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Introduction

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COPYRIGHT SYMPOSIUM PART I COPYRIGHT PROTECTION FOR COMPUTER DATABASES, CD-ROMS AND FACTUAL COMPILATIONS

INTRODUCTION

*Robert A. Kreiss**

The Program in Law and Technology at the University of Dayton School of Law decided to sponsor a Scholarly Symposium on "Copyright Protection for Computer Databases, CD-ROMs, and Factual Compilations" in the wake of the Supreme Court's March 1991 decision in *Feist Publications, Inc. v. Rural Telephone Service Co.*¹ As soon as the decision was handed down it was apparent that *Feist* was a major Supreme Court opinion in the copyright arena and that it opened a host of issues which warranted probing by scholars and practitioners alike. Among the issues which *Feist* raised were those of:

- * the constitutional parameters of copyright;
- * how the new originality standard would compare and comport with protection in the international scene;
- * the Copyright Office's policies for dealing with computer databases, works on CD-ROM, and factual compilations;
- * what *Feist* contributed to an understanding of the nature of copyright;
- * the policies which justify protecting databases in light of the fact that producing the works is expensive while copying is easy;
- * whether copyright is an appropriate response to policies justifying protection and/or to policies concerning access to information;
- * the extent to which *Feist* left open the door for state law protection;
- * whether *Feist* portends a more definitive separation between copyright law and unfair competition law; and
- * the enforceability of "sign-on" license agreements for databases.

The Symposium was held on November 8-9, 1991, in Dayton, Ohio. Copyright scholars, counsel for major corporations and industry associations involved in producing and distributing databases, and a Policy Planning Advisory to the Register of Copyrights were invited to gather, to present papers, and to discuss each other's papers. These people, the faculty members for the Symposium, were (alphabetically):

* Director, Program in Law and Technology, and Associate Professor of Law, University of Dayton School of Law.

1. *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 111 S. Ct. 1282 (interim ed. 1991).

David O. Carson
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Professor Jerome H. Reichman
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Nashville, Tennessee 37240

James E. Schatz
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Minneapolis, Minnesota 55401

Paul T. Sheils, Group General Counsel
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Princeton, New Jersey 08543-0300

Kurt D. Steele, Vice President
and General Counsel
Rand McNally & Company
Skokie, Illinois 60076

Sara Straight Wolf, Vice President
and General Counsel
Mead Data Central, Inc.
Dayton, Ohio 45401

The Chairman of the Symposium was:

Robert A. Kreiss
Director, Program in Law and Technology
& Associate Professor of Law
University of Dayton School of Law
Dayton, Ohio 45469-1320

In addition to the distinguished faculty for the Symposium, the audience contained attendees from industry and law firms. For example, there were attendees from: Dun & Bradstreet Information Services; Equifax, Inc.; Fujitsu, Ltd.; GTE Service Corp.; Mead Data Central, Inc.; NCR Corp.; Reynolds & Reynolds Corp.; TRW Inc.; and University Microfilms International. There were also attendees from the law firms of: Biebel & French (Dayton, OH); Brooks & Kushman (Southfield, MI); Frankfurt, Garbus, Klein & Selz (New York, NY); Ernest Hix (Dayton, OH); Marshall & Melhorn (Toledo,

OH); Stanley Phillips (Dayton, OH); Rogers & Wells (New York, NY); Thompson, Hine & Flory (Dayton, OH); Karen Williams (West Carrollton, OH). In addition, faculty and counsel for the University of Dayton attended.

Each of the faculty members provided a written paper for the Symposium. In addition, each faculty member presented a paper orally. In general, a discussion among all faculty and attendees followed each presentation. In a few instances, one or more faculty members presented papers responding to a paper by another faculty member, and then the floor was opened up for discussion.

All sixteen of the written papers, all sixteen of the oral presentations, and all of the discussions are contained in these two issues of the University of Dayton Law Review. Since oral communication relies to some extent on inflection, body language, gesture, and context, and since some slips of the tongue are inevitable in spontaneous discussions and oral presentations, some editing has been done by the authors and the editors in order to make the Symposium issues more readable and to correct the slips.

The order in which papers and discussions are presented in these two volumes is the same as the order in which the faculty spoke at the Symposium. Professor Leo Raskind spoke first. Hence, his written paper appears first in these volumes, followed by his oral presentation at the Symposium and then by the discussion of his paper. Professor David Lange was the second speaker, so his written paper, oral presentation, and the open discussion follow Professor Raskind's paper, presentation and discussion. The table of contents of these volumes provides the complete list of the order of speakers and materials.

