Secret Ingredients: How to Protect Recipes

Clients in the hospitality industry are often interested in protecting their recipes. It is understandable that a business would be concerned about keeping its "special sauce" out of the hands of its competitors. However, recipes generally are not protectable under copyright law. This article explores the circumstances under which a recipe may be protected under copyright law as well as other tips for protecting a recipe beyond the protections of copyright law.

WHAT DOES COPYRIGHT LAW PROTECT?

Copyright protection exists for "original works of authorship that are fixed in a tangible medium of expression."[1] That means that a work must be original such that it possesses at least some minimal degree of creativity.[2] It must also fall into the list of eight works of authorship set forth within the Copyright Act: "literary works, musical works, dramatic works, pantomimes and choreographic works, pictorial, graphic or sculptural works, motion pictures and other audiovisual works, sound recordings and architectural works."[3] It must also be independently created by a human author[4] (for now), and it must be set in a sufficiently permanent form (*e.g.*, written down on paper or electronically, a photographic film or digital image, a recording or sheet music).

THE IDEA-EXPRESSION DICHOTOMY GENERALLY PREVENTS COPYRIGHT PROTECTION FOR RECIPES

Recipes are usually not protected by copyright law due to the legal principle of the idea-expression dichotomy which creates a dividing line between ideas, which are not protected, and the expression of those ideas, which can be protected by copyright law. This occurs where the idea and the expression of the idea are so intertwined that there is only one way, or very few ways, to express the idea. When this happens, the expression of the idea is not protectable. For example, when a recipe merely lists the ingredients and the quantity of those ingredients, the idea of the recipe is so intertwined with the expression of the idea of the recipe because there are very few ways to express the ingredients and associated quantity of the ingredients, that the list of

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[1] 17 U.S.C. § 102(a).
[2] *Feist Publications, Inc. v. Rural Telephone Service Co.*, 499 U.S. 340, 346 (1991).
[3] 17 U.S.C. § 102(a).
[4] *See* The United States Copyright Office Compendium, the Copyright Office's manual for examiners, Chapter 300, Section 306, https://www.copyright.gov/comp3/chap300/ch300-copyrightable-authorship.pdf (last accessed on June 2, 2022); *see also Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 58 (1884).

ingredients will usually not be protectable under copyright law.[5] The Copyright Office has not only stated that "mere listing of ingredients or contents is not copyrightable," but also that "a simple set of directions is uncopyrightable."[6] Following suit with the Copyright Office, courts have found that recipes are wholly factual and merely contain procedures which do not entitle them to copyright protection. *See, e.g., Tomaydo-Tomahdo, LLC v. Vozary*, 629 F. Appx. 658, 661 (6th Cir. 2015) (the "list of ingredients is merely a factual statement, and as previously discussed, facts are not copyrightable. Furthermore, a recipe's instructions, as functional directions, are statutorily excluded from copyright protection.").

UNDER SOME CIRCUMSTANCES, RECIPES MAY BE PROTECTABLE

Yet, other courts have found that certain recipes may be copyrightable, as there is a difference between bare-bones recipes and those that "convey more than simply the directions for producing a certain dish."[7] The Seventh Circuit in *Publications Int'l, Ltd*. gave some examples where recipes may warrant copyright protection such as where the recipe includes "suggestions for presentation, advice on wines to go with the meal, or hints on place settings with appropriate music," or where the "recipes are accompanied by tales of their historical or ethnic origin."[8] The court in *Barbour v. Head* found "that there exists a genuine issue of material fact in the instant case as to whether or not the recipes procured from *Cowboy Chow* represent mere unprotected facts or actual protected expression" because the recipes in the subject cookbook were "infused with light-hearted or helpful commentary" (*e.g.*, "Heat oil in heavy skillet. Add sugar and let it brown and bubble. This is the secret to the unique taste!" or "Great with all your meats!" or the suggested use of a "Frito's" bag as a bowl for eating "Frito Pie").[9]

