A Recipe for Success

Intellectual Property Protection for Recipes

By C. Bailey King, Jr. and Bridget V. Warren

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In today's world of celebrity chefs, craft cocktail mixologists, and experiential dining restaurants, unique culinary creations (for non-foodies, "recipes") have become a valuable business asset. And, as with any other valuable business asset, commercial litigators will be tasked by their clients with protecting these assets. The question for commercial litigators will be, "How?"

In some respects, recipes should be tailor-made for intellectual property protection. New recipes are "invented" by highly educated and trained chefs (patent); marketed by restaurants under distinctive names such as the Big Mac or the Whopper (trademark); described in flowery language in best-selling cookbooks (copyright); and closely guarded by restaurants to protect a competitive advantage similar to the "secret eleven herbs and spices" at Kentucky Fried Chicken (trade secrets). In reality, though, establishing any intellectual property rights, much less protecting them in a recipe, is challenging. Indeed, "stealing" another chef's recipe (and of course putting your own "take" on it) is a time-honored tradition in the food service business.

As a practical matter, there are significant limitations on the protections that intellectual property can provide to the creator of a recipe, and it can only help those restaurants and chefs who are willing to take the steps necessary to protect their creations. Indeed, no matter what the creator of a recipe may claim, the majority of recipes are simply different combinations of familiar ingredients that come together in a way that is generally expected. For example, although your grandmother may make the sweetest brownies you have ever had, everyone knows this is because she uses more sugar. Most recipes, even secret family recipes, are not truly novel, and patent protection, therefore, is rarely available. As for trademark protection, all it can protect is the distinctive name (such as Oreo) or appearance (such as the teardrop shape of a Hershey Kiss) of a product; it provides no protection for the recipe itself.

■ C. Bailey King, Jr. is a partner and Bridget V. Warren is an associate with Bradley Arant Boult Cummings LLP in its Charlotte, North Carolina, office. Mr. King and Ms. Warren are commercial litigators with a broad business litigation practice that includes intellectual property disputes in the food, beverage, and hospitality industry. Mr. King is an active member of the DRI Commercial Litigation and Intellectual Property Litigation Committees, and he is a member of the FDCC and the North Carolina Association of Defense Attorneys. Ms. Warren is also an active member of the DRI Commercial Litigation and Intellectual Property Litigation Committees, as well as the American Bar Association Section of Litigation and the section's Woman Advocate Committee.

Under the right circumstances, though, a party that believes it owns a valuable recipe can use copyright law or trade secret law to protect it. Which one of these protections it should rely on will depend on how the recipe will be monetized. For example, a celebrity chef can publish a cookbook with his or her recipes and profit from the book sales. Of course, this will require the chef to reveal the "secret" recipe to the world at-large. Alternatively, a restaurant that believes it has a truly "secret" recipe for a popular dish that gives it a competitive advantage can use trade secret protection to prevent its employees from stealing the recipe and using it in competition.

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Regardless of which type of protection a business relies on, though, there are unique challenges in protecting a recipe based on its very nature: a combination of ingredients and cooking methods that are developed through the trial and error process of cooking. Courts have examined these issues as far back as 1924, and the rise in popularity of cooking shows and celebrity chefs have led to an increased number of cases in recent years. However, there is still a dearth of cases that analyze the circumstances under which a recipe may be copyrightable or protected as a trade secret. Even more, there is no consensus among the courts that have looked at these issues as to when a recipe is entitled to protection. The purpose of this article is to identify those challenges so that counsel can develop strategies to deal with them in litigation.

Copyright Protection

Copyrights are a form of protection to the authors of "original works of authorship" that are fixed in a tangible form of expression. 17 U.S.C. §102(a). Such original works include literary, dramatic, musical, and artistic works. Copyright does not protect facts, ideas, procedures, processes, systems, principles, or methods of operation. 17 U.S.C. §102(b). To establish a claim of copyright infringement, someone must prove ownership of a valid copyright and the copying of constituent elements of the work that are original. *Publications Intern. Ltd. v. Meredith Corp.*, 88 F. 3d 473 (7th Cir. 1996). Courts as early as 1924 applied copyright law in the context of recipes and found recipes to be copyrightable. As time went on and more courts looked at this issue, however, the ability to copyright a recipe has been dramatically limited. Now, a recipe must be accompanied by substantial literary expression even to be potentially copyrightable.

