.2d 242, 243 (D.C. Cir. 1992); *OddzOn Prods., Inc. v. Oman*, 924 F.2d 346, 348 (D.C. Cir. 1991); *Coach, Inc. v. Peters*, 386 F. Supp. 2d 495, 497 (S.D.N.Y. 2005).

120. *Darden*, 488 F.2d at 288.

3. *The Court Properly Applied an Abuse of Discretion Standard to the Facts of the Case at Bar to Conclude that William Darden Was Not Entitled to Copyright Protection*

The *Darden* court correctly applied the proper standard of review to the present facts in holding that the Register had not abused her discretion by denying William Darden copyright protection for his maps and APPRAISERSdotCOM website. The court's analysis was correct for several reasons. First, the court could not have reversed the Register's decision on the ground that the Register omitted an explanation,<sup>121</sup> applied an incorrect legal standard,<sup>122</sup> or considered irrelevant factors<sup>123</sup> because Darden did not challenge the Register's analysis or explanation; he claimed merely that the Register "reached the wrong result."<sup>124</sup> A different holding would have contravened the Supreme Court's mandate that reviewing courts are not to substitute their own judgment for that of the agency.<sup>125</sup>

Second, the court correctly upheld the Register's denial of copyright protection for Darden's maps based on an insufficient level of originality. The Register reasonably could have found that Darden's maps fell within the category, described in *Feist Publications, Inc. v. Rural Telephone Services Co.*,<sup>126</sup> of works that lack the requisite level of creativity and, thus, are ineligible for copyright protection.<sup>127</sup> Specifically, Darden's additions to the maps, consisting solely of font, coloring, labeling, and shading,<sup>128</sup> did not demonstrate the "creative spark" that *Feist* requires,<sup>129</sup> given their commonplaceness and extreme obviousness. In addition, the court distinguished on the facts the two cases that Darden cited to support his argument that maps are

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121. See *Overton Park*, 401 U.S. at 420–21 (remanding the case to the district court to consider whether the agency's explanation was sufficient).

122. *Turgeon v. Admin. Review Bd.*, 446 F.3d 1052, 1057 (10th Cir. 2006) (stating that failure to apply the correct legal principles "is grounds for reversal" under section 706(2)(A) of the APA).

123. *Motor Vehicle Mfrs. Ass'n v. State Farm Mut. Ins. Co.*, 463 U.S. 29, 43 (1983) (holding that the agency's decision could be overturned if it considered or omitted factors it was not supposed to consider or omit).

124. *Darden*, 488 F.3d at 284.

125. See *Motor Vehicle Mfrs.*, 463 U.S. at 43.

126. 499 U.S. 340 (1991).

127. See *id.* at 359. While the *Darden* court was justified in recognizing that maps are generally categorically eligible for copyright registration, *Mason v. Montgomery Data, Inc.*, 967 F.2d 135, 142 (5th Cir. 1992), the cases that Darden had cited in support of this proposition were inapposite to the instant determination, see *infra* note 130 and accompanying text.

128. *Darden*, 488 F.3d at 287.

129. *Feist*, 499 U.S. at 359, 363.

generally copyrightable, and properly concluded that neither was applicable to the case at bar.<sup>130</sup>

Further, the court correctly rejected Darden's allegation of originality based upon his customers' confusion when they encountered Darden's maps on a competitor's website.<sup>131</sup> Because originality in copyrights is determined as of the time of creation,<sup>132</sup> indications of public recognition, such as confusion or commercial success, are irrelevant to a determination of originality.<sup>133</sup> Darden's evidence suggesting confusion did not establish that the Register's determination was improper and was, thus, appropriately rejected by the court.

