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Copyright, Compilations, and Public Policy: Lingering Issues after the West Publishing-Mead Data Central Settlement

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COPYRIGHT, COMPILATIONS, AND PUBLIC POLICY:
LINGERING ISSUES AFTER THE WEST
PUBLISHING-MEAD DATA CENTRAL
SETTLEMENT

CARY E. DONHAM

Are the page numbers of a factual compilation protected by a copyright in that compilation? In *West Publishing Co. v. Mead Data Central*,¹ the United States Court of Appeals for the Eighth Circuit held that the page numbers of West Publishing Company's (West's) National Reporter System were protected by copyright and refused to allow Mead Data Central (MDC) to incorporate the page numbers in its LEXIS database through a "star-pagination" system.²

On July 21, 1988, MDC and West announced a settlement of the antitrust and copyright suits then pending between the two companies. Under the agreement, all suits were to be dismissed, and MDC would pay an undisclosed licensing fee to West in exchange for both the use of West's page numbers in a star-pagination system and the use of West's numbering systems in various state code compilations. In effect, MDC has recognized West's copyright in those items.³

Nonetheless, there are issues raised by the MDC-West dispute that remain despite the settlement. First, what is the standard for copyrightability of factual compilations which can readily be copied in a computer database? Second, in testing for copyright infringement of a printed compilation by a computer database, how is substantial similarity to be determined? While the immediate dispute has been settled, these issues are likely to arise again as computers and databases are used in an increasing variety of ways.

Finally, and most importantly for the legal profession, should there be limits on copyright protection for compilations of legal opinions and

1. 799 F.2d 1219 (8th Cir. 1986), *cert. denied*, 107 S. Ct. 962 (1987). The Eighth Circuit decision was on an appeal brought by MDC from the district court's grant of a preliminary injunction which prevented MDC from instituting a star-pagination system in MDC's LEXIS legal research data base, largely because the district court held that West would likely prevail on the merits of its copyright infringement claim brought against MDC. *Id.* at 1222. The case was tried on the merits of the copyright claim in April, 1988 but was settled before a verdict was entered. Blodgett, *West, Mead Data Central Settle*, A.B.A. J., Sept. 1, 1988, at 36.

2. 799 F.2d at 1229. "Star-pagination" indicates that the page breaks and page numbers of West's reports would be shown on the LEXIS computer screen.

3. Blodgett, *supra* note 1, at 36.

codes which have become quasi-official by virtue of their required use by courts which have adopted *A Uniform System of Citation* (the *Bluebook*)?⁴ This question reflects the fundamental tension in the Constitution between the public's first amendment right of access to information and the right of an author to be rewarded for his or her original work. This article will use the *West Publishing* case as a lens through which these copyright and policy issues can be clearly viewed.

I. COPYRIGHT LAW AND FACTUAL COMPILATIONS: AN OVERVIEW

Copyright law in the United States has its genesis in Article I of the Constitution.⁵ Congress enacted the first federal copyright statute in 1790, and both Congress and courts have periodically revised and interpreted the law to keep the Act in step with developing technology.⁶ In 1976, Congress enacted a complete revision of the statutory copyright law.⁷ Under the 1976 Act, copyright protection is given "in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which [the work] can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device."⁸

The owner of a copyrighted work is granted several exclusive rights in the work, including the rights to reproduce the work in copies and to sell or otherwise transfer copies of the work to the public.⁹ Anyone who

4. A UNIFORM SYSTEM OF CITATION (14th ed. 1986) [hereinafter BLUEBOOK].

5. U.S. CONST. art. I, § 8, cl. 8. This clause provides that Congress shall have power "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."

6. See, e.g., *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53 (1884) (photographs receive copyright protection); *Goldstein v. California*, 412 U.S. 546 (1973) (sound recordings receive copyright protection); Copyrights Act Amendment, Pub. L. No. 96-517, 94 Stat. 3015, 3028 (1980) (codified at 17 U.S.C. § 117 (1982)) (computer programs receive copyright protection). See also definitions in 17 U.S.C. § 101 (1982); and *M. Kramer Mfg. Co. v. Andrews*, 783 F.2d 421, 433-35 (4th Cir. 1986).

7. 17 U.S.C. §§ 101-810.

8. *Id.* at § 102(a).

9. *Id.* at § 106.

Exclusive Rights in copyrighted works

Subject to sections 107 through 118, the owner of copyright under this title has the exclusive rights to do and to authorize any of the following:

- (1) to reproduce the copyrighted work in copies or phonorecords;
- (2) to prepare derivative works based upon the copyrighted work;
- (3) to distribute copies or phonorecords of the copyrighted work to the public by sale or other transfer of ownership, or by rental, lease, or lending;
- (4) in the case of literary, musical, dramatic, and choreographic works, pantomimes, and motion pictures and other audiovisual works, to perform the copyrighted work publicly; and
- (5) in the case of literary, musical, dramatic, and choreographic works, pantomimes, and pictorial, graphic, or sculptural works, including the individual images of a

violates one of the exclusive rights granted to a copyright owner infringes the copyright. A copyright owner whose copyright is infringed may bring a suit in federal district court for both equitable relief and for damages.¹⁰

The 1976 Act also limits these exclusive rights, however.¹¹ Most significantly, the Act codifies the judicially created "fair use" doctrine, which is a defense to copyright infringement actions. Under this doctrine, copying of a copyrighted work is not an infringement if it is used for criticism, teaching, news reporting, or other limited use which can be characterized as fair use.¹² The "fair use" doctrine is an attempt to reconcile the competing interests of copyright law: promoting and rewarding creativity by granting exclusive rights in their works to authors, while at the same time making the broadest possible range of information available to the public. In determining fair use, courts consider the most important factor to be whether the use will affect the potential market for the copyrighted work.¹³

A. *Copyright of Compilations of Facts*

Factual compilations have long been included within the scope of the copyright laws,¹⁴ and are explicitly protected in the 1976 Act.¹⁵ Protected compilations of facts include works formed by collecting and assembling materials or data that have been selected or arranged in such a way that the resulting work can be considered an original work of authorship.¹⁶

motion picture or other audiovisual work, to display the copyrighted work publicly.

10. See 17 U.S.C. §§ 501-505. Attorney fees can also be recovered. *Id.* at § 505.

11. See *Id.* at § 107-118.

12. See *Id.* at § 107. "Section 107 is intended to restate the present judicial doctrine of fair use, not to change, narrow, or enlarge it in any way." H.R. REP. NO. 1476, 94th Cong., 2d Sess. 66, reprinted in 1976 U.S. CODE CONG. & ADMIN. NEWS 5659, 5680.

13. See *Harper & Row v. Nation Enters.*, 471 U.S. 539, 566-67 (1985); 3 M.B. NIMMER & D. NIMMER, NIMMER ON COPYRIGHT § 13.05(A)(4) (1988).

14. See *Schroeder v. William Morrow & Co.*, 566 F.2d 3 (7th Cir. 1977) (a catalog of names and addresses is copyrightable); *Leon v. Pacific Tel. & Tel. Co.*, 91 F.2d 484 (9th Cir. 1937) (telephone directory is copyrightable); *Jewelers' Circular Publishing Co. v. Keystone Publishing Co.*, 274 F. 932 (S.D.N.Y. 1921), *aff'd*, 281 F. 83 (2d Cir. 1922), *cert. denied*, 259 U.S. 581 (1922) (directory of trade names is copyrightable). See generally Denicola, *Copyright in Collections of Facts: A Theory for the Protection of Nonfiction Literary Works*, 81 COLUM. L. REV. 516, 527-29 (1981).

15. A compilation is defined 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. The term 'compilation' includes collective works." 17 U.S.C. § 101. "A 'compilation' results from a process of selecting, bringing together, organizing, and arranging previously existing material of all kinds, regardless of whether the individual items in the material have been or ever could have been subject to copyright." *Id.* at § 103 historical and revision note.

16. *Id.* at § 101.

The protection afforded compilations reflects the tension which gave rise to the fair use doctrine, discussed above. A copyright gives the author an economic incentive to produce by granting exclusive rights in the works the author creates; in effect the owner of a copyright has a limited monopoly to economically exploit the copyrighted work. On the other hand, the public is the intended beneficiary of this monopoly. Copyright law, by protecting the rights of authors and creators, encourages the dissemination of new ideas and means of expression, so that past and current creativity can fuel future discovery.¹⁷ Thus, by granting certain exclusive rights to those who collect and organize compilations of data, the copyright laws encourage both the production and the availability of useful information.¹⁸

The copyright in a compilation extends only to material contributed by the compiler, and does not include preexisting material or facts.¹⁹ In essence, this requirement implicitly extends the statutory requirement of originality to works that are primarily factual, by protecting only those portions of a factual compilation that are independently created or selected.²⁰ Originality, in terms of copyright law, does not require novelty or invention. Rather, it requires only that the work owe its origin to the author.²¹

Courts have used two distinct lines of reasoning to test whether compilations of facts have sufficient originality to warrant copyright protection. Under the first line of reasoning, which can be called the "arrangement criterion," courts have examined whether the arrangement of

17. Denicola, *supra* note 14, at 519 n.11.

Civil copyright law is a compromise between competing social policies—one favoring the widest possible dissemination of new ideas and new forms of expression, and the other giving writers and artists enough of a monopoly over their works to ensure their receipt of fair material rewards for their efforts. The first policy predominates, which means that the system of rewards is to be no more extensive than is necessary in the long run to elicit a socially [optimal] amount of creative activity.

(quoting *United States v. Bily*, 406 F. Supp. 726, 730 (E.D. Pa. 1975)). See also *Harper & Row Publishers v. Nation Enters.*, 471 U.S. 539, 546 (1985) ("The monopoly created by copyright thus rewards the individual author in order to benefit the public." (quoting *Sony Corp. of Am. v. Universal City Studios*, 464 U.S. 417, 429 (1984))).

18. See, e.g., *Schroeder v. William Morrow & Co.*, 566 F.2d 3 (7th Cir. 1977) (protection afforded compilation of names and addresses in a gardening directory); *Leon v. Pacific Tel. & Tel. Co.*, 91 F.2d 484 (9th Cir. 1937) (protection granted to telephone directory); *Rand McNally & Co. v. Fleet Management Sys.*, 600 F. Supp. 933 (N.D. Ill. 1984) (protection afforded map publisher's collection of mileage information).

19. See 17 U.S.C. § 103(b). See also *Harper & Row*, 471 U.S. at 547 ("[N]o author may copyright facts or ideas. . . . The copyright is limited to those aspects of the work—termed 'expression'—that display the stamp of the author's originality.").

20. 17 U.S.C. § 103(b). See *Financial Information v. Moody's Investors Serv.*, 808 F.2d 204, 207-08 (2d Cir. 1986), *cert. denied*, 108 S. Ct. 79 (1987).

