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1998]

MATTHEW BENDER & CO. v. WEST PUBLISHING CO.:
THE END OF WEST'S LEGAL PUBLISHING EMPIRE?

I. INTRODUCTION

Legal publishing has grown into a multi-billion dollar industry.¹ West Publishing Company ("West")² has managed to rise to the top of the industry with annual sales of approximately one billion dollars.³ One reason for West's success has been its popular system of organizing and arranging cases.⁴ Another reason for West's profitability is that it possesses "a virtual

1. See HyperLaw's Motion for Summary Judgment at 23, *Matthew Bender & Co. v. West Publ'g Co., Inc.*, No. 94 CIV. 0589, 1997 WL 266972 (S.D.N.Y. May 19, 1997) (stating that West has controlled multi-billion dollar legal publishing market), available at <<http://www.hyperlaw.com/hlsjfin.htm>>; see also John E. Morris, *How West was Won*, AM. LAW., Sept. 1996, at 73, 75-76 (estimating there is "a \$2.7 billion market for legal research materials, including books, CD-ROM publications, and on-line legal services").

2. See *West Group Will Merge Online and CD-ROM Search Engines into a Single Legal Research Tool, Project Code-Named 'Trinity'*, PR NEWswire, Mar. 17, 1997, available in LEXIS, News Library, Curnws File (discussing West's name change). In June 1996, West Publishing Co. merged with Thomson Legal Publishing to form the West Group. See *id.* Thomson, which already owned Lawyers Cooperative Publishing Company, purchased West for \$3.4 billion. See generally *Seven Attorneys General, DOJ Antitrust Division Require Thomson Corp., West Publishing Co. to Restructure \$3.4 Billion Merger*, NAT'L ASS'N ATT'YS GEN. ANTITRUST REP., May/June 1996.

3. See Daniel Wise, *\$3.4 Billion Merger of Legal Publishers Cleared by U.S. Judge*, N.Y. L.J., Feb. 28, 1997, at 1 available in LEXIS, LEGNEW Library, NYLAWJ File (estimating West Group's revenues to be \$1.2 billion in United States). West's revenues for 1996 were in excess of \$825 million. See generally INFORMATION INTELIGENCE, INC. ONLINE NEWSLETTER, April 1, 1996. Thomson's revenues from its own various legal publications has been estimated to be \$368 million. See *id.*

4. See Michelle D. Orton, *House Bill 1822: New Anti-Westopoly Rule Proposed In Congress*, 7 DEPAUL-LCA J. ART & ENT. L. 308, 308 (1997) (stating part of West's success is result of West's organization and arrangement of cases). The use of West's system allows courts and practitioners to cite to one set of materials. See *id.* The result has been the creation of a common system of citation. See *id.* Even though a common system of citation is favored for reasons of ease and efficiency, "preference for a common system has practically eliminated any possibility of competition." *Id.*

Because of this lack of competition, some of West's critics have called for a new system of citation. See *id.* (discussing initiatives to "reform citation methods"). In May of 1995, Representative Barney Frank of Massachusetts proposed a bill that would radically alter the current system of citation. See *id.* The bill would "permit lawyers to cite to any set of volumes where cases are published, and not just to West's volumes." *Id.* This proposal was made in response to West's "virtual monopoly" in the case reporting industry. See *id.* The chances of this bill actually becoming law, however, appear to be remote. See *id.* (stating that proposed bill "will most likely be stuck in committee indefinitely").

Congress' reluctance to pass legislation that would negatively affect West's position in the market can, in part, be explained by the fact that West is a powerful lobbyist and financial contributor to many members of Congress. See generally Tom Hamburger & Sharon Schmickle, *Who Owns the Law?, West Publishing and the Courts*,

(873)

monopoly on the publishing of judicial opinions and other types of legal materials.”⁵ West has been able to maintain this monopoly through aggressive use of the legal system and profitable licensing agreements with other legal publishers.⁶ Recently, however, in *Matthew Bender & Co. v. West Publishing Co.*,⁷ the United States District Court for the Southern District of New York dealt West’s monopoly a potentially fatal blow by ruling that West cannot claim a copyright in the page numbers of its reporters or in the court opinions that it publishes.⁸

The issue regarding the extent of copyright protection afforded case reporters dates back to the United States Supreme Court’s 1848 decision in *Wheaton v. Peters*.⁹ Despite a number of cases discussing the extent of copyright protection afforded to case reporters in the period between *Wheaton* and *Bender*, the issue has never been fully resolved.¹⁰ In fact, the

MINNEAPOLIS STAR TRIBUNE, Mar. 6, 1995, at 1A (discussing West’s financial contributions to members of Congress). For instance, between January 1, 1989 and June 30, 1994, West donated at least \$848,000 to the political process. *See id.*

5. Orton, *supra* note 4, at 308; Jol Silversmith, *Universal Citation: The Fullest Possible Dissemination of Judgments*, COLLEGE HILL INTERNET LEGAL PRAC. NEWSL. (May 19, 1997) <<http://www.collegehill.com/ilp-news>> (“West currently has a de facto monopoly on the print and electronic databases of most United States court opinions, with correspondingly high prices”); *see also* John H. Wyman, Comment, *Freeing the Law: Case Reporter Copyright and the Universal Citation System*, 24 FLA. ST. U. L. REV. 217, 246 (1996) (arguing West exerts “quasi-monopolistic control over access to law”). *But see* Robert Berring, *On Not Throwing Out the Baby: Planning the Future of Legal Information*, 83 CAL. L. REV. 615, 624 (1995) (“By no means does West have a stranglehold on the publication of case materials.”). According to one commentator, there are many sources of case materials, but West’s system has survived and grown because it is effective and relatively inexpensive. *See id.* (discussing “parallel systems” for case reporting). Proof of the fact that there is a competitive market is the growing popularity of LEXIS. *Cf. id.* (stating that LEXIS is accepted as standard, reliable information source).

6. *See* Wyman, *supra* note 5, at 221 (stating that West’s “quasi-monopoly is further buttressed by West’s aggressive defense of its copyright claim”). West claims to have a protectable interest in its reporters, as well as its other publications, and “routinely brings infringement actions” against would-be competitors. *See* Orton, *supra* note 4, 322; *see also* Wyman, *supra* note 5, at 246 (commenting that threat of West law suit precludes potential competitors from entering market). As a result, West’s competitors enter into licensing and royalty agreements with West to gain access to West’s material and avoid litigation. *See id.* at 245-46. One commentator has argued that through threats of potential litigation and the prohibitively expensive licensing fees, West has been able to maintain a monopoly over access to the law and inhibit the progress of “legal science.” *See id.*

7. No. 94 CIV. 0589, 1997 WL 266972 (S.D.N.Y. May 19, 1997).

8. *See id.* at *5.

9. 33 U.S. (8 Pet.) 591 (1834). For a detailed discussion of *Wheaton*, *see infra* notes 28-34 and accompanying text.

10. *Compare* *Matthew Bender & Co. v. West Publ’g Co.*, 41 U.S.P.Q.2d 1321, 1329 (S.D.N.Y. 1996) (holding that page numbers of case reporter are not protected by copyright), *with* *West Publ’g Co. v. Mead Data Cent., Inc.*, 799 F.2d 1219, 1223 (8th Cir. 1986) (deciding that page numbers are protected by copyright as reflection of arrangement of cases), *and* *Oasis Publ’g Co. v. West Publ’g Co.*, 924 F. Supp. 918, 925 (D. Minn. 1996) (holding that page numbers of case reporters “share[] in any copyright protection in the arrangement itself”).

proper scope of copyright protection given to case reporters, and factual compilations in general, has puzzled courts for quite some time.¹¹ While the Supreme Court, in *Feist Publications, Inc. v. Rural Telephone Service Co.*,¹² attempted to end the confusion, some questions still remain.¹³ The *Bender* decision is one court's answer to an important question left open by the Court in *Feist*, specifically, how much copyright protection remains for factual compilations?¹⁴ For West, the answer was painfully clear; not much protection is left at all.¹⁵ In this sense, *Bender* can be viewed as symbolic of the recent movement in copyright law, since *Feist*, towards diminished protection for factual compilations.¹⁶

This Note discusses West's position as the dominant legal publisher in light of this recent defeat and the potential effects of the decision on the legal profession. Part II discusses the development of copyright law as it relates to legal publications.¹⁷ Part III summarizes the facts and procedural history of *Bender*.¹⁸ Additionally, Part III considers the approach

11. See William S. Strong, *Database Protection After Feist v. Rural Telephone Co.*, 42 J. COPYRIGHT SOC'Y U.S.A. 39, 39 (1994) (stating that "question of what protection should be given to compilations of facts has bedeviled the law of copyright for decades").

12. 499 U.S. 340 (1991).

13. See Strong, *supra* note 11, at 39 (arguing that *Feist* left task of developing "a coherent framework for protecting compilations" to lower courts). For a further discussion of the ambiguities of *Feist*, see *infra* note 83.

14. See Jane C. Ginsburg, *Copyright, Common Law, and Sui Generis Protection of Databases in the United States and Abroad*, 66 U. CIN. L. REV. 151, 151 (1997) (discussing implications of *Feist* decision). For a discussion of the *Bender* decision, see *infra* notes 146-98 and accompanying text.

15. See generally *Matthew Bender & Co. v. West Publ'g Co.*, No. 94 CIV. 0589, 1997 WL 266972 (S.D.N.Y. May 19, 1997) (holding that copying cases directly from West's reporters did not violate West's copyright). After *Bender*, only West's headnotes and key numbers are protected by copyright. See *id.* at *1 (stating that headnotes and key numbers were not at issue in case).

16. Cf. 143 CONG. REC. E2000-02 (daily ed. Oct. 9, 1997) (statement of Rep. Coble) ("[L]ower court decisions have underscored that [since *Feist*] copyright cannot stop a competitor from lifting massive amounts of factual material from a copyrighted collection to sue as the basis for its own competing product."). Compare *West Publ'g Co. v. Mead Data Cent., Inc.*, 799 F.2d 1219, 1223 (8th Cir. 1986) (finding that page numbers of case reporters were protected by copyright), and *Hutchinson Tel. v. Fronteer Directory Co.*, 770 F.2d 128, 132 (8th Cir. 1985) (holding that listings in telephone directory were protected by copyright), with *BellSouth Adver. & Publ'g Corp. v. Donnelley Info. Publ'g, Inc.*, 999 F.2d 1436, 1446 (11th Cir. 1993) (ruling that listings in yellow pages were not protected by copyright), and *Matthew Bender & Co. v. West Publ'g Co.*, 41 U.S.P.Q.2d 1321, 1330 (S.D.N.Y. 1996) (holding that page numbers of case reporters were not protected by copyright).

17. For a discussion of copyright law as it relates to legal publications, see *infra* notes 23-118 and accompanying text.

18. For a discussion of the facts and procedural history of *Bender*, see *infra* notes 119-45 and accompanying text. For a discussion and analysis of the decision of the district court in *Bender*, see *infra* notes 146-254 and accompanying text.

that other courts have taken in dealing with West's copyright claims.¹⁹ Part IV discusses the court's reasoning in holding that West did not have a protectable interest in the page numbers of its reporters or the cases it publishes, concluding that the court appropriately decided that West's copyright does not protect the page numbers of its reporters or the text of the judicial decisions it publishes.²⁰ Finally, Part V details the possible impact of the court's decision, focusing on the potential ramifications for the legal publishing market and the cost of legal research.²¹ Part V also discusses *Bender's* impact on the copyright protection afforded to factual compilations and databases, as well as the recent congressional initiatives that address the issue.²²

II. BACKGROUND—COPYRIGHTING THE LAW

A. Copyright Law and Legal Publishing Before 1976

1. The United States Constitution and Copyright

The United States Constitution states that Congress has the 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."²³ This language suggests that the framers of the Constitution had three goals in mind when they created Congress' power to grant copyrights: "(1) [to] promote learning ('the Progress of Science'); (2) [to] secure the author's right to profit from their work ('exclusive Right'); and (3) [to] enhance the public domain ('limited Times')."²⁴ By granting authors the right to receive financial benefits

19. For a discussion of the approach that other courts have taken in dealing with West's copyright claims, see *infra* notes 97-118 and accompanying text.

20. For a discussion of the court's holding in *Bender* and the rationale underlying its decision, see *infra* notes 146-98 and accompanying text. For a critical analysis of the court's decision in *Bender*, see *infra* notes 199-254 and accompanying text.

21. For a discussion of the impact of *Bender*, see *infra* notes 255-93 and accompanying text.

22. For a discussion of *Bender's* impact on copyright protection afforded to factual compilations and databases, see *infra* notes 273-74. For a discussion of recent congressional initiatives dealing with the copyright status of factual compilations, see *infra* notes 276-91.

23. U.S. CONST. art. I, § 8, cl. 8.

24. L. Ray Patterson & Craig Joyce, *Monopolizing the Law: The Scope of Copyright Protection for Law Reports and Statutory Compilations*, 36 UCLA L. REV. 719, 783 (1989); cf. *Mazer v. Stein*, 347 U.S. 201, 219 (1954) (stating philosophy behind copyright clause of Constitution was idea "that encouragement of individual [author's] effort[s] by personal gain is the best way to advance public welfare").

The first goal, "the Progress of Science[,] . . . is the premier doctrine of copyright law." Patterson & Joyce, *supra*, at 783. Copyright was meant to encourage authors to create works, "without which learning would be less, and society the poorer." *Id.* at 783-84. An important aspect of the promotion of learning is that the monopoly given must be limited, because monopoly is contrary to learning. See *id.* at 786 (discussing need for public access to information).

from their creations, the framers hoped to encourage authors to create and publish their literary and artistic works.²⁵ The framers believed these creations would enhance public welfare “through the talents of authors and inventors in ‘Science and useful Arts.’”²⁶ With this framework in mind, the Supreme Court decided the first legal publishing case, *Wheaton v. Peters*.²⁷

2. *Wheaton v. Peters*

Wheaton was not only the Supreme Court’s first legal publishing case, it was also the Court’s first decision on copyright law.²⁸ Peters, the fourth Reporter of Decisions for the United States Supreme Court, condensed his predecessor’s twenty-five volumes into a six-volume set.²⁹ Peters’s condensed version contained the facts of the cases and the opinions of the

The second goal of the copyright clause is to secure the author’s right to profit from his or her work. *See id.* at 783. Copyright encourages the creation of new works by securing the author an “exclusive Right” to that work which allows the author to profit from the creation. *See id.* at 787 (noting framers’ decision to distinguish authors from publishers). It has been noted that “exclusive Right” as used in the copyright clause does not mean an unlimited monopoly. *See id.* (explaining meaning of “exclusive Right” in copyright clause). The word “exclusive” has a more limited meaning when considered in the context in which the copyright clause was adopted:

[C]opyright in eighteenth century usage denoted an exclusive right of “printing, publishing and vending.” Thus, the right given to the “Author” by the copyright clause was the right, at least initially, to publish and sell his [or her] writings. And, being a gift to the *author* only, this constitutionally protected right was, by definition, “exclusive” against the world, *including publishers*.

Id. (footnote omitted).

The third and final goal of the copyright clause is to enhance the public domain. *See id.* at 783. To accomplish this goal, the framers of the Constitution limited Congress’ power by permitting it to grant copyrights only “for limited Times.” *See id.* at 790 (noting that limitation would increase number of works in public domain and arguing that “[this] is as significant to the cause of learning as the creation and distribution of new works”).

25. *See* Christine Wallace, Note, *Overlapping Interests in Derivative Works and Compilations*, 35 CASE W. RES. L. REV. 103, 105-06 (1985) (discussing purpose of copyright clause); *see also* Harper & Row, Publishers, Inc. v. Nation Enters., 471 U.S. 539, 546 (1985) (“The monopoly created by copyright . . . rewards the individual in order to benefit the public.” (quoting Sony Corp. v. Universal City Studios, Inc., 464 U.S. 417, 429 (1984))).

26. *Mazer*, 347 U.S. at 219.

27. 33 U.S. (8 Pet.) 591 (1834).

28. *See* Wyman, *supra* note 5, at 221-22 (describing *Wheaton* as Supreme Court’s first decision involving copyright law).

29. *See* Craig Joyce, *The Rise of the Supreme Court Reporter: An Institutional Perspective on Marshall Court Ascendancy*, 83 MICH. L. REV. 1291, 1363-64 (1985) (explaining Peters’s business ventures). Peters’s condensed version could be produced for less than a third of the price of the original 25 volumes. *See* Wyman, *supra* note 5, at 221.

Supreme Court.³⁰ Wheaton, the Court's third reporter, filed a bill in equity seeking to enjoin Peters from further publication of Peters's *Condensed Reports*.³¹ Wheaton claimed that Peters's publication infringed on Wheaton's copyright.³² The Court ruled in favor of Peters, stating that "no reporter . . . can have any copyright in the written opinions delivered by this court."³³ With this holding, the Court established the "bedrock" policy that "the public should have maximum access to the law."³⁴

3. *Banks Law Publishing Co. v. Lawyers' Co-operative Publishing Co.*

In *Banks Law Publishing Co. v. Lawyers' Co-operative Publishing Co.*,³⁵ the Second Circuit addressed the issue of whether a case reporter's arrangement and pagination is subject to copyright law.³⁶ The Banks Law Publishing Company ("Banks") published the *United States Reports*, the official

30. See Joyce, *supra* note 29, at 1358. The plaintiff, Henry Wheaton, was the third Reporter of Decisions. See Patterson & Joyce, *supra* note 24, at 731. Peters's six-volume set included the reprinted version of 12 volumes of Wheaton's *Reports*. See *id.*

31. See Joyce, *supra* note 29, at 1370.

32. See *id.* Wheaton contended that "an author's natural (or 'common law') right, exist[ed] independently of statute and continu[ed] in perpetuity." Patterson & Joyce, *supra* note 24, at 732. Wheaton was forced to argue for a "common law" copyright because it was doubtful whether he had complied with the requirements of the copyright statutes. See *id.* at 732 n.41.

Peters, on the other hand, argued that copyright was solely "the grant of a statutory monopoly, limited in both scope and duration by the terms of the grant." See *id.* at 732. The Supreme Court sided with Peters, finding that the federal copyright statute protected published works and the common law copyright that Wheaton argued for applied only to unpublished works. See *id.* The Court also stated that the copyright statute granted only a limited monopoly for a limited period. See *id.* Finally, the Court stated that an author must strictly comply with the terms of the statute to secure the benefit of copyright. See *id.* "In short, statutory copyright is a monopoly grant awarded primarily for the benefit of the public rather than the author and, for that reason, is attended by appropriate limitations and conditions regulating both its length and scope." *Id.* at 732-33.

33. *Wheaton v. Peters*, 33 U.S. (8 Pet.) 591, 668 (1834). Although there was a split in the Court on other issues, the Court was unanimous with respect to this important point. See *id.* The holding in *Wheaton* was later expanded, in *Banks v. Manchester*, 128 U.S. 244 (1888), to deny copyright protection for state reporters as well. See Wyman, *supra* note 5, at 223 (stating that *Banks* court denied copyright to official state reporter).

34. See Patterson & Joyce, *supra* note 24, at 742. While the Court's reasoning in *Wheaton* is not completely clear, the overall effect of the decision can not be overstated:

The impact of the Court's opinion was sudden and extensive. Where case reporters had once been scarce because of the inflated prices charged by the owners of copyrights in the volumes, publishers around the country now raced to put out their own, presumably lower-priced editions. The law was thus more readily available to the citizenry than ever before.

Wyman, *supra* note 5, at 223 (footnote omitted).

35. 169 F. 386 (2d Cir. 1909).