Finally, the court was correct in upholding the Register's determination regarding Darden's claim for his APPRAISERSdotCOM website. The Register properly recognized that copyright protection in compilations extends only to those elements added to the work that are sufficiently original,<sup>134</sup> and could plausibly have determined that Darden's additions of color, shading, and font to the maps lacked the minimum level of creativity. Moreover, while websites may contain copyrightable elements, formatting and layout do not usually make the work original enough to be registrable because it is "the selection, coordination, and arrangement [of the elements that must be] sufficiently original to merit protection."<sup>135</sup> The court, thus, acted appro-

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130. See *Darden*, 488 F.3d at 287 & n.4 (citing *Streetwise Maps, Inc. v. VanDam, Inc.*, 159 F.3d 739, 746–48 (2d Cir. 1998); *Mason*, 967 F.2d at 142). Specifically, the court observed that *Streetwise Maps* considered the copyrightability of maps "in the context of an infringement claim" and that *Mason* involved more significant additions to the subject maps. *Id.* at 287 n.4.

131. *Id.* at 287 (citing *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768–69 (1992)).

132. See *Paul Morelli Design, Inc. v. Tiffany & Co.*, 200 F. Supp. 2d 482, 488 (E.D. Pa. 2002) ("A work is either original when created or it is not.").

133. See *id.* (stating that commercial success or public attention over time does not establish originality because originality is determined as of the time of creation and cannot be established by subsequent events).

134. See *Feist*, 499 U.S. at 359 ("The copyright in a compilation . . . extends only to the material contributed by the author . . . as distinguished from the preexisting material employed in the work." (internal quotation marks omitted) (quoting 17 U.S.C. § 103(b) (2000))); *Satava v. Lowry*, 323 F.3d 805, 811 (9th Cir. 2003) ("[A] combination of unprotectable elements is eligible for copyright protection only if those elements are numerous enough and their selection and arrangement original enough that their combination constitutes an original work of authorship."); *Dam Things from Den. v. Russ Berrie & Co.*, 290 F.3d 548, 563 (3d Cir. 2002) (stating that compilation authors may only claim protection for original material they have added to the underlying work).

135. *Feist*, 499 U.S. at 358; see also *Satava*, 323 F.3d at 811 (holding that the selection and arrangement of unprotectable elements must be "original enough that their combination constitutes an original work of authorship").

privately in finding no abuse of discretion and in upholding the Register's denial of copyright protection.

*B. The Court's Holding Raises the Question of Whether the Register's Denial of Copyright Protection Should Be Given the Same Deference as Determinations of Other Agencies*

Although the *Darden* court correctly applied the APA and followed case law in declining to adopt a de novo standard of review for the denial of copyright protection,<sup>136</sup> the court's discussion of standards of review raises a question that the court has yet to answer: Does the Register's decision actually merit a deferential standard of review? The APA applies to judicial review of decisions by numerous agencies, including those by the PTO in granting or denying patent protection; however, courts reviewing PTO determinations have emphasized that agency's technical expertise in the area of patents.<sup>137</sup> Given that the area of copyrights generally does not require comparable expertise, as evidenced by the fact that courts review copyrightability in infringement actions de novo, copyrights should not be subject to the same standard of review as agency decisions requiring technical expertise, such as those by the PTO.<sup>138</sup>

*1. The Supreme Court Has Applied the APA's Deferential Standard of Review to Denials of Patent Protection Because of the PTO's Technical Expertise*

One rationale for application of a deferential standard of review to agency decisions is agency expertise.<sup>139</sup> In *Dickinson v. Zurko*,<sup>140</sup> the Supreme Court extended the APA's abuse of discretion standard to determinations by the PTO because of the agency's specialized expertise in the area of patents and trademarks.<sup>141</sup> This justification for

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136. See *supra* Part IV.A.

137. See *infra* Part IV.B.1.

138. See *infra* Part IV.B.2.

139. See, e.g., Craig Allen Nard, *Legitimacy and the Useful Arts*, 10 HARV. J.L. & TECH. 515, 551 (1997) (citing *Chevron U.S.A. Inc. v. Natural Res. Def. Council*, 467 U.S. 837, 865 (1984)).

140. 527 U.S. 150 (1999).

141. *Id.* at 152, 160–61 (observing that “the PTO is an expert body . . . [and] can better deal with the technically complex subject matter”). While the Federal Circuit has acquired somewhat more expertise in the patent law area than other courts because it has exclusive jurisdiction of appeals in patent law cases, *Voda v. Cordis Corp.*, 476 F.3d 887, 903 (Fed. Cir. 2007), the PTO is still “best suited to comprehend and employ [technical] modalities in the context of validity determinations,” Nard, *supra* note 139, at 519, 541–53.

