

# Protection for Informational Works After *Feist Publications, Inc. v. Rural Telephone Service Co.*

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## INTRODUCTION

The 1990s brought significant developments in the field of information technology. These stimulated the creation of a new global market for electronic information services and products, which is occupied substantially by electronic databases. The emergence of these new technological developments challenged many branches of the law, including intellectual property. A particularly prominent part of this debate is how the law should address the protection of electronic databases.

The debate over database protection in the United States can be traced back to the Supreme Court's seminal decision in *Feist Publications, Inc. v. Rural Telephone Service Co.*<sup>1</sup> In *Feist*, the Court found "white pages" telephone directories to be non-copyrightable.<sup>2</sup> The Court held that the touchstone for copyright protection is creative originality, and that this requirement is constitutionally mandated.<sup>3</sup> The Court's determination "inevitably means that the copyright in a factual compilation is thin. Notwithstanding a valid copyright, a subsequent compiler remains free to use the facts contained in another's publication to aid in preparing a competing work, so long as the competing work does not feature the same selection and arrangement."<sup>4</sup> *Feist* thus ended the tradition in some courts of providing copyright protection based on the labor invested in creating the work and declared the deaths of the "sweat of the brow" and "industrious collection" doctrines.<sup>5</sup>

The debate gained additional prominence due to a number of worldwide initiatives that extended or considered extending much more extensive legal protection for databases. Notably, the *Agreement on Trade Related Aspects of Intellectual Property Rights* ("TRIPs Agreement") introduced minimum standards regarding copyright protection for databases.<sup>6</sup> For several years the World

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<sup>1</sup> 499 U.S. 340 (1991).

<sup>2</sup> *See id.* at 340.

<sup>3</sup> *See id.*

<sup>4</sup> *Id.* at 349.

<sup>5</sup> *See id.* at 359–60.

<sup>6</sup> Agreement on Trade-Related Aspects of Intellectual Property Rights, Apr. 15, 1994, 33 I.L.M. 81, 87–93 (1994), 1994 WL 327459 (I.L.M.) [hereinafter TRIPs Agreement].

Intellectual Property Organization (“WIPO”) had also considered providing broader intellectual property rights in databases than the United States.<sup>7</sup> Furthermore, the European Union’s Directive on the Legal Protection of Databases (“Database Directive”), adopted in 1996, constituted the most comprehensive attempt to provide protection to databases. It granted a fifteen-year, renewable *sui generis* right to prevent the extraction and utilization of raw data from a database.<sup>8</sup>

The adoption of the Database Directive has sparked an ongoing debate over bills drafted in the U.S. Congress to address the legal protection of databases.<sup>9</sup> In particular, a number of legal scholars have voiced their opinions on the question of how Congress should react to the Supreme Court’s holding in *Feist* and the EU’s subsequent enactment of the Database Directive.<sup>10</sup> Most of this scholarship, however, has simply accepted the argument, advanced by some segments of the database industry and others, that *Feist* creates a problem, that this problem is exacerbated by the EU’s Database Directive, and that this problem needs to be solved.<sup>11</sup> Much of the scholarly discussion has also been dedicated to criticizing the United States’ proposed bills because of the risks they supposedly pose to the database industry generally and specifically to groups such as the scientific and educational

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<sup>7</sup> WORLD INTELL. PROP. ORG., *Basic Proposal for the Substantive Provisions of the Treaty on Intellectual Property in Respect of Databases*, at Art. I, WIPO Doc. CRNR/DC/6 (Aug. 30, 1996).

<sup>8</sup> See Directive 96/9/EC of the European Parliament and of the Council of 11 March 1996 on the legal protection of databases, art. 10(1) and 10(3), available at <http://eurlex.europa.eu/LexUriServ/LexUriServ.do?uri=CELEX:31996L0009:EN:HTML>.

<sup>9</sup> See, e.g., Jonathan Band & Makoto Jono, *The Database Protection Debate in the 106th Congress*, 62 OHIO ST. L.J. 869, 887–91 (2001).

<sup>10</sup> See, e.g., *id.* at 887–88.

<sup>11</sup> See, e.g., *Database and Collections of Information Misappropriation Act of 2003: Joint Hearing on H.R. 3261 Before the Subcomm. on Courts, the Internet, and Intellectual Prop. of the House Comm. on the Judiciary and the Subcomm. on Commerce, Trade, and Consumer Prot. of the House Comm. on Energy and Commerce*, 108th Cong. 27 (2003) (statement of David Carson, General Counsel, Copyright Office of the U.S., Library of Cong.) [hereinafter H.R. 3261 Hearing]; see also Band & Jono, *supra* note 9, at 871.

communities.<sup>12</sup> The academic debate has, therefore, also focused on suggesting new and improved forms of protection that Congress could enact.<sup>13</sup> The United States, however, has not yet adopted any protective measure to remedy the alleged problem in the database industry.

This Article wishes to explore the *Feist* decision and its progeny, critically analyzing courts' decisions after *Feist*. The Article proceeds as follows: Part I discusses the Supreme Court's decision in *Feist*, its holdings and shortcomings. Part II discusses several post-*Feist* cases, exploring the different approaches employed by courts in analyzing what if any aspects of compilations are copyrightable. Part III of this Article then explores the creative selection and arrangement standard and the scope of protection granted under this standard as well as its application to databases. The Article concludes with some suggestions and concluding remarks concerning how to bring about better clarity and guidance concerning copyright protection for databases and compilations.

## I. *FEIST PUBLICATIONS, INC. v. RURAL TELEPHONE SERVICE CO.*

### A. *Discussion of the Court's Decision*

*Feist Publications, Inc. v. Rural Telephone Service Co.* is recognized as the Supreme Court's first attempt to bring order to a very complex and increasingly critical issue: the application of copyright law to factual compilations.<sup>14</sup> In *Feist*, the Court found a "white pages" telephone directory to be non-copyrightable, holding that the sole basis for protection under United States copyright law

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<sup>12</sup> See, e.g., J.H. Reichman & Paul Uhlir, *A Contractually Reconstructed Research Commons for Scientific Data in a Highly Protectionistic Intellectual Property Environment*, 66 LAW & CONTEMP. PROBS. 315, 319–21 (2003).

<sup>13</sup> See, e.g., Jane C. Ginsburg, *No "Sweat"? Copyright and Other Protection of Works of Information after Feist v. Rural Telephone*, 92 COLUM. L. REV. 338, 340 (1992) (suggesting a federal anticopying statute with collective licensing) [hereinafter Ginsburg, *No Sweat*]; J.H. Reichman & Pamela Samuelson, *Intellectual Property Rights in Data?*, 50 VAND. L. REV. 51, 145 (1997) (suggesting a modified liability approach).

<sup>14</sup> *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340–41 (1991).

is creative originality.<sup>15</sup> With this decision, a unanimous Supreme Court sounded the death knell for the “sweat of the brow doctrine,” also known as the “industrious collection doctrine.”<sup>16</sup> Under these doctrines, the courts moved the concept of originality, with its focus on individuality and the creative process to the background and placed renewed emphasis on labor and effort as a basis for copyright compilations.<sup>17</sup> Although on its face this decision clarified the law by invalidating the above doctrines as tests for assessing copyrightability in factual compilations, the availability of copyright for factual compilations has not become predictable or stable after *Feist*.

*Feist* involved the copyrightability of a white pages telephone directory.<sup>18</sup> The plaintiff and respondent, Rural Telephone Service Company (“Rural”), held a monopoly franchise that permitted it to provide telephone service to a number of communities in Kansas.<sup>19</sup> Pursuant to state law, Rural produced an annually updated telephone directory that contained a typical white pages section which listed the names of residents alphabetically by last name.<sup>20</sup> The defendant and petitioner, Feist Publications, Inc. (“Feist”), was a publishing company that produced area-wide telephone books. The directory at issue in the litigation contained over 46,000 telephone listings and covered eleven different service areas.<sup>21</sup> The area covered by Feist’s directory overlapped with a portion of that serviced by Rural.<sup>22</sup>

In preparing its directory, Feist successfully obtained permission to use the white pages from ten of the eleven telephone companies whose listings it wished to duplicate.<sup>23</sup> Rural was the only company that refused to license its information to Feist. This refusal, however, did not deter Feist from basing part of its

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<sup>15</sup> *See id.* at 340.

<sup>16</sup> *See id.* at 341.

<sup>17</sup> *See, e.g., Jeweler’s Circular Publ’g Co. v. Keystone Publ’g Co.*, 281 F. 83, 88 (2d Cir. 1922).

<sup>18</sup> *Feist*, 499 U.S. at 340.

<sup>19</sup> *See id.* at 342.

<sup>20</sup> *Id.*

<sup>21</sup> *See id.* at 343.

<sup>22</sup> *See id.* at 342–43.

<sup>23</sup> *See id.* at 343.

directory on Rural's white pages by simply taking the desired portion of Rural's listings and incorporated it into its own directory.<sup>24</sup> Rural discovered the copying and subsequently sued Feist for copyright infringement.<sup>25</sup> The district court found Feist liable,<sup>26</sup> and the Tenth Circuit affirmed this decision.<sup>27</sup> The Supreme Court granted certiorari, presumably to resolve a split in the circuits over the extent of protection available to fact works.<sup>28</sup>

*Feist* presented the Court with the very conflict that the circuit courts had found so troubling. The Court had two options for resolving this conflict. On the one hand, it could use the "sweat of the brow" or "industrious collection" doctrines<sup>29</sup> and extend meaningful protection to Rural,<sup>30</sup> thereby eroding the well-established proposition that "originality is a . . . prerequisite for copyright protection."<sup>31</sup> Or, the Court could apply the "creative selection" principle, derived from decisions such as *Burrow-Giles Lithographic Co. v. Sarony*<sup>32</sup> and *Bleistein v. Donaldson Lithographing Co.*,<sup>33</sup> which would leave Rural with no effective protection against competitors like Feist who appropriated valuable

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<sup>24</sup> *Id.* at 342–44. Feist's employees conducted additional research to verify and augment Rural's listings. *Id.* at 343–44. Despite this, four entirely fictitious listings created by Rural were reproduced in Feist's directory. *Id.* at 344. This certainly supports Feist's wholesale appropriation of information from Rural's directory.

<sup>25</sup> *Id.* at 344.

<sup>26</sup> *Rural Tel. Serv. Co. v. Feist Publ'ns, Inc.*, 663 F. Supp. 214 (D. Kan. 1987).

<sup>27</sup> *Rural Tel. Serv. Co. v. Feist Publ'ns, Inc.*, 916 F.2d 718 (10th Cir. 1990).

<sup>28</sup> *Feist*, 499 U.S. at 360 (noting that, unlike the Tenth Circuit, the Second and Fifth circuits had rejected copyright protection for factual compilations); *see also infra* notes 29–33.

<sup>29</sup> Under these doctrines, copyright was a reward "for the hard work that went into compiling facts," rather than for creativity and originality. *See id.* at 352.

<sup>30</sup> One might argue that the sweat of the brow theory does not extend protection to Rural because Rural expended no meaningful effort in assigning and printing the telephone numbers of its customers. Since state law required Rural to publish its directory, the cost of doing so was presumably built into the rates Rural charged its customers. Denying copyright in this case would, thus, neither damage the incentives for producing telephone white pages nor deprive Rural of a fair economic return. The Eighth Circuit, however, had expressly rejected such an argument. *See Hutchinson Tel. Co. v. Fronteer Directory Co.*, 770 F.2d 128, 131–32 (8th Cir. 1985).

<sup>31</sup> *See Feist*, 499 U.S. at 351.

<sup>32</sup> 111 U.S. 53 (1884).

<sup>33</sup> 188 U.S. 239 (1903).

information.<sup>34</sup> Such a resolution, however, might be viewed as unfair and unwise as a matter of policy.<sup>35</sup>

As the above discussion suggests, both options required the Court to construct justifications for its decision. In other words, if the Court decided for the defendant, it would have to square its doctrinal choice with notions of fairness and public policy. If it decided for the plaintiff, it would have to explain why it had chosen to ignore the guidance of its own well-established originality requirement. The Court chose the former option, endorsing the creative selection approach.

The Court began by restating basic doctrines. The Court reviewed the history of copyright protection for compilations and the development of the sweat of the brow or industrious collection doctrines, unequivocally repudiating both doctrines. Originality, the Court explained, must have two components: “independent creation plus a modicum of creativity.”<sup>36</sup> However, the Court emphasized that the creativity requirement is extremely modest:

To be sure, the requisite level of creativity is extremely low; even a slight amount will suffice. The vast majority of works make the grade quite easily, as they possess some creative spark, no matter how crude, humble or obvious it might be.<sup>37</sup>

The Court explained that Congress, in enacting the Copyright Act of 1976, intended to overrule the sweat of the brow doctrine and require originality in order to protect compilations.<sup>38</sup> It discerned such intent, in part, from the newly introduced definition of “compilation” in the 1976 Act: “A work formed by the collection and assembling of pre-existing materials or of data that are selected, coordinated, or arranged in such a way that the

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<sup>34</sup> The creative selection principle affords protection only to compilations of facts featuring “original selection, coordination, or arrangement,” no matter how valuable the underlying facts themselves are. *See Feist*, 499 U.S. at 360 (citing 17 U.S.C. § 101).

<sup>35</sup> *See* Jane C. Ginsburg, *Creation and Commercial Value: Copyright Protection of Works of Information*, 90 COLUM. L. REV. 1865, 1938 (1990) [hereinafter Ginsburg, *Creation and Commercial Value*].

<sup>36</sup> *Feist*, 499 U.S. at 346.

<sup>37</sup> *Id.* at 345 (internal quotation marks omitted).

<sup>38</sup> *Id.* at 354–56.

resulting work as a whole constitutes an original work of authorship.”<sup>39</sup> The Court then listed the elements of authorship that are protected in a compilation: the selection, coordination and arrangement of the underlying material.<sup>40</sup> Finally, the Court emphasized that applying the creative selection approach to factual compilations:

inevitably means that the copyright in a factual compilation is thin. Notwithstanding a valid copyright, a subsequent compiler remains free to use the facts contained in another’s publication to aid in preparing a competing work, so long as the competing work does not feature the same selection and arrangement.<sup>41</sup>

With this very statement, the Court completely reversed earlier judicial approaches of a substantial minority of the circuits which had held that any substantial appropriation of material from a copyrightable compilation was an infringement.<sup>42</sup> Relying on the sweat of the brow doctrine, these courts had previously required late-comers independently to collect material for a competing compilation.<sup>43</sup> Nevertheless, the Court’s holding reflected well-known doctrines and conclusions, embraced by the majority of circuit courts. The Court, therefore, could have simply applied the creative selection approach of *Burrow-Giles* and *Bleistein* to the facts of the case and reached the same result. The Court, however, chose a different path, perhaps deciding that doctrine alone was an

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<sup>39</sup> Copyright Act of 1976, 17 U.S.C. § 101 (2006).

<sup>40</sup> See *Feist*, 499 U.S. at 356–57.

<sup>41</sup> *Id.* at 349.

<sup>42</sup> See, e.g., *Jeweler’s Circular Publ’g Co. v. Keystone Publ’g Co.*, 281 F. 83, 88–89 (2d Cir. 1922) (“[A] subsequent compiler is bound to set about doing for himself that which the first compiler has done. . . . [G]enerally he is not entitled to take one word of information previously published, without independently working out the matter for himself, so as to arrive at the same result from the same common source of information, and the only use that he can legitimately make of a previous publication is to verify his own calculations and results when obtained.”).

<sup>43</sup> See, e.g., *Rural Tel. Serv. Co. v. Feist Publ’ns, Inc.*, 663 F. Supp. 214, 219 (D. Kan. 1987) (“Courts recognize that a compiler of a directory may make fair use of an existing compilation if he first makes an independent canvass, then merely compares and checks his own compilation with that of the copyrighted publication and publishes the result after verifying the additional items derived from the copyrighted publication.”).

insufficient basis on which to uphold the creative selection approach. Moving beyond statutory interpretation, the Court held that “[o]riginality is a constitutional requirement.”<sup>44</sup> Citing nineteenth-century case law, the Court derived this requirement from references in the Constitution’s Intellectual Property Clause to “Writings” and “Authors.”<sup>45</sup> The Court suggested that these terms “presuppose a degree of originality.”<sup>46</sup>

But the Court went even further, explaining why the concerns raised by sweat of the brow proponents were outweighed by the Constitution’s originality requirement.<sup>47</sup> The Court recognized the possible unfairness of failing to protect a compiler’s labor, but explained that the fact that a compiler’s labor may sometimes be “used without compensation by others” is “not ‘some unforeseen byproduct of a statutory scheme’ but is, rather, ‘the essence of copyright.’”<sup>48</sup> By announcing that “[t]he primary objective of copyright is . . . to promote the progress of science and useful arts,”<sup>49</sup> the Court endorsed the view that copyright is meant only to advance the public welfare and not to secure the rights of authors. Regarding the possibility that protecting a compiler’s labor might be necessary to encourage the desired production of factual compilations, the Court stated that the creative selection approach correctly implemented copyright’s policy of encouragement.<sup>50</sup>

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<sup>44</sup> *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 346 (1991).