36. See Wyman, *supra* note 5, at 225 (discussing facts of, and Second Circuit's decision in, *Lawyers' Co-operative*).

reporter of the United States Supreme Court.³⁷ Lawyers' Co-operative Publishing Company ("Lawyers' Co-operative") began producing low-cost sets of Supreme Court reports that contained star pagination to Banks's *United States Reports*.³⁸ Banks sued, claiming Lawyers' Co-operative had violated its copyright.³⁹

The trial court specifically addressed the copyrightability of case arrangement and pagination.⁴⁰ In its decision, the trial court stated that the sequence of cases and the pagination of the volumes were not features of a reporter that were entitled to copyright protection.⁴¹ In affirming the trial court's decision, the Second Circuit stated that "the arrangement of reported cases in sequence, their paging and distribution into volumes, are not features of such importance as to entitle the reporter to copyright protection of such details."⁴²

B. Copyright Law and Legal Publishing After 1976

1. The Copyright Act of 1976

The Copyright Act of 1976⁴³ ("1976 Act") is more sophisticated and comprehensive than its predecessors, the Copyright Act of 1909⁴⁴ and the Copyright Revision Acts of 1870⁴⁵ and 1831.⁴⁶ First, the 1976 Act does not

37. See *Lawyers' Co-operative*, 169 F. at 386.

38. See Wyman, *supra* note 5, at 225-26. Lawyers' Co-operative attempted to take advantage of new technology involving stereotype plates in order to supply consumers with cheaper versions of Supreme Court decisions. See *id.* In 1882, a complete set of 103 volumes of Banks' *United States Reports* cost about \$500. See THOMAS A. WOXLAND & PATTI J. OGDEN, *LANDMARKS IN AMERICAN LEGAL PUBLISHING* 41 (1990) (discussing price difference between Banks's product and Lawyers' Co-operative's). Lawyers' Co-operative, on the other hand, was able to sell each volume for one dollar. See *id.* Banks was in the same position as West is today in that the use of star pagination by Lawyers' Co-operative would allow a person to purchase the cheaper product and still cite to the "official" reporter. See Patterson & Joyce, *supra* note 24, at 740 n.72. Therefore, Lawyers' Co-operative eliminated the need for a consumer to purchase Banks's products. See *id.* (discussing factual similarities between *Lawyers' Co-operative* and *Bender*).

39. See *Lawyers' Co-operative*, 169 F. at 386. Banks claimed infringement, on the part of Lawyers' Co-operative, "arising out of the arrangement of the cases, the division into volumes, the table of cases, and the numerical or star pagination to indicate where in the official reports the different cases and points decided may be found." *Id.*

40. See *id.* at 388.

41. See *id.* at 390 ("It is inconceivable to me that to merely arrange the cases in sequence . . . and paging the volumes . . . are features or characteristics of such importance as to entitle him to copyright protection of such details.").

42. *Id.* at 391.

43. 1976 General Revision of Copyright Law ("1976 Act"), Pub. L. No. 94-553, 90 Stat. 2541 (codified as amended at 17 U.S.C. §§ 101-810 (1994)).

44. Act of Mar. 4, 1909 ("1909 Act"), ch. 320, 35 Stat. 1075 (repealed 1976).

45. Act of July 8, 1870 ("1870 Act"), ch. 230, §§ 85-111, 16 Stat. 198, 212-17 (repealed 1909).

46. Act of Feb. 3, 1831 ("1831 Act"), ch. 16, 4 Stat. 436 (amended 1870). There are several differences between the 1976 Act and the earlier copyright stat-

give copyright protection to works of the United States Government.⁴⁷ Second, the 1976 Act defines and limits protection for compilations and derivative works.⁴⁸ Third and finally, the 1976 Act requires an original work of authorship as a condition for copyright.⁴⁹

a. Government Works

Section 105 of the 1976 Act states that copyright protection is not available for any work of the United States Government.⁵⁰ A work of the United States Government is any “work prepared by an officer or employee of the United States Government as part of that person’s official duties.”⁵¹ Because section 105 is applicable to “any” work of the government, all official records of the United States are in the public domain.⁵²

utes. See Patterson & Joyce, *supra* note 24, at 750-51 (discussing differences between 1976 Act and earlier statutes). One commentator has stated that the 1976 Act is the first U.S. copyright statute “which truly encourages the publication of new works.” Wallace, *supra* note 25, at 106. In contrast to its predecessors, the 1976 Act provides protection to a work from the time it is created, therefore enabling an author to realize the work’s full economic value. See *id.* at 105-10.

47. See 17 U.S.C. § 105 (stating that “[c]opyright protection . . . is not available for any work of the United States Government”). Neither the 1831 nor the 1870 Acts expressly denied protection for works of the United States Government. See Patterson & Joyce, *supra* note 24, at 750. The 1976 Act, however, directly addresses the applicability of copyright law to federal cases and statutes “by providing that ‘copyright protection . . . is not available’ for such works.” *Id.* at 756-57 (quoting 17 U.S.C. § 105) (alteration in original).

48. See 17 U.S.C. §§ 101-03 (defining compilations and derivative works and limiting protection available to such works). Neither the 1831 nor the 1870 Acts defined or limited copyright protection for derivative works or compilations. See Patterson & Joyce, *supra* note 24, at 750. On the other hand, the 1909 Act included “an author’s right to abridge his work . . . and ‘to make any other version thereof.’” Wallace, *supra* note 25, at 109 (quoting Act of March 4, 1909, ch. 320 § 1(b), 353 Stat. 1075). The 1909 Act also limited these rights to “literary works.” See *id.* at 109 n.47. The 1976 Act extended protection for derivative works to all copyrightable work. See *id.* at 109-10 (comparing 1976 Act to 1909 Act). For a further discussion of copyright and compilations, see *infra* notes 55-60 and accompanying text. For a further discussion of derivative works and copyright, see *infra* notes 62-68 and accompanying text.

49. See 17 U.S.C. § 102 (stating that 1976 Act protects “original works of authorship fixed in any tangible medium of expression”). Neither the 1831 Act nor the 1870 Act required the condition that a work be an original work of authorship to warrant copyright protection. See Patterson & Joyce, *supra* note 24, at 750. For a further discussion of the “original work of authorship” requirement, see *infra* notes 68-96 and accompanying text.

50. See 17 U.S.C. § 105 (“Copyright protection under this title is not available for any work of the United States Government . . .”). The government, however, “is not precluded from receiving and holding copyrights transferred to it by assignment, bequest, or otherwise.” *Id.*

51. 17 U.S.C. § 101.

52. See MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 5.06[A], at 5-81 (explaining that all official records of government cannot be protected by copyright because of § 105 and therefore are in public domain). This rule is true for all federal judicial opinions as well. See *id.* § 5.06[C], at 5-90 (citing *Wheaton v. Peters*, 33 U.S. (8 Pet.) 591 (1834)).

While on its face the 1976 Act appears applicable only to works of the federal government, it applies to some state works as well.⁵³ The rule is that both state judicial opinions and state statutes are part of the public domain.⁵⁴

b. Compilations

Section 103(a) of the Copyright Act of 1976 provides that copyright law protects compilations and derivative works.⁵⁵ 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."⁵⁶ In order for a factual compilation to be copyrightable, three elements must be present: (1) collection and assembly of preexisting material; (2) selection, coordination or arrangement of that material; and (3) creation of an original work of authorship, by virtue of that selection, coordination or arrangement.⁵⁷

The fact that there are three requirements implies that not every collection of facts is entitled to copyright protection.⁵⁸ Prior to 1991, how-

53. See *Patterson & Joyce*, *supra* note 24, at 756-57 (discussing application of § 105 to works of state governments, specifically state cases and statutes). In 1888, the Supreme Court ruled that judges, as a matter of public policy, are incapable of being "authors." See *Banks v. Manchester*, 128 U.S. 244, 253 (1888). The 1976 Act made no attempt to overrule *Banks*, therefore, "it follows that [the *Banks*] rule now extends to state judicial opinions and reports by reason of sections 102 and 103, which allow copyright only for 'original works of authorship.'" *Patterson & Joyce*, *supra* note 24, at 757.

54. See *NIMMER & NIMMER*, *supra* note 52, § 5.06[C], at 5-90 (discussing rules applicable to state judicial opinions and state statutes).

55. See 17 U.S.C. § 103(a) ("The subject matter of copyright . . . includes compilations and derivative works . . ."). The 1976 Act provides for protection of both factual compilations and computer databases. See H.R. REP. NO. 94-1476 at 54, *reprinted in* 1976 U.S.C.C.A.N. 5659, 5667 (stating that literary works include "catalogs, directories, and similar factual, reference, or instructional works and compilations of data" including computer databases).

56. 17 U.S.C. § 101.

57. See *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 357 (1991) (identifying three distinct elements of compilations); see also *Skinder-Strauss Assocs. v. Massachusetts Continuing Legal Educ., Inc.*, 914 F. Supp. 665, 671 (D. Mass. 1995) (holding that compilations are copyrightable if three elements are present); *National Rifle Ass'n v. Handgun Control Fed'n*, 844 F. Supp. 1178, 1180 (N.D. Ohio 1992), *aff'd*, 15 F.3d 559 (6th Cir. 1994) (same). For a detailed discussion of the "original work of authorship" requirement, see *infra* notes 68-96 and accompanying text.

58. See *Feist*, 499 U.S. at 357 (concluding that existence of three requirements indicates that not every collection of facts will receive copyright protection). In discussing the three requirements, the Supreme Court noted the particular importance of the third requirement. See *id.* Because § 102 requires originality for all works, the Court concluded that Congress intended fact-based works to be held to the same standard as all other works. See *id.*

The Court stated that the second requirement, selection, coordination or arrangement, is the guide by which fact-based works should be judged. See *id.* at 358.

ever, confusion existed in the courts as to which compilations merited copyright protection.⁵⁹ The Supreme Court, in *Feist*, attempted to end the confusion by holding that a compilation is entitled to copyright protection only if it is “selected, coordinated, or arranged ‘in such a way’ as to render the work as a whole original.”⁶⁰

Because facts can never, by themselves, be the subject of copyright, “the compilation author can claim originality, if at all, only in the way the facts are presented. To that end, the statute dictates that the principal focus should be on whether the selection, coordination, and arrangement are sufficiently original to merit protection.” *Id.*

59. *See id.* at 351-52 (discussing confusion regarding protection of factual compilations); *see also* Howard B. Abrams, *Originality and Creativity in Copyright Law*, 55 LAW & CONTEMP. PROBS. 3, 7 (1992) (stating that prior to *Feist*, “the question of what constituted the requisite originality . . . [had] prove[n] troublesome for the courts”). Most of the confusion among the lower courts involved the level of originality needed for a work to gain copyright protection. *See Feist*, 340 U.S. at 351 (stating that statute implicitly incorporated originality requirement “thereby leaving room for error”). In *Feist*, the Court stated that “originality is a constitutionally mandated prerequisite for copyright protection.” *Id.* Most courts followed this principle, but ambiguity in the 1909 Act led some courts to ignore the originality component of copyright protection. *See id.* at 352 (noting that “some courts misunderstood the statute”). In this confusion, a number of lower courts developed a new test to justify protecting factual compilations, known as either the “sweat of the brow” or “industrious collection” test. *See id.* By the time of the *Feist* decision, the United States Court of Appeals for the Seventh, Eighth and Tenth Circuits had adopted the “sweat of the brow” test. *See Daniel A. Davis, Feist Publications, Inc. v. Rural Telephone Service Co.: Opening the Door to Information Pirates?*, 36 ST. LOUIS U. L.J. 439, 442 n.19 (1991) (discussing application of “sweat of the brow” doctrine). For an explanation of the “sweat of the brow” test, *see infra* note 60.

60. *Feist*, 499 U.S. at 358. In *Feist*, the Court specifically rejected the “sweat of the brow” doctrine. *See id.* (concluding that there is “no doubt that originality, not ‘sweat of the brow’ is the touchstone of copyright protection in . . . fact-based works”). Courts that applied the “sweat of the brow” standard equated originality with industriousness. *See Jane C. Ginsburg, Creation and Commercial Value: Copyright Protection of Works of Information*, 90 COLUM. L. REV. 1865, 1875 (1990) (discussing concept of laborious authorship in relation to copyright protection). “The sweat of the brow theory allows copyright protection for an entire factual compilation based upon the cost, effort, and labor invested in the creation.” Tracy Lea Meade, Note, *Ex-Post Feist: Applications of a Landmark Copyright Decision*, 2 J. INTELL. PROP. L. 245, 248 (1994). The root of the “sweat of the brow” doctrine can be traced back to English copyright law. *See id.* The doctrine as applied in the United States was described by the Second Circuit in *Jeweler’s Circular Publishing Co. v. Keystone Publishing Co.*, 281 F. 83 (2d Cir. 1922):

The right to copyright a book upon which one has expended labor in its preparation does not depend upon whether the materials which he [or she] has collected consist or not of matters which are *publici juris*, or whether such materials show literary skill or originality, either in thought or in language, or anything more than industrious collection.

Id. at 88.

Under this logic, even the most unoriginal compilations, such as a telephone directory, could be entitled to copyright protection if the compiler exerted enough of an effort in compiling the facts. *See United Tel. Co. v. Johnson Publ’g Co.*, 855 F.2d 604, 612-13 (8th Cir. 1988) (finding that copying phone directory constituted infringement of publisher’s copyright); *see also Leon v. Pacific Tel. & Tel. Co.*, 91 F.2d 484, 487 (9th Cir. 1937) (same).

c. Derivative Works

Section 103(a) of the 1976 Act extends copyright protection to derivative works.⁶¹ A derivative work is defined as:

[A] work based upon one or more preexisting works, such as a translation, musical arrangement, dramatization, fictionalization, motion picture version, sound recording, art reproduction, abridgment, condensation, or any other form in which a work may be recast, transformed, or adapted. A work consisting of editorial revisions, annotations, elaborations, or other modifications, which as a whole, represent an original work of authorship⁶²

For a derivative work to qualify for copyright protection, it must consist of two elements: (1) preexisting materials that are subject to a prior author's copyright or are in the public domain and (2) original material that can be protected by a separate copyright.⁶³

While there is some overlap between derivative works and compilations, they represent different concepts.⁶⁴ A derivative work requires a process of adapting, transforming or recasting one or more preexisting works.⁶⁵ A compilation, on the other hand, is the result of selecting, or-

In rejecting the "sweat of the brow" doctrine, the Supreme Court stated that it had a number of flaws. *See Feist*, 499 U.S. at 353. The most glaring error of the doctrine was that it expanded copyright protection to the facts of a compilation, not merely to the selection or arrangement of those facts. *See id.* at 353-54. In doing so, the courts that applied the doctrine "eschewed the most fundamental axiom of copyright law—that no one may copyright facts or ideas." *Id.* at 353.

In *Feist*, the Court rejected the claim that copying a compilation of facts was unfair to the compiler. *See id.* at 350. The Court asserted that "raw facts may be copied at will. This result is neither unfair nor unfortunate. It is the means by which copyright advances the progress of science and art." *Id.* By rejecting the "sweat of the brow" doctrine, the Court made it clear that the primary goal of copyright is to promote the progress of science, not to reward an author's labor. *Cf. id.* For a further discussion of the originality requirement, see *infra* notes 69-97 and accompanying text.

61. *See* 17 U.S.C. § 103(a) (1994) ("The subject matter of copyright . . . includes . . . derivative works . . .").

62. 17 U.S.C. § 101 (1982).

63. *See* Wallace, *supra* note 25, at 103 (identifying two elements of derivative works). It is also important to note that the derivative work must substantially borrow from the preexisting material. *See* NIMMER & NIMMER, *supra* note 52, § 3.01, at 3-3 ("A work is not derivative unless it has *substantially* copied from a prior work."). For a work to be copyrightable as a derivative work, it would have to infringe an author's copyright. *See id.* In other words, the derivative author must actually copy the original author's expression of ideas. *See id.* The only reason why it would not actually infringe a copyright is if the derivative author has the permission of the original author or the work is in the public domain. *See id.*

64. *See* H.R. REP. NO. 89-2237, at 48 (1966) (stating that despite some overlap, derivative works and compilations represent different concepts).

65. *See id.* (defining and explaining meaning of derivative work). In this context, preexisting work means a work that is covered by "the general subject matter of copyright" as defined by 17 U.S.C. § 102. *See id.* (explaining meaning of "preex-

ganizing and arranging preexisting materials.⁶⁶ In either case, the scope of the copyright is limited to “the material contributed by the author of such work, as distinguished from the preexisting material employed in the work.”⁶⁷

d. Original Work of Authorship

The 1976 Act was the first copyright statute to explicitly require originality as a condition to copyright.⁶⁸ According to section 102(a), copyright protection applies to works that represent an “original work[] of authorship.”⁶⁹ The originality requirement, however, is not particularly stringent and requires little innovation.⁷⁰ Courts have interpreted originality to consist of two basic components: independent creation and creativity.⁷¹ The requirement that a work be an independent creation is

isting work”). The concept has also been expanded to include works that have entered the public domain. *See, e.g.*, *Peter Pan Fabrics, Inc. v. Rosstex Fabrics, Inc.*, 733 F. Supp. 174, 177 (S.D.N.Y. 1990) (“[I]t is clear that a work is derivative only if it takes from a work already covered by copyright *or which is in the public domain.*”) (citing *NIMMER & NIMMER, supra* note 52, § 3.01, at 3-3) (emphasis added).

66. *See* H.R. REP. NO. 89-2237, at 48 (explaining meaning and requirements of compilation).

67. 17 U.S.C. § 103(b) (1994).

68. *See* Wallace, *supra* note 25, at 110-11 (stating that, while courts had previously incorporated originality requirement into copyright analysis, 1976 Act was first statute to explicitly recognize requirement); *see also* Brian A. Dahl, *Originality and Creativity in Reporter Pagination: A Contradiction in Terms?*, 74 IOWA L. REV. 713, 716 (1989) (commenting that codified requirement of originality is “unparalleled in statutory copyright history”). While the 1976 Act was the first statute to require originality, courts had required originality well before 1976. *See id.* (“The Supreme Court, prior to the enactment of section 102, interpreted the copyright clause as demanding some quantum of originality.”). The 1976 Act was simply an attempt to codify the concept as it had previously been applied by the courts. *See* Wallace, *supra* note 25, at 111.

69. *See* 17 U.S.C. § 102(a) (1982) (“Copyright protection subsists . . . in original works of authorship.”).

70. *See* *Feist Publications Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 358 (1991) (noting that originality requires only “some minimal level of creativity”); *see also* Dahl, *supra* note 68, at 716 (stating that originality standard requires little innovation because work need “only be distinguishable from prior works and involve minimal creativity”). Originality is not difficult to achieve; all that it requires is that the work contains some element that is not copied from another source and that the work displays a minimal degree of creativity. *See Feist*, 499 U.S. at 358 (discussing elements of originality requirement). In this context, originality does not require novelty, as patent law does. *See* Wallace, *supra* note 25, at 111.

While this standard is apparently easy to meet, not all works will satisfy the originality requirement. *See Feist*, 499 U.S. at 358-59 (“Presumably the vast majority of compilations will pass this test, but not all will.”). The *Feist* Court noted that there is “a narrow category of works in which the creative spark is utterly lacking or so trivial as to be virtually nonexistent.” *Id.* at 359 (citing *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251 (1903)).

71. *See, e.g.*, *Feist*, 499 U.S. at 358 (explaining that originality requires that work is independently created and possesses minimal degree of creativity); *Lipton v. Nature Co.*, 71 F.3d 464, 470 (2d Cir. 1995) (same); *Kregos v. Associated Press*, 937 F.2d 700, 704 (2d Cir. 1991) (same). The *Feist* Court held that this two-pro-

simply “‘a prohibition of actual copying.’”⁷² The prohibition of copying, however, does not amount to a requirement of novelty or striking uniqueness.⁷³

The creativity requirement has not been as easy to define.⁷⁴ Although the 1976 Act does not mention the word creativity, the Supreme Court established the creativity standard as a supplement to originality.⁷⁵ While the creativity standard is relatively low, it is an essential element in the effort to protect nondescript works.⁷⁶ Despite its increasing impor-

nged test of originality is required under the United States Constitution. See *Abrams*, *supra* note 59, at 14 (stating that *Feist* held two-step analysis to determine originality was “constitutionally mandated”).

72. *Alfred Bell & Co. v. Catalda Fine Arts, Inc.* 191 F.2d 99, 103 (1951) (quoting *Hoague-Sprague Corp. v. Frank C. Meyer, Inc.*, 31 F.2d 583, 586 (E.D.N.Y. 1929)). This requirement is fairly easy to meet, because it only requires that the author contribute something that is recognizable as his or her own. See *id.* at 102 (“[N]othing in the Constitution commands that copyrighted matter be strikingly unique or novel.”).

73. See *L. Batlin & Son, Inc. v. Snyder*, 536 F.2d 486, 490 (2d Cir. 1976) (maintaining that independent creation requirement does not require that work be strikingly unique, ingenious or novel).

74. For a discussion of the problems in defining the standard of originality, see *infra* notes 75-96 and accompanying text.

