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ASSESSING THE IMPACT OF *FEIST*

Leo J. Raskind*

I. THE *Feist* OPINION

Like the proverbial handful of pebbles dropped in a pond, the decision in *Feist Publications, Inc. v. Rural Telephone Service Co.*,¹ has the potential over time to generate a series of widening, if not necessarily concentric, consequences for the basic doctrines of copyright law.² This conclusion rests on the assumption that lower court judges will seek to absorb and follow its teaching, a task that is complicated by the meandering nature of the *Feist* opinion.³ In the short run, i.e., within the next five or so years, the *Feist* decision will almost certainly lead some lower court judges to narrow the scope of protection for the factual component of directories, maps, data bases, computer software programs, and kindred fact works.

In the longer term, the analysis suggested by this opinion may lead to a revision of the doctrinal statement of authorship. For, as the courts undertake the distinction between the protectable elements of a compilation and its unprotected facts, the creative conduct of the compiler will come under enhanced scrutiny. Since what constitutes a "fact" in this context is not self-defining, an articulated conception of authorship in compilations will probably appear in the case law in order to distinguish "fact" from the protectable element of its framework. Unfortunately, the opinion does not facilitate this task. The misplaced stress on originality in the *Feist* decision may cause some lower court judges merely to undertake comparisons between the factual content of the copyright claimant's work and the comparable preexisting public domain material. Other lower court judges may instead undertake a quest for the creative conduct in preparing the protectable compilation. Were there to emerge a line of cases stressing comparison of the works with preexisting public domain material, it is likely that a doctrine of "numbers," would emerge—i.e., ratio of amount of protected work taken to amount contributed by the putative infringer. If, however, the analysis of authorship came to dominate the case law, then various elements of

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1. 111 S. Ct. 1282 (interim ed. 1991).

2. *Id.*

3. In at least one of the spate of immediate post-*Feist* cases, the court seems to have cited *Feist* and otherwise ignored its reasoning. See *Bellsouth Advertising & Publishing Corp. v. Donnelly Info. Publishing, Inc.*, 933 F.2d 952 (11th Cir. 1991).

judgment and selection would identify the requisite conduct of authorship for a compiler. In the end, it is foreseeable that some lower court judges will interpret the *Feist* opinion's use of originality to include authorship as well. Another likely consequence of the *Feist* opinion is a renewed interest in the misappropriation and kindred doctrines. The demise of the "sweat of the brow" as a premise of copyright protection, at least for directories, will begin a search for alternatives. That doctrine served courts well enough as a means of engrafting acceptable commercial norms onto traditional copyright analysis. Courts and commentators will doubtlessly continue to be moved by an equitable sense of "fair" commercial conduct and by an abhorrence of "piracy." To the extent that *Feist* results in lesser copyright protection for compilations of data, there will be revived interest in misappropriation and other rationales of "fairness."⁴ It is likely that there will be active consideration given to state and federal legislation establishing some version of misappropriation principles for the protection of data bases.

If these predictions are valid, the overall impact of the *Feist* opinion will rest in revised and modified conceptions of authorship, originality, and "fair competition." The case may also influence the development of copyright protection with regard to traditional categories of property other than directories and related fact works as, for example, such emerging areas as sound sampling, uses of optical scanners, and related technology.⁵

Ultimately, the impact of the *Feist* decision will be derived from its two major statements. The first is its enhanced constitutional gloss on the traditional copyright concept of "original." The second is the flat rejection of the "sweat of the brow" or "industrious collection" principle. These two doctrinal changes may be inversely related. The rejection of the cost/effort basis of copyright protection may increase the need for an enhanced notion of originality as a substitute for the rejected "sweat" rationale. At the outset, the opinion identifies the tension inherent in the traditional protection of arrangements of factual material. If, as the Court reiterated, facts as such, are not protectable and the labor, sweat, or industry in collecting them are invalid grounds of copyright protection, then a revised rationale must be provided to support the protection clearly given to compilations by the statute.

