

# TRENDS IN PROTECTION FOR INFORMATIONAL WORKS UNDER COPYRIGHT LAW DURING THE 19TH AND 20TH CENTURIES<sup>†</sup>

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*The debate over databases protection has failed to identify and discuss some of its most basic and preliminary assumptions, accepting instead many of the historical aspects involved as given. This Article therefore seeks to challenge these underlying assumptions by providing a fresh look at the historical dimension of the debate. One common argument regarding database protection is that the U.S. Supreme Court decision in Feist v. Rural Publications Inc. brought about a dramatic change in the legal landscape, displacing the then-accepted “sweat of the brow” rationale for protecting rights in databases. This Article’s historical analysis therefore thoroughly examines the treatment of works of facts in general and compilations in particular and reveals the very complex and rich legal landscape that preceded Feist. For one thing, it shows that the law’s prevailing approach has long been to support unfettered access to facts and other materials considered indispensable for academic and economic progress. This Article’s historical analysis also demonstrates that the law’s treatment of databases has not, in fact, relied solely on the “sweat of the brow” doctrine, but rather on a much more complicated spectrum of legal analysis. Indeed, throughout U.S. copyright history—from the early eighteenth and nineteenth centuries through the days of the Copyright Act of 1909 and the 1976 Copyright Act until the*

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*Feist decision—judicial justifications for copyright protection have swung back and forth between investment of labor on the one hand and creativity on the other. In particular, this Article’s historical analysis shows that, contrary to popular thought, the “sweat of the brow” doctrine had been in constant decline under the 1976 Copyright Act even before the Court finally repudiated it in Feist.*

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## INTRODUCTION

The 1990s brought significant developments in the fields of computers, telecommunications, and information technology. These in turn stimulated the creation of a new global market for electronic information services and products, a market that is occupied substantially by electronic

databases. The emergence of these new technological developments and the global information market challenged many traditional branches of the law, including intellectual property law. A particularly prominent part of this debate is how the law should address the protection of electronic databases.

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

The debate gained additional prominence due to a number of worldwide initiatives that extended protection to databases and considered the provision of a much more extensive legal protection for databases. Notably, the *Agreement on Trade Related Aspects of Intellectual Property Rights* ("TRIPs Agreement")<sup>3</sup> introduced minimum standards regarding copyright protection for databases, and the ongoing discussion in the World Intellectual Property Organization ("WIPO") considered the provision of significantly broader intellectual property rights in databases than does the United States under *Feist*.<sup>4</sup> Furthermore, the European Union's Directive on the Legal Protection for Databases ("Database Directive"), adopted in 1996, constituted the most comprehensive attempt to provide protection to databases. It granted a 15-year, renewable, *sui generis* right to prevent the extraction and utilization of raw data in a database, thus resulting in *de facto* protection of the raw data itself. When compared to these much more protective measures, the Supreme Court's decision in *Feist* arguably creates a marked gap between European and American law in how each protects databases and their contents.

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1. 499 U.S. 340 (1991).

2. *Id.* at 349.

3. Agreement on Trade-Related Aspects of Intellectual Property Rights, Apr. 15, 1994, 33 I.L.M. 81 (1994) [hereinafter TRIPs Agreement].

4. *Basic Proposal for the Substantive Provisions of the Treaty on Intellectual Property in Respect of Databases*, WIPO Doc. CRNR/DC/6 (Aug. 30, 1996).

The adoption of the Database Directive, especially the reciprocity provision that conditions protection of non-EU databases upon reciprocal provision of comparable protection in non-EU jurisdictions, has sparked an ongoing debate over bills drafted in the U.S. Congress to address the legal protection of databases.<sup>5</sup> A variety of stakeholders in databases, including commercial users, Internet companies, database publishers, libraries, universities, science organizations, financial institutions, and legal scholars, have joined in this debate, giving their different perspectives on how the law should handle databases.

In particular, a number of legal scholars have voiced their opinions on the important question of how Congress should react to both the Supreme Court's 1991 holding in *Feist* and the EU's subsequent enactment of the Database Directive. Most of this scholarship, however, has simply accepted the argument, advanced by some segments of the database industry and others, that *Feist* creates a problem, that this problem is exacerbated by the EU's Database Directive (and especially by the Directive's reciprocity requirement), and that this problem needs to be solved.<sup>6</sup> Much of the scholarly discussion has also been dedicated to criticizing the United State's proposed bills because of the risks they supposedly pose to the database industry in general and to specific groups such as the scientific and educational communities in particular.<sup>7</sup>

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5. The current U.S. bill for database protection is the Database and Collections of Information Misappropriation Act, H.R. 3261, 108th Cong. (2003) (as passed by the House Judiciary Comm., Jan. 21, 2004). This bill adopts a pure misappropriation approach, modeled almost literally after the test formulated in *National Basketball Ass'n v. Motorola, Inc.*, 105 F.3d 841 (2d Cir. 1997).

6. See, e.g., *Database and Collections of Information Misappropriation Act of 2003: Joint Hearing on H.R. 3261 Before the Subcomm. on Courts, the Internet, and Intellectual Prop. of the House Comm. on the Judiciary and the Subcomm. on Commerce, Trade, and Consumer Prot. of the House Comm. on Energy and Commerce*, 108th Cong. 27 (2003) [hereinafter H.R. 3261 Hearing] (statement of David Carson, General Counsel, Copyright Office of the U.S., Library of Cong.) ("[T]here was a gap in existing legal protection, which could not be satisfactorily filled through the use of technology alone. . . . Without legislation to fill the gap, publishers were likely to react to the lack of security by investing less in the production of databases. . . .").

7. See, e.g., *THE ROLE OF SCIENTIFIC AND TECHNICAL DATA AND INFORMATION IN THE PUBLIC DOMAIN: PROCEEDINGS OF A SYMPOSIUM* (Julie M. Esanu & Paul F. Uhlir eds., 2003); *COMMITTEE ON ISSUES IN THE TRANSBORDER FLOW OF SCIENTIFIC DATA, U.S. NATIONAL COMMITTEE FOR CODATA, & COMMISSION ON PHYSICAL SCIENCES, MATHEMATICS, AND APPLICATIONS, NATIONAL RESEARCH COUNCIL, BITS OF POWER: ISSUES IN GLOBAL ACCESS TO SCIENTIFIC DATA* (1997); *COMMISSION ON PHYSICAL SCIENCES, MATHEMATICS, AND APPLICATIONS & DIVISION ON ENGINEERING AND PHYSICAL SCIENCES, NATIONAL RESEARCH COUNCIL, A QUESTION OF BALANCE: PRIVATE RIGHTS AND THE PUBLIC INTEREST IN SCIENTIFIC AND TECHNICAL DATABASES* (1999); *COMMITTEE ON INTELLECTUAL PROPERTY RIGHTS IN THE EMERGING INFORMATION INFRASTRUCTURE, NATIONAL RESEARCH COUNCIL, THE DIGITAL DILEMMA: INTELLECTUAL PROPERTY RIGHTS IN THE INFORMATION AGE* (2000).

The academic debate has, therefore, also focused on suggesting new and improved forms of protection that Congress could enact.<sup>8</sup>

Despite the extensive academic and legislative discussion on the subject of legal protections for databases, the questionable bases for the assumptions underlying the debate are routinely overlooked, reflecting blind acceptance of their accuracy. One major issue that has been ignored is the historical dimension of the debate. This Article provides a historical analysis of the protection of databases under modern intellectual property law. Specifically, it addresses the popular claim, often raised by proponents of legislation advocating broader database ownership rights, that the United States Supreme Court's 1991 decision in *Feist* brought about a dramatic change in the legal landscape. According to this argument, *Feist* disturbed the status quo and overturned legal protections based on the industrious collection doctrine, also known as the "sweat of the brow" theory, which governed copyright law for two hundred years. Under this long-standing doctrine, database producers had reasonably believed that their databases were entitled to copyright protection. Advocates of legislative action providing broader database ownership rights contend that the legal system flourished under the sweat-of-brow regime, and that Congress should therefore "restore" what the *Feist* decision changed.<sup>9</sup>

Opponents of such restrictive legislation, by contrast, argue that the industrious collection doctrine was never the prevailing approach for the protection of databases. They argue that the legal landscape prior to *Feist* reflected an information policy that consistently supported unfettered

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8. See Jane C. Ginsburg, *No "Sweat"? Copyright and Other Protection of Works of Information after Feist v. Rural Telephone*, 92 COLUM. L. REV. 338 (1992) (suggesting a federal anticopying statute with collective licensing); Justin Hughes, *How Extra-Copyright Protection of Databases Can Be Constitutional*, 28 U. DAYTON L. REV. 159 (2002); J.H. Reichman & Pamela Samuelson, *Intellectual Property Rights in Data?*, 50 VAND. L. REV. 51 (1997) (suggesting a modified liability approach).

9. See *H.R. 3261 Hearing*, *supra* note 6, at 27 (statement of David Carson, General Counsel, Copyright Office of the U.S. Library of Congress) (urging "restoration of the general level of protection provided in the past under copyright 'sweat of the brow' theories"); *Collections of Information Antipiracy Act: Hearing on H.R. 354 Before the Subcomm. on Courts and Intellectual Prop. of the House Comm. on the Judiciary*, 106th Cong. 157 (1999) [hereinafter *H.R. 354 Hearing*] (statement of Marilyn Winokur, Executive Vice President, Micromedex, Inc. on behalf of the Coalition Against Database Piracy) (asking to maintain "the traditional balance between the respective interests of the owners and users of informational products"); *Collections of Information Antipiracy Act; Trade Dress Protection Act; and Continued Oversight of Internet Domain Name Protection: Hearing on H.R. 2652 and H.R. 3163 Before the Subcomm. on Courts and Intellectual Prop. of the House Comm. on the Judiciary*, 105th Cong. 128 (1998) [hereinafter *H.R. 2652 and H.R. 3163 Hearing*] (statement of Jane C. Ginsburg, Columbia University School of Law) (seeking to "restore the *status quo ante-Feist*").

access to factual information.<sup>10</sup> In their view, it would be a mistake to overturn two hundred years of legal tradition by passing legislation that suddenly restricts access to fact-based works.

A historical analysis of database protection from the inception of U.S. copyright law until *Feist* reveals that at various times, however, what was perceived to be the copyrightable element of a work ranged along a continuum between creativity and originality at one end and industriousness and labor at the other. In other words, judicial thought in the United States has swung back and forth like a pendulum, alternating between a focus on investment of labor and a focus on creativity as the proper basis for copyright. The following historical analysis clearly indicates that the arguments on both sides of the debate over potential legislative action are inaccurate, and that prior to *Feist* the legal landscape was very complex in its treatment of information-based works.

In order to assess these arguments, it is important to thoroughly examine the treatment of works of facts in general and compilations in particular over time. Relying primarily on the seminal work of Professor Jane C. Ginsburg,<sup>11</sup> this Article begins with an overview of the emergence of the industrious collection doctrine and concludes with an examination of the legal landscape of the industrious collection doctrine under the 1976 Copyright Act. This historical analysis clearly illustrates the complex and rich legal landscape in the years preceding *Feist* and points to a general uneasiness and confusion about the doctrine. Moreover, it shows that most courts in their decisions were preparing the ground for an eventual repudiation of the doctrine. This analysis also supports the argument that U.S. policy on fact-based intellectual property has consistently fostered unrestricted access to the factual content contained in these works. Such access is based on an appreciation that unrestricted access is necessary to stimulate innovation in both the public and private sectors, support the educational process, and “promote the Progress of Science and useful Arts.”<sup>12</sup>

The historical evidence thus demonstrates that neither those who advocate strong legislative protection of databases nor those who oppose it are entirely correct in their characterization of the last two hundred years

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10. See *H.R. 354 Hearing*, *supra* note 9, at 127 (statement of James G. Neal, Dean, University Libraries, John Hopkins University) (“H.R. 354 would overturn our 200 years of information policy in this country which has consistently supported unfettered access to factual information.”); *H.R. 2652 and H.R. 3163 Hearing*, *supra* note 9, at 151 (testimony of Jonathan Band, Partner, Morrison & Foerster LLP, General Counsel of the Online Banking Association) (“In fact, sweat of the brow was never the prevailing approach for the protection of databases.”).

11. Jane C. Ginsburg, *Creation and Commercial Value: Copyright Protection of Works of Information*, 90 COLUM. L. REV. 1865 (1990).

12. U.S. CONST. art. I, § 8, cl. 8.

of copyright jurisprudence in the United States. Contrary to what the proponents of protective legislation would claim, the industrious collection doctrine has not consistently been the governing legal regime in the U.S. for the past two hundred years, particularly after passage of the 1976 Copyright Act. By the same token, the claims of the opponents of such legislation are also incorrect since the industrious collection doctrine was, at least for a certain period of time, a significant, if not the prevailing, doctrine governing copyright protection in this country. Accordingly, the Supreme Court's decision in *Feist* could not have worked a sea change in copyright jurisprudence in either direction, but rather is more accurately described as merely ending the movement of that jurisprudence along the continuum between authorship based purely on labor and authorship based purely on creativity, finding the latter approach as the only possible basis for copyrightability.

#### I. THE EMERGENCE OF THE INDUSTRIOUS COLLECTION DOCTRINE

In 1789, the Framers of the Constitution empowered Congress to "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>13</sup> The Framers appear primarily to have intended to promote learning, with secondary concerns of protecting authors and providing them with incentives and expanding the range of ideas and information within the public domain.<sup>14</sup> However, because no extensive history of the Copyright and Patent Clause exists, difficulties abound in determining exactly what types of works the Framers intended copyright to cover. On its face, the Copyright Clause says nothing about originality as a prerequisite for legal protection, however the text of the Clause implies such a requirement. By granting exclusive rights only to "authors," the clause implies that originality is the essence of the right to protection. Moreover, the Clause's reference to "progress" suggests that a work entitled to copyright protection must contain more than merely trivial originality. Nevertheless, the terms of the Clause are so general that it offers little help in determining the minimum original contribution necessary to create a copyrightable work from facts and data.

After the Constitution was ratified, Congress quickly enacted the Copyright Act of 1790 to provide limited periods of protection for original works of authorship such as books, maps, and charts. Under this statute,

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13. *Id.*

14. L. Ray Patterson & Craig Joyce, *Monopolizing the Law: The Scope of Copyright Protection for Law Reports and Statutory Compilations*, 36 UCLA L. REV. 719, 783 (1989).

compilations were considered to be “books,”<sup>15</sup> and, indeed, compilations constitute one of the oldest forms of authorship protected under U.S. law, dating back to the eighteenth century.<sup>16</sup> As Professor Ginsburg writes, the works at issue in early copyright disputes were most often highly useful, informational works such as calendars, maps, law books, and arithmetic and grammar primers.<sup>17</sup> The overwhelming presence of informational works reflects, in Professor Ginsburg’s opinion, an important legislative policy of encouraging fact-based works underlying English and American law: the 1710 English Statute of Anne,<sup>18</sup> United States Constitution,<sup>19</sup> and the 1790 United States federal copyright statute<sup>20</sup> all characterized copyright as a device to promote the advancement of knowledge.<sup>21</sup>

Professor Ginsburg also has identified the development of two discrete bases on which the concept of authorship has been founded: investment of labor and investment of individuality.<sup>22</sup> She argues that “[p]erhaps because of the predominance of informational subject matter, the concept of authorship and the basis for copyright protection underlying judicial decisions until the mid-nineteenth century seemed to focus on the labor, rather than the inspiration, invested in the work.”<sup>23</sup> Professor Ginsburg also examined the idea that later in the nineteenth century “courts and commentators began to offer . . . a different rationale for copyright coverage,” stating that these authorities viewed authorship as not purely the product of labor, but rather as the “emanation of an author’s personality.”<sup>24</sup> The author’s subjective judgment in arranging data, rather than her diligence in collecting it, was held to be the protectable essence of the work. Thus, a work was protectable because it incorpo-

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15. Copyright Act of May 31, 1790, ch. 15, 1 Stat. 124, *reprinted in* COPYRIGHT ENACTMENTS OF THE UNITED STATES 1783-1906 at 32 (Thorvald Solberg ed., 1906) [hereinafter Act of May 31, 1790].

16. *See, e.g.,* *Kilty v. Green*, 4 H. & McH. 345 (Md. 1799).

17. *See* Ginsburg, *supra* note 11, at 1873. *See also* Jane C. Ginsburg, *A Tale of Two Copyrights: Literary Property in Revolutionary France and America*, 64 TUL. L. REV. 991, 998–1005 (1990) (discussing political and social reasons for the dominance of informational works in early United States copyright).

18. An Act for the Encouragement of Learning, by Vesting the Copies of Printed Books in the Authors or Purchasers of such Copies, during the Times therein mentioned, 1710, 8 Anne, ch. 19, *reprinted in* HARRY RANSOM, THE FIRST COPYRIGHT STATUTE 109 (1956).

19. U.S. CONST. art. I, § 8, cl. 8. (ratified 1789).

20. Act of May 31, 1790.

21. Ginsburg, *supra* note 11, at 1873.

22. *Id.* at 1873–93.

23. *Id.* at 1873–74.

24. *Id.* at 1874.

rated something of its creator's unique individuality;<sup>25</sup> the benchmark of a work's value was the originality of its conception or execution, not the author's investment of labor.<sup>26</sup>

Nonetheless, this conclusion does not suggest that courts required that the work possess high levels of the requisite "subjectivity" or "distinctiveness."<sup>27</sup> "Sufficient original authorship" could be found "because each author is a distinct individual and inevitably stamps some part of herself upon the work."<sup>28</sup> Moreover, as Professor Ginsburg remarked, "this shift in copyright philosophy toward a more subjective view of authorship" did not in fact suddenly "spur abandonment of the prior labor-oriented approach. Instead, the two views continued to coexist."<sup>29</sup> Consequently, throughout the nineteenth and into the twentieth century, the concept of original authorship embraced investment of *both* labor and originality.

#### A. Labor as a Basis for Authorship

As Professor Ginsburg has explained, many English and American copyright decisions in the eighteenth and early to mid nineteenth centuries characterized copyrightable authorship in terms of the labor invested in the work.<sup>30</sup> This analysis was adopted by the Lord Chancellor in the 1806 decision *Matthewson v. Stockdale*,<sup>31</sup> in which the court held that the plaintiff's East India calendar was a protectable work:

[I]f a man, from his situation having access to the repositories in the *India House*, has by considerable expence and labour procured with correctness all the names and appointments on the *Indian Establishment*, he has a copyright in that individual work; which has

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25. *Id. See, e.g.,* *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 250 (1903) (Holmes, J.); *Jeffreys v. Boosey*, 4 H.L.C. 815, 866–81, 10 Eng. Rep. 681, 702–07 (1854) (Erle, L.J.).

26. Ginsburg, *supra* note 11, at 1874.

27. *Id.*

28. *Id. See also* *Jeffreys*, 4 H.L.C. at 869; *Jewelers' Circular Publ'g Co. v. Keystone Publ'g Co.*, 274 F. 932, 934 (S.D.N.Y. 1921) (Hand, J.) ("[N]o photograph, however simple, can be unaffected by the personal influence of the author, and no two will be absolutely alike"), *aff'd*, 281 F. 83 (2d Cir. 1922).

