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## Feist Applied: Imagination Protects, But Perspiration Persists—the Bases of Copyright Protection for Factual Compilations

Denise R. Polivy

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## ARTICLE

# *Feist* Applied: Imagination Protects, But Perspiration Persists – the Bases of Copyright Protection for Factual Compilations

Denise R. Polivy\*

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\* Associate, Hebb & Gitlin, P.C., Hartford, Conn. Wesleyan University, B.A. 1975; Dartmouth College, M.S. 1982; The University of Connecticut School of Law, J.D., *with high honors*, 1997. The author thanks Amy B. Cohen and Lewis Kurlantzick for their suggestions and guidance. As always, the author is grateful to her husband Austen Clark for his encouragement and support. This Article won first prize in The University of Connecticut School of Law 1997 Nathan Burkan Memorial Competition, sponsored by the American Society of Composers, Authors and Publishers, and is entered in the national Nathan Burkan Memorial Competition. The opinions expressed in this Article are the author's own and are not attributed to Hebb & Gitlin, P.C. or its clients.

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## INTRODUCTION

Ever since the Supreme Court, in *Feist Publications, Inc. v. Rural Telephone Service Co.*,<sup>1</sup> circumscribed copyright protection for factual compilations, courts have struggled to give content to *Feist's* requirements. The *Feist* Court held that, as a constitutional matter, copyright protects only compilations displaying “creative originality” in their selection or arrangement of facts and that the expenditure of effort—“sweat of the brow”—does not, in itself, merit protection.<sup>2</sup> Since *Feist*, courts have sketched the contours

1. 499 U.S. 340, 342 (1991) (reaffirming the constitutional proscription against copyrighting facts). In *Feist*, the Court emphasized that “originality is a constitutionally mandated prerequisite for copyright protection.” *Id.* at 344-45 (“The most fundamental axiom of copyright law is that ‘[n]o author may copyright his ideas or the facts that he narrates.’” (quoting *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 556 (1985))).

2. *Feist*, 499 U.S. at 359-60 (“[O]riginality, not ‘sweat of the brow,’ is the touchstone of copyright protection . . . .”); see also *Jeweler’s Circular Pub. Co. v. Keystone Pub. Co.*, 274 F. 932 (S.D.N.Y. 1921) (Hand, J.), *aff’d*, 281 F. 83 (2d Cir. 1922), *cited in Feist*, 499 U.S. at 352-53 (identifying *Jeweler’s Circular Pub.* as the source of the “classic formulation” of the “sweat of the brow” doctrine of copyright).

of creatively original selection and arrangement, applying *Feist's* directives to such compilations as a classified business directory, a New York City taxi drivers guide, a book of used car valuations, a numbers chart, and a yellow pages directory. Courts also have attempted to define the scope of the "thin" protection that *Feist* affords compilations,<sup>3</sup> and despite *Feist's* flat rejection of the sweat of the brow approach, some courts persist in considering the compiler's effort when determining whether a compilation is protected.

The difficulties in applying *Feist* reflect the tension inherent in the Copyright Clause,<sup>4</sup> which grants Congress the power "[t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries."<sup>5</sup> This constitutional directive attempts to balance incentives to authors, thought to encourage the creation of new works in the short run, with public dissemination of previously created works, thought to promote progress in the long run.<sup>6</sup> The tension between author control and public dissemination is especially strong in "fact-works," which compile and present factual information, as compared with "works of fancy," such as music, sculpture, and dance.<sup>7</sup>

A decade before the Supreme Court decided *Feist*, Professor Gorman wrote that our law stresses the greater need to disseminate the contents of fact-works than the contents of works of fancy.<sup>8</sup> As

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3. *Feist*, 499 U.S. at 349.

4. U.S. CONST. art. I, § 8, cl. 8.

5. *Id.*

6. See THE FEDERALIST NO. 43 (James Madison) (describing copyright as an area where "[t]he public good fully coincides . . . with the claims of individuals"); see also *Harper & Row*, 471 U.S. at 558 ("[T]he Framers intended copyright itself to be the engine of free expression. By establishing a marketable right to the use of one's expression, copyright supplies the economic incentive to create and disseminate ideas."); H.R. REP. NO. 98-781, at 4 (1984) ("The congressional role . . . —as is made very clear in the text of the Constitution—is to define the scope of the limited monopoly that should be granted a creator in order to give the public appropriate access to the creation.").

7. See Robert A. Gorman, *Fact or Fancy? The Implications for Copyright: The Twelfth Annual Donald C. Bruce Memorial Lecture*, 29 J. COPYRIGHT SOC'Y 560, 561 (1982).

8. See Gorman, *supra* note 7, at 561.

Gorman and others have pointed out, there is a strong public interest in access to facts and a widespread belief that we need such access to promote progress.<sup>9</sup> First, facts are considered building blocks of intellectual activity that should remain in the public domain where they are freely available for use.<sup>10</sup> In particular, the scientific community is committed to the free and unrestricted flow of data.<sup>11</sup> Second, the expression in fact-works is often driven by and difficult to separate from the factual information itself.<sup>12</sup> Because few varieties of expression are possible, similarities between fact-works may be considered non-infringing.<sup>13</sup> Third, the First Amendment and the fair use provision in the Copyright Act<sup>14</sup> expressly encourage free access to factual information to encourage commentary about social, political, and historical phenomena.<sup>15</sup> Depriving the public of free use of facts could interfere with the marketplace of ideas and hinder public discourse.<sup>16</sup> Lastly, the author's principal contribution to the creation of a fact-work may be "sweat"—expense, time, and effort.<sup>17</sup> Collections of facts do not comport with a romantic notion of authorship;<sup>18</sup> rather, fact-works are "personality-deprived."<sup>19</sup> To the extent that copyright is viewed as protecting works because they are rooted in or extensions of authors' personalities, fact-works will rarely qualify.

These arguments for public dissemination, however, overlook the need to provide author-incentives to spur the creation of fact-works. The claim that the public's strong interest in facts warrants reduced author control can be turned on its head; perhaps the util-

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9. *See id.* at 562.

10. *See* J.H. Reichman & Pamela Samuelson, *Intellectual Property Rights in Data?*, 50 VAND. L. REV. 51, 76 (1997).

11. *See id.*

12. *See* Gorman, *supra* note 7, at 562.

13. *See id.*

14. 17 U.S.C. § 107 (1994).

15. *See id.*

16. *See* Jessica Litman, *After Feist*, 17 U. DAYTON L. REV. 607, 613-14 (1992).

17. *See* Gorman, *supra* note 7, at 562.

18. *See* Reichman & Samuelson, *supra* note 10, at 76.

19. *See* Jane C. Ginsburg, *Creation and Commercial Value: Copyright Protection of Works of Information*, 90 COLUM. L. REV. 1865, 1866 (1990) [hereinafter Ginsburg I].

ity and importance of fact-works justify *greater* incentives for their creators. Moreover, the First Amendment and fair use policies may provide sufficient access to facts to safeguard public discourse. Additionally, Professor Ginsburg believes that the lack of romantic and expressive satisfaction in the creation of fact-works suggests that we need greater incentives for those works.<sup>20</sup> Although “some poets may toil for little more than fame,” those who create factual works probably do not.<sup>21</sup> Lastly, some fact-works, such as computer databases, are commercially valuable.<sup>22</sup> Failure to protect those works could retard the growth of the information industry, an increasingly important sector of the United States economy.

This Article suggests that in applying *Feist*, courts have granted copyright protection to compilations that reflect the compilers’ subjective, evaluative judgments, while reintroducing sweat of the brow under other guises. Part I outlines the protection provided in the 1976 Copyright Act and previous statutes and describes the pre-1991 split among the circuit courts over the doctrines of creative selection and sweat of the brow. Part II lays out the opinion in *Feist*, the landmark Supreme Court decision that resolved the circuit split in favor of “creative originality,” and analyzes the *Feist* opinion from constitutional, historical, and doctrinal perspectives. Part III reviews the key factual compilation cases decided since *Feist*, analyzes how the courts have developed the creative originality doctrine, and further analyzes how courts, since *Feist*, have applied the doctrine of idea-expression merger to factual compilations and addressed the scope of protection for compilations. This Article concludes that, despite *Feist*’s insistence on “creative originality,” the lower courts still reward hard work, thereby maintaining author incentives—a core purpose of the

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20. See *id.* at 1908 (“Because many works whose production would enhance knowledge may betray an authorship more plodding than inspired, . . . the works most in need of the copyright inducement are those in which personal authorship is least apparent.”).

21. *Id.*

22. See Bruce G. Joseph & David A. Vogel, *Copyright Protection of Software and Compilations: A Review of Critical Developments, 1991-1996*, at 369, 479 (PLI Pats., Copyrights, Trademarks & Literary Prop. Course Handbook Series No. 441, 1991).

## Copyright Clause.

### I. COPYRIGHT PROTECTION FOR FACTUAL COMPILATIONS PRIOR TO 1991

Since its inception, United States copyright law has protected factual compilations. The courts, however, have disagreed about the basis for the protection of compilations. Prior to *Feist*, the circuits were split between those subscribing to the creative selection doctrine and those applying the sweat of the brow approach, which protected the effort expended in creating compilations.

#### A. *Factual Compilations Under the Copyright Acts*

The first United States copyright act, the 1790 Copyright Act,<sup>23</sup> protected “maps, charts, and books.”<sup>24</sup> Although the 1790 Copyright Act did not expressly name “compilations,” its protection of maps and charts evinces Congress’s intent to protect utilitarian collections of information. Early case law under the 1790 Copyright Act suggests that the constitutional framers intended to protect directories and other informational works.<sup>25</sup> A high proportion of early copyright registrations was for works that presently would be considered compilations: spelling books, atlases, collections of sermons, case reporters, and collections of state documents.<sup>26</sup> The 1909 Copyright Act protected compilations by listing “[b]ooks, including composite and cyclopedic works, directories, gazetteers, and other compilations” as the first class of work for which a copyright could be registered.<sup>27</sup> It also stated that copyrights may be

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23. Act of May 31, 1790, ch. 15, 1 Stat. 124 (repealed 1909).

24. Paul Goldstein, *Copyright*, 38 J. COPYRIGHT SOC’Y 109, 116 (1991).

25. See Jennifer R. Dowd, Note, *A Selective View of History: Feist Publications, Inc. v. Rural Telephone Service Co.*, 34 B.C. L. REV. 137, 155 (1992).

26. J.C. Gilreath, *American Literature, Public Policy and the Copyright Laws before 1800*, LIBRARY OF CONGRESS, FEDERAL COPYRIGHT RECORDS, 1790-1800, at xii (1987), cited in Ralph Oman, *Reflections on the Changing Shape of Database Protection: The Current State of Play, Policy Issues, and the International Context*, 40 FED. B. NEWS & J. 232, 233 n.5 (1993).

27. 17 U.S.C. § 5 (repealed 1976).



secured for all the writings of an author<sup>28</sup> and that the copyright in a work protects “all the copyrightable components of the work copyrighted.”<sup>29</sup>

The 1976 Copyright Act expressly protects compilations, defining them in section 101 as works “formed by the collection and assembling of preexisting materials or of data that are selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes an original work of authorship.”<sup>30</sup> The House of Representatives Report (“House Report”) that accompanied the 1976 Copyright Act elaborated on the statutory definition, stating that “[a] ‘compilation’ results from a process of selecting, bringing together, organizing, and arranging previously existing material of all kinds, regardless of whether the individual items in the material have been or ever could have been subject to copyright.”<sup>31</sup> Section 102 of the 1976 Copyright Act states that copyright “subsists . . . in original works of authorship”<sup>32</sup> and provides that copyright protection does not extend to discoveries.<sup>33</sup> Section 103 explicitly states that the subject matter of copyright as specified in section 102 includes compilations,<sup>34</sup> but limits protection to the material contributed by the author and denies protection for any preexisting material used in the work.<sup>35</sup>

### B. *Factual Compilation Case Law Before Feist*

*Feist* resolved a split in the circuits under the 1976 Copyright Act regarding the proper grounds for protecting factual compilations. The majority of circuits<sup>36</sup> applied the “creative selection”

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28. *Id.* § 4.

29. *Id.* § 3.

30. 17 U.S.C. § 101 (1994).

31. H.R. REP. NO. 94-1476, at 57 (1976), *quoted in* Oman, *supra* note 26, at 233.

32. 17 U.S.C. § 102(a).

33. *Id.* § 102(b).

34. *Id.* § 103(a).

35. *Id.* § 103(b).

36. The Second, Fifth, Ninth, and Eleventh Circuits subscribed to the creative selection theory. *See* *Worth v. Selchow & Righter Co.*, 827 F.2d 569 (9th Cir. 1987); *Southwestern Bell Tel. & Tel. Co. v. Associated Tel. Directory Publishers*, 756 F.2d 801 (11th

doctrine, protecting only the creative aspects of compilations.<sup>37</sup> The doctrine originated in the *Trade-Mark Cases*<sup>38</sup> and *Burrow-Giles Lithographic Co. v. Sarony*,<sup>39</sup> in which the Supreme Court held that originality is required for copyright protection.<sup>40</sup> Courts applying the creative selection doctrine required works to show a minimal amount of creativity in the selection and arrangement of facts in order to qualify for copyright protection. A compilation that was no more than a mechanical list of facts was not protected, even if considerable labor went into creating it. If copyright existed, the facts in a compilation remained in the public domain. The creative selection approach ensured that future compilers could build on previously created factual compilations, so long as selection and arrangement were not borrowed. This approach arguably conferred a competitive advantage on subsequent compilers, who did not have to collect facts but could “borrow” them from existing compilations.<sup>41</sup>

The minority of circuits<sup>42</sup> subscribed to the sweat of the brow theory, which protected the compiler’s labor expended in creating the compilation.<sup>43</sup> The doctrine arose from early English cases interpreting the Statute of Anne, Great Britain’s copyright statute, to prohibit second-comers from free riding on the labor of others.<sup>44</sup> United States courts linked the doctrine with the originality re-

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Cir. 1985); *Eckes v. Card Prices Update*, 736 F.2d 859 (2d Cir. 1984); *Miller v. Universal City Studios, Inc.*, 650 F.2d 1365 (5th Cir. 1981); see also 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, 1344 n.3 (1991).