Nard opines that “[a]gency expertise has long been a justification for according deference.” *Id.* at 551. Moreover, Nard has suggested that “one must view somewhat suspi-

applying a deferential standard to PTO determinations is relevant more broadly to many other agency decisions that receive deference “because of [the agency’s] experience and the assistance of its technical staff.”<sup>142</sup> As one scholar noted: “[D]eference will result in better decision making because agencies have more expertise and greater electoral accountability.”<sup>143</sup>

This is particularly true in the field of patents, which generally requires technical expertise or knowledge not possessed by the reviewing lay court.<sup>144</sup> The PTO possesses such expertise in various fields of technology, “and although a court may be able to learn [technical] language, the PTO examiner has experience with the relevant technology.”<sup>145</sup> Thus, courts apply an abuse of discretion standard of review to determinations by many agencies because of the agencies’ expertise in their respective subject areas.

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ciously a patent system that requires federal district judges and lay juries to . . . comprehend and ascertain the meaning of sophisticated technological art.” *Id.* at 520. Nard has further noted that “the PTO is likely to do better than jurors [*and judges*] because the PTO, unlike the federal judiciary, employs individuals with training in exegesis in the fields of patent law and technology.” *Id.* at 547 (citations and internal quotation marks omitted).

142. *See* United States *ex rel.* Chapman v. Fed. Power Comm’n, 191 F.2d 796, 808 (4th Cir. 1951) (granting deference to the Federal Power Commission’s licensing determinations because of agency expertise); *see also* Turner Broad. Sys. v. FCC, 520 U.S. 180, 196 (1997) (noting that deference to Congress is similar to deference to administrative agencies given the expertise of both bodies); Thomas Jefferson Univ. v. Shalala, 512 U.S. 504, 512 (1994) (articulating the rationale for deference when “the regulation concerns a *complex and highly technical* regulatory program” that requires “significant expertise” (emphasis added) (citations and internal quotation marks omitted)); Martin v. Occupational Safety & Health Review Comm’n, 499 U.S. 144, 151 (1991) (observing that agency decisionmaking in complex situations requires specialized expertise); NLRB v. Link-Belt Co., 311 U.S. 584, 597 (1941) (holding that courts could not substitute their judgment for that of the National Labor Relations Board because it is an “expert agenc[y] dealing with [a] specialized field[ ]”); Rochester Tel. Corp. v. United States, 307 U.S. 125, 145–46 (1939) (giving deference to the FCC’s determination and referring to the agency as an “expert body”).

143. Phillip G. Oldham, Comment, *Regulatory Consent Decrees: An Argument for Deference to Agency Interpretations*, 62 U. CHI. L. REV. 393, 418 (1995).

144. *See* Nard, *supra* note 139, at 536 (noting, as an example, that one court’s lack of technical expertise led it to apply principles of structural chemistry, as opposed to relevant biological principles, which caused it to make a “dubious” determination that directly contradicted that of the PTO); *see also* Chapman, 191 F.2d at 808 (noting that “[t]he court may not . . . ignore the conclusions of [the agency] and put itself in the absurd position of substituting its judgment for theirs on controverted matters of hydraulic engineering,” and further opining that in such complex situations, deference to the agency is most crucial).

145. Nard, *supra* note 139, at 542.

2. *Determinations of Copyrightability Should Not Be Subject to the Same Standard of Review as Determinations by Expert Agencies*

Although agency determinations usually involve expertise in accordance with the general subject matter of the agency's work,<sup>146</sup> determinations of copyrightability do not and, therefore, should not receive the same level of deference.<sup>147</sup> While courts may understandably be reluctant to depart from the APA standard in reviewing questions of copyrightability, several factors demonstrate why de novo review of copyrightability is not only possible,<sup>148</sup> but might also be permissible within the confines of existing case law.<sup>149</sup>

a. *Determinations of Copyrightability Do Not Require Expertise Comparable to That of Other Agencies*

