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Taming the Wild West: The Scope of Copyright Protection for Compilations after Matthew Bender & Co., Inc. v. West Publishing Co. *

* Editor's Note: We encourage you to read John Tessensohn's related article on the protection of computer databases and the Collections of Information Act, appearing immediately supra at page 439.

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West Publishing seems to spend much of its time these days in litigation over whether the judicial opinions it publishes in its Supreme Court Reporter and Federal Reporter series are subject to copyright protection. Recently, it suffered a significant setback when the federal court in New York ruled in *Matthew Bender & Co., Inc. v. West Publishing Co.* n1 that the changes West makes to the court opinions are insufficient to qualify as an original work of authorship. This case, along with several other recent decisions, has important ramifications for publishers of compilations or other collections of facts, particularly in light of the increasing use of CD-ROM technology and other data storage and retrieval systems.

I. BACKGROUND

The current trend towards a lesser protection of copyright gained momentum in 1991 following the U.S. Supreme Court decision in *Feist Publications, Inc. v. Rural Telephone Service Co., Inc.* n2 In *Feist*, the Supreme Court attempted to resolve the tension between two well-established propositions of law. The first being that facts are not copyrightable; the second that compilations of facts generally are. In

[*492] doing so, the Court rejected what had become known alternatively as the "sweat of the brow" or "industrious collection" doctrine, under which various collections or compilations of facts that exhibited virtually no creativity were nevertheless granted copyright protection as a reward for the considerable labor involved in compiling the material. n3

It would be wrong, however, to treat *Feist* as a departure from established law. The Court merely restated -- albeit, quite forcefully -- that originality, not simply hard work, is the constitutionally mandated prerequisite for copyright protection.

At issue in *Feist* was whether an alphabetical listing of surnames in a telephone white pages directory was protectable under the copyright laws. Rural Telephone Service was a certified public utility that provided telephone service to several communities in Kansas. Pursuant to state regulation, Rural published a telephone directory consisting of white pages and yellow pages. It obtained the data for its directory directly from its subscribers, who were required to provide their names and addresses in order to receive telephone service. Feist Publications was a publishing company that specialized in area-wide telephone directories that covered a much wider geographic area than directories such as Rural's. When Rural refused to license its white pages listings to Feist for a directory covering several different telephone service areas, Feist copied the listings it needed directly from Rural's directory without Rural's consent. n4 The district court ruled, and the U.S. Court of Appeals for the Tenth Circuit agreed, that telephone directories were copyrightable and Feist had infringed Rural's copyright. n5

The Supreme Court disagreed. It noted that the Copyright Act of 1976 and its predecessor, the Copyright Act of 1909, dictate that "originality, not 'sweat of the brow,' is the touchstone of copyright protection in directories and other fact-based works." n6 Under the 1976 Act, copyright protection extends only to "original works of authorship." n7 There can be no copyright in facts. n8 In order for a work to be "original," as that term is used in copyright, it must independently be created by the author and possess at least a minimal degree of creativity.

[*493] The requisite level of creativity, however, is "extremely low; even a slight amount will suffice." n9

Although factual compilations n10 often possess the requisite degree of originality -- for example, in the choices by the compilation author as to the selection and arrangement of factual material -- the Supreme Court noted that the protection accorded such works is "thin." n11 Anyone may use facts contained in an original work to aid in the preparation of a competing work provided that the competing work does not feature the identical selection and arrangement of the original. n12

Courts applying the sweat of the brow doctrine, however, had erroneously extended copyright protection in a compilation beyond selection and arrangement to the underlying facts themselves. Under this doctrine, a subsequent compiler wishing to avoid an infringement action would have to "independently work out the matter for himself, so as to arrive at the same result from the same common sources of information." n13 *Feist* ruled that in applying this doctrine, these courts had "eschewed the most fundamental axiom of copyright law -- that no one may copyright facts or ideas." n14