29. Ginsburg, *supra* note 11, at 1873–74. *See, e.g.,* *Alfred Bell & Co. v. Catalda Fine Arts, Inc.*, 191 F.2d 99, 102–03 (2d Cir. 1951) ("All that is needed . . . is that the 'author' contributed something more than a 'merely trivial' variation, something recognizably 'his own.' Originality in this context 'means little more than a prohibition on actual copying.' No matter how poor artistically the 'author's' addition, it is enough if it be his own.") (citations omitted). *Cf. L. Batlin & Son v. Snyder*, 536 F.2d 486, 489 (2d Cir. 1976) (en banc) (holding a copyright on plastic bank copied from cast iron version invalid because this trivial variation did not satisfy originality requirement).

30. *See* Ginsburg, *supra* note 11, at 1873–74.

31. 12 Ves. Jun. 270, 33 Eng. Rep. 103 (Ch. 1806).

cost him considerable expence and labour; and employed him at a loss in other respects; though there can be no copyright in an *India* calendar, generally.<sup>32</sup>

Furthermore, in the famous 1866 English decision *Kelly v. Morris*,<sup>33</sup> the first English case involving a directory, the court held that where the publication in question was a general directory, the only legitimate use that a subsequent compiler could make of the already published, copyrighted directory was to verify the results of his own independent efforts to assemble the same information. Vice Chancellor Wood explained:

In the case of a dictionary, map, guide-book, or directory, when there are certain common objects of information which must, if described correctly, be described in the same words, a subsequent compiler is bound to set about doing for himself that which the first compiler has done. In case of a road-book, he must count the milestones for himself. In the case of a map of a newly discovered island . . . , he must go through the whole process of triangulation, just as if he had never seen any former map, and generally, he is not entitled to take one word of the information previously published, without independently working out the matter for himself, so as to arrive at the same result from the same common sources of information, and the only use that he can legitimately make of a previous publication is to verify his own calculations and results when obtained . . . .<sup>34</sup>

In the United States, Justice Story followed the English precedent and wrote in his 1845 Circuit Court decision, *Emerson v. Davies*:<sup>35</sup>

A man has a right to the copy-right of a map of a state or country, which he has surveyed or caused to be compiled from existing materials, at his own expense, or skill, or labor, or money. Another man may publish another map of the same state or country, by using the like means or materials, and the like

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32. *Id.* at 105–06. *Accord* *Lewis v. Fullarton*, 2 Beav. 6, 8, 48 Eng. Rep. 1080 (Rolls Ct. 1839) (“[W]hilst all are entitled to resort to common sources of information, none are entitled to save themselves trouble and expense by availing themselves, for their own profit, of other men’s works still subject to copyright and entitled to protection.”).

33. L.R. 1 Eq. 697 (1866).

34. *Id.* at 701; *accord* *Morris v. Ashbee*, L.R. 7 Eq. 34, 40 (1868). Subsequent English decisions adopted the rule laid down in *Kelly v. Morris*. *See, e.g.*, *Hogg v. Scott*, L.R. 18 Eq. 444, 458 (1874); *Morris v. Wright*, L.R. 5 Ch. App. 279 (1870); *Pike v. Nicholas*, L.R. 5 Ch. App. 251 (1869); *Cox v. Land & Water Journal Co.*, L.R. 9 Eq. 324 (1869); *Scott v. Stanford*, L.R. 3 Eq. 718 (1867). *See also* *Ager v. Peninsular & Oriental Steam Navigation Co.*, 26 Ch. D. 637, 642 (1884).

35. 8 F. Cas. 615 (C.C.D. Mass. 1845) (No. 4,436).

skill, labor and expense. But then he has no right to publish a map taken substantially and designedly from the map of the other person, without any such exercise of skill, or labor, or expense.<sup>36</sup>

And in *List Public Co. v. Keller*,<sup>37</sup> in which the court granted an injunction against the proprietor and publisher of a rival “society” directory, the court adopted a pure “industrious collection” approach:

[T]he subsequent compiler must investigate for himself from the original sources of information which are open to all. It has been said that, in the case of a road-book, he must count the mile-stones for himself, and in the case of a map of a newly-discovered island he must go through the whole process of triangulation, just as if he has never seen any former map; and generally, he is not entitled to take one word of the information previously published without independently working out the matter for himself, and the only use he can legitimately make of a previous publication is to verify his own calculations and results when obtained. . . . [I]t is safe to say that the compiler of a general directory is not at liberty to copy any part, however small, of a previous directory, to save himself the trouble of collecting the materials from original sources . . . .<sup>38</sup>

Likewise, in the famous 1905 decision, *Sampson & Murdock Co. v. Seaver-Radford Co.*, on the alleged infringement of a copyright of a general alphabetical directory of the City of Boston, the First Circuit Court of Appeals held that, “[whilst] all are entitled access to common sources of information, none are entitled to save themselves trouble and expense by availing themselves, for their own profit, of men’s works still subject to copyright and entitled to protection.”<sup>39</sup> The court considered the economic implications of copying, holding that:

Certainly the injury which such republications inflict on the owners of copyrighted directories, and the undermining of the markets of the original publishers arising therefrom, if permitted, may be so serious that it is impossible to assume that the use

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36. *Id.* at 619. *See also* Ginsburg, *supra* note 11, at 1875 (“These sorts of statements led contemporary writers of secondary sources to equate original authorship with industriousness”).

37. 30 F. 772 (C.C.S.D.N.Y. 1887).

38. *Id.* at 772–73. *See also* Hartford Printing Co. v. Hartford Directory & Publ’g Co., 146 F. 332, 334 (C.C.D. Conn. 1906) (“You must not bodily transmit the results of another’s labor from his sheets to your own; but, having made an honest canvass, you may use his work for the purpose of checking and revising your own . . .”).

39. 140 F. 539, 542 (1st Cir. 1905) (quoting *Lewis v. Fullarton*, 2 Beav. 6, 8 (1839)).

to which the respondent put the complainant's publication, in the manner we have expressed, is within any implied consent. . . .<sup>40</sup>

As Professor Ginsburg shows, when “[c]ombined with the United States constitutional and legislative goals to ‘promote the Progress of Science’ and learning, the labor concept of copyrightability appears to furnish ample rationale for protecting all kinds of informational works, from narratives to catalogues.”<sup>41</sup> Inquiry into the personal or subjective character of the author's investment in his work seemed to have been irrelevant.<sup>42</sup>

A regime of exclusive ownership rights in information itself seems to have been consistent with the early principles of copyright protection in the United States. Professor Ginsburg argues, however, that such a conclusion is somewhat misleading. Even during that period of jurisprudence, a copyright did not necessarily grant such expansive rights.<sup>43</sup> Indeed, the scope of early copyright protection in informational works was narrow; although it extended to the precise contribution of the first author,<sup>44</sup> it generally did not prevent competitors from duplicating the actual information in the copyrighted work as long as they themselves acquired that same information directly from the primary sources

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40. *Sampson & Murdock Co.*, 140 F. at 543–44.

41. Ginsburg, *supra* note 11, at 1876.

42. See Act of May 31, 1790, at 32 (reflecting this principle by providing protection for any “map, chart, book or books,” the first two categories of which are rather information-laden and labor-intensive works).

43. Ginsburg, *supra* note 11, at 1876–77.

44. *Id.* at 1877–81. See, e.g., English Cases: *Cary v. Kearsley*, 4 Esp. 168, 170–71, 170 Eng. Rep. 679 (K.B. 1802) (Lord Ellenborough). This decision, concerning a road atlas, captured some of the interests at stake in the issue of copyright scope:

[W]hen, in the defendant's book there are additional observations . . . while I shall think myself bound to secure every man in the enjoyment of copy-right, one must not put manacles upon science. I think great part of the book that I have seen, Mr. Kearsley might fairly avow that he had taken it from Mr. Cary's book. I shall address these observations to the jury, leaving them to say, whether what so taken or supposed to be transmitted from the plaintiff's book was fairly done with a view of compiling a useful book, for the benefit of the public, upon which there has been a totally new arrangement of such matter, or taken colourable, merely with a view to steal the copyright of the plaintiff?.

*Id.* at 680. As for U.S. law, see, e.g., *Webb v. Powers*, 29 F. Cas. 511 (C.C.D. Mass. 1847) (No. 17,323), which emphasizes the labor-valuing limitations on the scope of protection. In this case, involving a dictionary of flowers, the court inquired if a second comer's appropriations from the first author were “characterized by enough [that is] new or improved, to indicate new toil and talent, and new property and rights in the last compiler.” In this court's formulation, “new toil and talent” give rise to “new property and rights,” even when the toiler expends his labor on a predecessor's efforts. *Id.* at 517.

and not from copying the copyrighted work.<sup>45</sup> In other words, a copyright prohibited the actual act of copying but did not prohibit a second-comer from compiling the same information independently. In this way, copyright protection under early court decisions operated in much the same manner as the unfair competition tort of misappropriation currently operates.<sup>46</sup> Although a copyright did not prohibit the unauthorized re-manipulation of data, under certain circumstances a copyright holder could wield her copyright as a shield against second-comers who sought to save themselves the effort required to gather information on their own.<sup>47</sup>

### B. *Individuality as a Basis for Authorship*

While the late eighteenth and early nineteenth century Anglo-American courts tended to view original authorship as a function of labor, authors tended to characterize their work as an expression of their personality.<sup>48</sup> For example, the English writer George Colman declared in 1775: “The wild field of nature gives a scope for that variety, which ever distinguishes an area of genius. Never was there a period, wherein excellent authors flourished, but their several manners were as different as their faces. . . .”<sup>49</sup> Only later did the courts also finally begin to recognize individual author personality as a basis for copyright protection.<sup>50</sup> In an 1854 House of Lords decision, one Lord proclaimed:

The order of each man’s words is as singular as his countenance, and although if two authors composed originally with the same order of words, each would have a property therein, still the

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45. See Ginsburg, *supra* note 11, at 1876–81. See, e.g., *Hogg v. Kirby*, 8 Ves. Jun. 215, 222, 32 Eng. Rep. 336, 339 (Ch. 1803) (discussing a related idea that so long as the work was sufficiently new, similar works to those already in existence could be published. “It is equally competent to any other person, perceiving the success of such a work, to set about a similar work, *bona fide* on his own. But it must be in substance a new and original work. . . .”).

46. Ginsburg, *supra* note 11, at 1876–81. The classic misappropriation decision is *International News Service v. Associated Press*, 248 U.S. 215 (1918) [hereinafter *INS*], in which the Supreme Court announced a federal common law “quasi-property” right against misappropriation of commercial value. *Id.* at 239–40. See also Douglas G. Baird, *Common Law Intellectual Property and the Legacy of International News Service v. Associated Press*, 50 U. CHI. L. REV. 411 (1983).

47. See also *List Pub. Co. v. Keller*, 30 F. 772, 773 (S.D.N.Y. 1887).

48. Ginsburg, *supra* note 11, at 1881.

49. “The Gentleman” No. 6 (1775), in 1 PROSE ON SEVERAL OCCASIONS (1787).

50. See Ginsburg, *supra* note 11, at 1882–84 (tracing the development of this theory in courts and focusing on several respected justices in particular).

probability of such an occurrence is less than that there should be two countenances that could not be discriminated.<sup>51</sup>

While neither the United States Constitution nor the copyright laws prior to 1976 expressly required originality, American courts in the later half of the nineteenth century began to infer such a requirement from the Constitution's textual reference to granting protection to "authors." Because the term "author" means "beginner," "first mover," "creator" or "originator,"<sup>52</sup> the Constitution's grant of protection to "authors" necessarily requires originality; if a work lacks originality, it is not the creation of an "author."<sup>53</sup> As Judge Learned Hand stated, the Copyright Clause's "grants of power to Congress comprise, not only what was then known, but what the ingenuity of men should devise thereafter."<sup>54</sup>

Eventually, the U.S. Supreme Court also inferred from the Copyright Clause a requirement that a work be original in order to be copyrighted, noting that the Framers of the Constitution understood "the nature of copyright and the objects to which it was commonly applied, for copyright, as the exclusive right of a man to the production of his own genius or intellect, existed in England at that time."<sup>55</sup> Ultimately, the case law eliminated any doubt that the prevailing prerequisite for copyright protection, regardless of the type of work at issue, is originality.<sup>56</sup> As the following discussion shows, however, the case law also applied a more specific threshold standard below which originality will not be found.

In the seminal case *Burrow-Giles Lithographic Co. v. Sarony*, the plaintiff sued the defendant for reproducing a photograph of Oscar Wilde

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51. *Jeffreys v. Boosey*, 4 H.L.C. 815, 869, 10 Eng. Rep. 681, 703 (1854) (Erle, L.J.) (discussing copyright as a form of property).

52. *See Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 58 (1884) (The constitutional definition of "author" is "'he to whom anything owes its origin; originator; maker; one who completes a work of science or literature'"); *see also* 1 MELVILLE B. NIMMER & DAVID NIMMER, *NIMMER ON COPYRIGHT* § 1.06[A] (2004) ("[T]he one indispensable element of authorship is originality. One who has slavishly or mechanically copied from others may not claim to be an author."); *But see* William F. Patry, *Copyright in Collections of Facts: A Reply*, 6 COM. & L. 11, 18 (1984) (quoting 1 NIMMER & NIMMER, *supra*, § 2.01[A]) ("It was reasoned that since an author is 'the beginner . . . or first mover of anything, . . . creator, originator,' it follows that a work is not the product of an author unless the work is original."). Patry points out, however, that this reasoning is wrong because "it begs the central question of defining originality in works that admittedly are comprised of elements of which the 'author' was not the creator or originator," i.e., compilations of fact. *Id.* Indeed, the term "author" is used loosely to include the broad spectrum of compilers or arrangers of factual data, some of whom actually produce nothing original.

53. *See* 1 NIMMER & NIMMER, *supra* note 52, § 2.01.

54. *Reiss v. Nat'l Quotation Bureau, Inc.*, 276 F. 717, 719 (S.D.N.Y. 1921).

55. *Burrow-Giles*, 111 U.S. at 58.

56. *L. Batlin & Son, Inc. v. Snyder*, 536 F.2d 486, 489-90 (2d Cir. 1976); 1 NIMMER & NIMMER, *supra* note 52, § 2.01.

taken by the plaintiff.<sup>57</sup> The defendant admitted to copying the photograph, but contended that the photograph was merely the “reproduction on paper of the exact features of some natural object, or of some person” and therefore was not a “writing” that could be considered copyrightable subject matter.<sup>58</sup> The United States Supreme Court rejected this argument.

Initially, the Court justified a more expansive construction of the term “writings” by noting that the first federal copyright statute protected maps, charts and books, none of which are literally “writings.”<sup>59</sup> Because those who drafted this first copyright statute were the same authors who drafted the Constitution, the Court concluded that the Framers of the Constitution must have intended a broader and less literal definition of the term “writings.”<sup>60</sup> The Court therefore interpreted the term “authors” in the Copyright Clause to include anyone “to whom anything owed its origin,” such that the term “writings . . . meant the literary productions of those authors, and Congress very properly has declared these to include all forms of writing, printing, engraving, etching, etc., by which the ideas in the mind of the author are given visible expression.”<sup>61</sup> Accordingly, the original photographer qualified as an “author” who could be protected under the Copyright Clause.

Having established the broad constitutional scope of copyrightable subject matter, the *Burrow-Giles* Court then proceeded to consider and ultimately reject the defendant’s contention that the plaintiff’s photograph was merely a reproduction of preexisting objects and thus could not owe its origin to the plaintiff. Although this argument could plausibly apply to “the ordinary production of a photograph,”<sup>62</sup> the Court explained that the plaintiff’s photograph was unique because it was entirely the product of his own original mental conception, to which the plaintiff “gave visible form” by selecting Wilde’s pose, costume and other accessories, and carefully using light and shadow to arrive at the “desired expression.”<sup>63</sup> It was only from such original conception, arrangement, and orchestration that the plaintiff could have produced the picture.<sup>64</sup> Consequently, the plaintiff’s photograph was worthy of copyright protection and the Court allowed him to assert a copyright.<sup>65</sup>

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57. 111 U.S. at 53.

58. *Id.* at 56.

59. *Id.* at 56–57.

60. *Id.* at 57.

61. *Id.* at 58.

62. *Id.* at 59.

63. *Id.* at 55.

64. *Id.*

65. *Id.* at 60–61.

*Burrow-Giles* imparts two important lessons. First, in order to be copyrightable, a given subject matter must owe its origin to a particular identifiable author.<sup>66</sup> Accordingly, things that are already in existence at the time of alleged authorship cannot be copyrighted because no one can claim the credit for their creation. Second, the Court held that despite the general rule that pre-existing objects do not satisfy the “origination by the author” requirement, a particular selection and arrangement of such pre-existing items *can* qualify as copyrightable subject matter if that selection or arrangement is the author’s original conception.<sup>67</sup>

Once the *Burrow-Giles* Court established “originality” as a prerequisite for copyright protection, lower courts were required to distinguish original from unoriginal works, which they did by defining original works as works that display some artistic merit.<sup>68</sup> Such decisions were perfectly consistent with the *Burrow-Giles*’ Court’s language. As the *Burrow-Giles* Court noted, the “ordinary production of a photograph” by itself would not have been copyrightable, suggesting that genuinely creative works are distinct from merely “ordinary” works.<sup>69</sup> Of course, this approach would also leave many works unprotected simply because the judge or jury was unable to appreciate their artistic merit.

Nineteen years after *Burrow-Giles*, the Court substantially, but not completely, withdrew its requirement of artistic merit as a prerequisite for copyright. In *Bleistein v. Donaldson Lithographic Co.*, Justice Oliver Wendell Holmes wrote an opinion rejecting artistic merit as a prerequisite for copyright, and also adopted a “copyright-as-personality” approach.<sup>70</sup> In *Bleistein*, a circus owner sued the defendant for copying posters advertising the plaintiff’s circus.<sup>71</sup> Although this would likely be an open and shut case under modern copyright law, both the trial court and the court of appeals at that time rejected the plaintiff’s claim on the ground that advertisements could not possess the requisite artistic merit to be copyrightable subject matter.<sup>72</sup> The Supreme Court reversed and specifically stated that the Copyright Act did not exclude works simply because they were not considered to be “fine art”; “ordinary” works

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66. *Id.* at 58.

67. *Id.* at 59.

68. *See, e.g.*, *J.L. Mott Iron Works v. Clow*, 82 F. 316, 318 (7th Cir. 1897) (stating that a writing is uncopyrightable unless it has “some value as a composition, at least to the extent of serving some purpose other than as a mere advertisement or designation of the subject to which it is attached”); *see also* *Falk v. Donaldson*, 57 F. 32, 34 (C.C.S.D.N.Y. 1893).

69. *Burrow-Giles*, 111 U.S. at 59.

70. 188 U.S. 239 (1903).

71. *Id.* at 248.