Unlike the determinations of many agencies that involve special expertise by virtue of their subject matter,<sup>150</sup> determinations as to copyrightability do not require a comparable expertise.<sup>151</sup> Given that the touchstone of copyrightability is originality, which the Supreme Court has clarified "means only that the work was independently created by the author, as opposed to copied from other works, and that it possesses at least some minimal degree of creativity,"<sup>152</sup> courts with no technical expertise can undertake this analysis. Specifically, an interpretation of originality does not involve "complex" or "highly technical"<sup>153</sup> considerations that fall within the particular purview of the "agency's unique expertise."<sup>154</sup>

Moreover, it has been noted that, unlike in patent claims, the Register does not evaluate an application for copyright protection for "basic validity" before granting protection.<sup>155</sup> As a result, "the Copyright Office is not equipped to gauge the author's originality versus

146. See *supra* notes 141–145 and accompanying text.

147. See *infra* Part IV.B.2.a.

148. See *infra* Part IV.B.2.b.

149. See *infra* Part IV.B.2.c.

150. See *supra* notes 141–145 and accompanying text.

151. See *Carol Barnhart Inc. v. Econ. Cover Corp.*, 594 F. Supp. 364, 367 (E.D.N.Y. 1984) ("The Copyright Office's scrutiny of an article for registration is not like the intense and prolonged scrutiny required for patent and trademark registration. Elements of copyrightability are viewed as largely legal questions and therefore *equally within the expertise of the courts.*" (emphasis added)).

152. *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345 (1991).

153. *Thomas Jefferson Univ. v. Shalala*, 512 U.S. 504, 512 (1994).

154. *Martin v. Occupational Safety & Health Review Comm'n*, 499 U.S. 144, 151 (1991).

155. 3 MELVILLE B. NIMMER & DAVID NIMMER, *NIMMER ON COPYRIGHT* § 12.11[B][3] (2007) (citations omitted).

copying, and will not reject an application, even if a strikingly similar work has been previously registered.”<sup>156</sup> Because the PTO conducts a thorough review of an invention to ensure that it meets each requirement for patentability,<sup>157</sup> courts are arguably justified in relying on the PTO’s determination in this respect.<sup>158</sup> However, such a justification does not apply to the Register’s determinations given the lack of an equivalent investigation into copyrightability.<sup>159</sup> Determinations of copyrightability, therefore, require little, if any, true expertise and, as such, are within the analytical ability of any court.

*b. Courts Are Able to Review the Issue of Copyrightability De Novo*

Not only can courts review copyrightability de novo because the Register does not possess a high level of specialized expertise in the area,<sup>160</sup> but they already do so in copyright infringement actions.<sup>161</sup>

156. *Id.* (citations omitted); *see also* Stein v. Mazer, 111 F. Supp. 359, 360 (D. Md. 1953) (“[T]he issuance of the certificate of copyright is a perfunctory matter. The Copyright Office conducts no examination to determine the existence of novelty or invention in the subject matter.”), *rev’d on other grounds*, 204 F.2d 472 (4th Cir. 1953).

The Register does, however, conduct a “substantive” evaluation of whether the application “falls within the subject matter of copyright.” NIMMER & NIMMER, *supra* note 155, § 12.11[B][3]. In this area, its “expertise” has been recognized. *See id.* (“[T]he Copyright Office presumably possesses special expertise in evaluating the subject matter of copyright . . . .”); *see also* Carol Barnhart, 773 F.2d at 414 (observing that the Copyright Office’s expertise is in “interpretation of the law and its application to the facts presented by the copyright application” (citations and internal quotation marks omitted)); Mays & Assocs. Inc. v. Euler, 370 F. Supp. 2d 362, 369 (D. Md. 2005) (acknowledging the Copyright Office’s province to “exercise . . . its expertise” in its interpretation of copyright laws). Such acknowledgement of “expertise” purports to raise the Copyright Office to the level of other “expert” agencies, thereby requiring a deferential standard of review because courts are understandably hesitant to substitute their own judgment for that of any agency. Motor Vehicle Mfrs. Ass’n v. State Farm Mut. Auto. Ins. Co., 463 U.S. 29, 43 (1983). This argument is refuted, however, by the observation that courts possess comparable “expertise” in applying the law. *See, e.g.*, Van Ooteghem v. Gray, 628 F.2d 488, 492 (5th Cir. 1980) (noting courts’ expertise in “interpreting and applying the law” to the germane facts).