75. See *Dahl*, *supra* note 68, at 716 (discussing development of creativity requirement). The Supreme Court elaborated on the creativity requirement in *Feist*. See *Feist*, 499 U.S. at 358. In *Feist*, the Court held that original, as used in copyright, means “that the work was independently created by the author (as opposed to copied from other works), and that it possesses at least some minimal degree of creativity.” *Id.* In this respect, *Feist* was consistent with earlier Supreme Court cases. See, e.g., *United States v. Steffens*, 100 U.S. 82, 94 (1879) (stating that writing must be product of intellectual creativity to be protected by copyright). After *Feist*, other courts have followed the Supreme Court’s example, holding that creativity is an essential element of originality. See *Kregos*, 937 F.2d at 704 (“[T]he requirement of minimal creativity [is] an important ingredient of the test for copyright entitlement.”). But see, *Russ VerSteege, Sparks in the Tinderbox: Feist, “Creativity, and the Legislative History of the 1976 Copyright Act*, 56 U. PITT. L. REV. 549, 550 (1995) (challenging *Feist* Court’s conclusion that creativity is condition of copyrightability).

One commentator has argued that the legislative history of the 1976 Act suggests that Congress rejected the creativity requirement in drafting the Act. See *id.* at 550-51 (“The majority of those who spoke out about the issue during the drafting process expressly rejected the inclusion of ‘creativity’ as a factor in the calculus of copyrightability.”). The tentative draft of the 1976 Act included the phrase “original creative authorship.” See *id.* at 558. That phrase, however, caused a great deal of criticism, “[i]n fact, the negative comments were overwhelming.” *Id.* In response to this criticism, the final draft of the 1976 Act removed the word “creative” and simply used the term “original works of authorship,” without further definition. See *id.* at 559.

76. See *Dahl*, *supra* note 68, at 717 (stating that “the creativity requirement is minimal, but essential, to prevent the protection of nondescript efforts”). In discussing nondescript efforts, the Copyright Office Regulations state:

The following are examples of works not subject to copyright and applications for registration of such works cannot be entertained:

(a) Words and short phrases such as names, titles, and slogans; familiar symbols or designs . . . mere listing of ingredients or contents;

tance, the creativity requirement remains difficult to define.⁷⁷ In an effort to define creativity, two distinct lines of authority have developed.⁷⁸

The first line of authority has developed through lower courts' interpretations of the Supreme Court's decision in *Feist*.⁷⁹ While the Court in *Feist* held that a certain level of creativity was required for a work to be copyrightable, it failed to establish guidelines that lower courts could follow.⁸⁰ In the absence of clear guidance from the Supreme Court, lower

(b) Ideas, plans, methods, systems, or devices, as distinguished from the particular manner in which they are expressed or described in a writing;

. . .

(d) Works consisting entirely of information that is common property containing no original authorship, such as . . . lists or tables taken from public documents or other common sources.

37 C.F.R. § 202.1 (1988).

77. See Russ VerSteege, *Rethinking Originality*, 34 WM. & MARY L. REV. 801, 810 (1993) (asserting that subjective element of originality, i.e., creativity, is "an elusive concept that is difficult to quantify"). While courts continue to emphasize the creativity requirement, "they have completely avoided defining what they mean by the term 'creativity.'" *Id.* at 818.

78. See *id.* (stating that in attempt to define creativity, "two dominant articulations" have developed: 1) some degree of "creativity" standard and 2) trivial variation standard).

79. See *id.* at 818-24 (discussing *Feist* as paradigm of "some degree of creativity" standard). Essentially this first line of authority has dealt with the creativity standard as it relates to compilations. See *Feist*, 499 U.S. at 340 (dealing with creativity of compilations). The basic theories, however, apply equally to derivative claims. See HyperLaw's Motion for Summary Judgment at 15, *Matthew Bender & Co. v. West Publ'g Co., Inc.*, No. 94 CIV. 0589, 1997 WL 266972 (S.D.N.Y. May 19, 1997), available at <<http://www.hyperlaw.com/hlsjfin.htm>> (citing *Feist* as "starting point" for copyright analysis); see also Meade, *supra* note 60, at 270 (stating that impact of *Feist* decision extends beyond test for copyrightability of compilations; specifically, the Court "announced a philosophy of copyright priorities that extends to all works of authorship").

80. See VerSteege, *supra* note 77, at 822 (stating that *Feist* Court did not define creativity and failed to articulate one clear standard); see also Meade, *supra* note 60, at 262 (stating that *Feist* did not establish test to be used to judge creativity). "In short, the Supreme Court did not define 'creativity' in any manner other than by default. Basically, it resorted to a form of name-calling. Items labeled as 'mechanical,' 'entirely typical,' 'garden variety,' 'obvious,' and so on, fell short of demonstrating a minimal degree of creativity." VerSteege, *supra* note 77, at 823.

Instead of providing one definite standard, the Court added to the confusion by using five different standards to determine the "modicum of creativity" standard. See *id.* at 823-24. One commentator has explained the five standards as:

1) whether the plaintiff's work "possesses at least some minimal degree of creativity"; or 2) whether the plaintiff's work displayed "a modicum of creativity." It then added negative formulations: 3) whether the plaintiff's work was one in which "the creative spark is utterly lacking"; 4) whether "the creative spark" existing in the plaintiff's work was "so trivial as to be virtually nonexistent"; and 5) whether the plaintiff's work was "devoid of even the slightest trace of creativity."

Id. at 823-24 (quoting *Feist*, 499 U.S. at 344, 346, 357-58, 361). But see Abrams, *supra* note 59, at 16 (suggesting that examples used by *Feist* Court provide "a relatively consistent theme that ultimately suggests a coherent limit for creativity component").

courts have focused on the terminology of the Court in *Feist* when it determined that the work in question was not creative.⁸¹ Key phrases, such as “entirely typical” and “garden variety” were the only reasons given for determining that the work was not sufficiently creative to be protected by copyright.⁸² By focusing on these phrases, some courts have developed a

Because of the lack of clear guidance from the Supreme Court, some lower courts have developed other standards to determine whether a work is sufficiently creative to warrant copyright protection. See Meade, *supra* note 60, at 262 (discussing new standards developed by courts to determine whether work is creative). An example of one of these new standards is the industry standard test. See *id.* Building on the negative guidelines of *Feist*, the industry standard test states that a work is not creative if it is “typical” or “obvious” in a given field. See *id.* The Second Circuit applied this test in *Victor Lalli Enterprises v. Big Red Apple*, 936 F.2d 671, 673 (2d Cir. 1991). In *Victor Lalli*, the court held that a horse racing chart was not creative because the way in which it was organized was the norm for the industry. See Meade, *supra* note 60, at 262.

81. See, e.g., *Kregos v. Associated Press*, 937 F.2d 700, 705 (2d Cir. 1991) (using phrases such as “entirely typical” and “garden variety” to determine whether work was creative). For a further discussion of *Kregos*, see *infra* note 83.

82. See VerSteeg, *supra* note 77, at 823 (stating that “one can only assume” from *Feist* which works are not creative). The issue in *Feist* involved a phone book published by the plaintiff, Rural Telephone Service Company, Inc. See *Feist*, 499 U.S. at 343-44. Rural’s phone book consisted of yellow and white pages. See *id.* at 342. The yellow pages listed Rural’s business subscribers alphabetically by category and displayed advertisements of various sizes. See *id.* The white pages consisted of an alphabetical listing of Rural’s subscribers, along with their telephone number and the town in which they lived. See *id.* at 343. As the only telephone service in the service area, it was very easy for Rural to obtain this information; subscribers supplied Rural with their names and addresses in order to obtain telephone service and Rural assigned the telephone numbers. See *id.*

Feist Publications Inc. was a publisher that specialized in area-wide telephone directories. See *id.* *Feist’s* directory, like Rural’s, contained both yellow and white pages, with the yellow pages containing various advertisements. See *id.* *Feist* and Rural competed for yellow page advertising. See *id.* *Feist’s* area-wide directories, however, covered a much larger geographical area than typical directories that cover a smaller calling area. See *id.* For example, the directory that was the subject of the litigation covered 11 different telephone service areas. See *id.* To obtain subscriber information, *Feist* approached each of the 11 telephone companies operating in the area and offered to pay for the right to use its white page listings. See *id.* Of the 11, Rural was the only phone company that refused to license its listings. See *id.*

After Rural’s refusal, *Feist* used the listings without Rural’s consent. See *id.* *Feist* did some extra investigating and added some material to each listing, such as the subscribers’ street address. See *id.* Despite the changes, 1309 of the 46,878 listings in *Feist’s* directory were exactly the same as Rural’s. See *id.* at 344. Rural then sued *Feist* for copyright infringement. See *id.*

The Court decided that there was nothing even “remotely creative” about Rural’s alphabetized listing of names and phone numbers in its phone book. See *id.* at 363. “Because Rural’s white pages lack[ed] the requisite originality, *Feist’s* use of the listings [did not] constitute infringement.” *Id.* The Court, however, failed to explain the test it used to conclude that the work did not rise to the level of creativity needed for copyright protection. See VerSteeg, *supra* note 77, at 822 (stating that Court in *Feist* did not explain its conclusion). The Court explained that the selection of the names and phone numbers lacked the “modicum of creativity” necessary to create copyrightable expression because it was “entirely typical” or

test: if the work is "obvious" or "entirely typical" then it is not creative.⁸³ Alternatively, any work that is not "entirely typical" is creative and, therefore, may be sufficiently original to invoke copyright protection.⁸⁴ Typically, courts use this standard to judge whether a compilation is sufficiently original to deserve copyright protection.⁸⁵

The second line of authority is most often applied to cases dealing with creativity in derivative works.⁸⁶ This second line of authority has become known as the distinguishable variation standard.⁸⁷ The leading case advocating the distinguishable variation standard is *Alfred Bell & Co. v.*

that it was a "garden-variety white pages directory, devoid of even the slightest trace of creativity." *Feist*, 499 U.S. at 362. One commentator has noted that:

From this explanation, one can only assume that the Court would hold that certain works or products are noncreative. For example, things that can be characterized as "mechanical," "entirely typical," "garden-variety," "obvious," "basic information," "mere selection," "an age-old practice, firmly rooted in tradition," "so commonplace that it has come to be expected as a matter of course," "practically inevitable," or a "time-honored tradition" apparently lack *Feist's* "de minimus quantum of creativity."

VerSteeg, *supra* note 77, at 823 (quoting *Feist*, 499 U.S. at 362-63).

83. See *Kregos*, 937 F.2d at 705 (stating that question of whether work is sufficiently creative depends on whether it is "entirely typical," "garden-variety," or "obvious"). In *Kregos*, the plaintiff created a form containing information about baseball pitchers. See *id.* at 702. The plaintiff's form, which was copyrighted, was distributed to subscribing newspapers and included various statistics. See *id.* The Associated Press began publishing a form that was virtually identical to the plaintiff's. See *id.* The issue in the case involved the plaintiff's right to "the form without each day's data, in other words, his rights to the particular selection of categories of statistics appearing on his form." *Id.*

The Second Circuit reversed the trial court's grant of summary judgment for the defendant. See *id.* at 711. In doing so, the court "adopt[ed] a test for future cases by posing the question, whether the previously published selections of statistics had reached the point where it could be said the *Kregos's* selection was insufficiently creative or in the words of *Feist*, 'entirely typical,' 'garden variety,' or 'obvious.'" *Abrams*, *supra* note 59, at 23. This standard conforms to the "minimal degree of creativity" standard established by *Feist*. See *id.* at 24 (discussing *Kregos's* test in light of standard established by *Feist*). In effect, *Kregos* is an elaboration of the limited standard of *Feist*. See *id.* By using the terms supplied by the *Feist* Court, the Second Circuit suggested that any work that exceeded the minimum standard is sufficiently creative to support a copyright. See *id.*

84. See *Abrams*, *supra* note 59, at 24 ("In sum, while *Feist* tells us the negative, that a work failing to exceed these minima is not copyrightable, *Kregos* provides the positive, that any work exceeding the minima is sufficiently creative to be copyrightable.").

85. See, e.g., *Kregos*, 937 F.2d at 704-06 (dealing with originality required for compilation to be copyrightable); *Victor Lalli*, 936 F.2d at 673 (same).

86. See, e.g., *L. Batlin & Son, Inc. v. Snyder*, 536 F.2d 486, 490 (2d Cir. 1976) (discussing level of creativity needed for derivative work to be copyrightable); *Alfred Bell & Co., Ltd. v. Catalda Fine Arts, Inc.*, 191 F.2d 99, 102-103 (2d Cir. 1951) (same).

87. See *VerSteeg*, *supra* note 77, at 818 (discussing different lines of authority concerning creativity); see generally *NIMMER & NIMMER*, *supra* note 52, § 2.01[B], at 2-13 (asserting that any "distinguishable variation" of prior work constitutes originality).

*Catalda Fine Arts, Inc.*⁸⁸ According to the *Alfred Bell* court, a work is considered original if the author contributed something more than a “‘merely trivial’ variation, something recognizably ‘his [or her] own.’”⁸⁹ The United States Court of Appeals for the Second Circuit refined this standard in *L. Batlin & Son, Inc. v. Snyder*.⁹⁰ In *L. Batlin*, the court held that copyright only protects work that is a “substantial variation” from the underlying work.⁹¹ Further, the court added that originality can not be satis-

88. 191 F.2d 99 (2d Cir. 1951). Although *Alfred Bell* is frequently cited as espousing the distinguishable variation standard, the doctrine in many respects owes its origin to the reasoning developed by Justice Holmes. See *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251 (1903) (declaring that ordinary posters or advertisements are just as worthy of copyright protection as books and fine paintings). In *Bleistein*, Justice Holmes stated that “[i]t would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits.” *Id.* This statement gave rise to the doctrine that “judges may not properly assay artistic merit.” NIMMER & NIMMER, *supra* note 52, § 2.01[B], at 2-13. *Alfred Bell* built on this reasoning, concluding that “[n]o matter how poor artistically the ‘author’s’ addition, it is enough if it be his own.” *Alfred Bell*, 191 F.2d at 103 (citing *Bleistein*, 188 U.S. at 250). As long as the author contributed something more than a “merely trivial” variation, the work should be considered original because it is not a judge’s place to gauge the artistic merit of an author’s work. See *id.* at 102-03 (“All that is needed to satisfy . . . the Constitution . . . is that the author contributed something more than a ‘merely trivial’ variation, something recognizably ‘his [or her] own.’”) (citations omitted).

89. *Alfred Bell*, 191 F.2d at 103.

90. 536 F.2d 486 (2d Cir. 1976). *L. Batlin & Son, Inc.* sued to compel Snyder to cancel the recordation of a copyright and to restrain Snyder from enforcing the copyright. See *id.* at 487. The court had to decide whether Snyder’s Uncle Sam mechanical bank was copyrightable. See *id.* at 488. Snyder’s bank was a derivative work based on the original Uncle Sam mechanical bank. See *id.* The original bank, copyrighted in 1886, was metal and stood 11 inches tall. See *id.* By the time Snyder created its version of the bank, which was basically the same as the original except that it was two inches shorter and made of plastic, the design of the bank had long been part of the public domain and Snyder did not need permission to copy its design. See *id.* Snyder filed a copyright with the Register of Copyrights in January 1975. See *id.*

As early as August 1974, Batlin had ordered 30 cartons of a cast iron version of the Uncle Sam bank, as well as a number of the plastic version, from a company in Taiwan where the bank was manufactured. See *id.* In April 1975, the United States’ Customs Service notified Batlin that the plastic banks were covered by Snyder’s copyright. See *id.* Batlin then brought the suit seeking to have Snyder’s copyright declared void. See *id.* The district court granted Batlin a preliminary injunction and Snyder appealed. See *id.* The Second Circuit had to decide whether the district court abused its discretion in granting the injunction. See *id.*

91. See *id.* at 491 (“We do follow the school of cases in this circuit and elsewhere supporting the proposition that to support a copyright there must be at least some substantial variation, not merely a trivial variation such as might occur in the translation to a different medium.”); see also *Gracen v. Bradford Exch.*, 698 F.2d 300, 305 (7th Cir. 1983) (relying on *L. Batlin* in adopting “substantially different” standard of creativity and holding that “a derivative work must be substantially different from the underlying work to be copyrightable”).

In applying the refined test to the facts in *L. Batlin*, the Second Circuit found that Snyder’s bank was not original and therefore was not copyrightable. Cf. *L. Batlin*, 536 F.2d at 492. The court specifically stated that simply changing the me-

fied simply by the demonstration of “physical skill” or “special training.”⁹² Despite the added restrictions, the court continued to abide by the belief that “[t]he test of originality is concededly one with a low threshold.”⁹³

When applying the distinguishable variation standard, courts have focused on the nature of the changes, not the number of them.⁹⁴ Courts have also refused to extend copyright protection to a derivative work where the changes to the preexisting work were “driven primarily by a functional, utilitarian or mechanical purpose.”⁹⁵ Finally, courts have fur-

dium, i.e., changing the bank from metal to plastic, was “merely a trivial variation.” *See id.* at 491. (“[T]he mere reproduction of a work of art in a different medium should not constitute the required originality” (quoting NIMMER & NIMMER, *supra* note 52, § 20.2, at 94)). The court reasoned that extending copyright protection to merely trivial or “minuscule variations would simply put a weapon for harassment in the hands of mischievous copiers intent on appropriating and monopolizing public domain work.” *See id.* at 492.

The rationale for the change was further explained by the Seventh Circuit in *Gracen*. *See Gracen*, 698 F.2d at 305. The court stated its belief that the liberal rule, trivial variation, had the effect of inhibiting the creation of further works by “giving the first creator a considerable power to interfere with the creation of subsequent . . . works from the same underlying work.” *Id.* *But see* NIMMER & NIMMER, *supra* note 52, § 3.03, at 3-16 (questioning *Gracen* court’s reasoning by asking, “why should this be the case, as long as it is open to a second derivative work creator to base his work only upon the underlying work, and not upon the first derivative work”).

92. *See L. Batlin*, 536 F.2d at 491 (rejecting notion that demonstration of physical skill or special training alone is enough to meet originality requirement). The court stated that even if making the plastic molds that created Snyder’s bank required “special training” or “physical skills,” that skill or training alone was not enough to make the bank original. *See id.* “A considerably *higher* degree of skill is required, true artistic skill, to make the reproduction copyrightable.” *Id.* The court looked at the specifics of the case and noted that the plastic molds took about a day and a half to two days to create. *See id.* The court noted that “[i]f there be a point in the copyright law pertaining to reproductions at which sheer artistic skill and effort can act as a substitute for the requirement of substantial variation, it was not reached here.” *Id.*

93. *Id.* at 490.

94. *See, e.g.,* *Grove Press, Inc. v. Collectors Publications, Inc.*, 264 F. Supp. 603, 605 (C.D. Cal. 1967) (finding that 40,000 trivial changes did not amount to originality). In *Grove Press*, the court stated that:

Plaintiff made approximately forty thousand changes from the [original] copy in producing its edition. These changes consisted almost entirely of elimination and addition of punctuation, changes of spelling of certain words, elimination and addition of quotation marks, and correction of typographical errors. These changes required no skill beyond that of a high school English student and displayed no originality. These changes are found to be trivial.

Id. at 605. Because each of the plaintiff’s changes were trivial, the work was uncopyrightable even though the plaintiff made 40,000 such changes. *See id.* at 606 (“Since the new matter in the Grove edition was trivial, the Grove edition is uncopyrightable as a derivative work or otherwise.”).

95. *Entertainment Research Group, Inc. v. Genesis Creative Group, Inc.*, 853 F. Supp. 319, 322 (N.D. Cal. 1994). Entertainment Research Group (ERG) claimed a copyright in three-dimensional inflatable costumes that it manufactured of characters such as “Toucan Sam” and “Geoffrey the Giraffe.” *See id.* at 320-21.

ther refined the distinguishable variation standard by ruling that changes to a preexisting work that are imperceptible to the reader do not merit copyright protection.⁹⁶

2. *West's Victories: Mead and Oasis*

West previously won two important cases involving star pagination, the first of which was its victory over its rival LEXIS, in *West Publishing Co. v. Mead Data Central, Inc.*⁹⁷ In *Mead*, West brought a copyright infringement action based on Mead's proposed use of star pagination to West's report-

The defendant sought summary judgment, claiming that ERG's copyright was invalid. *See id.* at 321. ERG claimed that the costumes they manufactured were copyrightable derivative works "which are based on previously copyrighted characters (i.e., ERG is claiming a derivative copyright in their inflatable Doughboy, where Pillsbury obviously owns the underlying copyright for the Doughboy)." *Id.*

In deciding whether ERG's costumes were sufficiently original to warrant copyright protection as a derivative work, the court basically followed the *L. Batlin* substantial variation test. *See id.* at 321-22 (discussing and applying substantial variation test). Also, the court added that "[a]ny differences in appearance between a derivative work and the preexisting work which are driven primarily by a functional, utilitarian or mechanical purpose cannot be considered when seeking artistic differences for the purpose of originality." *Id.* at 322-23.