37. See Yen, *supra* note 36, at 1344.

38. 100 U.S. 82 (1879).

39. 111 U.S. 53 (1884).

40. See Tracy Lea Meade, Note, *Ex-Post Feist: Applications of a Landmark Copyright Decision*, 2 J. INTEL. PROP. L. 245, 250 (1994).

41. See Yen, *supra* note 36, at 1344.

42. The Seventh, Eighth, and Tenth Circuits followed the sweat of the brow theory. See *Rural Tel. Serv. Co. v. Feist Publications, Inc.*, 916 F.2d 718 (10th Cir. 1990) (mem.), *rev’d*, 499 U.S. 340 (1991); *Illinois Bell Tel. Co. v. Haines & Co.*, 905 F.2d 1081 (7th Cir. 1990); *Hutchinson Tel. Co. v. Fronteer Directory Co. of Minn.*, 770 F.2d 128 (8th Cir. 1985); see also Yen, *supra* note 36, at 1344 n.8.

43. See Yen, *supra* note 36, at 1344.

44. See Meade, *supra* note 40, at 248.

quirement by defining originality as independent creation.<sup>45</sup> Under the sweat of the brow theory, courts granted full copyright protection if the compilation resulted from meaningful effort. No matter how mechanical its selection and arrangement, every factual compilation containing a large number of facts was protected. Sweat of the brow courts prohibited future compilers from copying facts from protected compilations, effectively eliminating the competitive advantage of second-comers. Producers of subsequent competing works were required to collect data anew, as if the first work did not exist.<sup>46</sup>

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

“The Supreme Court dropped a bomb” with its decision in *Feist Publications, Inc. v. Rural Telephone Service Co.*,<sup>47</sup> according to Register of Copyrights Ralph Oman in his testimony before the House of Representatives.<sup>48</sup> Likewise, Professor Goldstein describes *Feist* as a “landmark decision” and “a defining event for copyright in the information age.”<sup>49</sup> *Feist* relied on the “bold and largely unprecedented premise” that creativity is part of copyright law’s originality requirement.<sup>50</sup> A second extraordinary premise, that copyright’s originality requirement is constitutionally grounded, also underlay the decision.<sup>51</sup> A third striking feature of the decision was its flat rejection of the sweat of the brow theory of copyright in favor of the creative selection approach favored by the

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45. *See id.* at 249.

46. *See Yen, supra* note 36, at 1345.

47. 499 U.S. 340 (1991).

48. Goldstein, *supra* note 24, at 118.

49. *Id.*

50. *Id.* at 118. Prior to *Feist*, most thought that outside the narrow area of photographs and art reproductions, “originality” meant no more than that the work had not been copied. *See id.* at 118-19. If a work had been independently created, as opposed to copied, and embodied a modicum of creative activity, the “originality” required in section 102 had been satisfied. *See* Leo J. Raskind, *Assessing the Impact of Feist*, 17 U. DAYTON L. REV. 331, 333 (1992) (citing 1 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT §2.01[A] (1991)).

51. *See* Goldstein, *supra* note 24, at 119.

Second Circuit and others.<sup>52</sup>

A. *Facts and Procedural Posture*

Rural Telephone Service Company (“Rural”), a certified public utility, supplied telephone service to several northwestern Kansas communities.<sup>53</sup> Because it was the local telephone monopolist, Rural obtained subscriber information directly from the applications filed by residents who wanted telephone service.<sup>54</sup> As a condition of its monopoly franchise, Rural published an annual white and yellow pages telephone directory.<sup>55</sup>

Feist Publications, Inc. (“Feist”), a publishing company, specialized in area-wide telephone directories.<sup>56</sup> The 1983 directory at issue in the case spanned eleven different telephone service-areas in fifteen counties and contained 46,878 residential listings, compared with Rural’s 7,700 listings.<sup>57</sup> Because it was not a telephone company, Feist lacked independent access to subscriber information and offered to pay the eleven phone companies in northwestern Kansas for the right to use their white pages listings.<sup>58</sup> Of the eleven, only Rural declined.<sup>59</sup> Both Rural and Feist distributed their directories for free and competed “vigorously” for yellow pages advertisements.<sup>60</sup>

In 1978, Feist used Rural’s listings without the telephone company’s consent.<sup>61</sup> Feist removed several thousand listings that were outside the geographic range of its directory, sorted the remaining listings by town and alphabetized them, and sent the re-

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52. See Raskind, *supra* note 50, at 332.

53. See Feist Publications, Inc. v. Rural Tel. Serv. Co., 499 U.S. 340, 342 (1991).

54. See *id.* at 343.

55. See *id.* at 342.

56. *Id.*

57. See *id.* at 343.

58. See *id.*

59. See *id.*

60. See *id.*

61. Rural Tel. Serv. Co. v. Feist Publications, Inc., 663 F. Supp. 214, 217 (D. Kan. 1987), *aff’d*, 916 F.2d 718 (10th Cir. 1990), *rev’d*, 499 U.S. 340 (1991).

sulting lists to verifiers in each town.<sup>62</sup> The verifiers checked every piece of information and sent corrections to Feist.<sup>63</sup> Feist repeated this process in 1983, with the result that 1,309 of 46,878 listings in Feist's 1983 directory were identical to listings in Rural's 1982-83 white pages.<sup>64</sup> Those included four false listings Rural had inserted to detect copying.<sup>65</sup>

Rural sued for copyright infringement, arguing that Feist could not use Rural's white pages in compiling its own directory but must collect the data anew.<sup>66</sup> Feist responded that conducting its own survey was economically impractical and also unnecessary because the listings it had copied were not protected by copyright.<sup>67</sup> The district court granted summary judgment to Rural, citing numerous lower court decisions holding that telephone directories were copyrightable.<sup>68</sup> In an unreported decision, the Tenth Circuit affirmed the district court.<sup>69</sup>

#### B. *Doctrinal Discussion and Application to the Facts*

Writing for all but Justice Blackmun, who concurred in the judgment but did not write an opinion, Justice O'Connor addressed the doctrinal tension posed by copyright law's protection of factual compilations but not facts.<sup>70</sup> Facts are not copyrightable,

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62. *See id.*

63. *See id.*

64. *See Feist*, 499 U.S. at 343-44.

65. *See id.* at 344.

66. *See id.*

67. *See id.* Feist also entered a cross-motion for summary judgment, contending that Rural had violated the antitrust laws by trying to exclude it as a competitor in the market for yellow pages advertisements. A United States District Court held that Rural's refusal to license its listings was motivated by the unlawful purpose of extending its monopoly in telephone service to a monopoly in yellow pages advertising. *See Rural Tel. Serv. Co. v. Feist Publications, Inc.*, 737 F. Supp. 610, 622 (D. Kan. 1990). The Tenth Circuit later reversed the antitrust violation. *See Rural Tel. Serv. Co. v. Feist Publications, Inc.*, 957 F.2d 765 (10th Cir. 1992).

68. *See Feist*, 499 U.S. at 344.

69. *See Rural Tel. Serv. Co. v. Feist Publications, Inc.*, 916 F.2d 718 (10th Cir. 1990) (mem), *rev'd*, 449 U.S. 340 (1991).

70. *See Feist*, 499 U.S. at 344.

O'Connor explained, because facts are not original.<sup>71</sup> Originality, which O'Connor termed the "sine qua non of copyright," requires independent creation and a minimal degree of creativity.<sup>72</sup> The required level of originality is so low that most works easily qualify.<sup>73</sup> Furthermore, originality does not signify novelty.<sup>74</sup> Originality is necessary to trigger copyright protection because "[o]riginality is a constitutional requirement."<sup>75</sup>

The Copyright Clause authorizes Congress to secure to "authors" the exclusive right to their "writings" for a limited time.<sup>76</sup> In the *Trade-Mark Cases* and in *Burrow-Giles Lithographic Co. v. Sarony*, the Court defined the crucial terms "authors" and "writings" to make it "unmistakably clear" that those terms presuppose originality.<sup>77</sup> The Court addressed the constitutional scope of "writings" in the *Trade-Mark Cases*, establishing that originality—which in turn requires independent creation "plus a modicum of creativity"—is required for a work to be classified as the writing of an author.<sup>78</sup> In *Burrow-Giles*, the Court derived the same requirement from the Constitution's use of the word "authors," defining "author," in the constitutional sense, as "he to whom anything owes its origin; originator; maker."<sup>79</sup> The *Burrow-Giles* Court also stressed the creative aspect of originality.<sup>80</sup>

Because facts are not created—they do not owe their origin to an act of authorship—they are not original and hence are not protected by copyright.<sup>81</sup> The distinction, according to O'Connor, is that between creation and discovery.<sup>82</sup> The discoverer does no

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71. *See id.* at 345.

72. *Id.*

73. *See id.*

74. *See id.*

75. *Id.* at 346.

76. *See Feist*, 499 U.S. at 346.

77. *See id.*

78. *See id.*

79. *Id.*

80. *See id.* at 346-47.

81. *See id.* at 347.

82. *See id.*

more than find information and copy it.<sup>83</sup> For example, census takers do not create population figures, but copy those figures from the world around them.<sup>84</sup> Because census data are not original in the constitutional sense, they are not protected.<sup>85</sup> Likewise, facts, which are discovered, are not subject to copyright protection.<sup>86</sup> Factual compilations, in contrast, may possess sufficient originality and creativity in their selection and arrangement of facts to deserve copyright protection.<sup>87</sup>

Justice O'Connor emphasized that, although fact compilations may be protected, their protection is "thin."<sup>88</sup> Copyright extends only to aspects of the work that are original to the author, which may include written expression surrounding the facts or, where facts stand alone, their selection and arrangement.<sup>89</sup> Later compilers may freely use the facts contained in an earlier compilation as long as they do not appropriate the first work's selection and arrangement.<sup>90</sup> According to O'Connor, it is not unfair that others may freely use the fruit of a compiler's labor because encouraging others to build freely upon the ideas and information in existing works "is the means by which copyright advances the progress of science and art."<sup>91</sup> Promoting progress, not rewarding labor, is the primary objective of copyright.<sup>92</sup>

Next, Justice O'Connor reviewed the history of the originality requirement and its treatment in the 1909 Copyright Act. The Court's decisions announcing that originality is a constitutional mandate predate the 1909 Copyright Act, but ambiguous language in the statute caused some lower courts to ignore the originality re-

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83. *See id.*

84. *See id.*

85. *See id.*

86. *See id.*

87. *See id.* at 348.

88. *Id.* at 349.

89. *See id.* at 348.

90. *See id.* at 349.

91. *Id.* at 350.

92. *See id.* at 349.

quirement.<sup>93</sup> The 1909 Copyright Act did not expressly require originality. Instead, section 4 of the act stated that copyright protects “all the writings of an author,” and the words “writing” and “author” implicitly incorporated the originality requirements articulated in the *Trade-Mark Cases* and *Burrows-Giles*.<sup>94</sup> Section 3 stated that only the copyrightable parts of a work were protected, but did not identify originality as the characteristic that determined which parts were copyrightable.<sup>95</sup> The implicit rather than explicit incorporation of the originality requirement led some courts to err.<sup>96</sup> Furthermore, section 5 mentioned compilations as copyrightable works, and some courts mistook this to mean that compilations were copyrightable per se.<sup>97</sup>

Misunderstanding the 1909 Copyright Act and led astray by section 5’s mention of compilations as copyrightable, some courts created the sweat of the brow theory.<sup>98</sup> The most glaring flaw of this doctrine, according to O’Connor, was that it extended protection in compilations to the facts themselves, ignoring the “fundamental axiom” that no one may copyright facts.<sup>99</sup> O’Connor asserted that copyright law has historically acknowledged a greater need to disseminate factual works than to disseminate fictional works or other works of fancy.<sup>100</sup> Consequently, the sweat of the brow theory contravened basic copyright principles.<sup>101</sup>

The Copyright Act of 1976<sup>102</sup> incorporated changes expressly designed to clear up uncertainty in the lower courts regarding basic copyright standards, including the originality requirement.<sup>103</sup>

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93. *See id.* at 351.

94. *See id.*

95. *See id.*

96. *See id.* at 351-52.

97. *See id.*

98. *See id.* at 352-53.

99. *See id.* at 353.

100. *See id.* at 354.

101. *See id.*

102. Pub. L. No. 94-553, 90 Stat. 2541 (codified as amended at 17 U.S.C. §§ 101-1010 (1994)).

103. *See id.* at 355.



Congress dropped the term “all the writings of an author,” replacing it with “original works of authorship” in section 102(a).<sup>104</sup> The legislative history makes clear that Congress purposely left “original works of authorship” undefined to incorporate without change the originality standard established by the courts under the 1909 Copyright Act.<sup>105</sup> In addition, section 102(b), which lists the elements of a work that cannot be copyrighted,<sup>106</sup> replaced the former section 3, which had stated that copyright protected only the copyrightable parts of a work but had not named those parts.<sup>107</sup> Furthermore, Congress defined “compilation” in section 101,<sup>108</sup> and clearly stated in section 103 that protection does not reach the facts themselves.<sup>109</sup>

The 1976 Copyright Act imposes three distinct requirements for a compilation to receive copyright protection: the collection and assembly of pre-existing information; the selection, coordination, or arrangement of those materials; and the creation, as a result of the particular selection, coordination, or arrangement, of an original work of authorship.<sup>110</sup> The first requirement is not informative.<sup>111</sup> The third stresses the originality requirement.<sup>112</sup> The second is the key; it directs courts to focus on the manner in which collected facts are selected, coordinated, and arranged in deciding whether a fact work is an original work of authorship.<sup>113</sup> The originality requirement is not stringent, but asks only that the author independently devise a selection or arrangement that displays a minimal degree of creativity.<sup>114</sup> Most works will satisfy this requirement, but not “the narrow category of works in which the

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104. *See id.*

105. *See id.* (quoting H.R. REP. NO. 94-1476, at 51 (1976) and S. REP. NO. 94-473, at 50 (1975)).

106. *See* 17 U.S.C. § 102(b) (1994).