72. *Id.* *See also* *Courier Lithographing Co. v. Donaldson Lithographing Co.*, 104 F. 993 (6th Cir. 1900).

could enjoy full protection as well.<sup>73</sup> Justice Holmes explained that the source of an author's protection under copyright law lies in the author's investment of unique individuality into his work. Copyrightable originality thus requires only some minimal level of unique expression by the author, some irreducible quantum that most people cannot define, but which they can nevertheless recognize when they see it:

[A work] is the personal reaction of an individual upon nature. Personality always contains something unique. It expresses its singularity even in handwriting, and a very modest grade of art has in it something irreducible, which is one man's alone. That something he may copyright unless there is a restriction in the words of the act.<sup>74</sup>

While this description distills the concept of originality down to a minimum threshold standard,<sup>75</sup> Holmes's opinion seems to rest more broadly on the idea that the author's personality is key. In doing so, he may have identified a practical truth—namely, true originality emanates only from within a person, and by definition outside sources alone cannot give rise to originality.<sup>76</sup>

Holmes' interpretation also built upon another early Supreme Court interpretation of originality. In *United States v. Steffens*,<sup>77</sup> one of the *Trade-Mark Cases*, the Court concluded that the Trade-Mark Act was unconstitutional because trademarks come into being only through extended periods of use, not from spontaneous creativity or design.<sup>78</sup> Because the establishment of a trademark relies only on the "priority of appropriation" and displays "no fancy or imagination, no genius, no laborious thought," trademarks do not meet the originality requirement of the Copyright Clause and are therefore not protectable under it.<sup>79</sup> Thus, in *Steffens*, as in *Bleistein*, a key criterion for copyright protection is the individual author's personality or creative thoughts as embodied in his

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73. *Bleistein*, 188 U.S. at 250.

74. *Id.*

75. *See, e.g.*, 1 NIMMER & NIMMER, *supra* note 52, § 2.01[B] (the *Bleistein* doctrine provides that any "distinguishable variation" from a prior work is sufficient originality for copyright protection "if such variation is the product of the author's independent efforts, and is more than merely trivial"); *see also* Alfred Bell & Co. v. Catalda Fine Arts, Inc., 191 F.2d 99 (2d Cir. 1951); Alfred C. Yen, *Restoring the Natural Law: Copyright as Labor and Possession*, 51 OHIO ST. L.J. 517, 522, 537 (1990).

76. The dictionary definition of originality supports this proposition: "relating to or constituting an origin or beginning . . . not secondary, derivative, or imitative . . . independent and creative in thought or action"; "the power of independent thought or constructive imagination." WEBSTER'S NEW COLLEGIATE DICTIONARY 803 (1979).

77. 100 U.S. 82 (1879).

78. *Id.* at 94.

79. *Id.*

work. A trademark, however, is merely a symbol, albeit a unique one, used for practical reasons—i.e., marking the product for sale—and, therefore, is not a product of originality or creativity.

The Supreme Court offered yet further insight into what constitutes originality in *Baker v. Selden*.<sup>80</sup> Denying copyright protection to a book providing an arrangement and explanation of a bookkeeping system, the Court noted that copyright is supposed to be “for the encouragement of learning,” not merely for the “encouragement of industry or labor unconnected to the advancement of learning and the sciences.”<sup>81</sup> The Court also emphasized that originality does not require novelty, but rather only independent creation: the “novelty of the art or thing described or explained has nothing to do with the validity of the copyright.”<sup>82</sup> Moreover, material drawn from the public domain will support a copyright if put together as a “distinguishable” or “substantial” variation of preexisting material.<sup>83</sup> Thus, the Court did not require that the author create something never done before. Instead, creativity required some expression or product that was the result of more than mere labor.<sup>84</sup> “All that is needed to satisfy both the Constitution and the statute is that the ‘author’ contributed something more than a ‘merely trivial’ variation, something recognizably ‘his own.’”<sup>85</sup> Together *Bleistein* and *Burrow-Giles* constitute the law that still governs copyrightable subject matter today, establishing that only a modest quantum of originality is required for copyright protection. Interestingly, these standards have generally not been considered controversial.

As for the scope of protection under the “copyright as personality” approach, former Justice Kaplan has suggested that the introduction of the

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80. 101 U.S. 99 (1879). See also BENJAMIN KAPLAN, AN UNHURRIED VIEW OF COPYRIGHT 64 (1967) (discussing *Baker v. Selden*). In his book, Professor Kaplan summarized the dilemma reflected in the *Baker* opinion and its resolution:

It is pointed out that the man who originated a workable system for producing and marketing paperbacks was more deserving than the authors or publishers of many sorry books put out in paperback which rest comfortably in copyright. Considering, however, the difficulties in demarking the limits of such copyrights of methods and the pervasive intrusion on competition which would be threatened, I daresay most of us would prefer to stay with the *Baker* case.

*Id.*

81. *Baker*, 101 U.S. at 105.

82. *Id.* at 102. See also *Roth Greeting Cards v. United Card Co.*, 429 F.2d 1106, 1110 (9th Cir. 1970); *Wihtol v. Wells*, 231 F.2d 550, 553 (7th Cir. 1956); *Alfred Bell & Co. v. Catalda Fine Arts, Inc.*, 191 F.2d 99, 102 (2d Cir. 1951); *Merritt Forbes Co. v. Newman Inv. Sec. Inc.*, 604 F. Supp. 943, 951 (S.D.N.Y. 1985).

83. *Gerlach-Barklow Co. v. Morris & Bendien, Inc.*, 23 F.2d 159, 161 (2d Cir. 1927).

84. *Baker*, 101 U.S. at 105.

85. *Alfred Bell*, 191 F.2d at 102–03 (citing *Chamberlin v. Uris Sales Corp.*, 150 F.2d 512, 513 (2d Cir. 1945)).

personality rationale led both to a greater disapproval of compositions heavily dependent on predecessors' works and to an increasing intolerance of copying in the nineteenth century.<sup>86</sup> This development led to an expansion in the scope of copyright protection over an increasing range of activities.<sup>87</sup> Examination of the first hundred years of United States copyright laws from 1790 to 1891 reveals movement from "rights simply in 'printing, reprinting, publishing and vending' to the additional rights of 'completing, copying, executing, finishing, and vending . . . and in the case of a dramatic composition, of publicly performing . . . [a]nd authors may reserve the right to dramatize or to translate their own works.'"<sup>88</sup>

## II. THE INDUSTRIOUS COLLECTION DOCTRINE

### A. *The Emergence of the Industrious Collection Doctrine Under the Copyright Act of 1909*

It was only after the Copyright Act of 1909 ("1909 Act") was enacted that the industrious collection doctrine truly made its first appearance in American copyright jurisprudence. The 1909 Act allowed putative authors to register their works for copyright protection. Under section 5 of the Act, the application for such protection had to identify their work from among certain specific categories. One of those categories was "directories."<sup>89</sup> Although the 1909 Act did not say that all categories of works listed in Section 5 were automatically copyrightable, some courts nevertheless inferred that directories must be copyrightable and that no further showing was required in order to benefit from copyright protection.<sup>90</sup> Thus was born the "industrious collection" doctrine, otherwise known as the "sweat of the brow" doctrine in American law.<sup>91</sup>

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86. Kaplan, *supra* note 80, at 22–25.

87. Ginsburg, *supra* note 11, at 1885.

88. *Id.*

89. 1909 Copyright Act, Pub. L. No. 349, 35 Stat. 1075 (1909) (previously codified at 17 U.S.C. §§ 1–216) (repealed 1976) [hereinafter the 1909 Act].

90. However, the legislative history of the 1909 Act might be interpreted as requiring creativity:

As thus interpreted, the word 'writings' would to-day in popular parlance be more nearly represented by the word 'works'; and this the bill adopts; referring back, however, to the word 'writings' by way of safe anchorage, but regarding this as including 'all forms of record in which the thought of an author may be recorded and from which it may be read or reproduced.'

S. REP. NO. 59-6187, at 4 (1907).

91. See *supra* Part I.A.

The first expression of the industrious collection doctrine in American jurisprudence can be traced back to the 1921 Second Circuit decision in *Jeweler's Circular Publishing Co. v. Keystone Publishing Co.*, in which the court upheld the copyright of a trade directory containing various jewelers' addresses and trademark illustrations, which were themselves unoriginal and non-copyrightable.<sup>92</sup> Stating that the "law is now well established" regarding copyright protection of directories in both England and the United States,<sup>93</sup> the court concluded that the right to copyright a book does not depend on whether the collected materials show literary skill or originality; rather, it depends on nothing "more than industrious collection."<sup>94</sup> Thus, although the directory lacked original thought and creativity, took no particular insight to produce, and evidenced no original form, according to the court:

[T]he man who goes through the streets of a town and puts down the names of each of the inhabitants, with their occupations and street numbers, acquires material of which he is the author. He produces by his labor a meritorious composition, in which he may obtain a copyright, and thus obtain the exclusive right of multiplying copies of his work.<sup>95</sup>

Accordingly, with this decision the court moved the concept of originality, with its focus on individuality and the creative process, to the background and placed renewed emphasis on labor and effort as a basis for copyrighting compilations.

Furthermore, like its eighteenth and nineteenth century predecessors, the industrious collection doctrine also extended copyright protection to the original author's investment in collecting the facts contained in the compilation, thereby providing protection that goes beyond simply the original selection and arrangement the compiler contributed. In addition, under the industrious collection doctrine, the only defense to infringement was independent creation. A subsequent compiler was "not entitled to take one word of information previously published," but had to "independently [work] out the matter for himself, so as to arrive at the same result from the same common sources of information."<sup>96</sup>

Although the doctrine therefore lacked justification under copyright theory, it was serviceable when most compilation related copyright liti-

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92. 281 F. 83 (2d Cir 1922). *See also* Donald v. Zack Meyer's TV Sales & Serv., 426 F.2d 1027 (5th Cir. 1970); Markham v. A.E. Borden Co., 206 F.2d 199 (1st Cir. 1953) (copying portion of telephone directory to prepare separate directory constitutes infringement).

93. *Jeweler's Circular Pub. Co.*, 281 F. at 85.

94. *Id.* at 88.

95. *Id.*

96. *Id.* at 89.

gation at that time dealt with old-fashioned databases such as telephone directories. Later courts seized upon the doctrine to deal with situations in which a compiler would make a substantial contribution of labor in collecting factual data only to have someone else freely reap the benefit.<sup>97</sup> In applying copyright protection in this manner, courts were probably trying to decrease the risk of a market failure or misappropriation in situations in which people spent large amounts of time and money compiling data. The abundance of cases that dealt with *Jeweler's*-type factual scenarios suggests that old-fashioned database piracy was probably a significant problem in the pre-digital era.<sup>98</sup> As shown elsewhere, unlike electronic database producers, old-fashioned database producers did not have the same non-legal tools and features at their disposal to overcome such a risk.<sup>99</sup> All they could do was offer data and organize it in a manner

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97. Professor Denicola argues that:

The effort of authorship can be effectively encouraged and rewarded only by linking the existence and extent of protection to the total labor of production. To focus on the superficial form of the final product to the exclusion of the effort expended in collecting the data presented in the work is to ignore the central contribution of the compiler.

Robert C. Denicola, *Copyright in Collections of Facts: A Theory for the Protection of Nonfiction Literary Works*, 81 COLUM. L. REV. 516, 530 (1981). This argument fails to consider that a work that does not meet the originality threshold is not entitled to protection regardless of how much labor was imputed. The value of that labor can be protected by market forces because people will expend labor only on what others will purchase. The law can thus foster efficiency by not granting unwarranted legal protection. See also *Patry*, *supra* note 52; *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539 (1985) (Brennan, J., dissenting). Justice Brennan reinforced this point in his *Harper & Row* dissent:

It is the labor of collecting, sifting, organizing, and reflecting that predominates in the creation of works of history such as this one. The value this labor produces lies primarily in the information and ideas revealed and not in the particular collocation of words through which the information and ideas are expressed. Copyright thus does not protect that which is often of most value in a work of history, and courts must resist the tendency to reject the fair use defense on the basis of their feeling that an author of history has been deprived of the full value of his or her labor.

*Id.* at 589.

98. See Symposium, *Bioinformatics and Intellectual Property Law, April 27, 2001—Boston, Massachusetts, Data Protection Statutes and Bioinformatics Databases*, 8 B.U.J. SCI. & TECH. L. 171, 172 (2002) (Professor Dennis Karjala, arguing that the reason for the existence of the sweat of the brow doctrine pre-*Feist* was probably market failure). See also Sarah Lum, Note, *Copyright Protection for Factual Compilations—Reviving the Misappropriation Doctrine*, 56 FORDHAM L. REV. 933, 952 (1988) (“Courts applying the sweat-of-the-brow standard of originality and courts enforcing the start-from-scratch rule of infringement implicitly rely on the misappropriation rationale because they emphasize the initial compiler’s investment of labor and protect it from piracy by subsequent compilers.”).

99. Miriam Bitton, *A New Outlook on the Economic Dimension of the Database Protection Debate*, 47 IDEA 93 (2006)

that best served users and hope that the courts would step in to protect them when necessary.

1. The Prohibition on Exclusive Ownership in Facts and Fact-Based Materials Under the Copyright Act of 1909 and the Emergence of a New Emphasis on the Public Domain

Despite the swing of copyright jurisprudence back toward the investment of labor end of the copyright continuum after the 1909 Act, an important, albeit often overlooked, piece in the historical puzzle is the treatment of factual works under the 1909 Act and the emergence of a new emphasis on the public domain. The prevailing approach under the 1909 Act, even in those courts adhering strictly to the industrious collection doctrine, was that facts and other indispensable materials are non-copyrightable. Evidence of the prevalence of these values can be found in copyright doctrines developed by the courts, most notably the idea/expression dichotomy and its twin, the fact/expression dichotomy, as well as the merger doctrine.

Furthermore, there was a growing awareness of and a new emphasis on the importance of maintaining a broad public domain of fact-based works. This analysis thus gives a broader perspective on the historical argument that the industrious collection doctrine has always been the ruling principle of copyright law in the United States and shows this assumption is not entirely valid.

a. The Fact/Expression Dichotomy

The fact/expression dichotomy and its twin, the idea/expression dichotomy, are classic doctrines of copyright law.<sup>100</sup> They reflect the balance that copyright law seeks to achieve between encouraging authors to create new works by protecting their original creations from unauthorized copying, while, at the same time, preserving the basic building blocks of facts and ideas for the public domain so that others may use

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100. See *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 344–45 (1991) (“The most fundamental axiom of copyright law is that ‘[n]o author may copyright his ideas or the facts he narrates.’” (quoting *Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 556 (1985))). See also Ginsburg, *supra* note 11. The author states:

[I]n principal, no matter how much original authorship the work displays, the facts and ideas it exposes are free for the taking. . . . But the very same facts and ideas may be divorced from the context imposed by the author, and restated or reshuffled by second comers, even if the author was the first to discover the facts or to propose the ideas. As a result of the “fact/expression or idea/expression dichotomy,” the *scope* of copyright protection in an informational work may be quite scanty.

*Id.* at 1868.

them to create new works.<sup>101</sup> The 1879 Supreme Court decision in *Baker v. Selden*<sup>102</sup> represents the beginning of the modern fact/expression doctrine.<sup>103</sup> In *Baker*, the Court emphasized that, while a copyright in a bookkeeping treatise protects the author's explanation of his bookkeeping system, it does not protect the bookkeeping system itself.<sup>104</sup>

Later decisions, most notably in *Nichols v. Universal Pictures Corp.*,<sup>105</sup> elaborated upon the doctrine and explored its difficulties as well. Judge Learned Hand, the author of the *Nichols* opinion, recognized that the major problem with the idea/expression dichotomy and, by implication, the fact/expression dichotomy, is uncertainty over where to draw the line between the idea or fact and the expression.<sup>106</sup> If expression means only the literal words used in a text, copyright law would protect a work only from verbatim copying and no more.<sup>107</sup> According to Judge Hand, what divides permissible borrowing of an "idea" from impermissible theft of an author's "expression" is a boundary that can never be fixed, but resides somewhere along a continuum of varying levels of abstraction.<sup>108</sup> The more abstractly an idea of a work is expressed, the less likely it is to be protected; conversely, the more concretely the idea is realized, the more likely it is protected expression.<sup>109</sup> As some recent court decisions have noted, Judge Hand's "abstractions test" is really not

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101. See Robert A. Gorman, *Fact or Fancy? The Implications for Copyright*, 29 J. COPYRIGHT SOC'Y U.S.A. 560, 560 (1982). See also *Nash v. CBS*, 899 F.2d 1537, 1540 (7th Cir. 1990).

The court stated:

Intellectual (and artistic) progress is possible only if each author builds on the work of others. No one invents even a tiny fraction of the ideas that make up our cultural heritage. Once a work has been written and published, any rule requiring people to compensate the author slows progress in literature and art, making useful expressions "too expensive," forcing authors to re-invent the wheel. . . . Every work uses scraps of thought from thousands of predecessors, far too many to compensate even if the legal system were frictionless, which it isn't.

*Id.* at 1540. See generally 4 NIMMER & NIMMER, *supra* note 52, § 13.03[B][2], at 13-69 to 13-70.

102. 101 U.S. 99 (1879). See Gorman, *supra* note 101, at 560.

103. See, e.g., *Triangle Publ'ns, Inc. v. Sports Eye, Inc.*, 415 F. Supp. 682 (E.D. Penn. 1976).

104. *Baker v. Selden*, 101 U.S. 99 (1879). See also 17 U.S.C. § 102(b) (2005) (incorporating *Baker*).

105. 45 F.2d 119 (2d Cir. 1930).

106. See *id.* at 121.

107. See *id.* (noting that copyright law "cannot be limited literally to the text, else a plagiarist would escape by immaterial variations").

108. See *id.*

109. See *id.*

a test, but an articulation of a line-drawing problem that must be addressed anew in each individual case.<sup>110</sup>

A seminal expression of the prohibition on copyrighting facts themselves came in the 1918 Supreme Court decision, *International News Service v. Associated Press*,<sup>111</sup> in which the Supreme Court announced a federal common-law “quasi-property” right in the dissemination of information. At issue in that case were the news reports the Associated Press (“AP”) published on the East Coast. Rival International News Service (“INS”) had been copying those reports and relaying them to its Midwest and West Coast papers simultaneously or even ahead of their receipt by the AP’s local counterparts. In rejecting the AP’s complaint, the Court made a clear, *constitutionally* based statement regarding the non-copyrightability of factual information:

It is not to be supposed that the framers of the Constitution, when they empowered Congress ‘to promote the progress of science and useful art, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries’ intended to confer upon one who might happen to be the first to report a historic event the exclusive right for any period to spread the knowledge of it.<sup>112</sup>

This generally accepted aversion to copyrighting facts carried through to the federal circuits and district courts as well. For example, in *Greenbie v. Noble*, the court was presented with the alleged copyright infringement of the plaintiff’s historical account of the life of Anna Ella Carroll, a member of the Lincoln cabinet.<sup>113</sup> The court carefully distinguished between the non-copyrightable factual elements of the historical work and the copyrightable expressive elements:

It is well settled that the facts concerning the actual life of an historic character are in the public domain and are not entitled to copyright protection. However, the fictionalizing of events and incidents in the life of an historic figure is the author’s original treatment of the life of such figure and is subject to protection against appropriation by others. In such case, however, the copyright does not protect the entire work but extends only to those

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110. See *Nash v. CBS*, 899 F.2d 1537, 1540 (7th Cir. 1990) (“Sometimes called the ‘abstractions test,’ Hand’s insight is not a ‘test’ at all. It is a clever way to pose the difficulties that require courts to avoid either extreme of the continuum of generality. It does little to help resolve a given case . . .”). See also *CCC Info. Servs. Inc. v. Maclean Hunter Mkt. Reports, Inc.*, 44 F.3d 61, 69 n.16 (2d Cir. 1994).