4. Professor Karjala, in his contribution to this Symposium, suggests that protection against wholesale copying of compilations of electronically stored public domain material should be rested on the variant methods of fixation. See Dennis S. Karjala, Copyright and Misappropriation, 17 U. DAYTON L. REV. 885 (1992).

5. See Tamara J. Byram, *Digital Sound Sampling and a Federal Right Of Publicity: Is It Live or Is It Macintosh?*, 10 COMPUTER/L.J. 365 (1990).

Prior to *Feist*, the word, "original," within section 102 was interpreted as requiring only (1) independent creation, as distinguished from copying, and (2) a modicum of creative activity, sufficient to produce a "distinguishable," as opposed to a "trivial," variation from pre-existing public domain material.⁶ Under this standard, a painter who made an exact copy of a Rembrandt or of a previously unknown Mozart sonata, would not have created an "original" work of authorship. The requisite variation from public domain material would be lacking. Thus, the doctrine of "sweat of the brow" or "industrious collection" was applied as an alternative basis of protection. Courts and commentators recognized the makeshift nature of protecting fact works in these terms, so the dispatch of this doctrine in *Feist* can be numbered as one of its salutary contributions to the orderly development of copyright law.⁷

One possible consequence is renewed interest in Jane Ginsburg's suggestion that protection be granted to a first compiler subject to a compulsory license. This proposal has the merit of allowing competitors to access, copy, reorganize, and sell the same basic information, perhaps in more accessible format, without the risk of litigation.⁸ In this way, there is an incentive of some copyright protection to produce fact works, coupled with the assurance to a second compiler that an improved version may be prepared and marketed by the payment of a reasonable royalty.

It appears likely that the *Feist* Court, having rejected "sweat of the brow," came to invest the traditional copyright doctrine of "original" with its new, constitutional significance as a more acceptable, alternative rationale. As the Court put it:

The key to resolving the tension . . . [between unprotectable facts and protectable compilations] lies in understanding why facts are not copyrightable. The *sine qua non* of copyright is originality . . . [O]riginal . . . means only that the work was independently created . . . and that it possesses at least some minimal degree of creativity Originality is a constitutional requirement.⁹

6. 1 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 2.01[A] (1991).

7. See, e.g., *Miller v. Universal Studios, Inc.*, 650 F.2d 1365, 1370 (5th Cir. 1981); Robert C. Denicola, *Copyright In Collection of Facts: A Theory For The Protection of Nonfiction Literary Works*, 81 COLUM. L. REV. 516 (1981); Jane C. Ginsburg, *Creation and Commercial Value: Copyright Protection of Works of Information*, 90 COLUM. L. REV. 1865 (1990); Robert A. Gorman, *Fact or Fancy: The Implications For Copyright?*, 29 J. COPYR. SOC'Y 560 (1982); David E. Shipley & Jeffrey S. Hay, *Protecting Research: Copyright, Common-Law Alternatives, and Federal Preemption*, 63 N.C. L. REV. 125 (1984).

8. Ginsburg, *supra* note 7, at 1870-71.

9. *Feist*, 113 S. Ct. at 1287-88.

In elevating originality to the primary ingredient of protection, the Court has obfuscated rather than clarified the basis of protection for compilations of fact works. For, as stated, this criterion invites a comparative test of the degree of similarity between preexisting public domain material and the compilation seeking protection. The static and limited nature of this comparative test is reflected in the Court's description of "original" as a requirement in which "[o]riginality does not signify novelty; a work may be original even though it closely resembles other works so long as the similarity is fortuitous, not the result of copying."¹⁰

The mischief of this exposition is that it distorts the analysis of protection by devaluing the authorship component required for a protectable work. The statute itself serves as a reminder that protection is granted to "original *works of authorship* fixed in any tangible medium of expression."¹¹ By its emphasis on originality alone, the opinion in *Feist* provides an inadequate tool for the determination of authorship in a compilation. Lower court judges may be misled to undertake only the comparison of the claimed work with preexisting public domain material and essentially to ignore conduct of authorship inherent in the selection of the compiled material.