21. See *Alfred Bell & Co. v. Catalda Fine Arts*, 191 F.2d 99 (2d Cir. 1951).

the facts in a compilation is protected expression. These courts, in recognizing copyright protection for a particular factual compilation, reason that the compiler's contribution is a new presentation or arrangement of the data, rather than the time or labor he or she expended in collecting the data.²² As one court recently noted, "[t]o grant copyright protection based merely on the 'sweat of the author's brow' would risk putting large areas of factual research material off limits and threaten the public's unrestrained access to information."²³

Other courts, however, have looked at the time and labor expended by the compiler in gathering the data (the "sweat-of-the-brow" criterion),²⁴ and have extended copyright protection only to those compilers who have put forth a substantial amount of effort. These courts, in rejecting the "arrangement" approach, note that an arrangement is dictated by function rather than creativity.²⁵ Further, they reason that a standard based on arrangement would allow the work to be pirated merely by rearranging a body of data previously collected and copyrighted.²⁶

Recently, courts and commentators have attempted to synthesize the "arrangement" criteria and the "sweat-of-the-brow" criteria into a single standard compatible with the language of the 1976 Copyright Act.²⁷ Their analyses focus on whether compilers have exercised selection, creativity and judgment in choosing the facts ultimately included in the particular compilation, as a means of testing whether a compilation is

22. *Rockford Map Publishers v. Directory Serv. Co.*, 768 F.2d 145, 148-49 (7th Cir. 1985), *cert. denied*, 474 U.S. 1061 (1986); *Schroeder*, 566 F.2d at 6. See generally *Denicola*, *supra* note 14, at 527-28. Originally, works granted copyright protection shared three characteristics: (1) Originality which calls for independent creation rather than novelty, and means little more than a prohibition of actual copying, 1 M.B. NIMMER & D. NIMMER, *supra* note 13, at § 2.01(A); (2) the constitutional requirement of writing which means that the work must be embodied in some relatively stable form; and (3) creative intellectual effort. *Denicola*, *supra* note 14, at 520-21.

23. *Financial Information*, 808 F.2d at 207.

24. See, e.g., *Leon v. Pacific Tel. & Tel. Co.*, 91 F.2d 484 (9th Cir. 1937). The court reasoned: The man who goes through the streets of a town and puts down the names of each of the inhabitants, with their occupations and their street number, acquires material of which he is the author. He produces by his labor a meritorious composition, in which he may obtain a copyright. . . .

Id. at 486 (quoting *Jewelers' Circular Publishing Co. v. Keystone Publishing Co.*, 281 F. 83, 88 (2d Cir. 1922)). *Accord* *Rand McNally & Co. v. Fleet Management Sys.*, 600 F. Supp. 933, 936 (N.D. Ill. 1984); *National Business Lists v. Dun & Bradstreet, Inc.*, 552 F. Supp. 89, 92 (N.D. Ill. 1982); *Southwestern Bell Tel. Co. v. Nationwide Indep. Directory Serv.*, 371 F. Supp. 900, 905 (W.D. Ark. 1974). See generally *Denicola*, *supra* note 14, at 528-31.

25. See, e.g., *Rand McNally*, 600 F. Supp. at 941.

26. See, e.g., *id.*

27. See *Denicola*, *supra* note 14, at 530-31. See also *Financial Information v. Moody's Investors Serv.*, 751 F.2d 501, 506-07 (2d Cir. 1984); *Eckes v. Card Prices Update*, 736 F.2d 859, 862-63 (2d Cir. 1984).

sufficiently original to merit copyright protection.²⁸ For example, in *Eckes v. Card Prices Update*,²⁹ the Second Circuit held that a comprehensive guide to the market price of baseball cards was copyrightable because the compilers "exercised selection, creativity and judgment in choosing among the 18,000 or so different baseball cards in order to determine which were the 5,000 premium cards."³⁰

The same court used an identical standard but reached the opposite result in *Financial Information v. Moody's Investors Service*.³¹ In that case, the court held that Daily Bond Cards, which sought to report all municipal bond redemptions each day, were not copyrightable, because the researchers who compiled the cards had only five facts to fill in on each card.³² Similarly, the Eighth Circuit held that a numbering system for lawn care equipment parts lacked the requisite degree of originality for copyright protection, because the record showed that the parts were assigned random numbers.³³ Importantly, in each of these cases, the court, in determining whether the requisite degree of originality for copyright protection was present, focused not only on the arrangement of the material being compiled, but also on the independent judgment exercised by the compiler in creating the collection of data.³⁴

Determining the criteria for granting copyright protection to a compilation of facts has proved to be particularly troublesome in the context of computer data bases. A data base is fundamentally a compilation of facts stored in a computer memory and is capable of being retrieved in

28. See Denicola, *supra* note 14, at 530-31. Denicola finds copyright protection in the collection of data obtained by a compiler, rather than in its arrangement, by recognizing that the compiler's work in aggregating information is akin to authorship:

Unless the collection of data contained in the compilation has been copied from a preexisting source, it represents an original contribution of the author. The collection owes its origin to the author as much as does the manner in which the collection is arranged. This distinguishes the process of culling and assembling facts, which results in the collection, from the discovery of the facts themselves, and thereby secures a spot for the collection outside the category of discoveries, which are expressly excluded from copyright protection.

Id. at 530. Thus, while Denicola rejects the arrangement of a compilation as a rationale for copyright protection, he recognizes that the compiler's effort must demonstrate some degree of selection above mere "sweat-of-the-brow" in order to qualify as "authorship."

29. 736 F.2d 859 (2d Cir. 1984).

30. *Id.* at 863.

31. 808 F.2d 204 (2d Cir. 1986).

32. *Id.* at 207-08.

33. *Toro Co. v. R & R Prods. Co.*, 787 F.2d 1208, 1213 (8th Cir. 1986).

34. There seems to be correlation between the number of items which the compiler must choose between or manage, and the amount of originality (for copyright purposes) recognized by a court. For example, in *Eckes v. Card Prices Update*, the Second Circuit noted the 18,000 total baseball cards available versus the 5000 premium cards chosen. 736 F.2d 859, 863 (2d Cir. 1984). On the other hand, in *Financial Information*, the clerks had only five facts to obtain for each card. 808 F.2d at 206-08.

various forms through a set of prescribed search instructions.³⁵ A data base differs from traditional compilations in that it does not appear in a set arrangement. It is essentially a formless collection of information which can be organized and reorganized by varying the search program; its arrangement is constrained only by the limitations of the computer or the computer programmer. Thus, a particular arrangement of data does not exist in relation to the physical computer data bases.³⁶

A corollary of this lack of sequential order is that one computer data base can easily subsume the information in another protected data base without copying its arrangement. Copyright protection for computer data bases, and for compilations of factual matter susceptible to inclusion in data bases, can no longer be based solely on an "arrangement" of data, since the term is virtually meaningless with respect to computer data bases.³⁷ Similarly, a copyright based solely on the "sweat-of-the-brow" criterion would risk making large areas of factual research unavailable to the public, without fulfilling the originality requirement of the 1976 Act.³⁸ For such compilations, the compiler's selection, creativity and judgment become the most satisfactory criteria to protect unauthorized copying of a factual compilation. This criteria would protect more than an arrangement of data in a data base, since it recognizes the process of selecting and judging the bits of information which are included in a data base.³⁹ In addition, by examining whether a compiler exercised judgment and creativity, this criteria fulfills the statutory requirement that a copyrightable work be original.⁴⁰

There must be limits on the copyright protection afforded factual works, however. Otherwise, matters of vital public importance would be

35. See AMERICAN NAT'L STANDARDS COMM. X3—COMPUTERS AND INFORMATION PROCESSING, AMERICAN NATIONAL DICTIONARY FOR INFORMATION PROCESSING, reprinted in, COMPUTER LAW SERVICE § 1-3, art. 1, at 44 (R. Bigelow ed. 1979). See generally Note, *Copyright and Computer Databases: Is Traditional Compilation Law Adequate?*, 65 TEX. L. REV. 993 (1987).

36. See West Publishing Co. v. Mead Data Cent., 616 F. Supp. 1571 (D. Minn. 1985), *aff'd*, 799 F.2d 1219 (8th Cir. 1986), *cert. denied*, 107 S. Ct. 962 (1987); Denicola, *supra* note 14, at 531.

37. Denicola, *supra* note 14, at 531. The problem of copyright infringement of existing works by computer data bases is a recent development. Professor Nimmer states: "[p]rior to the current Act [the unauthorized "input" of a copyrighted work into a computer] would not have constituted an infringement because that which is reproduced within the computer is not perceptible without the use of a machine." 2 M.B. NIMMER & D. NIMMER, *supra* note 13, at § 8-103.

The current Act finds that "copy" includes a work "perceived, reproduced or otherwise communicated, either directly or with the aid of a machine or device . . . [T]his expanded definition makes clear that the input of a work into a computer results in the making of a copy, and hence that such unauthorized input infringes the copyright owner's reproduction right." *Id.* at § 8-103 to 04.

38. See *Financial Information*, 808 F.2d at 207.

39. See Denicola, *supra* note 14, at 530-31.

40. *Financial Information*, 808 F.2d at 207. See 17 U.S.C. § 102.

placed off limits to researchers, scholars, and the public in general.⁴¹ Hence, the issue is how to separate those elements of a compilation which evidence selection, creativity and judgment, and which therefore are protected by copyright, from those uncopyrightable facts which make up the largest part of most compilations, and which must remain available to the public. Only the identification of copyrighted elements in a factual compilation will allow another work which uses the same facts to be tested for infringement.

B. Copyright Infringement: Proving Substantial Similarity

To establish infringement, a copyright owner must show ownership of a valid copyright and demonstrate copying of the protected work by the defendant.⁴² Direct evidence of copying is rarely available, but copying may be inferred where the defendant had access to the copyrighted work, and the accused work is "substantially similar" to the copyrighted work.⁴³ Under this criterion both the structure and expression of ideas in each work must be substantially similar.⁴⁴ The relevant inquiry is whether a substantial portion of the protectible material in the plaintiff's work was appropriated.⁴⁵

Some courts apply an "extrinsic" test to determine substantial similarity of ideas between two works. This test focuses on a comparison of the objective details of the works. Although the ideas in the works being compared must be substantially similar to prevail in a copyright infringement action, the ideas themselves cannot be copyrighted.⁴⁶

In addition to showing the similarity between the two works, the plaintiff must also show that the expression of those ideas is substantially similar. This test, sometimes called the "intrinsic" test, is subjective. It examines whether the defendant copied material of substance and value, according to the ordinary reasonable person. This "ordinary observer" is deemed to look at the total concept and feel of the works being compared, rather than dissecting and analyzing the details of the works.⁴⁷

For example, in *Rand McNally & Co. v. Fleet Management Sys-*

41. *Financial Information*, 808 F.2d at 207.