111. 248 U.S. 215 (1918).

112. *Id.* at 234 (citations omitted).

113. 151 F. Supp. 45 (S.D.N.Y. 1957).

matters which are the result of the author's independent labor, skill and ingenuity.<sup>114</sup>

In 1966, the Second Circuit employed similar reasoning in dealing with the protection of biographical works in *Rosemont Enterprises, Inc. v. Random House, Inc.*<sup>115</sup>:

Biographies, of course, are fundamentally personal histories and it is both reasonable and customary for biographies to refer to and utilize earlier works dealing with the subject of the work and occasionally to quote directly from such works. This practice is permitted because of the public benefit in encouraging the development of historical and biographical works and their public distribution . . . .<sup>116</sup>

Taking this rationale further, the *Rosemont* court, using language that would be repeated 25 years later in *Feist*,<sup>117</sup> vehemently rejected the view that a second-comer is absolutely precluded from saving time and effort by referring to and relying upon prior published material. It clearly rejected the industrious collection doctrine approach, stating that “[i]t is just such wasted effort that the proscription against the copyright of ideas and facts, and to a lesser extent the privilege of fair use, are designed to prevent.”<sup>118</sup>

#### b. The Merger Doctrine

The merger doctrine is a collateral branch of the idea/expression dichotomy, although it somewhat blurs the line between idea and expression. Under the merger doctrine, a court may exclude from copyright protection expressions of ideas that can be expressed only in one way or in a very limited number of ways based on the logic that copyrighting such an expression would effectively copyright the idea as well. Although it ostensibly prohibits copyrights in what would otherwise be protectable expression, the merger doctrine, like the idea/expression dichotomy, also reflects the law's general aversion to exclusive ownership in facts and their removal from the public domain.

The merger doctrine was first announced in *Morrissey v. Procter & Gamble Co.*,<sup>119</sup> a 1967 decision dealing with the alleged infringement of

114. *Id.* at 65 (citations omitted). *See also* *Lake v. Columbia Broad. Sys. Inc.*, 140 F. Supp. 707, 708–09 (S.D. Cal. 1956).

115. 366 F.2d 303 (2d Cir. 1966).

116. *Id.* at 307 (citations omitted). *See also* *Gardner v. Nizer*, 391 F. Supp. 940, 942 (S.D.N.Y. 1975); *Fuld v. Nat'l Broad. Co.*, 390 F. Supp. 877, 882 (S.D.N.Y. 1975).

117. *Feist Publ'n, Inc. v. Rural Tel. Serv. Co., Inc.*, 499 U.S. 340, 354 (1991).

118. *Rosemont*, 366 F.2d at 310.

119. 379 F.2d 675 (1st Cir. 1967).

the plaintiff's copyright in a set of rules for a "sweepstakes"-type contest. In holding for the defendants, the court stated:

When the uncopyrightable subject matter is very narrow, so that "the topic necessarily requires," if not only one form of expression, at best only a limited number, to permit copyrighting would mean that a party or parties, by copyrighting a mere handful of forms, could exhaust all possibilities of future use of the substance. In such circumstances it does not seem accurate to say that any particular form of expression comes from the subject matter. However, it is necessary to say that the subject matter would be appropriated by permitting the copyrighting of its expression. We cannot recognize copyright as a game of chess in which the public can be checkmated.<sup>120</sup>

c. The Emergence of New Emphasis on the Public Domain

As a number of other scholars have demonstrated,<sup>121</sup> since 1960 the United States Supreme Court has repeatedly emphasized the constitutional dimensions of the public domain, including the principle that it is the public that "owns" public domain materials and that these "ownership" rights are irrevocable—i.e., once something becomes part of the public domain, it will forever remain part of the public domain. For example, in the famous *Sears/Compco*<sup>122</sup> decisions, the Court held that the states could not prohibit copying of unpatentable public domain materials:

An unpatentable article, like an article on which the patent has expired, is in the public domain and may be made and sold by whoever chooses to do so. . . . To allow a State by use of its law of unfair competition to prevent the copying of an article which represents too slight an advance to be patented would be to permit the State to block off from the public something which federal law has said belongs to the public.<sup>123</sup>

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120. *Id.* at 678–79 (citations omitted). *See also* *Concrete Mach. Co. v. Classic Lawn Ornaments, Inc.*, 843 F.2d 600, 606 (1st Cir. 1988) ("When there is essentially only one way to express an idea, the idea and its expression are inseparable and copyright is no bar to copying that expression."); *Computer Assoc. Int'l, Inc. v. Altai, Inc.*, 982 F.2d 693, 709 (2d Cir. 1992).

121. *See, e.g.*, Tyler T. Ochoa, *Origins and Meanings of the Public Domain*, 28 U. DAYTON. L. REV. 215 (2002) (surveying the history and development of the public domain in intellectual property law).

122. *See* *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225 (1964); *Compco Corp. v. Day-Brite Lighting, Inc.*, 376 U.S. 234 (1964).

123. *Sears*, 376 U.S. at 231–32. *See also* *Graham v. John Deere Co.*, 383 U.S. 1, 5–6 (1966); *Kewanee Oil Co. v. Bicron Corp.*, 416 U.S. 470, 484 (1974). *But see* *Goldstein v. California*, 412 U.S. 546 (1973); Malla Pollack, *Unconstitutional Incontestability? The Inter-*

B. *The Industrious Collection Doctrine*  
*Under the 1976 Copyright Act*

After the introduction of the industrious collection doctrine more than eighty years ago and the concomitant swing back toward investment of labor as a justification for copyright protection, the lower courts began to struggle with the very underpinnings of the industrious collection doctrine, particularly after the enactment of the 1976 Copyright Act. Under the 1976 Act, courts were divided regarding the doctrine's continued viability. Although the majority of federal courts had never embraced the industrious collection doctrine,<sup>124</sup> the doctrine had considerable staying power in some circuits.<sup>125</sup> Some courts continued to apply the doctrine, viewing it as the only viable method by which to provide meaningful protection for factual compilations. Other courts tried to avoid any direct discussion of whether factual works are indeed copyrightable, preferring instead to assume that they are, and relying instead on the fair use defense as an indirect way of allowing defendants to freely use the underlying factual material.

Some courts, however, began showing overt uneasiness with the industrious collection doctrine and its questionable underpinnings, leading to confusion and internal inconsistency in the reasoning of their decisions. Other courts went even further and explicitly repudiated the doctrine, turning their focus instead back to the creative elements of a compilation as the touchstone of copyrightability. These unsuccessful attempts to reconcile the industrious collection doctrine with modern copyright jurisprudence, laid the groundwork for an outright repudiation of the industrious collection doctrine in *Feist*.

Despite these simultaneous but divergent trends in the copyrightability of compilations, lower courts continued to hold that actual facts and other information-based materials themselves are not copyrightable.

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*section of the Intellectual Property and Commerce Clauses of the Constitution: Beyond A Critique of Shakespeare Co. v. Silstar Corp.*, 18 SEATTLE U.L. REV. 259, 305–20 (1995) (describing *Goldstein* as inconsistent with public domain principles).

124. See *infra* Part II.B. 3–5. See also Ethan L. Wood, Note, *Copyrighting the Yellow Pages: Finding Originality in Factual Compilations*, 78 MINN. L. REV. 1319, 1322–23 (1994).

125. See, e.g., *Rural Tel. Serv. Co. v. Feist Publ'ns, Inc.*, 916 F.2d 718 (10th Cir. 1990), cert. granted, 498 U.S. 808 (1990); *S. Bell Tel. & Tel. Co. v. Associated Tel. Directory Publishers*, 756 F.2d 801 (11th Cir. 1985); *Ill. Bell Tel. Co. v. Haines & Co.*, 683 F. Supp. 1204 (N.D. Ill. 1988), *aff'd*, 905 F.2d 1081 (7th Cir. 1990), *vacated*, 499 U.S. 944 (1991); *Hutchinson Tel. Co. v. Fronteer Directory Co. of Minn.*, 586 F. Supp. 911 (D. Minn. 1984), *rev'd* 770 F.2d 128 (8th Cir. 1985); *Fin. Info. Inc. v. Moody's Investors Serv. Inc.*, 599 F. Supp. 994, 997–98 (S.D.N.Y. 1983), *rev'd*, 751 F.2d 501 (2d Cir. 1984); *Cent. Tel. Co. v. Johnson Publ'g Co.*, 526 F. Supp. 838 (D. Colo. 1981); *Quinto v. Legal Times, Inc.*, 506 F. Supp. 554, 559 (D.D.C. 1981); *Nw. Bell Tel. Co. v. Bedco, Inc.*, 501 F. Supp. 299, 301 (D. Minn. 1980); *Nat'l Research Bureau, Inc. v. Kucker*, 481 F. Supp. 612, 615 (S.D.N.Y. 1979); *Sw. Bell Tel. Co. v. Nationwide Indep. Directory Serv. Inc.*, 371 F. Supp. 900, 905 (W.D. Ark. 1974).

Courts interpreting the 1976 Act also continued to emphasize the importance of the public domain, pointing to its constitutional underpinnings. After promulgation of the 1976 Act, however, the case law on copyrightable subject matter began to give detailed, policy-based analyses as well. Unlike the industrious collection decisions that followed in the wake of the 1909 Act, which failed to grasp the purposes served by copyright law, post-1976 decisions were careful to adhere to the basic goals that copyright law aims to promote.

### 1. Copyrights in Facts and Other Information-Based Materials, Preservation of the Public Domain, and the Policy Underlying Copyright Law

Unlike the 1909 Act, the 1976 Copyright Act included an express definition of the term “compilation,” which, for the first time, drew an express statutory connection between compilations and “original works of authorship:”

A “compilation” is 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. The term “compilation” includes collective works.<sup>126</sup>

A separate section of the 1976 Act also clarified the scope of protection for compilations, specifying that:

The copyright in a compilation or derivative work extends only to the material contributed by the author of such work, as distinguished from the preexisting material employed in the work, and does not imply any exclusive right in the preexisting material. The copyright in such work is independent of, and does not affect or enlarge the scope, duration, ownership, or subsistence of, any copyright protection in the preexisting material.<sup>127</sup>

This definition expressly applies the originality requirement to compilations. It also compels a court to examine the nature of a compilation’s “selection, coordination, or arrangement” in order to determine whether the compilation is “an original work of authorship” protectable under 35 U.S.C. § 102(a).

Likewise, section 102(b) of the 1976 Act also expressly codified the common-law concepts of the idea/expression and fact/expression di-

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126. 17 U.S.C. § 101 (2005).

127. 17 U.S.C. § 103(b) (2005).

chotomies.<sup>128</sup> Under section 102(b), “in no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle or discovery.”<sup>129</sup> Sections 102(a) and 103 also implicitly codify the fact/expression dichotomy by according copyright protection only to “original works of authorship”<sup>130</sup> and granting protection of compilations and derivative works “only to the material contributed by the author of such work, as distinguished from the preexisting material employed in the work.”<sup>131</sup> The 1976 Act does not, however, resolve the ambiguities in the idea/expression doctrine that Judge Hand identified in the *Nichols* decision. Nowhere among the definitions in section 101 is there a definition of “fact” or “expression.”

Furthermore, the 1976 Act’s use of the phrase “original work of authorship,” which replaced the phrase “all the writings of an author” in the 1909 Act, was left purposefully undefined. Much like the Copyright Clause of the Constitution, the 1976 Act provides guidance in defining originality only in very general terms. Courts were thus left to develop an understanding of “originality” in their own terms. Nevertheless, the legislative history of the 1976 Act shows that Congress intended for courts to incorporate their own standards for the necessary level of originality, as established in their interpretations of the 1909 Act.<sup>132</sup> The legislative history of the 1976 Act also clarifies that the basic criteria for copyrightable subject matter (including original authorship) applies equally to both works containing preexisting material and those that are purely original, thus protecting only the original contribution of the compiler or arranger, and not any preexisting facts or data.<sup>133</sup>

After the enactment of the 1976 Act, courts dealing with historical and other fact-based works began to take a much more policy-oriented approach to these cases, growing increasingly aware of the risks of granting exclusive rights in facts and knowledge. They show a heightened understanding of the possible chilling effects that such exclusivity could have on other authors and late-comers who were trying to tackle other issues or pursue other endeavors. A few courts also began to emphasize the constitutional origins of the ideal of the public domain.

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128. See *supra* text accompanying notes 80–84.

129. 17 U.S.C. § 102(b) (2005).

130. 17 U.S.C. § 102(a).

131. 17 U.S.C. § 103(b).

132. H.R. REP. NO. 94-1476, at 51 (1976).

133. *Id.* at 57. See also *Harper & Row, Publ’g, Inc. v. Nation Enters.*, 471 U.S. 539, 581 (1985) (Brennan, J., dissenting) (“Copyright does not preclude others from using the ideas or information revealed by the author’s work. It pertains to the literary . . . form in which the author expressed intellectual concepts . . .”) (quoting S. Rep No. 93-983, at 107–08 (1974)).

For example, in *Alexander v. Haley*, the court dealt with, *inter alia*, the defendant's alleged infringement of the plaintiff's copyright in a novel and pamphlet that were amalgams of fact and fiction derived from the somber history of slavery in the United States.<sup>134</sup> In determining whether there had been a taking of copyrightable elements of the work, the court agreed with the defendant that "each of the similarities asserted by the plaintiff is in one or more of several categories of attributes of written work which are not subject to the protection of the copyright laws,"<sup>135</sup> pointing to three such categories in particular. First, the court rejected the plaintiff's claim of infringement based on "matters of historical or contemporary fact," for "[n]o claim of copyright protection can arise from the fact that the plaintiff has written about such historical and factual items. . . ."<sup>136</sup> Second, the court rejected the plaintiff's claim of infringement based on material traceable to common sources or to the public domain because such material "can no more be the subject of copyright protection than the use of a date or the name of a president or a more conventional piece of historical information."<sup>137</sup> Third, the court rejected copyright infringement claims based on borrowed scenes a faire,<sup>138</sup> which are incidents, characters, or settings that, as a practical matter, are indispensable to, or at least standard in, the treatment of a given topic.

Similarly, the courts perceived as the leading authorities in the formulation of United States' copyright laws, such as the Second and Ninth Circuits, have permitted extensive reliance on prior works of history and emphasized that factual information must remain in the public domain.<sup>139</sup> For instance, in *Hoehling v. Universal City Studios, Inc.*,<sup>140</sup> the Second Circuit held that second comers must be allowed to rely extensively on prior works of history, thus rejecting case law in other circuits that held

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134. 460 F. Supp. 40 (S.D.N.Y. 1978).

135. *Id.* at 44.

136. *Id.* at 44–45. *See also* Sid & Marty Krofft Television Prod. Inc. v. McDonald's Corp., 562 F.2d 1157, 1163 (9th Cir. 1977); Signo Trading Int'l Ltd. v. Gordon, 535 F. Supp. 362 (N.D. Cal. 1981); McMahon v. Prentice-Hall, Inc., 486 F. Supp. 1296 (E.D. Miss. 1980).

137. *Alexander*, 460 F. Supp. at 45.

138. *Id.* *See also* Landsberg v. Scrabble Crossword Game Players, Inc., 736 F.2d 485, 489 (9th Cir. 1984); *Hoehling v. Universal City Studios, Inc.*, 618 F.2d 972, 979 (2d Cir. 1980) (providing the underlying rationale for the scenes a faire doctrine: "[b]ecause it is virtually impossible to write about a particular historical era of fictional theme without employing certain 'stock' of standard literary devices, we have held that scenes a faire are not copyrightable as a matter of law"); *Reyher v. Children's Television Workshop*, 533 F.2d 87, 91 (2d Cir. 1976).

139. *See discussion supra* Part II.A.1, which deals, *inter alia*, with trends in the Second Circuit before the enactment of the 1976 Act. *See also* *Oxford Book Co. v. Coll. Entrance Book Co.*, 98 F.2d 688, 691 (2d Cir. 1938).

140. 618 F.2d 972. *See also* *Miller v. Universal City Studios, Inc.*, 650 F.2d 1365, 1369–71 (5th Cir. 1981).

the results of original research are copyrightable.<sup>141</sup> The appellee in *Hoehling* had written a literary account of the historical story of the Hindenburg. The appellee admitted that he consulted and relied on the appellant's more factual and objective account for some of the details in his work.

The Second Circuit's holding touched upon a fundamental policy underlying copyright law:

The rationale for this doctrine is that the cause of knowledge is best served when history is the common property of all, and each generation remains free to draw upon the discoveries and insights of the past. Accordingly, the *scope of copyright in historical accounts is narrow indeed, embracing no more than the author's original expression of particular facts and theories already in the public domain*. As the case before us illustrates, absent wholesale usurpation of another's expression, claims of copyright infringement where works of history are at issue are rarely successful.<sup>142</sup>

Conducting a detailed examination of, and ultimately rejecting, the plaintiff's various claims of authorship, the court concluded that under fundamental copyright policy all of the materials taken from Hoehling's book were non-copyrightable.<sup>143</sup>

In its 1984 decision, *Landsberg v. Scrabble Crossword Game Players, Inc.*, the Ninth Circuit followed the path set by the Second Circuit.<sup>144</sup> Because of the limited number of ways in which certain facts and factual information can be presented, the court held that protecting the public's interest in such limited modes of expression requires that the "similarity of expression may have to amount to verbatim reproduction or very close paraphrasing before a factual work will be deemed infringed."<sup>145</sup> Thus, in refusing to extend copyright protection to the *Landsberg* plaintiff's book of game strategy, the Ninth Circuit essentially indicated that there are

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141. The Second Circuit clearly repudiated such an approach in *Rosemont Enterprises Inc. v. Random House Inc.*, 366 F.2d 303, 310 (2d Cir. 1966). See *supra* text accompanying notes 115–118.

142. *Hoehling*, 618 F.2d at 974 (emphasis added). In *Hoehling*, the court noted that the "financial reward guaranteed to the copyright holder is but an incident of this general objective, rather than an end in itself. . . . Knowledge is expanded as well by granting new authors of historical works a relatively free hand to build upon the work of their predecessors." *Id.* at 980.

143. *Id.* at 974.

144. 736 F.2d 485 (9th Cir. 1984). See also *Ekern v. Sew/Fit Co.*, 622 F. Supp. 367, 370 (N.D. Ill. 1985); *Evans v. Wallace Berrie & Co.*, 681 F. Supp. 813, 817 (S.D. Fla. 1988).

145. *Landsberg*, 736 F.2d at 488.

only a very few ways to tell a person how to win a game of Scrabble.<sup>146</sup> Any other approach might allow the first few writers to tackle a factual topic to exhaust the limited modes of expression available to convey it. Consequently, these few writers would have the joint power exclusively to control the facts and ideas that otherwise would and should be part of the public domain.