To be sure, the opinion does ultimately invoke and interpret section 102 and its requirement of authorship, but in doing so, authorship is given diminished importance. The exercise begins and ends with originality. As the Court put it:

The key to the statutory definition [of section 102(a)] is in the second requirement [of works of authorship] [Courts] should focus on the manner in which the collected facts have been selected, coordinated and arranged. *This is a straightforward application of the originality requirement.* Facts are never original, so that the compilation author can claim originality . . . only in the way the facts are presented [T]he statute dictates that the principal focus should be on whether the *selection, coordination, and arrangement* are sufficiently *original* to merit protection.¹²

Thus, the opinion distorts the focus of the inquiry. By overriding the statutory reference to authorship with the concept of originality, the Court leaves readers of the opinion to speculate whether the ultimate inquiry is in the work produced or in the activity of producing it, or some of each. As the Court uses the operative language of section 101 defining a compilation, are the words "selection, coordination, and

10. *Id.* at 1287.

11. 17 U.S.C. § 102(a) (1988) (emphasis added).

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12. *Feist*, 114 S. Ct. at 1294 (emphasis added).

arrangement," to be read as nouns or as verbs identifying creative, intellectual activity?

Paradoxically, the opinion rests its revised conception of "original" on *The Trade-Mark Cases*¹³ and the *Burrow-Giles Lithograph Co. v. Sarony*¹⁴ decision. However, the portions of those opinions on which the court in *Feist* relies, also stress authorship as a coordinate element in their analysis. Thus, the opinion in *Feist* quotes from the *Trade-Mark Cases* as follows:

[W]hile the word *writings* may be liberally construed . . . to include original designs for engraving, prints, &c., it is only such as are *original*, and are founded in the creative powers of the mind. The writings which are to be protected are the *fruits of intellectual labor*, embodied in the form of books, prints, engravings, and the like.¹⁵

Seemingly unaware of the contradictory nature of the text of this quotation to its own thesis, the *Feist* opinion quotes from *Burrow-Giles* to the effect that copyright is limited to "original intellectual conceptions of the author . . . the existence of those facts of originality, of intellectual production, of thought, and conception."¹⁶ Notwithstanding the repeated stress of these earlier cases on intellectual processes, thought, and creativity, as the ingredients of protection, i.e., on authorship, the *Feist* opinion derives from these earlier cases the non-sequitur conclusion that, "[t]he originality requirement articulated in *The Trade-Mark Cases* and *Burrow-Giles* remains the touchstone of copyright protection today."¹⁷ The *Feist* opinion further blurs the concept of originality in relation to authorship by two quotations from *Nimmer* to the effect that, "'originality is a statutory as well as a constitutional requirement [and] a modicum of intellectual labor . . . clearly constitutes an essential constitutional element.'"¹⁸

This misplaced emphasis on originality in the *Feist* opinion becomes apparent when the opinion undertakes to apply this concept as the rationale for the unprotectability of facts. Despite its stated intention, the opinion rests the denial of protection to facts on authorship (in this case the absence thereof). Despite its prior extended discourse on originality as the primary, if not the sole, touchstone of copyright protection, the opinion now states: "No one may claim originality as to

13. 100 U.S. 82 (1879).

14. 111 U.S. 53 (1884).

15. *Feist*, 111 S. Ct. at 1288.

16. *Id.* at 1288 (quoting *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 59-60 (1884)).

17. *Id.*

18. *Id.* (quoting 1 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT §§ 1.06[A], 1.07[C](1) (1990)).

facts. *This is because facts do not owe their origin to an act of authorship.*"¹⁹

It thus seems that the criterion of originality as the opinion uses it, incorporates the conception of authorship. Had the Court, earlier in its exposition, unbundled authorship from originality it might have furnished guidance in developing a conception of authorship relevant to compilations. Lower courts might have been given some indication of the creative conduct relevant to the protection of compilations.