157. NIMMER & NIMMER, *supra* note 155, § 12.11[B][3].

158. *See* Oldham, *supra* note 143, at 417 (“It would be odd if courts were not allowed . . . to take advantage of agency knowledge and expertise.”).

159. *See supra* notes 155–156 and accompanying text.

160. *See supra* Part IV.B.2.a.

161. Gaiman v. McFarlane, 360 F.3d 644, 648 (7th Cir. 2004); Yankee Candle Co. v. Bridgewater Candle Co., 259 F.3d 25, 34 n.5 (1st Cir. 2001); Publ’ns Int’l v. Meredith Corp., 88 F.3d 473, 478 (7th Cir. 1996); OddzOn Prods., Inc. v. Oman, 924 F.2d 346, 348 (D.C. Cir. 1991); Collezione Europa U.S.A., Inc. v. Hilldale House, Ltd., 243 F. Supp. 2d 444, 452 (M.D.N.C. 2003); Newton v. Diamond, 204 F. Supp. 2d 1244, 1253 (C.D. Cal. 2002), *aff’d*, 349 F.3d 591 (9th Cir. 2003), *amended on other grounds* by 388 F.3d 1189 (9th Cir. 2004).

Nevertheless, the *Darden* court did note that applying a de novo standard to copyrightability in infringement actions was “not a foregone conclusion” and cited courts that have applied an abuse of discretion standard in infringement actions. *Darden v. Peters*, 488

Although the reasons for different standards of review in infringement actions and actions under the APA are statutory,<sup>162</sup> the application of a de novo standard in infringement cases illustrates that courts are *able* to review the issue of copyrightability de novo. Additionally, it further suggests that such determinations require less technical expertise than determinations as to patentability.<sup>163</sup> From a logistical perspective, therefore, courts could review the issue of copyrightability in actions directly challenging the Register's denial using a de novo standard.

*c. Existing Case Law Does Not Require Strict Adherence to the APA's Deferential Standard in the Context of the Register's Decisions*

Although courts may be wary of departing from the APA and pertinent case law discussing the applicable standard of review, some commentary suggests that the APA is not necessarily a rigid standard.<sup>164</sup> First, a strong dissent criticizing two preeminent Supreme Court decisions supports the ability of courts to deviate from the APA and apply a de novo standard of review to agency decisions. Justice Scalia, in a dissenting opinion in *United States v. Mead Corp.*,<sup>165</sup> questioned the Court's faithfulness to the APA in both *Chevron U.S.A. Inc. v. Natural Resources Defense Council*<sup>166</sup> and *Mead*.<sup>167</sup> Indeed, Justice Scalia viewed the holdings as departures from both the language of the APA and precedent.<sup>168</sup> Thus, Justice Scalia would argue that the

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F.3d 277, 286 (4th Cir. 2007) (citing *John Muller & Co. v. N.Y. Arrows Soccer Team*, 802 F.2d 989, 990 (8th Cir. 1986) (per curiam); *Norris Indus. v. Int'l Tel. & Tel. Corp.*, 696 F.2d 918, 922 (11th Cir. 1983)); see also *supra* note 97 and accompanying text.

162. Compare 17 U.S.C. § 410(c) (2000) (granting courts discretion in the weight they accord agency decisionmaking when reviewing certificates of registration), with 5 U.S.C. § 706(2)(A) (2000) (requiring an abuse of discretion standard when reviewing agency action under the APA).

163. See *supra* Part IV.B.2.a.

164. See Thomas W. Merrill, *Capture Theory and the Courts: 1967–1983*, 72 CHL-KENT. L. REV. 1039, 1039 (1997) (observing that the APA is not a comprehensive code, but rather a “framework statute”).

165. 533 U.S. 218 (2001).

166. 467 U.S. 837 (1984).

167. *Mead*, 533 U.S. at 241–42 & n.2 (Scalia, J., dissenting).

168. *Id.* In his dissent, Justice Scalia specifically criticized the majority's lack of consideration of the APA's text, which he contended was “difficult to reconcile” with the majority's holding. *Id.* Justice Scalia also noted that the Court in *Chevron* “did not even bother to cite” to the APA's actual text in purporting to interpret the level of deference it required. *Id.* at 241.