The court examined, as one example, the "Toucan Sam" costume. *See id.* at 323 (applying substantial variation test and excluding any changes that were "driven primarily by function"). The court recognized that there were differences between the preexisting work and the derivative costume. *See id.* For example, the original "Toucan Sam" had short, skinny legs that were drawn far apart on the torso. *See id.* The costume version, however, had thick, bulky legs that were placed close to the torso. *See id.* The court noted that these were not artistic or original changes that ERG decided to make. *See id.* Rather, the changes in appearance of the costumes were due to the limitations of the human body, i.e., functional, mechanical and utilitarian considerations. *See id.* Therefore the court concluded that "[n]o reasonable trier-of-fact could find that [the] differences were the result of 'artistic' decision making" and granted summary judgment to the defendant. *Id.* at 323-24.

96. *See EFS Mktg., Inc. v. Russ Berrie & Co., Inc.*, 836 F. Supp. 128, 133 (S.D.N.Y. 1993) ("Minuscule variations of otherwise preexisting craftsmanship that are imperceptible to the reader are insufficient to obtain copyright protection.") (emphasis added) (citing *L. Batlin*, 536 F.2d at 489). In *L. Batlin*, the fact that the Snyder's changes to the bank were imperceptible to a casual observer was clearly part of the court's reasoning in concluding that Snyder's derivative work was not a substantial variation of the original bank. *See L. Batlin*, 536 F.2d at 489. The court stated:

Appellant Snyder claims differences not only of size but also in a number of other very minute details: the carpetbag shape of the plastic bank is smooth, the iron bank rough; the metal bank bag is fatter at its base; the eagle on the front of the platform in the metal bank is holding arrows in his talons while in the plastic bank he clutches leaves In the metal version the umbrella is hanging loose while in the plastic item it is included in a single mold Many of these differences are not perceptible to the casual observer. Appellants make no claim for any difference based on the plastic mold lines in the Uncle Sam figure which are perceptible.

Id.

97. 799 F.2d 1219 (8th Cir. 1986).

ers in its computer-assisted legal research system, LEXIS.⁹⁸ The United States District Court for the District of Minnesota decided the issue in West's favor and granted a preliminary injunction against Mead.⁹⁹ On appeal, the United States Court of Appeals for the Eighth Circuit affirmed the district court's decision.¹⁰⁰

First, the Eighth Circuit held that arrangement and pagination could be protected by copyright.¹⁰¹ After examining what it considered to be the most relevant precedents,¹⁰² the court concluded that "[a]n arrangement of opinions in a case reporter, no less than a compilation and ar-

98. *See id.* at 1221 (discussing facts in appeal from preliminary injunction). LEXIS is a computer-assisted legal research service, first marketed in 1973, which reports decisions of state and federal courts. *See id.* at 1222. Cases stored on LEXIS had always included the citation to the first page of West's reported decision. *See id.* West never challenged the use of page numbers, acknowledging that citation to the first page was a noninfringing "fair use" under the 1976 Act. *See id.*

In 1985, however, LEXIS announced a plan to provide its users with a star pagination feature that would insert page numbers from West's National Reporter System into the body of LEXIS cases. *See id.* (discussing how system would provide "jump" or "pinpoint" citations to West's reporters). "Thus, with the LEXIS Star Pagination Feature, LEXIS users would be able to determine the West page number corresponding to the portion of an opinion viewed on LEXIS without ever physically referring to the West publication in which the opinion appears." *Id.* West then filed suit, arguing that "the LEXIS Star Pagination Feature [was] an appropriation of [its] comprehensive arrangement of case reports in violation of the Copyright Act of 1976." *Id.* This is the same issue that the court faced in *Bender*. *See generally* Matthew Bender & Co. v. West Publ'g Co., 41 U.S.P.Q.2d 1321 (S.D.N.Y. 1996) (analyzing issue of copyright protection for West's reporters).

99. *See* West Publ'g Co. v. Mead Data Cent., Inc., 616 F. Supp. 1571, 1583 (D. Minn. 1985) (relying in part on the Supreme Court's decision in *Callaghan*). The court interpreted *Callaghan* to stand for the proposition that "under appropriate circumstances pagination and arrangement ascend to a level appropriate for copyright protection." *Id.* at 1576 (citing *Callaghan v. Meyers*, 128 U.S. 617, 661, 662 (1888)). The court thought copyright protection would be appropriate where the arrangement and page numbers were the result of the "labor, talent, or judgment" of the creator. *See id.* On the other hand, if the arrangement and page numbers "depend simply on the will of the printer, or the order in which the cases have been decided, or upon other accidental circumstances, they of course are not subject to copyright protection . . ." *Id.* In applying this principle to the facts, the court determined that West's arrangement satisfied the *Callaghan* test and therefore could be protected by copyright. *See id.* For a further discussion of the Supreme Court's decision in *Callaghan*, see *infra* notes 104-06 and accompanying text.

100. *See Mead*, 799 F.2d at 1229-30 (concluding that district court did not abuse its discretion in granting preliminary injunction). For a discussion of the Eighth Circuit's reasoning and analysis, see *infra* notes 101-10 and accompanying text.

101. *See Mead*, 799 F.2d at 1223-26 (discussing potential copyright protection for arrangement and pagination).

102. *See generally id.* (discussing relevant authority, focusing on *Callaghan*). The court's choice of relevant authority has been the subject of much criticism. *See e.g.*, Carl J. Khalil, *Are Page Numbers Really Copyrightable? The Effect of Feist on the West Publishing v. Lexis Case*, 76 J. PAT. & TRADEMARK OFF. SOC'Y 807, 811 (1994) (stating that court relied on "perhaps the most specious of authority"); Wyman, *supra* note 5, at 244-45 (questioning *Mead* court's reliance on *Callaghan*); *see also* Dahl, *supra*

rangment of Shakespeare's sonnets, can qualify for copyright protection."¹⁰³ In reaching its conclusion, the court relied on the Supreme Court's decision in *Callaghan v. Meyers*.¹⁰⁴ In *Callaghan*, the

note 68, at 733 (same). For a further discussion of the *Mead* court's questionable use of precedent, see *infra* notes 104-05.

103. *Mead*, 799 F.2d at 1224. In making this conclusion, the court specifically rejected Mead's contention that case arrangements were per se uncopyrightable. *See id.* at 1223 (summarizing Mead's argument). Mead claimed that the portion of West's cases that were actually used by LEXIS, specifically the page numbers, were not copyrightable. *See id.* To support this claim, Mead argued that an arrangement of cases and page numbers could not possibly meet the original work of authorship requirement. *See id.* In the alternative, Mead argued that even if arrangement and pagination could possibly qualify as an original work, "West's case arrangement and pagination do not in fact meet this standard." *Id.*

The court stated that the "dominant chord" of Mead's argument was that mere page numbers are not copyrightable. *See id.* According to the court, Mead would have prevailed if it were indeed just mere page numbers that West sought to copyright. *See id.* at 1227. The court concluded that West sought copyright protection "because access to these particular numbers—the 'jump cites'—would give users of LEXIS a large part of what West has spent so much labor and industry in compiling, and would *pro tanto* reduce anyone's need to buy West's books." *Id.*

The court, however, reasoned that Mead was not just copying page numbers. *See id.* at 1224. The page numbers reflected and expressed the arrangement of a compilation, and the arrangement of a compilation was copyrightable. *See id.* Therefore if West's arrangement of cases qualified as an original work of authorship, use of West's page numbers would infringe West's copyright. *Cf. id.*

104. 128 U.S. 617 (1888). The fact that the *Mead* court relied so heavily on *Callaghan* has led some courts and commentators to question the court's decision. *See, e.g., Mead*, 799 F.2d at 1238-39 (Oliver, J., dissenting) (suggesting that court's reliance on *Callaghan* is misplaced); Wyman, *supra* note 5, at 244-45 (questioning *Mead* court's reliance on *Callaghan*); *see also* Dahl, *supra* note 68, at 733 (same). In *Callaghan*, the defendant copied the plaintiff's arrangement of cases as well as the plaintiff's headnotes, statements of cases and arguments of counsel. *See Callaghan*, 128 U.S. at 619-33 (stating case for copyright infringement); *see also* Dahl, *supra* note 68, at 733 (discussing facts of *Callaghan*); Patterson & Joyce, *supra* note 24, at 744 (stating that issue in *Callaghan* involved both judicial opinions and original matter).

It is arguable that the more sound decision would have been to rely on *Banks v. Manchester*, 128 U.S. 244 (1888), because the facts of that case more closely resembled the facts of *Mead*. *See Mead*, 799 F.2d at 1243 (J. Oliver, dissenting) ("The record in this case establishes a factual situation comparable to *Banks v. Manchester* rather than that presented in *Callaghan*."); *see also* Dahl, *supra* note 68, at 733 (comparing *Banks* to *Mead* and determining that *Banks* is factually similar to *Mead*). Despite the factual similarities, the majority in *Mead* did not even cite or discuss the *Banks* decision. *See Mead*, 799 F.2d at 1239-40 (J. Oliver, dissenting) (finding fault with majority opinion). In *Banks*, the Court held that judges were not entitled to copyright protection for the opinions they authored while acting in their official capacities. *See Banks*, 128 U.S. at 253. The Court also ruled that a reporter of opinions could not copyright judicial opinions because the reporter did not create them. *See id.* at 250-51. *Banks* is significant in relation to *Mead* because *Banks* led one court that closely examined the decision to conclude that "the reporter's right to protection must be limited to his [or her] intellectual labor." *Banks Law Publ'g Co. v. Lawyers' Co-operative Publ'g Co.*, 169 F. 386, 390 (2d Cir. 1909).

In *Banks*, the defendant only reproduced the unprotected works of judges; in *Callaghan*, however, copyrightable elements of the reporter were also appropri-

Court indirectly addressed the copyrightability of arrangement and pagination of case reporters.¹⁰⁵ The *Callaghan* Court stated, in dicta, that case arrangement and pagination were features of a case reporter that may be protected by copyright.¹⁰⁶ Thus, the *Mead* court concluded that the

ated. See *Mead*, 799 F.2d at 1243 (J. Oliver, dissenting). In *Mead*, as in *Banks*, the defendant did not use any of West's original material, such as headnotes, syllabi, indexes or tables of cases that would be protected by copyright. See *id.* at 1223. Therefore it is arguable that the court in *Mead* should have "follow[ed] *Banks v. Manchester's* application of the principles enunciated in *Wheaton v. Peters* and distinguished *Callaghan* on its facts." *Id.* at 1243 (J. Oliver, dissenting).

The *Mead* court has also been criticized for not applying *Lawyers' Co-operative*. See *id.* at 1245 (J. Oliver, dissenting) (dissenting from majority's rejection of *Lawyers' Co-operative*); see also Dahl, *supra* note 68, at 733-34 (arguing that majority's emphasis on official status of reporter in *Lawyers' Co-operative* was misplaced). The majority stated that the ruling in *Lawyers' Co-operative* was "based upon the official status of the reporter." See *Mead*, 799 F.2d at 1225. The court also stressed its belief that *Lawyers' Co-operative* conflicted with *Callaghan* and as a decision of the Supreme Court, the Eighth Circuit had no choice but to follow *Callaghan*. See *id.* at 1226 ("To the extent that [*Lawyers' Co-operative*] diverges from *Callaghan*, we of course follow the Supreme Court.").

As stated above, it can be argued that the majority opinion in *Mead* "placed too much emphasis on the official status of the reporter in [*Lawyers' Co-operative*]." Dahl, *supra* note 68, at 733-34. Instead, *Lawyers' Co-operative* should be viewed in conjunction with *Eggers v. Sun Sales*, 263 F. 373 (2d Cir. 1920), "which held pagination . . . [was] not independently copyrightable when the report was not made pursuant to a specific statutory requirement." Dahl, *supra* note 68, at 734 (citing *Eggers*, 263 F. at 375). In addition, the *Mead* court incorrectly categorized *Lawyers' Co-operative* as conflicting with *Callaghan*. Cf. Patterson & Joyce, *supra* note 24, at 745 ("*Lawyers Co-operative* is consistent with *Wheaton* and [*Banks*], and not inconsistent with *Callaghan*"). Specifically, *Callaghan* dealt with a situation involving "piracy of law books" and the use of star pagination by legal publishers is not piracy. See *id.*

105. See Dahl, *supra* note 68, at 727 (stating that Court in *Callaghan* indirectly dealt with issues of arrangement and pagination). In *Callaghan*, the defendant was a publisher who wanted to publish judicial opinions and negotiated with the plaintiff for the use of his reports. See *Callaghan*, 128 U.S. at 619-22. After his attempts to obtain the plaintiff's rights to the work failed, the defendant copied the reports, including the arrangement and page numbers, without the plaintiff's permission. See *id.* The Court ruled that the defendant's action constituted infringement of the plaintiff's copyright. See *id.* at 662. Despite noting that arrangement and pagination were elements of a reporter that may be protected by copyright, the Court expressly refused to recognize the plaintiff's copyright in those elements. See *id.* ("[T]he arrangement of law cases and the paging of the book may depend simply on the will of the printer, of the reporter, or publisher, or order in which the cases have been decided, or upon other accidental circumstances."); see also Dahl, *supra* note 68, at 728 (offering analysis of Court's holding in *Callaghan* and stating that "the Supreme Court made it clear that *Callaghan's* works would not have constituted an infringement had he not pirated other, original portions of Myer's reporter, namely his headnotes, tables, indexes, and syllabi.").

106. See *Callaghan*, 128 U.S. at 649; see also Dahl, *supra* note 68, at 728 (explaining Court's statement that pagination and arrangement could potentially be protected by copyright under certain circumstances).

Supreme Court's dicta indicated that there was not a per se rule against copyright protection for case arrangements and pagination.¹⁰⁷

Second, the *Mead* court concluded that "the arrangement West produces . . . is the result of considerable labor, talent, and judgment."¹⁰⁸ The court stated that originality required only a modicum of intellectual labor and West's reporters easily met that standard.¹⁰⁹ Therefore, West's case arrangements, including internal pagination, were original works of authorship entitled to copyright protection.¹¹⁰

Because the *Mead* court relied so heavily on the labor West exerted in arranging its cases,¹¹¹ some commentators have questioned the validity of

107. See *Mead*, 799 F.2d at 1226 (finding that "there is no per se rule that case arrangements are not copyrightable"). The court stated that "*Callaghan* does not seem so hostile to the very idea that case compilation, arrangement, and paging can be protected by copyright." *Id.* But see Dahl, *supra* note 68, at 728 (arguing that *Callaghan* Court expressly refused to recognize copyright in case arrangement and page numbers).

108. *Mead*, 799 F.2d at 1226. In order to support the conclusion that West exerted considerable effort in arranging its cases, the court explained West's publishing process. See *id.* (describing West's arrangement of opinions). First, West collects the opinions from every federal and state court in the United States. See *id.* The federal and state opinions are divided and then assigned to the appropriate reporter series. See *id.* West further divides state court opinions by geographic region and those decisions are then assigned to the appropriate regional reporter. See *id.* Federal opinions are first divided according to the level of the court by which they were decided. See *id.* Those opinions may be further divided according to the subject matter of the case. See *id.* Once a decision has been assigned to a reporter, it will then be assigned to a volume and arranged within that volume. See *id.* For example, federal court of appeals decisions are arranged by circuit within each volume of West's *Federal Reporter, Second Series*. See *id.*

109. See *id.* at 1227 ("[T]o meet . . . [the originality] requirement[] a work need only be the product of a modicum of intellectual labor; West's case arrangements easily meet this standard.") The court further justified its conclusion by explaining that a contrary holding would allow *Mead* to use star pagination, thereby giving LEXIS users "a large part of what West has spent so much labor and industry in compiling." *Id.*

110. See *id.* (holding that West's arrangements are original works of authorship and that *Mead*'s proposed use of star pagination would infringe West's copyright in those arrangements).

111. See Wyman, *supra* note 5, at 241 (stating that *Mead* court "focused an inordinate amount of attention on the labor West expended in compiling its case reporters"); see also Khalil, *supra* note 102, at 811 (commenting that court relied in substantial part on fact that West expended considerable labor and effort in preparing its case reports). "West's arrangement, the court observed, was 'the result of considerable labor, talent and judgment'; and what [*Mead*] was trying to do was give its users 'a large part of what West has spent so much labor and industry in compiling.'" Wyman, *supra* note 5, at 241. The court also applied the "sweat of the brow" theory when applying what it considered to be relevant precedent. See generally *Mead*, 799 F.2d at 1224 (discussing Court's decision in *Callaghan* and considering labor involved in arrangement and pagination in that case). For example, the court concluded that the reason that the *Callaghan* Court had not specifically ruled that case arrangement and pagination were independently copyrightable was that the arrangement and pagination in question "involved little labor." See *id.*

Mead in light of *Feist*.¹¹² Despite these questions, the United States District Court for the District of Minnesota affirmed the *Mead* decision in *Oasis Publishing Co., Inc. v. West Publishing Co.*¹¹³

Oasis Publishing Company, Inc. ("Oasis") published cases and statutes in Compact Disk-Read Only Memory ("CD-ROM") format.¹¹⁴ Oasis intended to publish Florida court decisions on CD-ROM with both parallel citation and star pagination to West's *Florida Cases*.¹¹⁵ Oasis sued West,

112. See, e.g., NIMMER & NIMMER, *supra* note 52, § 3.03, at 3-15 ("It is doubtful [that *Mead*] . . . survives the Supreme Court's rejection of the 'sweat of the brow' doctrine [in *Feist*].") (footnote omitted); Khalil, *supra* note 102, at 811 (concluding that *Feist* undermines court's holding in *Mead*). Considering the holding of *Feist*, it is obvious why *Mead* is now questionable authority. See *id.* at 810. The district court, for example, referred to West's "effort" and "enterprise" at least once each and to the "labor" that West exerted at least four times. See *id.* at 811. After *Feist*, however, considerations of labor and enterprise are no longer relevant. See *id.* (discussing how *Feist* undermined previous considerations, including labor and enterprise, in copyright cases involving West); see also Wyman, *supra* note 5, at 242 ("[T]he amount of labor expended . . . is, after *Feist*, entirely irrelevant to copyright considerations.").

Similarly, the position of the Eighth Circuit, in *Mead*, is severely weakened by *Feist*. See Khalil, *supra* note 102, at 811. "The Eighth Circuit relied upon . . . perhaps the most specious authority . . . and . . . the considerable labor expenditure of West Publishing. *Feist* undermined each of these bases for the Eighth Circuit holding." *Id.* (citations omitted).

113. 924 F. Supp. 918 (D. Minn. 1996). The court declared that "*Feist* did not overrule *Mead*." *Id.* at 923. According to the *Oasis* court, *Mead* applied essentially the same standard of creativity that was used in *Feist*. See *id.* *Mead* had not applied a mere "sweat of the brow" analysis, rather it considered the "'originality and intellectual-creation requirements' of the arrangement." *Id.* (quoting *Mead*, 799 F.2d at 1225-26). In its analysis, the court emphasized that *Feist* had not created a new test of originality; *Feist* simply "reaffirmed the originality standard as it existed in the Copyright Act of 1909, as it was consistently recognized by the Copyright Office, and as it was emphasized by the Copyright Act of 1976." *Id.* The court also stated that even if *Feist* had created a new test, West's arrangement would easily satisfy the "modicum of creativity" standard articulated in *Feist*. See *id.* at 924. For these reasons, the *Oasis* court concluded that *Mead* was still applicable to the facts before it, even in light of *Feist*. See *id.* at 923-24 (applying *Mead* analysis to facts of case).