The need to consider authorship as well as originality in the determination of protection is further illustrated by the Court's strained attempt to bolster the unprotectability of facts on the distinction between creation and discovery. In the Court's view, facts are unprotectable on the basis of originality because, as the Court put it, "[t]he distinction is one between creation and discovery: the first person to find and report a particular fact has not created the fact; he or she has merely discovered its existence."²⁰

This strained distinction between discovering facts and creating them is contrary to the philosopher's characterization of the scientific method and is, moreover, empty of analytical content for copyright purposes.²¹

The infelicitous example of the census taker does not advance the exposition. Firstly, census data would not be the subject matter of copyright protection under section 105, in any event.²² Secondly, that issue aside, the Court's example is unpersuasive. It states: "Census-takers . . . do not 'create' the population figures that emerge from their efforts; *in a sense*, they copy these figures from the world around them."²³ If the data that census-takers produce is as the Court states, mere copying of existing information, how is it possible that the current debate over the accuracy of the census in several large, metropolitan areas could arise?

The mischief of the *Feist* opinion is its failure to illuminate the process of gathering information. Failure to recognize that gathering the kind of information at issue in these cases involves the exercise of judgment, goes to the root of copyright protection. Thus, the *Feist* opinion in rejecting "sweat of the brow" as a basis of protection for compilations, without providing an articulate alternative, has only

19. *Id.* (citations omitted) (emphasis added).

20. *Id.*

21. M. POLLNER, MUNDANE REASON (1987); see also Jane C. Ginsburg, *Sabotaging and Reconstructing History: A Comment on the Scope of Copyright Protection in Works of History After Hoehling v. Universal City Studios*, 29 J. COPYR. SOC'Y 647 (1982).

22. 17 U.S.C. § 105 (1988).

23. *Id.* (emphasis added).

opened up the difficult question of providing a workable statutory foundation for compilations as a class of protectable subject matter.

II. THE LOWER COURTS' APPLICATION OF *Feist*

The spate of lower court decisions since *Feist* suggests the conclusion that the opinion has not provided clear direction to lower court judges. For example, in *Bellsouth Advertising & Publishing v. Donnelley Information Publishing, Inc.*,²⁴ the Court of Appeals for the Eleventh Circuit interpreted *Feist* merely to require a literal application of the statutory definition of a compilation. In finding copyright protection for plaintiff's yellow page telephone directory and infringement by the defendant's use of that directory to solicit advertisers and to produce a competing directory, the court interpreted *Feist* as extending protection to the format of a compilation. The Eleventh Circuit then announced the existence of a protectable format and found infringement. That court undertook no description or analysis of the protectable format. In this opinion, the Eleventh Circuit essentially ignored any of the analysis of *Feist* and announced its conclusion in formulary fashion. Thus, it is possible some federal courts will cite *Feist*, but pay it no heed.

The decision of the Second Circuit in *Victor Lalli Enterprises, Inc. v. Big Red Apple, Inc.*²⁵ is representative of a likely trend of narrowing protection for compilations of preexisting material on the authority of *Feist*. There the court affirmed the dismissal of an infringement action by denying copyright protection to a plaintiff's compilation of horse racing statistics taken from preexisting sources. In a *per curiam* opinion, the panel interpreted *Feist* to require protection of a compilation only if there were a showing of some creativity in the process of selecting the data. As the court put it, the plaintiff was not entitled to copyright in the compilation because "[t]he format of the charts is a convention: Lalli exercises neither selectivity in what he reports nor creativity in how he reports it."²⁶ It is interesting to note that this panel of the Second Circuit has interpreted the *Feist* opinion to require authorship as an ingredient of copyright protection, notwithstanding the great stress *Feist* places on originality as the touchstone of protection.