107. *See supra* note 29 and accompanying text.

108. *See supra* note 30 and accompanying text.

109. *See supra* notes 34-35 and accompanying text.

110. *See* 17 U.S.C. § 102(b).

111. *See* *Rural Tel. Serv. Co. v. Feist Publications, Inc.*, 499 U.S. 340, 357 (1991).

112. *See id.*

113. *See id.* at 358.

114. *See id.*

creative spark is so utterly lacking or so trivial as to be virtually nonexistent.”<sup>115</sup> Furthermore, protected works receive only limited protection because copyright does not reach the pre-existing material.<sup>116</sup>

Applying the doctrine to the facts, Justice O’Connor reiterated that the issue before the Court was whether Feist had infringed Rural’s copyright.<sup>117</sup> Because Feist did not contest Rural’s copyright in its directory, the Court asked whether Rural had proven the second element of infringement by establishing that Feist had copied material that was “original” to Rural.<sup>118</sup> The raw subscriber information copied was not original.<sup>119</sup> Furthermore, Rural had not selected, coordinated, or arranged the raw data in an original way.<sup>120</sup> Rural’s white pages were “typical” and “garden-variety” and devoid of even the slightest trace of creativity.<sup>121</sup> Rural’s selection, in publishing every subscriber’s name, town, and telephone number, was “obvious.”<sup>122</sup> The white pages’ alphabetical organization of names was no more creative than their selection and, therefore, was unoriginal.<sup>123</sup>

As a constitutional matter, Rural’s white pages did not possess the creative spark that the Constitution requires for protection.<sup>124</sup> As a statutory matter, similarly, Rural’s white pages lacked the originality required for Copyright Protection under the 1976 Copy-

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115. *Id.* at 358-59.

116. *See id.* at 359.

117. *See id.* at 361.

118. *See id.*

119. *See id.*

120. *See id.* at 362.

121. *See id.*

122. *See id.* Rural’s selection may also fail the originality requirement, Justice O’Connor noted, because, as a condition of its monopoly franchise, it did not truly “select” to publish the names and telephone numbers of its subscribers but was required to do so by the Kansas Corporation Commission. *Id.* at 363.

123. *See id.* According to the court, alphabetical arrangement is “an age-old practice, firmly rooted in tradition and so commonplace that it has come to be expected as a matter of course. It is not only unoriginal, it is practically inevitable.” *Id.*

124. *See id.*

right Act.<sup>125</sup> Because the white pages were not protected, Feist's use of Rural's listings was not infringement.<sup>126</sup> In closing, the Court reversed the judgment of the Court of Appeals.<sup>127</sup>

### C. *Analysis of the Feist Opinion: Three Perspectives*

As a landmark Supreme Court decision, *Feist* has been the subject of much commentary. This section examines the opinion from constitutional, historical, and doctrinal perspectives.

#### 1. Congress's Authority Questioned

*Feist's* assertion that copyright's originality requirement is constitutionally grounded raises questions about the scope of congressional authority to protect factual compilations both under and outside of the Constitution's Copyright Clause. First, O'Connor's repeated invocation of the Constitution as the source of the creative originality requirement challenges Congress's authority to implement and lend its own construction to the Copyright Clause. *Feist* construes both "author" and "writing" in the Copyright Clause to demand creativity.<sup>128</sup> Professor Ginsburg, however, argues that regardless of the Supreme Court's previous interpretations of those terms, Congress may interpret the clause as it chooses.<sup>129</sup> Moreover, the Court should review congressional findings deferentially.<sup>130</sup>

Professor Ginsburg contrasts the *Feist* court's "textual exegesis" of the Copyright Clause with the Court's lack of concern, in recent years, over articulating and enforcing internal limits inher-

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125. *Id.* at 363-64.

126. *Id.*

127. *See id.*

128. *See supra* notes 76-80 and accompanying text.

129. *See* Jane C. Ginsburg, *No "Sweat"? Copyright and Other Protection of Works of Information After Feist v. Rural Telephone*, 92 COLUM. L. REV. 338, 375 (1992) [hereinafter Ginsburg II] ("Congress' determination of what endeavors constitute the 'Writings' of 'Authors' should be viewed as an exercise in fact-finding by the body most competent to evaluate the efficacy of the means chosen to promote the constitutional goal.").

130. *See id.*

ent in Article I grants of power.<sup>131</sup> Moreover, legislative precedent supports broad congressional power to interpret the key terms of the Patent-Copyright Clause.<sup>132</sup> For example, in the Plant Patent Act,<sup>133</sup> Congress buttressed its determination that finders of new plant varieties could be considered “inventors” by stating that it would not expect the courts to impede the progress of science and the useful arts by insisting on such a narrow definition of the word “inventor” as to decide that the Plant Patent Act exceeded Congress’s authority.<sup>134</sup>

Professor Ginsburg’s view of Congress’s role is grounded in her belief that the judicial branch is poorly suited to determine what constitutes knowledge and how its progress should be encouraged.<sup>135</sup> Instead, Ginsburg claims that determining whether a given work is the “writing” of an “author” is best made by Congress, which can investigate the factual basis for a claim and will be aware of the economic and policy implications of including or excluding a particular type of work.<sup>136</sup>

Congress, unlike the judiciary, is subject to direct political and economic pressure to protect and reward certain sectors of the economy. If not constrained by judicial interpretations of the Copyright Clause, Congress may be unwilling to balance impartially the competing interests of public dissemination and author incentives. The economically powerful information industry will lobby forcefully for increased protection. Those interest groups likely to favor public dissemination—libraries, schools, and re-

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131. *See id.* at 376 (citing LAURENCE H. TRIBE, *AMERICAN CONSTITUTIONAL LAW* 297 (2d. ed. 1988)). For example, in a 1972 patent case, the Court showed great deference to Congress’s construction of the clause, stating that “[t]he direction of Art[icle] I is that Congress shall have the power to promote the progress of science and the useful arts. When . . . the Constitution is permissive, the sign of how far Congress has chosen to go can come only from Congress.” *Id.* (quoting *Deepsouth Packing Co. v. Laitram Corp.*, 406 U.S. 518, 530 (1972)).

132. *See id.*

133. Act of July 19, 1952, ch. 950, 66 Stat. 804 (codified as amended at 35 U.S.C. § 161 (1994)).

134. *See Ginsburg II*, *supra* note 129, at 376-77.

135. *See id.* at 378.

136. *See id.* at 380-81.

search foundations—lack comparable economic power. Consequently, Congress’s fact-finding may not be impartial, and its determination that a given work is the “writing” of an “author” may represent a political decision, rather than an informed policy judgment.<sup>137</sup> The courts, which are not subject to direct political and economic pressure, are better suited to effect a wise balance between public dissemination and protection.

Of course, Congress could try to circumvent constitutional limitations on its power to interpret the Copyright Clause by enacting statutory protection for compilations under the Commerce Clause. O’Connor’s reliance on the Constitution, however, also raises questions about Congress’s authority to protect compilations even under the Commerce Clause. The Court could hold that the more specific clauses of the Constitution limit the more general.<sup>138</sup> The contrary position—that the more specific clauses illustrate the more general powers—may be foreclosed in the context of the Patent-Copyright Clause because the Court has already described that clause as both a grant of power and a limitation.<sup>139</sup>

## 2. Did *Feist* Mischaracterize History?

The *Feist* Court may have misapplied prior Supreme Court constructions of the Copyright Clause.<sup>140</sup> One scholar suggests that *Feist* misconstrued history by ignoring the fact that, from the enactment of the Constitution through the *Trade-Mark Cases* in 1879, an entire body of case law and secondary sources construed “originality” merely to require independent creation.<sup>141</sup> Courts protected, and commentators contemplated protecting, directories and other informational works based on the labor expended.<sup>142</sup>

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137. It is likely that members of Congress will be more receptive to the message delivered by economically powerful publishers in favor of protection than to that delivered by librarians and public interest representatives—who cannot make large political action committee contributions—in favor of public dissemination.

138. See Ginsburg II, *supra* note 129, at 370.

139. See *id.* at 370 (citing *Graham v. John Deere Co.*, 383 U.S. 1, 5 (1966)).

140. See *id.* at 374.

141. See Dowd, *supra* note 25, at 154-55.

142. See *id.* at 155.

Additionally, *Feist* disregarded the English precedent, which stressed protection for independently created informational works, on which United States copyright law was based.<sup>143</sup>

Furthermore, the *Trade-Mark Cases* and *Burrow-Giles* do not clearly support the contention that the Constitution limits copyright protection to original works.<sup>144</sup> In the *Trade-Mark Cases*, which concerned the constitutionality of federal trademark legislation, the Court interpreted “writings,” as used in the Copyright Clause, as merely a comparison to trademark law. The Court did not interpret “writings” to elucidate what copyright law protected, but rather to show what trademark law did not protect.<sup>145</sup> The “intellectual labor” required of a “writing” in the *Trade-Mark Cases* might be satisfied by the assembly of information into a compilation, whether or not the information was creatively selected or arranged.<sup>146</sup> *Burrow-Giles* addressed whether the framers meant to limit copyright protection to literary works.<sup>147</sup> The “author” at the “origin” of a work, under *Burrow-Giles*, could include the maker of an information compilation, without regard to the compilation’s creativity.<sup>148</sup> Moreover, neither decision addressed the scope of copyright protection. Consequently, these decisions do not support constitutionally restricting copyright infringement claims to the copying of authors’ “original” contributions.<sup>149</sup> In fact, other cases decided early in the twentieth century indicate that courts perceived no such limitation on acts constituting infringement.<sup>150</sup>

### 3. Social Benefits, Cost Recoupment, Creative Originality, and Sweat of the Brow

Ideally, copyright law would encourage compilers to create so-

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143. *See id.* at 142, 154.

144. *See id.* at 155-56.

145. *See id.* at 156.

146. *See Ginsburg II, supra* note 129, at 374.

147. *See Dowd, supra* note 25, at 156.

148. *See Ginsburg II, supra* note 129, at 374.

149. *See id.*

150. *See id.* at 375.

cially beneficial compilations that would not be produced without copyright protection. In affirming creative originality rather than sweat of the brow as the basis for copyright protection, the *Feist* Court chose the doctrine that best approximates the ideal. Creative originality encourages compilers to enhance information that already is in the public domain. The sweat of the brow doctrine, in contrast, helps compilers recoup their costs but does not expressly encourage the creation of useful compilations.

i. Social Benefits

The Constitution directs that copyright law promote the progress of science and the useful arts. To achieve this result, doctrines that confer and circumscribe copyright protection should, as a policy matter, encourage the creation of socially beneficial works.<sup>151</sup>

One difficulty with the social benefit rationale is that it justifies protection with respect to an overall system of production but cannot easily be applied to individual works.<sup>152</sup> Applying a social benefit rule on a case-by-case basis would require judges to determine the social value of individual compilations, a role inappropriate for judges in copyright law.<sup>153</sup> Even if courts could articulate criteria for ruling on compilations' social value, judges are unlikely to apply these criteria consistently from court to court.<sup>154</sup> In fact, judges may be unable to do so, as criteria of social worth may vary from one locale to another.<sup>155</sup>

Furthermore, a social benefit rationale would require courts to

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151. See Ginsburg I, *supra* note 19, at 1899 (citing Robert A. Gorman, *Copyright Protection for the Collection and Representation of Facts*, 76 HARV. L. REV. 1569, 1603 (1963)).

152. See *id.*

153. See *id.* at 1899-1900. Justice Holmes stated that, "[I]t would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of [works], outside of the narrowest and most obvious limits." *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251 (1903).

154. See Ginsburg I, *supra* note 19, at 1900.

155. See *id.*

assess the potential social worth of a second-comer's work, which might or might not be considered infringing depending on whether the first-comer's work is protected. For example, a court faced with the facts in *Feist* would need to compare the social benefits conferred by Rural's white page directory with the benefits of Feist's area-wide directory. Each offered different social benefits. How should a court compare the value of a limited, easy-to-use white pages directory to an elderly rural resident of northwestern Kansas with the value of a comprehensive directory to a business located in the nearest urban area? Taking the matter one step further, the social benefit approach would also require courts to consider the potential social benefits of future compilations that a second-comer might or might not choose to create, depending on whether the first work was protected.

#### ii. Cost Recoupment

According to the social benefit rationale, copyright should encourage the production of useful works that might not be created without copyright protection because their costs could not be recouped.<sup>156</sup> With respect to cost recoupment, Professor Yen claims that factual compilations share the characteristics of public goods.<sup>157</sup> Numerous people can use them without impairing others' use ("non-rivalrous consumption"), and those who do not pay cannot easily be prevented from using them (absence of "excludability").<sup>158</sup> These characteristics suggest that, as with other public goods, the supply of factual compilations produced by the free market will fall short of society's needs.<sup>159</sup> Developers will produce compilations only to the extent that they can recoup their costs, and free riding interferes with such recoupment.<sup>160</sup>

Compilation developers can recoup their costs by selling the

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156. *See id.* at 1899.

157. *See Yen, supra* note 36, at 1368.

158. *See id.*

159. *See id.*

160. *See id.*



information they compile.<sup>161</sup> A second-comer who wants to undercut the original developer can buy a copy of the first compilation and incur only the marginal costs of making and distributing copies. As Yen points out, however, original compilers can recoup their costs in other ways besides selling information, such as using the information as a loss-leader to increase sales of other products and services, recouping some costs from sponsoring government or non-profit organizations, and exploiting the natural monopoly that follows initial publication of the data.<sup>162</sup> Other cost recoupment tactics include charging parties for inclusion of their information in the compilation and discriminating in the prices charged to different customers.<sup>163</sup> These possibilities for cost recoupment suggest that some compilations will be developed even if copyright law does not confer a natural monopoly on the developers.<sup>164</sup> Because adequate incentives exist for these compilations, there is no good policy reason for extending copyright protection to them, and the public's interest in dissemination of information dictates that they should not be protected.