For Rural, this meant that although its directory as a whole might be subject to a valid copyright because it contained a foreword text and original material in its yellow pages, Feist was free to copy the names, towns and telephone numbers straight from Rural's white pages for use in Feist's regional directory. The Supreme Court dismissed the notion that Rural selected, coordinated or arranged these facts in an original way. Although originality is not a stringent standard, the Court ruled that the selection and arrangement "cannot be so mechanical or routine as to require no creativity whatsoever." n15 Rural's choice to arrange the names in its white pages in alphabetical order, in the Court's words, was "an age-old practice . . . so commonplace that it has come to be expected as a matter of course." n16 Similarly, the Court characterized Rural's choices in

[*494] selecting, collecting, collating and preparing the data as "garden-variety" and "devoid of even the slightest trace of creativity." n17 Thus, Rural's white pages did not meet even the minimum constitutional standards for copyright protection. n18

In passing, the Court did take note of the time, cost and effort Rural expended in preparing its telephone directories and implied that, despite Feist's wholesale copying of its work-product, Rural would continue to benefit financially from the advertising revenues it received from its yellow pages. However, as demonstrated in the dispute between Matthew Bender, Hyperlaw and West, other companies that undoubtedly will be affected by the ruling in *Feist* may not be as fortunate.

II. WEST PUBLISHING

As anyone who has attended law school can attest, West provides an invaluable service to law students and practicing attorneys alike by publishing decisions of the United States Supreme Court, the United States Courts of Appeals and the United States District Courts in comprehensive book form, known as "reporters." In addition, West publishes the opinions of state courts, which are also published in official state reporters.

In order to ensure that a consistent form is used in all of the decisions that West selects for inclusion in its reporters, West modifies the opinions by capitalizing those names or portions thereof that will be used in citing the case. West adds to its published opinions the docket number of the case and the dates that the case was argued and decided. Sometimes, West abbreviates portions of the parties' names, combines captions when two or more cases are reported together, and lists the names and addresses of the attorneys involved in the action. West adds to the title a "file line" that gives subsequent history, such as "rehearing denied" and the date of the action. When subsequent opinions are issued by the court in the same case, West may combine the two opinions, publish them separately, or make the correction in the final bound volume of its reporter.

As for the opinions themselves, West employs cite checkers who carefully review each decision and correct any misspellings or errors in either the form or the substance of the citations. In some instances, West may even call the court to verify the accuracy of elements of an opinion. West's employees may also fill in blanks in a judicial opinion,

[*495] such as a reference back to a portion of the same opinion, or a blank left in a citation because the official reporter in which the cited case appears has not been printed at the time the judicial opinion is filed. Another significant addition to the judicial opinion by West is the inclusion of parallel citations and changes to citations to cite to a more readily available source.

A telling measure of West's success in this area is that citation to the specific volume and page number of a case as found in a West reporter is now almost universally accepted and expected in judicial opinions, attorney's briefs and other legal documents.

In 1994, Matthew Bender commenced an action against West in federal court in New York. n19 Matthew Bender, a legal publisher whose publications include treatises, casebooks and practice guides (available in print and in CD-ROM form), sought a declaratory judgment that West does not possess a federal statutory copyright in the volume number and pagination of the opinions as they appear in West's reporters and that Matthew Bender may use such information in its CD-ROM products. The inclusion of this information is typically done for cross-reference purposes and is known in the legal publishing industry as "star paging." Hyperlaw, also a publisher of CD-ROM products, intervened as a plaintiff in that action and sought a declaration of non-infringement with respect to its scanning of the title, text and certain other information directly from the West reporters for use in one of its research products. Hyperlaw, if permitted by the court to do so, intended ultimately to scan up to 75% of West's cases into its system. n20

It was common knowledge in the publishing industry at this time that West would aggressively defend against any challenge to what it viewed as its proprietary systems. In 1986, in *West Publishing Co. v. Mead Data Central, Inc.* n21 the United States Court of Appeals for the Eighth Circuit affirmed an order preliminarily enjoining Mead from using West's arrangement and numbering system on its LEXIS computer legal research network on the grounds that West's arrangement of legal decisions was entitled to copyright protection and that Mead's appropriation of the pagination from West's reporters would infringe West's copyright in arrangement. Later, in 1996, in *Oasis Publishing Co., Inc. v. West Publishing Co.*, n22 the United States District Court in Minnesota

[*496] granted summary judgment in favor of West holding that West's copyright in the arrangement of its cases also protected West's internal pagination system.