<sup>45</sup> *Id.* (quoting U.S. CONST. art. I, § 8, cl. 8). The Court hinted, however, that other forms of protection might not be subject to the same constitutional restriction. *See id.* at 354 (“Protection for the fruits of such research . . . may in certain circumstances be available under a theory of unfair competition.” (quoting I MELVILLE B. NIMMER & DAVID NIMMER, *NIMMER ON COPYRIGHT* § 3.04, at 3–23 (1990))).

<sup>46</sup> *Feist*, 499 U.S. at 346.

<sup>47</sup> *Id.* at 349–51.

<sup>48</sup> *Id.* at 349 (quoting *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 589 (1985) (Brennan, J., dissenting)).

<sup>49</sup> *Id.*; *see also* U.S. CONST. art. I, § 8, cl. 8.

<sup>50</sup> *Feist*, 499 U.S. 340, 349–50 (1991) (“To this end, copyright assures authors the right to their original expression, but encourages others to build freely upon the ideas and information conveyed by a work . . . . This principle, known as the idea/expression dichotomy, applies to all works of authorship. As applied to a factual compilation, assuming the absence of original written expression, only the compiler’s selection and arrangement may be protected; the raw facts may be copied at will. This result is neither unfair nor unfortunate. It is the means by which copyright advances the progress of science and art.”).

Having found copyright's originality requirement to be constitutionally mandated, the Court proceeded to explain how the sweat of the brow doctrine could not coexist with the creative selection approach.<sup>51</sup> The Court went on to suggest that courts that had adopted the sweat of the brow doctrine simply misunderstood the copyright statute.<sup>52</sup> The Court supported this conclusion by recapping the copyright statute's legislative history<sup>53</sup> that referred to the originality standard when it defined the phrase "original works of authorship."<sup>54</sup>

Having completed its attack on the sweat of the brow doctrine, the Court concluded its opinion by applying the originality/creative selection requirement to Feist's compilation. The Court reasoned that Rural's case hinged on whether Feist copied anything "original" from Rural.<sup>55</sup> The Court concluded that Feist did not copy any original material and accordingly reversed the lower courts.<sup>56</sup>

Understanding how and why the Court reached its finding of non-infringement also uncovers its strong desire to rule on the selection and arrangement question. The Court began by identifying what Feist copied from Rural, stating that Feist appropriated "1,309 names, towns, and telephone numbers from Rural's white pages."<sup>57</sup> One might then have expected the Court to proceed by analyzing whether Feist borrowed any selection or arrangement,<sup>58</sup> since copyright could extend only to the selection and arrangement of the underlying information. However, even if the Court had proceeded this way, it would almost certainly still

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<sup>51</sup> *Id.* at 353–54.

<sup>52</sup> *Id.* at 352 ("But some courts misunderstood the statute. These courts ignored §§ 3 and 4 . . . . Making matters worse, these courts developed a new theory to justify the protection of factual compilations. Known alternatively as 'sweat of the brow' or 'industrious collection,' the underlying notion was that copyright was a reward for the hard work that went into compiling facts." (citing *Leon v. Pac. Tel. Co.*, 91 F.2d 484 (9th Cir. 1937); *Jeweler's Circular Publ'g Co. v. Keystone Publ'g Co.*, 281 F. 83 (2d Cir. 1922))).

<sup>53</sup> *Id.* at 354–61

<sup>54</sup> *Id.* at 355 (quoting 17 U.S.C. § 102).

<sup>55</sup> *Id.* at 361.

<sup>56</sup> *Id.* at 363.

<sup>57</sup> *Id.* at 361.

<sup>58</sup> Feist admitted that the directory as a whole was copyrightable. *See id.*

have found for *Feist* as *Feist* had copied Rural's underlying material without appropriating an original selection or arrangement.<sup>59</sup> Such a finding would have been entirely consistent with the Court's statement that "copyright in a factual compilation is thin."<sup>60</sup>

But, the Court did not do this. Instead, the Court apparently assumed that *Feist* did take Rural's selection and arrangement, if only to reach the question of whether Rural's white pages selection and arrangement were copyrightable. The Court concluded that Rural's selection of listings was "obvious," and its arrangement was "not only unoriginal, it [was] practically inevitable,"<sup>61</sup> explaining:

The selection, coordination, and arrangement of Rural's white pages do not satisfy the minimum constitutional standards for copyright protection . . . . Rural's white pages are entirely typical . . . . In preparing its white pages, Rural simply takes the data provided by its subscribers and lists it alphabetically by surname. The end product is a garden-variety white pages directory, devoid of even the slightest trace of creativity.<sup>62</sup>

However, the Court acknowledged that the telephone white pages were an extreme case, falling into a "narrow category of works in which the creative spark is utterly lacking or so trivial as to be virtually nonexistent,"<sup>63</sup> and that "the vast majority of compilations will pass" the originality test.<sup>64</sup>

### *B. Analysis of the Decision*

The Supreme Court's decision in *Feist* has three main components. The first point was that one cannot acquire a copyright solely because of her sweat or industriousness in collecting the underlying material. However, this point, though

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<sup>59</sup> See *id.* at 343–44.

<sup>60</sup> *Id.* at 349.

<sup>61</sup> *Id.* at 362–63.

<sup>62</sup> *Id.* at 362.

<sup>63</sup> *Id.* at 359.

<sup>64</sup> *Id.*

important, is hardly earth shaking. As I have argued elsewhere, a historical analysis reveals that most circuit courts had already reached the same conclusion prior to the Court's decision in *Feist*.<sup>65</sup> In fact, only a small number of courts had granted copyright protection to factual compilations based on the sweat or industriousness expended by the compiler, with such decisions generally only granted in response to the pleas of producers of telephone directories and maps who claimed they had labored hard to produce their works.<sup>66</sup> In these cases, apparently moved by the equities of the cases, courts purported to rely on copyright law to justify their holdings, although their reasoning seems to be more in line with the misappropriation doctrine enunciated in cases such as *International News Service v. Associated Press*.<sup>67</sup>

“The second point in the *Feist* decision was that the Court held that a second compiler does not infringe a copyright when using facts gathered by a first compiler.”<sup>68</sup> This decision, however, was also unexceptional given the reality that copyright law has not protected facts under the 1909 Copyright Act and subsequent copyright statutes,<sup>69</sup> a point I have argued previously.<sup>70</sup> Requiring people to repeat all of the necessary time-consuming steps taken to gather information is simply inefficient.

The last and most important point in the Court's analysis was the Court's constitutionalization of the originality requirement in copyright law. “Although it was clearly unnecessary to decide the case on constitutional grounds since statutory grounds would have sufficed, the Court held that the Constitution required a minimum amount of originality or creativity in order for a work to be eligible for copyright protection.”<sup>71</sup> Indeed, prior to *Feist*, no other cases

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<sup>65</sup> Miriam Bitton, *Trends in Protection for Informational Works Under Copyright Law During the 19th and 20th Centuries*, 13 MICH. TELECOMM. & TECH. L. REV. 115 (2006). [hereinafter Bitton, *Trends*].

<sup>66</sup> *Id.*

<sup>67</sup> 248 U.S. 215 (1918).

<sup>68</sup> Bitton, *Trends*, *supra* note 65, at 172.

<sup>69</sup> *Id.* at 136 (showing that “[t]he prevailing approach under the 1909 Act, even in those courts adhering strictly to the industrious collection doctrine, was that facts and other indispensable materials are uncopyrightable”).

<sup>70</sup> *Id.*

<sup>71</sup> *Id.*

had stated *explicitly* that originality is constitutionally mandated, though one could argue that the Court's decision in *Sarony* suggested this implicitly.<sup>72</sup>

"*Feist* thus sounded the death knell for the sweat of the brow doctrine."<sup>73</sup> One might even be surprised that it took the Court 200 years to arrive at such a fundamental decision given the many opportunities it had to explain the terms "Author" and "Writings." However, when one examines the legal landscape and historical context within which *Feist* was decided, one begins to understand why the Court likely viewed constitutionalization of the originality requirement as necessary,<sup>74</sup> even if *Feist* was not necessarily the

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<sup>72</sup> See *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 58 (1884) ("We entertain no doubt that the constitution is broad enough to cover an act authorizing copyright of photographs, so far as they are representatives of original intellectual conceptions of the author."); Bitton, *Trends*, *supra* note 65, at 128–29.

<sup>73</sup> See Bitton, *Trends*, *supra* note 65, at 179.

<sup>74</sup> *But see* Robert Kreiss, *Copyright Protection for Computer Databases, CD-ROMS And Factual Compilations*, 17 U. DAYTON L. REV. 323, 327 (1992) (arguing that the Court in *Feist* failed to deal with the possibility that constitutional grant of power to Congress to "promote the Progress of Science and useful Arts" might contain some breathing room and that the Copyright Clause could have been interpreted broadly so that Congress could give copyright protection to some works whose originality is questionable in order to ensure that no worthwhile work (i.e., one which contributes to the "progress of science") is left out); Leo J. Raskind, *Assessing the Impact of Feist*, 17 U. DAYTON L. REV. 331, 336 (1992) (arguing that the main flaw of the *Feist* opinion is its failure to illuminate the process of gathering information and that failure to recognize that gathering of information at issue in this and other cases involves the exercise of judgment, which goes to the root of copyright protection); Benjamin B. Thorner, *Copyright Protection for Computer Databases: The Threat of Feist and a Proposed Solution*, 1 VA. J.L. & TECH. 5, 27 (1997) (arguing that "the idea that functional writings are unprotectable by copyright is wrongheaded as it hampers creators' incentives to profitably bring their goods to the public"); Russ VerSteeg, *Sparks in the Tinderbox: Feist, "Creativity," and the Legislative History of the 1976 Copyright Act*, 56 U. PITT. L. REV. 549 (1995) (questioning the validity of the "creativity" premise of the Court in *Feist* and arguing that the legislative history of the 1976 Copyright Act suggests that the drafters did not intend "creativity" to be a required element of copyrightability); Timothy Young, *Copyright Law: Copyright Protection for Factual Compilations: The White Pages of the Phone Book Are Not Original Enough to Be Copyrighted—But Why?*, 17 U. DAYTON L. REV. 631, 655–58 (1992) (arguing, inter alia, that the *Feist* decision required a higher level of originality than is congressionally mandated); Anant S. Narayanan, Note, *Standards of Protection for Databases in the European Community and the United States: Feist and the Myth of Creative Originality*, 27 GEO. WASH. J. INT'L L. & ECON. 457, 489–91 (1993–1994) (arguing that legislative history and congressional inaction

“best” factual scenario for establishing order and guidance within the problematic field of compilation copyright.

“*Feist* was decided in 1991, exactly when major developments and breakthroughs in the fields of computers, telecommunications, and information technologies, as well as the commercialization of the Internet, were rapidly taking place.”<sup>75</sup> The opinion in *Feist*, thus, both reflected and signaled the beginning of a new era of coherence, one which emphasized the constitutional dimensions constraining intellectual property law doctrines. The opinion also reflected the great uneasiness with and intolerance of the industrious collection doctrine that allowed the capture and enclosure of facts—our building blocks of knowledge—and signaled a shift away from a focus on the proprietary dimension of copyright in favor of dissemination of information and ideas.<sup>76</sup> Therefore, as I have argued elsewhere, while the industrious collection doctrine might have been a necessity during the era of pre-digital, old-fashioned compilations—those in which database producers did not have the tools at their disposal to recoup their investment in the creation of their products—*Feist* represented the realization that such reasoning is inapplicable to modern electronic databases.<sup>77</sup> A constitutionally-mandated originality requirement anticipated and prevented the possibility that interest groups would try to press Congress to pass legislation protecting these building blocks of knowledge. Indeed, almost all the bills introduced to cope with the database protection “problem” thus far have failed mainly because they could not have withstood constitutional

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suggest that the Court’s creative originality requirement is not constitutionally mandated).

<sup>75</sup> Bitton, *Trends*, *supra* note 65, at 173.

<sup>76</sup> See *Cable News Network, Inc. v. Video Monitoring Serv. of Am. Inc.*, 940 F.2d 1471, 1481 (11th Cir. 1991), *vacated*, 949 F.2d 378 (11th Cir. 1991). Viewing *Feist* as revolutionizing the law of copyright, the panel in *Cable News Network* was persuaded that *Feist* signaled a shift away from a focus on the proprietary nature of copyright, in favor of dissemination of information and ideas. *Id.* at 1478. Using this as a philosophical basis, the court concluded that Cable News Network had no copyright in the news of the day, which apparently included Cable News Network’s own news clips and its own reports of the news. *Id.* at 1485. See also David O. Carson, *Copyright Protection for Factual Compilations After Feist: A Practitioner’s View*, 17 U. DAYTON L. REV. 969, 980 (1992).

<sup>77</sup> Bitton, *Trends*, *supra* note 65, at 173.

challenges after *Feist*.<sup>78</sup> The Court thus seems to have envisioned the challenges and technological advances that were to come. The origins of the jurisprudence inherent in *Feist*, therefore, necessarily lie in twentieth century achievements, rather than those of the nineteenth century.

Nonetheless, despite these important (and largely predictable) aspects of *Feist*, the Supreme Court offered no guidance to the lower courts on the question of creativity in the selection and arrangement of compilations since it articulated the originality standard by choosing the weakest possible case: that of a white-pages directory. The following discussion details some of the most notable problems with the decision's fact pattern.

First, *Feist* proved a poor case for the Court to discuss copyright protection in fact works as it involved no real sweat from

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<sup>78</sup> The most recent U.S. bill for database protection was the Database and Collections of Information Misappropriation Act of 2003, H.R. 3261, 108th Cong. (2003) (The bill passed the House Judiciary Committee on Jan. 21, 2004. This bill adopts a pure misappropriation approach, modeled almost literally after the Second Circuit's test formulated in *Nat'l Basketball Ass'n v. Motorola, Inc.*, 105 F.3d 841 (2d Cir. 1997). Former database protection bills are: Database Investment and Intellectual Property Antipiracy Act of 1996, H.R. 3531, 104th Cong. (1996) (The professed goal of the bill was to prevent actual or threatened competitive injury by misappropriating a database or its contents and it proposed a twenty-five-year term of protection. The bill was met with ample criticism and finally failed, mainly because it contained inadequate exceptions or privileges to protect the public interest and because the drafters of the bill did not consult with the relevant scientific and educational communities.); Collection of Information Antipiracy Act, H.R. 2652, 105th Cong. (1997) (Although the legislation was styled as a misappropriation bill based on a tort rather than an intellectual property right theory, the substantive tests were almost identical to those of H.R. 3531. This bill received support from a limited number of large database publishers, but was eventually dropped due to concerns voiced by some government agencies.); Consumer and Investor Access to Information Act of 1999, H.R. 1858, 106th Cong. (1999) (designed to provide protection only against unauthorized commercial uses that were "in competition" with the protected database and would have protected only against duplication of another's database. The bill contained exceptions for news reporting use and for scientific, educational, and research uses, but did not contain a general exception for unauthorized "fair uses" and a limited term of protection. The lack of these last two ingredients might have made this bill more vulnerable than H.R. 354 to a facial First Amendment challenge.); Collection of Information Antipiracy Act, H.R. 354, 106th Cong. (1999) (Designed broadly to protect investment in databases against unauthorized uses that cause material harm, it prohibited the unauthorized use of "all or a substantial part" of a protected database. The bill contained exceptions for news reporting use and for scientific, educational, and research uses. It also contained general exception for fair use and a limited term of protection.).