Supreme Court has previously departed from the language of the APA.<sup>169</sup>

Second, one commentator has noted that, because the APA is a “framework statute,” its application is defined chiefly by case law.<sup>170</sup> The result is that “this interpretative mantle has assumed a different shape with different generations of judges.”<sup>171</sup> In other words, application of the APA may fluctuate and change depending on the individual interpretations of the courts touching on the issue.<sup>172</sup> While not a complete justification for courts to reject the APA’s deferential standard when reviewing the Register’s determinations, this view nevertheless supports the conclusion that alteration or denunciation of the APA’s standard is not entirely unprecedented.

Moreover, despite the impressive body of case law upholding a deferential standard under the APA,<sup>173</sup> federal precedent on the specific issue of the APA’s standard of review in actions challenging denial of copyright registration is minimal.<sup>174</sup> Indeed, no court has squarely addressed the issue of the Register’s expertise and whether the same justification exists for applying a deferential standard to the Register’s determinations as for applying a deferential standard to decisions by genuinely expert agencies.

C. *The Darden Court Should Have Challenged the Application of the APA’s Deferential Standard to Denials of Copyright Protection*

Though the court in *Darden* correctly applied the APA’s standard of review and federal case law on the issue of deference to the Register,<sup>175</sup> it should have declined to apply a deferential standard in favor of de novo review. The outcome in *Darden*’s case would likely have been the same under a de novo standard,<sup>176</sup> but, by applying this standard, the court could have precluded separation of powers concerns

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169. *Id.* at 241–42 & n.2.

170. *See* Merrill, *supra* note 164, at 1039.

171. *Id.*

172. *Id.*

173. *See supra* note 57 and accompanying text.

174. The *Darden* court commented on this phenomenon, noting that its holding was “consistent with the few federal decisions . . . addressing the proper review standard under the APA for courts directly reviewing a registration decision.” *Darden v. Peters*, 488 F.3d 277, 283 (4th Cir. 2007) (emphasis added) (citing *Atari II*, 979 F.2d 242, 243 (D.C. Cir. 1992); *OddzOn Prods., Inc. v. Oman*, 924 F.2d 346, 347–48 (D.C. Cir. 1991); *Atari I*, 888 F.2d 878, 881 (D.C. Cir. 1989); *Coach, Inc. v. Peters*, 386 F. Supp. 2d 495, 497 (S.D.N.Y. 2005)).

175. *See supra* Part IV.A.

176. *See infra* Part IV.C.1.

that will arise in cases where the issue of copyrightability is more ambiguous.<sup>177</sup>

*1. The Holding in Darden Likely Would Have Remained the Same Under a De Novo Standard of Review*

Even if the court had reviewed William Darden's claims using a de novo standard of review, the result would likely have been the same. A court undertaking de novo review will not accord deference to the agency's determination, but will independently analyze the claim.<sup>178</sup> In *Darden*, the first consideration under de novo review—whether the work exhibits “constituent elements . . . that are copyrightable”<sup>179</sup>—would not have been met, as Darden's alterations to the original Census maps were minimal and the original Census maps supplied the significant features of Darden's maps.<sup>180</sup> Additions of color, font, and shading do not exhibit a “creative spark,”<sup>181</sup> given their obviousness, triviality, and widespread use. Therefore, Darden's additions to the maps would not have satisfied the originality that *Feist* requires.<sup>182</sup>

Darden's APPRAISERSdotCOM claim would also likely have failed. Given that virtually the only pictorial elements on the website were the maps, and that Darden's sole additions to the Census maps—font, coloring, visual effects, and labeling<sup>183</sup>—fell short of the originality standard because they were “practically inevitable,”<sup>184</sup> APPRAISERSdotCOM would not have satisfied the requirements for protection as a derivative work.<sup>185</sup> Moreover, APPRAISERSdotCOM would not have qualified as a compilation because the “selection, coordination, and arrangement” of the elements, which must “render the work as a whole original” in order to make it copyrightable, failed

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177. See *infra* Part IV.C.2.