West would not fare as well in the New York action. In March 1997, Judge John S. Martin, believing that West's assertion of a copyright interest in the pagination of its volumes could deter competitors from entering the market, issued a brief opinion granting summary judgment in favor of both Matthew Bender and Hyperlaw ruling that their use of star paging did not violate West's copyright in the compilation. n23 This decision resolved the case for Bender. The issues presented by Hyperlaw, however, required further consideration by the court.

In May 1997, Judge Martin decided the remaining issues in the case. Ironically, the court began its opinion with the maxim: "Thou shall not copy," noting that allowing Hyperlaw to copy verbatim large portions of the judicial opinions published by West would seem fundamentally unfair in view of the substantial time and effort West invests in its reporters n24 Unfortunately for West, the court then proceeded to apply the rules on originality set forth in *Feist* to hold that West cannot prevent Hyperlaw or others from doing just that. n25

The court first noted that the opinions published by West are written by judges, not by West, and that it would be unfair to hold that West can preclude anyone from copying what is essentially a government document. n26 The court, analyzing the nature of the copyright protection at issue, then rejected West's argument that its reporters, as well as Hyperlaw's conduct, should be judged under the standard for compilations. n27 Instead, the court ruled that the correct analysis in this case is that which is applicable to derivative works. n28 Since Hyperlaw was not copying West's arrangement of cases, its indices, its headnotes or its selection of cases for publication, but rather was copying individual reported decisions, the court found that Hyperlaw was not copying "those aspects of the compilation that embody the original creation of the compiler." n29

[*497] Section 101 of the Copyright Act defines a derivative work as one "consisting of editorial revisions, annotations, elaborations, or other modifications which, as a whole, represent an original work of authorship." n30 Following Second Circuit law, the court found that in order for a derivative work to be entitled to copyright protection, it must be independently copyrightable -- in other words, it must exhibit originality of authorship. For purposes of the immediate action, this meant that West would have to establish that its published decisions contained at least some substantial variation from the original judicial decision. A "merely trivial" variation would not suffice. n31

West argued, to no avail, that each of its modifications should be judged on whether it changes substantially that particular piece of information. For example, West argued that adding a parallel citation substantially changes the case citation as originally drafted by the judge. The court rejected this argument. n32 It ruled that the changes made by West must be viewed together to determine whether the totality of such changes constitute "an original work of authorship." Using *Feist* as a guide, the court then characterized the changes that West makes to its published opinions -- individually and as a whole -- as "trivial" and not deserving of copyright protection. n33

The court first examined the changes that West makes to the caption of each case and the information it adds pertaining to the subsequent history of such case and the attorneys involved in the action. It found that these changes involved no creative activity but rather were a "mechanical application of preexisting rules of citation" or facts that were not subject to copyright protection. n34 West's other additions fared no better. The addition of the case docket number and the date the case was argued and decided were, in the court's view, "clearly facts" and

[*498] though West needed to make some effort to obtain such information, "there is nothing so original about West's expression of these facts that would entitle them to copyright protection." n35 Similarly, the "file line" was little more than "straightforward factual summaries of court action." n36 West's expression of this information again was unremarkable and followed widely accepted rules of citation. n37 The addition of incomplete information -- West's filling in of blanks -- was also nothing more than a mechanical search for and addition of facts, not subject to any protection.

The court appeared to have some reservations when it came to ruling on West's corrections, additions, and other editing of the text of its published judicial opinions. Nevertheless, these too were found to possess no copyrightable attributes. n38 For example, although the decisions that West makes with respect to subsequent opinions issued by the court in the same case posed "a substantial question" for Judge Martin, he ruled that the available options are so limited that any decision made by West would not involve sufficient creative effort to transform West's report of the decision into an original work by West. n39 Likewise, the efforts by West to cite check each decision and correct any misspellings or errors involved "no element of creativity or originality," even though such efforts undeniably took considerable time and money. n40 Finally, the court found that West's inclusion of parallel citations and its changes to cite to a more readily available source are basically mechanical and devoid of originality. n41