Rural's brow and thus no free riding by Feist. Whereas in the past, creating a "white pages" directory was a labor-intensive mission, requiring lots of people with file cards to handle, assemble, and check individual phone listings,<sup>79</sup> today's phone information is digital. In the digital era, telephone companies are not engaged in the same labor-intensive task for creating telephone directories. Such directories can easily be created based on the companies' client data.<sup>80</sup> Therefore, *Feist* did not really involve "sweat of the brow" or human effort as historically understood.<sup>81</sup> Additionally, the *Feist* case did not exemplify the classical free rider scenario. The classical free rider scenario assumes that late-comers use authors' work product without paying the authors, thus benefitting from their work without sharing the authors' production costs. In *Feist*, Feist actually licensed ten out of the eleven telephone directories and clearly attempted to license Rural's directory rather than copy it for free.<sup>82</sup>

The second problem lies in the fact that the data at issue in *Feist* was generated by a government-created monopolist (Rural), which was required by law to produce this information but refused to license it.<sup>83</sup> State-licensed monopolies such as Rural do not require incentives to create directories since there are mandatory requirements to produce such information as well as the possibility of revenue received from advertising or other readily available business models.<sup>84</sup> In fact, even if no possibility of advertising revenue existed, and certainly before the rise of the Internet, consumers would probably be willing to pay for the production of phone books. It is important to emphasize that in the Telecommunication Act of 1996, Congress solved *Feist's* holdout

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<sup>79</sup> Symposium, *Panel I: Database Protection*, 11 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 275, 296 (2001); see also *Jeweler's Circular Publ'g Co. v. Keystone Publ'g Co.*, 274 F. 932 (S.D.N.Y. 1921), *aff'd*, 281 F. 83 (2d Cir. 1922), *cert. denied*, 259 U.S. 581 (1922) (upholding copyright protection in a compilation of the names and addresses of jewelers which "was the result of considerable past labor" by the compiler-plaintiff and which featured "original illustrations made by the plaintiff.").

<sup>80</sup> See *Panel I: Database Protection*, *supra* note 79, at 296.

<sup>81</sup> *Id.*

<sup>82</sup> *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 343 (1991).

<sup>83</sup> *Id.*

<sup>84</sup> *Id.* at 342.

problem regarding telephone subscribers' information by requiring telecommunication carriers to provide non-discriminatory access to telephone numbers and directory listings,<sup>85</sup> thereby ensuring that such information remain accessible to others.

Third, the *Feist* Court dealt with the easiest type of directory: a white pages directory, organized in alphabetical order, lacking minimal creativity.<sup>86</sup> The nature of the case thus made the need to provide guidelines regarding creativity in compilations extraneous to the holding, a fact that has since proven to be one of the major weaknesses of the decision. For example, soon after the Court decided *Feist*, a series of cases "pop[ped] up throughout the federal circuit" courts that seemed especially suited to follow from the precedent set in *Feist*.<sup>87</sup> "However, the stability and clarity that the Court seemed to promise proved to be short-lived"<sup>88</sup> because while factually similar, different circuits decided those cases differently.<sup>89</sup> Thus, while the Court's decision in *Feist* did succeed in ending the split among circuit courts regarding the continued viability of the industrious collection doctrine, the Court created ambiguity as to the exact standard of originality required for copyright protection for selection and arrangement of information in fact works.<sup>90</sup> The result: continued division and uncertainty regarding the copyrightability of compilations.

Fourth, by holding that "obvious" selection and arrangement is not copyrightable,<sup>91</sup> the Court implicitly introduced uncertainty as

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<sup>85</sup> Telecommunication Act of 1996, 47 U.S.C. § 222(e) (2006).

<sup>86</sup> *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 364 (1991) ("Given that some works must fail [copyright's minimal creativity test], we cannot imagine a more likely candidate. Indeed, were we to hold that Rural's white pages pass muster, it is hard to believe that any collection of facts could fail.").

<sup>87</sup> Ethan R. York, Note, *Warren Publishing, Inc. v. Microdos Data Corp.: Continuing the Stable Uncertainty of Copyright in Factual Compilations*, 74 NOTRE DAME L. REV. 565, 565 (1999).

<sup>88</sup> *Id.*

<sup>89</sup> *Id.*

<sup>90</sup> *Id.* at 585 (arguing that while *Feist* may have "ended 'the seventy year split among circuits' concerning sweat of the brow versus creative selection/arrangement theory, the Court may have created a new seventy year split by not providing further clarification in the standards of originality it proclaimed" (quoting Tracy Lea Meade, *Ex-Post Feist: Application of a Landmark Copyright Decision*, 2 J. INTELL. PROP. L. 245, 251-52 (1994))).

<sup>91</sup> *Feist*, 499 U.S. at 362.

to the level of copyright protection available to fact works which demonstrate less obvious selection and arrangement. Indeed, *Feist* suggests that the work's copyright status is dynamic rather than static and that over time a fact work can become an industry standard or convention, and as a result, might lose its protection. For example, the first creator of a telephone directory could have been perceived as an author of an original work of authorship by organizing her compilation in an original way not known or used before. However, over time, with the widespread adoption of alphabetically organized telephone directories, such organization became an industry standard. One can imagine a new copyrightable organization or selection for fact works being found unoriginal during its lifetime.

Fifth and last, the Court failed to articulate what is considered a "fact" and why telephone subscribers' information is factual in nature. The Court's failure to address these seemingly basic and simple questions created many problems later on as the following discussion will demonstrate.

## II. *FEIST*'S PROGENY

The ambiguous decision thus left some, including members of the information industry, unsatisfied. They argued that while the Court's decision in *Feist* established that originality in selection and arrangement precludes copying but does not preclude using the underlying factual materials of compilations,<sup>92</sup> they were still left with no meaningful copyright protection since "mechanical" selection and arrangement are insufficient to meet the creativity requirement.<sup>93</sup> Indeed, the Court's analysis did fail to provide

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<sup>92</sup> See *id.* at 349–350 (citing *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 556–57 (1985)).

<sup>93</sup> See, e.g., Alfred C. Yen, *The Legacy of Feist: Consequences of the Weak Connection Between Copyright and the Economics of Public Goods*, 52 OHIO ST. L.J. 1343, 1374–75 ("[T]here is no particular reason to think that the creative selection approach directs copyright to compilations whose production genuinely requires encouragement. If anything, it would seem that the sweat theory, which the Court rejected, is better related to the need for encouragement because the amount of a compiler's labor bears some relationship to the size of development costs. Significant sweat would imply large development costs, which in turn would suggest that a compiler would face difficulty in recouping those costs. This realization exposes as questionable

guidelines for evaluating whether a compilation meets the original selection and arrangement test, leaving such decisions to the lower courts. Accordingly, lower courts were left with two critical unanswered questions: what constitutes creativity in selection and arrangement, and, assuming that this threshold is met, what sort of copying does it prevent? Courts' decisions following *Feist* provide answers to these questions.

Since I have discussed the arguments regarding the need for copyright protection in fact works elsewhere,<sup>94</sup> the focus of this Article is limited to an assessment of the strength of copyright protection for compilations under the above-mentioned creativity standard in selection and arrangement within post-*Feist* case law. The discussion closely examines this case law by first distilling the standards that were developed regarding the selection and arrangement test. It describes the courts' search for creative selection based on either the subjective decisions involved in determining the compilations' criteria or the conscious exclusion from the compilation of some data that meets the objective criteria of the compilation. It also explores the courts' struggle to define a creative arrangement standard based on data's arrangement in a non-mechanical or subjective manner.

The discussion then deals with the courts' struggles in applying these tests (and *Feist's* proscription of copyright protection in facts themselves)<sup>95</sup> to define the "fact," "idea," and "expression" of compilations.<sup>96</sup> Professor Ginsburg has argued that the definitions

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any assertion that the creative selection approach's application to factual compilations strongly promotes "the progress of Science and useful Arts." (citations omitted)); *see generally* Miriam Bitton, *A New Outlook on the Economic Dimension of the Database Protection Debate*, 47 *IDEA* 93 (2006) [hereinafter Bitton, *A New Outlook*].

<sup>94</sup> *See generally id.*

<sup>95</sup> *See, e.g.*, *CCC Info. Servs., Inc. v. Maclean Hunter Mkt. Reports, Inc.*, 44 F.3d 61 (2d Cir. 1994), *cert. denied*, 516 U.S. 817 (1995); *Kregos v. Associated Press*, 937 F.2d 700 (2d Cir. 1991); *Key Publ'ns, Inc. v. Chinatown Today Publ'g Enters.*, 945 F.2d 509 (2d Cir. 1991).

<sup>96</sup> *See, e.g.*, Ginsburg, *No Sweat*, *supra* note 13, at 346 ("In copyright law, an 'idea' is not an epistemological concept, but a legal conclusion prompted by notions—often unarticulated and unproven—of appropriate competition. Thus, copyright doctrine attaches the label 'idea' to aspects of works which, if protected, would (or, we fear, might) preclude, or render too expensive, subsequent authors' endeavors.").

of the above terms were based on public policy considerations.<sup>97</sup> Such considerations, she claims, reflected an attempt to draw a proper balance between incentives to create and access the building blocks of future works.<sup>98</sup> This Article suggests that a careful, closer examination of these cases reveals that many of these decisions were wrongly decided and are a source of concern. Though purporting to follow *Feist's* legacy and provide greater access to materials constituting building blocks of knowledge via newly created distinctions between different kinds of facts, these cases instead seem to exhibit disloyalty to the holding and spirit of *Feist*, providing protection to works that do not meet *Feist's* threshold of creativity, and introducing uncertainty and incoherence to copyright law jurisprudence.<sup>99</sup>

The discussion concludes with an introduction to and a description of the new and improved “intent test” for identification of unprotectable “facts” and “ideas” and protectable “expression” in compilations. The scope of copying that is prevented under the creative selection and arrangement standard is also explored and the application of the standard and its scope of protection as formulated by the courts regarding electronic databases is examined.

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<sup>97</sup> *Id.*

<sup>98</sup> See Jane C. Ginsburg, *Copyright, Common Law, and Sui Generis Protection of Databases in the United States and Abroad*, 66 U. CIN. L. REV. 151 (1997). Discussing the Second Circuit’s distinction between types of ideas, the author suggests that, for the court, a “soft” idea is one whose privatization by copyright is tolerable because it “do[es] not materially assist the understanding of future thinkers. The court has come close to acknowledging that an idea in copyright law is not an epistemological concept; it is a legal conclusion informed by public policy notions of what is necessary to stimulate creations of works in the first place, while still leaving room for subsequent innovation.” *Id.* at 153–54 (quoting *CCC*, 44 F.3d at 71).

<sup>99</sup> Subjective is defined as “[p]roceeding from or taking place within an individual’s mind and unaffected by the outside world.” AMERICAN HERITAGE DICTIONARY 677 (1983). Because these decisions are based on functional considerations, they are certainly affected by the outside world and are not subjective.

### A. *The Creative Selection and Arrangement Standard*

#### 1. Development of the Standard in Courts' Decisions

Examination of major decisions in both the Second and Eleventh Circuits show that these courts and others that followed them required the compiler to have made subjective decisions in compiling the directory in order to meet *Feist's* creativity threshold.<sup>100</sup> Standards that search for subjective elements attempt to identify the “person” in the work, meaning the elements of a work that stem from a person. Thus creative selection requires showing either the presence of subjective decisions in determining the criteria of the compilation or conscious exclusion from the compilation of some data that meets the objective criteria of the compilation.<sup>101</sup> Similarly, creative arrangement requires the compiler to arrange data in a subjective or non-mechanical manner.<sup>102</sup> The underlying assumptions of the “subjective decisions” standards are that works whose facts are selected or arranged in an objective manner do not reflect their creator’s personality and, even if one assumed that they did, objective selection or arrangement criteria permit the facts in the works at issue to be expressed in only a very limited number of ways.<sup>103</sup>

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<sup>100</sup> See *Bellsouth Adver. & Publ'g Corp. v. Donnelley Info. Publ'g, Inc.*, 999 F.2d 1436 (11th Cir. 1993) (en banc), *cert. denied*, 510 U.S. 1101 (1994); *Key Publ'ns, Inc. v. Chinatown Today Publ'g Enters.*, 945 F.2d 509 (2d Cir. 1991); *Eckes v. Card Prices Update*, 736 F.2d 859, 862–63 (2d Cir. 1984) (finding the exercise of judgment in selecting a set of “premium” baseball cards worthy of copyright protection); see also 1 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 2.04[B] (Matthew Bender rev. ed. 2010) (examining opinions which found originality in selection and emphasizing the necessity of “subjective judgment”); Ginsburg, *Creation and Commercial Value*, *supra* note 35, at 1896 (describing selection and arrangement as “a test of subjective authorship”); Jack B. Hicks, Note, *Copyright and Computer Databases: Is Traditional Compilation Law Adequate?*, 65 TEX. L. REV. 993, 1005 (1987) (noting that “under the *subjective* selection standard expression is found in the actions taken to collect information” (emphasis added)).

<sup>101</sup> 1-2 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 2.04[B] (Matthew Bender rev. ed. 2010) (noting that “the requisite originality may inhere in selection or arrangement alone, even if the other ingredient is lacking”).

<sup>102</sup> See, e.g., *Matthew Bender & Co., Inc. v. West Publ'g Co.*, 158 F.3d 674, 682 (2d Cir. 1998) (“[W]hen it comes to the selection or arrangement of information, creativity inheres in making non-obvious choices from among more than a few options.”).

<sup>103</sup> See, e.g., *Key Publ'ns*, 945 F.2d at 513.

This leads to the application of the merger doctrine and results in the denial of copyright protection for such works.<sup>104</sup> “Subjective decisions” standards also assume that providing protection to objectively dictated selection and arrangement of factual compilations provides, in practice, protection to the least valuable elements of the work.

Loyalty to such standards and their underlying assumptions would keep the most valuable aspects of the work free for use by all. However, courts’ decisions in applying these standards, oftentimes providing protection to works that should not have been protected, illustrate their failure to understand *Feist’s* underlying rationales. The Second Circuit’s decision in *Key Publications, Inc. v. Chinatown Today Publishing Enterprises*,<sup>105</sup> which provided protection to a classified business directory used by New York City’s Chinese-American community,<sup>106</sup> and the Eleventh Circuit’s decision in *Bellsouth Advertising & Publishing Corp. v. Donnelley Information Publishing, Inc.*<sup>107</sup> which denied protection to a yellow pages directory, provide excellent examples of two cases with identical factual scenarios that were decided differently.

In *Key Publications*, the Second Circuit examined whether defendant Galore infringed plaintiff Key’s classified business directory intended for use by New York City’s Chinese-American

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<sup>104</sup> See *infra* note 153 and accompanying text.

<sup>105</sup> 945 F.2d 509 (2d Cir. 1991).

<sup>106</sup> *Id.* at 512.

<sup>107</sup> 999 F.2d 1436 (11th Cir. 1993); see also *Mid Am. Title Co. v. Kirk*, 59 F.3d 719 (7th Cir. 1995) (holding that the selection of factual information in a title commitment did not merit copyright protection since the selection of facts to include was not a matter of discretion grounded in the title company’s personal judgment or taste, but was dictated by convention and industry standards. Title examiners had to list all of the facts that could affect the marketability of a title); *Am. Dental Ass’n v. Delta Dental Plans Ass’n*, 39 U.S.P.Q.2d 1714 (N.D. Ill. 1996) (holding that a list of dental procedures did not constitute a creatively original selection because no selection can be discerned when the list was intended to be comprehensive); *Skinder-Strauss Assocs. v. Mass. Continuing Legal Educ., Inc.*, 914 F. Supp. 665, 676 (D. Mass. 1995) (finding that a publisher of a legal directory “did not exercise even a minimal degree of creativity in a Feistian sense” in selecting only actively practicing Massachusetts attorneys and in omitting those who were retired or suspended and in selecting other information in the directory, such as attorney name, address, telephone, and fax numbers since such information was not original but was rather “determined by forces external to the compiler”).

community.<sup>108</sup> Noting that original selection involves judgment in choosing what from a body of data to include in a compilation,<sup>109</sup>

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<sup>108</sup> *Key Publ'ns*, 945 F.2d at 512.