In a later 1987 decision, *Worth v. Selchow & Righter Co.*,<sup>147</sup> the Ninth Circuit encountered a similar fact pattern and again pointed out that facts, like ideas, are never protected by copyright law. Absent a wholesale appropriation of another's expression of those facts, such that both the total concept and feel of the two works are *substantially* similar, no claim of infringement may be maintained.<sup>148</sup>

Likewise, in the wake of the 1976 Act, the Supreme Court touched upon the essence of modern copyright law in *Harper & Row, Publishers Inc. v. Nation Enterprises*, one of its most important copyright law decisions from the mid-1980's.<sup>149</sup> Although the Court's decision in *Harper & Row* was at face value concerned with the "fair use" defense as applied to *The Nation's* publication of numerous extracts from President Ford's biography, the Court also took this opportunity to discuss more generally exactly what protective scope fact-based works enjoyed under copyright law. Quoting from the Court's earlier opinion in *Sony Corp. of America v. Universal City Studios, Inc.*,<sup>150</sup> Justice O'Connor's opinion for the Court in *Harper & Row* touched upon the underlying principle of the Copyright Clause and its application to works of fiction and non-fiction alike:

[Copyright] is intended to motivate the creative activity of authors and inventors by the provision of a special reward, and to allow the public access to the products of their genius after the limited period of exclusive control has expired.<sup>151</sup>

O'Connor wrote that "no author may copyright facts or ideas,"<sup>152</sup> since "copyright is limited to those aspects of the work—termed 'expression'—that display the stamp of the author's originality."<sup>153</sup>

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146. *Id.* at 489.

147. 827 F.2d 569 (9th Cir. 1987).

148. *Id.* at 572 (affirming no infringement where trivia game referenced plaintiff's trivia books).

149. 471 U.S. 539 (1985).

150. 464 U.S. 417 (1984) (discussing the Patent and Copyright Clause and noting that one of the purposes of copyright is to place material into the public domain, although with a decidedly idiosyncratic view of the public domain).

151. *Harper & Row*, 471 U.S. at 546 (quoting *Sony*, 464 U.S. at 429).

152. *Id.* at 547.

153. *Id.*

Subsequent users are therefore free to “copy from a prior author’s work those constituent elements that are not original,” such as “facts, or materials in the public domain—as long as such use does not unfairly appropriate the author’s original contributions.”<sup>154</sup> By refusing to recognize a copyright in facts alone, the law is able to serve the public’s interest in the free flow of information.<sup>155</sup> Consequently, although the Supreme Court did not deal directly with the viability of the industrious collection doctrine, it did plant the seeds for its later decision in *Feist*.<sup>156</sup>

The *Harper & Row* Court also placed the idea/expression dichotomy within its broader constitutional context, pointing out that the doctrine “‘strike[s] a definitional balance between the First Amendment and the Copyright Act by permitting free communication of facts while still protecting an author’s expression.’”<sup>157</sup> Even Justice Brennan, in dissent, commented on why facts cannot be copyrighted. First noting the economic rationale for this rule, Justice Brennan explained that, “were an author able to prevent subsequent authors from using concepts, ideas, or facts contained in his or her work, the creative process would wither, and scholars would be forced into unproductive replication of the research of their predecessors.”<sup>158</sup> He then looked at the broader constitutional rationale for this rule, explaining that such a limitation on copyright protections also ensures consonance with important First Amendment values:

Our “profound national commitment to the principle that debate on public issues should be uninhibited, robust, and wide-open,” leaves no room for a statutory monopoly over information and ideas. . . . A broad dissemination of principles, ideas, and factual information is crucial to the robust public debate and informed citizenry that are “the essence of self-government.” And every citizen must be permitted freely to marshal ideas and facts in the advocacy of particular political choices.<sup>159</sup>

Using works of history as an example, Justice Brennan emphasized that, at its core, copyright law does not protect the most valuable aspect of factual works:

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154. *Id.* at 548.

155. *Id.*

156. *But see* Black’s Guide, Inc. v. Mediamerica, Inc., No. C-90-0819, 1990 U.S. Dist. LEXIS 16272, at \*9 (N.D. Cal. Aug. 15, 1990) (pointing to *Harper & Row*’s statement that “[c]reation of a nonfiction work, even a compilation of pure fact, entails originality” as supporting the “sweat” theory).

157. *Harper & Row*, 471 U.S. at 556 (quoting *Harper & Row Publishers, Inc. v. Nation Enters.*, 723 F.2d 195, 203 (2d Cir. 1983)).

158. *Id.* at 582.

159. *Id.* (citations omitted).

It is the labor of collecting, sifting, organizing, and reflecting that predominates in the creation of works of history such as this one. The value this labor produces lies primarily in the information and ideas revealed, and not in the particular collocation of words through which the information and ideas are expressed. Copyright thus does not protect that which is often of most value in a work of history . . . .<sup>160</sup>

Accordingly, the impulse to compensate authors for subsequent use of the information and ideas produced by their labors is entirely understandable, for there is an “inequity [that] seems to lurk in the idea that much of the fruit of the historian’s labor may be used without compensation.”<sup>161</sup> And yet, Justice Brennan continued, in a passage that would be adopted seven years later by the majority in *Feist*:

This, however, is not some unforeseen byproduct of a statutory scheme intended primarily to ensure a return for works of the imagination. Congress made the affirmative choice that the copyright laws should apply in this way: “Copyright does not preclude others from using the ideas or information revealed by the author’s work. It pertains to the literary . . . form in which the author expressed intellectual concepts.”<sup>162</sup>

## 2. The Decline of the Industrious Collection Doctrine

Although the industrious collection doctrine both originated in and was subsequently rejected by both the Second and Ninth Circuits,<sup>163</sup> the Seventh, Eighth and Tenth Circuits continued strongly to support the doctrine until the Supreme Court’s decision in *Feist*.

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160. *Id.* at 589.

161. *Id.*

162. *Id.* (quoting H.R. REP. No. 94-1476, at 56–57 (1976)). *But see* San Francisco Arts & Athletics, Inc. v. U.S. Olympic Comm’n, 483 U.S. 522 (1987) (holding 7–2 that the First Amendment did not restrict Congress’ power to grant a statutory trademark in the word “Olympic” to the United States Olympics Commission); Harper & Row Publishers, Inc. v. Nation Enters., 471 U.S. 539 (1985) (holding 6–3 that the First Amendment did not protect a magazine that published excerpts from Gerald Ford’s memoirs in advance of authorized publication date); Zacchini v. Scripps-Howard Broad. Co., 433 U.S. 562 (1977) (holding 5–4 that the First Amendment did not give a news station the right to broadcast a videotape of the plaintiff’s human cannonball act).

163. The Ninth Circuit originally embraced the industrious collection doctrine as a basis for copyright protection in *Leon v. Pacific Telephone & Telegraph Co.*, 91 F.2d 484 (9th Cir. 1937) (citing *Jeweler’s Circular Publishing Co. v. Keystone Publishing*, 281 F. 83 (2d Cir. 1922)).

A recent example of the doctrine at work is the Seventh Circuit decision in *Schroeder v. William Morrow & Co.*,<sup>164</sup> in which the court addressed the alleged copying of a gardening directory. The names and addresses in the garden directory were arranged alphabetically, requiring no original insights on the part of the compiler.<sup>165</sup> The court, citing the Second Circuit's now rejected application of the industrious collection doctrine in *Jeweler's Circular Publishing Co.*, found the directory warranted copyright protection. It asserted that "only industrious collection" is required since "copyright protects not the individual names and addresses but the compilation, the product of the compiler's industry,"<sup>166</sup> thus protecting the fruits of any substantial and independent effort, regardless of the originality or creativity involved.

Another relatively recent example of the industrious collection doctrine is the Eighth Circuit's decision in *United Telephone Co. of Missouri v. Johnson Publishing Co.*<sup>167</sup> The defendant had updated its own independent directory by verifying new listings obtained from the local telephone company's directory. The court found that by comparing its directory to and obtaining new subscriber listings from the telephone company's directory, the defendant had created a second work of substantial similarity to the telephone company's directory, thereby infringing the telephone company's legitimately asserted copyright in its directory.<sup>168</sup>

In addition to this line of cases overtly applying the industrious collection doctrine, there is a second line of cases that purported to require originality as a prerequisite for copyright protection, but, in practice, simply measured originality as a function of industry. For example, the Eighth Circuit's 1986 decision in *West Publishing Co. v. Mead Data Central, Inc.* revolved around Mead Data's proposal to cite page numbers from West Publishing's legal reporters in Mead Data's computerized LEXIS reports of the same opinions, thus providing "jump" or "pinpoint" citations to the cited passage's location in the West reporter.<sup>169</sup>

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164. 566 F.2d 3 (7th Cir. 1977). Prior to *Schroeder* the Seventh Circuit had already adopted the industrious collection doctrine in a few cases. See, e.g., *G.R. Leonard & Co. v. Stack*, 386 F.2d 38 (7th Cir. 1967); *Adventures in Good Eating, Inc. v. Best Places to Eat, Inc.*, 131 F.2d 809, 812-13 (7th Cir. 1942).

165. *Schroeder*, 566 F.2d at 6.

166. *Id.* at 5. *Accord* *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 916 F.2d 718 (10th Cir. 1990), *rev'd*, 499 U.S. 340 (1991); *Illinois Bell Tel. Co. v. Haines & Co.*, 905 F.2d 1081 (7th Cir. 1990), *vacated*, 111 S. Ct. 1408 (1991); *Hutchinson Tel. Co. v. Fronteer Directory Co. of Minn., Inc.*, 770 F.2d 128 (8th Cir. 1985).

167. 855 F.2d 604 (8th Cir. 1988).

168. *Id.* at 608-09.

169. 799 F.2d 1219, 1222 (8th Cir. 1986) ("*Mead*"). See also the post-*Feist* case *Oasis Publishing Co. v. West Publishing Co.*, 924 F. Supp. 918 (D. Minn. 1996). In *Oasis*, a competitor intended to convert the decisions in West's Florida Cases to a CD-ROM format using

The Eighth Circuit affirmed the lower court's grant of a preliminary injunction against Mead Data.<sup>170</sup> At first, the court correctly pointed out that an arrangement of preexisting materials may receive copyright protection and that "in each case the arrangement must be evaluated in light of the originality and intellectual-creation standards" of prior case law.<sup>171</sup> The court seemed to lose this standard, however, for although West Publishing had arranged the cases in a purely mechanical fashion with no original insight or creativity, the court stated that "a work need only be the product of a modicum of intellectual labor" to be protectable, a test that West's reporters easily met.<sup>172</sup> Because Mead had not alleged that West had copied its case arrangement from any other source, the court concluded that the requirement of originality posed no obstacles to copyright protection.<sup>173</sup> In response to the argument that this essentially granted copyright protection to page numbers, the court rejoined that "protection for the numbers is not sought for their own sake. It is sought, rather, because access to these particular numbers . . . would give users of LEXIS a large part of what West has spent so much labor and industry in compiling,"<sup>174</sup> thus overlooking the lack of originality in the arrangement of page numbers.<sup>175</sup>

As discussed below, however, many other courts decisions, and ultimately *Feist* itself, not only rejected the premise of the "industrious

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West's page numbering. West conceded that such parallel citations would be fair use but insisted that it would infringe upon West's compilation copyright. Tracking *Mead* the court found protectable creativity in West's arrangement of the cases first by states; then by court level; then by whether they are opinions, memoranda, or table dispositions; and finally alphabetically and chronologically. The court further held that internal pagination was an integral part of the arrangement because "by determining an internal page from each case in a given volume, the user could sort and determine West's arrangement with Oasis' CD-ROM product." *Id.* at 924, 926.

170. *Mead*, 799 F.2d at 1222.

171. *Id.* at 1225.

172. *Id.* at 1227.

173. *Id.*

174. *Id.*

175. *But see id.* at 1248 (Oliver, J., concurring in part and dissenting in part)(rejecting idea that "sequential publication of court opinions in the chronological order in which the cases are handed down" can be copyrightable under the 1976 Act or that "the scope of West's copyright is broad enough to protect the placement of arabic numbers on the pages of the volumes in which those opinions are published"); *see also* *Toro Co. v. R & R Prods. Co.*, 787 F.2d 1208, 1213 (8th Cir. 1986) (stating that pagination of public domain materials "is nothing more than public domain numbers," not an original work of authorship, unless displaying some meaningful pattern or judgment). Two other cases expressly deny copyright protection to the pagination of a public domain work. *See* *Eggers v. Sun Sales Corp.*, 263 F. 373 (2d Cir. 1920); *Banks Law Publ'g Co. v. Lawyers' Co-op. Publ'g Co.*, 169 F. 386 (2d Cir. 1909), *appeal dismissed*, 223 U.S. 738 (1911). *But see* Stephen C. Carlson, Note, *The Law and Economics of Star Pagination*, 2 GEO. MASON U.L. REV. 421 (1995) (arguing that economic analysis supports the Eighth Circuit decision in *West Publishing Co. v. Mead Data Central, Inc.*).

collection” doctrine but also required an affirmative showing that the allegedly infringed material demonstrates originality of authorship.<sup>176</sup>

### 3. The Fair Use Defense as a Shield Against Exclusive Ownership of Facts

A few courts have tried to avoid the question of database protection in general and the industrious collection doctrine in particular. Instead, they simply assumed that the work at issue was entitled to copyright protection and tried to resolve the disputes indirectly via the fair use defense as a means of “freeing” factual information for use by the public. These courts, however, went to such extraordinary lengths as to stretch the defense beyond its limits.

The fair use defense is a limitation on the copyright owner’s exclusive rights. Section 107 of the 1976 Act<sup>177</sup> provides that “the fair use of a copyrighted work . . . for purposes such as criticism, comment, news reporting, teaching . . . , scholarship, or research is not an infringement of copyright.” It also provides that “[i]n determining whether the use made in any particular case is a fair use the factors to be considered shall include—(1) the purpose and character of the use, including whether such use is for a commercial nature or is for nonprofit educational purposes; (2) the nature of the copyrighted work; (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and (4) the effect of the use upon the potential market for or value of the copyrighted work.”

The case of *New York Times Co. v. Roxbury Data Interface*<sup>178</sup> serves as a good example of this trend. The court dealt with whether a copyrighted work may be indexed by an outsider without the permission of the copyright holder. The plaintiff’s newspaper, *The New York Times*, published its own annual indices of citations to names and other data in newspaper issues from that year.<sup>179</sup> Finding plaintiff’s indices inadequate, the defendants published their own index to those indices but collated the citations over several years.<sup>180</sup> The court refused to grant a preliminary injunction, despite the defendant’s confession to copying names directly from the plaintiff’s directory:

[T]he substance of plaintiff’s copyrights . . . covers the *correlation* of personal names, with citations to the pages and columns

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176. See *infra* Part II.B.5.

177. 17 U.S.C. § 107 (2005).

178. *N.Y. Times Co. v. Roxbury Data Interface, Inc.*, 434 F. Supp. 217 (D.N.J. 1977) (“*Roxbury*”).

179. *Id.* at 218.

180. *Id.* at 219.

of The New York Times. Defendants have not copied any of these *correlations*, but, rather, have taken only the personal names appearing in the Times indexes.<sup>181</sup>

Because the defendant did not appropriate the corresponding citations to pages and columns, the court held that the defendant's index likely either was not an infringement or was excused under the doctrine of fair use.<sup>182</sup>

Although the court thus focused upon the expression inherent in the author's final product, it recognized that copyrightable expression goes beyond the mere superficial arrangement or ordering of the data.<sup>183</sup> Although correlations drawn between facts may still be criticized as lacking the required creativity,<sup>184</sup> the scope of protection afforded by this broadened view of what is copyrightable in a compilation of facts is still significantly more than that afforded under an unadulterated application of the originality requirement. Even under a pure application of the industrious collection doctrine, the court's attempt to distinguish between different forms of data is, at best, baseless. In terms of solely the labor invested or saved, copying only the names gathered by the plaintiffs is not in any meaningful way very different from copying the entire work. In both situations the defendant was simply free-riding on the labor already invested by the plaintiff. Something else must therefore have motivated the court's analysis—most likely the court's disinterest in dealing with the uneasy question of copyrightability of compilations.

The court's application of the four "fair use" factors in this case is particularly revealing. In a typical fair-use analysis, a court will look first at whether the alleged fair use is commercial or non-commercial. In *Roxbury*, however, the court looked first at the purpose and character of the use, identifying at least two main motives that the defendants had in copying from the plaintiff's indices: (1) to make money, and (2) to facili-

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181. *Id.* at 222 (emphasis added).

182. *Id.* at 226–27. The court stated that even if the personal names were independently copyrightable, the defendant's copying of them was excused under the doctrine of fair use. Because the defendant's publication referred back to the plaintiff's index, the court reasoned, "the effect of [defendant's publication] on the potential market for the Times Index appears slight or nonexistent." *Id.* at 226.

183. Although sufficient correlation arguably exists among data merely by their inclusion in a compilation, a court may nonetheless require additional elements of creative arrangement. *Fin. Info., Inc. v. Moody's Investors Serv., Inc.*, 808 F.2d 204, 208 n.3 (2d Cir. 1986).

184. When the arrangement of data truly reflects creative aspects of a compiler's work, a copyright is deserved. Most compilations, however, contain only exhaustive lists of names or other facts and do not display creativity in style or form. Because such arrangements are typically chronological, numerical, or alphabetical, they appear to reflect insufficient creativity. Alternatively, the layout of information in an alphabetical or similarly routine format should be dismissed as non-copyrightable because it is an expression indistinguishable from the underlying idea.

tate public access to useful information in the plaintiff's newspapers.<sup>185</sup> Although the court was undoubtedly correct in finding that the defendant's index would serve the public interest, this hardly seems significant since an alleged infringing work usually serves the public interest in at least some manner. Perhaps for this very reason, the typical "fair use" analysis does not begin by looking at the public interest. Instead, public interest is typically a factor reserved for the threshold question of whether the plaintiff's work is in fact protected by copyright, and not whether the defendant's work infringes that protection. Such a public interest analysis could have led the court to conclude that the plaintiff's work was factual and useful rather than creative in nature and thus was non-copyrightable material that should remain in the public domain. Nevertheless, in struggling to protect the free flow of facts, the court in *Roxbury* went to extraordinary lengths to emphasize the defendant's contribution to the public interest:

It seems likely that defendants' index will serve the public interest in the dissemination of information. Without defendants' index, an individual seeking to find articles which appeared in the New York Times on a certain person whose career spanned, say, forty years, would be compelled to search through forty volumes of the Times Index. . . . On its face, defendants' index appears to have the potential to save researchers a considerable amount of time and, thus, facilitate the public interest in the dissemination of information.<sup>186</sup>

Only as the second step in its fair use analysis did the court finally consider the nature of the plaintiffs' copyrighted work. The court found that the Times indices were basically a collection of facts, and "[s]ince the Times Index is a work more of diligence than of originality or inventiveness, defendants have greater license to use portions of the Times Index under the fair use doctrine."<sup>187</sup> Again, such explorations of a work's factual or creative nature should be conducted during the threshold copyrightability analysis. Classifying the work as one "more of diligence than of originality" suggests that, in the court's eyes, it does not deserve copyright protection in the first place, providing another indication to the court's struggle to accommodate the need to free the flow of facts and information.