42. *Atari, Inc. v. North Am. Philips Consumer Elecs. Corp.*, 672 F.2d 607, 614 (7th Cir. 1982), *cert. denied*, 459 U.S. 880 (1982).

43. *Id.* See generally *Sid & Marty Krofft Television Prods. v. McDonald's Corp.*, 562 F.2d 1157 (9th Cir. 1977).

44. *Landsberg v. Scrabble Crossword Game Players, Inc.*, 736 F.2d 485, 488 (9th Cir. 1984).

45. *Worth v. Selchow & Righter Co.*, 827 F.2d 569, 570 n.1 (9th Cir. 1987), *cert. denied*, 108 S. Ct. 1271 (1988).

46. *Id.* at 572. See also *Digital Communications Assocs. v. Softklone Distrib. Corp.*, 659 F. Supp. 449, 457-58 (N.D. Ga. 1987).

47. *Atari*, 672 F.2d at 614.

tems,⁴⁸ the court found that the plaintiff's compilation of mileage data taken from its highway maps was copyrightable. Consequently, the court found that the defendant infringed that copyright when it copied the mileage data into its computer data base. Since the copied work contained the same information as plaintiff's work, and was advertised as the computerized equivalent of plaintiff's work, an ordinary observer would conclude that the works were substantially similar.⁴⁹

Users of the ordinary observer test must recognize, however, that a copyright protects only those elements of the work which are in fact copyrighted. For example, since facts cannot be copyrighted,⁵⁰ a copyright cannot prevent the use of facts in a copyrighted compilation unless the expression of those facts is something more than what "must unavoidably be produced by anyone who wishes to use and restate" those facts.⁵¹ Thus, in *Worth v. Selchow & Righter Co.*,⁵² the court held that use of factual matter in plaintiff's books on trivia in the defendant's Trivial Pursuit game was not infringement. The words used in the plaintiff's books to describe the trivia facts were the only way those facts could be expressed; to grant copyright protection to those words would amount to granting a copyright protection in the facts.

The *Worth* case helps to illustrate potential difficulties in proving substantial similarity between a copyrighted compilation of factual material and a computer data base which uses the facts in the copyrighted work. First, the factual material itself cannot be protected. Second, while the printed compilation has a fixed organization, the information in a computer data base containing the same factual material can appear in any form.

Thus, whether there is substantial similarity between a computer data base and a printed compilation may turn on circumstantial evidence of copying, such as the copying of errors in the spelling of names and addresses listed in the compilation.⁵³ Similarly, if the computer data base copied the "look and feel" of the printed work, a court might find

48. 600 F. Supp. 933 (N.D. Ill. 1984).

49. *Id.* at 943.

50. See 17 U.S.C. § 102(b). See also *Mazer v. Stein*, 347 U.S. 201 (1954) (the idea of using a sculpture for a lamp base is not protected by copyright, but a particular sculpture which represents the expression of that idea may be protected). A work which is closer to a particularized expression of an idea than to the idea itself receives broader copyright protection. *Atari*, 672 F.2d at 616-17.

51. *Worth v. Selchow & Righter Co.*, 827 F.2d 569, 572-73 (9th Cir. 1987) (quoting *Landsberg*, 736 F.2d at 489).

52. 827 F.2d 569.

53. See, e.g., *Southwestern Bell Tel. Co. v. Nationwide Indep. Directory Serv., Inc.*, 371 F. Supp. 900, 906 (W.D. Ark. 1974).

the data base substantially similar to the printed work.⁵⁴ Alternatively, if the copyright protects the compilation of data as a whole, whether because of the the author's labor in producing the compilation, or because the compilation reflects the author's judgment in selecting the data, any wholesale appropriation of the data from the compilation could generate potential liability for copyright infringement.⁵⁵

C. *Compilations in Legal Publishing*

Compilations of judicial opinions provide unique copyright problems to publishers. Judicial opinions are the law of the land, and must be made available to the public to afford the public its constitutional guarantee of due process.⁵⁶ This constitutional requirement conflicts with the needs of private publishers who desire to retain the greatest possible exclusive rights in their compilations of opinions in order to obtain the greatest market share and earn the greatest profits. Thus, potential copyright infringement of compilations of judicial opinions involves not only copyright issues, but also questions of public policy.

In *Wheaton v. Peters*,⁵⁷ Henry Wheaton, a reporter of United States Supreme Court cases from 1816 to 1827, alleged that the defendant had infringed his copyright in twelve volumes of Supreme Court reports by publishing a competing and identical version of Supreme Court decisions.⁵⁸ The Supreme Court disagreed, and held that judicial opinions could not be copyrighted.⁵⁹

This decision was reaffirmed in 1888, in *Banks v. Manchester*.⁶⁰ There, the Court held that the official reporter for the Ohio Supreme Court could not obtain a copyright for the syllabus, the statement of the case, or the decision or opinion of the court, because they were prepared by the judges rather than by the reporter.⁶¹

However, in the same term in which it decided *Banks*, the Supreme Court faced a slightly different question. In *Callaghan v. Myers*,⁶² the

54. *Digital Communications*, 659 F. Supp. at 462-63.

55. *Rand McNally*, 600 F. Supp. at 940-41 (quoting Denicola, *supra* note 14, at 531-32).

56. See, e.g., *Building Officials & Code Adm'rs. v. Code Technology, Inc.*, 628 F.2d 730, 734 (1st Cir. 1980) ("[T]he cases go on to emphasize the very important and practical policy that citizens must have free access to the laws which govern them. This policy is, at bottom, based on the concept of due process."). See also *Nash v. Lathrop*, 142 Mass. 29, 6 N.E. 559 (1886).

57. 33 U.S. 591 (1834).

58. *Id.* at 593-94.

59. *Id.* at 668. The *Wheaton* Court also held that copyright was determined by statutory law rather than by common law principles. *Id.* at 661-62.

60. 128 U.S. 244 (1888).

61. *Id.* at 253-54.

62. 128 U.S. 617 (1888).

Court considered a copyright claim brought by the publishers of the Illinois Supreme Court reports, originally prepared by Norman Freeman, the official Illinois Supreme Court reporter.⁶³ In *Callaghan*, plaintiffs alleged that the defendants' copying extended to the title pages, table of cases, arrangement and paging of the volumes, statements of cases and the syllabi.⁶⁴ The Supreme Court held that a law publisher *could* claim a copyright for a "matter not embracing the written opinions of the court,"⁶⁵ which might include the arrangement, headnotes, table of cases, and pagination of the volumes.⁶⁶

With respect to the use of star-pagination, the central issue in the MDC-West dispute, only one prior case directly addressed the issue. In *Banks Law Publishing Co. v. Lawyers' Co-operative Publishing Co.*,⁶⁷ the Circuit Court of Appeals for the Second Circuit considered whether use of star-pagination in defendants' Lawyers' Edition of United States Supreme Court reports in order to reflect the paging in the official version published by plaintiff, infringed plaintiff's copyrighted reports. The court held that where a court reporter has a statutory duty to collect and publish a court's opinions, the reporter's copyright may not extend to the arrangement of cases, since the arrangement "so obviously was necessary to produce the volumes required by the statute."⁶⁸ The court distinguished copying the arrangement and paging of a volume of reports from copying headnotes or syllabi, which would have a much stronger copy-

63. *Id.* at 619-22.

64. *Id.* at 621-22.

65. *Callaghan v. Myers*, 128 U.S. 617, 649 (1888). In *Callaghan*, the plaintiff became the owner of several volumes of the reports of the Illinois Supreme Court, which had been prepared by and obtained from the official court reporter. The volumes contained not only the court's opinions but also material prepared by the reporter, including the title page, headnotes, a table of cases, etc. Plaintiff alleged that defendant had infringed its copyright in the volumes by republishing a series of reports which were copied from plaintiff's volumes. *Id.* at 622. The court recognized a copyright in the matter added by the reporter. *Id.* at 649. Such matter includes:

[the] title-page, table of cases, head-notes, statements of facts, arguments of counsel, and index. Such work of the reporter, which may be the lawful subject of copyright, comprehends also the order of arrangement of the cases, the division of the reports into volumes, the numbering and paging of the volumes, the table of the cases cited in the opinions, . . . and the subdivision of the index into appropriate, condensed titles, involving the distribution of the subjects of the various headnotes, and cross-references, where such exist.

Id.

66. *Id.* The Supreme Court concurred with circuit Justice Drummond that whether the arrangement and paging of cases were copyrightable depended on whether the editor used "labor, talent [and] judgment," or whether the arrangement and paging depended on "accidental circumstances." *Id.* at 661-62. Note that this language is virtually identical language to the Second Circuit's recently articulated "selection, creativity and judgment" standard for copyright of compilations. See *Financial Information*, 808 F.2d at 206-07.

67. 169 F. 386 (2d Cir. 1909), *dismissed*, 223 U.S. 738 (1911).

68. *Id.* at 388-90.

right claim.⁶⁹

These cases indicate that a volume of judicial opinions is a compilation of primarily factual material. Therefore, its author must exercise selection, creativity and judgment in creating the compilation in order to make the volume an original work of authorship eligible for copyright protection.⁷⁰ For example, if the arrangement of the cases is based on an accidental circumstance, such as the order in which the cases are decided, there may be no copyright protection available to the publisher.⁷¹ In *West Publishing Co. v. Mead Data Central*,⁷² the court had to draw the line between the uncopyrightable judicial opinions published in West's National Reporter System volumes, and the material added by West which evidenced selection, creativity and judgment, and which therefore was protected by copyright.

II. THE RECENT DISPUTE BETWEEN WEST AND MDC

West and MDC are well known leaders in the legal publishing and legal information fields. West collects and compiles the judicial opinions of state and federal courts. West arranges these opinions into its series of books known as the National Reporter System.⁷³ West also registers a copyright claim for each volume with the Register of Copyrights and

69. *Id.* at 390.

70. *West Publishing*, 799 F.2d at 1225: "*Callaghan* establishes at least that there is no *per se* rule excluding case arrangement from copyright protection, and that instead, in each case the arrangement must be evaluated in light of the originality and intellectual-creation standards." *Id.*

71. *Id.* at 1248 (Oliver, J., dissenting). The legislative history to the 1976 Copyright Act makes clear that copyright protection in a compilation extends only to original material added by the author. See H.R. REP. No. 1476, 94th Cong., 2d Sess. 57, reprinted in 1976 U.S. CODE CONG. & ADMIN. NEWS 5659, 5670.

72. 799 F.2d 1219.