<sup>109</sup> *Id.* at 513; *see also* *Lipton v. Nature Co.*, 71 F.3d 464, 470 (2d Cir. 1995) (finding creative selection in the words included in a book since the plaintiff selected the words included in his book from numerous variations of hundreds of available terms in fifteenth century works based on subjective, informed, and creative judgment); *Eckes v. Card Prices Update*, 736 F.2d 859, 863 (2d Cir. 1984) (finding selectivity in the designation of 5,000 cards as “premium” from among 18,000 baseball cards); *Nester’s Map & Guide Corp. v. Hagstrom Map Co.*, 796 F. Supp. 729, 733 (E.D.N.Y. 1992) (finding creative selection in the selections of both street address listings and out-of-town destinations in a New York City taxi driver’s guide since the plaintiff showed creativity in assigning approximate numbers to building addresses at chosen intersections and used its knowledge and judgment in making its choice regarding specific useful out-of-town destinations); *Budish v. Gordon*, 784 F. Supp. 1320, 1333 (N.D. Ohio 1992) (finding creative selection in the selection of data contained in tables in a copyrighted book on Medicaid planning since the plaintiff chose relevant data from the Governor’s Report and discarded what he felt was unnecessary). Also, see the following cases which went along the same line of analysis: *Matthew Bender & Co., Inc. v. West Publ’g Co.*, 158 F.3d 674 (2d Cir. 1998) (“Bender I”) and *Matthew Bender & Co., Inc. v. West Publ’g Co.*, 158 F.3d 693 (2d Cir. 1998) (“Bender II”). In both cases the Second Circuit denied copyright protection to the selection and arrangement of many of West’s case reports. In *Bender I*, the defendant published HyperLaw, a CD-ROM compilation of federal decisions. 158 F.3d at 677. It copied the text of the opinions from West, but deleted West’s syllabi, headnotes, and key numbers. *Id.* at 677–78. Hyperlaw, however, did copy other enhancement features that West typically adds to the judicial texts: information about parties, counsel, court, and date of decision; annotations about subsequent procedural developments; and the editing of parallel citations in the reported cases to ensure uniformity of style. *Id.* at 678. West argued that each enhancement feature reflected creative choices. *Id.* at 681. The Second Circuit disagreed, affirming the district court’s grant of declaratory relief to HyperLaw. *Id.* at 689. The court held that all of the information was factual in nature, and that the information was not compiled or arranged with even the minimal creativity required by *Feist*. *Id.* at 685. On the contrary, every decision that West made about format or arrangement was dictated by convention. *Id.* at 677. While West’s work “entails considerable scholarly labor and care,” the court observed, “creativity in the task of creating a useful case report can only proceed in a narrow groove.” *Id.* at 688. But see *West Publ’g Co. v. Mead Data Cent., Inc.*, 799 F.2d 1219 (8th Cir. 1986) where West had established a compilation copyright in the arrangement of cases in its National Reporter System; *Oasis Publ’g Co. v. West Publ’g Co.*, 924 F. Supp. 918 (D. Minn. 1996) in which the court upheld the court’s rulings in the pre-*Feist* case discussed above. In *Bender II*, however, the Second Circuit rejected claims identical to those that had been endorsed in *Oasis* and the earlier *Mead Data* decisions. The court held that a work that simply permits a user “to re-arrange the material into the copyright holder’s arrangement,” does not amount to an infringing copy—an issue never addressed in *Oasis*. *Bender II*, 158 F.3d at 702. Bender could not be charged with contributory infringement because West had failed to identify any primary infringer. Finally, the court criticized the *Oasis*, *Mead Data* notion that a work

the court held that the plaintiff's exclusion of businesses that it did not think would remain open very long was sufficiently original.<sup>110</sup> However, this exclusion does not seem to be truly subjective since the plaintiff's decision was the result of purely functional considerations—the plaintiff wanted to provide consumers with a directory that included only relevant, useful data.<sup>111</sup>

The court examined whether the plaintiff's work exhibited creative arrangement, explaining that original “[a]rrangement ‘refers to the ordering or grouping of data into lists or categories that go beyond the mere mechanical grouping of data as such, for example, the alphabetical, chronological, or sequential listings of data.’”<sup>112</sup> Applying this standard in *Key Publications*, the court wrongly concluded that while Key's directory was in a format “common to most classified directories,”<sup>113</sup> its “arrangement [was] in no sense mechanical, but involved creativity on the part of [the plaintiff] in deciding which categories to include and under what name.”<sup>114</sup>

However, functional considerations dictate both the decisions regarding which categories to include and under what headings. Producers of such business directories usually make such decisions based on the intuitiveness of such choices to consumers. They use conventional, accepted—and thus, predictable—categories so consumers can easily find the information they seek.<sup>115</sup> Therefore,

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which can supplant the original, is by definition, a copy. These cases, the Second Circuit held, have no basis, other than the defunct “sweat of the brow” doctrine. *Bender II*, 158 F.3d at 708.

<sup>110</sup> See *Key Publ'ns, Inc. v. Chinatown Today Publ'g Enters.*, 945 F.2d 509, 513 (2d Cir. 1991).

<sup>111</sup> *Id.* In this context I consider “functional” considerations to constitute objective rather than subjective selection because the compiler has no real choice in making such decisions.

<sup>112</sup> *Id.* (quoting U.S. COPYRIGHT OFFICE, GUIDELINES FOR REGISTRATION OF FACT-BASED COMPILATIONS 1 (Rev. Oct. 11, 1989)).

<sup>113</sup> *Id.* at 514.

<sup>114</sup> *Id.*

<sup>115</sup> See Ginsburg, *Creation and Commercial Value*, *supra* note 35, at 1868 n.13 (arguing that the “[p]ersonality-based characterizations of many [factual compilations] seem contrived”). In *Publ'ns Int'l, Ltd. v. Meredith Corp.*, the Seventh Circuit, a sweat of the brow court before *Feist*, clearly invoked the sweat of the brow doctrine in the guise of originality after *Feist*. 88 F.3d 473 (7th Cir. 1996). The court held that the ingredient lists in recipes contained in a cookbook holding a compilation copyright were not

while the court found originality in the compiler's work, the case can easily be made that such "originality" was dictated by purely functional considerations, suggesting essentially that the directory was organized based on objective criteria and thus should not have been protectable.

In contrast to *Key Publications*, the Eleventh Circuit, in its decision in *Bellsouth*, found no original selection and arrangement in a yellow pages directory, seeming to understand the flaws in such an approach.<sup>116</sup> In *Bellsouth*, the court held that the defendant's entry into a computer of all of the names, addresses, and telephone numbers of advertisers in the plaintiff's yellow pages telephone directory, together with business type and type of advertisement, did not constitute copyright infringement.<sup>117</sup>

The court's analysis focused on the question of whether the plaintiff's selection, coordination, and arrangement, which the plaintiff claimed were infringed, were protectable and copied by

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protectable because they were statements of fact. Furthermore, the directions for combining ingredients were not protectable because they were procedures and processes. Discussing the basic principles of compilation copyright, the court cited *Feist* for the proposition that "[t]he creative energies that an author may independently devote to the arrangement or compilation of facts may warrant copyright protection for that particular compilation." *Id.* at 480. This proposition focuses on the effort involved in creating the compilation, not the creativity of the result. Furthermore, the court stated "a compilation's originality flows from the efforts of 'industrious collection' by its author." *Id.* For this principle, the court cited *Schroeder v. William Morrow & Co.*, which in turn cited *Jeweler's Circular Publishing*, the seminal case describing the sweat of the brow theory. *Id.*; *Mason v. Montgomery Data, Inc.*, 967 F.2d 135, 140 (5th Cir. 1992) (holding that creativity in constructing maps arose from verifying preexisting maps generated by the U.S. Geological Survey); *United States Payphone, Inc. v. Execs. Unlimited, Inc.*, 18 U.S.P.Q.2d 2049 (4th Cir. 1991). The Fourth Circuit, an "unaligned" circuit before *Feist*, held that U.S. Payphone's guidebook to the coin-operated telephone market was copyrightable. *Id.* at 2051. The district court had found that "the Guide . . . [was] the result of hundreds of hours of reviewing, analyzing, and interpreting state tariffs and regulations of the fifty states and the District of Columbia." *Id.* at 2050. In addition, the court noted, "Payphone produced 2700 pages of documents relating to the review, selection, coordination and arrangement of the compiled data which ultimately it organized in a 'simple and readable format' of fifty-one pages." *Id.* Based on these findings, the appellate court held that Payphone's selection and organization of the material met the minimal standard for creative originality enunciated in *Feist*. *Id.* at 2051.

<sup>116</sup> See *Bellsouth Adver. & Publ'g Corp. v. Donnelley Info. Publ'g, Inc.*, 999 F.2d 1436 (11th Cir. 1993).

<sup>117</sup> *Id.* at 1442.

the defendant. The court found that the plaintiff's selection of listings by establishing a closing date for changes, determining the geographic scope of the directory, and limiting listings to subscribers of its business telephone service did not meet the creativity threshold required by *Feist*.<sup>118</sup> Such a decision perhaps resulted from an understanding that the above elements were all functional considerations that do not entail any subjectivity. Moreover, the court did not consider these elements to be "acts of authorship, but techniques for the discovery of facts."<sup>119</sup> Accordingly, the court concluded, these elements were not entitled to copyright protection since "protection of copyright must inhere in a creatively original *selection* of facts to be reported and not in the creative means used to discover those facts."<sup>120</sup>

As for the directory's arrangement, the court found it to be unoriginal and to have merged with the idea of a business directory since it was "in an alphabetized list of business types, with individual businesses listed in alphabetical order under the applicable headings."<sup>121</sup> However, since there was insufficient evidence to establish that the defendant copied the headings used in the plaintiff's directory, the court did not rule on their protectability.<sup>122</sup>

Similarly, in *Victor Lalli Enterprises, Inc. v. Big Red Apple Inc.*,<sup>123</sup> the Second Circuit did not extend copyright protection to a publisher of charts comprised of the "lucky numbers" derived from gambling operations.<sup>124</sup> In that case, the plaintiff published a chart that contained winning numbers that were determined by gambling activity at local racetracks; the numbers were the last three digits

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<sup>118</sup> *Id.* at 1441.

<sup>119</sup> *Id.*

<sup>120</sup> *Id.*

<sup>121</sup> *Id.* at 1442.

<sup>122</sup> *Id.* at 1444; *see also* *Martindale-Hubbell, Inc. v. Dunhill Int'l List Co., Inc.*, No. 88-6767-CIV(NCR), 1994 U.S. Dist LEXIS 21485, at \*19 (S.D. Fla. Dec. 30, 1993) (relying on *Bellsouth Adver. & Publ'g Corp.*, the court held that defendant's copying of all the names and addresses of lawyers in the plaintiff's directory, together with certain "correlating data" (attorney specialization, title, firm composition and structure) was not infringing since those elements were all unprotectable facts).

<sup>123</sup> 936 F.2d 671 (2d Cir. 1991).

<sup>124</sup> *Id.* at 673.

of the total sum of money bet each day at New York racetracks for the previous thirteen months.<sup>125</sup> The numbers were displayed in a grid with the months of the year in a row across the top of the chart and the days of the month, from one to thirty-one, in a vertical column.<sup>126</sup> There were numerous publishers of such charts.<sup>127</sup> The numbers were computed according to a formula that was standard in that industry so the information presented in competing charts did not vary at all.<sup>128</sup> The court held that the plaintiff's selection, coordination, and arrangement of these numbers failed to meet the creativity requirement<sup>129</sup> since the plaintiff arranged the factual data into "purely functional grids that offer[ed] no opportunity for variation,"<sup>130</sup> and as such, like Rural's listings, were considered to be "'mechanical,' 'typical,' and 'garden variety,'" and, hence, not protectable.<sup>131</sup>

Likewise, in *Silverstein v. Penguin Putnam, Inc.*,<sup>132</sup> the court found that a decision to publish a collection of *all* of Dorothy Parker's unpublished poetry did not reflect the compiler's creativity in the selection process because it employed an objective criterion for determining which poems to include.<sup>133</sup> Because there was only one way to publish the complete collection of the poet's unpublished works, the court reasoned, the compilation was uncopyrightable.<sup>134</sup> Therefore, when exhaustive, a compilation is automatically denied protection. The court also rejected Silverstein's contention that he had to use his subjective judgment to determine what was or was not a poem holding that "Silverstein's choices were obvious ones that required no

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<sup>125</sup> *Id.* at 672.

<sup>126</sup> *Id.*

<sup>127</sup> *Id.*

<sup>128</sup> *Id.*

<sup>129</sup> *Id.* at 673.

<sup>130</sup> *Victor Lalli Enters., Inc.*, 936 F.2d at 673.

<sup>131</sup> *Id.*; see also *Eng'g Dynamics, Inc. v. Structural Software, Inc.*, 26 F.3d 1335, 1346 (5th Cir. 1994) (suggesting that *Feist's* definition of originality suggests that a work can be original when there are other ways of expression or products available in the market and holding that the work was original because there were other structural engineering programs available in the market).

<sup>132</sup> 522 F. Supp. 2d 579 (S.D.N.Y. 2007).

<sup>133</sup> *Id.* at 599.

<sup>134</sup> *Id.* ("[T]he collection of all is not a selection." (internal quotation marks omitted)).

subjective judgment.”<sup>135</sup> By contrast, in *Bensbargains.net, LLC v. XPBargains.com*,<sup>136</sup> the court suggested that when the selection criteria is not *select all*, but rather there exists some selection criteria that *excludes* some information, then it is likely that originality will be found.<sup>137</sup> In this case, carefully *selecting* deals to include on a website led the court to hold that the compilation of the deals on the plaintiff’s website was creative.<sup>138</sup>

Lastly, in *Warren Publishing, Inc. v. Microdos Data Corp.*,<sup>139</sup> the Eleventh Circuit held plaintiff Warren’s directory of cable television systems and their owners to be non-copyrightable and not infringed.<sup>140</sup> The defendant, Microdos, marketed an electronic database of information on the cable television industry called the “Factbook.”<sup>141</sup> Warren claimed infringement as to the communities chosen and as to its designation of “lead community” to indicate the primary community served by a given cable operator where that operator served multiple communities.<sup>142</sup> The district court found that “the selection of . . . communities was creative and protectable because Warren use[d] a unique system in selecting the communities that [would] be represented in the Factbook.”<sup>143</sup>

Reversing the District Court, the Eleventh Circuit held that, to the extent that the district court was correct in characterizing Warren’s claim as relating to a *system* of selecting communities, section 102(b) of the Copyright Act would bar protection since the statute expressly excludes “any . . . system” from copyright

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<sup>135</sup> *Silverstein*, 522 F. Supp. 2d 579, 599–600 (S.D.N.Y. 2007).

<sup>136</sup> 2007 U.S. Dist., LEXIS 60544 (S.D. Cal. Aug. 16, 2007).

<sup>137</sup> *Id.* at \*16.

<sup>138</sup> *Id.* at \*7.

<sup>139</sup> 115 F.3d 1509 (11th Cir. 1997) (en banc).

<sup>140</sup> *Id.* at 1513. *But see* York, *supra* note 88, at 588 (arguing that the Eleventh Circuit reached the wrong result in *Warren* since it relied on a several rationales that are inconsistent with *Feist* and copyright law in general and created too high of a standard for originality).

<sup>141</sup> *Warren Publ’g*, 115 F.3d at 1511.

<sup>142</sup> *Id.* at 1512. Warren had also claimed infringement as to the data fields and the data field entries, but the district court found that Microdos had not infringed the data field format and that the data field entries were unprotectable fields. *Id.* at 113–14.

<sup>143</sup> *Id.* at 1516 (citation omitted).

protection “regardless of the form in which it is . . . embodied.”<sup>144</sup> Even if Warren’s selection process was not a “system” within the meaning of the statute, the court held, Warren’s selection was not original and thus non-protectable.<sup>145</sup> The Eleventh Circuit found that Warren “did not exercise any creativity or judgment in ‘selecting’ cable systems to include in its Factbook, but rather included the entire relevant universe known to it,” thus employing objective, rather than subjective, selection criteria.<sup>146</sup> As to the selection of principal communities, the court held that since Warren made this determination by contacting cable operators and asking them for information regarding their classification, “the selection [was] not its own, but rather that of the cable operators.”<sup>147</sup>

In another line of cases, courts suggested that the question whether an arrangement or selection is not creative under *Feist* is dictated by the question of whether it is “obvious.” If found to be obvious, courts have suggested that the selection and arrangement are not copyrightable. In determining whether a selection is obvious—and thus analogous to the plaintiff’s telephone book in *Feist*—courts explored whether it was possible to arrange the work in different ways and whether those selections and arrangements followed industry standards or conventions.<sup>148</sup> When found to follow industry standards or conventions, courts usually decided that protection was not warranted, given the scarcity of forms of expression for selection or arrangement.

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<sup>144</sup> *Id.* at 1517 (quoting 17 U.S.C. § 102(b) (2006)).

<sup>145</sup> *Id.*

<sup>146</sup> *Id.* at 1518.

<sup>147</sup> *Id.* at 1519.

<sup>148</sup> *See, e.g.,* Carmichael Lodge No. 2103 v. Leonard, 2009 U.S. Dist. LEXIS 84857, at \*36 (E.D. Cal. Sept. 16, 2009) (holding “even when multiple options for selection or arrangement are available, the choice from among those options must be non-obvious in order to be protectable”); *Lexmark Int’l, Inc. v. Static Control Components, Inc.*, 387 F.3d 522, 536–37 (6th Cir. 2004) (stating that *Feist* is used to show that although a work may be set up in many different ways, the possible different ways must also be feasible); *Mid Am. Title Co. v. Kirk*, 59 F.3d 719, 722 (7th Cir. 1995) (holding that a selection of a factual compilation regarding a residential parcel of land was not copyrightable because the selection was a matter of following convention and strict industry standards).