The Scholarly Symposium would not have been possible without financial support by a number of corporate sponsors. The corporate sponsors were The Dun & Bradstreet Corp., Mead Data Central, Inc., and NCR Corp. The corporate contributor was The Reynolds and Reynolds Corp. The University of Dayton School of Law gratefully acknowledges the contributions of these corporations, without which there would not have been a Symposium.

Primary responsibility for planning the program fell on my shoulders as Chairman. It was my responsibility to solicit corporate sponsorships and contributions, to solicit input from law professors and people in industry as to whom we should invite, and to invite the speakers. I am particularly grateful that none of the corporate sponsors or contributors put forth any private agendas as to who should be invited or not invited, and none of them exerted any pressure on me to give the program any particular slant.

I decided quite early that I wanted to include representatives from both the academic community and from corporations and law firms which were involved in developing and marketing databases. I started my search for speakers by contacting law professors whose articles had been cited by Justice O'Connor in the *Feist* opinion. Justice O'Connor cited authors with whom she agreed and others with whom she disagreed. I started with these scholars since I believed that they would have an understanding of the issues and an interest in this area of copyright. These two factors seemed important since we wanted each speaker to produce a scholarly article in the relatively short span of about five months. My search for speakers then expanded based on suggestions from those initial contacts.

Our choice of a Symposium based on *Feist* and its ramifications for computer databases, works on CD-ROMs, and factual compilations was based on the far-reaching nature of Justice O'Connor's opinion. Even a casual reading of *Feist* showed that this decision would be of singular importance in copyright jurisprudence. There were at least three points which struck immediately: one of relatively minor interest; a second of more importance; and the third having the greatest significance.

The ultimate conclusion of the case, that a second researcher does not infringe a copyright when using the facts gathered by a first researcher, was rather unexceptional. After all, the copyright law has never given protection to facts, and it is certainly inefficient to require people to repeat all of the time-consuming steps taken to gather the information. While there have been a few cases which have seemed to require a second researcher to repeat all of the work of the first researcher and only use the first researcher's work to check the second work,² the better rule has always been that copyright does not protect facts.³

The second point, that one cannot acquire a copyright solely because of the "sweat of the brow" or because of "industrious collection" was more important but again hardly earth-shaking. Over the years, in response to the pleas of workers who have labored hard to produce a work, a number of courts have granted copyright protection to those works even though the works have been collections of facts. Many of these cases have involved maps or telephone directories.⁴ In these cases,

2. See, e.g., *Leon v. Pacific Tel. & Tel. Co.*, 91 F.2d 484 (9th Cir. 1937); *Jewelers' Circular Publishing Co. v. Keystone Publishing Co.*, 281 F. 83 (2d Cir.), cert. denied, 259 U.S. 581 (1922).

3. See *Harper & Row, Publishing Inc. v. Nation Enters.*, 471 U.S. 539, 556 (1985) (author cannot copyright facts he narrates).

4. See, e.g., *Hutchinson Tel. Co. v. Fronteer Directory Co.*, 770 F.2d 128 (8th Cir. 1985); *United States v. Hamilton*, 383 F.2d 448 (9th Cir. 1978); *United Tel. Co. v. Johnson Publishing*

courts have contrasted the hard work and effort of the original worker with the lack of effort by the copier. These courts have used the language of "sweat of the brow" or "industrious collection" in their opinion as if copyright rights could be earned by putting in enough hard work. No doubt these courts were moved, as courts often are, by the equities of the cases. While the courts have used the legal regime of copyright law to reach their results, the reasoning seems more in line with the misappropriation doctrine enunciated in cases such as *International News Service v. The Associated Press*.⁵

While the Supreme Court in *Feist* stated in no uncertain terms that the "sweat of the brow" theory cannot be used as a basis for granting copyright protection for collections of fact or other works, there is more smoke than fire in this pronouncement because in many of the "sweat of the brow" cases, one could justify granting copyright protection on more traditional copyright grounds. Most works which involve industrious collection are either works incorporating historical research or are collections of facts such as maps or directories. A work involving historical research will often contain "original work of authorship," thus meeting the test for copyright protection. A map or directory may well be a copyrightable compilation of facts, based on the original "selection, coordination, and arrangement" of the facts in the work. Thus this second point, while important in emphasizing that copyright is not a misappropriation law, may not lead to major changes in the results of most cases.