73. *Id.* at 1221-22. West publishes a series of regional state reports, all of which are currently in their second series; reports from each state and the District of Columbia are included in the regional reporters. West also prints the official state reporter in Arizona, New Jersey, Pennsylvania, and contributes the syllabi, synopses, and index to the Oregon state reporter. In addition, the following states' court decisions appear only in a West regional reporter: Delaware, District of Columbia, and Maine (Atlantic); Iowa, Minnesota, North Dakota, and South Dakota (Northwestern); Alaska, Colorado, Oklahoma, Utah, and Wyoming (Pacific); West Virginia (Southeastern); Kentucky, Missouri, Tennessee, and Texas (Southwestern); and Alabama, Florida, Louisiana, and Mississippi (Southern). West also publishes a series of opinions from California (*California Reporter*); Illinois (*Illinois Decisions*); and New York (*New York Supplement*, now in its second series). West is also the only publisher which collects and prints a series of United States district court opinions (*Federal Supplement*) and United States court of appeals opinions (*Federal Reporter*, now in its second series). West publishes United States Supreme Court opinions in its *Supreme Court Reporter*. In addition, West collects opinions from the United States Court of Claims (*U.S. Claims Court Reports*), bankruptcy courts (*Bankruptcy Reporter*), and decisions pertaining to the Federal Rules of Civil Procedure (*Federal Rules Decisions*). Decisions in the last three reporters are sometimes also reported in the *Federal Reporter* or the *Federal Supplement*. Finally, West is the printer for slip opinions from the United States Court of Appeals for the Eleventh Circuit.

receives a separate Certificate of Registration for that volume.⁷⁴

MDC owns and operates LEXIS, a computer assisted legal research tool which contains reports of state and local judicial decisions in its database.⁷⁵ Most of the judicial opinions stored in the LEXIS database display the citation to the first page of West's National Reporter System report of the opinion, as well as the citation of the official state or federal report of the opinion.⁷⁶

In June, 1985, MDC announced a plan to include within the body of LEXIS a "star-pagination" system. This new feature would consist of the addition of the official page cites to the full text of on-line case law material.⁷⁷ Thus, a LEXIS user would be able to determine the West volume and page number coinciding with the text of a LEXIS report taken from a video monitor or computer printout, without the physical necessity of referring to the National Reporter volume in which the report appears. West claimed that MDC's proposed "star-pagination" system was an appropriation of West's comprehensive arrangement of case reports in violation of the Copyright Revision Act of 1976.⁷⁸ West sought injunctive relief to stop MDC's alleged infringement.⁷⁹

The United States District Court held that the page numbers of West's reporters were protected by West's copyright in the volumes. It found that West's effort in collecting and organizing opinions into volumes met the test of labor, talent, and judgment necessary to establish copyright protection for a compilation.⁸⁰ Further, it found that MDC's proposed use of the National Reporter System page numbers in LEXIS was not fair use of the copyrighted material.⁸¹ Accordingly, it issued a preliminary injunction halting MDC's star-pagination project. MDC made an interlocutory appeal to the Eighth Circuit, which affirmed the district court decision.⁸²

The Eighth Circuit analyzed two questions in deciding whether to uphold the district court's grant of injunctive relief to West. First, the court discussed West's claimed copyright in the arrangement of cases and the resulting page numbers of its volumes of judicial opinions.⁸³ Sec-

74. *West Publishing*, 799 F.2d at 1222.

75. *Id.*

76. *Id.*

77. *Id.*

78. 17 U.S.C. §§ 101-810.

79. *West Publishing Co. v. Mead Data Cent.*, 616 F. Supp. 1571 (D. Minn. 1985), *aff'd*, 799 F.2d 1219 (8th Cir. 1986), *cert. denied*, 107 S. Ct. 962 (1987).

80. *Id.* at 1576.

81. *Id.* at 1580.

82. *West Publishing*, 799 F.2d 1219.

83. *Id.* at 1223.

ond, the court analyzed whether MDC's proposed use of West's page numbers infringed on West's copyright.⁸⁴

The court noted that the Supreme Court had found pagination and arrangement to be appropriate matters for copyright protection and were to be evaluated in light of the originality and independent creation of the particular arrangement.⁸⁵ Testing West's editorial efforts against this standard, it found that West collected opinions from the various state and federal courts from across the country, and separated the state from the federal decisions. It divided the state opinions into its various regional reporters, or compiled them into an appropriate state reporter. Further, West divided the various federal judicial opinions at the United States district court and United States court of appeals levels. District court opinions were further subdivided by subject matter, such as bankruptcy or federal rules. The court found that, given the copyright law's minimal standard for originality, West's effort satisfied the Supreme Court's test of labor, talent and judgement.⁸⁶

Rejecting MDC's argument that the pagination and the arrangement of court decisions were not appropriate subject matter for copyright protection, the court distinguished *Banks Law Publishing Co. v. Lawyers' Co-operative Publishing Co.*⁸⁷ The plaintiff in *Banks* was the official court reporter who had a statutory duty to print and publish the decisions of the Supreme Court; the *Banks* court held that a reporter required by law to collect, arrange, and paginate cases was not entitled to copyright protection.⁸⁸ West, on the other hand, was not an official reporter for any court, and on its own initiative expended labor and talent compiling and publishing its reporters.⁸⁹

The Eighth Circuit panel also rejected MDC's contention that West sought to protect only numbers on pages. The court found that West did not want to protect the page numbers as such, but rather wanted to protect them because their use in LEXIS would give access to what West had spent labor and effort in compiling. The key to the case, according to the court, was "whether the copyright on the books as a whole is infringed by the unauthorized appropriation of these particular numbers."⁹⁰

84. *Id.* at 1227-28.

85. *Id.* at 1224-25.

86. *Id.* at 1226-27. See *supra* note 65 and accompanying text.

87. 169 F. 386 (2d Cir. 1909), *appeal dismissed per stipulation*, 223 U.S. 738 (1911).

88. *Id.* at 389-90.

89. *West Publishing*, 799 F.2d at 1226. The court offers only a perfunctory explanation of its conclusion that West is not an official reporter. *Id.*

90. *Id.* at 1227.

The court found that MDC's proposed use of West's page numbers in LEXIS would infringe upon West's copyright in its arrangement of cases.⁹¹ The court determined that by using the LEXIS star-pagination system, a subscriber could call up the first case in a National Reporter System volume, and then page through the case. By repeating this procedure, the subscriber could, in effect, page through an entire volume. The fact that such a procedure would be uneconomical, or that a subscriber would be unlikely to use LEXIS in that manner was not relevant to the court in its determination of infringement.⁹²

In addition, the court found that putting the West page numbers in LEXIS was infringement "because they enable[d] LEXIS users to discern the precise location in West's arrangement of the portion of the opinion being viewed."⁹³ As a result, the court reasoned that LEXIS subscribers would have no need to purchase West's reporters to obtain each aspect of West's arrangement. Thus, use of West's page numbers in LEXIS would supplant a portion of the market for West's reports. The court reasoned that "a use that supplants any part of the normal market for a copyrighted work would ordinarily be considered an infringement,"⁹⁴ and concluded that West had demonstrated a likelihood of success on the merits of its copyright claim. Accordingly, it affirmed the grant of the preliminary injunction against MDC's use of West's page numbers in LEXIS.⁹⁵

The dissent raised two key issues. First, the dissent did not believe

91. *Id.*

92. *West Publishing*, 799 F.2d at 1227.

93. *Id.*

94. *Id.* at 1228. The *West Publishing* court's discussion of infringement confused fair use—which is a defense to an infringement action—with infringement. The quotation by the court from *Harper & Row Publishers v. Nation Enterprises*, 471 U.S. 539 (1985), is taken from the Supreme Court's discussion of fair use, not from a discussion of infringement. The effect on the market of a copyrighted work is one of the factors to be considered in determining whether a particular use of the copyrighted work is fair use. 17 U.S.C. § 104(4). Unless a work is infringing, generally determined by whether it is "substantially similar" to the copyrighted work, the question of fair use does not arise. Thus, the *West Publishing* court did not apply the appropriate test to determine whether LEXIS with star pagination infringes West's copyright.

95. *West Publishing*, 799 F.2d at 1229. The court also affirmed the district court's holding that use of West's page numbers in LEXIS was not fair use. See *West Publishing*, 616 F. Supp. at 1580. Apparently, MDC did not raise the question of fair use at the appellate level. See *West Publishing*, 799 F.2d at 1228 n.3. The district court examined the four fair use factors given in 17 U.S.C. § 107. First, it found that MDC's purpose was commercial; a commercial use weighs against a finding of fair use. *West Publishing*, 616 F. Supp. at 1580. Second, it found that the page numbers constituted a substantial part of West's reports. *Id.* at 1580-81. Next, it noted that a factual compilation is generally granted a wider degree of fair use than an original work. *Id.* at 1580. Finally, the court found that using West's page numbers in LEXIS would have a serious effect on the market for West's reports. The effect on the market is generally considered the most important of the fair use factors. *Id.* at 1581. Accordingly, the court held that MDC's proposed use of West's page numbers was not fair use. *Id.*

that the record had established that the pagination of West's reports could be considered an original work of authorship. According to the dissent, the record did not show whether the page numbers of West's reports were generated automatically by a word processor, or whether they could factually be considered an original work of authorship.⁹⁶ In the dissent's view, if the page numbers were "no more than the work of a machine responding to a punch of a button," their creation would not have been the result of sufficient intellectual labor to merit copyright protection.⁹⁷

Second, the dissent disagreed that inclusion of West's page numbers in LEXIS meant that MDC had copied the arrangement of West's reporters. According to the dissent, MDC did not intend to use any of West's headnotes, synopses, tables, or key number classifications.⁹⁸ Rather, it intended only to add star-pagination to its LEXIS opinions, a practice which "law book publishers in the United States have long and traditionally used" in reporting court opinions which have been taken verbatim from previously published and copyrighted works.⁹⁹ The judicial opinions themselves are in the public domain. The dissent concluded that since West could not claim a copyright in the opinions themselves, it could not protect the page numbers of those opinions.¹⁰⁰

III. ANALYSIS

At first glance, litigation about whether page numbers can be copyrighted may appear to be trivial. However, underlying the *West Publishing* case, as well as other cases raising similar issues,¹⁰¹ is a problem of

96. *West Publishing*, 799 F.2d at 1237 (Oliver, J., dissenting).

97. *Id.* at 1239.

98. *Id.* at 1234.

99. *Id.* at 1235.

100. *Id.* at 1247-48. The dissent cited *Eggers v. Sun Sales Corp.*, 263 F. 373 (2d Cir. 1920). In that case, the question was whether the defendant's use of the same pages used by the plaintiff in a copyrighted version of General Pershing's World War I Official Report, a public document infringed plaintiff's copyright. The Second Circuit held the copyright was not infringed; the court reasoned that since all that the defendant had copied was an official report which could not be copyrighted, the copying of page numbers and the "get-up" of the report was not infringement. *Id.* at 375.