114. See *id.* at 920. Oasis planned to obtain a copy of West's *Florida Cases*, which contains all of the Florida cases that West prints in its *Southern Reporter*, and reproduce it in CD-ROM format. See *id.* at 921. The CD-ROM product would contain both parallel citation and star pagination to *Florida Cases*. See *id.* West was willing to concede that the inclusion of parallel citation was a "fair use" under the Copyright Act. See *id.* As in *Mead*, however, West contended that the use of star pagination violated its copyright. See *id.*

115. See *id.* (explaining Oasis's plans with regard to its CD-ROM product). Oasis did not plan to use any material authored by West, such as case synopses, syllabi, etc. See *id.* West publishes *Florida Cases*, in which it reprints Florida cases that appear in West's *Southern Reporter*. See *id.* (explaining West's publishing activities in Florida). *Florida Cases* is the official reporter of the state of Florida. See *id.* at 921. Since 1957, West's contract with Florida contained a clause that stated "[t]he Synopsis, Syllabi, and Key Number Digest classifications, Index Digest, Table of Statutes Construed . . . included in the volumes of *Florida Cases*, are subject to copyright and will be copyrighted. Beginning in 1987, the parties added 'and arrangement of cases' to the sentence." *Id.*

seeking a declaratory judgment that its actions did not violate West's copyright.¹¹⁶ The court, relying on *Mead*, determined that West's arrangement of cases possessed "the requisite creativity for copyright protection."¹¹⁷ Finally, the court held that pagination was an integral part of arrangement and was protected by West's copyright.¹¹⁸

III. MATTHEW BENDER & CO. V. WEST PUBLISHING CO.: FACTS AND PROCEDURAL HISTORY

A. *West Publishing Company*

West is the leading publisher of state and federal judicial opinions in the United States.¹¹⁹ West compiles these decisions in books known as

116. *See id.* (explaining Oasis's claims as alleged in its complaint). In addition, Oasis claimed that West had created and maintained an illegal monopoly and a dangerous probability of monopoly under both federal and Florida law. *See id.* Also, Oasis claimed that West's refusal to allow it to star paginate violated a number of Florida public records statutes. *See id.*

117. *Id.* at 925. The court concluded that the Eighth Circuit, in *Mead*, applied the proper originality standard and that West's arrangement of cases "easily satisfied the 'modicum of creativity' standard later emphasized repeatedly by the Supreme Court in *Feist*." *Id.* at 924.

118. *See id.* at 925 ("Pagination of that arrangement is an integral part of the arrangement and shares in any copyright protection in the arrangement itself."). Oasis appealed the decision and West, despite its victory, offered Oasis a favorable settlement to withdraw its appeal. *See* Thomas Scheffey, *A Cagey Move?*, CONN. L. TRIB., Aug. 11, 1997, available in LEXIS, News Library, Clt File (discussing West's settlement with Oasis). The exact terms of the settlement were not revealed, but West stated that "it paid some of Oasis' legal costs, gave the small CD-ROM publisher a 'not insignificant' money settlement and entered into a licensing deal permitting Oasis to use West's book and page numbers at a favorable rate." *Id.* By settling the case, West preserved the favorable decisions of *Mead* and *Oasis* and reduced the prospects of settlement of the star pagination issue by the Supreme Court. *See id.* (discussing legal implications of *Oasis* settlement).

119. *See* Patterson & Joyce, *supra* note 24, at 720-21 n.2 (stating that West is "premier publisher of state and federal judicial opinions"). West has been in legal publishing since 1876. *See id.* (discussing activities of John B. West, founder of West Publishing and his first publication, *The Syllabi*). In 1975, West started WESTLAW, its computer-assisted legal research system. *See id.*

"reporters."¹²⁰ Citing to West's reporters is a commonly accepted and often necessary practice in many legal documents.¹²¹

Before an opinion is included in a reporter, West proofreads it and checks the citations, often adding parallel citations when it believes one is necessary.¹²² West then prepares headnotes, adds a synopsis of the opinion to the case and arranges the opinion to conform with its style and format.¹²³ Next, West assigns the opinion, according to the subject matter or the particular court, to one of the individual series in the National Reporter System.¹²⁴ Each reported opinion is assigned to a volume and further categorized and arranged within that volume.¹²⁵ Finally, volume and page numbers are added, allowing for precise reference to the location of

120. See *Matthew Bender & Co. v. West Publ'g Co.*, No. 94 CIV. 0568, 1995 WL 702389, at *1 (S.D.N.Y. Nov. 28, 1995). Each reporter is part of a series of books known as the "National Reporter System." See *West Publ'g Co. v. Mead Data Cent., Inc.*, 799 F.2d 1219, 1221 (8th Cir. 1986) (describing West's publishing system). The "National Reporter System" consists of 15 trademarks: Atlantic Reporter, Bankruptcy Reporter, California Reporter, Federal Reporter, Federal Rules Decisions, Federal Supplement, Military Justice Reporter, New York Supplement, North Eastern Reporter, Southern Reporter, South Western Reporter and Supreme Court Reporter. See *Patterson & Joyce*, *supra* note 24, at 721-22 n.5.

West also publishes official reports that are not considered units of the National Reporter System: Arizona Reports, Idaho Reports, Maryland Reports, Maryland Appellate Reports, New Jersey Reports, New Jersey Superior Court Reports, New Jersey Tax Court Reports, New Mexico Reports, Pennsylvania Reports and Pennsylvania Superior Court Reports. See *id.* at 727-28 n.21.

Some state reporters have been discontinued and the volumes of the National Reporter System are now designated as official: Alabama Reports, Alabama Appellate Court Reports, Delaware Reports, Delaware Chancery Reports, Colorado Reports, Florida Reports, Iowa Reports, Indiana Reports, Indiana Court of Appeals Reports, Kentucky Reports, Maine Reports, Minnesota Reports, Mississippi Reports, Missouri Reports, North Dakota Reports, Oklahoma Reports, Oklahoma Criminal Reports, South Dakota Reports, Tennessee Reports, Tennessee Criminal Appeals Reports, Wisconsin Reports and Wyoming Reports. See *id.*

Several other states have discontinued their own reports, but have not designated West's volumes as official: Louisiana Reports, Texas Reports, Texas Criminal Appellate Reports, Texas Civil Appellate Reports and Utah Reports. See *id.*

121. See *Patterson & Joyce*, *supra* note 24, at 727-28 n.21 ("Citation to the specific volume and page number of a case as found in a West reporter is common, and indeed often necessary, in judicial opinions, attorney's briefs and other legal documents."); see also D.C. CIR. R. 8(f) (requiring use of Federal Reporter for District of Columbia Circuit Court decisions and National Reporter System for state court decisions); 1ST CIR. R. 11(h) (requiring use of West's system for state decisions); 3D CIR. R. 21(1)(A)(i) (calling for use of West system "whenever possible"); *Berring*, *supra* note 5, at 631 n.61 (stating that 15 federal district and circuit courts require citation to West publications).

122. See *Mead*, 799 F.2d at 1221-22 (describing West's procedure before cases are published).

123. See *id.* at 1222 (documenting additions West makes to cases).

124. See *id.* (including such reporters as *Federal Reporter*, *Second Series* or *Bankruptcy Reporter*).

125. See *id.* (detailing West's process).

the case within West's system.¹²⁶ When each volume is completed, West registers a copyright claim with the Register of Copyrights and receives a Certificate of Registration for the volume.¹²⁷

B. *Matthew Bender & Company*

Matthew Bender & Company, Inc. ("Bender") is a legal publisher whose works include a number of casebooks, treatises and practice guides.¹²⁸ Bender also produces products in CD-ROM format.¹²⁹ In its CD-ROM products, Bender inserts into the text of the opinions the volume and page number where the text of the opinion is found in West's reporter.¹³⁰ Bender provides the users of the CD-ROM product with the volume and page number where a case begins and the place in the text where the page break occurs in West's version of the opinion.¹³¹ In effect, Bender star-paginates to West's reporters.¹³² By doing so, Bender allows its CD-ROM users to cite to West volumes without having to purchase West's products.¹³³

C. *HyperLaw, Inc.*

HyperLaw, Inc. ("HyperLaw") is a CD-ROM publisher that specializes in the publication of legal information.¹³⁴ One of HyperLaw's products is

126. *See id.* ("Volumes and pages are numbered sequentially to facilitate precise reference to West reports; citing the proper volume number, series name, and page number communicates the exact location of a West report, or a portion thereof, within the National Reporter System.")

127. *See id.* (discussing West's final step in certification).

128. *See* *Matthew Bender & Co. v. West Publ'g Co.*, No. 94 CIV. 0589, 1995 WL 702389, at *1 (S.D.N.Y. Nov. 28, 1995).

129. *See id.* (explaining portion of Bender's business). One such product is a comprehensive collection of published and unpublished decisions, beginning with cases from 1990, of the Second Circuit Court of Appeals and the four United States District Courts within New York called the "Search Master New York Practice Library With Cases" ("Search Master"). *See id.* Bender also planned future versions of Search Master that were to contain federal and state cases from earlier years. *See id.*

130. *See* Memorandum of the United States as Amicus Curiae in Support of the Proposition that Bender's Star Pagination to West's National Reporter System Does Not Infringe Any Copyright Interest West May Have In the Arrangement of the National Reporter System at 3-4, *Matthew Bender & Co. v. West Publ'g Co.*, No. 94 CIV. 0589, 1997 WL 266972 (S.D.N.Y. May 19, 1997) available at <<http://www.usdoj.gov/atr/cases/f0800/0866.htm>>.

131. *See id.*

132. *See id.* (explaining star pagination). In legal publishing, the procedure of inserting the page number of one publication into the text of another, for purpose of cross-referencing, is known as "star paging." *See* *Matthew Bender & Co. v. West Publ'g Co.*, No. 94 CIV. 0589, 1996 WL 223917, at *3 n.2 (S.D.N.Y. May 2, 1996).

133. *See* *Bender*, 1995 WL 702389, at *1.

134. *See* Plaintiff's Motion for Summary Judgment at 6, *Bender*, 1997 WL 266972, available at <<http://www.hyperlaw.com/hlsjfin.htm>> (explaining HyperLaw's method of collecting and compiling cases).

a CD-ROM database that contains all of the cases that HyperLaw has collected from the United States Courts of Appeals and the Supreme Court.¹³⁵ While HyperLaw obtains most of its cases from other sources, it did scan a number of cases directly from West's reporters.¹³⁶ HyperLaw planned to expand its product to provide a user with the ability to see the text of any opinion cited in a case by simply clicking on the citation.¹³⁷ Because many of the cases cited date back to before HyperLaw began to collect cases, HyperLaw planned to scan the older cases into its products directly from West's reporters.¹³⁸

D. *The Case*

In February 1994, Bender filed an action in the United States District Court for the Southern District of New York seeking a declaration that West did not possess a federal statutory copyright in the page numbers of its reporters.¹³⁹ HyperLaw intervened as a plaintiff in the action.¹⁴⁰ HyperLaw sought a declaration of noninfringement with respect to page numbers, as well as to its use of West's reporters in its CD-ROM product.¹⁴¹

135. *See id.* HyperLaw began collecting Supreme Court cases in 1991 and started collecting cases from the Courts of Appeals in 1993. *See id.* By June 1996, HyperLaw had collected 36,000 cases, of which 22,000 had also been published by West in its reporters. *See id.*

136. *See Bender*, 1997 WL 266972, at *1 (revealing that HyperLaw scanned "a small percentage of cases" from West's reporters). HyperLaw scanned the title, text and other information directly from West's reporters. *See id.* HyperLaw, however, did not scan West's headnotes or key numbers. *See id.*

137. *See id.* (discussing HyperLaw's plans to expand its product).

138. *See id.* Ultimately, this practice may result in HyperLaw scanning up to 75% of West cases into its system. *See id.* In its motion for summary judgment, HyperLaw supplied an example of what it intended to copy from one of West's reporters. *See Plaintiff's Motion for Summary Judgment at 6, Bender*, 1997 WL 266972, available at <<http://www.hyperlaw.com/hlsjfin.htm>> (describing HyperLaw's intended use of West's work). Using Volume 1 of the *Federal Reporter-Third Series* as an example, HyperLaw cites 15 cases that it could not obtain electronically and would have to scan into its system. *See id.* HyperLaw would have to copy the names of counsel published by West from Fifth and Eleventh Circuit cases and other circuits in which West is not the slip opinion reporter. *See id.* at 7. Also, like Bender, HyperLaw plans to star-paginate to the West reporter. *See id.*

139. *See Matthew Bender & Co. v. West Publ'g Co.*, No. 94 CIV. 0589, 1996 WL 223917, at *1 (S.D.N.Y. May 2, 1996). Bender also filed a declaratory action concerning a similar product that it produced covering Texas law. *See id.* at *7 (discussing Bender's Texas product action). The Texas product is a CD-ROM entitled "Search Master Texas Practice Library." *See id.* Bender hoped to enhance the Search Master by adding published decisions of the Texas courts for the past 40 years. *See id.* ("[The enhancement would allow] users . . . [to] move from a citation in a Bender treatise to the actual judicial opinion. The opinions in the Texas product will contain star pagination to the Texas court opinions in West's South Western Reporter.").

140. *See id.* at *1.

141. *See id.*

After West's motion to dismiss the complaints was denied, Bender and HyperLaw moved for summary judgment on their respective issues.¹⁴² After hearing arguments from each side, the court granted both Bender's and HyperLaw's motions for summary judgment on the star pagination issue.¹⁴³ The court, however, found that a disputed issue of material fact existed with respect to HyperLaw's claims regarding the text of opinions and accordingly denied HyperLaw's motion on those claims.¹⁴⁴ After a trial on the remaining issues, the court found that HyperLaw's use, in its CD-ROM product, of cases that it scanned directly from West's reporters did not violate West's copyright.¹⁴⁵

IV. ANALYSIS

A. *Matthew Bender & Co. v. West Publishing Co.: Narrative Analysis*

In *Bender*, the court addressed two separate issues, each having a potentially tremendous impact on the future of the legal publishing market.¹⁴⁶ After a hearing concerning the parties' motions for summary judgment, the court granted judgment in favor of Bender and HyperLaw on the star pagination issue.¹⁴⁷ The court then ruled that HyperLaw could scan cases from West's reporters directly into its computer system without violating West's copyright.¹⁴⁸

1. *Star Pagination*

In its previous copyright battles, West successfully argued that a competitor's "star pagination constitute[d] appropriation of West's compre-

142. See *Matthew Bender & Co. v. West Publ'g Co.*, 41 U.S.P.Q.2d 1321, 1321 (S.D.N.Y. 1996).

143. See *Bender*, 41 U.S.P.Q.2d at 1330 (concluding that "summary judgment should be issued on the question of the use of star pagination").

144. See *id.* (finding that "it is a more practical approach . . . that the issues of fact be developed at trial").

145. *Matthew Bender & Co. v. West Publishing Co.*, No. 94 CIV. 0589, 1997 WL 266972, at *5 (S.D.N.Y. May 19, 1997) ("HyperLaw is entitled to a judgment that its copying on [sic] the opinions from the West reports does not violate West's copyrights."). For an analysis of the court's holding in *Bender*, see *infra* notes 146-254 and accompanying text.

146. For a discussion of the facts of *Bender*, see *supra* notes 119-46 and accompanying text. For a discussion of the potential effects of the decision on the legal publishing market and legal research, see *infra* notes 255-94 and accompanying text.

147. See *Bender*, 41 U.S.P.Q.2d at 1330 (holding page numbers of West's reporters were not protected by copyright). For a discussion of the court's reasoning in ruling that West's page numbers were not protected by copyright, see *infra* notes 149-67 and accompanying text.

148. See *Bender*, 1997 WL 266972, at *4 (ruling that West did not have protectable interest in text of opinions it published). The court based its decision on evidence presented in a very brief trial. See *generally* Transcript, Jan. 27-28, 1997 Trial, *Bender*, 1997 WL 266972, available at <<http://www.hyperlaw.com/trialtr.htm>>.

hensive arrangement of case reports in violation of the Copyright Revision Act of 1976.”¹⁴⁹ West took the same position in *Bender*, arguing that although facts are not copyrightable, a compilation is protected by copyright.¹⁵⁰ The protection afforded a compilation extends to the original arrangement and anything that copies West’s original arrangement constitutes a violation of its copyright.¹⁵¹ According to West, page numbers are an integral part of its arrangement.¹⁵² Therefore, West argued that copying the numbers from West’s reporters would be equivalent to copying its arrangement.¹⁵³

Bender and HyperLaw, however, argued that they were not copying West’s arrangement of cases.¹⁵⁴ Rather, their use of star pagination “states a fact—where certain public domain matter, i.e., a passage from a judicial opinion, is located in a parallel source—and nothing more.”¹⁵⁵

149. See *West Publ’g Co. v. Mead Data Cent., Inc.*, 616 F. Supp. 1571, 1575 (D. Minn. 1985) (holding that West’s page numbers were protected by copyright as part of its arrangement of cases); see also *Oasis Publ’g Co. v. West Publ’g Co.*, 924 F. Supp. 918, 925 (D. Minn. 1996) (same).

150. See *Bender*, 41 U.S.P.Q.2d at 1322 (explaining West’s position on star pagination). In a compilation, the protectable expression is the arrangement and according to West, “arrangement has everything to do with where case reports are found in volumes and how they are displayed and how they are reported by West.” *Id.*

151. See *id.* at 1324 (discussing extent of copyright protection).

152. See *id.* (arguing that West’s arrangement “has everything to do” with place in volume in which case appears).

153. See *id.* (arguing compilation copyright protects “entire work as a whole”). West claimed that the page numbers were essential to the arrangement of its reporters. See *id.*

154. See Matthew Bender’s Brief in Support of Motion for Summary Judgment, at 14, *Matthew Bender & Co. v. West Publ’g Co.*, No. 94 CIV. 0589, 1997 WL 266972 (S.D.N.Y. May 19, 1997) available at <<http://www.hyperlaw.com/mbsjbr.htm>> (arguing that Bender did not violate West’s copyright). Bender compared Volume 1 of Federal Reporter-Third Series to its New York product. See *id.* The nine Second Circuit opinions that appeared in Volume 1 were arranged consecutively by West. See *id.* In the New York product, however, those nine cases were interspersed across 37 cases. See *id.* The New York product included cases that appeared on LEXIS but not in the West reporter. See *id.* In addition, Bender’s product did not arrange opinions in separate volumes as West did. See *id.* Thus, Bender argued that there was no “actionable similarity between West’s and Bender’s arrangement of cases.” *Id.*

155. *Id.* (quoting Patterson & Joyce, *supra* note 24, at 758 n.137). In its brief, Bender attacked West’s theory that page numbers reflected original elements of West’s compilation, stating that the theory “rests on a false factual premise—that star pagination is intended to and does relate to arrangement.” *Id.* Instead, according to Bender, “the information conveyed by star pagination is present solely to state a fact about the location of text in a parallel source.” *Id.*; see Patterson & Joyce, *supra* note 24, at 758 n.137 (stating emphatically that star pagination does not reflect case arrangement). According to two prominent commentators on the subject, “star pagination of judicial reports has nothing whatsoever to do with case arrangement—that is, with how cases are arranged in the original report or, for that matter, the subsequent report containing the star pagination.” *Id.* Star pagination, in this view, reflects nothing more than simple facts. See *id.*

The court expressed serious doubts concerning West's position on the star pagination issue.¹⁵⁶ According to the court, the main flaw with West's argument was that the page number on which a court opinion appears is a fact.¹⁵⁷ Because facts themselves can never be protected by copyright, the page numbers are free for anyone to copy.¹⁵⁸

Although West admitted that a page number is a fact, it attempted to distinguish between preexisting facts that exist independent of the compilation and facts that are the result of the creation of the compilation.¹⁵⁹ West contended that the page numbers of reporters result from the creation of the compilation.¹⁶⁰ Therefore, West's copyright protected the page numbers.¹⁶¹

Despite West's arguments, the court refused to distinguish between preexisting facts and facts that were the result of West's compilation.¹⁶² Instead, the court ruled that page numbers were facts that were not protected by copyright.¹⁶³ Next, the court rejected West's argument that its

156. *See Bender*, 41 U.S.P.Q.2d at 1321 ("But it seems to me . . . that the title and the citation to a West reported decision are facts, facts that anybody is free to use.").

157. *See id.* According to the court, page numbers were not the result of West's creative activity. *See id.* The court noted that West's selection of cases or its headnotes were parts of the compilation that were original creations, page numbers, however, did not meet the required standard. *See id.* at 1329-30. In the court's view, all that West did was decide how to compile the cases. *See id.* at 1321. The page numbers were the accidental consequence of that decision. *See id.* at 1321-22. From this reasoning, the court concluded that the page number of a case was merely a fact and not protected by copyright. *See id.* at 1322.