As the third step in its fair use analysis, the court considered whether the amount and substance of the copied parts in relation to the copyrighted

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185. *Roxbury*, 434 F. Supp. at 221.

186. *Id.*

187. *Id.*

work as a whole were reasonable in light of the defendant's purpose in copying the plaintiff's work. Here the court emphasized again that the protected element in the plaintiff's work is the correlation of names to page citations, an element that the defendants had not copied.<sup>188</sup> The court thereby distinguished other directory cases that had employed the industrious collection doctrine, stressing that these other cases involved defendants who had copied the essence of the plaintiff's work in its entirety as a new and virtually identical directory in direct competition with the plaintiff's directory.<sup>189</sup>

The court also noted the extent to which producing the defendant's index required copying the names directly from the Times Index, and that for all practical purposes, defendants could not have published their index without such direct copying.<sup>190</sup> The plaintiff, however, correctly pointed out that the defendant could have obtained the same information directly from the newspaper issues, as had the compilers of the Times Index.<sup>191</sup> Had the court been loyal to the industrious collection doctrine, it would not have allowed the defendants such leeway because the Times Index required a significant expenditure of time and effort. The court, however, did not take this path:

If defendants have copied from the Times Index both the personal names and the correlated citations to the New York Times, plaintiffs' argument would have merit because defendants would have produced an abridgement or other version of the Times Index without expending efforts equal to the compilers of the Times Index.<sup>192</sup>

It is unclear, however, why the defendants would have had to appropriate both the names and their correlative citations under the industrious collection doctrine. Taking only the names saved the defendants a significant amount of resources and thus should have been prohibited under the industrious collection doctrine. Even the court itself acknowledged that its distinction between taking the names alone and taking both names and citations was "not determinative" to its "fair use" analysis, but simply "must be noted."<sup>193</sup> Nonetheless, the court's analysis suggests that copying of factual works will almost always survive a "fair use" analysis as long as there is no identical or substantial copying of the work.

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188. *Id.* at 222.

189. *Id.* at 222–23.

190. *Id.* at 223.

191. *Id.*

192. *Id.*

193. *Id.*

Interestingly, the court seems to suggest in a footnote that, regardless of the amount or substance of the material copied, what the defendants copied was not the true, copyrightable essence of the plaintiffs' work. The court essentially divided compilations into two categories, factual compilations and subjective compilations, hinting that the latter category merited greater protection than the former.<sup>194</sup> The former is mechanical compilation of facts while the latter is the product of the compiler's judgment and discretion in choosing which entries to include. Although the court was reluctant to take the next logical step and expressly declare the plaintiffs' indices to be mere non-selective compilations of fact warranting less protective scope the implications of the court's analysis are clear. Content selected on inevitably objective criteria for automatic inclusion in a compilation should remain in the public domain, for there are very few ways to create such compilations. The upshot of this distinction is that copyright law effectively protects only those elements of a work of the least public value.

Fourth and last, the court considered the effect of the defendants' name index on the potential market for the Times Index, which the court found to be slight.<sup>195</sup> The defendants' index was useless without the corresponding Times Index volume because only the Times indices themselves cited the actual articles.<sup>196</sup> The defendants' index therefore did not compete directly with the plaintiffs' indices.<sup>197</sup>

Even more revealing is the court's response to the argument that the defendants' index deprived the plaintiffs of their right to exploit their copyrights.<sup>198</sup> The court viewed this argument as stating that a copyrighted work cannot be indexed without permission from the copyright holder in much the same way that filmmakers cannot make a movie from a copyrighted play or novel. The court rejected this analogy, first because the defendants had not copied the essence of plaintiffs' work, the correlation of names and other data with page cites.<sup>199</sup> As discussed above, however, this explanation would fail under the industrious collection doctrine, for it is irrelevant that the work itself was not entirely duplicated. Second, the court rejected the analogy because the defendants' index had a different function and format.<sup>200</sup> Again, however, this fact is irrelevant under the industrious collection doctrine if the defendants drew significantly and extensively from the plaintiffs' copyrighted materials. Third, the court

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194. *Id.* at 222 n.2.

195. *Id.* at 223.

196. *Id.*

197. *Id.* at 224.

198. *Id.*

199. *Id.* at 224–25.

200. *Id.* at 225.

cited the fact that the Times Indices themselves contained nothing comparable to the defendants' index,<sup>201</sup> yet another factor that would have been irrelevant under a pure industrious collection analysis.<sup>202</sup>

#### 4. Questioning the Underpinnings of the Industrious Collection Doctrine

Some courts at both the appellate court and district court level started to explicitly doubt the foundation of the industrious collection doctrine. These courts included some that had previously applied the doctrine, such as the Seventh Circuit. The discussion that follows provides an illustration of such uneasiness at its peak, showing how courts voiced their concerns regarding the consistency of the industrious collection doctrine with copyright doctrine while at the same time "excusing" in economic terms their continued adherence to the doctrine as the only meaningful means of supporting compilation creators. These courts' decisions thus reflect confusion and internal inconsistency in their reasoning and final resolutions. In their own way, however, these cases prepared the ground for *Feist's* later explicit repudiation of the doctrine.

A good example is found in a 1982 district court decision, *National Business Lists, Inc. v. Dun & Bradstreet, Inc.*<sup>203</sup> The court started by describing the copyright protection of compilations as "a doctrine in search of conceptual underpinnings,"<sup>204</sup> and a "troublesome legal issue because it involves consideration of competing interests within the confines of a statutory scheme better suited to other literary works."<sup>205</sup> Describing the compiler's contribution to knowledge as the collection of information and not its arrangement, the court expressed concern about the compilation industry: "If [its] protection is limited solely to the form of expression, the economic incentives underlying the copyright laws are largely swept away."<sup>206</sup> The court admitted, however, that such economic concerns nevertheless do not explain why courts fall back on copyright

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201. *Id.* at 225.

202. *See, e.g.,* *Dow Jones & Co. v. Bd. of Trade*, 546 F. Supp. 113, 120 (S.D.N.Y. 1982) (applying "fair use" defense and stating that "[a]uthors of compilations, therefore, must be held to grant broader licenses for subsequent use than persons whose work is truly creative"); *Nat'l Bus. Lists, Inc. v. Dun & Bradstreet, Inc.*, 552 F. Supp. 89 (N.D. Ill. 1982) (using similar analysis). The *Dow Jones* court equivocated, however, about the legal basis for protecting compilations. At first, the court cited "the subjective judgment and selectivity involved" in the plaintiff's compilation but also noted the "effort" invested. 546 F. Supp. at 116.

203. 552 F. Supp. 89.

204. *Id.* at 93.

205. *Id.* at 91.

206. *Id.* at 92; *See also* *Black's Guide, Inc. v. Mediamerica, Inc.*, No. C-90-0819, 1990 U.S. Dist. LEXIS 16272, at \*8 (N.D. Cal. Aug. 15, 1990).

law when other legal doctrines, such as the misappropriation doctrine, can accomplish the same ends.<sup>207</sup>

The courts have generally rested, however, not on an analysis of copyright concepts but on the economic incentives premise of copyright law and the injustice of permitting one to appropriate the fruit of another's labor.<sup>208</sup>

Indeed, the court went even further, pointing to the questionable constitutionality of protecting factual compilations: "[A]lphabetizing of a list of names could hardly have been the originality which Congress meant to reward."<sup>209</sup> Its grave doubts notwithstanding, however, the court followed the industrious collection doctrine, providing a two-fold explanation for its decision. First, the court noted that "there appears to remain a lingering recognition that '[t]he second historian or second directory publisher cannot bodily appropriate the research of his predecessor.'"<sup>210</sup> Second, the court adverted to the fact that "the directory cases, rather than being a breed apart, are the most striking illustrations in copyright law that the misappropriation doctrine most commonly associated with *International News Service v. Associated Press*, has there long found a house if not a home."<sup>211</sup>

In another case, *Rand McNally & Co. v. Fleet Management Systems, Inc.*,<sup>212</sup> the court found Rand McNally's roadway mileage guide non-copyrightable as a compilation, and expressed its uneasiness with the industrious collection doctrine. This decision is unusual in a few respects.

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207. *Nat'l Bus. Lists*, 552 F. Supp. at 95.

208. *Id.* at 92. *See also* *Fin. Info. Inc. v. Moody's Investors Serv. Inc.*, 599 F. Supp. 994, 999 (S.D.N.Y. 1983), *rev'd*, 751 F.2d 501 (2d Cir. 1984). The court stated:

To deny copyright protection to FII's daily called bond service, even while preserving it for the annual cumulative volumes, would go a long way toward destroying FII's incentive to collect and assemble bond data in a speedy, systematic way for the convenience of its subscribers. Although according protection to compilations "does not fit nicely into the conceptual framework of copyright law" such protection of the compiler's diligence is essential "because that is the only protection which is meaningful."

*Id.* at 999 (citations omitted); Note, *Copyright Law—Will the Denial of Copyright to an Author's Research Impede Scholarship?* *Miller v. Universal Studios, Inc.*, 605 F.2d 1365 (5th Cir. 1981), 5 W. NEW. ENG. L. REV. 103, 121 (1982) ("Without . . . protection, few would undertake to compile a directory or draw a map since the substantial labor necessary to complete the task might be sacrificed by the wholesale appropriation of the work by a copier."). *But see* *Denicola, supra* note 97, at 530 (suggesting that the act of aggregating isolated pieces of information can be authorship, with the resulting collection of data being a work of authorship).

209. *Nat'l Bus. Lists*, 552 F. Supp. at 93.

210. *Id.* at 95 (quoting *Huie v. Nat'l Broad. Co.*, 184 F. Supp. 198 (S.D.N.Y. 1960)).

211. *Id.* (citation omitted)

212. 591 F. Supp. 726 (N.D. Ill. 1983).

On the one hand, the court accepted the long-established idea that “[c]ompilations of facts, however, have ‘long rested securely within the scope of copyright.’”<sup>213</sup> Nevertheless, relying on *National Business List*,<sup>214</sup> the court also acknowledged that “the rationale behind protecting such compilations, however, is unclear.”<sup>215</sup> On the other hand, despite its recognition that “another justification for protecting compilations of facts relies on the compiler’s ‘subjective judgment and selectivity in choosing items to a list,’”<sup>216</sup> the court asserted that factual compilations may still be protected by copyright by simple virtue of being the “result of some level of compiler effort and industry.”<sup>217</sup>

The court turned next to the question of whether the plaintiff had invested the requisite “considerable time and effort” in the creation of its roadway mileage guide. The court concluded that Rand McNally had not produced evidence of sufficient effort, because it was not clear what portion of their expense was spent updating the mileage tables and how much of the information used by Rand McNally was actually in the public domain and therefore not copyrightable.<sup>218</sup> Without evidence of adequate original efforts, the court could not find that Rand McNally’s contributions constituted sufficient effort.<sup>219</sup> The *Rand McNally* court not only placed the burden on the plaintiff to show the connection between his expenses and his work, but was also the first to ask whether the material in question had required more than a trivial effort to compile,<sup>220</sup> despite the fact that previous cases had simply assumed that all databases require intensive investment of labor.

While such borrowing from accessible public domain materials is very common in the database industry (with the exception of sole-source databases providers), until *Rand McNally* courts had rarely dealt with this question, perhaps because everyone had simply accepted as given that all databases were created in the same laborious manner as the compilations of old.<sup>221</sup> The *Rand McNally* court’s resurrection of this basic inquiry to deny the plaintiff copyright protection, along with its stated

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213. *Id.* at 731.

214. *See supra* text accompanying notes 203–211.

215. *Rand McNally & Co. v. Fleet Mgmt. Sys., Inc.*, 591 F. Supp. 726, 731 (D.C. Ill. 1983).

216. *Id.* at 732 n.4.

217. *Id.* at 733.

218. *Id.* at 733–34.

219. *Id.*

220. *Id.* at 733. *But see* *United Tel. Co. v. Johnson Publ’g Co.*, 671 F. Supp. 1514 (W.D. Miss. 1987)(finding telephone directories copyrightable but finding implicitly that creation of the directories probably involved no labor), *aff’d*, 855 F.2d 604 (8th Cir. 1988).

221. *See supra* text accompanying notes 97–99.

doubts about the underpinnings of the industrious collection doctrine, thus demonstrate its implicit uneasiness with this doctrine.<sup>222</sup>

Soon thereafter, the Seventh Circuit's 1985 decision in *Rockford Map Publishers, Inc. v. Directory Service Co. of Colorado*<sup>223</sup> declared that "copyright laws protect the work, not the amount of effort expended,"<sup>224</sup> thus de-emphasizing labor and finding originality only in creative arrangements. The defendant, relying on the industrious collection doctrine affirmed in *Schroeder*, argued that because the plaintiff had spent little time preparing its maps, its efforts were "not very 'industrious'" and its product was thus not copyrightable.<sup>225</sup> Rejecting this argument, the court emphasized that the amount of time invested is irrelevant;<sup>226</sup> after all, other types of work produced in an insignificant amount of time are nonetheless copyrightable.<sup>227</sup> Though the court appeared to reject the industrious collection doctrine as a basis for protection, the court actually made no explicit judgment as to whether labor, in and of itself, is protectable. Rather, the court simply reinterpreted *Jeweler's* and *Schroeder*, two classic industrious collection cases, as hinging on whether the compiler produced a "new" or original arrangement, not on whether the compiler had invested a significant amount of time and effort.<sup>228</sup>

*Rockford Map* created confusion within the Seventh Circuit probably because it studiously avoided adopting the industrious collection doctrine while at the same time borrowing heavily from classical industrious collection cases such as *Jeweler's*.<sup>229</sup> Indeed, a statement the court made in dicta at the end of its decision did nothing to ameliorate that confusion:

All concede, as Learned Hand said in *Jeweler's Circular* . . . that  
"a second compiler may check back his independent work upon

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222. In *Rand McNally & Co. v. Fleet Management Systems Inc.*, 600 F. Supp. 933 (N.D. Ill. 1984) ("*Rand McNally II*"), the district court granted in part Rand McNally's renewed motion for summary judgment, finding copyrightable its mileage table data and certain mileage segment data in its maps. *Id.* at 934-35, 946.

223. 768 F.2d 145 (7th Cir. 1985).

224. *Id.* at 148.

225. *Id.*

226. *Id.*

227. *Id.*

228. *Id.* The court found that the work was a "new" and therefore "original" arrangement of facts stating that "[t]he contribution of a collection of facts lies in their presentation, not in the facts themselves." *Id.* at 149. *But see* Black's Guide, Inc. v. Mediamerica, Inc., No. C-90-0819, 1990 U.S. Dist. LEXIS 16272, at \*8 (N.D. Cal. Aug. 15, 1990) (stating that the contribution of a collection of facts, particularly electronic ones, lies in the facts, and not in their presentation); Nat'l Bus. Lists, Inc. v. Dun & Bradstreet, Inc., 552 F. Supp. 89, 97 (N.D. Ill. 1982).

229. See *Rockford Map Publishers*, 768 F.2d at 148.

the original compilation.” The right to “check back” does not imply a right to start with the copyrighted work. Everyone must do the same basic work, the same “industrious collection.”<sup>230</sup>

In light of the court’s ruling in *Rockford Map*, the defendant in *Rand McNally I* brought a motion for reconsideration.<sup>231</sup> The court conceded that after *Rockford Map*, its previous reliance on the level of effort involved in compiling data was erroneous.<sup>232</sup> Instead, the proper analysis is whether the compilation as a whole evinced originality in its arrangement of facts.<sup>233</sup> Even under this latter rule, however, the court still found the guides copyrightable because the collection of numerous maps and the arrangement of data involved a “new arrangement or presentation of facts.”<sup>234</sup>

The *Rand McNally III* court expressed its uneasiness with the industrious collection doctrine, calling the law on factual compilation copyrights a “tangled web”<sup>235</sup> and admitting that it presents “intellectual difficulties in determining where protectable copying of facts ends and unlawful copying of the compilation begins.”<sup>236</sup> As to the continued viability of the industrious collection doctrine, however, it concluded that *Schroeder*<sup>237</sup> remained solid law in the Seventh Circuit,<sup>238</sup> and rejected the proposition that *Rockford Map* moved away from concentrating on labor expended to concentrating on originality.<sup>239</sup> Trying to reconcile *Rockford Map*’s confusing pronouncements,<sup>240</sup> the *Rand McNally III* court tried to draw formalistic distinctions between infringing map-makers and infringing compilers<sup>241</sup>—a distinction that ultimately fails to satisfy anyone.<sup>242</sup> Ignoring the conflicting case law and the 1976 Act’s express

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230. *Id.* at 149.

231. *Rand McNally & Co. v. Fleet Mgmt. Sys., Inc.*, 634 F. Supp. 604–05 (N.D. Ill. 1986) (“*Rand McNally III*”).

232. *Id.* at 606.

233. *Id.* at 606–07.

234. *Id.* at 607.

235. *Id.* at 608.

236. *Id.*

237. *Schroeder v. William Morrow & Co.*, 566 F.2d 3 (7th Cir. 1977).

238. *Rand McNally III*, 634 F. Supp. at 608.

239. *Id.*

240. *See supra* text accompanying notes 228–229.

241. *Rand McNally III*, 634 F. Supp. at 608.

242. Another district court case in the Seventh Circuit expressly rejected the idea that *Rockford Map* overruled the industrious collection doctrine, finding instead that it actually affirmed the doctrine’s viability. *Clark Equip. Co. v. Lift Parts Mfg. Co.*, 32 Copyright L. Rep. (CCH) P 20, 528, 530 (N.D. Ill. 1986). *See also* *Ill. Bell Tel. Co. v. Haines & Co.*, 683 F. Supp. 1204, 1207–10 (N.D. Ill. 1988) (adopting *Rand McNally III*’s holding that *Rockford Map* did not repudiate earlier authority for copyright protection of factual compilations in a white pages directory infringement case), *aff’d*, 905 F.2d 1081 (7th Cir. 1990). *Clark* held that the Copyright Act expressly protects compilations and that the Seventh Circuit has therefore

requirement that compilations constitute *original* works of authorship, the *Rand McNally III* court instead relied exclusively on the industrious collection doctrine as the basis for protection.