101. *See, e.g.*, *Building Officials & Code Adm'rs. v. Code Technology, Inc.*, 628 F.2d 730, 732-35 (1st Cir. 1980) (discussing whether plaintiff's virtual authorship of the Massachusetts building code entitled it to enforce a copyright monopoly over when, where and how the building code was to be reproduced and made publicly available); *Texas v. West Publishing Co.*, 681 F. Supp. 1228 (W.D. Tex. 1988) (dismissing for lack of an actual controversy Texas' claim that the copyright West claimed in the statutory headings and article numbers in its published version of the Texas statutes was invalid); *Georgia v. Harrison Co.*, 548 F. Supp. 110, 114-15 (N.D. Ga. 1982), *vacated as settled*, 559 F. Supp. 37 (N.D. Ga. 1983) (discussing whether a state could claim a copyright in the official codification of its statutes or in the title, chapter and article headings); and unofficial Attorney General Opinion from Illinois Attorney General Neil F. Hartigan, dated October 19, 1987 (discussing whether the State of Illinois could be liable for copyright infringement if a bill making the classifica-

fundamental importance to the legal profession — the manner in which court opinions are to be cited in legal briefs, memoranda, and articles. West's page numbers are important because they play a key role in current citation form.¹⁰² If West has an exclusive right to use the page numbers because they are protected by copyright, and if current legal citation rules remain as they are now, then West has few barriers to maintaining its virtual monopoly position in the legal publishing field.¹⁰³ The important question in the *West Publishing* case was whether West could claim a copyright in the page numbers of its arrangements, and thus prevent MDC from using the page numbers in LEXIS, even though the judicial opinions on those pages are not protected by copyright.

As noted previously, compilations are defined as works formed by collecting and assembling preexisting materials which are selected or arranged in such a way that the work as a whole is an original work of authorship. Compilations are expressly granted copyright protection in the 1976 Copyright Act.¹⁰⁴ The owner of a copyright has several exclusive rights including the right to reproduce the work in copies, the right to distribute copies of the work, and the right to prepare derivative works.¹⁰⁵

In the *West Publishing* case, the right which West apparently contended that MDC would violate with its star-pagination system was the right to reproduce a copyrighted work in copies.¹⁰⁶ With respect to that issue, the court's initial task was to determine whether MDC's inclusion of the page numbers of judicial opinions reported in West's volumes in the LEXIS data base amounted to reproducing the volumes as a whole, thus violating West's exclusive right to make copies of its copyrighted compilations. This task, in turn, required the court to answer two distinct questions: 1) does West's copyrighted arrangement include the page

tion and numbering scheme in West's compilation of Illinois statutes public domain material became law).

102. See BLUEBOOK, *supra* note 4, Rule 3.3(a).

103. On August 18, 1987, MDC filed an antitrust complaint against West in the United States District Court for the Southern District of Ohio. The complaint sought damages and injunctive relief. MDC alleged that West had become the sole published source for most United States courts, and had attempted to prevent competitors from having access to published judicial opinions. The complaint further alleged that West maintained its monopoly power by systematically acquiring competitors and through other anticompetitive practices. See Complaint, *Mead Data Cent. v. West Publishing Co.*, No. C-3-87-426 (S.D. Ohio, filed Aug. 18, 1987). This complaint was dismissed as part of the West-MDC settlement. Blodgett, *supra* note 1, at 36.

104. See 17 U.S.C. § 103.

105. 17 U.S.C. § 106. The exclusive rights also include the right to publicly perform a literary, musical, dramatic or choreographic work, or motion picture publicly; and to display certain types of works publicly. *Id.* at § 106(4) and (5).

106. See *supra* note 37 and accompanying text.

numbers of its reporters, and, 2) if West's copyright protection does extend to the page numbers of its volumes, does MDC's use in LEXIS of those page numbers infringe West's copyright?

A. Copyrighting Law Reports as Compilations — The Meaning of "Arrangement"

The Eighth Circuit found that West's "arrangement" of cases was a copyrightable aspect of West's compilations, and that the pagination of the volumes "reflect[ed] and expresse[d] West's arrangement."¹⁰⁷ The court also held that that the internal page citations were an important part of that arrangement.¹⁰⁸ The court, however, failed to define what it meant by West's "arrangement."

The *West Publishing* court did not point to any precise factual findings which supported its conclusion that use of West's page numbers in LEXIS was tantamount to copying the arrangement of West's reporters. This omission was significant, because the court ignored the fact that MDC did not propose to include page numbers of West's reporters which correspond to headnotes, key number guides, case tables, or case summaries; West's copyright in such material is undisputed. Instead, the court found that West's copyright protected page numbers associated with uncopyrightable judicial opinions. Such protection is broader than that usually offered to factual compilations.¹⁰⁹

As a general rule, the copyright in a compilation extends only to material that is contributed by the author and does not give the author of the compilation any exclusive right in the preexisting material.¹¹⁰ As the *West Publishing* dissent pointed out, if the page numbers are to be considered part of West's "new" copyrighted material, they should be works of original authorship, that is, material selected, arranged, or organized by West.¹¹¹ The dissent explained further that while the standard for originality may be minimal, there must be at least a "modicum of intellectual effort."¹¹²

For example, in *Toro Co. v. R & R Products Co.*,¹¹³ the manufac-

107. *West Publishing*, 799 F.2d at 1223.

108. *Id.* at 1227.

109. *Id.* at 1228. Cf. *Financial Information v. Moody's Investors Serv.*, 808 F.2d 204 (2d Cir. 1986), cert. denied, 108 S. Ct. 79 (1987); *Toro Co. v. R & R Prods. Co.*, 787 F.2d 1208 (8th Cir. 1986); *Gem Prods., v. Robertshaw Controls Co.*, 1986 Copyright L. Dec. (CCH) ¶ 25,975 (C.D. Cal. Feb. 27, 1986).

110. 17 U.S.C. § 103(a).

111. See *West Publishing*, 799 F.2d at 1233 (Oliver, J., dissenting).

112. *West Publishing*, 799 F.2d at 1227.

113. 787 F.2d 1208 (8th Cir. 1986).

turer created a numbering system for replacement parts for its lawn equipment in which each part was given a five or six digit number. A competitor, in its catalog, used identical numbers for each part, except that the letter "R" was added to each number. The manufacturer claimed that the use of the part numbers infringed the copyright it claimed in the parts numbering system. However, the court held that the numbering system lacked the originality required for copyright protection. Since the numbers were arbitrarily and randomly assigned to each part, the court found insufficient originality to distinguish authorship.¹¹⁴

In *West Publishing*, the record did not disclose how the page numbers were generated for West's reports. The dissent noted that the pagination of a slip opinion was generally the work of the judge's secretary or word processor; if West's page numbers were similarly generated as "an electronic response to a direction given a machine,"¹¹⁵ their creation would lack the originality required for copyright protection. Like the arbitrary numbering of replacement parts,¹¹⁶ the page numbers would be randomly generated and lacking independent creation.¹¹⁷

In another recent case involving the originality of a compilation of factual material, *Financial Information v. Moody's Investors Service*,¹¹⁸ the Second Circuit considered whether plaintiff's Daily Bond Cards were sufficiently original to merit copyright protection. The court noted that the clerks who recorded municipal bond facts gleaned then from "tombstone ads" in newspapers and that this practice did not require special skills.¹¹⁹ The court affirmed the district court's factual finding that "[w]ith this data, there is no room for selection or choices or judgment."¹²⁰ Accordingly, it denied the Daily Bond Cards copyright protection.¹²¹

114. See *id.* at 1213.

115. *West Publishing*, 799 F.2d at 1237 (Oliver, J., dissenting).

116. See *Toro*, 787 F.2d at 1213. "The random and arbitrary use of numbers in the public domain does not evince enough originality to distinguish authorship." *Id.*

117. In a word processing program, the operator can generally set parameters such as line length, line spacing, or page length. Once these initial decisions are made, the program determines where actual page breaks occur. If no decision as to line length or spacing is made by the operator, the program will generally create pages based on a "default" or predetermined line length, page length and line spacing. The minimal effort required to set page breaks on a word processing program can be distinguished from the creativity needed to generate an index or table of contents by computer. Index entries would have to be chosen by the editor, based on his or her purpose in creating the index, before the computer program could locate, retrieve and arrange the words or phrases selected by the editor. Thus, several different indexes could be generated from one article, depending on the needs or judgment of the editor.

118. 808 F.2d 204.

119. *Id.* at 206.

120. *Id.* at 207.

121. *Id.* at 208.

In the *West Publishing* case, the court seemed to take a different approach. The court made no finding as to the degree of selection or judgment exercised by West in paging its reports; it nonetheless determined that the page citations were protected by copyright. This conclusion is not persuasive without evidence of how West's page numbers are actually created. For example, there was apparently no quantitative indication in the record of how much independent effort West uses in creating its arrangements and in assigning its page numbers.¹²² If the cases are arranged merely by date, and the pages are determined by the printing and typesetting process, then the arrangement and page numbers are not compiled solely through West's efforts.

Another problem which resulted from the court's failure to define arrangement is that we do not know precisely what is protected by West's copyright. First, the court did not say whether it recognized West's "selection, creativity, and judgment," in creating its reporters, as the second circuit did in *Eckes v. Card Prices Update*.¹²³ In that case the court held that a compilation of the most valuable baseball cards was copyrightable because the compilers used selection, creativity and judgment in selecting 5000 premium cards from approximately 18,000 cards available.¹²⁴

Second, the *West Publishing* court failed to say whether it recognized the "sweat-of-the-brow" of West's editors in compiling its reports, the standard espoused by the Eighth Circuit in *Hutchinson Telephone Co. v. Fronteer Directory Co.*¹²⁵ In that case, the court found that the labor of the telephone company which had compiled a list of telephone customers and their numbers was sufficient to allow copyright protection for the telephone directory.¹²⁶ Finally, the *West Publishing* court did not indicate whether West's copyright protected the actual case order contained in the National Reporter System volumes.¹²⁷

The clearest clue to the *West Publishing* court's meaning of "arrangement" is its statement that "[c]ommunication to LEXIS users of the location in West's arrangement of specific portions of text is precisely

122. *West Publishing*, 799 F.2d at 1237 (Oliver, J., dissenting).

123. 736 F.2d 859, 863 (2d Cir. 1984).

124. *Id.*

125. 770 F.2d 128 (8th Cir. 1985). If the *West Publishing* court based West's copyright on its labor in compiling its arrangement, MDC should prevail. In terms of collecting and organizing the judicial opinions, West and MDC do equal work; each collects opinions from courts, judges, and court reporters. There was no allegation by West that MDC copies opinions from West's reporters.

126. *Id.* at 131-32.

127. See *Rockford Map Publishers v. Directory Serv. Co.*, 768 F.2d 145 (7th Cir.), cert. denied, 474 U.S. 1061 (1985).

what the LEXIS Star Pagination Feature is designed to do.”¹²⁸ Apparently, by “West’s arrangement” the court meant the physical arrangement of cases, synopses, and headnotes in West’s volumes.¹²⁹ However, this definition of arrangement does not offer a great deal of protection when printed factual material is included in a computer data base such as LEXIS.