These decisions coincide with the Copyright Office's statement that recipes can be protected "where a recipe or formula is accompanied by substantial literary expression in the form of an explanation or directions."[10] This is often why chefs opt to include anecdotes and personal stories alongside their recipes. For example, in *Fabio's Italian Kitchen*, a simple tomato sauce recipe is accompanied with the following personal commentary: "This is the simplest of sauces out there, so simple I don't even feel I want to call it cooking. But it's also delicious, so it does deserve the name of sauce."[11] Recipes can also be protected if they are accompanied by creative descriptions of the cooking or baking process. However, doing so will still not protect the ingredient list, the underlying process for making the dish, or the resulting dish — meaning that someone can express the same recipe in a different way (or "expression") and still not infringe the recipe creator's copyright. This was the unfortunate case for Alan Richardson and Karen Tack, the authors of the best-selling cookbook *Hello, Cupcake*, who saw their signature corn-on-the-cob

[5] The United States Copyright Office Compendium, Chapter 300, Section 313.4(F), states that a "mere listing of ingredients or contents is not copyrightable", as lists are not protected by copyright law, https://www.copyright.gov/comp3/chap300/ch300-copyrightable-authorship.pdf (last accessed on June 2, 2022). The Office has also stated that "a simple set of directions is uncopyrightable," https://www.copyright.gov/circs/circ33.pdf (last accessed on June 2, 2022).
[6] *Id*.
[7] *Publications Int'l., Ltd. v. Meredith Corp*., 88 F.3d 473, 481 (7th Cir. 1996).
[8] *Id*.
[9] *Barbour v. Head*, 178 F.Supp.2d 758, 764 (S.D. Texas 2015).
[10] Copyright Office FAQ's, https://www.copyright.gov/help/faq/faq-protect.html (last accessed June 2, 2022).
[11] Fabio Viviani, Fabio's Italian Kitchen p. 18 (2013).

cupcake on the cover of a magazine without giving them credit.[12] When Richardson and Tack tried to get the copycat article removed, they were told "the wording on the method isn't the same" and that they had no grounds to remove the recipe from the magazine.[13] While a cookbook can be protected under copyright law as a compilation as long as the arrangement and coordination of the recipes included is creative, this still does not cover the individual works included in the compilation.[14] This leaves you with protection of the arrangement of the selected recipes and not the actual recipes.

These real-life examples provide some insight for those seeking copyright protection for their recipes. First, an author should include content beyond the ingredient list such as headnotes, general instructional notes, directions and photographs. Second, an author should personalize his/her writing by developing a non-technical voice in the writing. For example, instead of "bake the chicken wings for 20 minutes" one could say "bake wings for 20 minutes, until the crispy skin sizzles and fills the room with mouth-watering aromas." Third, an author should use copyright notices on his/her recipes to alert the public that he/she is asserting ownership over the recipe and request that users seeking to reproduce the recipes get permission from the author first. Finally, even if a copyright is not at issue, it is good practice to be courteous to the author and mention the cookbook, website or blog where a recipe originated.

OPTIONS FOR PROTECTING YOUR RECIPE BEYOND COPYRIGHTS

A) TRADE SECRETS

Another option to consider, beyond copyright law, is to protect a recipe like a trade secret. While treating a recipe like a trade secret requires a certain level of intentional effort, the benefit is that, if done correctly, there is a real chance of keeping the recipe hidden. A trade secret is defined as: "all forms and types of financial, business, scientific, technical, economic, or engineering information, including patterns, plans, compilations, program devices, formulas, designs, prototypes, methods, techniques, processes, procedures, programs, or codes, whether tangible or intangible, and whether or how stored, compiled, or memorialized physically, electronically, graphically, photographically, or in writing if (A) the owner thereof has taken reasonable measures to keep such information secret; and (B) the information derives independent economic value, actual or potential, from not being generally known to, and not being readily ascertainable through proper means by, another person who can obtain economic value from the disclosure or use of the information."[15]

Reasonable efforts to keep a recipe secret include creating agreements (*e.g.*, Non-disclosure and Confidentiality agreements), as well as creating and enforcing policies and procedures between the owners, employees and others that may access the recipe. It is also important to establish physical and electronic security of the recipe as well as monitoring and