158. *See id.* at 1329-30 (holding that page numbers are facts that can not be protected by copyright and therefore can be copied at will).

159. *See id.* at 1322 (arguing that page numbers, while facts, should still be protected by copyright). To illustrate its point, West used the example of an address and phone number. *See id.* A person's address and phone number exists regardless of whether they are ever compiled into a telephone directory. *See id.* On the other hand, according to West, a slip opinion issued by a court would "not have a volume number, West Reporter publication name and page number independent of the compilation and creation of an arrangement by West . . ." *Id.* West claimed that because the "facts" here are the result of the creation of an arrangement, they should be protected by copyright. *Cf. id.* (distinguishing between preexisting facts and facts that are dependent on compilation).

160. *See id.* (arguing that page numbers were facts that would not exist independent of West's creation).

161. *See id.* (claiming that any publisher that copies arrangement is copying protectable interest). In making this argument, West was trying to distinguish its case from *Feist*. *See id.* ("[Y]ou cannot rely on the defense that these are facts because they are not the kind of preexisting facts dealt with by the Supreme Court in *Feist*.").

162. *See generally id.* at 1321. The court did not specifically address West's argument on this point. *See generally id.* Rather, the court took the position early in the proceedings that a page number was a fact, making no distinction between preexisting facts and facts that were the result of West's creation. *See generally id.* The court did not waiver from this position. *See generally id.* at 1321-22.

163. *See id.* at 1329 (reiterating that facts set forth in compilation are not protected by copyright).

page numbers were part of a compilation and an essential part of its arrangement.¹⁶⁴ The court viewed page numbers as an “accident,” a mere consequence of the way that a reporter is compiled.¹⁶⁵ The court stated that the case might be different had Bender or HyperLaw copied West’s arrangement in its entirety, but that was not the situation in this case.¹⁶⁶ Thus, the court granted both plaintiffs’ motions for summary judgment on the star pagination issue.¹⁶⁷

2. *The Text of Opinions*

At trial, West argued that it had a protectable interest in its compilations and that copying West’s cases was an infringement of its copyright.¹⁶⁸

164. *See id.* (stating copyright protection extends to aspects of compilation that embody original creation of compiler). In rejecting West’s argument, the court stated that a page number is not part of West’s original contribution. *See id.* at 1322 (commenting that page number “is a consequence of the way the compilation is put together, but it is not any part of the aspect of compilation that embody the original creation of the compiler”); *see also* Patterson & Joyce, *supra* note 24, at 758 n.137 (arguing star pagination of judicial reports has nothing to do with arrangement of cases). The court went even further in minimizing West’s role in creating page numbers, referring to them as completely accidental. *See Bender*, 41 U.S.P.Q.2d at 1322 (concluding that page numbers were mere “accident[s] as to the page upon which a particular portion of text falls”).

This view is in direct contrast with the Eighth Circuit’s decision in *Mead* and the district court’s holding in *Oasis*. For a discussion of both *Mead* and *Oasis*, see *supra* notes 97-118 and accompanying text.

165. *See Bender*, 41 U.S.P.Q.2d at 1322 (“[T]he essence of the protectable compilation has nothing to do with the accident as to the page upon which a particular portion of text falls.”).

166. *See id.* at 1323 (explaining that Bender and HyperLaw were not copying West’s arrangement in its entirety). As far as the court was concerned, the plaintiffs were simply making references to specific cites within one of West’s reporters and were not copying West’s work product. *See id.* The court then distinguished this situation from a clear example of infringement. *See id.* If the plaintiffs were just taking one of West’s volumes and putting it in CD-ROM format, that would be a clear case of infringement because that would be copying West’s skill and originality. *See id.* (stating that Bender’s product contained some cases that are reported by West and others that are not).

167. *See id.* at 1330 (“[W]here and on what particular pages the text of a court opinion appears does not embody any original creation of the compiler, and, therefore . . . is not entitled to protection.”). In addition, it is apparent that both the United States Constitution and West’s “monopoly” of the legal publishing market played some part in the court’s decisionmaking process. *See id.* at 1325, 1329 (mentioning Article 1, § 8 of Constitution and West’s attempt to monopolize reported decisions). The court stated that “[w]hat West is attempting to do by trying to inhibit star pagination is to create a monopoly over reported court decisions.” *See id.* at 1329.

168. *See generally* Transcript, Jan. 27-28, 1997 Trial, at 5-6 *Matthew Bender & Co. v. West Publ’g Co.*, No. 94 CIV. 0589, 1997 WL 266972 (S.D.N.Y. May 19, 1997), *available at* <<http://www.hyperlaw.com/trialtr.htm>> (arguing that West’s compilations were entitled to copyright protection). West argued that a court’s decisions, published in one of West’s reporters with West’s “enhancements,” were compilations. *See id.* at 6. West further claimed that as compilations, West did not have to add anything substantial to a judicial opinion for the compilation to be

HyperLaw took the position that West's work on each individual opinion must be judged by the standard of copyrightability applied to derivative works, not compilations.¹⁶⁹

The court quickly ended the argument by suggesting that this was not a compilation case.¹⁷⁰ In the court's view, the compilation argument was only appropriate as to the star pagination issue.¹⁷¹ The court held that to determine whether HyperLaw could scan cases directly from West's reporters, the derivative works standard should be applied.¹⁷² Once the

copyrightable. *See id.* at 8. According to West, the test for copyrightability in such a case is not whether it had made a substantial contribution to the opinion but rather "whether or not there is any modicum, humble, crude, obvious, slight, minimal creativity or judgment and it is beyond per adventure . . ." *Id.* Under this standard, West believed that the text of an opinion should be protected by copyright. *See id.* (stating belief that West's changes met modicum of creativity standard).

169. *See* Matthew Bender & Co. v. West Publ'g Co., No. 94 CIV. 0589, 1997 WL 266972, at *1 (S.D.N.Y. May 19, 1997) (stating HyperLaw's argument that court should apply standards applicable to derivative works). HyperLaw contended that they were not copying the order or arrangement of West's cases. *See id.* Rather, HyperLaw argued that they were simply copying individual opinions and "the extent of West's protectible interest in any single opinion must be determined under the standards that apply to derivative works." *Id.*

170. *See* Transcript, Jan. 27-28, 1997 Trial, at 6, *Bender*, 1997 WL 266972, available at <<http://www.hyperlaw.com/trialtr.htm>>.

171. *See id.* (explaining why compilation argument was proper in star pagination case). West was adamant in its position that this was a compilation case. *See id.* West had hoped that the court would apply the compilation standard because it could then claim a copyright in the selection and arrangement of its cases. *Cf.* NIMMER & NIMMER, *supra* note 52, § 3.02, at 3-5 (discussing differences between compilations and derivative works). For a detailed discussion of compilations and derivative works, see *supra* notes 55-67 and accompanying text.

For the purposes of West's chances of winning the case, the difference between the two is enormous. *See generally* Thomas Scheffey, *A Tilting of the Tables*, CONN. LAW TRIBUNE, Feb. 3, 1997, available in LEXIS, News Library, Clt File (stating "there is a world of difference" between compilations and derivative works). A compilation can be copyrightable based solely on its selection and arrangement, without any internal changes. *See* NIMMER & NIMMER, *supra* note 52, § 3.02, at 3-5 (describing creation of copyrightable compilation). On the other hand, a derivative work must recast or transform the original work to such an extent as to qualify as an "original work of authorship." *See* 17 U.S.C. § 101 (1994) (defining derivative work). Once the court determined that the derivative works standard applied, West had the more difficult task of proving that the changes it makes to each individual case (e.g., corrections, adding attorneys names and parallel citations) qualified as an original work of authorship. *See Bender*, 1997 WL 266972, at *2 ("[T]he question presented is whether each reported decision found in the West reports is an original work of West authorship.").

172. *See Bender*, 1997 WL 266972, at *1-*2 (deciding to apply standards applicable to derivative works). At trial, the court gave a detailed description of why this was not a compilation case. *See generally* Transcript, Jan. 27-28, 1997 Trial, at 309-11, *Bender*, 1997 WL 266972, available at <<http://www.hyperlaw.com/trialtr.htm>> (discussing reasons why this case involves derivative works, not compilations). The court stated that HyperLaw would not be copying one entire volume in CD-ROM format, rather it would be copying a case from that volume, which had previously been cited by any case that HyperLaw included in its product. *See id.* at 310. The

court determined that HyperLaw merely copied individual cases from West's reporters and not West's arrangement, the number of cases that HyperLaw copied became irrelevant because each individual case must meet the originality standard to be protected by copyright.¹⁷³

West then argued that the changes it made to each case, for example adding parallel citations, providing attorneys' names, making corrections and implementing other modifications with respect to subsequent opinions, were enough to make the reported decision independently copyrightable.¹⁷⁴ HyperLaw, however, stressed that copyright law and the United States Constitution require that the changes made by West possess a certain degree of originality in order to be copyrightable and the changes that West made to each case did not meet this requirement.¹⁷⁵

In the court's view, West's argument was flawed because West attempted to look at each individual change and argue that it substantially changed a particular portion of the decision.¹⁷⁶ For example, the court

end result might be that HyperLaw copied every case of a particular volume, however, the court felt that it was still simply copying individual cases. *See id.*

173. *See Bender*, 1997 WL 266972, at *2 (stating that changes made must be significant enough to qualify each reprint as independently copyrightable). "What Hyperlaw [sic] is copying is the individual reported decision and the fact that it copies one, two or a thousand decisions does not change the fact that it is the decisions and not West's compilation of those decisions that Hyperlaw is copying." *Id.* One important effect of this reasoning was that the scope of the case widened significantly. *See Scheffey, supra* note 171, at 1 (commenting scope of case grew from "bid to copy just 1 percent to 2 percent of West federal cases into 'wholesale copying' of tens of thousands of those decisions").

174. *See generally Bender*, 1997 WL 266972, at *2-*4 (discussing changes West makes to individual decisions). For a discussion of each change examined by the court, see *infra* notes 176-96 and accompanying text.

175. *See HyperLaw's Motion for Summary Judgment*, at 15-17, *Bender*, 1997 WL 266972, available at <<http://www.hyperlaw.com/hlsjfil.htm>> (arguing that West's changes are minor and trivial variations). Relying on *L. Batlin*, HyperLaw argued that West uses "minuscule variations to original court text to appropriate and monopolize public domain works." *Id.* at 17. HyperLaw also noted that no matter how many changes West made to the text, the number was irrelevant if each change was trivial. *See id.* at 18 ("[E]ven if a court were to find that some minimal originality exists with regard to such changes—it must be more than a quantum of originality."). Another problem with West's argument was that its changes, such as changing "a short form citation to full form, 'prescribed' to 'proscribed', 'Consul' to 'Consaul', 'Labor-Management' to 'Labor Management' (deleting the hyphen), 'McGuiness' to 'MacGuineas', and 'NMF Hosp.' to 'NME Hosp.'," were imperceptible to the reader and driven primarily by a functional purpose, therefore not protected by copyright. *See id.* at 19-20. Finally, HyperLaw added that West's claim is further hampered by the "insurmountable obstacle that almost all of the changes it makes to judicial opinions are facts." HyperLaw, Inc.'s Post-Trial Brief-in-Chief-Challenge to West Text Copyright Claims at 24-25, *Bender*, 1997 WL 266972, at *1.

176. *See Bender*, 1997 WL 266972, at *2 (explaining court's perception of West's argument). The court gave an example of the problem with West's argument: "West argues that it makes a substantial change to the cases cited in an opinion when it adds a parallel citation. Even if this were a substantial change to that citation, it is still a trivial change to the court's opinion." *Id.*

examined West's argument with regard to parallel citations.¹⁷⁷ While it is arguable that adding a parallel cite substantially changed the citation, overall it is a trivial change to the reported decision.¹⁷⁸ Instead, the court stated that in order to determine whether an individual opinion was entitled to copyright protection, it was "necessary to look at the significance of each individual change only for the purpose of determining whether the totality of the changes made by West can be said to constitute 'an original work of authorship.'"¹⁷⁹ Therefore, the court examined each of the changes West claimed to make in order to determine if the changes, in totality, constituted an original work.¹⁸⁰

The court first examined West's changes to case titles.¹⁸¹ In its analysis, the court stated that case names were facts and that West's changes did not vary to any significant extent from the universal rules of citation used throughout the legal community.¹⁸² Thus, the court concluded that the changes West made to case titles did not involve "creative activity."¹⁸³

Next, the court examined West's additions of the docket number and the date argued and decided.¹⁸⁴ The court quickly dismissed these addi-

177. *See id.* (examining West's argument regarding parallel citations).

178. *See id.* (deciding that adding parallel citation, while possibly substantial change to that citation, was trivial change to court's opinion as whole). According to the court, West had taken the wrong approach. *See id.* (rejecting West's analysis). Instead of looking at each change to each particular piece of information, the correct analysis would be to look at the changes in respect to the entire reported decision. *See id.* To determine whether an opinion was entitled to copyright protection, the court ruled that it had to examine the totality of the changes made by West to determine whether West's version of the opinion was an original work of authorship. *See id.*

179. *Id.*

180. *See generally id.* at *3-*4 (examining individual changes made by West for purpose of determining whether work as whole is original).

181. *See id.* at *3 (examining and explaining changes West makes in title of cases). Basically West capitalizes the names, or portions of the names, used in citing the case. *See id.* Also, West abbreviates portions of parties' names, "sometimes combine[s] captions when two or more cases are reported together and make[s] other minor changes to ensure that a consistent form is used in all reported decisions." *Id.*

182. *See id.* (critiquing changes West makes to case names). The court acknowledged some differences between West's changes and Bluebook rules, but it remarked that those differences were little more than trivial. *See id.* (stating that "the differences do not appear to be of major significance").

183. *See id.* (stating that changes in title are simply mechanical application of preexisting rules of citation).

184. *See id.* (discussing West's addition of docket numbers and dates). At trial, a West employee testified that West got the docket number from the slip copy issued by the court. *See* Transcript, Jan. 27-28, 1997 Trial, at 23, *Bender*, 1997 WL 266972, available at <<http://www.hyperlaw.com/trialtr.htm>>. West inserts "No.," rearranges the docket number according to West's style and puts a period at the end. *See id.* There was also testimony regarding the addition of and changes to dates made by West. *See id.* at 24. Besides making the initial decision to publish both the "argued" and "decided" dates, West also puts the dates in West's style and format. *See id.*

tions as “raw facts [that] may be copied at will.”¹⁸⁵ Despite West’s efforts in obtaining this information, there was nothing in the expression of these facts that entitled it to copyright protection.¹⁸⁶ Next, the court addressed West’s claims that it had a protectable interest in the publication of attorneys’ names.¹⁸⁷ The court reasoned that although West exerts some time and energy when collecting the names and makes an editorial decision as to which names to publish, the names “are facts which West cannot copyright.”¹⁸⁸

The court also reviewed the changes West made to the text of the opinions.¹⁸⁹ West made two types of changes to the text: corrections and additions.¹⁹⁰ West proofread each case and checked the form and substance of each cite.¹⁹¹ Occasionally, West would contact the court to determine if there was an error in an opinion.¹⁹² Again, the court ruled that despite West’s considerable effort, these corrections were not evidence of creativity or originality.¹⁹³

185. *Bender*, 1997 WL 266972, at *3 (quoting *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 350 (1991)). “These are clearly facts and even though West must make some effort to obtain some of this information, there is nothing so original about West’s expression of these facts that would entitle them to copyright protection.” *Id.* (citing *Feist*, 499 U.S. at 349). As facts, it was “neither unfair or [sic] unfortunate” that HyperLaw copied them, “[i]t is the means by which copyright advances the progress of science and art.” *Id.* (quoting *Feist*, 499 U.S. at 349).

186. *See id.* (deciding docket number and date were not protected by copyright).

187. *See generally id.* (discussing copyrightability of names of attorneys). West’s treatment of names is similar to its treatment of dates and docket numbers. *See generally* Transcript, Jan. 27-28 Trial, at 16, *Bender*, 1997 WL 266972, available at <<http://www.hyperlaw.com/trialtr.htm>> (discussing West’s treatment of attorneys’ names). West obtains the name of the attorney from the court’s docket sheet and merges the name with West’s case report. *See id.* West also adds the city and state in which the attorney practices; it obtains this information from West’s Legal Directory or Bar Association journals. *See id.* at 19.

188. *Bender*, 1997 WL 266972, at *3 (citing *Feist*, 499 U.S. at 360).

189. *See id.* at *4 (addressing textual changes made by West).

190. *See id.* (explaining West’s changes to text of court’s opinion).

191. *See id.* (discussing West’s procedure when proofreading court opinions that it includes in reporter). West hires a number of editors and cite checkers; when proofreading, these employees check for, and correct, any spelling errors and any mistakes in the form or substance of a citation. *See id.*

192. *See id.* (stating West may contact courts to check on possible corrections); *see also* Transcript, Jan. 27-28 Trial, at 34-35, *Bender*, 1997 WL 266972, available at <<http://www.hyperlaw.com/trialtr.htm>> (discussing instances in which West does and does not contact court to check possible corrections).

193. *See Bender*, 1997 WL 266972, at *4 (“While West clearly expends considerable time and money on this effort and performs a valuable service to the bench and the bar, there is no element of creativity or originality involved in these corrections.”).

Lastly, the court noted two different types of additions made by West: filling in the blanks and parallel citations.¹⁹⁴ In each case, West performed mechanical searches and added nothing more than facts to the case.¹⁹⁵ Therefore, neither type of addition reached the level of creativity needed to invoke copyright protection.¹⁹⁶

After undergoing this analysis, the court concluded that the changes West makes to reported opinions are trivial and, "taken separately or collectively, they do not result in 'a distinguishable variation' of the opinion written by the court."¹⁹⁷ Accordingly, the court held that HyperLaw did not, and would not, violate West's copyrights by copying opinions from West's reporters.¹⁹⁸

B. Critical Analysis

The district court's decision in *Bender*, concerning both star pagination and the text of opinions, is correct.¹⁹⁹ The court's decision is the most reasonable conclusion in light of the facts of the case and relevant

194. See *id.* (discussing how West filled in blanks and added parallel citations); see also Transcript, Jan. 27-28 Trial, at 31, *Bender*, 1997 WL 266972, available at <<http://www.hyperlaw.com/trialtr.htm>> (same). The process of filling in the blanks involves "a reference back to a portion of the same opinion or a blank left in a citation." *Bender*, 1997 WL 266972, at *4. According to the court, any search conducted by West when they attempt to fill in the blanks is a mechanical exercise that does not involve creativity. See *id.* (stating that filling in blanks is "[a] mechanical search for and addition of facts").

West adds the parallel citations that it believes are necessary for readers to use the National Reporter System. See Transcript, *supra* note 149, at 31 (discussing West's choice of parallel citations). West obtains its parallel cites from either West's library or its Insta-Cite system. See *id.* (explaining where West finds its parallel citations). "[T]he selections made tend to conform to the standard of the legal profession and appear consistent with those recommended in [The Bluebook] A Uniform System of Citation." *Bender*, 1997 WL 266972, at *4.

195. See *Bender*, 1997 WL 266972, at *4 (discussing filling in of blanks and parallel citations). The court viewed the addition of parallel citations as "[t]he most significant additions that West makes to the opinions." *Id.* Despite the significance that the court attached to this addition, parallel citations were still not considered original. See *id.* (holding that parallel citations "reflect no level of originality").

196. See *id.* (ruling that additions made by West are basically mechanical and do not represent sufficient originality to invoke copyright protection).

197. *Id.* (citing *Waldman Publ'g Corp. v. Landell, Inc.*, 43 F.3d 775, 782 (2d Cir. 1994)).