For example, the arrangement of cases in LEXIS’ computer data base is different from West’s arrangement of cases in its National Reporter System volumes. LEXIS has no predetermined arrangement of cases, while the physical arrangement of West’s volume is established when a bound volume is printed. A LEXIS search can retrieve cases from one West volume, several West volumes, or no West volume, in any order, depending on the instructions given to the computer. The opposite is not true, however. For example, in West’s Federal Reporter, 2d Series, volume 799, the case *Culbreath v. Block*,¹³⁰ will always come directly after *West Publishing Co. v. Mead Data Central*.¹³¹ This is exactly the problem anticipated by Professor Denicola in *Copyright in Collections of Facts: A Theory for the Protection of Nonfiction Literary Work*.¹³² Arrangement alone as a basis for the copyright of a compilation of factual material no longer offers real protection to the copyright holder, since a computer data base can easily subsume both the collection of facts, and its original form without copying the physical arrangement.¹³³

West might have argued that the page numbers of its reports are the necessary byproduct of the number and length of the headnotes, the size

128. *West Publishing*, 799 F.2d at 1228.

129. *Id.* at 1227. The court described how a LEXIS user could view the arrangement of cases in every volume of the National Reporter System by paging through each succeeding case in the West reporter. The court did not consider that a LEXIS user would not be able to see headnotes, key numbers, and other material added by West. A LEXIS user would only be able to view the uncopyrightable judicial opinions. Therefore, unless material added by West to its volumes of judicial opinions is considered insignificant, a LEXIS user could not view West’s arrangement.

130. 799 F.2d 1248 (8th Cir. 1986).

131. 799 F.2d 1219.

132. See Denicola, *supra* note 14, at 531.

133. If the protected aspect of a compilation is the arrangement of the data in compilation, there is a clear problem in showing infringement if the facts are incorporated into a computer data base without copying the original arrangement. If the facts are presented in a different arrangement than in the copyrighted work, there is no substantial similarity between the works—all that has been copied are uncopyrightable facts. The copyright protects only the overall arrangement of facts, which has not been copied. See *Gem Prods. v. Robertshaw Controls Co.*, 1986 Copyright L. Dec. (CCH) ¶ 25,975 (C.D. Cal. Feb. 27, 1986). This situation demonstrates why the basis for a copyright in a compilation should not be the arrangement of data in the compilation; rather, to be eligible for copyright protection, the material in a compilation should reflect the selection, creativity and judgment of the compiler. This test gives a compiler protection against one who copies an arrangement of factual material and publishes it in a different arrangement, such as in a computer data base rather than in printed form. See *Financial Information*, 808 F.2d at 207-08.

and style of the typeface, and the page layout. Since these are editorial decisions which reflect selection, creativity and judgment, the resulting page numbers also reflect selection, creativity and judgment, and, therefore, should be protected.¹³⁴ This argument has some appeal; however, it misses the fundamental functional purpose of page numbers.

The page numbers of any publication are a *result* of editorial decisions as to length of the text, typeface, layout and size of the page. They are a means of locating material in a publication, and they are part of a system of reference. Once a system of page numbering is established for a publication, page two will always come after page one. Moreover, decisions as to layout, typestyle, or even the number of headnotes determine only how much is on a page; substance is not affected.

The purpose of a page number is to provide a reference point for the text; the expression of this purpose is the page number itself. Page numbers are essential to virtually any printed publication. They are like rules of a game, which can be expressed only one way.¹³⁵ Where an expression is limited as such, the purpose and the expression merge, and the merged purpose/expression cannot be protected by copyright.¹³⁶ To allow West a copyright in the page numbers of its volumes amounts to granting them a copyright in a numbering system which has a singular method of expression. Thus, there is serious doubt whether the copyright in a compi-

134. The district court stated that such editorial decisions would not be an exercise of independent judgment for an official reporter, because his or her duties are mandated. *West Publishing*, 616 F. Supp. at 1577.

135. See *Atari, Inc. v. North Amer. Philips Consumer Elecs. Corp.*, 672 F.2d 607, 616-17 (7th Cir.), cert. denied, 459 U.S. 880 (1982). See also *Affiliated Hosp. Prods. v. Merdel Game Mfg. Co.*, 513 F.2d 1183 (2d Cir. 1975). In *Merdel*, the court held that a defendant did not infringe plaintiff's rulebook for table top games by publishing a competing rulebook prepared in part from reference to plaintiff's book. The court found that the game and its rules are in the public domain, and "the simplicity of the games makes the subject matter extremely narrow, and the distinction between substance and arrangement blurs." *Id.* at 1188. In other words, the rules are so closely tied to the idea of the game, which cannot be protected, that the rules themselves cannot be protected.

136. There is nothing unique about the page numbering system in West's reports; one Arabic number follows another in ascending order. There is no selection or judgment demonstrated by the numbers which appear on the pages in West's reports. See *Toro*, 787 F.2d at 1213, which described a parts numbering system as "the accidental marriage of a part and a number." *Id.* In addition, the idea of numbering pages, and the expression of that idea are essentially one. Once a decision is made to number pages, the expression is determined for all practical purposes—one Arabic number will follow another in ascending order. "[W]here idea and expression are indistinguishable, the copyright will protect against only identical copying." *Atari*, 672 F.2d at 616. Similarly,

when the "idea" and "expression" are thus inseparable, copying the "expression" will not be barred, since protecting the "expression" in such circumstances would confer a monopoly of the "idea" upon the copyright owner free of the conditions and limitations imposed by the patent law.

Herbert Rosenthal Jewelry Corp. v. Kalpakian, 446 F.2d 738, 742 (9th Cir. 1971) (granting West a copyright in the page numbers of its reports amounts to protecting an idea which is indistinguishable from its expression).

lation of law reports should include the page numbers on which the uncopyrightable judicial opinions are located.

B. *Infringement — Substantial Similarity*

To show that MDC infringed West's copyright, West had to show two items: first, that MDC had access to West's copyrighted material; and second, that the LEXIS data base with star-pagination was "substantially similar" to West's copyrighted work.¹³⁷ There was no question that MDC had access to West's copyrighted works. The question which remained, then, was whether the works were substantially similar.¹³⁸

Substantial similarity turns on whether the copying work is so similar to the plaintiff's work that a reasonable person would conclude that defendant appropriated the plaintiff's protected expression by taking material of value and substance; this is often called the "ordinary observer" test.¹³⁹ Elements of a work that are protected by copyright are the only elements to be taken into account. To constitute infringement, both the underlying idea and the expression of that idea must be copied.¹⁴⁰ In *West Publishing*, the court did not expressly determine whether LEXIS with star-pagination was substantially similar to West's printed reports. Had the proper test been applied, the results would have demonstrated the weakness of West's claim that MDC's proposed star-pagination infringed West's copyright.

Importantly, the LEXIS data base with star-pagination would not contain West's synopses, headnotes, tables, or key number classifications, which appear in West's printed volumes. This is the material which is clearly entitled to copyright protection. A LEXIS subscriber could not retrieve an entire volume of West reports, even if she or he wanted to do so, since the material added by West to the judicial opinions is not in LEXIS.¹⁴¹ It follows that even with a star-pagination feature, LEXIS could not copy the physical arrangement of West's volumes. A LEXIS subscriber could only view the actual judicial opinions, which are clearly not copyrightable, with their corresponding page numbers. Pages which contain only headnotes, tables or similar material would not be present in LEXIS. Thus, even if West's page numbers which correspond to judicial

137. *Atari*, 672 F.2d at 614.

138. *See Farmers Indep. Tel. Co. v. Thorman*, 648 F. Supp. 457, 459-60 (W.D. Wis. 1986).

139. *Atari*, 672 F.2d at 614.

140. *Id. See Mazer v. Stein*, 347 U.S. 201 (1954). The Court there noted that a copyright gives no exclusive right to the idea expressed in a work, only to the expression itself. *Id.* at 217.

141. MDC does not propose to include West's headnotes or other similar material in LEXIS. *West Publishing*, 799 F.2d at 1223.

opinions are present in the LEXIS data base, the LEXIS "arrangement" of cases will not copy West's entire physical arrangement. Similarly, an "ordinary observer" would be hard pressed to determine that LEXIS' "arrangement" of cases is substantially similar to West's arrangement, if the only part of West's arrangement present in LEXIS is page numbers and other uncopyrightable material.¹⁴²

The *West Publishing* court characterized the proposed use of West's page numbers in LEXIS as "wholesale appropriation," comparing it to copying every listing in a telephone directory.¹⁴³ This analogy is not appropriate. There is a long line of case law holding that telephone directories and similar publications are eligible for copyright protection.¹⁴⁴ These cases are generally based on the "sweat-of-the-brow" criteria, which has been described as follows:

The man who goes through the streets of a town and puts down the names of each of the inhabitants, with their occupations and their street number, 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.¹⁴⁵

Conversely, copyright protection for page numbers and similar numbering systems have been treated differently than copyright protection for directories. For example, in *Eggers v. Sun Sales Corp.*,¹⁴⁶ the Second Circuit showed how identical page numbering does not necessarily lead to a finding of substantial similarity. In that case, the court considered whether the plaintiff could prevent the defendant from imitating the plaintiff's publication of General Pershing's official report of World War I, an official public document.¹⁴⁷ The defendant had set its version of the report in the same number of pages as had the plaintiff, but did not copy the ornamentation or pictures added to the pamphlet by the plaintiff. The court held that since all that the defendant had copied was the official report, they had not infringed plaintiff's copyright. Significantly, the fact that the page numbers were identical in each publication was

142. See *Atari*, 672 F.2d at 614, and *supra* note 136 and accompanying text.

143. *West Publishing*, 799 F.2d at 1228.

144. *Id.* 799 F.2d at 1238 (Oliver, J., dissenting). Directory cases generally find originality in the compiler's independent effort in obtaining and arranging the information in the directory.

145. *Hutchinson Tel. Co. v. Fronteer Directory Co.*, 770 F.2d 128, 131 (8th Cir. 1985) (quoting *Jeweler's Circular Publishing Co. v. Keystone Publishing Co.*, 281 F. 83, 88 (2d Cir. 1922)). See also *Southwestern Bell Tel. Co. v. Nationwide Indep. Directory Serv.*, 371 F. Supp. 900, 905 (W.D. Ark. 1974) (listing numerous cases finding a directory copyrightable based on compiler's "sweat-of-the-brow").

146. 263 F. 373 (2d Cir. 1920).