In sum, the court ruled that taken separately or collectively, the modifications made by West do not result in "a distinguishable variation" n42 of the original opinion written by the court and, thus, the portions of West's published opinions scanned by Hyperlaw are not protected by the copyright laws. n43

Judge Martin's decision is currently under appeal but in a telling sign, after the decision was rendered, West quickly settled its dispute with Oasis Publishing. In exchange for Oasis dropping an appeal of the district

[*499] court's decision, West reportedly paid a portion of Oasis' legal costs and money damages. n44 In addition, West entered into a licensing deal that allows Oasis to use West's volume and page citation system. By settling that case, it preserved existing favorable precedent in the Eighth Circuit and, at least for now, prevented that Circuit from rendering any decision that might further change the legal publishing industry.

Even if West pursues its appeal in *Matthew Bender*, the Second Circuit is unlikely to reverse Judge Martin. His reasoning is in direct accord with *Feist*. On these facts, it would be virtually impossible for West to distinguish *Feist*. West could not credibly argue that *Feist* purported to establish a new test for copyrights in compilations. To the contrary, it reaffirmed the originality standard set forth in the Copyright Acts of 1909 and 1976 and as it consistently has been recognized by the U.S. Copyright Office. Nor would West be able to rely on appeal upon *Mead v. West* in support of its copyright claims. Although an appeals court generally will follow legal precedent established by its sister courts, the ruling in *Feist* fundamentally undermines the Eighth Circuit's decision. In light of *Feist*, *Mead v. West* is probably no longer viable.

For this reason, it is not surprising that West has redirected its efforts away from the courts to Congress and to the World Intellectual Property Organization, where there are battles raging to adopt a variety of protections for databases. For example, in its first term, the Clinton administration floated proposals to create a new type of intellectual property protection for electronic databases. n45 In what many believe is a response to *Matthew Bender*, Congress is now considering proposals to expand such legislation to cover compilations distributed in printed form. n46 West calculates -- correctly so -- that it has a greater chance of

[*500] convincing lawmakers to legislate protections for databases than it does of persuading the appellate courts to ignore the dictates of the Supreme Court. Nevertheless, victory for West in this arena is far from certain. The stakes are extremely high and the players on both sides are determined and well-funded.

III. CONCLUSION

Judge Martin's decision in *Matthew Bender* is likely to cause great concern not only to legal publishers, but to all publishers of compilations and other collections of facts. Until now, the availability of copyright protection justified the significant time and expense incurred in preparing works such as West's reporters. However, by trivializing the added value (the editorial elaborations, revisions, and modifications) that publishers such as these bring to the works they publish, the court's ruling strikes at the heart of this business. Legal publishers, for example, may find it much more difficult to sell or license their work, particularly now that anyone with a scanner could conceivably provide an instant and cheaper law library simply by copying the fruits of their labor onto CD-ROM disks or making the data available over the Internet. Unlike the telephone company in *Feist*, few, if any, of these legal publishers have advertising revenues built into their products to offset some of their costs. Thus, the likelihood of diminishing profits may drive some legal publishers to scale back their products or increase their prices.

Publishers remain optimistic -- at least for now. West has appealed Judge Martin's decision. Meanwhile, efforts in Congress to limit the impact of *Feist* and legislate away the *Matthew Bender* decision and others like it continue. The publishing industry will be keeping a close eye on this issue in the months to come.

n1 No. 94-*C0589, 1997 U.S. Dist. LEXIS 6915* (S.D.N.Y. May 19, 1997).

n2 *499 U.S. 340 (1991).*

n3 This doctrine was enunciated in *Jeweler's Circular Publishing Co. v. Keystone Publishing Co., 281 F. 83 (2d Cir. 1922), cert. denied sub nom, 259 U.S. 581 (1922).*

n4 *499 U.S. at 343-44.*

n5 *Id. at 344.*

n6 *Id. at 359-60.*

n7 *17 U.S.C. § 102* (a) (1994).

n8 *17 U.S.C. § 102* (b) (1994).

n9 *499 U.S. at 346.*

n10 The 1976 Act defines a compilation as "a work 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." *17 U.S.C. § 101* (1994).