198. See *id.* at *5 (holding HyperLaw's copying of West's reports does not violate West's copyright).

199. For a narrative analysis of the court's decision in *Bender*, see *supra* notes 146-98 and accompanying text. Although other courts have reached the opposite conclusion on similar facts, the court in *Bender* has the more persuasive analysis in light of the relevant background. But see *West Publ'g Co. v. Mead Data Central, Inc.*, 799 F.2d 1219, 1227 (8th Cir. 1986) (holding that page numbers of West's reporters were protected by copyright); *Oasis Publ'g Co. v. West Publ'g Co.*, 924 F. Supp. 918, 923-24 (D. Minn. 1996) (same). For a further discussion of the contrary rulings in *Mead* and *Oasis*, see *supra* notes 97-118 and accompanying text.

background, including the Constitution's purpose in providing copyright protection, relevant case law and the Copyright Act of 1976.²⁰⁰

1. *Star Pagination*

In *Bender*, the court ruled that West did not have a protectable interest in the page numbers of its reporters.²⁰¹ The decision directly conflicts with two earlier decisions in other courts.²⁰² Nevertheless, the court's ruling in *Bender* is rational in light of the relevant background.²⁰³ The decision is clearly supported by the Constitution's goal of promoting learning, the Supreme Court's holding in *Wheaton* and the Second Circuit's holding in *Lawyers' Co-operative*.²⁰⁴ Moreover, the appropriateness of the court's holding is evident when compared with the *Oasis* holding.²⁰⁵

The Constitution's justification for granting Congress the power to enact copyright legislation is to promote learning or, as the Constitution states, to promote the "Progress of Science."²⁰⁶ This goal is the "premier doctrine of copyright law."²⁰⁷ To further the goal, copyright law must limit an author's monopoly because a monopoly impedes learning.²⁰⁸ While it is true that the Constitution also secures an author's "exclusive Right" to his or her work, that right is solely for the purpose of encouraging the creation of new works, thereby promoting learning.²⁰⁹

200. For a discussion of the facts of the case, see *supra* notes 119-45 and accompanying text. For a discussion of the Constitution and copyright law, see *supra* notes 23-27 and accompanying text. For a discussion of relevant case law, see *supra* notes 28-42 and accompanying text. For a discussion of the Copyright Act of 1976, see *supra* notes 43-67 and accompanying text.

201. See *Matthew Bender & Co. v. West Publ'g Co.*, 41 U.S.P.Q.2d 1321, 1330 (S.D.N.Y. 1996) (holding page numbers are not embodiment of original creation and therefore not protected by copyright).

202. Compare *id.*, with *Mead*, 799 F.2d at 1227 (holding that page numbers of West's reporters were protected by copyright), and *Oasis*, 924 F. Supp. at 923-24 (same).

203. Cf. *Dahl*, *supra* note 68, at 714 (arguing that *Mead* abandoned years of precedent in holding that West's pagination was protectable); *Wyman*, *supra* note 5, at 244-45 ("The *Mead* holding is thus at odds with the current thought underlying *Wheaton* and its progeny.").

204. For a discussion of the Constitution's goal of enhancing the public domain through copyright, see *supra* notes 23-26 and accompanying text. For a discussion of the Supreme Court's holding in *Wheaton*, see *supra* notes 28-34 and accompanying text. For a discussion of the Second Circuit's holding in *Lawyers' Co-operative*, see *supra* notes 35-42 and accompanying text.

205. For a discussion of the facts of *Bender*, see *supra* notes 119-45 and accompanying text. For a discussion of *Oasis*, see *supra* notes 113-18 and accompanying text.

206. See *Patterson & Joyce*, *supra* note 24, at 783 (discussing constitutional imperative of promoting learning).

207. *Id.*

208. See *id.* at 786 (arguing that monopoly must be limited because monopoly is antithetical to learning).

209. See *id.* at 787 (explaining that purpose of granting "exclusive Right" was to promote learning by encouraging new works); see also *Harper & Row, Publish-*

The *Bender* court's decision to deny copyright protection to page numbers is correct because it furthers the Constitution's goal of promoting learning.²¹⁰ A decision that would subject page numbers to copyright protection has two potential effects: (1) impeding access to the law by restricting the development of new technologies, such as *Bender's* and *HyperLaw's* CD-ROM products, or (2) allowing West to impose a tax in the form of licensing fees on rival publishers.²¹¹ Both results would inhibit the progress of science and therefore, decisions such as *Mead* and *Oasis*, where the court protected page numbers, would actually be at odds with the Copyright Clause of the Constitution.²¹² Thus, the *Bender* court's decision is consistent with constitutional principles.²¹³

Similarly, the *Bender* decision is consistent with the policy established by the Supreme Court in *Wheaton*.²¹⁴ In *Wheaton*, the Court established that the public should have "maximum, unimpeded access to the law."²¹⁵

ers, Inc. v. Nation Enters., 471 U.S. 539, 546 (1985) ("The monopoly power created by copyright . . . rewards the individual author in order to benefit the public." (quoting *Sony Corp. v. Universal City Studios, Inc.*, 464 U.S. 417, 477 (1984))).

210. *Cf.* *Patterson & Joyce*, *supra* note 24, at 810 (stating that protecting page numbers in no way "Promote[s] the Progress of Science").

211. *See id.* (explaining how protecting page numbers inhibits legal science). Protecting page numbers produces one of two results:

[E]ither it impedes more efficient access to the law by restricting the use of competitors' developing technologies, as occurred prior to the settlement in [*Mead*]; or it in effect imposes a tax for the use of the law, preventing effective price competition by sanctioning the imposition of license fees on the publisher's rivals.

Id.

212. *Cf. id.* (arguing that "protecting page . . . numbers in legal materials . . . in no way 'Promote[s] the Progress of Science'"). The decision in *Bender* is also consistent with the other constitutional goals. For a discussion of the other constitutional goals, see *supra* notes 24-26 and accompanying text. By not protecting page numbers, the court did not violate the Constitution's goal of granting an author exclusive rights to his or her work because "cases and statutes are not the products of authorship; and, without authorship, there is no right to profit from copyright protection." *Patterson & Joyce*, *supra* note 24, at 810. The elements of reporters, which West claims are protected by copyright, are discretionary and therefore original expression is lacking. *See id.* (explaining why West is not an author). "As to such features, the publisher is a publisher rather than an author, and not entitled to the protection of a copyright monopoly." *Id.* Finally, the goal of enhancing the public domain is furthered by the *Bender* decision. *Cf. id.* at 810-11 (explaining that, unlike *Bender*, *Mead* inhibited access to public domain materials). By denying protection to page numbers, the court has paved the way for greater development in the area of computer assisted access to the law, thereby enhancing the public domain. *Cf. id.* (criticizing *Mead* for inhibiting access to public domain materials through computer technology).

213. *Cf. id.* at 811 (arguing that *Mead* decision failed to "ensure the fulfillment of the three doctrinal imperatives [of the Constitution]").

214. *See generally* *Wyman*, *supra* note 5, at 244-45 (discussing policy established by *Wheaton* and its progeny). For a further discussion of *Wheaton*, see *supra* notes 28-34 and accompanying text.

215. *See* *Wyman*, *supra* note 5, at 244 ("The public policy . . . [*Wheaton*] furthers is one of maximum, unimpeded access to the law."); *see also* *Patterson &*

The *Bender* court clearly followed this policy by denying copyright protection to West's page numbers.²¹⁶ On the other hand, the *Mead* and *Oasis* decisions were clearly contrary to this policy because those decisions potentially prevented many legal publishers from entering the market.²¹⁷ In *Bender*, however, the court opened the door for legal publishers, such as Bender and HyperLaw, to develop products that contain judicial opinions, creating new sources of judicial materials at lower costs, and thereby providing the public with "maximum, unimpeded access to the law."²¹⁸

Finally, the *Bender* court followed the precedent established by the Second Circuit in *Lawyers' Co-operative*.²¹⁹ In *Lawyers' Co-operative*, the Second Circuit declined to rule that the mere use of page numbers constituted copyright infringement.²²⁰ Instead, the court concluded that page numbers of a reporter "are, as a matter of public policy, insufficient intel-

Joyce, *supra* note 24, at 742 (claiming that bedrock policy of *Wheaton* is that people should have maximum access to law).

216. See, e.g., Thomas Scheffey, *West Ruling's Effects Seen as Far-Reaching; Company Can't Stop Rivals from Copying Cases from Its Books*, FULTON COUNTY DAILY REP., May 30, 1997, available in LEXIS, News Library, Fulton File ("[The *Bender* decision] releases West's stranglehold on primary law materials . . . and will allow publishers on CD-ROM or the Web to connect cases and statutes in whatever way proves most useful to lawyers and the public.").

217. Cf. Wyman, *supra* note 5, at 245-46 (explaining how *Mead* has impeded public's access to law). The courts in both *Mead* and *Oasis* seemed more concerned with the potential effect on West's standing in the legal publishing market than public policy concerns. See *id.* at 252. "[B]oth *Oasis* and *Mead* eschewed any public policy analysis and found that the mere possibility of market harm to West was sufficient to warrant extending copyright protection to West's pagination." *Id.*

218. See *id.* at 245. As a result of *Mead* and *Oasis*, West maintained its control over published court opinions, and other legal publishers were effectively eliminated from competing in the market. Cf. *id.* at 245-46 (noting that extension of copyright protection to page numbers, in *Mead* and *Oasis*, essentially retarded legal "science"). The reason for this result is that potential legal publishers were left with three choices: 1) use West's page numbers without West's permission and face a lawsuit; 2) enter into a licensing agreement with West for the use of its page numbers; or 3) refrain from publishing the law. Cf. *id.* Many publishers could not afford either of the first two options so they refrained from legal publishing, so that West "exert[ed] a quasi-monopolistic control over access to the law [and] . . . [t]o a great degree, then, legal science end[ed] up being held hostage . . ." *Id.* at 246.

219. See *Banks Law Publ'g Co. v. Lawyers' Co-operative Publ'g Co.*, 169 F. 386, 391 (2d Cir. 1909) (per curiam) (holding that page numbers of reporters were not protected by copyright).

220. See Wyman, *supra* note 5, at 244 (stating that Second Circuit had opportunity to protect page numbers but declined to do so). The Court in *Callaghan* also had this opportunity and, like the court in *Lawyers' Co-operative*, declined to do so. See *id.* The Court in *Callaghan* found that a case reporter as a whole was entitled to copyright protection. See generally *Callaghan v. Myers*, 128 U.S. 617, 662 (1888) (holding case reporter was entitled to copyright protection). It did so, however, in the context of a case in which an entire reporter, including headnotes and arguments of counsel, were copied. See *id.* at 659. On the other hand, *Lawyers' Co-operative* dealt directly with page numbers and arrangement, and directly denied protection to such details. See *Lawyers' Co-operative*, 169 F. at 390 (holding that page numbers did not warrant copyright protection). Therefore, the *Mead* court's reli-

lectual labor to warrant copyright protection.”²²¹ While the court in *Bender* did not specifically mention *Lawyers’ Co-operative*, it followed the same reasoning by concluding that protectable expression “has nothing to do with the accident as to the page upon which a particular portion of text falls.”²²²

2. *The Text of Opinions*

Based on the facts of this case, the decision to deny copyright protection to opinions published by West is appropriate in light of the Copyright Act of 1976 and is consistent with relevant case law on the subject.²²³ A careful reading of the 1976 Act shows that the court’s decision to apply the standard for derivative works to the text of opinions was correct.²²⁴

Individual cases in West’s reporters should be treated as derivative works under the 1976 Act.²²⁵ Compilations are formed by the collection of preexisting materials and are afforded copyright protection only to the extent that the selection, coordination and arrangement of that material constitutes an original work of authorship.²²⁶ In contrast, a derivative work simply recasts or transforms an original work.²²⁷

ance on *Callaghan* was misplaced. For a further discussion of this conclusion, see *supra* notes 104-05.

221. Wyman, *supra* note 5, at 227 (citing *Lawyers’ Co-operative*, 169 F. at 390). The district court in *Lawyers’ Co-operative* concluded that “for another to simply adopt the plan of groupings of the cases, making marginal references to the paging of the volumes . . . without in any way pirating the substance of his [or her] origination, is not enough . . . to establish infringement.” *Lawyers’ Co-operative*, 169 F. at 387. The Second Circuit agreed with the decision and adopted the district court’s opinion, reiterating that page numbers are not entitled to copyright protection. *See id.* at 391.

222. *Matthew Bender & Co. v. West Publ’g Co.*, 41 U.S.P.Q.2d 1321, 1322 (S.D.N.Y. 1996). *Compare Bender*, 41 U.S.P.Q.2d at 1330 (holding that page numbers of reporters were not copyrightable), with *Lawyers’ Co-operative*, 169 F. at 390 (concluding that copying page numbers without copying substance of original material was not enough to establish infringement of copyright). The court in *Bender*, as in *Lawyers Co-operative*, also ruled that pagination could not be protected by copyright because “where and on what particular pages the text of a court opinion appears does not embody any original creation of the compiler, and therefore . . . is not entitled to protection.” *Id.* at 1330.

223. For a further discussion of the 1976 Act, see *supra* notes 43-96 and accompanying text. For a further discussion of the relevant case law, see *supra* notes 28-42.

224. For a further discussion of the 1976 Act, see *supra* notes 43-96 and accompanying text.

225. For a further discussion of the 1976 Act, see *supra* notes 43-96 and accompanying text. For a detailed discussion of the meaning of derivative works, see *supra* notes 61-67 and accompanying text.

226. *See* 17 U.S.C. § 103(a) (1994) (defining compilation and explaining requirements for copyright of compilation). For further explanation of compilations, see *supra* notes 55-60 and accompanying text.

227. *See id.* § 101 (defining derivative work).

To violate the copyright of a compilation, a party would have to copy the selection, coordination or arrangement of the compilation.²²⁸ In *Bender*, HyperLaw did not copy West's selection, coordination or arrangement of cases.²²⁹ HyperLaw only copied individual reported decisions.²³⁰ Even if HyperLaw were to copy every case in one of West's reporters, as long as it did not copy the arrangement of those cases, the derivative works standard would apply.²³¹ Therefore, the court was correct in concluding that each case should be judged by the standards that apply to derivative works.²³²

After making this decision, the court determined that the changes West made to its reported decisions do not represent a sufficiently creative effort to warrant copyright protection.²³³ To determine whether these changes were creative, the court conducted a methodical examination of each change West made to the text of the opinions.²³⁴ The court concluded that the changes did not result in a distinguishable variation.²³⁵ The court reached this conclusion through proper use of the relevant cases dealing with creativity.²³⁶

228. *Cf.* *Matthew Bender & Co. v. West Publ'g Co.*, 41 U.S.P.Q.2d 1321, 1329 (S.D.N.Y. 1996) (stating copyright protection for compilations extends only to those aspects that embody creation of compiler, i.e., selection, coordination or arrangement).

229. *See* *Matthew Bender & Co. v. West Publ'g Co.*, No. 94 CIV. 0589, 1997 WL 266972, at *2 (S.D.N.Y. May 19, 1997) (stating that HyperLaw was not copying West's arrangement of cases); *see also* Transcript, Jan. 27-28 Trial, at 309-11, *Bender*, 1997 WL 266972, available at <<http://www.hyperlaw.com/trialtr.htm>> (discussing why this is not compilation case). For a further discussion of the court's reasoning in determining that this was not a compilation case, *see supra* notes 169-72 and accompanying text.

230. *See Bender*, 1997 WL 266972, at *2 (stating that HyperLaw copied individual decisions); *see also* Transcript, Jan. 27-28 Trial, at 309-11, *Bender*, 1997 WL 266972, available at <<http://www.hyperlaw.com/trialtr.htm>> (discussing HyperLaw's copying of individual cases).

231. *See Bender*, 1997 WL 266972, at *2 (concluding that number of cases copied by HyperLaw does not transform this situation into compilation case).

232. *See id.* (concluding "that the correct analysis is that which applies to derivative works").

233. *See id.* (ruling that changes West makes to opinions do not make decisions copyrightable).

234. *See id.* at *2-*3 (discussing each of West's changes). Before beginning its analysis, the court stated that "it is necessary to look at the significance of each individual change . . . for the purpose of determining whether the totality of the changes made by West can be said to constitute 'an original work of authorship.'" *Id.* at *2.

235. *See id.* at *4 ("In sum, each of the changes that West makes to the cases it reports are trivial and . . . do not result in 'a distinguishable variation' of the opinion written by the court.") (citing *Waldman Publ'g Corp. v. Landoll, Inc.*, 43 F.3d 775, 782 (2d Cir. 1994)).

236. *See, e.g.,* *L. Batlin & Son, Inc. v. Snyder*, 536 F.2d 486, 491 (2d Cir. 1976) (holding that substantial variation is necessary to support copyright for derivative work). For a discussion of the relevant cases dealing with creativity, *see supra* notes 68-96 and accompanying text.

The court quickly dismissed as immaterial the time and money West spends in making changes to opinions.²³⁷ The court conceded that West potentially made many changes to the text of an individual opinion, but the mere number is irrelevant.²³⁸ Thus, the court correctly focused on the nature of West's changes, not the number of changes made.²³⁹

After examining the nature of the changes, the court determined that West's additions of attorneys' names, docket numbers and date argued and decided are facts which are not protected by copyright law.²⁴⁰ It is a well-established rule that facts are not copyrightable.²⁴¹ The court correctly applied the rule in this case because the additions are facts, not substantive changes.²⁴² Even West admitted that attorneys' names and docket numbers either appear on the slip opinions or can be obtained by anyone with little effort.²⁴³ Although West also added parallel citations and made changes to the titles of the cases, these changes involve a mechanical application of the universal rules of citation.²⁴⁴ Such a mechanical procedure does not involve sufficient creativity to qualify for copyright protection.²⁴⁵ In addition, while West's process of proofreading and correcting each case is time consuming, it is not creative.²⁴⁶ Also,

237. See *Bender*, 1997 WL 266972, at *3 (discussing time and money expended by West in making some changes). Instead of focusing on time and money spent by West, the court concentrated on the constitutionally mandated element of creativity. See *id.* Here, the court correctly applied the guidelines established by the Supreme Court in *Feist*, when it rejected the "sweat of the brow" approach to originality. See generally *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 359-60 (1991) (rejecting "sweat of the brow" doctrine).

238. Cf. *Grove Press, Inc. v. Collectors Publication, Inc.*, 264 F. Supp. 603, 606 (C.D. Cal. 1967) (denying copyright protection of work containing 40,000 trivial changes). For a further discussion of *Grove Press*, see *supra* note 94.

239. See generally *Bender*, 1997 WL 266972, at *2-*4 (discussing nature of each change and examining work in its entirety).

240. See *id.* at *3 (finding docket number and date argued and decided to be facts).

241. See, e.g., *Feist*, 499 U.S. at 351 ("In no event may copyright extend to facts themselves.").

242. See 37 C.F.R. § 202.1 (1988) (declaring that "words and short phrases such as names, titles, and slogans" cannot be protected by copyright).

243. See Transcript, Jan. 27-28 Trial, at 23, *Bender*, 1997 WL 266972, available at <<http://www.hyperlaw.com/trialtr.htm>> (stating that West gets docket number and dates from slip copies issued by court).

244. See *Bender*, 1997 WL 266972, at *4 (stating that addition of parallel citations and changes to title are mechanical application of preexisting rules of citation).

245. Cf. *Entertainment Research Group, Inc. v. Genesis Creative Group, Inc.*, 853 F. Supp. 319, 322 (N.D. Cal. 1994) (concluding that changes that are driven primarily by functional, utilitarian or mechanical purposes should not be considered in attempt to determine if work is original).

246. See *Groves Press, Inc. v. Collectors Publication, Inc.*, 264 F. Supp. 603, 605 (C.D. Cal. 1967) (holding that changes in course of proofreading are trivial). In some cases West contacts the judge who wrote the opinion and the judge will actually make the correction. See *Bender*, 1997 WL 266972, at *4 (stating that West contacts court to discuss possible mistakes). The work of a judge can not be the

West's corrections are imperceptible to the reader and therefore should not be protected by copyright.²⁴⁷ Any hope of having these changes protected by copyright rested solely on the "sweat of the brow" theory, which granted copyright protection based on the compiler's labor, that was rejected by *Feist*.²⁴⁸ Therefore, the court correctly dismissed the possibility of copyright protection for West's corrections.²⁴⁹

To summarize, although West expends great effort in making changes to judicial opinions, that effort is not relevant in determining the issue of originality.²⁵⁰ The 1976 Act clearly states that a work will be protected by copyright only if it is an original work of authorship.²⁵¹ The changes West makes to its reported decisions do not vary substantially from the work of the judges.²⁵² Because the cases West publishes are not creative, they are not an original work of authorship and cannot be protected by copyright.²⁵³ Therefore, the conclusions and reasoning of the court in *Bender* are correct.²⁵⁴

subject of a copyright. See 17 U.S.C. § 105 (1994) (stating work of U.S. Government cannot be protected by copyright); see also *Banks v. Manchester*, 128 U.S. 244, 253 (1888) (holding that "no copyright could . . . be secured in the products of the labor done by judicial officers in the discharge of their judicial duties").