A cost recoupment rule would be no easier to apply than a social benefit rationale. What, exactly, would be the nature of the judicial inquiry? Under a per se rule, costs for certain types of compilations would be deemed per se unrecoverable. Alternatively, under a rule of reason analysis, analogous to that used in antitrust law,<sup>165</sup> compilations that do not meet the per se rule's requirements would be subject to a factual investigation to determine whether their costs were in fact recouped. A factual analysis would require courts to separate cases of "legitimate" failure to recoup costs, i.e., useful compilations heavily used by free riders,

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161. *See id.* at 1369.

162. *See id.* at 1369-71. If the data are time-sensitive, the first-comer's natural monopoly will confer a large advantage. *See id.* at 1371. Furthermore, the first-comer can lengthen the natural monopoly by discouraging potential free riders through tactics such as regular printing of updates and, in the case of computer databases, charging for copying or downloading. *See id.* at 1371-72.

163. *See id.* at 1372.

164. *See id.* at 1374.

165. *See Chicago Bd. of Trade v. United States*, 246 U.S. 231 (1918).

from those where the failure to recoup costs was caused by mismanagement and poor marketing. It is difficult to see what end would be served by asking courts to make such determinations.

### iii. Creative Originality

From a policy perspective, the ideal doctrine would protect socially beneficial compilations that would not be produced absent the guarantee of cost recoupment offered by copyright protection. *Feist's* creative originality doctrine serves as a good proxy for a social benefits rule. Its originality requirement insists that a compilation offer something new, that is, something original, to the world. By requiring compilations to display a "modicum of creativity," *Feist* ensures that compilers will build upon and not simply rehash pre-existing public domain information. Because facts are not protected, compilers are encouraged creatively to select and arrange factual information and to add their subjective judgments to facts in order to ensure protection. The doctrine of creative originality thus promotes progress by spurring compilers to enhance public domain information. On a case-by-case basis, creative originality may protect some arguably unimportant works and may not protect some undeniably useful works. The aggregate effect of the doctrine, however, is to encourage compilers to contribute to the store of knowledge in the world. Meanwhile, by limiting protection to compilations displaying a modicum of creativity, the doctrine promotes progress by allowing compilers to use freely any material that does not meet *Feist's* threshold originality requirement.

Professor Ginsburg agrees that *Feist* may impel compilers to add value in the form of subjective information to their compilations.<sup>166</sup> If a compilation includes all the information in a given universe, a court might consider the choice of a universe to be an idea and therefore unprotectable under the merger doctrine,<sup>167</sup> be-

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166. See Ginsburg II, *supra* note 129, at 347.

167. For a detailed case analysis of the merger doctrine, see *infra* notes 317-53 and accompanying text.

cause protecting the selection of a universe would preclude others from creating compilations about that universe.<sup>168</sup> To ensure protection of an exhaustive compilation, Professor Ginsburg suggests that the compiler will add complementary and subjective information to the basic data, so that a court will be likely to find creative selection in the resulting compilation.<sup>169</sup> The addition of subjective information, however, will raise the cost of producing the compilation, and the developer will pass the increased cost onto users.<sup>170</sup> To the extent that users do not value the additional information enough to warrant the increased cost of access, their use of the compilation will decrease.<sup>171</sup>

Professor Ginsburg's objection actually highlights an advantage of the creative originality doctrine: the likelihood that it will encourage compilation developers to add value, in the form of optional and subjective information, to factual compilations. Ginsburg herself uses the term "value added" to refer to the possibly unnecessary and expensive information that compilers will add.<sup>172</sup> With respect to increased costs and reduced access, it is likely that the marginal cost of adding information to a compilation is small, relative to the fixed cost of developing a compilation in the first place. Consumers who do not want the enhanced information can ignore it. The popularity of consumer publications offering ratings and rankings of cities, schools, restaurants, and mutual funds, to name just a few categories, suggests strong consumer demand for exactly this sort of enhanced information.

Although creative originality provides a good proxy for a social benefits rule, as Professor Yen points out, it is not positively correlated with an inability to recoup costs.<sup>173</sup> Yen writes that "[t]here is simply nothing to suggest that creative selection or arrangement of facts is positively correlated with the absence of gov-

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168. See Ginsburg II, *supra* note 129, at 347.

169. See *id.* at 347.

170. See *id.*

171. See *id.*

172. See *id.*

173. See Yen, *supra* note 36, at 1374.

ernment subsidy, nonprofit motives, low development costs, high sales volume, or natural monopolies.”<sup>174</sup> All of these conditions are as likely to exist for uncreative as for creative compilations. Thus in Yen’s view, *Feist* does not necessarily protect compilations that, from a cost recoupment perspective, need protection.

Although Professor Yen may be correct that creativity is not correlated with inability to recoup costs, nothing suggests that the latter is positively correlated with a compilation’s contribution to the progress of science and the useful arts. In fact, an inverse correlation is more likely. Arguably, a compilation’s ability to recoup costs signals that the marketplace places a high value on a compilation. The existence of some free riding does not mean that marketplace signals are worthless.<sup>175</sup>

With respect to ease of application, creative originality allows judges to assess compilations according to a set of “objective” characteristics, rather than requiring them to make value judgments about compilations’ worth or complex economic evaluations of cost-recoverability. Although courts may differ as to what exactly is “creative,” determination of creativity lends itself to case-by-case factual comparisons, and courts can use other compilation cases as guideposts. Different types of compilations can be compared along two dimensions: creative selection and creative arrangement. In contrast, evaluation of the social worth or cost recovery potential of a compilation requires a stand-alone assessment of the work. Inter-work comparisons, except within narrow categories of similar compilations, will not be useful because each compilation may offer a different type of social benefit or pose a different set of cost-recoupment difficulties.

Professor Raskind criticizes creative originality because it ignores the subjective and creative judgments inherent in the activity of collecting data for a compilation.<sup>176</sup> Rewarding creativity in the

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174. *Id.*

175. For example, the fact that law students may offer their friends and relatives the use of their free Westlaw and Lexis passwords does not prevent law firms from paying large sums in order to use those services.

176. See Raskind, *supra* note 50, at 336. Professor Raskind illustrates his charge

activity of data collection, however, is inconsistent with promoting progress. Creative data collection is not socially valuable in itself; it is the *result* of that collection that may be valuable. If the creativity inherent in the data collection method reduces the cost of preparing the compilation, then, from a policy perspective, protection becomes less desirable because the compiler is more likely to recoup the lowered costs. If creative data collection results in a minimally creative product, then the compilation will be protected. Rewarding the creativity inherent in the collection process focuses not on the compilation produced but on the compiler's effort in producing it, as did the sweat of the brow doctrine rejected in *Feist*.

#### iv. Sweat of the Brow

The sweat of the brow doctrine is less likely to protect socially beneficial compilations than *Feist's* creative originality approach. Although the latter allows compilers to build upon others' work and encourages them to contribute something new in order to obtain protection, the sweat of the brow approach prevents compilers from building upon pre-existing compilations and provides no incentive for creative as opposed to merely laborious effort. On a case-by-case basis, sweat of the brow might protect many useful works. In the aggregate, however, it would impede progress by requiring compilers to continually collect raw data anew.

With respect to cost recoupment, sweat of the brow is more likely than creative originality to protect compilations, the costs of which might not otherwise be recouped. Compilers who expend significant effort probably incur high development costs that they may be unable to recoup. Cost recoupment in itself, however, is

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with *Feist's* census-taking example. If taking the census is mere copying of information from the world, he asks, why do some dispute the accuracy of the census in large cities? *See id.* Professor Raskind confuses the data collected with disputes about its accuracy. Critics of urban census counts do not attack census-takers' subjective judgments but rather question the correctness and comprehensiveness of the data, alleging that certain groups are undercounted because census-takers are reluctant to enter crime-ridden neighborhoods and cannot easily count the homeless.

not a goal of copyright policy unless protecting the compilations at issue also promotes progress in some way. Thus the choice between creative originality and sweat of the brow can be characterized as a choice between, on the one hand, encouraging the creation of useful compilations and the free use of pre-existing material while not guaranteeing cost recoupment, and, on the other hand, ensuring that significant investments in compilation efforts will be recovered while not expressly encouraging the creation of useful compilations or the free use of existing material.

Given this tradeoff, it is evident that the *Feist* Court made the correct choice. As between the social benefit and cost recoupment rationales, cost recoupment is the more easily sacrificed of the two. As discussed above, compilers may recoup their costs even without copyright protection. Therefore, the fact that *Feist* denies protection to purely factual works that do not meet its minimal creativity requirement does not condemn those works. In effect, the aspect of the creative originality doctrine that might seem to discourage, rather than encourage, the creation of useful factual works is not fatal to their creation. In contrast, the sweat of the brow doctrine's flat insistence that second-comers must proceed as if other works did not exist<sup>177</sup> is unquestionably fatal to the type of progress compilers can achieve by building on predecessor works. Consequently, the doctrine of creative originality promotes progress more fully than the sweat of the brow approach.

Furthermore, the sweat of the brow doctrine actually may keep development costs high by promoting inefficiency and encouraging the use of old, labor-intensive methods rather than new technology. If copyright rewards significant expenditures of effort, compilers will be sure to expend considerable effort to guarantee protection. As a result, added costs will be passed on to consumers, whose use of those works may drop. If copyright does not reward sweat, compilers will use the most efficient and inexpensive means possible to create compilations, because they will not be guaranteed cost-recovery. The resulting lower cost to consumers

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177. See Yen, *supra* note 36, at 1345.

will encourage greater use.

### III. FACTUAL COMPILATION CASE LAW AFTER *FEIST*

Courts applying *Feist* have added content to the concepts of creative selection and arrangement and further delineated the scope of protection for compilations. Additionally, two cases have suggested an approach to idea/expression merger in factual compilations, an issue not addressed in *Feist*. Lastly, several decisions suggest that the sweat of the brow doctrine is not dead, and that courts will not hesitate to introduce it in other guises.

#### A. *Creative Selection*

Since *Feist*, more courts have analyzed creative selection than any other aspect of compilation copyright protection. Courts find creative originality in selections that reflect the compiler's subjective judgment and personal knowledge and experience and that are not obvious in the underlying data. In contrast, selections determined by convention, industry standards, or other strictly utilitarian criteria are not creatively original.

#### 1. Cases in Which Selections Were Held to be Creative

Seven months after *Feist*, in *Key Publications, Inc. v. Chinatown Today Publishing Enterprises*,<sup>178</sup> the Second Circuit found creativity in Key Publications' ("Key") selection of businesses of interest to New York City's Chinese-American community and its exclusion of businesses unlikely to survive for long.<sup>179</sup> A second directory that copied a subset of Key's directory, however, was held not to infringe on Key's selection because the two directories employed significantly different selection principles.<sup>180</sup>

Key published an annual classified business directory for New York City's Chinese-American community.<sup>181</sup> Key's president,

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178. 945 F.2d 509 (2d Cir. 1991).

179. *See id.* at 513.

180. *See id.* at 515-16.

181. *See id.* at 511.

Lynn Wang (“Wang”), created the directory by collecting business cards from professionals and businesses, and copying what the district court termed a “modest percentage” of listings from an earlier directory.<sup>182</sup> Wang placed each of the listings, which exceeded 9,000 in number, in one of more than 260 business categories.<sup>183</sup> Galore Enterprises, Inc. (“Galore”), the alleged infringer, published a competing classified directory for the New York Chinese-American community.<sup>184</sup> Galore’s yellow pages contained about 2,000 listings grouped into 28 categories.<sup>185</sup> About 75% of the businesses listed in Galore’s directory were also in Key’s.<sup>186</sup>

Galore appealed the district court’s holding that its publication infringed Key’s copyright in its directory.<sup>187</sup> Affirming the district court on copyrightability but reversing on infringement, the Second Circuit held that Key’s directory was subject to copyright but that Galore’s book did not infringe.<sup>188</sup>

Analyzing the copyrightability of Key’s directory, Judge Winter stated that “[s]election implies the exercise of judgment in choosing which facts from a given body of data to include in a compilation.”<sup>189</sup> Although Galore claimed that Wang had “slavishly” included every business about which she had obtained information, the record supported the district court’s conclusion that Wang’s selection was sufficiently original.<sup>190</sup> Specifically, Wang’s testimony that she excluded businesses she did not think would remain open very long showed thought and creativity in selection.<sup>191</sup> Galore also argued that, because some of the listings in the Key directory had been printed in the earlier *Restaurant Direc-*

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182. *Id.*

183. *See id.*

184. *Id.*

185. *See id.*

186. *See id.*

187. *See id.* at 510-11.

188. *See id.* at 514, 515-16.

189. *Id.* at 513

190. *Id.*

191. *See id.*



tory, the court should not find originality.<sup>192</sup> The court rejected this claim because the selection in the Key directory “was not copied wholesale” from the earlier guide.<sup>193</sup>

In *Nester’s Map & Guide Corp. v. Hagstrom Map Co.*,<sup>194</sup> decided shortly after *Key Publications*, the district court for the Eastern District of New York held that the selections of both street address listings and out-of-town destinations in a New York City taxi-driver’s guide were copyrightable.<sup>195</sup> The street address section of *Nester’s Official New York Taxi Driver’s Guide* listed all the major concourses in New York City.<sup>196</sup> Instead of listing all the cross streets, the guide listed only those that its author, Lewis Nester (“Nester”), considered the most important and helpful, based upon his knowledge of New York.<sup>197</sup> The guide assigned approximate, not actual, street address numbers to the cross streets.<sup>198</sup> Hagstrom Map Co. (“Hagstrom”), which published a competing taxi-driver’s guide, admitted copying from Nester’s guide but claimed that the material taken was factual and, therefore, not copyrightable.<sup>199</sup> In response, Nester claimed that because the street address numbers were invented, they were not facts but should be protected like other fictional works.<sup>200</sup> The court refused to treat the addresses as fiction but held that they were protected because of the originality used in selecting and assigning them.<sup>201</sup> Specifically, Nester had shown creativity in assigning approximate numbers to building addresses at the chosen intersections.<sup>202</sup>

Besides its street address section, Nester’s publication included

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192. *See id.*

193. *Id.*

194. 796 F. Supp. 729 (E.D.N.Y. 1992).

195. *Id.* at 733.

196. *See id.* at 732.

197. *See id.*

198. *See id.*

199. *See id.* at 733.