The Eleventh Circuit showed its own discomfort with the industrious collection doctrine in *Southern Bell Telephone & Telegraph Co. v. Associated Telephone Directory Publishers*.<sup>243</sup> There, the court found the Atlanta Yellow Pages to be a copyrightable work of original authorship because of its subjective selection, organization, and arrangement of pre-existing materials. Although the court discounted the substantial line of cases relying on the industrious collection doctrine, it misinterpreted the originality requirement since the arrangement and selection of data in a typical Yellow Pages directory is mechanical and conventional, not original, and although laborious, does not reflect the compiler's personality. Moreover, notwithstanding its apparent rejection of the industrious collection doctrine, the court expressly refused to reject the notion that "the principle characterized as the 'sweat of the brow' theory is to apply in a determination of originality under the act."<sup>244</sup> Declining to choose between a limited or more expansive standard of originality under the Act, the court opined that originality should "be tested by the nature of the selection and arrangement of the preexisting material in the compilation"<sup>245</sup> and that "protection of original research of information in the public domain is better afforded under an unfair competition theory."<sup>246</sup>

##### 5. Repudiation of the Industrious Collection Doctrine and the Minimum Level of Originality Necessary for Copyright Protection of Compilations

After the 1976 Act was implemented, most courts rejected the industrious collection doctrine,<sup>247</sup> requiring instead that compilations contain sufficient creativity in their "select[ion], coordinate[ion] or arrange[ment]" as to render them "original works of authorship" entitled to copyright protection.<sup>248</sup> The line, however, between mere labor producing

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"recognize[d] and protect[ed] such industrious collections as well." *Clark*, 32 Copyright L. Rep. (CCH) P 20, 531 (agreeing with *Rand McNally III* that industrious collection remains valid) (alteration in original).

243. 756 F. 2d 801 (11th Cir. 1985).

244. *Id.* at 809 n.9.

245. *Id.*

246. *Id.* See also *Bellsouth Adver. & Publ'g Corp. v. Donnelley Info. Publ'g Inc.*, 719 F. Supp. 1551, 1557 (S.D. Fla. 1988) ("Although the Court prefers the 'selection, coordination or arrangement' test, it is not clear which test the Eleventh Circuit adopted in *Assoc. Tel. Directory*.").

247. See, e.g., *Worth v. Selchow & Righter Co.*, 827 F. 2d 569, 572-73 (9th Cir. 1987); *Fin. Info. Inc. v. Moody's Investors Serv. Inc.*, 808 F. 2d 204, 207 (2d Cir. 1986); *Eckes v. Card Prices Update*, 736 F.2d 859, 862 (2d Cir. 1984).

248. 17 U.S.C. § 101 (2005).

little or no originality and “intellectual labor” producing original and newly created material can be very fine.

The basic problem with the industrious collection doctrine was that it failed to incorporate the concept of originality, as understood in copyright law.<sup>249</sup> Courts that rejected the industrious collection doctrine, however, began to draw the line between “intellectual labor” and mere unoriginal labor according to the fundamental principles underlying copyright law. These courts understood that facts do not owe their origin to the author who simply describes them. They also recognized that originality is not only a constitutionally mandated requirement but also a requirement that serves the important function of balancing the public’s interest in stimulating creative activity against the public’s need for unrestricted access to information by allowing subsequent authors to build upon and add to prior knowledge without unnecessary duplication of effort. These courts therefore established a minimum threshold of originality, with an emphasis on “minimum,” to deny copyright protection to fact compilations that failed to exhibit some level of subjective arrangement, thoughtful selection, or creativity.

The 1978 Ninth Circuit decision in *United States v. Hamilton*<sup>250</sup> provided the first explicit rejection of the industrious collection doctrine.<sup>251</sup> A Third Circuit decision from the 1950s had held that only those portions of a map that were recorded by direct observation of the geography described could be copyrighted.<sup>252</sup> The *Hamilton* court, however, found this rule theoretically unsound and instead made clear that only originality is the basis for a copyright:

Originality requires only that the work display “something irreducible,” which is one man’s alone . . . not that the work be novel in comparison with the works of others. . . . When a work displays a significant element of compilation, that element is protectable even though the individual components of the work

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249. See, e.g., 1 NIMMER & NIMMER, *supra* note 52, § 3.04 (“One who explores obscure archives and who finds and brings to the light of public knowledge little known facts or other public domain materials has undoubtedly performed a socially useful service, but such service in itself does not render the finder an ‘author.’ ”).

250. 583 F.2d 448 (9th Cir. 1978).

251. The defendant was charged with the counts of willful and knowing infringement of a copyright in violation of 17 U.S.C. § 104. The defendant admitted making and selling reproductions of a copyrighted map. The lower court found the defendant guilty and imposed a fine. The defendant appealed on the grounds that the copyrighted map was not original enough material to deserve copyright protection.

252. *Amsterdam v. Triangle Publ’ns*, 93 F. Supp. 79, 82 (E.D. Pa. 1950), *aff’d*, 189 F.2d 104 (3d Cir. 1951).

may not be, for originality may be found in taking the commonplace and making it into a new combination or arrangement.<sup>253</sup>

The *Hamilton* court further cited early cases recognizing that “(t)he elements of the copyright (in a map) consist in the selection, arrangement, and presentation of the component parts.”<sup>254</sup>

Explicit and direct rejection of the industrious collection doctrine also appeared in the Fifth Circuit’s *Miller v. Universal City Studios, Inc.*<sup>255</sup> decision, in which the court held that research itself is merely an alternative form of fact compilation and therefore also non-copyrightable. In doing so, the court provided for the first time a full-blown legislative, constitutional, economic, and policy-based analysis repudiating the industrious collection doctrine. Comparing the collection of facts to the compilation of names and addresses in a directory, the circuit court concluded that copyrightability for such a work rests “on the originality of the selection and arrangement of factual material, rather than on the industriousness of the efforts to develop the information.”<sup>256</sup> Lending protection to the industry of gathering facts or other non-copyrightable material would essentially protect the material itself, in violation of fundamental principles of copyright law.<sup>257</sup>

The court started its analysis with the idea/expression dichotomy, explaining that it “derives from the concept of originality which is the premise of copyright law.”<sup>258</sup> Originality, the court continued, is a constitutional requirement, as illustrated by the Copyright Clause’s use of the word “Author.”<sup>259</sup> Facts, however, do not meet the threshold of originality because:

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253. *Hamilton*, 583 F.2d 448, 451. See also *Signo Trading Int’l Ltd. v. Gordon*, 535 F. Supp. 362, 364 (N.D. Cal. 1981) (“[O]riginality is lacking from Plaintiff’s translations of the single words and short phrases . . . [Translation] may have involved considerable effort by Plaintiff, but effort is not the touchstone of originality.”); *Roy Export Co. v. Columbia Broad. Sys. Inc.*, 672 F.2d 1095, 1103 (2d Cir. 1982) (“[P]rotection is available . . . for what he has added to the component works, or for his skill and creativity in selecting and assembling an original arrangement of those works, even if no new material is added.”).

254. 583 F.2d at 452 (quoting *Gen. Drafting Co. v. Andrews*, 37 F.2d 54, 55 (2d Cir. 1930)). See also *Emerson v. Davies*, 8 F. Cas., 615, 619 (C.C.D. Mass. 1845) (No. 4436).

255. 650 F.2d 1365 (5th Cir. 1981). See also *Southern Bell Tel. & Tel. Co. v. Associated Tel. Dir. Publishers*, 756 F.2d 801, 809 (11th Cir. 1985).

256. *Miller*, 650 F.2d at 1369.

257. *Id.* at 1372. See also *id.* at 1370 (“[H]owever difficult it may be to reconcile these cases with the principle that facts are not copyrightable, the special protection granted directories under the copyright law has generally not been applied to other factual endeavors.”) (citation omitted).

258. *Id.* at 1368.

259. *Id.* (citing U.S. Const. art. I, § 8, cl. 8). See also *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 58 (1884)).

[A] fact does not originate with the author of a book describing the fact. . . . “The discoverer merely finds and records. He may not claim that the facts are ‘original’ with him although there may be originality and hence authorship in the manner of reporting, i.e., the ‘expression,’ of the facts.” Thus, since facts do not owe their origin to any individual, they may not be copyrighted and are part of the public domain available to every person.<sup>260</sup>

Although the court was aware of the possibility of diminished incentives to create databases, it understood that the only question at bar was whether the copyright laws were intended to provide such protection.<sup>261</sup> Under the law, the only element of a compilation of facts that can be protected is the original selection and arrangement.<sup>262</sup> Otherwise, directories are a problematic breed that cannot be reconciled with the principle that facts are non-copyrightable; the “mere use of the information contained in a directory without a substantial copying of the format does not constitute infringement.”<sup>263</sup> Accordingly, the *Miller* court found the Second Circuit’s approach in *Hoehling* and *Rosemont* more in line with the purpose and intended scope of copyright law:

The line drawn between uncopyrightable facts and copyrightable expression of facts serves an important purpose in copyright law. It provides a means of balancing the public’s interest in stimulating creative activity, as embodied in the Copyright Clause, against the public’s need for unrestricted access to information. It allows a subsequent author to build upon and add to prior accomplishments without unnecessary duplication of effort.<sup>264</sup>

Another Second Circuit case, *Eckes v. Card Prices Update*,<sup>265</sup> also rejected the industrious collection doctrine. Ignoring the economic concerns about industry incentives, the court rested its holding squarely on the “selection, creativity, and judgment” it found in the baseball card guidebook at issue in the case.<sup>266</sup> Although the Second Circuit found a tension between the proposition that facts alone are not copyrightable while a collection of them is, it resolved this tension by applying the rule

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260. *Miller*, 650 F.2d at 1368–69 (citation omitted).

261. *Id.* at 1369.

262. *Id.* at 1368.

263. *Id.* at 1369–70.

264. *Id.* at 1371–72.

265. 736 F.2d 859 (2d Cir. 1984).

266. *Id.* at 863.

that only original selection or creative arrangement may be protected.<sup>267</sup> This solution was ultimately adopted seven years later in *Feist*.<sup>268</sup>

The Ninth Circuit followed the steps of the Second Circuit in *Eckes* in its 1987 decision *Worth v. Selchow & Righter Co.*<sup>269</sup> *Worth* is notable for the minimal scope of protection it affords compilations of facts. It is also instructive because of its endorsement of the original selection or arrangement requirement<sup>270</sup> and its reliance on cases disavowing the industrious collection doctrine.<sup>271</sup> In *Worth*, the Ninth Circuit permitted the creators of the game Trivial Pursuit to use two volumes of *Worth's* copyrighted encyclopedia as a source of factual information.<sup>272</sup> Even though the accused infringers appropriated approximately 4,000 of the encyclopedia's 12,000 discrete entries the district court held that the scope of *Worth's* copyright did not encompass the appropriated material.<sup>273</sup> In affirming, the Ninth Circuit held that the discovery of a fact, regardless of the quantum of labor and expense invested in that discovery, is simply not a copyrightable work of an "author."<sup>274</sup> Quoting from the Second Circuit's *Eckes* decision, the court made clear:

We . . . cannot subscribe to the view that an author is absolutely precluded from saving time and effort by referring to and relying upon prior published material. . . . It is just such wasted effort that the proscription against the copyright of ideas and facts, and to a lesser extent the privilege of fair use, are designed to prevent.<sup>275</sup>

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267. *Id.* at 862 ("[T]he very vocabulary of copyright law is ill suited to analyzing property rights in works of nonfiction.' Indeed, while this court has recognized the 'distinction between fact and expression is not always easy to draw,' we have been particularly restrictive in the protection of non-fiction works. . . .") (citations omitted). *See also* *Fin. Info., Inc. v. Moody's Investors Serv., Inc.*, 751 F.2d 501, 510 (2d Cir. 1984)(Newman, J., concurring) ("[The] view that copyright protection should be extended solely because of laborious effort is no reason for us to disregard the statutory criteria that Congress articulated in 1976 when it enacted the current statute. The 'sweat of the brow' rationale is no substitute for meeting of those statutory criteria."); *Fin. Info., Inc. v. Moody's Investors Serv., Inc.*, 808 F.2d 204, 207 (2d Cir. 1986)(finding creativity in selection and arrangement of factual work but stating that granting copyrights based solely on labor in compiling facts "would risk putting large areas of factual research material off limits and threaten the public's unrestrained access to information").

268. 499 U.S. 340 (1991).

269. 827 F.2d 569 (9th Cir. 1987).

270. *Id.* at 573.

271. *Id.* at 572-73.

272. *Id.*

273. *Id.*

274. *Id.* at 573.

275. *Id.* at 574 (citing *Rosemont Enters., Inc. v. Random House, Inc.*, 366 F.2d 303, 310 (2d Cir. 1966)). *See also* *Black's Guide, Inc. v. Mediamerica, Inc.*, No. C-90-0819, 1990 U.S. Dist. LEXIS 16272, at \*10 (N.D. Cal. Aug. 15, 1990) ("It is clear from subsequent cases,

In addition to these court decisions, the Copyright Office's registration practices during the years that preceded *Feist* are also informative. In its report on legal protection of databases, the Copyright Office outlined its registration practices during these pre-*Feist* years.<sup>276</sup> One of the primary roles of the Copyright Office is to register copyright claims in works of authorship.<sup>277</sup> Generally, the Copyright Office has always applied an originality standard. Until the late 1980s, however, based on the industrious collection doctrine it also registered compilations including, but not limited to, telephone directories and other factual databases.<sup>278</sup> Such works, however, were registered under a "rule of doubt"; when the Copyright Office had a genuine question about the copyrightability of a work, the Office would make note of this doubt.<sup>279</sup> This practice obviously stemmed from the fact that the case law at the time simultaneously upheld both the industrious collection doctrine and the 1976 Act's explicit originality standard.<sup>280</sup>

Beginning in 1987, however, the Copyright Office began to question the copyrightability of works where the industrious collection doctrine was the only basis for registration.<sup>281</sup> By 1989, it had abandoned this standard for most compilations, continuing to apply it only to works like commercial telephone, street, and business directories and parts catalogues and inventory lists that were not "clearly *de minimis*" (a practice that reflected the fact that some courts continued to uphold the copyrightability of such works based on the industrious collection doctrine).<sup>282</sup> Thus, database producers had fair warning that copyright protection might not extend to the facts contained in their databases.

In light of this long, complex, and vacillating history of copyright protection of databases in the U.S., one must wonder whether the Supreme

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however, that the rationale which was behind the *Leon* decision . . . more recently has been rejected, at least insofar as it involved the appropriation of labor and skill"); *Cooling Sys. & Flexibles v. Stuart Radiator*, 777 F.2d 485, 491 (9th Cir. 1985) ("An author can claim to 'own' only an original manner of expressing ideas or an original arrangement of facts.").

276. U.S. COPYRIGHT OFFICE, REPORT ON LEGAL PROTECTION FOR DATABASES 29–38 (1997).

277. 17 U.S.C. §§ 410, 701(a) (2005). Although not a prerequisite to copyright protection, registration provides many benefits such as public notice, *prima facie* evidence of copyrightability (17 U.S.C. § 410(c)), standing to sue for infringement (17 U.S.C. § 411(a)), better remedies for infringement (17 U.S.C. § 412), and priority in the event of conflicting transfers (17 U.S.C. § 205). Therefore, many commercial copyright owners, including database producers, regularly register their works with the Copyright Office.

278. U.S. COPYRIGHT OFFICE, *supra* note 276, at 32.

279. *Id.* at 30, 32–33.

280. *Id.* at 32.

281. *Id.* at 32–34.

282. *Id.* at 32, 34.

Court really did “drop a bomb”<sup>283</sup> when it issued its decision in *Feist*. As the discussion above shows, the legal landscape prior to *Feist* was much more complex than what has been argued on either side of the *Feist* debate. The pre-*Feist* courts’ constant struggle over the industrious collection doctrine set the stage for the Supreme Court’s consideration of the issue. The Supreme Court ultimately granted certiorari in a Tenth Circuit case that applied the industrious collection doctrine to protect a white pages telephone directory against wholesale copying.<sup>284</sup>

### III. *FEIST PUBLICATIONS INC. v. RURAL TELEPHONE SERVICE CO.*

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

*Feist Publications v. Rural Telephone Service Co.*<sup>285</sup> is recognized as the Supreme Court’s first attempt to bring order to a very complex and increasingly critical issue—the application of copyright law to factual compilations. In *Feist*, the Court found a white pages telephone directory to be non-copyrightable, holding that the sole standard for protection under U.S. copyright law is creative originality. With this decision, a unanimous Supreme Court sounded the death knell for the “sweat of the brow doctrine,” also known as the industrious collection doctrine. Although, at face value, this decision clarified the law by invalidating these doctrines as methods of applying copyright to factual compilations, this clarification did not mean that copyright’s treatment of factual compilations became predictable or stable.

*Feist* involved the copyrightability of a white pages telephone directory. The plaintiff and respondent, Rural Telephone Service (“Rural”), held a monopoly franchise on telephone service to a number of communities in Kansas. Pursuant to state law, Rural produced an annually updated telephone directory that contained a typical white pages section.<sup>286</sup> The defendant and petitioner, Feist Publication (“Feist”), produced area-wide telephone books covering eleven different service areas. Feist’s directory overlapped with a portion of the area that Rural serviced.<sup>287</sup>

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283. Denise R. Polivy, *Feist Applied: Imagination Protects, But Perspiration Persists—the Bases of Copyright Protection for Factual Compilations*, 8 *FORDHAM INTELL. PROP. MEDIA & ENT. L.J.* 773, 782 (1998).

284. *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 916 F.2d 718 (10th Cir. 1990), cert. granted, 498 U.S. 808 (1990), rev’d 499 U.S. 340 (1991).

285. 499 U.S. 340 (1991).

286. *Id.* at 342.

287. *Id.* at 342–43.

In preparing its directory, Feist licensed the use of the white pages of ten of the eleven telephone companies whose listings it wished to duplicate; only Rural refused to license its telephone listings. This refusal, however, did not deter Feist; Feist simply took the desired portion of Rural's listings and incorporated it into its own directory.<sup>288</sup> Rural successfully sued Feist for copyright infringement, and the Tenth Circuit affirmed.<sup>289</sup>

The Supreme Court granted certiorari, presumably to resolve the split that the circuit courts had found so troubling.<sup>290</sup> The Court had two options for resolving this conflict. It could either uphold the "sweat of the brow" doctrine and extend meaningful protection to Rural or it could apply the creative selection principle, derived from decisions such as *Sarony* and *Bleistein*, and leave Rural with no effective protection against competitors like Feist. Leaving Feist without protection, however, might be viewed as unfair and damaging to public policy.<sup>291</sup> Thus, if the Court found for the defendant it would have had to square its doctrinal choice with notions of fairness and public policy. If the Court decided for the plaintiff, it would have had to explain why it chose to ignore its own well-established originality requirement. The Court chose the former option—to endorse the creative selection approach.

The Court began by reviewing the history of copyright protection for compilations and the development of the "sweat of the brow"/industrious collection doctrines before unequivocally repudiating them. Originality, the Court stated, must have two components: "independent creation plus a modicum of creativity."<sup>292</sup> The Court noted, however, that the creativity component is extremely modest.<sup>293</sup> The Court concluded that Congress overruled the "sweat of the brow" doctrine, specifically requiring originality in order to protect compilations, as demonstrated by the newly

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288. *Id.* at 342–44 (explaining that Feist's employers conducted additional research to verify and augment Rural's listings but nevertheless reproduced four entirely fictitious listings planted by Rural).

289. *Id.* at 344.

290. 498 U.S. 808 (1990).

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

292. *Feist*, 499 U.S. at 346.