178. See *Atari I*, 888 F.2d at 889 (Silberman, J., concurring) (explaining that under de novo review, as used in infringement actions, the court is “not obliged to defer to an agency's action or interpretation”).

179. *Compaq Computer Corp. v. Ergonome Inc.*, 387 F.3d 403, 407 (5th Cir. 2004) (citation and internal quotation marks omitted).

180. *Darden v. Peters*, 488 F.3d 277, 280 (4th Cir. 2007).

181. *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 359 (1991).

182. See *id.* at 345.

183. *Darden*, 488 F.3d at 280–82.

184. See *Feist*, 499 U.S. at 363 (explaining that the alphabetical arrangement of telephone numbers is inevitable and, thus, lacking the requisite originality for copyrightability).

185. See *Dam Things from Den. v. Russ Berrie & Co.*, 290 F.3d 548, 563 (3d Cir. 2002) (clarifying that protection for derivative works extends only to added elements that satisfy the originality standard).

to transform the website into an original work.<sup>186</sup> Therefore, Darden's claims would ultimately have been dismissed under a de novo standard.

2. *The Court's Application of a Deferential Standard of Review to the Register's Decisions Could Raise Separation of Powers Concerns*

Although the outcome in *Darden* would probably have been unaffected by application of a de novo standard of review,<sup>187</sup> had the court applied a de novo standard, it could have eliminated the potential problem involving separation of government powers. For courts to extend deference to agencies regardless of whether the agencies have expertise in a given area raises separation of powers concerns in that it accords a body of the executive branch authority in its decisionmaking that treads dangerously close to usurping the role of the judiciary.<sup>188</sup> Specifically, the traditional justification for deference—agency expertise<sup>189</sup>—is inapplicable to the Register's determinations as to copyrightability, given that the relevant analysis of copyright applications requires no special expertise.<sup>190</sup> Indeed, the evaluation of originality that the Register undertakes for works submitted for copyright protection is strikingly analogous to the traditional role of courts in applying law to facts<sup>191</sup> and in “say[ing] what the law is.”<sup>192</sup> The Su-

186. See *Feist*, 499 U.S. at 358 (determining that the “selection, coordination, and arrangement” at issue did not meet the originality requirement). In particular, Darden's additions to APPRAISERSdotCOM consisted primarily of formatting and layout, which are not protectable. *Darden*, 488 F.3d at 282.

187. See *supra* Part IV.C.1.

188. See *Peretz v. United States*, 501 U.S. 923, 929 n.6 (1991) (noting that the system of checks and balances in American government was designed to protect “the role of the independent judiciary within the constitutional scheme of tripartite government” (citations and internal quotation marks omitted)); *County of Esmeralda v. U.S. Dep't of Energy*, 925 F.2d 1216, 1223 (9th Cir. 1991) (Wallace, C.J., concurring in part and dissenting in part) (noting that the deference granted to certain agency actions by courts is a reflection of agency expertise in particularly executive arenas where court interference may upset the separation of powers).

189. See *supra* Part IV.B.1.

190. See *supra* Part IV.B.2.a.

191. Compare *Norris Indus. v. Int'l Tel. & Tel. Corp.*, 696 F.2d 918, 922 (11th Cir. 1983) (observing that courts often defer to the Register's determinations regarding “the interpretation of the law and its application to the facts presented by the copyright application”), and *supra* Part II.A, with *Vermont v. New York*, 417 U.S. 270, 277 (1974) (per curiam) (explaining that courts apply law to facts), and *Van Ooteghem v. Gray*, 628 F.2d 488, 492 (5th Cir. 1980) (observing that courts have expertise in applying legal standards to facts).

192. *Marbury v. Madison*, 5 U.S. (1 Cranch) 137, 177 (1803); see also *Elliot Greenfield, A Lenity Exception to Chevron Deference*, 58 BAYLOR L. REV. 1, 3 (2006) (noting that “the *Chevron* rule of deference would appear to contradict . . . Chief Justice John Marshall's famous

preme Court has made clear that “the judicial Power of the United States vested in the federal courts by [Article] III, [Section] 1, of the Constitution can no more be shared with the Executive Branch than the Chief Executive, for example, can share with the Judiciary the veto power . . . .”<sup>193</sup> Thus, if courts automatically defer to the Register’s determinations, this would constitute an “intrusion”<sup>194</sup> by the executive branch into the traditional role of the judiciary.