In summary, after *Feist*, some courts approach the question of original arrangement and selection of a database with caution, suggesting that when the selection or arrangement is dictated by functional considerations or where the criteria for selection or organization are objective, copyright protection will be denied. However, some other courts failed to follow *Feist's* underlying policies and as a result, have afforded copyright protection to compilations when not warranted.

## 2. Courts' Search for the "Idea," "Fact," and "Expression" of Compilations

The general idea/expression or fact/expression dichotomy and its corollary, the merger doctrine, are applicable to databases as well.<sup>149</sup> The idea/expression and the fact/expression dichotomy are doctrines of copyright law, providing that "[n]o author may copyright his ideas or the facts he narrates."<sup>150</sup> These doctrines reflect the balance that copyright law seeks to achieve between encouraging authors to create new works by protecting their original creations from unauthorized copying, while at the same time, preserving the basic building blocks of facts and ideas for the public domain so that others may use them to create new works.<sup>151</sup> Thus, if protection for a database would prevent others from using the database's ideas or underlying facts, the idea/expression dichotomy will be applicable.<sup>152</sup> And, if there are a limited

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<sup>149</sup> The question of what constitute "facts" for purposes of copyright law has been discussed in some cases and in the academic literature. *See, e.g.*, *Castle Rock Entm't, Inc. v. Carol Publ'g Grp., Inc.*, 150 F.3d 132 (2d Cir. 1998) (suggesting that fictitious facts are considered expression); Justin Hughes, *Created Facts and the Flawed Ontology of Copyright Law*, 83 NOTRE DAME L. REV. 43 (2007).

<sup>150</sup> *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 556 (1985).

<sup>151</sup> *See* Robert A. Gorman, *Fact or Fancy? The Implications for Copyright*, 29 J. COPYRIGHT SOC'Y 560, 560 (1982).

<sup>152</sup> *See Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 350–51 (1991) ("Facts, whether alone or as part of a compilation, are not original and therefore may not be copyrighted. A factual compilation is eligible for copyright if it features an original selection or arrangement of facts, but the copyright is limited to the particular selection or arrangement. In no event may copyright extend to the facts themselves."). The *Feist* Court, however, never discussed the problem of protecting a factual compilation's underlying idea. However, in *Baker v. Selden*, the Court held that copying an idea without copying its expression does not constitute infringement. 101 U.S. 99 (1879). *See also Mazer v. Stein*, 437 U.S. 201, 217 (1954); MELVILLE B. NIMMER & DAVID NIMMER,

number of means to express the database's ideas, then courts apply the merger doctrine and decline to extend copyright protection to the database.<sup>153</sup>

In 1991, the Second Circuit considered the applicability of these two doctrines to the protection of databases in *Kregos v. Associated Press*.<sup>154</sup> In *Kregos* the court found the idea of an “outcome predictive pitching form” for baseball not to have merged with its expression: the form at issue in the case.<sup>155</sup> This finding resulted in the reversal of a grant of summary judgment against the compiler, Kregos, and the case was remanded for trial on the question of whether his pitching form met the required creativity standard.<sup>156</sup>

Kregos, the compiler and plaintiff, created a baseball pitching form distributed to newspapers that displayed information about past performance of the opposing pitchers scheduled to start each day's baseball game.<sup>157</sup> The plaintiff's form listed nine items of information about each pitcher's past performance to assist newspaper readers in predicting the outcomes of future games.<sup>158</sup> The plaintiff argued that his compilation was “an outcome predictive pitching form” in that he selected pitching statistics that he thought were the most important to newspaper readers when they were making their predictions on the games.<sup>159</sup> The district court held for the defendants, ruling that the pitching form lacked sufficient originality in its selection of statistics to be copyrightable as a compilation and that there were so few ways of selecting

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NIMMER ON COPYRIGHT § 2.18[D] (1990). The doctrine was eventually codified by the Copyright Act of 1976. *See* 17 U.S.C. § 102(b) (2006).

<sup>153</sup> *See* *Kregos v. Associated Press*, 937 F.2d 700, 705 (2d Cir. 1991) (noting that “even expression is not protected in those instances where there is only one or so few ways of expressing an idea that protection of the expression would effectively accord protection to the idea itself”); *see also* *Educ. Testing Servs. v. Katzman*, 793 F.2d 533, 539 (3d Cir. 1986); *Toro Co. v. R & R Prods. Co.*, 787 F.2d 1208, 1212 (8th Cir. 1986).

<sup>154</sup> 937 F.2d 700 (2d Cir. 1991); *id.* at 705.

<sup>155</sup> *Id.* at 705–07; *see also* *Eng'g Dynamics, Inc. v. Structural Software, Inc.*, 46 F.3d 408, 409 (5th Cir. 1995).

<sup>156</sup> *Kregos*, 937 F.2d at 711.

<sup>157</sup> *Id.* at 702.

<sup>158</sup> *Id.*

<sup>159</sup> *Id.*

pitching statistics that the pitching form's idea merged with its expression and was thus rendered uncopyrightable.<sup>160</sup>

The Second Circuit reversed this decision, holding that, as a matter of law, Kregos's selection of pitching statistics could not be rejected for lack of originality and creativity.<sup>161</sup> The court concluded that because an ample variety of ways to express the idea of rating a pitcher's performance were rejected by Kregos in assembling his form, the merger doctrine did not apply.<sup>162</sup>

The court started its opinion by warning that the merger doctrine must be applied with caution, explaining that if applied too readily, the doctrine denies protection to protectable forms of expression, while if applied too sparingly the doctrine protects ideas.<sup>163</sup> The court acknowledged that the application of the merger doctrine always depends on the level of abstraction at which the idea is stated.<sup>164</sup> Moreover, the court explained that a reviewing court should exercise particular caution when applying the merger doctrine to compilations of facts because the idea of the compilation could always be defined as its particular selection of facts thus merging the idea into the compiler's expression of it.<sup>165</sup> Such an application, in effect, eliminates copyright protection for

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<sup>160</sup> *Id.* at 703.

<sup>161</sup> *Id.* at 704–05.

<sup>162</sup> *Id.* at 707.

<sup>163</sup> *See id.* at 705. Thus, “courts have been cautious in applying the merger doctrine to selections of factual information.” *Id.*; *see* *Educ. Testing Servs. v. Katzman*, 793 F.2d 533, 540 (finding the doctrine inapplicable to the selection of test questions); *Toro Co. v. R & R Prods. Co.*, 787 F.2d 1208, 1212 (finding the doctrine inapplicable to selection of data for numbering parts). However, it “has been applied on occasion to selections of categories of data.” *Kregos*, 937 F.2d at 705; *see also* *Matthew Bender & Co. v. Kluwer Law Book Publishers, Inc.*, 672 F. Supp. 107, 112 (S.D.N.Y. 1987) (finding that the plaintiff's categories of data concerning personal injury awards were “the only sensible ones which could have been used to compile the data”).

<sup>164</sup> *Kregos*, 937 F.2d at 706.

<sup>165</sup> *Id.* at 706 (“In one sense, every compilation of facts can be considered to represent a merger of an idea with its expression. Every compiler of facts has the idea that his particular selection of facts is useful. If the compiler's idea is identified at that low level of abstraction, then the idea would always merge into the compiler's expression of it. Under that approach, there could never be a copyrightable compilation of facts.”).

compilations.<sup>166</sup> Thus, the more generally one defines an idea, the less likely it is that the doctrine of merger will apply.<sup>167</sup>

In order to prevent such a result and to justify the boundary the court had drawn between idea and expression, the court offered an alternative view of the doctrine of merger. The court drew a distinction between selections based on “matters of taste and personal opinion” and those that are “the first step in an analysis that yields a precise result.”<sup>168</sup> Protection of the former imposes little risk that an idea will be protected while protection of the latter imposes significant risk that protection of ideas will occur.<sup>169</sup> Examples of the former include the selection of “premium” baseball cards<sup>170</sup> or the selection of prominent families to include in a social directory.<sup>171</sup> As an example of the latter, the court presented a hypothetical doctor who publishes a list of symptoms useful in diagnosing a disease.<sup>172</sup> Where the selection amounts to a system yielding a precise result (i.e., the diagnosis of a disease), the court recommended that the idea of the selection be formulated at a low level of abstraction.<sup>173</sup> Thus, the idea of the doctor’s selection may be defined as the specific idea that this particular group of symptoms identifies a particular disease.<sup>174</sup> Defined in so specific a manner, no other way to express that specific idea may exist and, as a result, the idea merges with the expression.<sup>175</sup> Where the selection is based on taste or personal opinion, however, the court recommended a more general formulation of the idea of the selection, such that alternative expressions will always be possible and the merger doctrine will not apply.<sup>176</sup>

Applying this distinction between types of selections of facts to Kregos’s pitching form, the court found that his pitching statistics

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<sup>166</sup> *Id.*; see also Ginsburg, *No Sweat*, *supra* note 13, at 346–47.

<sup>167</sup> *Kregos*, 937 F.2d at 707.

<sup>168</sup> *See id.*

<sup>169</sup> *Id.*

<sup>170</sup> *See Eckes v. Card Prices Update*, 736 F.2d 859 (2d Cir. 1984).

<sup>171</sup> *See Social Register Ass’n v. Murphy*, 128 F. 116 (D.R.I. 1904).

<sup>172</sup> *See Kregos*, 937 F.2d at 707.

<sup>173</sup> *Id.*

<sup>174</sup> *Id.*

<sup>175</sup> *Id.*

<sup>176</sup> *Id.*

selection was somewhere in between pure taste and predictive analysis.<sup>177</sup> Accordingly, the court decided that the plaintiff's selection of the nine pitching-performance characteristics included on his form was less than a complete system for weighing each performance characteristic—that is, less than a system, method or process for determining each team's probability of winning—but was also more than merely his personal opinion of which performance characteristics were “most pertinent.”<sup>178</sup> Thus, because the form differed enough from a system that determined outcomes to warrant treatment as a selection reflecting Kregos's own personal taste, the court did not apply the merger doctrine.<sup>179</sup> The pitching form was, therefore, held to be protectable by copyright.<sup>180</sup>

In *CCC Information Services, Inc., v. Maclean Hunter Market Reports, Inc.*<sup>181</sup> the Second Circuit drew additional and even more significant distinctions between different types of selections of facts and further complicated its idea/expression and merger tests.<sup>182</sup> *CCC* concerned the question of copyrightability of the predicted values for used cars in different regions of the country, published eight times a year by Maclean Hunter Market Reports, Inc. in its *Automobile Red Book—Official Used Car Valuations* (“*Red Book*”).<sup>183</sup> *CCC*, a computer service, copied substantial portions of the *Red Book* onto its computer network and provided

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<sup>177</sup> *See Id.*

<sup>178</sup> *Id.* (“Kregos has been content to select categories of data that he obviously believes have some predictive power, but has left it to all sports page readers to make their own judgments as to the likely outcomes from the sets of data he has selected.”).

<sup>179</sup> *Id.* at 707.

<sup>180</sup> *Id.*

<sup>181</sup> 44 F.3d 61 (2d Cir. 1994), *cert. denied*, 516 U.S. 817 (1995).

<sup>182</sup> *Id.*; *see also* *CDN Inc. v. Kapes*, 197 F.3d 1256 (9th Cir. 1999). Analogously, in this case, plaintiff CDN published *The Coin Dealer Newsletter* containing projected collectable coin valuations, which were derived from a variety of factors by expertise and judgment. *Id.* at 1260. CDN alleged that Kapes used its wholesale prices as a baseline to arrive at the retail price on its Internet site, and in so doing infringed CDN's copyright. *Id.* at 1258. The Ninth Circuit reasoned that CDN's coin prices, like the car values at issue in *CCC*, were the result of extrapolation and judgment. *Id.* at 1261. Accordingly, the court held that CDN's values were not merely facts, but original creations that were subject to copyright protection. *Id.*

<sup>183</sup> *CCC*, 44 F.3d at 63.

information from it in different forms to its customers.<sup>184</sup> CCC tried unsuccessfully to obtain a license from Maclean to include *Red Book* values in its on-line services.<sup>185</sup> Despite Maclean's refusal, CCC proceeded to use the *Red Book* valuations, updating its figures regularly as new editions of the *Red Book* were published.<sup>186</sup> CCC filed suit against Maclean seeking a declaratory judgment that its use of the *Red Book's* used car valuations did not constitute copyright infringement.<sup>187</sup> Maclean, the publisher, counterclaimed, alleging that CCC's use of the *Red Book* valuations constituted copyright infringement.<sup>188</sup>

The district court found for CCC. The court held that the *Red Book's* selection, arrangement, and coordination of data lacked sufficient originality to be protected as an "original work of authorship."<sup>189</sup> The court also held that the *Red Book's* used car valuations "were facts, or interpretations of facts, and were, therefore, not protected by copyright."<sup>190</sup> Lastly, the court held that even if the valuations were not facts, the doctrine of merger prevented their protection<sup>191</sup> since each *Red Book* valuation was an idea—the idea of the value of a particular used car—that could be expressed in only one way: by the dollar figure listed in the *Red Book*.<sup>192</sup>

Maclean appealed, seeking to prove that CCC infringed its copyright in the *Red Book*.<sup>193</sup> The Second Circuit reversed the district court's ruling, holding that the *Red Book* was sufficiently original to warrant copyright protection, both in its underlying data—the used car valuations themselves—and as a compilation.<sup>194</sup>

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<sup>184</sup> *Id.* at 64.

<sup>185</sup> *Id.* at 64 n.3.

<sup>186</sup> *Id.* at 64.

<sup>187</sup> *Id.*

<sup>188</sup> *Id.*

<sup>189</sup> *Id.* at 64 (citing 17 U.S.C. § 101 (1977)).

<sup>190</sup> *Id.*

<sup>191</sup> *Id.*

<sup>192</sup> *Id.* ("[E]ven if the entries were not facts, copyright protection was nonetheless precluded by the doctrine of 'merger of idea and expression,' because each entry in the *Red Book* is an idea—the idea of the value of the particular vehicle—and that idea is necessarily communicated by a dollar figure.").

<sup>193</sup> *Id.* at 63.

<sup>194</sup> *Id.* at 67.

Moreover, the court held that the merger doctrine should have been “withheld,”<sup>195</sup> concluding that Maclean had demonstrated both a valid copyright in the *Red Book* and an infringement of it by CCC.<sup>196</sup>

The court found sufficient originality in the selection and arrangement of data to protect the *Red Book* as a compilation.<sup>197</sup> Such originality was found in the following aspects of the *Red Book*: (1) division of the national used car market into several regions, (2) adjustment of mileage by five-thousand-mile increments, (3) choice of which optional features on used cars to include, (4) use of the “average” vehicle as the basis for valuation in each category, and (5) selection of the number of models per year to include.<sup>198</sup> Even if the *Red Book* was not original as a compilation of data, the court implied that it was “an original work of authorship” because its data reflected creative judgments of its editors and were not pre-existing facts at all.<sup>199</sup> The *Red Book* valuations were, instead, found to be predictions based on the professional opinions of Maclean’s editors and not reports of historical prices (considered facts), nor mechanical derivations of historical prices (also considered facts).<sup>200</sup> The court’s distinction between invented or created facts—the used car valuations—and historically or mechanically derived facts, suggests the implicit adoption of *Kregos*’s distinction between mechanically selected facts and facts which are selected based on subjective opinion.<sup>201</sup>

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<sup>195</sup> *Id.* at 72.

<sup>196</sup> *Id.* at 74.

<sup>197</sup> *Id.* at 67 (“We find that the selection and arrangement of data in the *Red Book* displayed amply sufficient originality to pass the low threshold requirement to earn copyright protection.”).

<sup>198</sup> *Id.*

<sup>199</sup> *Id.* (“The valuations themselves are original creations of Maclean.”). The court pointed out in a footnote that even though these valuations were just numbers, their numerical form is “immaterial to originality. Original authorship warranting protection may be ‘fixed in any tangible medium of expression . . . includ[ing] . . . literary works.’ . . . The Act broadly defines literary works to include ‘works, other than audiovisual works, expressed in words, numbers, or other verbal or numerical symbols . . . .’” *Id.* at 67 n.6 (citing 17 U.S.C. §§ 101, 102(a)).

<sup>200</sup> *Id.* at 67.

<sup>201</sup> *See Kregos v. Associated Press*, 937 F.2d 700, 707 (2d Cir. 1991).