147. *Id.* at 374.

insufficient to constitute infringement.¹⁴⁸

Similarly, in *Gem Products v. Robertshaw Controls Co.*,¹⁴⁹ Gem claimed that Robertshaw had infringed its copyright in a parts catalog. Robertshaw had included Gem's part numbers in a comprehensive computer data base of parts information it maintained, which was derived from catalogs, publications, price lists, brochures and labels. The court held that plaintiff's copyright in the catalog did not protect the parts numbers in the catalog. Gem's copyright only extended to the arrangement of the material contained in the catalog. The court explained that the parts numbers themselves were "facts," which were not protected by copyright law, and their use in a catalog was not copyright infringement.¹⁵⁰

West and MDC use equal effort and ingenuity in collecting and compiling judicial opinions; there was no allegation that MDC copied the court opinions included in its LEXIS database directly from West's publications. The page numbers of West's reports are more closely analogous to the alphabetical indicators given at the top of most telephone directories than to the directories themselves. In other words, they are guides to locating individual cases within the arrangement, rather than a part of the arrangement itself. Such short descriptive phrases are not eligible for copyright protection.¹⁵¹

For example, in *Mathew Bender & Co. v. Kluwer Law Book Publishers*,¹⁵² Bender argued that a chart which compiled representative settlement and award data in medical malpractice cases was a copyrightable aspect of a nine volume publication entitled *Damages in Tort Actions*. The court found that Bender could not copyright the column headings

148. *Id.* at 375. The court stated that:

[the defendant's] conduct may be called mean, but it is not punishable under the Copyright Act. . . . It is even possible that defendants' printers set up the official report from a copy of plaintiff's book; identity of pagination leads to that suspicion; but legally that is not of sufficient importance to constitute infringement of copyright.

Id. (citing *Banks Law Publishing Co. v. Lawyers' Co-operative Publishing Co.*, 169 F. 386 (1909) *dismissed per stipulation* 223 U.S. 738 (1911)). The idea that copying of paging by itself is insufficient to constitute infringement was also acknowledged by the Court in *Callaghan v. Myers*, 128 U.S. 617 (1888).

Here the object on the part of the defendants seems to have been that there should not be confusion in the references and examination of cases; but the arrangement of cases and the paging of the volumes is a labor inconsiderable in itself, and I regard it, not as an independent matter, but in connection with other similarities existing between the two editions. . . .

Id. at 662.

149. 1986 Copyright L. Dec. (CCH) ¶ 25,975 (C.D. Cal. Feb. 27, 1986).

150. *Id.* at ¶ 20,450-451.

151. See *Mathew Bender & Co. v. Kluwer Law Book Publishers*, 672 F. Supp. 107, 110-11 (S.D.N.Y. 1987).

152. 672 F. Supp. 107.

used in the chart, since terms like "amount" and "jurisdiction" were taken from the normal usage of courts in describing key aspects of cases. Since the terms used in the chart were the most logical and clear way of expressing the idea to be conveyed, they could not be protected.¹⁵³

The *West Publishing* court failed to recognize that MDC did not intend to include West's headnotes and similar material within LEXIS. In effect, the court implied that the headnotes, synopses and other material added by West to the judicial opinions were irrelevant to the arrangement; the only "important part"¹⁵⁴ of West's arrangement which star-pagination would copy was the page numbers *which correspond to the uncopyrightable judicial opinions*. This analysis skips a step, however. Rather than asking whether LEXIS with star-pagination would be substantially similar to a volume of West's reports,¹⁵⁵ the court simply concluded that LEXIS with star-pagination would harm the market for West's reports. The court's question is part of the "fair use" inquiry, which is a defense to copyright infringement.¹⁵⁶

"Fair use" was defined traditionally as "a privilege in others than the owner of the copyright to use the copyrighted material in a reasonable manner without his consent."¹⁵⁷ The 1976 Copyright Act codified this judge-made definition of the fair use doctrine,¹⁵⁸ the Act's purpose was to restate the existing law rather than change it in any way.¹⁵⁹ Thus, the Act does not strictly define "fair use," but rather leaves much discretion to the courts by providing a list of four general factors to be considered in determining "fair use":¹⁶⁰

(1) the "purpose and character of the use, including whether such use is of a commercial, for profit nature or is for nonprofit educational purposes"¹⁶¹ (a commercial use of copyrighted material is generally regarded as unfair);¹⁶²

(2) "the nature of the copyrighted work"¹⁶³ (the law recognizes a

153. *Id.* at 110-11.

154. *West Publishing*, 799 F.2d at 1227.

155. West does not claim a copyright on its entire National Reporter System. Each volume published by West has its own copyright. *Id.* at 1233 (Oliver, J., dissenting).

156. See 17 U.S.C. § 107; *Harper & Row Publishers v. Nation Enters.*, 471 U.S. 539, 549 (1985).

157. *Harper & Row*, 471 U.S. at 549 (quoting H. BALL, *LAW OF COPYRIGHT AND LITERARY PROPERTY* 260 (1944)).

158. 17 U.S.C. § 107.

159. "Section 107 is intended to restate the present judicial doctrine of fair use, not to change, narrow or enlarge it in any way." 17 U.S.C.A. § 107 Historical Note.

160. See 3 M.B. NIMMER & D. NIMMER, *supra* note 13, at § 13.05(A).

161. 17 U.S.C. § 107(1). Section 107 gives as examples of possible fair use reproduction for purposes of "criticism, comment, news reporting, teaching, . . . scholarship, or research" *Id.*

162. 3 M.B. NIMMER & D. NIMMER, *supra* note 13, at § 13.05(A).

163. 17 U.S.C. § 107(2).

greater public importance in disseminating factual works, such as text books, than works of fiction);¹⁶⁴

(3) the "amount and substantiality of the portion used in relation to the copyrighted work as a whole"¹⁶⁵ (courts have taken a somewhat subjective approach in evaluating this factor, focusing on whether the portion of the work used is "qualitatively substantial");¹⁶⁶

(4) "the effect of the use upon the potential market for or value of the copyrighted work"¹⁶⁷ (This factor has been regarded as the most important for the purpose of evaluating whether a particular use is fair use;¹⁶⁸ it examines whether unrestricted conduct of the sort engaged in by defendant would have a "substantially adverse impact on the potential market for or value of the plaintiff's present work."¹⁶⁹ Accordingly, where two works at issue share the same function and hence the same market, the scope of fair use is restricted.)¹⁷⁰

The question of fair use does not arise, however, until infringement is shown by a finding that the infringing work is substantially similar to the copyrighted work. In *West Publishing*, the court incorrectly tested for infringement by combining the infringement and fair use inquiries.¹⁷¹ The court took a broad view of the limits of copyright protection when it concluded that West had demonstrated a likelihood of success on the merits of its infringement claim. First, unlike the *Eggers* court, the *West Publishing* court found that page numbers of factual material were of sufficient importance in a copyrighted work to warrant a finding of infringement when they were copied in a competing work.¹⁷² Second, unlike the *Toro Products* court, which refused to grant copyright protection to a randomly assigned parts numbering system, the *West Publishing*

164. *Harper & Row*, 471 U.S. at 563.

165. 17 U.S.C. § 107(3).

166. *Harper & Row*, 471 U.S. at 565. The Court in *Harper & Row* found that Nation's use of 300 words of a 200,000 word manuscript was not fair use because the Nation "took what was essentially the heart of the book." *Id.* at 564-65.

167. 17 U.S.C. § 107(4).

168. *Harper and Row*, 471 U.S. at 566.

169. 3 M.B. NIMMER & D. NIMMER, *supra* note 13, at § 13.05(A).

170. *Id.* at § 13.05(B).

171. See *West Publishing*, 799 F.2d at 1227-28. The *West Publishing* district court did analyze the fair use factors, and found that MDC's proposed use of star-pagination in LEXIS would not be fair use. That court determined that West's printed reports and LEXIS have the same purpose and fulfill the same function; further, the court believed that inclusion of West's page numbers in LEXIS would make West's reports unnecessary. *West Publishing*, 616 F. Supp. at 1580-81. However, that conclusion is not inevitable. The court did not make any findings regarding the markets for LEXIS and for West's reports. Given the relatively high cost of a LEXIS search, and the relative inefficiency in viewing the full text of cases on a computer screen, one could argue that the two services are complementary rather than competitive, since cases located in LEXIS are often more conveniently reviewed in a printed volume.

172. *West Publishing*, 799 F.2d at 1227-28.

court permitted West's copyright protection to extend to page numbers associated with factual material, without determining how the numbers were created.¹⁷³ Most importantly, the court did not determine whether star-pagination in LEXIS was substantially similar to the copyrighted arrangement of West's reporters; by failing to make this inquiry, the court short-circuited the test for infringement.¹⁷⁴ The court's conclusion is particularly questionable in light of West's status as the quasi-official reporter for many court's opinions.

C. *The Bluebook and Policy Considerations*

Rules for citing judicial opinions are, by convention, set by the *Bluebook*.¹⁷⁵ These rules have been adopted by the legal profession to aid in identifying, distinguishing, and locating legal authority.¹⁷⁶ Their purpose is to allow judges, attorneys, scholars and students to quickly and accurately reference holdings or quotations in judicial opinions.

Key to the *Bluebook's* standard citation form is its requirement for citations to particular reporters.¹⁷⁷ In addition, many courts publish rules which set standards for citation form.¹⁷⁸ For example, West has a virtual monopoly in terms of citation to particular opinions: West's *Federal Reporter* is the standard citation for United States court of appeals opinions; West's *Federal Supplement*¹⁷⁹ is the standard citation for

173. See *Toro Co. v. R & R Prods. Co.*, 787 F.2d 1208, 1213 (8th Cir. 1986). See *West Publishing*, 799 F.2d at 1226-27. The court's discussion of West's arrangement of cases in its volumes does not mention how page numbers are generated. It focuses on West's efforts in collecting opinions from various state and federal courts, and dividing the opinions by reporter. *Id.* at 1226.

174. *West Publishing*, 799 F.2d at 1226. See generally the *West Publishing* court's discussion of infringement. *Id.* at 1227-28.

175. See BLUEBOOK, *supra* note 4.

176. See *id.* at iv.

177. *Id.* at 173-219.

178. See, e.g., United States Court of Appeals for the First Circuit, Local Rule 28 ("All citations to State or Commonwealth Courts shall include both the official state court citation and the National Reporter System citation when such decisions have been published in both reports" (Effective September 1, 1986)). See also 28 U.S.C. Court Rules, United States Court of Appeals for the Third Circuit Rule 21(i) (West Supp. 1986); United States Court of Appeals for the Eleventh Circuit Rule 28-1(i) (Effective July 1987); 28 U.S.C. Court Rules, District of Columbia Circuit Rule 8(f) (West Supp. 1980). For a representative state court rule on citation, see State of Washington *Official Rules of Court 1988*, Rules of Appellate Procedure Rule 10.4(g):

Citations must be in conformity with the form used in current volumes of the Washington Reports. Decisions of the Supreme Court and of the Court of Appeals must be cited to the official report thereof and should include the national reporter citation and the year of decision. The citation of other state court decisions should include both the state and national reporter citations.