247. See *EFS Mktg., Inc. v. Russ Berrie & Co.*, 836 F. Supp. 128, 133 (S.D.N.Y. 1993) ("Minuscule variations of otherwise preexisting craftsmanship *that are imperceptible to the casual observer are insufficient to obtain copyright protection.*") (emphasis added). Although West may make a number of changes to any one case, those changes are not distinguishable from the original text. See HyperLaw's Motion for Summary Judgment at 9-10, *Bender*, 1997 WL 266972, available at <<http://www.hyperlaw.com/hlsjfn>> (arguing that West's changes can not be distinguished from court's original opinion). West has admitted that a reader cannot determine the difference between West's changes and the original text. See *id.* at 10. ("West has . . . conceded the practical impossibility of ascertaining which of the changes to the original court opinion were authored by West.")

248. See generally *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 353 (1991) (rejecting "sweat of the brow" doctrine). The vast majority of West's changes involve "page numbering, capitalization, spelling corrections and cites." HyperLaw's Motion for Summary Judgment at 11, *Bender*, 1997 WL 266972, available at <<http://www.hyperlaw.com/hlsjfn>>. "This is a classic case of 'sweat of the brow.'" *Id.* For a further discussion of the "sweat of the brow" doctrine and the Supreme Court's rejection of it in *Feist*, see *supra* note 60. For a further discussion of the changes made by West, see *supra* notes 180-97 and accompanying text.

249. See *Bender*, 1997 WL 266972, at *4 (rejecting argument that West's corrections are protected by copyright).

250. See generally *Feist*, 499 U.S. at 353 (rejecting "sweat of the brow" doctrine).

251. See 17 U.S.C. § 102 (1994) (stating copyright protects "original works of authorship"). For a further discussion of the originality requirement, see *supra* notes 68-96 and accompanying text.

252. See *Bender*, 1997 WL 266972, at *4 (holding that West's changes do not result in distinguishable variation).

253. See 17 U.S.C. § 102 (protecting only works of original authorship).

254. For a discussion of the reasoning and conclusions of the court in *Bender*, see *supra* notes 146-98 and accompanying text.

V. THE IMPACT OF *BENDER* ON THE LEGAL PUBLISHING MARKET, THE
FUTURE OF LEGAL RESEARCH AND THE COPYRIGHT PROTECTION
OF FACTUAL COMPILATIONS

The district court's decision in *Bender* may have a potentially devastating effect on West's legal publishing empire.²⁵⁵ The impact of the decision might lead to an erosion of West's profits.²⁵⁶ West will no longer be able to collect money from legal publishers for licensing agreements.²⁵⁷ Because its page numbers are no longer protected by copyright, competitors will be able to copy the numbers at will, without paying a fee.²⁵⁸ West can potentially lose tens of millions of dollars from the loss of these fees alone.²⁵⁹

The free use of star pagination will allow smaller publishers, who previously could not compete with West because of prohibitive licensing fees, to enter the legal publishing market.²⁶⁰ This will lead to greater competition, potentially driving down the price of legal research.²⁶¹ Also, West's

255. See David Cay Johnston, *The Media Business; West Publishing Loses a Decision on Copyright*, N.Y. TIMES, May 21, 1997, at D1 (discussing potential impact of *Bender* decision on West's business).

256. See *id.* (stating that experts expect decision to allow new competition to emerge that "would erode West Publishing's profit margins"). Several experts in copyright and electronic publishing commented that the impact of the decision could be far reaching. See *id.* (commenting on potential impact of *Bender*). The experts that were questioned believed that the decision could lead to increased competition in the field of legal research. See *id.* Due to the increased competition, the price of research would drop, leading one legal publisher to proclaim that "West's monopoly pricing is finished." *Id.*

257. Cf. Stephen Labaton, *Westlaw and Lexis Near Truce*, N.Y. TIMES, July 19, 1988, at D5 (discussing settlement agreement between West and Mead after Eighth Circuit's decision in *Mead*); see also Scheffey, *supra* note 216 (discussing West's settlement with Oasis after district court's decision in *Oasis*). As a result of West's victory in *Mead*, the two parties reached an agreement in which Mead agreed to pay a large licensing fee for the right to star paginate to West's reporters. See Labaton, *supra*, at D5. For a discussion of West's settlement with Oasis, see *supra* note 118.

258. Cf. *Matthew Bender & Co. v. West Publ'g Co.*, No. 94 CIV. 0589, 1997 WL 266972, at *5 (S.D.N.Y. May 19, 1997) (holding that HyperLaw did not violate West's copyright by copying opinions from West's reporters). While this result might appear unfair because West has spent a great deal of time and money developing its reporters, the Supreme Court has held that such a result is "neither unfair nor unfortunate. It is the means by which copyright advances the progress of science and art." *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 350 (1991).

259. See Labaton, *supra* note 257, at D5 (discussing terms of settlement between Mead and West). While the exact terms of the deal were not disclosed, it is believed that Mead agreed to pay West "tens of millions of dollars" for the licensing agreement. See *id.*

260. See Laura Mansnerus, *Easing Limits on Legal Publishing*, N.Y. TIMES, Oct. 9, 1995, at D5 (implying that small publishers could not compete with LEXIS and West because they feared being sued by West and they could not afford licensing agreement with West).

261. See Scheffey, *supra* note 216 ("Prices for legal research are going to go down, way down."); see also Johnston, *supra* note 255, at D1 ("You are about to see

competitors, such as HyperLaw and Bender, will be able to produce cheaper CD-ROM products.²⁶² Thus, the need for West's reporters will decrease, causing a drop in subscriptions, which recently were said to account for about forty percent of West's sales.²⁶³

West will also be collecting less money from computer assisted research.²⁶⁴ Before the *Bender* decision, other on-line services and sources on the Internet were almost useless because of the limited number of cases that were available.²⁶⁵ Now, other on-line services can copy West's older cases and increase the viability of their services.²⁶⁶ The availability of a greater number of cases may also allow the Internet to grow into a powerful legal research tool, providing the public with "free" access to the law.²⁶⁷

Along with the potentially devastating changes for West, the *Bender* decision may also have an enormous impact on the practice of law.²⁶⁸ With increased competition and a greater range of products to choose from, lawyers and their clients will pay less for legal research.²⁶⁹ Federal practice libraries will be more accessible, allowing small firms to afford the

the price of legal research spiral downward. . . . West's monopoly pricing is finished.").

262. See Scheffey, *supra* note 216 (comparing price of West's reporters with price of CD-ROM). For example, a federal practice library, which could cost as much as \$30,000 for new books, are now available electronically for \$2000 per year. See *id.* The price of state law would be even cheaper, with prices for a state's collected law on CD-ROM priced as low as \$600. See *id.* Greater use of CD-ROMs would also impact on-line legal research because "lawyers will be able to buy a single product that has both the reported federal decisions found in books and the unreported decisions found in online services, such as Westlaw and Lexis." *Id.*

263. See Iver Peterson, *Thomson to Buy Legal Publisher in a \$3.43 Billion Cash Accord*, N.Y. TIMES, Feb. 27, 1996, at D1 (noting that 40% of West's sales come from subscriptions).

264. See generally Mansnerus, *supra* note 260, at D5 (explaining that small database companies stayed away from using citations to West for fear of being sued). If the *Bender* decision is upheld, these companies would not have to worry about a lawsuit and could create a more useful product, giving users alternatives to Westlaw and LEXIS, which can cost more than \$200 an hour. See *id.* (comparing price of Westlaw to smaller database company). One company would charge as little as \$6.25 per hour for computer assisted legal research. See *id.*

265. Cf. Scheffey, *supra* note 216 (discussing problems faced by legal publishers in attempting to compete with West). West's competitors contend that they were forced to rely on West's cases because copies of older cases, pre-1990, were "difficult or impossible to obtain from courts in any form." *Id.* This problem has been alleviated to some extent for cases decided after 1990 because many courts have published their opinions in electronic form. See *id.*

266. See *id.* (stating ability to link to cases or statutes makes CD-ROMs and Internet powerful).

267. See *id.* (stating ability to link to cases and statutes via Internet is powerful tool for lawyers).

268. See Johnston, *supra* note 255, at D1 (stating price of research is going to decrease).

269. See, e.g., Scheffey, *supra* note 216 (discussing drop in price of legal research).

case law necessary for a federal practice.²⁷⁰ There will be “a more level research playing field,” allowing small firm lawyers to compete with “big-city Goliaths.”²⁷¹ After the *Bender* decision, one attorney commented, “Leveling the playing field . . . doesn’t begin to convey the fundamental change in the profession You start knocking out the high cost of legal research, and it’s going to fundamentally change the way people can practice.”²⁷²

Finally, *Bender* may affect the copyright protection afforded future factual compilations and databases.²⁷³ *Feist* limited the protection afforded compilations by eliminating “sweat of the brow” protection, leaving only the compilation’s selection and arrangement protected.²⁷⁴ The *Bender* decision shows just how limited that protection is and makes it clear that “‘uncreative’ but hard working fact-compilers will find it difficult to have their sweat remunerated.”²⁷⁵ Because *Bender* and other copyright decisions since *Feist* have severely reduced copyright protection for factual compilations, Congress has recently debated the merits of legislation that would provide greater protection to data compilers like West.²⁷⁶

270. See *id.*; see also Wyman, *supra* note 5, at 264-65 (stating that CD-ROM technology allows small firms and sole practitioners that had previously been unable to afford library of case reporters to access case law).

271. Scheffey, *supra* note 216.

272. *Id.*

273. For a discussion of the impact of *Bender* on the copyright protection afforded factual compilations and databases, see *infra* notes 274-93 and accompanying text.

274. See John F. Hayden, *Copyright Protection of Computer Databases After Feist*, 5 HARV. J.L. & TECH. 215, 240 (1991) (arguing that protection is virtually nonexistent after *Feist*, limited strictly to selection and arrangement). This limited protection leaves a compilation’s most substantial contribution, “the assembly of various pieces of information into a coherent and useful whole,” unprotected. See *id.*

275. N. Stephan Kinsella & Robert E. Rosenthal, *Wither Goes Copyright Law*, LEGAL INTELLIGENCER, Sept. 4, 1997, available in LEXIS, News Library, Lgint File.

276. See H.R. 2652, 105th Cong. (1997) (proposing “Collections of Information Antipiracy Act”); see also H.R. 3531, 104th Cong. (1996) (proposing “Database Investment and Intellectual Property Antipiracy Act of 1996”). The 104th Congress failed to adopt H.R. 3531. See Jonathan Band & John Kennedy, *Battle Lines Form Over WIPO Copyright Bill*, NAT’L L.J., Jan. 26, 1998, at C5 (stating that H.R. 3531 died with end of 104th Congress). H.R. 3531 proposed protection for databases that were “the result of a qualitatively substantial investment of human, technical, financial or other resources in the collection, assembly, verification, organization or presentation of the database contents” H.R. 3531, 104th Cong., § 3(a) (1996).

Essentially the proposed act attempted to overrule *Feist* by giving database producers “sweat of the brow” protection. See Wyman, *supra* note 5, at 257 (discussing underlying purpose of proposed act). The act would have created a cause of action against anyone that used some portion of a protected database’s content “in a manner that conflict[ed] with the database owner’s normal exploitation of the database or adversely affect[ed] the actual or potential market for the database.” H.R. 3531, § 4(a)(1). The proposed act would have also imposed criminal penalties on anyone who violated the act for commercial advantage or who caused “loss or damage to a database owner aggregating \$10,000 or more in any one-year calendar period.” H.R. 3531, § 8(a).

House Resolution 2652, the Collections of Information Conspiracy Act ("Resolution 2652"),²⁷⁷ proposes to extend the Copyright Act of 1976 to cover factual compilations and databases that currently lack protection.²⁷⁸ The stated purpose of Resolution 2652 is to "prohibit the misappropriation of valuable commercial collections of information by unscrupulous competitors who grab data collected by others, repackage it and market a product that threatens competitive injury to the original collection."²⁷⁹ To accomplish this objective, Resolution 2652 proposes to make it illegal for a party to "misappropriate" compilations of facts that the owner had compiled by spending substantial amounts of money and effort, regardless of the originality involved in these compilations.²⁸⁰ Resolution 2652 also proposes that repeat violators of the law could be subject to as much as five hundred thousand dollars in fines and possibly even ten years in prison.²⁸¹ The great irony of the *Bender* decision may be that while it is a case that stands for the proposition that very limited copyright protection exists for factual compilations, its greatest impact might be that

277. See H.R. 2652, 105th Cong.

278. See Jodine Mayberry, *The Database Antipiracy Act: Friend or Foe of Academic Freedom?*, 15 COMPUTER & ONLINE INDUSTRY LITIGATION REPORTER 7 (1998) (discussing intentions of H.R. 2652). The act would amend the Copyright Act of 1976 to include a new chapter dealing with collections of information. See *id.*

279. 143 CONG. REC. E2000-02 (daily ed. Oct. 9, 1997) (statement of Rep. Coble). According to the representative who introduced the bill, it is important to offer greater protection to compilations because "[e]lectronic collections, and other collections of factual materials, are absolutely indispensable to the American economy on the verge of the new century." *Id.* Compilations enable "business people, professionals, scientists, scholars, and consumers" to retrieve specific factual information efficiently. See *id.*

Databases are an ever-growing, vital aspect of the United States economy. See Hayden, *supra* note 274, at 215. "The information age of the late twentieth century has seen the proliferation of factual compilations." Davis, *supra* note 59, at 439. The development of factual compilations and databases entails a great deal of expense and effort on the other hand, copying the final product is very cheap and easy. See Hayden, *supra* note 274, at 216. "Databases thus need legal protection because they are simultaneously difficult to produce and easy to copy." See *id.*

280. See H.R. 2652, § 1201 (stating "investment[s] of substantial monetary or other resources" qualify for protection). In proposing this bill, proponents argue that it is fair because of its reliance on the tort of misappropriation, as opposed to H.R. 3531, that created a form of sui generis copyright protection for databases. See 143 CONG. REC. E2000-03 (explaining differences between H.R. 2652 and H.R. 3531). A sui generis law, like copyright law, would give a compiler of factual material exclusive ownership of the compilation for a specified period of time. See Mayberry, *supra* note 278, at 7 (explaining meaning of sui generis law). H.R. 2652 does not attempt to establish an exclusive right, it is simply a "prohibition against misappropriation." See H.R. 2652, § 1201. *But see* Band & Kennedy, *supra* note 276, at C5 (stating that "as a practical matter, H.R. 2652 affords compilers essentially the same level of protection as its sui generis predecessors").

281. See Mayberry, *supra* note 278, at 7 (describing penalties proscribed by H.R. 2652). First offenders could be subject to a fine of up to \$250,000 and five years in jail. See *id.*

it is the impetus for legislation that would substantially enhance such protection.²⁸²

Obviously, large data collectors like West strongly support this proposed legislation.²⁸³ They argue that there is a great need for such legislative action, both economically and scientifically.²⁸⁴ According to the argument in favor of Resolution 2652, data compilers need incentives and profit protection to maintain data collection as worthy of the time and effort that the collectors expend.²⁸⁵ The proponents argue that if these incentives do not exist, then no one would be willing to undertake the task of compiling large databases.²⁸⁶

The opponents of Resolution 2652, including smaller publishers, educational institutions and libraries, argue that the proposed legislation would eliminate competition and drive up the costs of research.²⁸⁷ Additionally, they argue that Resolution 2652 would have a "chilling effect on

282. See generally H.R. 2652, 105th Cong. (1997) (making it illegal to "misappropriate collections of information"). Alan D. Sugarman, president of HyperLaw has stated that "the raison d'être for this bill is to protect the case reports of West Publishing and Lexis." Thomas Scheffey, *Congress Debates Law Guarding Against Electronic "Piracy,"* TEXAS LAWYER, Nov. 10, 1997, available in LEXIS, News Library, Txlawr File (quoting statement of Alan D. Sugarman, president of HyperLaw, Inc.). While Sugarman's charge is debatable, it is clear that *Bender* and similar lower court decisions are some of the main reasons for the proposed legislation. See *id.* (stating that bill is response to pressure from two fronts, *Bender* decision and directive of European Union). In February 1996, the European Union issued a directive to its member nations, instructing them to enact database protection laws by Dec. 31, 1997. See *id.* The directive also stated that "[f]oreign nations without 'equivalent' database protection laws may not be protected in Europe." *Id.*

283. See Mayberry, *supra* note 278, at 7 (noting that bill is strongly supported by database publishers and their trade organizations). Trade organizations support the bill because the database industry employs over 200,000 workers nationwide. See *id.*

284. Cf. 143 CONG. REC. E2000-02 (stating that there is need for "legislation to protect developers who place their materials in interstate commerce against piracy and unfair competition," thereby encouraging investment in production and distribution of valuable information). Essentially, the argument is that the best way to promote science and the economy, of which databases are an important part, is to protect these compilations. Cf. *id.*

285. Cf. Scheffey, *supra* note 282 (stating that proponents of bill claim that it is essential to keep data collection profitable).

286. Cf. *id.* ("It is better to have one provider than zero."). Proponents of the bill argue that the lack of protection, since *Feist*, has led to a slowing in the growth of the database, electronic publishing, on-line and information retrieval industry. See Mayberry, *supra* note 278, at 7. If data collectors lose their economic incentive to create compilations, there is a real chance that no one will be there to take their places. For a discussion of this possibility, see *infra* note 293.

287. See Mayberry, *supra* note 278, at 7 (noting that bill has created concern among scientists, journalists, academics and librarians). Librarians, for example, feel that the bill will drive up acquisition costs, limiting the amount of information that they can make available to students. See *id.* Overall, the opponents of the bill believe that it "will only add a legal barrier that will facilitate monopoly pricing and foster a substantial risk that large commercial providers will gradually control all of the building blocks of knowledge." *Id.*

the full and open exchange of data for research and education[al] purposes."²⁸⁸ Finally, the opponents see the proposed legislation as a danger to the viability of the public domain in general.²⁸⁹ They believe Resolution 2652, if enacted, will establish a dangerous precedent in which every investor, in any number of products, would seek similar statutory protection for their profits.²⁹⁰ The overall effect of such requests would be to "eliminate the public domain and discourage new uses for collected information."²⁹¹

While the potential results of the *Bender* decision, lowering the cost of legal research and increasing the public's access to the law, are welcomed, and the opponents of Resolution 2652 present a valid concern in protecting the continued viability of the public domain, one intriguing question remains: if West and other compilers of data lose their monopoly and profits, thereby losing their economic incentive to undertake their valuable work,²⁹² who will be willing to take their place?²⁹³

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288. *Id.*

289. *See id.* (discussing possible effects on existence of public domain material). Opponents argue that the bill's exemption is not enough protection as currently worded. *See id.* They argue that the bill should be changed to "ensure that governmental works cannot be copyrighted and thus removed from the public domain." *Id.* Currently, the bill would protect a private publisher who simply repackages governmental information, even without significant contribution of its own. *See id.* (describing argument of opposition to H.R. 2652). Another problem that certain groups have with the bill is that they claim that the definition of database is overly broad. *See id.* As a result of this broad definition, the proposed act could "conceivably cover every information product now freely available from the public domain." *Id.*

290. *See id.* ("The proposed law would open the door for investors in a myriad of products and processes to demand the same kind of protections for their profits . . .").

291. *Id.*

292. *See* Matthew Bender & Co. v. West Publ'g Co., No. 94 CIV. 0589, 1997 WL 266972, at *4 (S.D.N.Y. May 19, 1997) (stating that West "performs a valuable service for the bench and the bar").

293. *Cf.* Stephen C. Carlson, *The Law and Economics of Star Pagination*, 2 GEO. MASON L. REV. 421, 429 (1995) (discussing effect of removing author's monopoly protection). In general, removing an author's right to exclusive work will result in the author not being able to make a profit for two reasons:

First, the price per copy does not include the initial fixed cost to produce it. Second, the demand for the author's copy will decrease because of the competing copies. In addition, the copyist does not bear the risk of failure in producing the work, because only the popular works tend to be pirated. *The effect is to reduce the incentive to write the book in the first place.*

Id. (emphasis added).