200. *See id.*

201. *See id.*

202. *See id.*

a mileage rate guide that contained the mileage from 59th Street and Columbus Circle to various locations outside of New York City.<sup>203</sup> The court determined that Nester's selection of particular destinations was protected because it rested upon his knowledge and judgment as to their usefulness to a taxi-driver.<sup>204</sup>

In *CCC Information Services, Inc. v. Maclean Hunter Market Reports*,<sup>205</sup> the next compilation case to reach the Second Circuit, the court held that a selection of used car valuations was sufficiently original to warrant copyright protection.<sup>206</sup> Maclean Hunter Market Reports ("Maclean Hunter") published the *Automobile Red Book—Official Used Care Valuations* ("*Red Book*") eight times a year in different versions for each of three regions of the United States.<sup>207</sup> Each issue presented the next six weeks' projected values of "average" models of most of the used cars, seven years old and under, sold in that region.<sup>208</sup> The *Red Book* presented the predicted values separately for each make, model, body style, and engine type, with adjustments for options and for mileage in 5,000 mile increments.<sup>209</sup> Maclean Hunter's editors assigned the valuations based on a range of sources and their own professional experience.<sup>210</sup> CCC Information Services, Inc. ("CCC") also provided its customers with valuation information about used vehicles, but through a computer database rather than a book.<sup>211</sup> For several years, CCC had loaded large portions of the *Red Book* onto its computer network and made the *Red Book* data available to its customers.<sup>212</sup> CCC requested a declaratory judgment that this practice did not infringe Maclean Hunter's copy-

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203. *See id.* at 734.

204. *See id.* at 735.

205. 44 F.3d 61 (2d Cir. 1994), *cert. denied*, 516 U.S. 817 (1995).

206. *Id.* at 67.

207. *See id.* at 63.

208. *See id.*

209. *See id.*

210. *See id.*

211. *See id.* at 64.

212. *See id.*

right, and the district court granted it summary judgment.<sup>213</sup>

The Second Circuit reversed the district court's determination that the *Red Book* was not copyrightable.<sup>214</sup> Although the district court had considered the *Red Book's* valuations to be facts, like the telephone numbers in *Feist*, the Second Circuit held that Maclean Hunter's valuations were its original creations because they represented predictions of future prices estimated for specific geographic regions, based on numerous considerations and the professional judgment and expertise of the editors.<sup>215</sup> The district court had also held that the *Red Book's* selection and arrangement were not original because they were logical responses to the requirements of the vehicle valuation market.<sup>216</sup> Reversing the district court on this point, Judge Leval explained that "[t]he fact that an arrangement of data responds *logically* to the needs of the market for which the compilation was prepared does not negate originality. To the contrary, the use of logic to solve the problems of how best to present the information being compiled is independent creation."<sup>217</sup> The judge discussed original selection and arrangement in combination, and some of the original features he noted could properly be considered aspects of either selection or arrangement. The features he listed that are best characterized as aspects of selection were the selection of a single approximate and original number to represent a model's valuation within a given region; the selection of optional features for inclusion, which included far fewer than all possible options; the selection of 5,000 miles, as opposed to some other breakpoint, as the increment at which to adjust valuations for mileage; the selection of the abstract concept of an "average" vehicle in each category as the subject of the valuation; and the selection of the number of years' models to include in the book.<sup>218</sup>

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213. *See id.*

214. *See id.* at 67-68.

215. *See id.* at 67.

216. *See id.*

217. *Id.*

218. *See id.*

The Second Circuit again found creative selection in a compilation of terms of ventry.<sup>219</sup> In *Lipton v. Nature Co.*,<sup>220</sup> James Lipton (“Lipton”) alleged that the defendants had created posters and other works that infringed on his copyright in his book, a compilation of nouns.<sup>221</sup> Although the defendants argued that the book was not copyrightable because the nouns were facts and not Lipton’s original work, the court held that the book was protected because Lipton’s selection and arrangement were original.<sup>222</sup> Based on his subjective, informed, and creative judgment, Judge Cabranes wrote, Lipton selected the words included in his book from numerous variations of hundreds of available terms in fifteenth century works.<sup>223</sup>

In an opinion that was subsequently vacated, the Eleventh Circuit found creative selection in a publisher’s selection of cable television systems in *Warren Publishing, Inc. v. Microdos Data Corp.*<sup>224</sup> Warren Publishing, Inc. (“Warren”) compiled and published an annual printed directory of cable systems located throughout the United States.<sup>225</sup> Entries within each state were arranged by the name of the principal community each system served.<sup>226</sup> The book’s group ownership section listed selected pieces of information about entities that owned and operated more than one cable system.<sup>227</sup> Alleging copyright infringement, Warren sought and was granted an injunction against Microdos Data Corp. (“Microdos”), which published a software package provid-

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219. Terms of ventry are collective nouns for identifying animal groups. See *Lipton v. Nature Co.*, 71 F.3d 464, 467 (2d Cir. 1995).

220. 71 F.3d 464 (2d Cir. 1995).

221. See *id.* at 468.

222. See *id.* at 468, 470.

223. See *id.* at 470.

224. 52 F.3d 950 (11th Cir.), *vacated*, 67 F.3d 276 (11th Cir. 1995) (granting rehearing en banc), *remanded*, 115 F.3d 1509 (11th Cir. 1997) (en banc), *cert. denied*, \_\_\_ U.S. \_\_\_, 118 S. Ct. 397 (1997).

225. See *Warren Publ’g, Inc. v. Microdos Data Corp.*, 52 F.3d 950, 951 (11th Cir. 1995).

226. See *id.*

227. See *id.*

ing similar cable system information.<sup>228</sup>

Affirming the district court, the circuit court held that Warren's selection was sufficiently creative and original to be copyrightable.<sup>229</sup> Warren selected the data it presented about cable systems from an external universe of existing information drawn from the industry and presented in various forms by other compilers.<sup>230</sup> The publisher chose to present information by listing cable systems, identified according to its own definition of "system."<sup>231</sup> Also, Warren selected a method for locating each system within its listings, identifying each system by the name of the principal community it served.<sup>232</sup> For multiple-community systems, it selected the principal community by which to list the system.<sup>233</sup> The court noted that "the underlying data in this case does not in itself reveal that listing will be by principal communities, and, except for single-community operations, it does not reveal the name of the principal community, which is central to Warren's selection process."<sup>234</sup> The court contrasted Warren's selection with that in *Bellsouth Advertising & Publishing Corp. v. Donnelly Information Publishing, Inc.*<sup>235</sup> Unlike Warren, Bellsouth Advertising & Publishing Corp., the plaintiff in *Bellsouth*, had used its own data rather than select data from external sources.<sup>236</sup>

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228. *See id.* at 950.

229. *See id.* at 955.

230. *See id.* at 954.

231. *See id.*

232. *See id.*

233. *See id.*

234. *Id.*

235. 999 F.2d 1436 (11th Cir. 1993).

236. *Warren Publ'g, Inc. v. Microdos Data Corp.*, 52 F.3d 950, 954 (11th Cir. 1995). Writing in dissent, Judge Kravitch stated that the case was factually similar to *Bellsouth*, in which the Eleventh Circuit had not found Bellsouth's selection of business listings, geographic area, or directory closing date to be sufficiently creatively original to warrant copyright protection. *See id.* at 956 (Kravitch, J., dissenting). Kravitch discussed how Warren's selection of principal communities was similar to Bellsouth's selection of business listings. *See id.* at 957. Both Warren and Bellsouth selected business classifications from a larger universe of available headings. *See id.* Finally, the fact that Bellsouth compiled its own data was not sufficient to distinguish it from Warren. Hinting that the majority's reasoning reintroduced sweat of the brow, Kravitch wrote that "[a]

In *Budish v. Gordon*,<sup>237</sup> an Ohio district court found creative selection in the selection of data contained in tables in a copyrighted book on Medicaid planning.<sup>238</sup> The book *Avoiding the Medicaid Trap: How to Beat the Catastrophic Cost of Nursing-Home Care* (“*The Medicaid Trap*”)<sup>239</sup> included tables based on a complex 152-page technical Governor’s Report that presented information about state requirements and guidelines for Medicaid eligibility in most states.<sup>240</sup> The defendants published a competing Medicaid planning guide containing tables allegedly copied from *The Medicaid Trap*,<sup>241</sup> and the book’s author Armond Budish (“Budish”) sued for infringement.<sup>242</sup> The court determined that the tables were protectable expression because Budish had selected and arranged the material taken from the Governor’s Report in an original manner.<sup>243</sup> The selection was original because Budish had chosen relevant data and discarded what he felt was unnecessary.<sup>244</sup> The court stated that “[t]he cluttered tables in the Governor’s Report appear nothing like Plaintiff’s final Tables, and clearly it was Plaintiff’s selectivity that made the difference.”<sup>245</sup>

## 2. Cases in Which Selections Were Held Not to be Creative

Courts have also rejected claims of creative selection in several cases decided since *Feist*. Five months after the *Feist* decision, in *Victor Lalli Enterprises, Inc. v. Big Red Apple, Inc.*,<sup>246</sup> the Second

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compiler who takes facts from an outside source is not any more original under copyright law than a compiler who takes facts from its own files; its employees just may have worked harder.” *Id.*

237. 784 F. Supp. 1320 (N.D. Ohio 1992).

238. *Id.* at 1332-33.

239. ARMOND BUDISH, *THE MEDICAID TRAP: HOW TO BEAT THE CATASTROPHIC COST OF NURSING-HOME CARE* (rev. 1990) [hereinafter *THE MEDICAID TRAP*]

240. *See Budish*, 84 F. Supp. at 1324-25.

241. *See id.* at 1328.

242. *See id.* at 1331.

243. *See id.* at 1332.

244. *See id.* at 1333.

245. *Id.* at 1333.

246. 936 F.2d 671 (2d Cir. 1991).

Circuit affirmed the district court's pre-*Feist* holding that a chart containing thirteen months of winning numbers in New York City's illegal "numbers games" was not entitled to copyright protection.<sup>247</sup> Victor Lalli Enterprises' ("Lalli") chart contained numbers calculated from simple formulae that were used by all publishers of numbers charts.<sup>248</sup> All charts shared the same format for displaying their data, and the data themselves did not vary from publisher to publisher.<sup>249</sup> Lalli's charts were not protected, according to the court, because they did not display the minimal creativity required by *Feist*.<sup>250</sup> With regard to selection, the court wrote that "Lalli exercises neither selectivity in what he reports nor creativity in how he reports it."<sup>251</sup>

About the same time that the Second Circuit denied copyright protection to Lalli's numbers chart, the Sixth Circuit in *Sem-Torq, Inc. v. K-Mart Corp.*<sup>252</sup> denied protection to a set of five double-sided lawn signs on the grounds that the set was not a compilation.<sup>253</sup> Although Sem-Torq, Inc. ("Sem-Torq") arranged the signs as a set for store display, they were neither packaged nor sold as a set to retailers or to consumers.<sup>254</sup> Affirming the district court's grant of summary judgment to K-Mart Corporation, the circuit court held that the set of signs was no greater than the sum of the individual unprotected signs.<sup>255</sup> Rather than find that Sem-Torq's selection was not creative, the Sixth Circuit found no selection at all.<sup>256</sup>

In *Bellsouth Advertising & Publishing Corp. v. Donnelly Information Publishing, Inc.*,<sup>257</sup> the Eleventh Circuit held that the se-

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247. *See id.* at 673.

248. *See id.* at 672.

249. *See id.*

250. *See id.* at 673.

251. *Id.* at 673.

252. 936 F.2d 851 (6th Cir. 1991).

253. *Id.* at 855.

254. *See id.*

255. *See id.*

256. *See id.*

257. 999 F.2d 1436 (11th Cir. 1993).

lection of a geographic scope and closing date for a yellow pages directory was not sufficiently original to deserve copyright protection.<sup>258</sup> Bellsouth Advertising & Publishing Corp. (“Bellsouth”) published a yellow pages directory organized as an alphabetical list of business classifications.<sup>259</sup> Each of Bellsouth’s business telephone service subscribers was listed under at least one heading in the directory.<sup>260</sup> To create sales lead sheets for its own competing yellow pages directory, Donnelly Information Publishing, Inc. (“Donnelly”) created a computer database using information copied from Bellsouth’s directory.<sup>261</sup>

In an en banc decision, the Eleventh Circuit found that the district court had erred in determining that Bellsouth’s acts of selection merited copyright protection.<sup>262</sup> The court noted that in *Feist*, Rural had established a geographic scope and closing date for its white pages directory, which the Supreme Court held uncopyrightable as a matter of law.<sup>263</sup> The court also pointed out that every collection of facts will have a closing date and, where applicable, a geographic range.<sup>264</sup> Bellsouth’s acts of selection, which included requiring yellow pages subscribers to use its business telephone service and employing several marketing techniques to generate listings, were not acts of authorship, but rather techniques for discovering information.<sup>265</sup> Decisions about the best ways to collect information will contribute to any compilation, but those decisions are insufficient to protect a compilation.<sup>266</sup> According to the court, “the Copyright Act . . . affords no shelter to the resourceful, efficient, or creative collector . . . . The protection of copyright must inhere in a creatively original selection of facts to be reported and

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258. *See id.* at 1441.

259. *See id.* at 1438.

260. *See id.*

261. *See id.* at 1438-39.

262. *See id.* at 1441.