Deciding that, either way, the *Red Book* demonstrated enough originality to merit copyright protection, the court proceeded to evaluate and ultimately reject CCC's and the district court's application of the idea/expression and merger doctrines. Instead, the court relied on the distinction laid out in *Kregos*.<sup>202</sup>

Understanding the potential risks in application of the idea/expression and merger doctrines to the explicit protection given to compilations under § 103 of the 1976 Act,<sup>203</sup> the court emphasized that the level of abstraction could always be adjusted in a manner such that the idea of the compilation is defined as its particular selection, arrangement, and coordination.<sup>204</sup> Such a definition would necessarily result in merger of the idea and the particular expression in the compilation.<sup>205</sup> Therefore, the court interpreted the *Kregos* distinction more broadly, as one between types of ideas, some more susceptible to merger than others,<sup>206</sup> and not as one between types of selections of facts. The court stated that the merger doctrine should apply to those ideas that “undertake to advance the understanding of phenomena or the solution of problems,”<sup>207</sup> like the hypothetical doctor's identification of symptoms for disease diagnosis. These ideas are the “more important and useful kind,”<sup>208</sup> constituting “building blocks of understanding,”<sup>209</sup> or “hard” ideas. The court contrasted these hard ideas with “soft” ideas to which the merger doctrine should not apply. These “soft” ideas “do not materially assist the understanding of future thinkers,”<sup>210</sup> and are usually “infused with the author's taste or opinion.”<sup>211</sup> Soft ideas are “weaker,” and they “explain nothing, and describe no method, process, or procedure.”<sup>212</sup>

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<sup>202</sup> See *CCC*, 44 F.3d at 70–73.

<sup>203</sup> See *id.* at 70 (citing 17 U.S.C. § 103 (2005)); see also *Kregos*, 937 F.2d at 706; Ginsburg, *No Sweat*, *supra* note 13, at 346.

<sup>204</sup> See *CCC*, 44 F.3d at 70.

<sup>205</sup> See *id.* at 70–71; see also Ginsburg, *No Sweat*, *supra* note 13, at 346.

<sup>206</sup> See *CCC*, 44 F.3d at 71.

<sup>207</sup> *Id.*

<sup>208</sup> *Id.*

<sup>209</sup> *Id.*

<sup>210</sup> *Id.*

<sup>211</sup> *Id.* at 71.

<sup>212</sup> *Id.* at 72–73.

The court found support for this distinction between types of ideas in the language of § 102(b) of the 1976 Act, which denies copyright protection to any “idea, procedure, process, system, method of operation, concept, principle, or discovery.”<sup>213</sup> The court seemed to read this section as capturing the “building blocks” theory. Although § 102(b) does not specifically define “idea,” the court read this section of the statute to suggest congressional intent to deny copyright protection to the “building block” type of idea that explains a process or discovery.<sup>214</sup> The court read the same dichotomized notion of “idea” into a Copyright Office circular and a copyright regulation<sup>215</sup> and supported this distinction by other Second Circuit case law. In particular, the court compared the outcome of *Eckes v. Card Prices Update*,<sup>216</sup> which granted protection to the selection of “premium” baseball cards, with the outcome of *Hoehling v. Universal City Studios, Inc.*,<sup>217</sup> which denied protection to a historical theory explaining the fate of the Hindenburg.<sup>218</sup> The court read the former decision as resting on a determination that the selection of “premium” baseball cards was a matter of personal opinion and was thus subjective—a “soft” idea meriting protection.<sup>219</sup> The court read the latter decision as resting on a categorization of historical theory as a building-block type of “hard” idea that should remain in the public domain.<sup>220</sup>

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<sup>213</sup> 17 U.S.C. § 102(b) (2006).

<sup>214</sup> See *CCC*, 44 F.3d at 71 n.22 (2d Cir. 1994) (“This dichotomy between types of ideas is supported by the wording of various legislative pronouncements, which seem uniformly to contemplate denying protection to building-block ideas explaining processes or discoveries, and do not refer to expressions of subjective opinion. Thus, 102(b) denies protection to any ‘idea, procedure, process, system, method of operation, concept, principle, or discovery.’” (quoting 17 U.S.C. § 102(b)).

<sup>215</sup> *Id.* (“37 C.F.R. § 202.1(b), in similar terms, denies protection to ‘[i]deas, plans, methods, systems, or devices, as distinguished from the particular manner in which they are expressed or described in a writing.’ Copyright Office Circular 31 maintains that ‘Copyright protection is not available for ideas or procedures for doing, making or building things; scientific or technical methods or discoveries; business operations or procedures; mathematical principles; formulas, algorithms; or any concept, process [or] method of operation.’” (citations omitted)).

<sup>216</sup> 736 F.2d 859 (2d Cir. 1984).

<sup>217</sup> 618 F.2d 972 (2d Cir. 1980), *cert. denied*, 449 U.S. 841 (1980).

<sup>218</sup> See *CCC*, 44 F.3d at 71.

<sup>219</sup> *Id.* at 71 nn.21, 23.

<sup>220</sup> *Id.* at 71 n.23.

Applying this latter, expanded distinction to the *Red Book's* used car valuations, the court found that the district court should not have applied the merger doctrine because the valuations were ideas of the weaker, "soft" category and not the "building-block" type of idea.<sup>221</sup> This court reasoned that since the valuation predictions reflected the opinions of the *Red Book* editors and were not the kind of idea that "illuminates our understanding of the phenomena that surround us or of useful processes to solve our problems."<sup>222</sup> Therefore, the court held, any copyright-based limitations on the public's access to those valuations involved negligible harm, especially when compared to the harm that would be inflicted on the compilations' creators if the merger doctrine were applied to prevent enforcement of copyright against wholesale takings.<sup>223</sup>

These distinctions between "soft" and "hard" facts or ideas raise many difficulties. The Second Circuit's distinctions between fact or idea and expression seem to be problematic, as they rely mainly on the measure of the fact's or idea's social utility.<sup>224</sup> For example, it is not at all clear that the *Red Book's* used car valuations were not the kind of ideas that "illuminate[] our understanding of the phenomena that surround us."<sup>225</sup> As

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<sup>221</sup> *Id.* at 72–73.

<sup>222</sup> *Id.* at 73.

<sup>223</sup> *Id.* The court stated:

If the public's access to Red Book's valuations is slightly limited by enforcement of its copyright against CCC's wholesale copying, this will not inflict injury on the opportunity for public debate, nor restrict access to the kind of idea that illuminates our understanding of the phenomena that surround us or of useful processes to solve our problems. In contrast, if the merger doctrine were applied so as to bar Maclean's enforcement of its copyright against CCC's wholesale takings, this would seriously undermine the protections guaranteed by § 103 of the Copyright Act to compilations that employ original creation in their selection, coordination, or arrangement. It would also largely vitiate the inducements offered by the copyright law to the makers of original useful compilations.

*Id.* (citation omitted).

<sup>224</sup> See Ginsburg, *No Sweat*, *supra* note 13, at 346, 379; see also CCC, 44 F.3d at 73.

<sup>225</sup> See CCC, 44 F.3d at 71–73; see also Irene Segal Ayers, Comment, *The "Facts" of Cultural Reality: Rewarding the Line Between Fact and Expression in Copyright Law*, 67 U. CIN. L. REV. 563 (1999) (criticizing the court's distinctions in *Kregos* and CCC).

Professor Ginsburg has argued, all judges exercise this sort of judgment of social value whenever they apply the fact/expression or idea/expression and merger doctrines.<sup>226</sup> The approach taken in *CCC* is problematic exactly because it introduces a subjective “test” that provides an opportunity to expand protection to ideas and facts.

Judge Sweet’s partial dissent in *Kregos* echoed the above concerns with the *CCC* fact/expression analysis.<sup>227</sup> Judge Sweet argued that it was impossible to apply the merger doctrine to the hypothetical doctor’s list of symptoms used to identify and diagnose a disease<sup>228</sup> while withholding it for *Kregos*’s pitching form. Disease diagnosis is no less creative and no more scientific than predicting the results of a baseball game with the pitching form.<sup>229</sup> The only distinction between a system for estimating sports odds and a system for medical diagnosis is the degree of social benefit in each activity.<sup>230</sup> Judge Sweet questioned whether judgments of social utility should be the basis for distributing the protections of copyright law.<sup>231</sup>

*Kregos*’s distinction between opinion or taste-based fact selections and those that are outcome-determinative, which subsequently developed in *CCC* into the distinction between “soft” and “hard” ideas, was strongly criticized in *Continental Micro, Inc. v. HPC, Inc.*<sup>232</sup> This case dealt with the question of whether the plaintiff’s code cards, containing space and depth information needed by key-cutting machines to cut a specific key, were copyrightable.<sup>233</sup> The plaintiff argued that such data were professional opinions regarding the most effective settings for the

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<sup>226</sup> See Ginsberg, *No Sweat*, *supra* note 13, at 346.

<sup>227</sup> See *Kregos v. Associated Press*, 937 F.2d 700, 711–16 (2d Cir. 1991) (Sweet, J., concurring in part and dissenting in part).

<sup>228</sup> *Id.* at 711.

<sup>229</sup> *Id.* at 711 n.2.

<sup>230</sup> *Id.* at 711.

<sup>231</sup> *Id.* (“[T]here is the obvious distinction that a system for making medical diagnoses is more socially beneficial than [a] system for estimating sport odds, but such a distinction does not offer a basis for denying copyright protection to one while granting it to the other.” (citation omitted)). *But see CCC Info. Servs., Inc. v. Maclean Hunter Mkt. Reports, Inc.*, 44 F.3d 61, 71 (2d Cir. 1994).

<sup>232</sup> No. 95 C 3829, 1997 WL 102541 (N.D. Ill. Mar. 5, 1997).

<sup>233</sup> *Id.* at \*1–2.

machine to use to cut particular keys and not non-copyrighable facts.<sup>234</sup>

The district court pointed to the similarity between the plaintiff's argument and the argument raised in *CCC*, but rejected both as incompatible with copyright law.<sup>235</sup> Instead, the court held that the code cards' depth and spacing data were functionally different but not expressively different and were thus not copyrightable.<sup>236</sup> In making its decision, the court relied on the Seventh Circuit's opinion in *Publications International, Ltd. v. Meredith Corp.*,<sup>237</sup> which denied copyright protection for recipes in a Dannon yogurt cookbook, explaining that "Mediterranean Meatball Salad" and "Swiss 'n' Cheddar Cheeseballs" describe procedures by which readers can produce dishes and as such, are denied protection under copyright law as a procedure, process or system.<sup>238</sup> This court found that for code cards, just as with a recipe, though there may be originality and professional judgment in creation, it is not the sort of originality which copyright protects.<sup>239</sup>

Thus, the *Continental Micro* test involves determining whether the facts, ideas, or a selection thereof, if they are neither "pre-existing facts" nor original selections, constitute a "procedure, process, or system," or are simply analogous to a recipe. The test does not determine whether facts are "infused with taste or opinion."<sup>240</sup> However, this test is obviously applicable and useful

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<sup>234</sup> *Id.* at \*3.

<sup>235</sup> *Id.* at \*4.

<sup>236</sup> *Id.*

<sup>237</sup> 88 F.3d 473 (7th Cir. 1996).

<sup>238</sup> *Id.* at 481; *see also Cont'l Micro, Inc.*, No. 95 C 3829, 1997 WL 102541, at \*3-4. ("Plaintiff's argument is similar to that of the Second Circuit in *CCC Information Services*. His data, like automobile valuations, are based in part on his opinion of likely variances caused by wear and tear on key-cutting machines and by variances among types of key blank. Thus his figures are not facts, he argues, but expressions of his opinion. This argument is an attractive one, but unfortunately, it does not square with the law of copyright, at least as [it] has been interpreted in this circuit.").

<sup>239</sup> *See Cont'l Micro, Inc.*, 1997 WL 102541, at \*4.

<sup>240</sup> *Compare Cont'l Micro, Inc.*, 1997 WL 102541, at \*4. (assessing whether the data are facts that constitute a "procedure, process or system" excluded from copyright protection), *with Kregos v. Associated Press*, 937 F.2d 700, 707 (2d Cir. 1991) (stating

only in circumstances in which ideas or facts comprise functional directions. For example, application of this test to the facts of *CCC* might lead one to conclude that the *Red Book* valuations were copyrightable since they were not pre-existing facts and did not provide a method for determining the value of a used car.

Although the court attempted to depict this new test as better than those used in *Kregos* and *CCC*,<sup>241</sup> the *Continental Micro* test—attempting to answer whether facts or ideas constitute an uncopyrightable “procedure, process, or system”—is really nothing more than the flip side of those other tests. Instead of searching for and identifying the protectable elements of the work—fact-selection based on opinion or taste as in *Kregos*<sup>242</sup> or “soft” facts as opposed to “hard” facts as in *CCC*<sup>243</sup>—the court in *Continental Micro* focused on and searched for the unprotectable elements of the work.<sup>244</sup>

Recently, however, the Second Circuit issued its decision in *New York Mercantile Exchange, Inc. v. Intercontinental Exchange, Inc.*,<sup>245</sup> which dealt with questions very similar to those discussed in the *CCC* case. New York Mercantile Exchange (“NYMEX”) is an exchange for trading futures and options contracts for energy commodities.<sup>246</sup> At the end of each day, NYMEX calculates what is called the “settlement price.”<sup>247</sup> This is the “value, at the end of trading each day, of a particular futures contract for a particular commodity for future delivery at a particular time.”<sup>248</sup> In setting the settlement price for these option contracts, NYMEX broke the contracts into two groups: those entered into during “high-volume months” and those occurring during “low-volume months.”<sup>249</sup> For

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that “as long as selections of facts involve matters of taste and personal opinion, there is no serious risk that withholding the merger doctrine will extend protection to an idea”).

<sup>241</sup> See *Cont'l Micro, Inc.*, 1997 WL 102541, at \*4.

<sup>242</sup> See *Kregos*, 937 F.2d at 706–07.

<sup>243</sup> See *CCC Info. Servs., Inc. v. Maclean Hunter Mkt. Reports, Inc.*, 44 F.3d 61, 71–73 (2d Cir. 1994).

<sup>244</sup> See *Cont'l Micro, Inc.*, 1997 WL 102541, at \*4–5.

<sup>245</sup> 497 F.3d 109 (2d Cir. 2007).

<sup>246</sup> *Id.* at 110.

<sup>247</sup> *Id.*

<sup>248</sup> *Id.* at 111.

<sup>249</sup> *Id.*

high-volume months, the settlement prices were based on a formula.<sup>250</sup> The amount of data for low-volume months was lower, requiring more data extrapolation and the use of NYMEX's professional judgment.<sup>251</sup> NYMEX then published this information.<sup>252</sup> Defendant Intercontinental Exchange ("ICE") was a subscriber to the futures values published by NYMEX and used these values as is or slightly altered them based on a pre-set formula for its customers.<sup>253</sup> ICE's customers then used the London Clearing House to complete commodities trades, because NYMEX itself could not make the trades.<sup>254</sup>

The majority opinion did not squarely address whether the calculated values of the futures contracts were "facts." Instead, it affirmed the district court's determination of uncopyrightability of the values based on the merger doctrine.<sup>255</sup> Thus, the court's discussion of *Feist* is dicta. In explaining the doctrines of *Feist* and the issues of copyrighting facts, the majority opinion referenced *Feist's* analogy to the role of a census taker: he or she does not create the data but instead discovers it.<sup>256</sup> The court thus reasoned that its task was to determine if NYMEX's settlement prices constituted original valuations created by NYMEX or objective values in the marketplace which NYMEX merely discovered.<sup>257</sup> The majority stated that on the facts of this case the distinction was uncommonly close and there was a strong argument that, "like the census taker, NYMEX does not 'author' the settlement prices as the term is used in copyright law."<sup>258</sup> It also suggested that there was a better argument that the settlement prices were facts during high-volume months than in low-volume months, because of the greater amount of data for use in its formulas.<sup>259</sup>

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<sup>250</sup> *Id.*

<sup>251</sup> *Id.*

<sup>252</sup> *Id.* at 112.

<sup>253</sup> *Id.*

<sup>254</sup> *Id.*

<sup>255</sup> *Id.* at 114–16.

<sup>256</sup> *Id.* at 115.

<sup>257</sup> *Id.* at 114.

<sup>258</sup> *Id.* at 114.

<sup>259</sup> *Id.* at 116–17.