The third point which one immediately noticed in reading *Feist* was the Court's constitutionalization of copyright law. The Court held that the Constitution required a minimum amount of originality or creativity in order for a work to be eligible for copyright protection.⁶

I suspect that most copyright scholars and practicing attorneys were as astounded as I was at this surprising new development in copyright law. It was surprising for a number of reasons. First, it was surprising simply because it is so unusual. I can think of no previous copyright cases which have been decided on constitutional grounds, and in fact there may have been no such cases.

Co., 671 F. Supp 1514 (W.D. Mo. 1987), *aff'd*, 855 F.2d 604 (8th Cir. 1988); *Rand McNally & Co. v. Fleet Management Sys.*, 600 F. Supp. 933 (N.D. Ill. 1984); *Northwestern Bell Tel. Co. v. Bedco of Minn. Inc.*, 501 F. Supp. 299 (D. Minn. 1980).

5. 248 U.S. 215 (1918).

6. *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 111 S. Ct. 1282 (interim ed. 1991). The Constitutional provision on which the Court relied states: "The Congress shall have power . . . (8) To promote the Progress of Science . . . by securing for limited Times to Authors . . . the exclusive Right to their respective Writings. . . . U.S. CONST. art. I, § 8, cl. 8.

Second, it is surprising since it was unnecessary. If the Court wanted to hold that a minimum amount of originality is required before a work can have copyright protection, it could certainly have done so on statutory grounds almost as easily as it did on constitutional grounds. The statutory language in section 102 providing that copyright protection subsists "in original works of authorship"⁷ could easily have been interpreted to require some threshold level of originality. Such an interpretation would certainly have been as easy as basing an originality threshold on the constitutional language of "authors" and "writings."

And third, it is surprising since it has taken the Court 200 years to tell us that the words "author" and "writings" in the Constitution contain a requirement of originality in order to have copyright protection. If the text of the Constitution were as clear as the Court seems to claim in the *Feist* opinion, surely an earlier Court would have told us so.

More importantly, the Court fails to deal with the possibility that the constitutional grant of power to Congress to "promote the Progress of Science and useful Arts,"⁸ might contain some breathing room. Just as the Commerce Clause's grant of power to "regulate Commerce . . . among the several States" has been interpreted broadly to allow some regulation of hotels and restaurants which only operate in one state, one might expect that the Copyright Clause could have been interpreted broadly so that Congress could give copyright protection to some works whose originality is questionable in order to ensure that no worthwhile work (i.e., one which contributes to the "progress of Science") is left out. *Feist* refused such a broad interpretation of the constitutional clause without any discussion or consideration of this possibility.

The *Feist* decision comes at a particularly interesting time in the development of technology, particularly computer technology. In the past decade large computers have increased dramatically in power. Personal computers have sprouted on desks throughout the country. More and more massive databases are being created. And these databases are available not only on-line, but also on CD-ROM. This combination of events is likely to lead to increased legal tensions between creators, distributors, and users of databases.

As computer power has increased, databases can be made more complete and all-inclusive. Under *Feist*, such databases may not qualify for copyright protection because their very completeness under-

mines any claim that there is "original" selection in them. The distribution of these databases on CD-ROM and the widespread use of personal computers means that users can use these databases, and the user will not care about the co-ordination or arrangement of the databases. A competitor who takes advantage of these factors might be tempted to acquire (cheaply) one copy (on CD-ROM) of a complete database, dump the data into his or her own computer system using his or her own data structure (i.e., co-ordination and arrangement of data), and then market the database in a new format to consumers. The competitor would not be copying the co-ordination and arrangement of the data, and there would be no copyright in the selection of the data. Wouldn't that lead to a situation in which the competitor escapes copyright liability and is able to operate without the costs associated with gathering the data in the first place?

As readers of this Symposium will discover, *Feist* actually raises a host of other difficult and important issues—e.g., issues relating to copyright's relationship with the First Amendment and relating to the scope of copyright's preemption of certain state law claims.⁹ The faculty and attendees at the Symposium addressed these issues. You, the reader, are invited to join in the discussion that they began.

9. Section 301 of the copyright law states that "all legal and equitable rights that are equivalent to any of the exclusive rights within the general scope of copyright as specified by section 106 in works of authorship that are fixed in a tangible medium of expression and come within the subject matter of copyright as specified by sections 102 and 103, . . . are governed exclusively by this title." 17 U.S.C. § 301(a) (1988) (emphasis added). The *Feist* decision raises the issue of whether works lacking sufficient "originality" to qualify for copyright protection can now be protected by state misappropriation or other laws. Such works would not be "works of authorship" and would not come within the "subject matter of copyright."