In 1924, the Eighth Circuit addressed this issue. *Fargo Mercantile Co. v. Brechet & Richter Co.*, 295 F. 823 (8th Cir. 1924). There, the plaintiff, a manufacturer of fruit nectar, alleged that the defendant infringed the plaintiff's copyright. *Id.* At issue was a label the plaintiff put on its bottles of fruit nectars. There were two parts to the label: recipes and an emblem. The recipes contained detailed directions for making certain food and drinks. The emblem was colorful and included the plaintiff's name and additional advertising material. The plaintiff copyrighted the entire label and alleged the defendant infringed the label and violated the Copyright Act. *Id.*

In evaluating the plaintiff's claim, the court examined the recipes and emblem separately. Regarding the recipes, the court stated, "they are original compositions, and serve a useful purpose…." *Id.* Specifically, they served to "advance culinary art." *Id.* Importantly, the court stated that "[i]f printed on a single sheet, or as a booklet, these recipes could undoubtedly be copyrighted, and we see no reason why this protection should be denied, simply because they are printed and used as a label." *Id.* The Eighth Circuit held the recipe was copyrightable as an "original work of authorship." *Id.* Notably, the court did not address the argument that the recipe was merely a factual recitation of a "procedure[ ]" or "process[ ]" that would not be copyrightable.

Fargo stands for the proposition that recipes are copyrightable as "original works of authorship." The court in *Fargo*, unlike later courts, did not examine whether the recipe had additional commentary or needed the same to be copyrightable. Instead, the court simply held that recipes are copyrightable. Therefore, under *Fargo*, recipes that only include a list of ingredients with simple instructions appear to be protected by the Copyright Act.

In more modern times, the ability to copyright recipes has been limited. The Seventh Circuit had occasion to visit this issue over seventy years later and adopted a holding much different from its sister circuit. In *Publications Intern. Ltd. v. Meredith Corp.*, the court addressed whether copyright laws afford protection to recipes that are contained in a cookbook where the cookbook has a compilation copyright. 88 F. 3d 473 (7th Cir. 1996). There, both the plaintiff and the defendant published magazines and books with recipes in them. Meredith published a cookbook titled, *Discover Dannon–50 Fabulous Recipes with Yogurt,* and the company received a copyright for the cookbook as a "collective work." *Id.* In the copyright application, the defendant described the subject matter as a "compilation" of "recipes tested with Dannon yogurt." *Id.* Meredith alleged that Publications International produced twelve publications containing recipes from the *Discover Dannon* cookbook that infringed on its copyright. *Id.* Meredith argued its collective work copyright extended to the individual recipes within the cookbook. *Id.*

The court looked at the language of the Copyright Act of 1976, which requires that copyrightable work "possess some minimum indicia of creativity, that they be original intellectual conceptions of the author." Section 102(a) includes literary works (*e.g.*, cookbooks), while Section 102(b) excludes things such as processes, systems, and methods of operation (*e.g.*, recipes). A com-

pilation copyright protects the order and manner of the presentation of the compilation's elements (*e.g.*, the order of recipes in the cookbook), but not necessarily the individual elements (*e.g.*, the individual recipes).

In *Publications*, the recipes were found to be lists of required ingredients and directions for combining them to achieve the final result. They did not contain "expressive elaboration upon either of these functional components." *Publications*, 88 F. 3d at 480. At its core, the court found the ingredient sections to be statements of facts. *Id.* Such functional listing was not original within the meaning of the Copyright Act. Regarding the directions, those were excluded under Section 102(b) as nothing more than the "process" for making the dish, which is something that is specifically excluded from copyright protection. *Id.* The court went on to state that there can be no monopoly in the method that someone might use in preparing and combining the necessary ingredients. *Id.* In other words, a bare recipe, without literary expression, is not copyrightable. *Id.* The court held open the question of whether certain recipes might be copyrightable, though, such as "dishes with musings about the spiritual nature of cooking…suggestions for presentations, advice on wines to go with the meal…." *Id.*