[12] Priya Krishna, "Who Owns a Recipe? A Plagiarism Claim Has Cookbook Authors Asking," New York Times, https://www.nytimes.com/2021/11/29/dining/recipe-theft-cookbook-plagiarism.html (last accessed June 2, 2022).
[13] *Id.*
[14] *Feist Publications, Inc. v. Rural Telephone Service Co.*, 499 U.S. 340, 346 (1991) ("A factual compilation may be copyrightable, but copyright protection is limited to the "particular selection or arrangement" and never to the facts themselves").
[15] *See* 18 U.S.C. § 1839.

measuring corporate efforts to keep the recipe secret. Finally, it is imperative to continuously take corrective actions and continually improve policies and procedures for disclosure of the trade secret. Some very well-known examples of companies that have kept their "secret recipe" under lock and key under the standards of a trade secret include Coca-Cola's coke recipe, McDonald's Big Mac "special sauce" recipe, KFC's secret recipe for its blend of 11 herbs and spices, and the Krispy Kreme Doughnut (the baking process, not the doughnut recipe itself).

Nevertheless, court decisions reflect the difficulty of demonstrating that recipes qualify as trade secrets. For example, in *Buffets, Inc. v. Klinke*, 73 F.3d 656 (9th Cir. 1996), the owners of a buffet restaurant chain sued the owners of a competing buffet restaurant for misappropriation of its trade secrets—its recipes for "basic American dishes" such as barbecue chicken and macaroni and cheese. The Ninth Circuit found that the recipes did not warrant trade secret protection because they were well-known and could easily be discovered by others.[16] And, in *Li v. Shuman*, 2016 WL 7217855 (W.D. Va. 2016), a chef sued his former business partner alleging misappropriation of trade secrets of common Asian dishes because the "process" for making them was novel. The court determined that the recipes were not entitled to trade secret protection because it could not be shown that there was anything novel or proprietary about the process for making typical Asian dishes generally known in the industry.[17] Further, in *Vraiment Hospitality, LLC v. Todd Binkowski*, 2012 WL 1493737 (M.D. Fla. 2012), the chef/owner sought a preliminary injunction against defendants for using his salted caramel brownie recipe, claiming that it was a trade secret. However, when the owner divulged the secret ingredient in the litigation, the court did not agree that it was in fact a unique secret ingredient as it could be found in other widely distributed salted caramel brownie recipes.[18] Finally, in the recently decided case *Mallet & Co. Inc. v. Laxayo*, 16 F.4th 364 (3d Cir. 2021), the Third Circuit declined to enforce a preliminary injunction or permit the company to pursue misappropriation of trade secret claims against two former employees because it found that the company did not identify the trade secret with "sufficient particularity to separate it from matters of general knowledge in the trade."[19] The takeaway from *Mallet & Co. Inc.* is that identifying broad categories of business and technical information as trade secrets will not meet the standard of a trade secret, and companies must do more if they wish to receive trade secret protection.

B) PROCESS PATENTS

The last possibility to protect a recipe falls under the "process patent" rubric. In order for a recipe to be patentable, it must meet the four requirements for patentability. First, it must be the type of invention that qualifies for patent protection. A recipe may be protectable under patent law as either a "new and useful process" (*e.g.*, steps to make a sauce or dough) or as a "composition of matter" (*e.g.*, a secret sauce).[20] The second requirement for patentability is whether the invention is useful. Recipes certainly meet the requirement as a "useful invention." The recipe must also be novel. This is where things begin to become more difficult for a recipe. In order to determine whether the recipe is novel, the Patent Examiner will determine whether the invention (*i.e.*, the

[16] See *Buffets, Inc. v. Klinke*, 73 F.3d 965, 968 (9th Cir. 1996).
[17] *See Li v. Shuman*, 2016 WL 7217855 at *20 (W.D. Va. 2016).
[18] *See Vraiment Hospitality, LLC v. Todd Binkowski*, 2012 WL 1493737 at *14 (M.D. Fla. 2012).
[19] *Mallet & Co. Inc. v. Laxayo*, 16 F.4th 364 (3d Cir. 2021).
[20] 35 U.S.C. 101.