263. *See id.*

264. *See id.*

265. *See id.*

266. *See id.*



not in the creative means used to discover those facts.”<sup>267</sup>

In *Mid-America Title Co. v. Kirk*,<sup>268</sup> the Seventh Circuit held that the selection of factual information in a title commitment<sup>269</sup> did not merit copyright protection.<sup>270</sup> 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.<sup>271</sup> All title examiners would have selected the same facts.<sup>272</sup> Because *Mid-America Title Co.* was required to list every fact that could affect the marketability of a title, the court determined that the company was afforded little room for creativity in selection and exercise of subjective judgment.<sup>273</sup>

Two district courts also failed to find selections creatively original. In *Skinder-Strauss Associates v. Massachusetts Continuing Legal Education, Inc.*,<sup>274</sup> a Massachusetts federal district court found that Skinder-Strauss Associates, publisher of a legal directory, “did not exercise even a minimal degree of creativity in a

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267. *Id.* (emphasis omitted). Judge Hatchett, writing in dissent, asserted that Bellsouth had performed sufficiently original acts of selection to warrant copyright protection. *See id.* at 1473 (Hatchett, J., dissenting). First, as in *Key Publications*, Bellsouth’s choice of classified headings was an original selection dissimilar to that in other yellow pages. *See id.* Second, the selection of only businesses with business telephone service, as opposed to residential telephone service, was also an act of selection contributing to originality. *See id.* at 1476-77. The fact that Donnelly, Bellsouth’s competitor, had chosen to accept listings from both residential and business subscribers demonstrated that Bellsouth’s choice was not automatic or determined by functional concerns. *See id.* at 1477. Third, choosing a geographic area was also an original act of selection. *See id.* at 1477-78.

268. 59 F.3d 719 (7th Cir.), *cert. denied*, 516 U.S. 990 (1995).

269. A title commitment “is an offer to provide a policy of title insurance, which is ordinarily subject to all interests which affect title to a piece of property.” *Mid-America Title Co. v. Kirk*, 867 F. Supp. 673, 678 (N.D. Ill. 1994). Title commitments contain “a legal description of the property, the property index number, general taxes on the property and their status, mortgages on the property and any information of record with respect to such mortgages and the current owners of record on the property and whether they are married.” *Id.*

270. *See Mid-America Title*, 59 F.3d at 722.

271. *See id.*

272. *See id.*

273. *See id.* at 722-23.

274. 914 F. Supp. 665 (D. Mass. 1995).

Feistian sense” in selecting only actively practicing Massachusetts attorneys and in omitting those who were retired or suspended.<sup>275</sup> The court noted that the selection of other information in the directory, such as attorney name, address, telephone, and fax numbers, likewise, was not original but was rather “determined by forces external to the compiler.”<sup>276</sup>

In *American Dental Ass’n v. Delta Dental Plans Ass’n*,<sup>277</sup> an Illinois district court held that a list of dental procedures did not employ a creatively original selection because the list was intended to be comprehensive.<sup>278</sup> According to the court, where there is blind inclusion, there cannot be discerning selection.<sup>279</sup>

### 3. Analysis of Creative Selection After *Feist*

The *Key Publications* court stated that “[s]election implies the exercise of judgment in choosing which facts from a given body of data to include in a compilation.”<sup>280</sup> But what is “judgment?” These decisions show that courts consider subjective, evaluative choices based on the selector’s personal knowledge and experience and involving a degree of arbitrariness or uncertainty to be creatively original selections. In *Key Publications*, the evaluative choice was Wang’s assessment, based on her own familiarity with New York City’s Chinese-American community, of which businesses were likely to remain open and which were likely to disappear quickly.<sup>281</sup> The Second Circuit in *Nester’s* noted that Nester selected cross streets and out-of-town destinations to include in his guide based on his personal knowledge of New York City and his judgment as to their usefulness.<sup>282</sup> In *CCC Information Services*,

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275. *Id.* at 676 (emphasis omitted).

276. *Id.*

277. 39 U.S.P.Q. 2d 1714 (N.D. Ill. 1996).

278. *See id.* at 1725.

279. *See id.*

280. *Key Publications, Inc. v. Chinatown Today Publ’g Enters.*, 945 F.2d 509, 513 (2d Cir. 1991).

281. *See id.*

282. *See Nester’s Map & Guide Corp. v. Hagstrom Map Co.*, 796 F. Supp. 729, 735 (E.D.N.Y. 1992).

the court emphasized the judgment involved in assigning the valuations.<sup>283</sup> The court stressed the fact that Maclean Hunter's valuations were the product of its managers' professional judgment and expertise.<sup>284</sup> The *Lipton* court likewise noted that Lipton's selections were the product of Lipton's "subjective and informed" judgment.<sup>285</sup> The subjective element in *Warren* was the choice to organize cable systems by principal community served, along with the designation of principal communities.<sup>286</sup> Those selections were not obvious in the underlying data and represented Warren's arbitrary judgment. Budish used his years of experience in the field of elder law to decide which of the many potentially useful pieces of information in the Governor's Report his readers would find useful.<sup>287</sup> Budish's selections, like Warren's selection of principal communities, were not obvious from looking at the data source.<sup>288</sup>

These cases, in which the selections were held to be creatively original, contrast sharply with *Mid-America Title*, *Skinder-Strauss* and *American Dental Ass'n*, in which creatively original selections were held not to exist. *Mid-America*'s selection was dictated by convention and strict industry standards.<sup>289</sup> *Skinder-Strauss*' selection of all actively practicing attorneys in the Massachusetts area was "typical" and "garden-variety" in the Feistian sense.<sup>290</sup> As a comprehensive compilation for which the only principal of selection was inclusion, *American Dental Ass'n* clearly did not involve creatively original selection. *Bellsouth* presents a slightly more

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283. See *CCC Info. Servs. v. Maclean Hunter Mkt. Reports, Inc.*, 44 F.3d 61, 67 (2d Cir. 1994) (stating that with the selection of "a single number to cover vast regions that undoubtedly contain innumerable variations, the *Red Book* expresse[d] a loose judgment that values are likely to group together with greater consistency within a defined region than without" and, therefore, the number was "necessarily both approximate and original").

284. See *id.* at 66.

285. *Lipton v. Nature Co.*, 71 F.3d 464, 470 (2d Cir. 1995).

286. See *Warren Publ'g, Inc. v. Microdos Data Corp.*, 52 F.3d 950, 954 (11th Cir. 1995).

287. See *Budish v. Gordon*, 784 F. Supp. 1320, 1333 (N.D. Ohio 1992).

288. See *id.*

289. See *Mid-America Title Co. v. Kirk*, 59 F.3d 719, 722 (7th Cir. 1995).

290. See 914 F. Supp. 665, 676 (D. Mass. 1995).

difficult case, but it is distinguishable from the cases in which courts found selections to be sufficiently creative. One commentator suggests that Bellsouth's selections of a geographic area and temporal cutoff were as creative as Wang's selection of businesses in *Key Publications*.<sup>291</sup> Insofar as the opinion reveals, however, Bellsouth did not apply a subjective, evaluative rule in selecting its geographic area and cutoff date. Wang's selections, in contrast, reflected her evaluations of the health and stability of various businesses. Similarly, Bellsouth's choice of a geographic area was not as creative as Maclean Hunter's designation of three geographical regions in *CCC Information Services*, because Bellsouth's choice apparently did not reflect any special judgment about the area chosen but was instead a utilitarian decision. In contrast, Maclean Hunter's selection, like Wang's, was evaluative.

The selection cases also evince a distinction between informative and inevitable selections. Wang's selection of businesses conveyed the information that she thought those businesses were not ephemeral. Maclean Hunter's selection of geographic regions represented a judgment that all the locales within a region shared certain characteristics in their used car markets. That is, the selection made a statement about those regions, separate from Maclean Hunter's use of those regions to organize its data. Warren's selection of cable systems by community served conveyed information as to which community each system served. None of those selections were "obvious" from the underlying data. The *Bellsouth* court, in contrast, termed Bellsouth's selection "inevitable."<sup>292</sup> *Skinder-Strauss* and *Mid-America Title* resemble *Bellsouth* in this respect.

The cases also differ with respect to the importance of the selection *method* as opposed to the ultimate selection of data. In *Bellsouth*, the Eleventh Circuit stated that originality must inhere

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291. See Ethan L. Wood, Note, *Copyrighting the Yellow Pages: Finding Originality in Factual Compilations*, 78 MINN. L. REV. 1319, 1334 (1994).

292. See *Bellsouth Adver. & Publ'g Corp. v. Donnelly Info. Publ'g Inc.*, 999 F.2d 1436, 1442 (11th Cir. 1993).

in the selection itself, not in the methods used to gather data.<sup>293</sup> On the other hand, the *Lipton* and *Warren* courts gave some weight to *how* the compilers had gone about selecting their information. Lipton pored over fifteenth century manuscripts.<sup>294</sup> Warren selected a method for locating cable systems within its listings.<sup>295</sup>

The differing approaches may reflect a doctrinal split among the circuits with respect to Professor Raskind's question whether "selection, coordination, and arrangement" are to be read as nouns or as verbs identifying creative, intellectual activity.<sup>296</sup> In other words, should courts focus on the acts of authorship involved in creating a compilation, or on the work itself?<sup>297</sup> Alternatively, the different outcomes may reflect subtle differences in the types of selection methods involved in these cases. The methods used in *Bellsouth* were marketing techniques directed at mining Bellsouth's own business data. The methods in *CCC Information Services*, *Lipton*, and *Warren* were subjective evaluations of large amounts of external data.

If courts can consider the source of the data and selection method when assessing whether a compilation shows the creative spark required for copyright protection, they can introduce sweat of the brow. The focus will not be on the quantity of labor expended, but on the nature of the effort and its intellectual difficulty such that it can be characterized as embodying non-obvious subjective judgments. *Lipton*, *CCC Information Services*, and *Warren* all hint at an intellectual sweat of the brow doctrine, under which courts consider not the labor but the intellectual enterprise that contributed to an ultimate selection. Perhaps the true distinction between these cases and *Bellsouth*, then, is that the selection process in *Bellsouth* was not an unguided intellectual exercise but an

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293. *See id.* at 1441.

294. *See Lipton*, 71 F.3d at 470 ("In compiling his work, Lipton assembled terms from various fifteenth century texts and manuscripts. They were selected from numerous variations of hundreds of available terms.").

295. *See Warren*, 52 F.3d at 954-55.

296. Raskind, *supra* note 50, at 334-35.

297. *See id.* at 334.

application of business marketing principles.

### B. *Creative Arrangement*

The United States Copyright Office defines “arrangement” as “the ordering or grouping of data into lists or categories that go beyond the mere mechanical grouping of data such as, for example, the alphabetical, chronological, or sequential listings of data.”<sup>298</sup> Compilations often are most useful when arranged in commonplace, “inevitable,” or functional ways. Consequently, establishing creative originality in an arrangement may be more difficult than in a selection.<sup>299</sup> Although courts should, and typically do, analyze selection and arrangement separately, they tend to find both or neither selection and arrangement to be creatively original.

#### 1. Cases in Which Arrangements Were Held to be Creative

In *Key Publications*, the Second Circuit found creative originality in Wang’s decision as to which businesses to include under which category.<sup>300</sup> Although the format of Key’s directory resembled that of many classified directories, and Key’s categories had been used before, some were of special interest to Chinese-Americans and not commonly found in yellow pages.<sup>301</sup> The court stated that the individual categories chosen are not relevant to the inquiry into creative arrangement.<sup>302</sup> Rather, the focus is on whether the directory’s arrangement in the aggregate is original.<sup>303</sup> Here, the arrangement was original because it was not mechanical but resulted from Wang’s creative decisions as to which businesses

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298. See *Key Publications, Inc. v. Chinatown Today Publ’g Enters.*, 945 F.2d 509, 513 (2d Cir. 1991) (quoting UNITED STATES COPYRIGHT OFFICE, GUIDELINES FOR REGISTRATION OF FACT-BASED COMPILATIONS I (rev. Oct. 11, 1989)).

299. See *Ginsburg II*, *supra* note 129, at 344-45.

300. See *id.* at 514.

301. See *id.*

302. See *id.*

303. See *id.*

to include in each category.<sup>304</sup>

Although it analyzed selection and arrangement together, the Second Circuit in *CCC Information Services* also found creative arrangement in Maclean Hunter's division of the national used car market into three regions for the purpose of estimating used car valuations.<sup>305</sup>

## 2. Cases in Which Arrangements Were Held Not to be Creative

In contrast to the courts in *Key Publications* and *CCC Information Services*, the *Bellsouth* court held that the arrangement in Bellsouth's yellow pages was not original but rather was "entirely typical" for a business telephone directory.<sup>306</sup> The Eleventh Circuit compared Bellsouth's directory with other business directories and found that Bellsouth had not varied from the standard arrangement, which consisted of alphabetical listings of headings describing types of businesses, with alphabetical listings of businesses under those headings.<sup>307</sup> The court also determined that the merger doctrine precluded it from finding creative originality in Bellsouth's arrangement, because an examination of other directories showed that there was only one way to construct a useful business directory.<sup>308</sup> It is irrelevant that there are other imaginable methods of

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304. *See id.*

305. *See CCC Info. Servs. v. Maclean Hunter Mkt. Reports*, 44 F.3d 61, 67 (2d Cir. 1994). The Eleventh Circuit in *Warren Publ'g* never explicitly analyzed Warren's arrangement of cable system data but rather found creative originality only in Warren's selection. *See Warren Publ'g, Inc. v. Microdos Data Corp.*, 52 F.3d 950, 955 (11th Cir. 1995). The court, however, should have characterized as arrangement, not selection, the fact that Warren had "selected a method for placing each system within the listing structure; i.e., it chose to identify each system by the geographical name of the principal community served." *Id.* at 954. The underlying data, according to the court, did not on its face suggest that it should be listed by principal communities. *Id.* The aspect of Warren's compilation so described meets the United States Copyright Office's definition of arrangement as an ordering of data into a list that goes beyond a mechanical grouping.

306. *Bellsouth Adver. & Publ'g Corp. v. Donnelly Info. Publ'g, Inc.*, 999 F.2d 1436, 1442 (11th Cir. 1993).

307. *See id.* at 1442 n.13.