179. Not all United States District Court opinions are printed in the *Federal Supplement* series. However, the *Federal Supplement* is the most comprehensive reporter for United States district court opinions, and it must be cited if an opinion is published therein. See BLUEBOOK, *supra* note 4, at 174.

United States district court cases; and West's *Bankruptcy Reporter* series is the standard cite for federal bankruptcy court opinions.¹⁸⁰ Even though opinions from the above-noted federal courts are printed in full text by other publishers in looseleaf services and in series of bound volumes,¹⁸¹ such services are not to be cited in briefs or articles unless the opinion in question has not been published in a reporter designated as a standard citation by the *Bluebook*.¹⁸²

Similarly, West's regional reporters serve as standard citations for twenty-one state courts.¹⁸³ Judicial opinions from these twenty-one state courts are published *only* in West's regional reporters.¹⁸⁴ West also publishes the *official* state reporter in Arizona, New Jersey and Pennsylvania, and contributes syllabi, the index, and synopses for the official Oregon state reporter.¹⁸⁵ In addition, the regional reporters must be used as parallel cites for official state reporters.¹⁸⁶

In *Banks Law Publishing Co. v. Lawyers' Cooperative Publishing Co.*,¹⁸⁷ the court held that an official reporter cannot claim a copyright in the arrangement of cases in a volume because the reporter's duties were prescribed by statute.¹⁸⁸ In *West Publishing*, however, the court quickly

180. *Id.*

181. *See, e.g., Federal Securities Law Reporter*, New Matters [CCH].

182. *See* BLUEBOOK, *supra* note 4, Rule 10.3.1. "If possible, cite decisions of courts listed on pp. 173-219 to the reporter(s) indicated." *Id.* As noted previously, the federal court reporters listed in the BLUEBOOK at 173-74 are the *Federal Reporter*, the *Federal Supplement*, and the *Bankruptcy Reporter*, all published by West. United States Tax Court decisions are the only lower federal court bound volumes published by companies other than West which can be officially cited. *Id.* at 175.

183. These twenty-one states include Alabama (*Southern Reporter*); Alaska (*Pacific Reporter*); Colorado (*Pacific Reporter*); Delaware (*Atlantic Reporter*); Florida (*Southern Reporter*); District of Columbia (*Atlantic Reporter*); Iowa (*Northwestern Reporter*); Kentucky (*Southwestern Reporter*); Louisiana (*Southern Reporter*); Maine (*Atlantic Reporter*); Minnesota (*Northwestern Reporter*); Mississippi (*Southern Reporter*); Missouri (*Southwestern Reporter*); North Dakota (*Northwestern Reporter*); Oklahoma (*Pacific Reporter*); South Dakota (*Northwestern Reporter*); Tennessee (*Southwestern Reporter*); Texas (*Southwestern Reporter*); Utah (*Pacific Reporter*); West Virginia (*Southeastern Reporter*); Wyoming (*Pacific Reporter*). *See generally* BLUEBOOK, *supra* note 4, at 177-217.

184. *See supra* note 73 and accompanying text.

185. *See* current volumes of Arizona, New Jersey, Oregon and Pennsylvania official state reporters.

186. *See* BLUEBOOK, *supra* note 4, Rule 10.3.1. ("Note that many decisions require parallel citations to two or more sources. Cite decisions of unlisted courts to the official reporter with a parallel citation to the preferred unofficial reporter (in the United States, the West reporter).").

187. 169 F. 386 (1909), *dismissed*, 223 U.S. 738 (1911).

188. The district court distinguished West's editorial efforts from:

the inherent nature of printing when one is mandated to officially record a court's decision. The raw (slip) opinions must be collated and arranged. They then must be placed with a printer whose selection of typeface and page size dictate a certain number of words or lines for each page. Each page must be numbered sequentially. When one is mandated (as an official reporter) to perform these functions, the result is not an exercise of independent judgment or discretion. The arrangement and pagination inherent in the official process and become part of the public domain.

West Publishing, 616 F. Supp. at 1577. The main element of independent creation in West's editorial

rejected the idea that West acted as an official reporter for many courts in the United States.¹⁸⁹ An analysis of West's current market position in the legal profession demonstrates that the question deserved fuller treatment from the court.

West's legal battle with MDC was more than a dispute about the copyrightability of page numbers. This case was about whether standard citation form in the legal profession should limit competition in the legal publishing industry.¹⁹⁰ Legal profession rules require that the page numbers of West's reporters be cited if a case is located therein.¹⁹¹ West is interested in protecting the page numbers on which cases appear precisely because those page numbers must be cited by the legal profession. If West's reports were not required to be cited, MDC would not be interested in West's page numbers.¹⁹²

One possible consequence to this dispute would be to broaden the range of standard citations. While standardized citation form is essential to the legal profession, West's reluctance to grant publishers the right to use the page numbers of its reports could lead courts to recognize a wider range of citations to avoid being caught in the middle of litigation be-

process noted by the court seems to be West's process of dividing the opinions from various states into regions, and from the various federal courts into reporters based on district court and appellate court level. *Id.* at 1576. An official reporter only deals with one court. However, it is at least arguable that a process which divides state cases into well-established regions is as mechanical an editorial process as that of compiling cases from one court. In any case, the court did not indicate how the creation of West's page numbers was a product of this process.

189. *West Publishing*, 799 F.2d at 1225-27.

190. *See supra* note 103 and accompanying text.

191. *See supra* notes 181-86 and accompanying text.

192. The dispute between MDC and West had become much bigger than the dispute over the copyrightability of the page numbers of West's reports by the time the case was settled. Besides an antitrust complaint filed by MDC in the United States District Court for the Southern District of Ohio, *see supra* note 103 and accompanying text, West and MDC were disputing the extent of West's copyright in state codes. For example, in Illinois, during the 1987 legislative session, the state legislature passed a bill which would have placed the paragraph and section titles which appear in West's Smith-Hurd version of the Illinois state statutory compilation—in which West claims a copyright—in the public domain, so that the titles could be used by MDC in LEXIS. The bill, H.B. 1924, was vetoed by Governor James Thompson, who feared state liability for copyright infringement if West's copyright were to be upheld. *Chicago Daily Law Bulletin*, Oct. 21, 1987, at 1, col. 2. An attempt to override the veto failed by a single vote. *Chicago Tribune*, October 22, 1987, at 1, col. 2. A similar dispute is taking place in Texas, between West and publisher Bancroft Whitney, as well as MDC. *See Texas v. West Publishing Co.*, 681 F. Supp. 1228 (W.D. Tex. 1988). *See also* Austin, Tex. *American Statesman*, April 21, 1987, at 3, col. 1. Finally, West had filed an antitrust and unfair competition complaint against MDC in federal district court in Minnesota, alleging: 1) that MDC had contracted or conspired with accounting and insurance industry groups to keep West from competing in the computer database market for those industry groups, and 2) that MDC had copied most of its LEXIS database directly from West's reporters, while giving the impression that MDC collected the opinions directly from the courts, thus creating a false designation of origin and violating section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a). *See West Publishing Co. v. Mead Corp. and Mead Data Cent.*, No. C-4-88-142 (D. Minn. filed Feb. 22, 1988). This complaint was also dismissed as part of the settlement agreement. *See Blodgett, supra* note 1.

tween the publishers.¹⁹³

One solution would be for courts to number the paragraphs of each opinion. The specific paragraph number could be cited rather than a page number of a West report. Citing paragraphs would have two advantages over citing pages. First, the paragraph numbers would be consistent from one reporter to another. They would not be a by-product of any material added by a publisher, and thus their use would allow greater competition among publishers without sacrificing accuracy of citation. If paragraphs were numbered by courts in a uniform manner, citation to numbered paragraphs would allow accurate reference between competing reporters without the need to refer to West's page numbers, although West has already acknowledged that use of the first page citation of a case in its reports is "fair use."¹⁹⁴ Finally, citing the paragraph in which a quotation or holding is located would be more accurate than citing a page number.

The ultimate purpose of the copyright laws is to stimulate the dissemination of information to the public. Although a publisher is rewarded with exclusive rights as an incentive to create original works,¹⁹⁵ the copyright law should not be used to restrict the use of compilations of the laws of the nation, which include judicial opinions. The due process requirement that nation's laws be available to the public is the rationale underlying numerous cases which hold that judicial opinions are in the public domain.¹⁹⁶ Yet, by recognizing a copyright in the page numbers of West's reports which must be used by the legal profession the Eighth Circuit effectively granted West a property interest in uncopyrightable judicial opinions.¹⁹⁷ Despite the Supreme Court's ruling over 150 years ago that there is no copyright in judicial opinions,¹⁹⁸ a copyright in the page numbers of West's National Reporter System volumes means that the judicial opinions on those pages effectively belong to West.

The *West Publishing* court treated the copyright dispute between the legal publishing giants as a purely commercial transaction. However, it should have recognized that, in terms of public policy, the purpose of the Copyright Act would be better fulfilled by erring on the side of the widest

193. Perhaps a loosening of citation form would be a positive development. See generally Posner, *Goodbye to the Bluebook*, 53 U. CHI. L. REV. 1343 (1986).

194. *West Publishing*, 799 F.2d at 1222.

195. See *Harper & Row*, 471 U.S. at 546.

196. See generally *Building Officials & Code Admin. v. Code Technology, Inc.*, 628 F.2d 730 (1st Cir. 1980), for a history and summary of cases holding judicial opinions to be in the public domain.

197. Since the citations which must be used by the legal profession are those on West's pages, the judicial opinions on those pages effectively belong to West.

198. *Wheaton v. Peters*, 33 U.S. 591, 668 (1834).

possible dissemination of judicial opinions. So long as West's reports continue to be required citations by courts and the legal profession, the public and other publishers should be allowed wide latitude in using the page numbers of West's reports.

CONCLUSION

The settlement of the copyright dispute between West and MDC did not end questions about the scope of protection for printed factual compilations used without permission in computer databases. The difficulty the *West Publishing* court had in sorting out the issues of the copyrightability of West's page numbers and the infringement of West's copyright by the proposed inclusion of those page numbers in LEXIS indicates that adapting the present Copyright Act to computer data bases may be a lengthy process.

As the *West Publishing* case demonstrates, courts should be careful to explain exactly what a copyright in a factual compilation protects, so that an allegedly infringing work can be properly tested for substantial similarity. The test for copyrightability of a factual compilation which best satisfies the constitutional standard of originality is to examine whether the compiler exercised selection, creativity, and judgment in creating the compilation. Once the extent of the compiler's copyright is determined, the court should examine the allegedly infringing work, such as a computer data base, for substantial similarity. Factors such as the extent of the copyrighted work included in the data base, and the form in which the factual information is presented in the data base will help determine substantial similarity. This type of detailed analysis is essential if the legal profession is to take full advantage of such new technology as computer assisted research, as well as encourage competition and service in the legal publishing industry.