Publications takes several steps back from *Fargo* in protecting recipes through copyright. Under *Publications*, the list of ingredients in a recipe is a statement of facts devoid of any protectable expressive element. Additionally, the instructions in recipes, without expressive elaboration, are likewise not protectable because they describe a "procedure, process, system, [or] method of operation" that is specifically excluded from copyright protection. 17 U.S.C. §102(b). The court in *Fargo* did not put these restraints on the ability to copyright recipes. Under *Publications*, it is harder to copyright recipes because they need to have sufficient creativity, expressive elaboration, and commentary. Under such a standard, a recipe that is written down by a chef or restaurant owner for use in the restaurant would likely not be copyrightable. On the other hand, a recipe prepared for a celebrity cookbook, with commentary, may be copyrightable.

The Sixth Circuit, just two years later, also examined this issue and went even further than *Publications* in limiting the ability to copyright recipes. In *Lambing v. Godiva*, the plaintiff claimed that Godiva misappropriated her proprietary rights in her recipe and design of a chocolate truffle. 142 F. 3d 434 (6th Cir. 1998) (unpublished). The plaintiff argued Godiva violated her copyright by preparing and selling a truffle described in one of her recipes contained in an unpublished cookbook. *Id.* In a short opinion with little analysis, the court plainly stated, "Recipes…are not copyrightable." *Id.* The court went on to say, "the identification of ingredients necessary for the preparation of food is a statement of facts. There is no expressive element deserving copyright protection in each listing." *Id.* Accordingly, the court held that "recipes are functional directions for achieving a result" and are excluded from copyright protection. *Id.*

Unlike *Publications*, the *Lambing* court ignores the possibility that there could be sufficient expressive elements in a recipe that could make it protectable. In *Publications*, the court found that no such expressive elements existed in the recipes in that case. In *Lambing*, the court did not even entertain such possibilities. It simply stated, "Recipes…are not copyrightable." *Lambing,* 142 F. 3d at 434. This holding is much narrower than the holdings in *Fargo* or *Publications*. Someone could argue that a circuit split exists on the issue of whether recipes are copyrightable. The Eighth Circuit has held that a recipe is copyrightable; the Sixth Circuit has held that a recipe is not copyrightable; and the Seventh Circuit has held that a recipe is not copyrightable if it is a functional list, but it left open whether a recipe can be copyrightable if it contains musings, suggestions, or advice.

Publications is the more-reasoned decision, and it has been followed in recent district court cases, including in a case in the U.S. District Court for the Southern District of Texas. There, the court adopted a holding similar to what *Publications* described as copyrightable: recipes that are more than mechanical listings and have sufficient expressiveness can be copyrightable. *Barbour v. Head*, 178 F. Supp. 2d 758 (S.D. Tex. 2001). The plaintiff was the author of a cookbook titled, *Cowboy Chow*, for which he held a copyright. The defendant published an internet magazine with recipes that were almost identical to those in the cookbook. The plaintiffs alleged copyright infringement, arguing what *Publications* said in dicta: "where a recipe or formula is accompanied by substantial literary expression in the form of an explanation or directions, …there may be a basis for copyright protection." *Id.* at 762–63. The *Cowboy Chow* recipes contained various literary anecdotes, such as "Heat oil in heavy skillet. Add sugar and let it brown and bubble. (This is the secret to the unique taste!)," and it exclaimed that the Crazy Horse Cranberry Sauce with Raisins is "Great with all your meats!" *Id.* This "light hearted or helpful commentary" was included throughout the cookbook. *Id.* The court found there to be a genuine issue of material fact of whether the recipes were "sufficiently expressive" or merely "unprotected facts." *Id.* Because the recipes were more than mechanical listings, it denied the defendant's motion for summary judgment and left a jury to decide. *Id.* The case ultimately settled, so the question of whether these recipes were sufficiently expressive and, thus, copyrightable, was not answered.

Barbour follows exactly what *Publications* indicated would be protected by copyright: recipes with fluff. The bare bones recipes, those without anecdotes or "substantial literary expression," are not copyrightable, but recipes that contain expressive commentary may be copyrightable. This analysis by the courts makes it difficult to copyright recipes that are not contained in cookbooks, however, and meant to be sold to a wide audience. For instance, if a restaurant has a signature dish that is a crowd-pleaser, but the restaurant does not publish a cookbook, the restaurant may not be able to copyright that recipe, and it may not want to copyright it because the restaurant would have to publish its "secret" recipe. Presumably, the recipe would be written down in the form of a list of ingredients and the steps that would be necessary to make the dish, and it would not include anecdotes or substantial literary expression. In such a case, that recipe likely would not be copyrightable.