308. *See id.* at 1442.

arrangement, according to the court; what matters is whether the compilation at issue shows originality.<sup>309</sup> Bellsouth's heading structure itself was not original because some headings were "obvious" and some reflected standard industry practices.<sup>310</sup> Also, some subscribers chose where to be listed, so placement of their listings in categories was not creative.<sup>311</sup>

The *American Dental Ass'n* court held that the arrangement was not creative because it was logical and conventional, based on standard custom and practice in dentistry.<sup>312</sup>

### 3. Analysis of Creative Arrangement After *Feist*

The major question that emerges from the cases that specifically analyze arrangement is whether the court should focus on the particular categories chosen or on the overall format of the work. The Second and Eleventh Circuits differ on this issue. In *Key Publications*, the Second Circuit admitted that the directory's format was common to classified directories but found creativity in the choice of particular categories and the arrangement of listings under categories.<sup>313</sup> In contrast, the Eleventh Circuit in *Bellsouth* focused on the general format of Bellsouth's arrangement rather than its specific features. Because the heading structure was "entirely typical," the arrangement was not protected.<sup>314</sup> The Eleventh Circuit's test effectively raises the threshold of originality higher than the *Feist* standard, by requiring that the general format of a yellow pages directory be different from that in other yellow pages directories.<sup>315</sup> *Feist* stated that originality does not require novelty. The Eleventh Circuit has in effect imposed a novelty requirement on original arrangements.

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309. *See id.* at 1443.

310. *Id.* at 1444.

311. *See id.*

312. *See American Dental Ass'n v. Delta Dental Plans Ass'n*, 39 U.S.P.Q. 2d 1714, 1725 (N.D. Ill. 1996).

313. *See Wood*, *supra* note 291, at 1335.

314. *Id.* at 1334.

315. *See id.* at 1337.



Another issue is the extent to which an arrangement can respond to market needs and still be creatively original. In *CCC Information Services*, the court stated that originality is not negated just because an arrangement responds to the needs of the market.<sup>316</sup> Likewise, the arrangement in *Budish* responded to Budish's perception of his readers' needs. In both of those cases, the particular arrangement chosen was one of many possible responses to the compiler's subjective evaluation of the market's needs. In contrast, the compilations in *Bellsouth* and *American Dental Ass'n* used arrangements that the respective courts determined had been dictated by standard industry practices. The distinction is that between a subjective evaluation of market needs and an unquestioned industry standard.

Under the 1976 Copyright Act, as construed by *Feist*, the selection, arrangement, or *coordination* of pre-existing materials may constitute creative originality sufficient to merit protection. No cases, however, have addressed coordination as an independent factor.

### C. Applying the Merger Doctrine to Factual Compilations

The merger doctrine—the principle that copyright law does not protect expression where protection of the expression would effectively grant protection to the idea itself—was not an issue in *Feist*, but has been addressed in subsequent compilation cases.

#### 1. Factual Compilation Cases Discussing Idea/Expression Merger

In *Kregos v. Associated Press*,<sup>317</sup> the Second Circuit analyzed whether the merger doctrine should bar protection of an outcome-predictive baseball pitching form. In this case, George Kregos (“Kregos”) distributed to newspapers a form containing nine items of information about the past performances of opposing pitchers

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316. *CCC Info. Servs. v. Maclean Hunter Mkt. Reports*, 44 F.3d 61, 67 (2d Cir. 1994).

317. 937 F.2d 700 (2d Cir. 1991).

scheduled to start each day's games.<sup>318</sup> Other pitching forms had previously used some of Kregos' nine items but had grouped them differently.<sup>319</sup> No form had previously used Kregos' ninth item.<sup>320</sup> Kregos charged the Associated Press ("AP") with infringing his copyright by publishing a virtually identical form. The circuit court held that it could not determine as a matter of law that the form was not copyrightable and reversed the district court's grant of summary judgment in favor of the AP.<sup>321</sup>

Judge Newman noted that every compilation merges idea and expression in that it expresses its compiler's idea that a particular selection of information is useful.<sup>322</sup> Identifying the idea at that low level of abstraction would deny copyright to all factual compilations.<sup>323</sup> At a higher level of abstraction, merger is not automatic, although in some cases alternative forms of expression may be so few as to preclude protecting the idea.<sup>324</sup> Newman endorsed the district court's characterization of Kregos' idea as the idea of an outcome predictive pitching form.<sup>325</sup> Pointing to variations among published pitching forms as evidence of alternative means of expression, however, Newman rejected the district court's determination that such an idea could be expressed in only a limited number of ways.<sup>326</sup>

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318. *See id.* at 702.

319. *See id.*

320. *See id.* at 703.

321. *Id.* at 704. On remand, the district court held that the Associated Press had not infringed. *See Kregos v. Associated Press*, 795 F. Supp. 1325 (S.D.N.Y. 1992). The Second Circuit court affirmed. *See Kregos v. Associated Press*, 3 F.3d 656 (2d Cir. 1993).

322. *Kregos*, 937 F.2d at 706.

323. *See id.*

324. *See id.*

325. *See id.*

326. *See id.* at 706-07. Judge Newman admitted he was uncomfortable about the possibility that protecting a selection could in effect protect an idea. He posited as an example a doctor publishing a list of symptoms for diagnosing a disease. If the doctor's idea was the general one that the disease in question could be identified from observable symptoms, then there would not be merger. But if the doctor's idea was the narrow one that his particular selection of symptoms was useful in identifying the disease, then the narrow idea could be expressed only by his list of symptoms and merger would probably

According to Judge Newman, “[a]s 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>327</sup> Newman added that, “where a selection of data is the first step in an analysis that yields a precise result or even a better-than-average probability of some result, protecting the ‘expression’ of the selection would clearly risk protecting the idea of the analysis.”<sup>328</sup> Applying this framework, Newman judged Kregos’ form to be midway between “pure taste” and predictive analysis.<sup>329</sup> Kregos’ selection of nine items implied that he thought them useful in predicting outcomes.<sup>330</sup> His form, however, did not provide a system for determining the probabilities of particular outcomes.<sup>331</sup> Kregos’ idea remained the general idea that statistics can be used to evaluate pitching performance, rather than the narrow idea that his selection would predict an outcome.<sup>332</sup>

Judge Sweet, writing in dissent, stated that Kregos’ idea was the specific one that his nine items were the most important statistics in predicting the outcome of a baseball game.<sup>333</sup> According to Sweet, if the concept of an outcome-predictive pitching form were new, then Kregos’ form might be protected as the detailed expression of an idea.<sup>334</sup> Nevertheless, because other forms with similar formats and arrangements existed before Kregos chose his nine items, his “creation” was nothing more than the choice of those nine statistics, a choice that was inseparable from its idea.<sup>335</sup>

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exist. Whether merger applies depends on the level of abstraction at which the idea is formulated. *See id.* at 707.

327. *Id.*

328. *Id.*

329. *See id.*

330. *See id.*

331. *See id.*

332. *See id.*

333. *See id.* at 711 (Sweet, J., dissenting).

334. *See id.*

335. *See id.* Interestingly, the majority and dissent drew opposite legal conclusions from the fact that Kregos’ form was one of many pitching forms. When choosing a level of abstraction, Newman relied on the existence of other pitching forms to establish that Kregos’ form was one of many possible expressions of the idea of an outcome-predictive

Sweet distinguished the general idea that a selection of data is useful from the more specific idea that a particular selection of data is the most useful possible.<sup>336</sup> The less precise idea is expressed in compilations that are based on “aesthetic choices,” or those in which the compilation’s value rests more on the fact of the compilation than on the worth of the data it contains.<sup>337</sup> The narrow idea is expressed in compilations having the primary purpose of allowing a reader to reach a “clearly defined goal.”<sup>338</sup> Kregos’ form, according to Sweet, was of the latter type.<sup>339</sup>

The Second Circuit again addressed merger and factual compilations in *CCC Information Services*.<sup>340</sup> CCC asserted that each *Red Book* entry expressed the authors’ idea of a vehicle’s valuation, and that any expression in the *Red Book* was indispensable to the statement of the idea and therefore merged with it and became unprotectable.<sup>341</sup> In response, Judge Leval stated that the fundamental constitutional principle of copyright is to promote the advance of knowledge by granting authors exclusive rights to their writings.<sup>342</sup> Copyright provides financial incentives to authors in the form of exclusive rights to their writings, allowing authors to sell or license their works.<sup>343</sup> The merger doctrine limits the scope of protection to ensure that ideas remain freely accessible.<sup>344</sup> The issue before the court exemplified the conflict between these policies. If CCC were to prevail in its merger argument, statutory pro-

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pitching form. Sweet used the existence of other forms as the basis for his claim that Kregos’ expression was no more than the idea that his nine items would best predict the outcome of a baseball game. Sweet also took issue with the majority’s doctor example. Both the hypothetical doctor and Kregos developed precise ideas about which data are important in predicting a given result, according to Sweet, and the only means of expressing those ideas is identifying the relevant data. *See id.*

336. *See id.* at 714.

337. *See id.*

338. *See id.*

339. *See id.*

340. 44 F.3d 61 (2d Cir. 1994).

341. *See id.* at 68.

342. *See id.*

343. *See id.* at 68-69.

344. *See id.* at 71.

tection for compilations would be practically eviscerated because, given the nature of the compilations, virtually any independent creation as to selection, coordination, or arrangement will be intended to increase the compilation's usefulness and will represent an idea.<sup>345</sup> In compilations, these ideas will be expressed simply and plainly.<sup>346</sup> If the merger doctrine allowed copying the individual expression of such ideas, section 103 of the Copyright Act would no longer protect compilations.<sup>347</sup>

Leval characterized the *Kregos* decision as a policy judgment between two evils, the "unbridled" application of merger, which would negate copyright protection for compilations, and the complete failure to apply merger, which would protect useful ideas.<sup>348</sup> The *Kregos* court had chosen the middle path, "a *selective* application of the merger doctrine, withholding its application as to soft ideas infused with taste and opinion."<sup>349</sup>

Applying *Kregos*' approach to the case at hand, Leval stated that merger should be withheld as a matter of copyright policy.<sup>350</sup> Because CCC took the entire compilation and the valuations taken were opinion statements rather than facts, giving CCC the benefit of the merger doctrine would destroy the protection intended by the Copyright Act and "largely vitiate the inducements offered by the copyright law to the makers of original useful compilations," without sufficiently benefiting the policy of public access.<sup>351</sup>

## 2. Analysis of Merger Doctrine and Factual Compilations

First, both *Kregos* and *CCC Information Services* indicate that merger will not be applied to bar protection of "soft" ideas reflecting "taste and personal opinion."<sup>352</sup> The merger cases thus rein-

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345. *See id.* at 70.

346. *See id.* at 70.

347. *See id.*

348. *See id.* at 72.

349. *Id.*

350. *See id.* at 72.

351. *See id.* at 73.

352. *See Kregos*, 937 F.2d at 707; *CCC Info. Servs.*, 44 F.3d at 71.

force the post-*Feist* emphasis on protecting subjective, evaluative judgments that is also reflected in courts' analysis of creative selection and arrangement.

Second, *Kregos* indicates that the more general or imprecise the idea of a compilation, the more likely that there will be many ways to express it.<sup>353</sup> Conversely, precise ideas can be expressed in very few ways, so the merger doctrine will preclude their protection. A general idea, however, may be expressed as a comprehensive compilation, and the designation of that comprehensive universe might be considered an idea and thus unprotectable.<sup>354</sup> Such a decision would seem likely on policy grounds. According to Professor Ginsburg, "idea" is a legal conclusion derived from courts' idea of appropriate competition.<sup>355</sup> Courts will label as "ideas" aspects of works that they are reluctant to protect because they do not want to preclude or raise the costs of other authors' efforts.<sup>356</sup> Because granting copyright protection to the designation of a compiler's universe would prevent others from producing competing compilations dealing with the same universe, courts would probably apply the "idea" label to the universe.

Third, the balancing approach adopted in *CCC Information Services* allows courts to ameliorate the perceived harshness of the *Feist* rule and reintroduce sweat of the brow through competing policy judgments. The *CCC Information Services* court's characterization of the merger doctrine as a tool for balancing the competing policy considerations of author incentives and free access to ideas exactly matches Ginsburg's characterization of "idea" as a legal conclusion applied to works that courts are reluctant to protect. When application of the merger doctrine would deny protection to a compilation that, in the court's view, deserves protection, and when withholding merger would not harm the public interest in free access to ideas, the court will withhold it. The very fact that courts are called upon to balance these interests makes it possible

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353. See *Kregos*, 937 F.2d at 707.

354. Ginsburg II, *supra* note 129, at 346.

355. See *id.*

356. See *id.*

for them to deem some compilations more deserving of protection than others. Judge Leval's proposed rule that merger should be withheld for compilations involving "soft ideas infused with taste and opinion" leaves room for considerable judicial discretion. Courts can use balancing to withhold merger to reward compilers who invested significant effort in their work.

#### D. *The Scope of Protection Provided by Compilation Copyrights*

Under *Feist*, copyright affords only "thin" protection to factual compilations.<sup>357</sup> So long as the selection and arrangement are not copied, compilers are free to use the facts contained in other compilations.<sup>358</sup> This section discusses how the courts have determined whether a factual compilation infringes on another's selection and arrangement.

##### 1. Factual Compilation Cases Analyzing Infringement

Only *Key Publications* extensively addressed infringement of a creative selection. Although the court in *Key Publications* might have interpreted *Feist* to permit a finding of infringement only when a second-comer produces an exact copy of a protected compilation, the court refused to do so.<sup>359</sup> For compilations, the sub-

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357. 499 U.S. 340, 349 (1991). The Court ruled that:

Where the compilation author adds no written expression but rather lets the facts speak for themselves, the expressive element is more elusive. The only conceivable expression is the manner in which the compiler has selected and arranged the facts. Thus, if the selection and arrangement are original, these elements of the work are eligible for copyright protection. No matter how original the format, however, the facts themselves do not become original through association. This inevitably means that the copyright in a factual compilation is thin.

*Id.* at 349.

358. *See id.* at 349.