recipe) already exists in the "prior art." In general, "prior art" consists of disclosures or events that occur before a person files a patent application. Examples of prior art include earlier patent published applications, books (including cookbooks), magazine articles, episodes on cooking shows, commercials, radio ads, and college thesis papers. If the recipe can be found in the prior art in substantially identical form, you cannot obtain a patent for it because the prior art "anticipates" the claim to the recipe.[21] If you can articulate any meaningful distinctions between your recipe and the prior art, you may be able to overcome an anticipation rejection by the patent office. Finally, and perhaps the most difficult requirement to establish for a recipe, is whether the invention is non-obvious. In order to patent a recipe, the owner must identify what makes the recipe unique and how the recipe can be distinguished over the totality of the prior art to overcome a rejection relating to obviousness.[22] Distinguishing features could include "unexpected results" from, for example, professional taste testers.

The Patent Examiner will look at a variety of references and pull from different patent applications, ultimately seeing if he or she can find all the elements of your recipe in the prior art. If the examiner can find all the elements in the prior art, they will likely deny the application on the basis that your recipe is a rearrangement of what is already known to exist and that someone with skill in the art would have known to combine the elements to make your recipe, or that it would have been "obvious to try" to combine the elements extant in the prior art. One way to overcome this type of rejection is to demonstrate that the recipe or process is counter-intuitive, meaning that it is unlikely that one of skill in the art would think to combine two ingredients or processes to solve a problem. Some examples that have overcome these hurdles and achieved a process patent include a sealed crustless sandwich with a crimped edge along an outer perimeter of the bread to seal the filling between the two slices of bread (also known as an "uncrustable").[23] Another example is a nut butter and jelly food slice whereby the first and second layers of jelly contain a hollow region between them and a volume of nut butter is inserted within the hollow region with a structural component making it stand alone and easy to use for mass sandwich-making.[24] A third example is the process of making what is known as "popcorn chicken."[25] These examples further reiterate the value of process patents to the hospitality industry.

TAKEAWAYS AND PRACTICAL CONSIDERATIONS

In sum, in order to protect a recipe under copyright law, there needs to be a unique expression accompanying the directions and ingredients, as mere ingredient lists and instructions are not protected. To obtain trade secret protection for a recipe, the recipe has to be novel and unique, and it must be protected like a trade secret. However, it may not be practical to keep a famous recipe under lock and key considering how often the dish is likely being made. Third, if the recipe or process is unique and non-obvious, consider a process patent application. Keep in mind that both copyright and patent applications require full disclosure of the recipe or process,

[21] 35 U.S.C. 102.
[22] 35 U.S.C. 103.
[23] *See* Patent Application for Sealed Crustless Sandwich, https://www.freepatentsonline.com/6004596.html (last accessed on June 2, 2022).
[24] *See* Patent Application for Nut Butter and Jelly Food Slice, https://www.freepatentsonline.com/5567454.html (last accessed on June 2, 2022).
[25] *See* Patent Application for Method of Making a Food Product from the Thigh of a Bird and Food Product made in Accordance with the Method, https://www.freepatentsonline.com/5266064.html (last accessed on June 2, 2022).

and these disclosures are available to the public which may moot the entire purpose of seeking protection.

Notwithstanding the foregoing, you might be left wondering how to practically deal with these issues in real-life and beyond legal theory. For example, how can a chef prevent his sous chef from stealing a famous dish and opening his own restaurant featuring the very same dish? Practically speaking, the chef would be best suited to enter into a non-disclosure and confidentiality agreement with the sous chef (and all other employees with access to the recipe) at the commencement of the employment.[26] This is the most cost-efficient way to communicate to the sous chef and other employees that the chef is serious about protecting the recipe and all other confidential information without creating burdensome rules (like keeping a secret ingredient under lock and key or having to sign a sheet every time a recipe is removed from a safe) likely to get in the way of daily practices. This also gives the chef leverage to sue the sous chef for breach of these agreements should a situation like this arise and hopefully recoup his or her damages.

Hospitality Law Committee
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[26] The same would hold true for an owner that employs a chef to create recipes for the entity as "works made for hire." The doctrine of works made for hire is beyond the scope of this article.