Even when a restaurant's signature dish is copyrightable, business issues arise. If a

restaurant has a signature dish and publishes a cookbook with enough "fluff," the recipes themselves may be protected by copyright, but what good is that copyright? The recipes will be public and open for all to see. It will be nearly impossible to know if and when restaurants around the country put that recipe on their own menus. The solution to these business concerns is found not in copyright but in trade secret law.

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Trade Secret Protection

Unlike copyright, which does not protect an idea itself, only its particular expression, trade secret law protects the author's very ideas if they possess some novelty and are kept secret. The Uniform Trade Secrets Act, which has been adopted in almost all fifty states, sets out the parameters for what constitutes a trade secret. Under the Uniform Trade Secrets Act, to constitute a trade secret and be entitled to protection, the information must derive "independent economic value, actual or potential, from not being generally known to, and not being readily ascertainable by proper means by, other persons who can obtain economic value from its disclosure or use" and must be the "subject of efforts that are reasonable under the circumstances to maintain its secrecy." Several courts have examined whether recipes constitute trade secrets, as discussed below.

In *Buffets, Inc. v. Klinke*, owners of a buffet restaurant chain brought an action against owners of a competing buffet restaurant for misappropriation of trade secret, specifically, its recipes for "basic American dishes" such as barbecue chicken and macaroni and cheese. 73 F.3d 965 (9th Cir. 1996). The court noted that trade secret law "protects the author's very ideas if they possess some novelty and are undisclosed or disclosed only on the basis of confidentiality." *Id.* The plaintiffs were forced to argue that novelty is a not a requirement for trade secret protection (because there would be nothing novel about macaroni and cheese), which was unsupported by the case law. *Id.* Although the lower court found the plaintiffs' recipes were more detailed than those of its competitors, it reasoned that details do not mandate a finding of novelty. *Id.* In contrast, the lower court concluded that even the detailed procedures were readily ascertainable. *Id.* Ultimately, the recipes and procedures were well-known in American cuisine, fairly basic, and could easily be discovered by others. They were, after all, food staples such as barbecue chicken and macaroni and cheese. The court found these recipes to be little more than typical American fare that were not entitled to trade secret protection. *Id.* Finally, the plaintiffs failed to prove that they necessarily derived any benefit from the recipes being kept secret. *Id.* As such, the court held that the recipes did not warrant trade secret protection.

The court in *Li v. Shuman* found similarly. No. 5:14-cv-00030, 2016 WL 7217855 (W.D. Va. 2016). In that case, one party alleged that common Asian dishes were trade secrets because the "process" for making them was novel. *Id.* The parties in *Li* were former business partners in an Asian restaurant venture. One of the plaintiffs was the head chef and the creator of the alleged "secret recipes," which he claimed were trade secrets. The court stated that recipes could be trade secrets, but these recipes were not. *Id.* The court reasoned that a "crucial characteristic of a trade secret is secrecy rather than novelty." *Id.* The recipes originated from two of the head chef's friends and partners, but the head chef testified that he incorporated his own taste. *Id.* He could not testify to anything specific that he changed in the recipes, though, saying the secret was "the process." *Id.* But he could not identify what was proprietary about his process. *Id.* Instead, the head chef admitted that the recipes were common Asian dishes. *Id.* There was, in fact, no evidence how his recipes were any different from those generally known in the industry. *Id.* The lack of a secret ingredient is not fatal, but he could point to nothing that gave him a competitive edge. Accordingly, the court held that the head chef could not meet his burden that the information derived independent economic value from not being generally known or readily ascertainable. *Id.*

In light of *Li*, it is necessary to be able to show why the process is novel. To do so, it is imperative to identify the actual process. It is not enough to allege the "process" is a trade secret without more context, explanation, or identification. Even then, the process must be sufficiently different from the processes used in publicly available recipes.