359. *Key Publications, Inc. v. Chinatown Today Publ'g Enters.*, 945 F.2d 509, 514 (1991). The court stated that:

We have not read *Feist* in such a broad and self-defeating fashion. Such a reading of *Feist* would allow subsequent compilers to avoid infringement suits simply by adding a single fact to a verbatim copy of the copyrighted compilation,

stantial similarity test is narrowed. To prove infringement, the compiler must show substantial similarity between the particular elements of the compilation that provide copyrightability.<sup>360</sup>

Applying this principle to the selection aspect of the Key directory, the court held that Galore's directory did not infringe as a matter of law.<sup>361</sup> Judge Winter reasoned that a finite number of businesses are of special interest to the New York Chinese-American community, so that significant overlap among business directories created for that community is inevitable.<sup>362</sup> The key issue, according to Winter, is not whether one directory overlaps with or copies from another, but whether the organizing principle guiding the selection is substantially similar.<sup>363</sup> Winter did not identify the organizing principles used in the Key or Galore directories, but instead compared the numbers of entries in the two that overlapped or differed. Galore's selection of businesses in fact differed significantly from that in the Key directory. The Galore book did not contain 7,500 of Key's 9,000 businesses. The copied listings were not taken from a single section of the Key book, but were scattered throughout the directory. In addition, more than 500 businesses listed in Galore's directory were not in Key's.<sup>364</sup> Based on this quantitative analysis, Winter concluded that the organizing principles the two directories used were not the same.<sup>365</sup> In contrast, if Galore had exactly replicated a substantial portion of the Key directory, such as all its listings of professionals, an infringement claim would have succeeded.<sup>366</sup>

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or omitting in the copy a single fact contained in the copyrighted compilation. Such a result would render the copyright of a compilation meaningless. While, as the Court pointed out in *Feist*, the "copyright in a factual compilation is thin," we do not believe it is anorexic.

*Id.* (citations omitted).

360. *See id.*

361. *Id.* at 515-16.

362. *Id.* at 516.

363. *Id.*

364. *See id.*

365. *See id.*

366. *See id.* at 517.



Ironically, the court warned Key that, having prevailed on its copyright claim even though it had copied some listings from the earlier Restaurant Directory, it could not protect itself from Galore's similarly copying some entries from it.<sup>367</sup> This warning emphasizes the weak level of protection in a compilation copyright. To the extent that a compilation borrows from a single source, that compilation is vulnerable to another compilation's borrowing from it.

With respect to arrangement, Winter also concluded that Galore had not infringed.<sup>368</sup> Galore's arrangement was facially unlike Key's. While Key used more than 260 categories, Galore used only 28, with only 3 of those having appeared in Key's directory.<sup>369</sup> Although many of the listings duplicated across the two categories were contained in similar categories in both directories, the court stated that the arrangement of categories was to be distinguished from the placement of a listing in a particular category, which "is the sort of mechanical task that does not merit copyright protection."<sup>370</sup>

The remaining compilation cases reaching the infringement issue have applied *Key Publications'* approach. For example, the district court in *Nester's* determined that Hagstrom had infringed because its list of cross streets, though just a subset of Nester's, was based entirely on Nester's selection.<sup>371</sup> On the other hand, the court found no infringement as to Nester's mileage rate guide because calculations of distances between New York City and particular destinations were facts derived from destinations and hence not copyrightable.<sup>372</sup> Though Nester's selection of particular destinations was copyrightable, Hagstrom's list of destinations dif-

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367. *See id.* at 516.

368. *See id.* at 515.

369. *See id.*

370. *See id.* It is difficult to square this statement with the court's earlier determination that Wang's creative decisions about placing businesses within categories conferred copyrightability on the Key directory's arrangement.

371. *Nester's Map & Guide Corp. v. Hagstrom Map Co.*, 796 F. Supp. 729, 734 (E.D.N.Y. 1992).

372. *See id.* at 735.

ferred significantly from Nester's with respect to the facts listed and their selection and arrangement.<sup>373</sup>

The *Lipton* court found that the scarf from which the defendants claimed to have copied their terms of venery replicated Lipton's selection almost exactly.<sup>374</sup> Likewise, the *Budish* court held that the tables of Medicaid information in the defendants' book were substantially similar to those in Budish's book.<sup>375</sup> Similarly, the *Warren* court held that Microdos had infringed Warren's selection based on the substantial similarity between Microdos' and Warren's selection of principal communities.<sup>376</sup>

## 2. Analysis of Infringement Issues Raised by Factual Compilation Cases

The principal question that arises with respect to infringement is exactly what Judge Winter meant when he stated that the key issue is the substantial similarity of the organizing principles guiding the selections in two compilations. Although other courts have paid lip service to Winter's approach, neither Winter himself nor any judge since has enunciated the organizing principles of the factual compilations at issue. Rather, courts have employed a quantitative approach, looking at the amount of copied material versus the amount of material that differs between the works in question. There appears to be no basis other than the amount of material copied for assessing whether the organizing principles in two compilations are similar or different. If that is the case, the idea of comparing organizing principles serves merely to obscure the analysis.

### E. *The Persistence of the Sweat of the Brow Doctrine*

Despite *Feist's* affirmation of the creative originality doctrine,

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373. *See id.*

374. *Lipton v. Nature Co.*, 71 F.3d 464, 471 (2d Cir. 1995). Seventy-two of the 77 terms in the book appeared on the scarf, which included only one term not in the book. Several translation errors appearing in Lipton's book appeared on the scarf. *See id.*

375. *Budish v. Gordon*, 784 F. Supp. 1320, 1333-34 (N.D. Ohio 1992).

376. *Warren Publ'g, Inc. v. Microdos Data Corp.*, 52 F.3d 950, 956 (11th Cir. 1995).

courts persist in emphasizing the effort expended in creating compilations. Two courts have equated effort with originality. Another has introduced a balancing approach to the merger doctrine, which, in effect, invites courts to consider rewarding effort after finding a compilation to be creatively original.

### 1. Cases Invoking Sweat of the Brow by Another Name

Faced with *Feist's* flat rejection of sweat of the brow, courts have in effect invoked the doctrine under the rubric of originality. In *U.S. Payphone, Inc. v. Executives Unlimited of Durham, Inc.*,<sup>377</sup> the Fourth Circuit, an “unaligned” circuit before *Feist*, held that U.S. Payphone’s (“Payphone”) guidebook to the coin-operated telephone market was copyrightable. The district court had found that “[t]he 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.”<sup>378</sup> In addition, the court noted that “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.”<sup>379</sup> 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*.<sup>380</sup>

More recently, in *Publications International, Ltd. v. Meredith Corp.*,<sup>381</sup> the Seventh Circuit, a sweat of the brow circuit before *Feist*, clearly invoked sweat of the brow in the guise of originality after *Feist*. The court held that the ingredient lists in recipes contained in a cookbook holding a compilation copyright were not protectable because they were statements of fact.<sup>382</sup> Furthermore, the directions for combining ingredients were not protectable be-

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377. 18 U.S.P.Q. 2d 2049 (4th Cir. 1991).

378. *Id.* at 2050.

379. *Id.* at 2050-51.

380. *See id.* at 2051.

381. 88 F.3d 473 (7th Cir. 1996).

382. *See id.* at 480.

cause they were procedures or processes.<sup>383</sup> Discussing the basic principles of compilation copyrights, 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.”<sup>384</sup> This proposition focuses on the effort involved in creating the compilation, not the creativity of the result.<sup>385</sup> Furthermore, the court stated that “a compilation’s originality flows from the efforts of ‘industrious collection’ by its author.”<sup>386</sup> For this principle the court cited *Schroeder v. William Morrow & Co.*,<sup>387</sup> which in turn had cited *Jeweler’s Circular Publishing Co. v. Keystone Publishing*,<sup>388</sup> the seminal case describing the sweat of the brow theory.<sup>389</sup> In *Feist*, O’Connor identified *Jeweler’s Circular* as a case that misunderstood the 1909 statute and applied the sweat of the brow doctrine.<sup>390</sup>

Unlike the Fourth and Seventh Circuits, the Second Circuit clearly subscribed to the creative selection doctrine before *Feist*. Nonetheless, the Second Circuit’s *CCC Information Services* decision also hints at the re-emergence of the sweat of the brow approach. As discussed above, the balancing approach suggested by the *CCC Information Services* court opens a trapdoor through which other courts may sneak in sweat of the brow considerations. Moreover, the reintroduction of sweat of the brow is evident when *CCC Information Services*’s and *Feist*’s characterizations of basic copyright principles are compared.

In *CCC Information Services*, the court named as the fundamental principle of copyright “promot[ing] the advance of knowledge by granting authors exclusive rights to their writings.”<sup>391</sup> In

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383. *See id.* at 481.

384. *Id.* at 480

385. *See id.* at 480.

386. *Id.*

387. 566 F.2d 3, 5 (7th Cir. 1977).

388. 281 F. 83, 87-88 (2d Cir. 1922).

389. *See Meade, supra* note 40, at 249.

390. *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 351 (1991).

391. *CCC Info. Servs. V. Maclean Hunter Mkt. Reports*, 44 F.3d 61, 68 (2d Cir.

contrast, the *Feist* Court said that “[t]he primary objective of copyright is not to reward the labor of authors but ‘[t]o promote the Progress of Science and useful Arts.’”<sup>392</sup> Selective application of merger, according to *CCC Information Services*, allows courts to balance the competing policies of incentives to authors and free access to ideas.<sup>393</sup> But *Feist* said in no uncertain terms that others may build freely on the fruit of a compiler’s labor.<sup>394</sup>

## 2. Analysis of Hidden Sweat of the Brow Doctrine Cases

By equating mere effort with creative originality, the *U.S. Payphone* and *Publications Int’l* decisions threaten to undermine the doctrine espoused in *Feist* and establish precedents that will confuse other courts. In contrast, the Second Circuit’s explicit balancing of copyright’s competing policies in *CCC Information Services* is less pernicious, even though it creates an entry point for the sweat of the brow doctrine. As a policy matter, it is desirable for courts to have authority to selectively apply sweat of the brow in the limited number of situations in which the equities of the situation mandate its use and the facts suggest no good policy reason for withholding it.

Professor Raskind suggests that before *Feist*, the sweat of the brow doctrine allowed courts to “engraft[ ] acceptable commercial norms onto traditional copyright analysis.”<sup>395</sup> He predicts that courts will “continue to be moved by an equitable sense of ‘fair’ commercial conduct and by an abhorrence of ‘piracy.’”<sup>396</sup> If he is correct—and the three decisions discussed here suggest that he is—the Second Circuit’s forthright balancing of interests is far preferable to the Fourth and Seventh Circuits’ back-door approach. The *CCC Information Services* approach does not redefine originality as something other than what the *Feist* court intended it to

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1994) (emphasis added).

392. *Feist*, 499 U.S. at 349.

393. *CCC Info. Servs.*, 44 F.3d at 73.

394. *Feist*, 499 U.S. at 353-54.

395. See Raskind, *supra* note 50, at 332.

396. *Id.*

be. Rather, it suggests that in certain situations, additional considerations may be added to the mix. Instead of diluting the concept of creative originality, this approach encourages courts to adhere faithfully to *Feist's* teachings as an initial matter. Only after finding creative originality in a compilation might a court entertain alternative policy considerations.

#### F. *Summary of Factual Compilation Cases After Feist*

The factual compilation cases decided since *Feist* demonstrate that the doctrine of creative originality guides courts to reward compilers who do not simply repackage pre-existing information in predictable ways but who add content, in the form of useful subjective evaluations, to unprotectable facts. The post-*Feist* cases indicate that subjective, arbitrary judgments are generally protected, while objective, predictable decisions are not. Specifically, courts are more likely to protect selections and arrangements that reflect compilers' subjective judgments or evaluations than to protect those that respond to routine business requirements. Courts tend not to find creative selection or arrangement when the compiler's choices are "inevitable" or circumscribed by convention, industry standards, or other external limitations.

Nevertheless, as long as they embody an element of subjective judgment, compilations can respond to market needs and still be held creatively original. Similarly, courts will withhold idea/expression merger if the idea inherent in a compilation is "soft" and "infused with taste and opinion." In contrast, if the idea purports to represent a precise or definite prediction or statement about the world, application of the merger doctrine will bar protection.

Copyright protection for compilations, if granted, is thin "but not anorexic." Proving infringement requires showing substantial similarity between the particular copyrightable elements of the first work and those same elements in the allegedly infringing work. Substantial similarity between the principles of selection used, inferred from an analysis of the quantity of information reproduced, determines whether a work infringes another's creative selection.

Finally, courts persist in applying the sweat of the brow doctrine by equating effort with originality or subtly changing *Feist's* characterizations of basic copyright principles.

## CONCLUSION

The tension between copyright law's competing policies of public dissemination and author incentives is keenly felt in the area of factual compilations. *Feist*—which held that copyright protects only the creatively original aspects of a compilation's selection, coordination, or arrangement—promotes progress in the form of enhancements to factual data while encouraging compilers to use public domain information freely. Nevertheless, *Feist's* insistence on originality as a constitutional requirement for copyright raises questions about the scope of Congress's authority to protect factual compilations. Moreover, the accuracy of Justice O'Connor's historical characterization of the originality requirement is questionable.

The factual compilation cases decided since *Feist* have elucidated the concepts of creative selection and arrangement. Courts consider the compiler's subjective, evaluative selections that are grounded in the compiler's personal knowledge and experience and are not inevitable or purely utilitarian to be creative. Several courts have applied an intellectual sweat of the brow doctrine, considering the creativity of the compiler's selection *method* and rewarding those who exerted considerable intellectual effort. Creative arrangement is less clearly defined than creative selection, in that courts disagree on whether to focus on the particular categories chosen or the overall format of the work. Arrangements dictated by standard industry practices are not creative, although an arrangement may respond to market needs and still be creative.

The merger doctrine will bar protection of selections that are starting points for predictive analyses, but will not prevent protection of "soft" ideas based on personal judgments. Merger may be withheld as a policy matter in particular cases if it would vitiate author incentives while insufficiently serving the policy of public access. Additionally, copyright provides only thin protection for factual compilations. Courts analyzing infringement have focused on the amount of copied material contained in the works in question.



Last, *Feist's* disavowal of the sweat of the brow doctrine has not prevented courts from applying the doctrine in other guises. By protecting intellectual and creative selection methods and balancing competing policies when analyzing idea/expression merger, courts have re-introduced sweat of the brow alongside *Feist's* requirement of creative originality. Two cases have gone farther and directly undermined *Feist* by equating effort with originality. The stubborn persistence of sweat of the brow, despite *Feist's* insistence that copyright should not reward effort alone, suggests a strong judicial inclination to reward effort and give primacy to copyright's incentive role.