However, the court did not decide the case on the issue of whether or not the valuations represented original creations or uncopyrightable facts. Rather, the court assumed without deciding that the valuations were original creations, but applied the merger doctrine to bar copyright in the values.<sup>260</sup> For both high- and low-volume months, the court explained, NYMEX sought to calculate the actual appropriate market valuation, and not just what the value should be, is currently, or will be in the future.<sup>261</sup> Because the court found that the idea (the fair market price of a given contract) merged with the only possible expression of that idea (the price), it applied the merger doctrine and declined to extend copyright protection to NYMEX's valuations.<sup>262</sup>

The concurring opinion by Judge Hall offered a different perspective, concurring in all parts of the decision except the majority's discussion of *Feist* and the factual nature of the settlement price.<sup>263</sup> He argued that the majority was heightening the standard used to determine whether a work displays some minimal degree of creativity.<sup>264</sup> In particular, Judge Hall disagreed with the majority's dicta concerning the originality of the settlement prices for three reasons.<sup>265</sup> First, the settlement prices were similar to car valuations where the values are determined by integrating a number of data sources and combined with professional judgment.<sup>266</sup> Second, he argued, the majority's argument was circular, because they labeled the settlement prices as facts and thus unoriginal.<sup>267</sup> (This was despite the majority's instruction that it is unclear whether appropriate values of futures contracts can ever be precisely calculated).<sup>268</sup> Third, there was good reason to doubt that settlement prices were facts.<sup>269</sup> They did not replicate individual trades, nor the weighted average of the

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<sup>260</sup> *Id.*

<sup>261</sup> *Id.* at 115.

<sup>262</sup> *Id.* at 118.

<sup>263</sup> *Id.* at 119.

<sup>264</sup> *Id.*

<sup>265</sup> *Id.*

<sup>266</sup> *Id.* at 120.

<sup>267</sup> *Id.*

<sup>268</sup> *Id.*

<sup>269</sup> *Id.*

trades, and they also contained an override mechanism which enabled NYMEX to change the settlement price as it deemed fit.<sup>270</sup>

However, both the majority and the concurring opinions in this case seem to be wrong in their analysis of *Feist* and the question of what constitute facts that are ineligible for copyright protection. The majority's analysis concerning the question of whether the settlement prices were facts is flawed. The court's suggestion that the nature of the work should be determined based on the amount of data used in reaching the settlement prices is not persuasive. As Judge Hall correctly pointed out, the settlement prices seem to be very much like the car valuations at issue in the *CCC* case. The "author" of the work was indicating a settlement price aimed to offer a value for futures and options contracts. The valuations, using data and formulas, aimed to accurately predict their value. Very much like the valuations at issue in *CCC*, the valuations here should also be considered facts, regardless of the amount of data used to calculate them. Additionally, creating distinctions between valuations or past prices cannot be a valid way to determine what should not be copyrightable as facts. That the valuations attempted to predict the value of the futures does not render them no longer factual in nature; it simply reflects an attempt to accurately assess the futures' objective value. The fact that these valuations had not yet been confirmed when generated by NYMEX should not make any difference to the analysis either. Neither should the fact that different entities offer different valuations of the very same product render the valuations any less factual. Therefore, the majority should have made the additional step and determined that the valuations were indeed facts. This would have added clarity to the flawed *CCC* line of cases.<sup>271</sup>

All of the tests articulated in the *CCC* line of cases attest to and exemplify the difficulties in determining what should be considered a fact or an idea as opposed to the expression of a compilation. However, the question, "Is this or is this not a fact?"

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<sup>270</sup> *Id.* at 120–21.

<sup>271</sup> See also *Health Grades, Inc. v. Robert Wood Johnson Univ. Hosp., Inc.*, 634 F. Supp. 2d 1226 (D. Colo. 2009) (finding star rating and reviews of health care facilities copyrightable because the ratings were produced based on a collection of reviews and ratings that are analyzed and later arranged to be presented online).

is ultimately fruitless. The real question instead becomes, “What kinds of factual information call for some protection and what kinds of information really ought to be left free for all to use?”<sup>272</sup> It appears that the courts formulated all these tests in an attempt to provide some guidance in the search for the “building blocks” of knowledge. Nonetheless, this does not mean that when the courts applied these tests to the cases discussed above they reached the correct decisions. Therefore, the discussion that follows suggests the adoption of a complementary “intent test” that might prove useful in assessing and determining the nature of the work.

The present claim is that when the court attempts to determine the nature of the work at stake—factual versus non-factual—it should try to place itself in the shoes of the work’s creator. This means that the court should try to understand how the creator perceived her work and how she wanted the public to perceive it when it was commercialized and/or offered to the public. In other words, the court should try to get at the root of the creator’s *intent* regarding the work’s nature. This search for intention, however, must examine objective evidence, such as marketing materials, commercial ads, or any other materials which may provide circumstantial evidence of how the work’s creator perceived her work and how she wanted others to perceive it.

The relevance of intention in determining a work’s nature is not new. In fact, the famous Israeli Supreme Court decision in *Eisenman v. Qimron*<sup>273</sup> illustrates its application. In this case, the plaintiff-respondent was a scholar who reconstructed an ancient text in one of the Dead Sea Scrolls from manuscript fragments.<sup>274</sup> The defendants-appellants published the completed reconstructed

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<sup>272</sup> Leo J. Raskind, *Open Discussion, Copyright Symposium Part I—Copyright Protection for Computer Databases, CD-ROMs and Actual Compilations*, 17 U. DAYTON L. REV. 351, 358 (1992).

<sup>273</sup> C.A. 2790/93, 2811/93 *Eisenman v. Qimron*, 54(3)PD 817 [1993](Isr.), *unofficial translation available at* [http://lawatch.haifa.ac.il/heb/month/dead\\_sea.htm](http://lawatch.haifa.ac.il/heb/month/dead_sea.htm); *see also* David Nimmer, *Copyright in The Dead Sea Scrolls: Authorship and Originality*, 38 HOUS. L. REV. 1, 211–12 (2001) (criticizing the decision); Lisa Michelle Weinstein, Comment, *Ancient Works, Modern Dilemmas: The Dead Sea Scrolls Copyright Case*, 43 AM. U. L. REV. 1637 (1994).

<sup>274</sup> *Qimron*, 54(3)PD at 822–23.

text in their book<sup>275</sup> without attributing the reconstruction of the text to the plaintiff.<sup>276</sup> The case dealt with the question of whether the plaintiff could secure copyright in the assemblage.

The appellants' main argument was that the respondent's acts of supplementing the text were no more than the reconstruction of an existing work. Accordingly, they argued, copyright law should not protect the deciphered text.<sup>277</sup> However, for reasons to be explained shortly, the Court found that the respondent was entitled to copyright in the deciphered text.<sup>278</sup>

Examining the Israeli court's analysis in reaching its conclusions provides insights into the notion of intentionality. In order to decide the question, the court first defined the subject matter of the respondent's right. Here, the court distinguished between two main components of the deciphered text: the physical, tangible, raw material—the fragments of the scroll, created about 2000 years ago and found in Qumran—and the act of assembling the collection of the fragments into a deciphered text—physically adding them together, arranging them, deciphering what was written on them, and filling the gaps between the fragments.<sup>279</sup> In other words, the court distinguished between the fragments themselves and the art of providing “soul and spirit” to the fragments that made them a meaningful and living text.

The court pointed out that the scroll's fragments are today in the public domain in the sense that anyone who wishes to aggregate and decipher them is permitted to do so.<sup>280</sup> But the court added that the fact that such materials are in the public domain is irrelevant to the question of whether the work's creator has copyright in his work.<sup>281</sup> The court instead felt that the question it faced was whether the spirit and soul that the respondent placed in the fragments of the scroll, with the power of his academic

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<sup>275</sup> *Id.* at 823.

<sup>276</sup> *Id.*

<sup>277</sup> *Id.* at 825.

<sup>278</sup> *Id.* at 849.

<sup>279</sup> *Id.* at 828–29.

<sup>280</sup> *Id.* at 828.

<sup>281</sup> *Id.*

knowledge and talent, make the deciphered text, in its entirety, a work protected by the Israeli Copyright Act of 1911.<sup>282</sup>

Under Israeli copyright law, a “literary work” enjoys copyright protection only if it is an original work of authorship.<sup>283</sup> Israeli copyright law is also very similar to United States copyright law in that it does not provide copyright protection based on the industrious collection or sweat of the brow doctrines.<sup>284</sup> Protection is accorded only to expression and not ideas, facts, or other indispensable materials.<sup>285</sup>

Relying on these standards, the court moved on to examine whether the respondent added something original while reconstructing the scroll’s fragments. The court looked at the process by which the collection of fragments became a complete text bearing content and meaning. The court identified several phases of “creation”: matching the fragments based on their physical compatibility, arranging the matching islands of fragments and placing them in their putative place in the scroll, deciphering the written text on the fragments (to the extent that such deciphering was required) and filling the gaps between the fragments.<sup>286</sup>

The court then examined whether there was originality in the work as a whole.<sup>287</sup> The court found no justification to examine separately each of the above-discussed phases because the various phases of the work were interdependent and had mutual influence upon each other.<sup>288</sup> For example, deciphering the text dictated to some extent the arrangement of the islands of fragments; the arrangement influenced the possible meaning of the text, its construction and content, and the way of filling the gaps in it.<sup>289</sup>

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<sup>282</sup> *Id.* at 828–29.

<sup>283</sup> Copyright Act, 5768-2007, 2199 LSI 34 (2007) (Isr.), available at <http://www.tau.ac.il/law/members/birnhack/IsraeliCopyrightAct2007.pdf>.

<sup>284</sup> C.A. 513/89 Interlego A/S v. Exin-Lines Bros., S.A., 48(4) PD 133, 165 [1994] (Isr.) (“According to the goals of copyright law it is clear that the conclusion is that labor is not sufficient to justify according copyright protection.”).

<sup>285</sup> *Qimron*, 54(3) PD at 828–29.

<sup>286</sup> *Id.* at 832–33.

<sup>287</sup> *Id.* at 833.

<sup>288</sup> *Id.*

<sup>289</sup> *Id.*

In the court's opinion, the work involved in the performance of these various tasks revealed uncontestable originality and creativity.<sup>290</sup> The respondent's work was not technical or mechanical, like simple labor, but rather was original work in that he turned the fragments into a living text, applying his knowledge, skill, imagination and discretion by choosing among various options.<sup>291</sup>

However, the court's discussion clearly left out one major argument that might have proved significant to its ruling. The appellants' main argument was that the respondent's filling in the gaps was not his original work, but was rather a discovery and exposition of parts of the original text, as written 2000 years ago.<sup>292</sup> Thus, the appellants characterized the respondent's work as only a discovery of facts in the framework of historical research and, as such, not the subject matter of copyright law.<sup>293</sup> Therefore, although the respondent had invested effort, time, knowledge, and talent, the deciphered text lacked originality. The fact that no original and complete text of the scroll was available from any existing source by which to compare it to the deciphered text did not transform the deciphered text from a non-copyrightable factual work into a copyrightable fictional work. In fact, the appellants argued, since the respondent presented the work as reflecting the real text of the scroll, he could not argue that it was an original work. The court did seem to consider this argument, but rejected it, instead holding that the respondent's work was not really a reconstruction, but rather his *own estimate* of what the original work really was or should have been.<sup>294</sup> As such, the respondent created a literary work and did not simply reconstruct an existing text.

Such an analysis clearly ignored the relevance of intention in determining originality. This copyright infringement suit would clearly never have been brought had the appellants given credit to the respondent for reconstructing the text. Scholars, such as the

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<sup>290</sup> *Id.*

<sup>291</sup> *Id.* at 833–34.

<sup>292</sup> *Id.* at 825.

<sup>293</sup> *Id.* at 831–32.

<sup>294</sup> *Id.* at 832–33.

respondent, usually care about attribution and recognition more than copyrights in their works.<sup>295</sup> Of course, the court's reasoning clearly worked to the respondent's advantage. However, it is not particularly flattering to his scholarly skills. Indeed, had the plaintiff had the same level of knowledge regarding copyright law as he does the Dead Sea Scrolls, he would have been disturbed by this court's finding of originality. The respondent, like every other serious historian, obviously intended that his work would be perceived as a text that accurately reflected the original text as written 2000 years ago. Attention to the respondent's intent regarding the work's nature could have led the court to hold that the work was unoriginal and, as such, did not merit copyright protection.

Re-examining the courts' decisions in *CCC*, *Kregos* and *New York Mercantile Exchange* in light of the above analysis leads to different results. In *CCC*, the creators of the *Red Book* had been in the market for a long time.<sup>296</sup> They seemed to try to establish themselves as the authority or the industry standard in the field of used car valuations and wanted consumers to perceive their valuations as reflective of the real value of the car and thereby rely on them.<sup>297</sup> Thus, *Red Book* wanted its valuations to be viewed as facts and not as personal opinions. That it did not provide the way in which it reached the specific values, i.e., the procedure/process/system that led it to a given valuation, does not make the resulting valuation any less factual in nature. Similarly, in *Kregos*, the creators of the pitching form viewed this form as providing information that consumers could rely on for betting purposes to predict a game's outcome.<sup>298</sup> Although the creators did not detail the procedure/process/system used to select the form's data or the relative importance of each detail provided, they clearly viewed their work as supplying information of predictive,

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<sup>295</sup> Kevin Donovan, *In an Age of Abundance, Attribution is More Important than Copying*, TECHDIRT (Aug. 12, 2008, 12:45 AM), <http://www.techdirt.com/articles/20080808/2157481936.shtml>.

<sup>296</sup> *CCC Info. Servs., Inc. v. Maclean Hunter Mkt. Reports, Inc.*, 44 F.3d 63 (2d Cir. 1994), *cert. denied*, 516 U.S. 817 (1995).

<sup>297</sup> *CCC*, 44 F.3d at 64.

<sup>298</sup> *Kregos v. Associated Press*, 937 F.2d 700, 702 (2d Cir. 1991).

i.e., factual, value.<sup>299</sup> Lastly, the *New York Mercantile Exchange* court, too, could have employed the intent test to explore the question whether the calculated valuations of the future contracts were factual.

While complementary in nature, the test of intentionality might bring more works to the public domain. It appears that the test might be helpful in providing some loyalty to the Supreme Court's decision in *Feist*. It is not easy to determine what should be considered fact and what should not. It is very helpful, however, to look objectively at the intention of the creator of the work as reflected in objective evidence and, thereby, to try to determine the nature of the work as she saw it when she created the work and offered it to the public.<sup>300</sup>

Indeed, all these tests aim at achieving the same goal: preserving the building blocks of knowledge in the public domain.

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<sup>299</sup> *Id.* at 706; see also *Eckes v. Card Prices Update*, 736 F.2d 859, 864 (2d Cir. 1984). The court seemed to suggest the possibility of such an argument, but rejected its applicability under the case's circumstances:

It may be that a copyrighted work, here a listing of premium cards, can be so successful that it established the "market," but there is no credible evidence in the record to support application of this theory here. Moreover, there is no basis for such an inference in light of the short time in this case between the issuance of appellants' Guide and appellees' CPU. In addition, this argument would best be advanced in a fair use context, that is, that it is necessary to copy the premium cards and prices from appellants' book because their book establishes which cards are premium and the respective prices of each card.

*Id.*

<sup>300</sup> While the intent test has never been recognized explicitly by American courts, there exists some case law from which such a test can be implied, mainly based on the estoppel doctrine. See *Arica Inst., Inc. v. Palmer*, 970 F.2d 1067 (2d Cir. 1992). Arica Institute is a teaching organization that instructs people on finding "inner balance." *Id.* at 1069–70. The founder of the organization had written extensively on the subject and the work at issue in this case (and that was allegedly copied by the defendant) was called "Interviews with Oscar Ichazo." *Id.* at 1070–71. At the core of his work were seven fundamental "enneagons" associated with nine "ego fixations." *Id.* Some of the enneagons in the defendant's book were quite similar to those in "Interviews." *Id.* at 1070–71. Ichazo, the founder of Arica, argued at trial that he discovered the ego fixations and that they were scientifically verifiable "facts" of human nature. *Id.* at 1075–76. On appeal, the court held that Ichazo was estopped from disclaiming that the nine ego fixations were uncopyrightable facts; after having represented to the world that his discoveries were factual, the court held, Ichazo could not take back his claim for purposes of the litigation. *Id.* at 1075.

This goal can be achieved if courts are cautious and err on the side of freeing information instead of enclosing it. Nonetheless, despite the courts' attempts at vigilance, they seemed to fail in applying their newly created distinctions or tests, as the cases described in this section have illustrated. The complementary intent test that explores the subjective intent of the work's creator can assist courts in assessing the work's nature.