The plaintiff in *Vraiment Hospitality, LLC v. Todd Binkowski, et al.* faced the same difficulties proving that a recipe for salted caramel brownies was a trade secret. 8:11-CV-1240-T-33TGW, 2012 WL 1493737 (M.D. Fla. Mar. 19, 2012). There, the owner and operator of Amelie's Bakery & Café sued the defendants for using Amelie's salted caramel brownie recipe. *Id.* The plaintiff claimed that the salted caramel brownie recipe was secret and moved for a preliminary injunction to stop the defendants from using it. *Id.* The plaintiff argued that its salted caramel brownie had been prepared using a unique combination of ingredients that it had kept secret. *Id.* In support, the plaintiff presented an affidavit from a former pastry chef who stated the recipe included a "secret" ingredient that gave the brownie its "distinguishing taste." *Id.* The pastry chef tasted both parties' brownies and opined that the defendants copied Amelie's recipe because they had the same unique texture and taste, which she attributed to the secret ingredient. *Id.* Regarding secrecy, the plaintiff required its employees to sign confidentiality agreements. *Id.* The plaintiff divulged the secret ingredient to the court, but the court was unimpressed by its purported uniqueness, as it was included in brownie recipes found on http://www.epicurious.com. *Id.* Accordingly,

the court denied the plaintiff's motion for a preliminary injunction. *Id.*

Although these cases illustrate how difficult it can be to prove that a recipe is a trade secret, they also show that in the right case, recipes can be entitled to trade secret protection. The case of *Magistro v. J. Lou, Inc.* illustrates what a plaintiff will need to show to have a chance of prevailing in a trade secret case. 270 Neb. 438 (Neb. 2005). In *Magistro*, the court found that a pizzeria's dough and sauce recipes constituted trade secrets. *Id.* There, the owner of a pizza joint entered into a contract with the defendant, allowing the defendant to operate a pizzeria under the plaintiff's name and to use the plaintiff's "secret recipes." *Id.* The defendant stopped paying royalties and changed the restaurant name but continued using the recipes. *Id.* Ultimately, the issue in the case was not whether the dough and sauce recipes were trade secrets, but whether the defendant used the recipes in violation of the franchise agreements. *Id.* Nonetheless, the court concluded that the recipes were trade secrets. *Id.* According to the court, they derived independent economic value from not being known to others, and the plaintiff made reasonable efforts to maintain their secrecy. *Id.* The plaintiff, however, still lost. The reason was that the plaintiff failed to establish that the defendant was using the secret recipes. *Id.* In other words, just establishing trade secret protection may not be enough. There will be significant problems proving that a competitor is using a misappropriated secret recipe. The fact that the dishes taste similar will not be enough. *Id.*

The cases discussed here demonstrate the difficulty that someone has proving that a recipe is a trade secret. At the outset, the recipe has to be novel, which is a challenging task to prove, given the number and breadth of recipes that the public can access. The analysis, according to the *Vraiment* court, is not necessarily whether other restaurants are serving the same dish as you, but whether anyone anywhere could be doing so. Moreover, it is difficult to discern whether someone misappropriated a recipe or whether he or she just relied on personal experience and skill to come up with a similar recipe. Cooking is all about trial and error, which makes it hard to prove that someone misappropriated a recipe. It seems possible that someone could argue a recipe is different because the process for making the dish is different. Even there, it may be difficult to identify properly what makes a process secret and unique.

Conclusion

Given the limitations of copyright and trade secret law, the best protections for recipes are for the parties to agree who the rightful owner of a recipe is (*e.g.*, the chef or the restaurant) at the time of contracting, with assignments, and if appropriate, nondisclosure agreements (which, practically speaking, are almost a requirement for trade secret protection). Of course, by the time a dispute arises that is ripe for litigation, it is too late to correct these mistakes. Given this reality, commercial litigators must shape their arguments based on the facts they are given. In the copyright context, this can mean framing the recipe as merely a recitation of ingredients or focusing instead on the expressive words used in the recitation, depending on your side of the case. In the trade secret context, this means homing in on the steps taken (or not taken) to keep a recipe secret and the existence (or non-existence) of similar recipes in the public domain. Regardless of which side of a case you are on, the explosion of the foodie culture, the historical practices of the restaurant business, and the evolving law in this area provide ample grounds to develop and put forward unique and persuasive arguments.