293. *Id.* at 345 ("To be sure, the requisite level of creativity is extremely low; even a slight amount will suffice. The vast majority of works make the grade quite easily, as they possess some creative spark, 'no matter how crude, humble or obvious' it might be.").

introduced definition of “compilation” in the 1976 Act.<sup>294</sup> Thus, the elements of authorship that are protected in a compilation are only the selection, coordination and arrangement of the underlying material.<sup>295</sup> The Court explicitly reversed the minority of circuits that had adopted the “sweat of the brow” doctrine and required second-comers to independently collect material lest any substantial appropriation of a copyrightable compilation to be an infringement<sup>296</sup>

This portion of the Court’s opinion was really no more than well-known doctrines and conclusions, representing the view taken by the majority of circuit courts. The Court could therefore have simply just applied the originality requirement (i.e. the creative selection approach) to the facts of the case. The Court, however, chose a different path, perhaps deciding that doctrine alone was an insufficient basis on which to endorse the creative selection approach. The Court’s holding therefore went beyond statutory interpretation, stating that “[o]riginality is a constitutional requirement” derived from the Copyright and Patent Clause’s references to “Writings” and “Authors.”<sup>297</sup>

But the Court went even further to dismiss concerns raised by “sweat of the brow” proponents.<sup>298</sup> It recognized the possible unfairness of failing to protect a compiler’s labor but nevertheless stated that this unfairness was simply not an issue: the failure to protect a compiler’s labor is “not ‘some unforeseen byproduct of a statutory scheme.’ It is, rather, ‘the essence of copyright.’”<sup>299</sup> The Court reiterated that the policy

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294. See 17 U.S.C. § 101 (2005) (“[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.”)

295. *Feist*, 499 U.S. at 356–58.

296. *Id.* at 349 (“This inevitably means that copyright in a factual compilation is thin. Notwithstanding a valid copyright, a subsequent compiler remains free to use the facts contained in another’s publication to aid in preparing a competing work, so long as the competing work does not feature the same selection and arrangement.”)

297. *Id.* at 346 (quoting U.S. Const., art. I, § 8, cl. 8). The Court hinted, however, that other forms of protection might not be subject to the same constitutional restriction. See *id.* at 354 (“Protection for the fruits of such research . . . may in certain circumstances be available under a theory of unfair competition.”) (quoting 1 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 3.04 (1990)).

298. *Feist*, 499 U.S. at 349–51.

299. *Id.* at 349 (citation omitted); see also *id.* (noting that “the primary objective of copyright is . . . ‘[t]o promote the Progress of Science and useful Arts,’” and thereby provide economic incentives for the production of socially beneficial works). Cf. H.R. REP. NO. 60-2222, at 7 (1909) (“Not primarily for the benefit of the author, but primarily for the benefit of the public, [copyright] rights are given . . . .”); *Sony Corp. of Am. v. Universal City Studios*, 464 U.S. 417 (1984):

The monopoly privileges that Congress may authorize are neither unlimited nor primarily designated to provide a special private benefit. Rather, the limited grant is a means by which an important public purpose may be achieved. It is intended to

behind copyright was “[t]o promote the Progress of Science and useful Arts,”<sup>300</sup> thereby adopting the long tradition that copyright is meant only to advance the public welfare and not to secure the rights of authors. The creative selection approach thus correctly implemented copyright’s policy of encouraging the desired production of factual compilations.<sup>301</sup>

The Court then proceeded to explain how the “sweat of the brow” doctrine could not coexist with the creative selection approach.<sup>302</sup> It suggested that courts that had adopted the “sweat of the brow” doctrine simply misunderstood the copyright statute.<sup>303</sup> The court specifically pointed to the legislative history of the 1976 Act<sup>304</sup> and the revision of the definition of a “compilation” to require original authorship<sup>305</sup> as evidence

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motivate the creative activity of authors and inventors by the provision of a special reward, and to allow the public access to the products of their genius . . . .

*Id.* at 429; *Mazer v. Stein*, 347 U.S. 201, 219 (1954) (“The economic philosophy behind the clause empowering congress to grant patents and copyrights is the conviction that encouragement of individual effort by personal gain is the best way to advance public welfare through the talents of authors and inventors in ‘Science and useful Arts.’”); PAUL GOLDSTEIN, *COPYRIGHT: PRINCIPLES, LAW & PRACTICE* (1989); Stephen Breyer, *The Uneasy Case for Copyright: A Study of Copyright in Book, Photocopies, and Computer Programs*, 84 HARV. L. REV. 281 (1970); Robert M. Hurt & Robert M. Schuchman, *The Economic Rationale of Copyright*, 56 AM. ECON. REV. 420 (1966); William M. Landes & Richard A. Posner, *An Economic Analysis of Copyright Law*, 18 J. LEGAL. STUD. 325 (1989); Peter S. Menell, *An Analysis of the Scope of Copyright Protection for Application Programs*, 41 STAN. L. REV. 1045 (1989). This, however, should not be taken as proof of the proposition that copyright is always best explained or shaped as a matter of economic incentives. Many others decry the overwhelming emphasis on economics in copyright, emphasizing the diverse and sometimes conflicting set of values involved. See Ralph S. Brown, *Eligibility for Copyright Protection: A Search for Principled Standards*, 70 MINN. L. REV. 579 (1985); Wendy J. Gordon, *An Inquiry into the Merits of Copyright: The Challenges of Consistency, Consent and Encouragement Theory*, 41 STAN. L. REV. 1343 (1989); Justin Hughes, *The Philosophy of Intellectual Property*, 77 GEO. L.J. 287 (1988); Peter Jaszi, *Towards a Theory of Copyright: The Metamorphoses of “Authorship,”* 1991 DUKE L.J. 455 (1991); Gary Kauffman, *Exposing the Suspicious Foundation of Society’s Primacy in Copyright Law: Five Accidents*, 10 COLUM. J.L. & ARTS. 381 (1986); Jessica Litman, *The Public Domain*, 39 EMORY. L.J. 965, 997–98 (1990); Yen, *supra* note 75.

300. *Feist Publ’ns Inc.*, 499 U.S. at 349 (quoting U.S. Const. art. I, § 8, cl. 8).

301. *Id.* at 350:

[The] principle, known as the idea/expression or fact/expression dichotomy, applies to all works of authorship. As applied to a factual compilation, assuming the absence of original written expression, only the compiler’s selection and arrangement may be protected; the raw facts may be copied at will. This result is neither unfair nor unfortunate. It is the means by which copyright advances the progress of science and art.

302. *Id.* at 353–54.

303. *Id.* at 352 (citing *Leon and Jeweler’s Circular*).

304. *Id.* at 352–357.

305. See *id.* at 356 (“[The statute] defines a ‘compilation’ in the copyright sense 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.’” (emphasis added by court) (quoting § 101 of the 1976 Act)).

that the “sweat of the brow” doctrine was not relevant. Because of the originality requirement, the court concluded, copyright protection is never available for the facts themselves, but only for the original presentation of those facts.<sup>306</sup>

Having completed its attack on the “sweat of the brow” doctrine, the Court concluded its opinion by applying the originality creative selection requirement to Feist’s compilation. According to the Court, Rural’s case hinged on whether Feist copied anything “original” from Rural,<sup>307</sup> which the Court concluded Feist did not.

Understanding how and why the Court reached its finding of non-infringement also uncovers its strong desire to rule on the creative selection and arrangement question. The Court began by identifying what Feist copied from Rural, stating that Feist appropriated “1,309 names, towns, and telephone numbers” from Rural’s white pages.<sup>308</sup> One might then have expected the Court to proceed by analyzing whether Feist borrowed any selection or arrangement<sup>309</sup> and therefore finding no infringement because, as noted earlier, Feist borrowed Rural’s underlying material without its selection or arrangement.<sup>310</sup> Such a finding would have been entirely consistent with its statement that “copyright in a factual compilation is thin.”<sup>311</sup>

The Court did not do this. Instead, it apparently assumed that Feist did take Rural’s selection and arrangement,<sup>312</sup> if only to reach for the question of whether Rural’s white pages selection and arrangement were copyrightable.<sup>313</sup> The Court concluded that Rural’s selection of listings was “obvious,” and its arrangement was “not only unoriginal, it [was] practically inevitable,”<sup>314</sup> explaining:

The selection, coordination, and arrangement of Rural’s white pages do not satisfy the minimum constitutional standards for copyright protection. . . . Rural’s white pages are entirely typical. . . . In preparing its white pages, Rural simply takes the data provided by its subscribers and lists it alphabetically by surname.

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306. See *id.* at 358 (“*Facts are never original*, so the compilation author can claim originality, if at all, only in the way the facts are presented.” (emphasis added)).

307. *Id.* at 361.

308. *Id.*

309. *Id.* at 361 (noting that Feist admitted that the directory as a whole was copyrightable).

310. See *supra* note 287 and accompanying text.

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

312. One could plausibly conclude that such an assumption was incorrect. See *supra* note 287 and accompanying text.

313. *Feist*, 499 U.S. at 361–62.

314. *Id.* at 362–63.

The end product is a garden-variety white pages directory, devoid of even the slightest trace of creativity.<sup>315</sup>

However, the Court acknowledged that the telephone white pages were an extreme case, falling into a “narrow category of works in which the creative spark is utterly lacking or so trivial as to be virtually nonexistent,”<sup>316</sup> and that “the vast majority of compilations will pass” the originality test.<sup>317</sup>

### B. *Analysis of the Decision*

The Court’s decision in *Feist* thus has three main components. The first point was that compilations are not copyrightable solely because of the time and effort needed to create them. However, this point, though important, is hardly earth shaking. As the historical analysis in this Article demonstrates, most circuit courts reached such a conclusion prior to the Court’s decision in *Feist*. In fact, only a small number of courts granted copyright protection based on the “sweat of the brow,” and this protection was generally only granted to telephone directories and maps alleged to be labor-intensive. The courts granting protection relied on copyright law because they were moved by the equities of these cases, although their reasoning fit better with the misappropriation doctrine enunciated in cases such as *International News Service v. Associated Press*.<sup>318</sup> The second point in the *Feist* decision was that a second compiler does not infringe a copyright when using facts gathered by a first compiler. This, however, was also unexceptional given the reality that copyright law has never protected facts.

The last, and most important, point in the Court’s analysis is that it constitutionalized the originality requirement of copyright law. Although it was clearly unnecessary to decide the case on constitutional grounds since statutory grounds would have sufficed, the Court held that the Constitution required a minimum amount of originality or creativity in order for a work to be eligible for copyright protection. As the historical analysis above showed, *Feist* was the first case to *explicitly* state that originality is constitutionally mandated, though one could argue that the Court’s decision in *Burrow-Giles* suggested this implicitly.

*Feist* thus sounded the death knell for the “sweat of the brow” doctrine. One might even be surprised that it took the Court two hundred years to arrive at such a fundamental decision given the many opportunities it had to explain the terms “Author” and “Writings.” However, when

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315. *Id.* at 362.

316. *Id.* at 359.

317. *Id.*

318. *See supra* note 46 and accompanying text.

one examines the legal landscape and historical context within which *Feist* was decided, one begins to understand why constitutionalization of the originality requirement seemed necessary,<sup>319</sup> even if *Feist* was not necessarily the “best” factual scenario for establishing order and guidance within the problematic field of compilation copyright.

*Feist* was decided in 1991, while major developments and breakthroughs in the fields of computers, telecommunications, and information technologies, as well as the commercialization of the Internet, were rapidly taking place. The opinion in *Feist* therefore both reflected and signaled the beginning of a new era of coherence, one which emphasized the constitutional dimensions constraining intellectual property law doctrines. The opinion also reflected the great uneasiness with the way the industrious collection doctrine allowed capture and enclosure of facts, and signaled a shift away from the proprietary nature of copyright in favor of dissemination of information and ideas.<sup>320</sup> Therefore, while the industrious collection doctrine might have been a necessity in some situations during the era of pre-digital, old-fashioned compilations, when database producers did not have the tools to otherwise recoup their investment, *Feist* represented the realization that such reasoning is inapplicable to modern electronic databases.

The constitutionally mandated originality requirement anticipated and prevented the possibility that interest groups would try to checkmate

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319. *But see* Robert Kreiss, *Copyright Protection for Computer Databases, CD-ROMS And Factual Compilations*, 17 U. DAYTON L. REV. 323, 327 (1992) (addressing the possibility that Congress’s power to “promote the Progress of Science and useful Arts” could have been interpreted to allow copyright protection to works of questionable originality to ensure works that contribute to the “progress of science” are protected); Anat S. Narayanan, Note, *Standards of Protection for Databases in the European Community and the United States: Feist and the Myth of Creative Originality*, 27 GEO. WASH. J. INT’L L. & ECON. 457 (1993–1994) (arguing that the creative originality requirement is not constitutionally mandated); Leo J. Raskind, *Assessing the Impact of Feist*, 17 U. DAYTON L. REV. 331, 336 (1992) (arguing that *Feist* fails to recognize that information gathering involves the exercise of judgment); Benjamin B. Thomer, *Copyright Protection For Computer Databases: The Threat of Feist and a Proposed Solution*, 1 VA. J.L. & TECH. 5 (1997) (arguing that *Feist* hampers incentives to bring functional writings to the public); Russ VerSteege, *Sparks in the Tinderbox: Feist, “Creativity,” and the Legislative History of the 1976 Copyright Act*, 56 U. PITT. L. REV. 549 (1995) (arguing that legislative history of the 1976 Act suggests “creativity” was not intended to be a required element of copyrightability); Timothy Young, Casenotes, *Copyright law: Copyright Protection for Factual Compilations: The White Pages of the Phone Book Are Not Original Enough To Be Copyrighted—But Why?*, 17 U. DAYTON L. REV. 631 (1992) (arguing that *Feist* required more originality than is congressionally mandated).

320. *See* *Cable News Network, Inc. v. Video Monitoring Serv. of Am. Inc.*, 940 F.2d 1471, *vacated*, 949 F.2d 378 (11th Cir. 1991) (viewing *Feist* as revolutionizing the law of copyright away from the proprietary nature of copyright, such that CNN had no copyright in the news of the day, apparently including CNN’s own news clips and reports). *See also* David O. Carson, *Copyright Protection for Factual Compilations After Feist: A Practitioner’s View*, 17 U. DAYTON L. REV. 969, 980 (1992).

the public by pressing Congress to pass legislation protecting these building blocks of knowledge. Indeed, almost all the database bills on the database protection “problem” thus far failed mainly because they could not withstand a constitutional challenge.<sup>321</sup> The Court thus accurately envisioned challenges and technological advances that were to come. The origins of the jurisprudence inherent in *Feist*, therefore, necessarily lie in twentieth century achievements, rather than those of the nineteenth century. Nonetheless, despite these important aspects of *Feist*, the Supreme Court offered little guidance to the lower courts on the question of creativity of compilations since it articulated the originality standard in the weakest possible case, that of a white-pages directory. Three notable problems result from this aspect of *Feist*.

First, in *Feist* there was neither real “sweat of the brow” nor free riding involved. Whereas in the past, creating a “white pages” directory was a labor intensive mission, requiring many people with file cards to handle, assemble, and check individual phone listings, today’s phone information is digital. Phone companies can quickly and easily create a directory without much human input<sup>322</sup> by simply receiving the names and addresses of all phone owners. Therefore, *Feist* did not really involve “sweat of the brow” or human effort. Additionally, there was no free riding since *Feist* paid for the information it licensed from ten out of eleven directories (and offered to pay Rural for the directory information) and created a new productive work that was different from other directories competitors offered.

The second problem lies in the fact that the data in *Feist* was generated by a government-created monopoly (Rural), which was required by law to produce this information. Telephone companies such as Rural do not, therefore really need incentives to create directories since these incentives exist in the form of mandatory requirements to produce such information as well as the possible revenue received from advertising.<sup>323</sup> In fact, even if no possibility of advertising revenue existed, consumers would probably be willing to pay for the production of telephone books if there was even a demand. It is interesting to note that Congress in the Telecommunication Act of 1996 solved *Feist*’s holdout problem regarding

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321. See, e.g., John Tessensohn, *The Devil’s in the Details: The Quest for Legal Protection of Computer Databases and the Collection of Information Act*, H.R. 2652, 38 IDEA 439 (1998) (examining H.R. 2652 and arguing that it must be overhauled to strike a balance between computer database publishers and the public).

322. Symposium, *Panel I: Database Protection*, 11 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 275, 296 (2001).

323. Michael J. Schmelzer, Note, *Protecting the Sweat of the Spider’s Brow: Current Vulnerabilities of Internet Search Engines*, 3 B.U.J. SCI. & TECH. L. 12 (1997) (discussing subscription, advertising, and enabling the purchase of goods and services as revenue models for the web enterprises).

telephone subscribers' information by requiring telecommunication carriers to provide non-discriminatory access to telephone numbers and directory listings,<sup>324</sup> thereby ensuring that such information is accessible to others.

Finally, the Court in *Feist* dealt with the easiest type of directory case—a white pages directory, organized in alphabetical order and lacking minimal creativity. The nature of the case therefore made the need to provide guidelines regarding creativity in compilations redundant, a fact that has proven to be one of the major weaknesses of the decision. For example, soon after the Court decided *Feist*, a series of cases emerged in the federal circuit courts that seemed especially suited to follow from the precedent set in *Feist*.<sup>325</sup> However, the stability and clarity that the Court seemed to promise in *Feist* proved to be short-lived<sup>326</sup>: different circuits examining cases with similar factual scenarios reached different results when applying *Feist*.<sup>327</sup> Thus, while the Court's decision in *Feist* did succeed in ending the split among circuit courts concerning "sweat of the brow" versus creative selection/arrangement theory, the Court may have ended up simply creating a new ambiguity by not providing further clarification in the standards of originality it proclaimed.<sup>328</sup> The result—continued division and uncertainty regarding the copyrightability of compilations.

## CONCLUSIONS

The current debate over the legal protection of databases has lasted for almost ten years. As this Article has shown, however, the debate has failed to identify and discuss some of the most basic and preliminary historical aspects of the issue. This Article has therefore sought to challenge these underlying assumptions by providing a fresh look at the historical dimension of the debate.

Indeed, as can be seen from the more comprehensive review provided above on the history of informational works before the Court's

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324. Telecommunication Act of 1996, Pub. L. No. 104-104, § 222(e), 110 Stat. 56, 61, 62 (codified at 47 U.S.C. § 222(e) (2005)).

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

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

327. See *supra* note 325.

328. *Id.* at 585. See also Tracy Lea Meade, *Ex-Post Feist: Application of a Landmark Copyright Decision*, 2 J. INTELL. PROP. L. 245, 251–52 (1994).

decision in *Feist*, the law's prevailing approach has long been to support unfettered access to facts and other materials considered indispensable for academic, economic progress. In particular, the discussion showed that the "sweat of the brow" doctrine had been in constant decline under the 1976 Copyright Act even before the Court finally repudiated it in *Feist*, clearly rebutting the commonly accepted argument that the Court dropped a bomb when issuing its decision in *Feist*.

Based on this historical analysis it becomes evident that the actual decision in *Feist* did not really establish any new law that would have come as a surprise to the database industry. Instead, *Feist* simply reflected the prevailing approach of the time. Most importantly, however, *Feist* reaffirmed the originality requirement and thus guaranteed the continued unfettered access to facts and information in a new and constantly evolving information environment.