*B. Scope of Protection Under the Selection and Arrangement Standard*

The Court in *Feist* clearly held that an original selection or arrangement offers minimal, "thin" protection to compilations:

[A] subsequent compiler remains free to use the facts contained in another's publications to aid in preparing a competing work, so long as the competing work does not feature the same selection and arrangement. . . . [T]he very same facts and ideas may be divorced from the context imposed by the author, and restated or reshuffled by second comers, even if the author was the first to discover the facts or to propose the ideas.<sup>301</sup>

Thus, copyright law protects only the selection and arrangement of a factual compilation; it is limited to the components that originated with the author<sup>302</sup> and "[i]n no event may copyright extend to the facts themselves."<sup>303</sup>

However, *Feist* does not provide clear guidance regarding the scope of protection available to original selections and

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<sup>301</sup> *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 349 (1991) (quoting Ginsburg, *Creation and Commercial Value*, *supra* note 35, at 1868). Thus, "each subsequent compiler [need not] start from scratch and is [not] precluded from relying on research undertaken by another. *Id.* at 359. Rather, the facts contained in existing works may be freely copied because copyright protects only the elements that owe their origin to the compiler . . ." *Id.* at 359 (citations omitted); *see also* Ginsburg, *Creation and Commercial Value*, *supra* note 36, at 1868 n.12; L. Ray Patterson & Craig Joyce, *Monopolizing the Law: The Scope of Copyright Protection for Law Reports*, 36 UCLA L. REV. 719, 776, 800-02 (1989); William F. Patry, *Copyright in Collections of Facts: A Reply*, 6 COMM. & L. 11, 16 (1984).

<sup>302</sup> *Feist*, 499 U.S. at 350.

<sup>303</sup> *Id.* at 351.

arrangements of facts because the Court found Rural's selection and arrangement to be non-copyrightable.<sup>304</sup> While it is clear that verbatim copying of an entire compilation is not allowed when the compilation's selection or arrangement is original, it remains unclear the degree to which non-verbatim copying is prohibited.

An analysis of the Second Circuit's decision in *Key Publications*<sup>305</sup> sheds light on the extent of copying prevented by original selection and arrangement. In that case, the court refused to "read *Feist* in such a broad and self-defeating fashion"<sup>306</sup> as to provide that only verbatim copying of the compilation is prevented. Instead, the court stated that subsequent compilers cannot avoid infringement liability simply by making minor changes to a copyrighted compilation.<sup>307</sup> "Such a result would render the copyright of a compilation meaningless,"<sup>308</sup> the court held, resulting in a change of its scope from "thin" to "anorexic."<sup>309</sup> The court added that in order to establish copyright infringement, a plaintiff must prove "substantial similarity between those elements, and only those elements, that provide copyrightability to the allegedly infringed compilation."<sup>310</sup> Thus, since protection is limited to the original selection and arrangement, similarity to those elements must be proven.

Applying this requirement in *Key Publications*, the court determined that the plaintiff had to show substantial similarity between the two directories with regard to their selection of businesses or arrangement of categories in order to prevail on its

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<sup>304</sup> *Id.* at 363.

<sup>305</sup> *Key Publ'ns, Inc. v. Chinatown Today Publ'g Enters.*, 945 F.2d 509 (2d Cir. 1991).

<sup>306</sup> *Id.* at 514; *see also* *Kregos v. Associated Press*, 937 F.2d 700, 710 (2d Cir. 1991) (noting that the defendant's selection of data must vary from the plaintiff's by more than a trivial degree to avoid infringement).

<sup>307</sup> *Key Publ'ns, Inc.*, 945 F.2d at 514; *see also* *Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 583 n.5 (1985) (Brennan, J., concurring).

<sup>308</sup> *Key Publ'ns, Inc.*, 945 F.2d at 514.

<sup>309</sup> *Id.* (quoting *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 349 (1991)).

<sup>310</sup> *Id.* Proof of "substantial similarity" is a basic requirement in establishing infringement. *Id.*; *e.g.*, *Bus. Trends Analysts, Inc. v. Freedonia Grp., Inc.*, 887 F.2d 399, 402 (2d Cir. 1989); *Eckes v. Card Prices Update*, 736 F.2d 859, 863 (2d Cir. 1984); *see also* 4 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 13.03[A] (Matthew Bender rev. ed. 2010) ("Just as copying is an essential element of infringement, so substantial similarity . . . is an essential element of copying." (citations omitted)).

infringement claim.<sup>311</sup> However, the court found no substantial similarity in the selections of the data after it examined the key issue: “whether the organizing principle guiding the selection of businesses for the two publications [was] in fact substantially similar.”<sup>312</sup> In this case, the defendants’ directory had intentionally copied 1,500 of the 2,000 listings from the plaintiff’s directory.<sup>313</sup> The defendants, however, copied only 17% (1,500/9,000) of the listings in the plaintiff’s directory and did not completely duplicate any category containing more than a few listings.<sup>314</sup> The court therefore found no infringement of the plaintiff’s selection, reasoning that there will always be significant overlap between classified directories for a given community.<sup>315</sup> Had the defendants “exactly duplicated a substantial designated portion” of the plaintiff’s directory, the court explained, infringement would have been found.<sup>316</sup> Thus, original selection allows significant copying from the original work as long as the copy does not duplicate a substantial portion of the original.<sup>317</sup>

As for the substantial similarity test for the “arrangement” prong of the *Feist* standard, the *Key Publications* court ruled that,

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<sup>311</sup> *Key Publ’ns, Inc.*, 945 F.2d at 515. “[T]he components of a compilation are generally in the public domain, and a finding of substantial similarity or even absolute identity as to matters in the public domain will not suffice to prove infringement.” *Id.* at 514; see also *Kregos*, 937 F.2d at 709 (2d Cir. 1991) (compilation author is only protected against infringement of the protectable features of the compilation); 3 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 13.03[B][2][b] (Matthew Bender rev. ed. 2010).

<sup>312</sup> *Key Publ’ns*, 945 F.2d at 516. Thus, substantial similarity is limited to the organizing principle of selection. *Id.* However, protection of this principle is limited by the idea/expression dichotomy, which limits protection to the expression of an idea and denies protection to the idea itself.

<sup>313</sup> *Id.* at 515.

<sup>314</sup> *Id.*

<sup>315</sup> *Id.* at 516.

<sup>316</sup> *Id.* at 517; see also *Eckes v. Card Prices Update*, 736 F.2d 859, 863 (2d Cir. 1984) (finding infringement where a directory duplicated the listing of 5,000 cards designated as “premium” in a copyrighted 18,000 card directory).

<sup>317</sup> *But see Kregos v. Associated Press*, 937 F.2d 700, 710 (2d Cir. 1991) (holding that the defendant’s compilation would not infringe if it “differs in more than a trivial degree” from the plaintiff’s work, essentially creating a “virtual identity” test for infringement); *Alexandria Drafting Co. v. Amsterdam*, 43 U.S.P.Q.2d 1247, 1253 (E.D. Pa. 1997) (holding that copying of features such as positions of symbols and street alignments in compilations of maps did not constitute infringement).

as a matter of law, the arrangements in the two compilations were not substantially similar<sup>318</sup> since only three of the twenty-eight categories in the defendants' directory duplicated any of the 260 categories in the plaintiff's directory.<sup>319</sup> It should be emphasized, however, that many of the listings in both directories appeared under similar headings. The court found the placement of listings within categories to be "the sort of mechanical task that does not merit copyright protection," but distinguished placement within categories from original arrangements of the categories themselves.<sup>320</sup>

Such a distinction, however, as others have already argued, is baseless.<sup>321</sup> Neither the placement of listings within a category nor other decisions about arrangement in a directory are particularly subjective; both seem to be dictated by utilitarian considerations. The categories in a classified directory are arranged alphabetically, and are therefore clearly unoriginal arrangements under *Feist*.<sup>322</sup> Likewise, category names are chosen based on what will most likely come to mind when a consumer thinks about a product or service offered by a business listed within that category.<sup>323</sup>

### III. APPLICATION OF THE STANDARD AND ITS SCOPE TO DATABASES

*Feist's* standard for copyright protection for compilations, coupled with the courts' elaborations on this standard, including the courts' search for the "ideas," "facts," and "expression" of compilations, all contributed to significant difficulties regarding application of this standard to databases. Furthermore, the scope of protection provided under this standard has implications regarding producers' ability to provide meaningful copyright protection for their products.

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<sup>318</sup> *Key Publ'ns*, 945 F.2d at 515.

<sup>319</sup> *Id.*

<sup>320</sup> *Id.*

<sup>321</sup> See generally John F. Hayden, *Recent Development, Copyright Protection of Computer Databases After Feist*, 5 HARV. J.L. & TECH. 215 (1991).

<sup>322</sup> See *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 363 (1991).

<sup>323</sup> For example, information about legal services is listed under generic headings such as "lawyer" or "attorney."

First, most databases are comprehensive in nature.<sup>324</sup> They therefore do not meet the subjective selection or arrangement standard because there is no real selection when the database includes the entire universe in a given field. Indeed, the scope of databases is generally based on objective criteria<sup>325</sup> so that users can exercise and employ their own selection and arrangement of the underlying data.<sup>326</sup> In the online context, most databases are actually exhaustive in nature and do not demonstrate any selection or arrangement. Even the modern Internet-based white pages directories allow a user to conduct a limited search rather than an exhaustive search. As a result, most online databases will probably easily fail the original arrangement and selection test.

Second, identifying discernible arrangement within a database is difficult.<sup>327</sup> The protection of databases that is based on original arrangement, therefore, becomes unlikely.<sup>328</sup> Even if original

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<sup>324</sup> See Brief for Information Industry Association and ADAPSO, The Computer Software and Services Industry Association, Inc., as *Amici Curiae* in support of neither party at 19–20 n.16, *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340 (1991) (No. 89-1909) (arguing that under the original selection standard “copyright protection would be afforded to compilations in inverse proportion to their comprehensiveness, which is to say (in many cases) to their commercial value and usefulness”); see also *Fin. Info. Inc. v. Moody's Investors Serv., Inc.*, 751 F.2d 501, 507 (2d Cir. 1984) (basing selectivity on the omission of facts); Hicks, *supra* note 100, at 1006 (noting that most compilations “stand out for their exhaustiveness and usually contain components selected on the basis of objective, not subjective, criteria”).

<sup>325</sup> See Hicks, *supra* note 100, at 1006.

<sup>326</sup> *Id.* (noting that a compilation listing “all known inhabitants of a city . . . would exhibit insufficient subjectivity”). *But see id.* at 1006–07 (arguing that subjectivity is involved even in the selection of objective criteria); *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 362 (1991) (finding that the selection of name, town, and telephone number “could not be more obvious”).

<sup>327</sup> The physical arrangement of data within a database is important to the efficiency of the database system. See Hicks, *supra* note 100, at 1014. This concept of arrangement, however, is purely functional, and protection of any original method of physically arranging data would surely be barred by the idea/expression dichotomy as embodied in § 102(b) of the Copyright Act.

<sup>328</sup> *Nat'l Bus. Lists, Inc. v. Dun & Bradstreet, Inc.*, 552 F. Supp. 89, 97 (N.D. Ill. 1982) (stating that a database stores information “without arrangement and form”); see also Robert C. Denicola, *Copyright in Collections of Facts: A Theory for the Protection of Nonfiction Literary Works*, 81 COLUM. L. REV. 516, 531 (1981) (arguing that “there is no particular arrangement to protect”). *But see* Hicks, *supra* note 100, at 1022 (criticizing this view as “factually incorrect”). This lack of arrangement is, however, a very positive feature of databases since it allows users to arrange data in a format they find most

arrangement exists, copyists can simply rearrange the data to avoid infringement, without sacrificing the utility of the new database.<sup>329</sup>

Third, new technologies enhance the functionality of databases in a manner that makes reliance on subjective selection and arrangement almost impossible.<sup>330</sup> Since new technologies, especially developments related to database system software, allow easy processing of voluminous amounts of data,<sup>331</sup> there is no need to exercise subjectivity in selection, as there was for old-fashioned databases.

Fourth, the idea/expression dichotomy and the doctrine of merger raise additional challenges for database compilers. Specifically, the courts' formulation of several post-*Feist* doctrines regarding copyright in compilations—as exemplified by courts' attempts to identify the “idea,” “fact,” and “expression” of a work—leaves compilers facing increased uncertainty as to whether their databases will ultimately be found to be protectable. The court in *Kregos* explained that the more generally an idea of a compilation is defined, the less likely it is that the doctrine of merger will apply.<sup>332</sup> This need for generality, however, is at odds with the subjective selection or arrangement requirement which requires that database producers provide instances where subjective decisions were made.<sup>333</sup> Thus, the interaction of these two requirements contributes to even weaker copyright protection for databases. Furthermore, like the hypothetical system in *Kregos* that weighed statistics, database systems generally produce useful results, likely to make them fall within the ambit of the merger doctrine.

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useful. *See Hicks, supra* note 100, at 1014 (“The database compiler leaves the determination of the manner in which data is viewed to the discretion of the user within the confines of the software.”).

<sup>329</sup> *See Hicks, supra* note 100, at 1023 (noting that rearrangement will avoid infringement and that the ease with which a technically proficient party can rearrange the data “leads to shallow protection”).

<sup>330</sup> *See Hayden, supra* note 321, at 229–31.

<sup>331</sup> *See id.*

<sup>332</sup> *See Kregos v. Associated Press*, 937 F.2d 700, 707 (2d Cir. 1991).

<sup>333</sup> If subjectivity exists, it will be found in the details of the selection process. *See Hicks, supra* note 100, at 1026.

Lastly, the scope of protection provided under the “substantial similarity” standard, which prevents verbatim copying, imposes an additional limitation on database compilers’ ability to protect their products’ original selection and arrangement. Such a rule prevents verbatim copying by parties who lack the technical expertise to make minimal changes to the material’s selection or arrangement to avoid infringement, in reality deterring only a small group of unsophisticated users. Moreover, significant problems of detection and prevention of such behavior, mainly by individual users, remain.<sup>334</sup>

### CONCLUSION

*Feist’s* progeny seems to be very troubling for many reasons. It fails to provide guidance and coherence regarding key questions pertaining to copyright doctrine. Many courts fail to faithfully apply *Feist’s* holding, finding originality where none exists. Courts should exercise more diligence in searching for creative selection and arrangement or in distilling the work’s nature (as either factual or fictional). Providing protection for such works upsets the delicate balance between what should be protectable by intellectual property and what should reside in the public domain. Courts can employ the intent test in exploring the work’s nature and should exercise more caution when handling works whose arrangement and selection is dictated by functional considerations. Additionally, it should be pointed out that the creative selection and arrangement test for compilations copyright is probably an obsolete test for most databases offered online because they most often purposefully lack selection and arrangement.<sup>335</sup> Therefore, given this new environment, this protectability threshold is inapplicable to most databases.

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<sup>334</sup> Database developers experience significant difficulties tracking individual computer systems to determine if they contain illegal copies of their products. Moreover, the costs of bringing individual infringement actions add to this difficulty. See Hicks, *supra* note 100, at 1023.

<sup>335</sup> See Ginsburg, *Creation and Commercial Value*, *supra* note 35, at 1869 (noting that arrangement in factual compilations “may bear little, if any, connection to the work’s central importance as a source of information”).

One might argue that copyright protection based on original selection and arrangement is insufficient for modern electronic databases and is probably meaningless for most of them, exposing them to misappropriation by others thus disincentivizing their creation.<sup>336</sup> As I have argued elsewhere, this argument is not well-founded. There is no empirical evidence that there exists a piracy problem in the database industry.<sup>337</sup> Therefore, there is no reason to make any legislative changes. If the database industry, other producers of fact-intensive works, is able to make the case that a problem exists, then we might want to consider the provision of some form of protection. That day has not yet come, so if the system is not broken there is no need to fix it . . . .

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<sup>336</sup> See, e.g., *Database and Collections of Information Misappropriation Act of 2003: Hearing on H.R. 3261 Before the Subcomm. on Courts, the Internet, and Intell. Prop. of the H. Comm. on the Judiciary and the Subcomm. on Commerce, Trade, and Consumer Prot. of the H. Comm. on Energy and Commerce*, 108th Cong. 11 (2003) (statement of David Carson, General Counsel, Copyright Office of the U.S. Library of Cong.) (“[T]here was a gap in existing legal protection, which could not be satisfactorily filled through the use of technology alone . . . . Without legislation to fill the gap, publishers were likely to react to the lack of security by investing less in the production of databases . . . .”); *Collection of Information Antipiracy Act; Trade Dress Protection Act; and Continued Oversight of Internet Domain Name Protection: Hearing on H.R. 2652 and H.R. 3163 Before the Subcomm. on Courts and Intell. Prop. of the H. Comm. on the Judiciary*, 105th Cong. 386–402 (1998) (statement of Daniel C. Duncan, Vice President, Government Relation, Information Industry Association) (advocating strong protection for databases).

<sup>337</sup> Miriam Bitton, *A New Outlook on the Economic Dimension of the Database Protection Debate*, 47 *IDEA* 93 (2006).