n11 *499 U.S. at 349.*

n12 *Id.*

n13 *Id. at 353* (quoting *Jeweler's Circular Publishing Co. v. Keystone Publishing Co., 281 F. 83, 88-89 (2d Cir. 1922), cert. denied sub nom, 259 U.S. 581 (1922)).*

n14 *Id.*

n15 *Id.* at 362.

n16 *Id.* at 363.

n17 *Id.* at 362.

n18 *Id.* at 362.

n19 Matthew Bender & Co., Inc. v. West Publ'g Co., No. 94-*C0589, 1997 U.S. Dist. LEXIS 6915* (S.D.N.Y. May 19, 1997).

n20 However, Hyperlaw does not scan, and did not seek to scan, West's headnotes or the key numbers that West inserts as a reference guide into its published opinions.

n21 *799 F.2d 1219 (8th Cir. 1986), cert. denied, 479 U.S. 1070 (1987).*

n22 *924 F. Supp. 918 (D. Minn. 1996).*

n23 No. 94-*C0589, 1997 U.S. Dist. LEXIS 2710* (S.D.N.Y. Mar. 11, 1997).

n24 *Matthew Bender, 1997 U.S. Dist. LEXIS 6915,* at * 3.

n25 *Id.* at * 4-6.

n26 *Id.* at * 3.

n27 *Id.* at * 4.

n28 *Id.*

n29 *Id.* (quoting *CCC Info. Serv., Inc. v. Maclean Hunter Mkt. Reports, Inc., 44 F.3d 61, 66 (2d Cir. 1994), cert. denied, 116 S. Ct. 72 (1995)).*

n30 *17 U.S.C. § 101* (1994).

n31 *Matthew Bender, 1997 U.S. Dist. LEXIS 6915,* at * 5 (quoting *Woods v. Bourne Co., 60 F.3d 978, 990 (2d Cir. 1995)).*

n32 *Id.* at * 6-7.

n33 *Id.* at * 11-12. Similarly, *Feist* was the basis for a decision in the United States District Court in Pennsylvania in which the court held that Alexandria Drafting Company, a map maker, had no copyright interest in its maps. *Alexandria Drafting Co. v. Amsterdam, 43 U.S.P.Q.2d (BNA) 1247 (E.D. Pa. 1997).* Although that court noted that maps had traditionally received copyright protection, with the decision in *Feist* and the demise of sweat of the brow doctrine, such protection no longer appeared justified. Accordingly, the positions of symbols and street alignments, like the "copyright traps" -- fictitious names, streets, dead-ends and the like routinely used by cartographers to uncover unauthorized copying -- simply did not rise to the level of originality required for copyright protection. *Id. at 1253.*

n34 *Matthew Bender, 1997 U.S. Dist. LEXIS 6915,* at * 7.

n35 *Id.* at * 8.

n36 *Id.*

n37 *Id.*

n38 *Id.* at * 10-11.

n39 *Id.* at * 8-9.

n40 *Id.* at * 10.

n41 *Id.* at * 11.

n42 *Id.* at * 12.

n43 *Id.* at * 12.

n44 *See* Thomas Scheffey, *A Cagey Move?*, CONN. L. TRIBUNE, August 11, 1997.

n45 In May 1996, Representative Moorhead, (RCA), Chairman of the House Subcommittee on Courts and Intellectual Property, introduced H.R. 3531, entitled the Database Investment and Intellectual Property Antipiracy Act of 1996. Although the legislation died in the 104th Congress, the legislation proposed to prohibit under certain conditions the extraction, use or reuse of the contents of databases where doing so would conflict with the owner's commercial exploitation of the information. To be protected, a database owner would have to show only "a qualitatively or quantitatively substantial investment of human, technical, financial or other resources in the collection, assembly, verification, organization or presentation of the database contents" and a use of, or intent to use, the database in commerce.

n46 On October 9, 1997, Representative Coble (RNC) introduced the "Collections of Information Antipiracy Act," H.R. 2652, 105th Cong. (1997), that would impose civil and criminal liability upon those who "extract, or use in commerce, a substantial part of a collection of information gathered or maintained by another person through the investment of substantial resources, so as to harm the other person's actual or potential market for a product or service that incorporates such information and is offered in commerce."