This risk would be most apparent in situations where the issue of originality is less clear than in *Darden*. In such cases, courts might conceivably determine that the law instructs them to reach a conclusion at odds with the Register’s decision but that the Register’s decision does not rise to the level of “arbitrary, capricious, an abuse of discretion, or . . . not in accordance with law.”<sup>195</sup> If the reviewing court defers to the Register, however, it would be unable to reach such an independent conclusion regarding originality.<sup>196</sup> As a result, the Register, barring application of an incorrect legal standard or consideration of inappropriate factors,<sup>197</sup> would have virtually unfettered discretion in granting or denying copyrights. This would effectively eliminate one of the fundamental purposes of judicial review: to put a check on the Executive’s exercise of its authority.<sup>198</sup>

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pronouncement in *Marbury v. Madison* that ‘it is emphatically the province and duty of the judicial department to say what the law is’” (quoting *Marbury*, 5 U.S. (1 Cranch) at 177)).

193. *United States v. Nixon*, 418 U.S. 683, 704 (1974), *superseded by rule on other grounds*, FED. R. EVID. 104(a). Although separation of powers does not require “a complete division of authority between the three branches,” there must be some degree of separation. *Nixon v. Adm’r of Gen. Servs.*, 433 U.S. 425, 443 (1977).

194. *See Cheney v. U.S. Dist. Court*, 542 U.S. 367, 381 (2004) (explaining that the issuance of a writ by the lower court could intrude into federal-state relations).

195. 5 U.S.C. § 706(A) (2000).

196. *See Motor Vehicle Mfrs. Ass’n v. State Farm Mut. Auto. Ins. Co.*, 463 U.S. 29, 43 (1983) (noting that, under a deferential standard, courts may not substitute their judgment for that of the agency).

197. *See id.* (holding that application of an incorrect legal standard could warrant reversal); *Turgeon v. Admin. Review Bd.*, 446 F.3d 1052, 1057 (10th Cir. 2006) (explaining that failure to apply the correct legal standard and consideration of inappropriate factors constitute grounds for reversal).

198. *See Youngstown Sheet & Tube Co. v. Sawyer*, 343 U.S. 579, 635 (1952) (Jackson, J., concurring) (acknowledging constitutional “separateness” of the branches of government); *see also Vieth v. Jubelirer*, 541 U.S. 267, 302 (2004) (plurality opinion) (explaining that “lines of separation drawn by the Constitution between the three departments of the government” prevent one branch from extending its authority into the authority of another branch (citations and internal quotation marks omitted)); *Mistretta v. United States*, 488 U.S. 361, 380–81 (1989) (discussing the constitutional understanding of separation of powers and emphasizing that diffusing powers between the three branches best protects “the fundamental principles of a free constitution”).

## V. CONCLUSION

In *Darden v. Peters*,<sup>199</sup> the Court of Appeals for the Fourth Circuit held that the correct standard of review for the Register's denial of copyright registration under the APA was an abuse of discretion standard and upheld the Register's denial of protection to William Darden.<sup>200</sup> In so holding, the court correctly interpreted both the plain language of the APA and case law on the subject,<sup>201</sup> but it failed to address whether the justification for application of a deferential standard applies to the Copyright Office.<sup>202</sup> Instead, the court should have acknowledged that determinations of copyrightability do not require an expertise comparable to that required, for instance, in determinations of patentability by the United States Patent and Trademark Office.<sup>203</sup> The application of a de novo standard would likely not have altered the outcome in Darden's case, but it might very well have impacted the resolution of more ambiguous cases in the future, and it would also have addressed the separation of powers concerns raised by the more deferential abuse of discretion standard.<sup>204</sup>

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199. 488 F.3d 277 (4th Cir. 2007).

200. *Id.* at 286, 288.

201. *See supra* Part IV.A.

202. *See supra* Part IV.B.

203. *See supra* Part IV.B.

204. *See supra* Part IV.C.