In *Sem-Torq, Inc. v. K Mart Corp.*,²⁷ the Sixth Circuit denied copyright protection to a package of commonplace signs, e.g., "For Sale"/"For Rent," by citing *Feist*, but rested its decision primarily on a lower court finding that there was no compilation, only mere packag-

24. 933 F.2d 952 (11th Cir. 1991).

25. 936 F.2d 671 (2d Cir. 1991).

26. *Id.* at 673.

27. 936 F.2d 851 (6th Cir. 1991).

ing. However, in its reference to the *Feist* opinion, the Sixth Circuit cited the phrase from that Supreme Court opinion which characterized the white pages telephone directory as "devoid of even the slightest trace of creativity."²⁸ This reference suggests that the Sixth Circuit would interpret *Feist* to require more than a comparison of the competing works. The Sixth Circuit appears to follow the Second Circuit in the concern over authorship along with originality.

The closest reading of *Feist* comes in two Second Circuit opinions one of which rejects the Supreme Court's new definition of "original," while the other accepts it. In *Kregos v. The Associated Press*,²⁹ Judge Newman, in reversing and remanding a grant of summary judgment for the defendant, cited *Feist*, but stated the standard for protection of a compilation in traditional terms. Thus, he wrote, "[to determine copyrightability] the first issue would be whether Kregos could demonstrate originality, *i.e.*, persuade the trier that he had not copied Even if Kregos could satisfy that burden, the issue would then arise as to whether . . . it could be said that Kregos' selection was insufficiently creative" ³⁰ Judge Newman clearly distinguished originality from authorship.

Judge Winter, however, in a yellow pages directory case, *Key Publications, Inc. v. Chinatown Today Publishing Enterprises, Inc.*,³¹ did adopt and apply the *Feist* definition of originality to support copyright protection, stating, "we are concerned with whether the arrangement of . . . [plaintiff's work], viewed in the aggregate, is original. We believe it is. The arrangement is in no sense mechanical, but involved creativity . . . in deciding which categories to include and under what name."³² Elsewhere in the opinion Judge Winter does require creativity, but within the *Feist* formulation of originality as the ultimate factor in protection of compilations.

If, as has historically been the case, the Second Circuit tends to dominate the development of copyright law, these opinions, albeit a most limited sample, suggest that the constitutional gloss given originality in *Feist* will not become a beacon of analysis akin to Judge Learned Hand's abstractions test. Rather, the impact of *Feist* is more likely to be noted in more limited protection for directories without an express refinement of the doctrinal basis.

28. *Id.* at 854 (quoting *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 111 S. Ct. 1282, 1296 (interim ed. 1991)).

29. 937 F.2d 700 (2d Cir. 1991).

30. *Id.* at 705

31. 945 F.2d 509 (2d Cir. 1991).

Looking beyond directories, it does not require exceptional prescience to expect that the express rejection of the "sweat of the brow" doctrine will recast the scope of protection in the map cases. It remains to be seen whether the demise of the "sweat" rationale will modify the judicial view of *Rockford Map Publishers, Inc. v. Directory Service Co. of Colorado, Inc.*,³³ about the use of a protected work as a template for a competing map. Arguably, if the effort of compiling the information is no longer protected, the bar against the use of a copyrighted map to prepare a competing work is no longer an element of infringing conduct. The originality and creativity reflected in the second work is dispositive.

A further radiation of the *Feist* opinion may serve to undercut the scope of protection of computer programs. To the extent that "structure, sequence, and organization," has become the basis of protection of software programs and screen displays, this doctrine is vulnerable because it rests copyright protection on labor and costs.³⁴

III. THE IMPACT OF *Feist* ON MISAPPROPRIATION

Because the *Feist* opinion has narrowed the scope of copyright protection of directories and kindred material, there is a renewed interest on the part of publishers of compilations in alternative means of protection. Indeed, the misappropriation doctrine is mentioned, in passing, in the *Feist* opinion itself. However, this topic also suffers from the lack of clarity already noted in other parts of the opinion. In an unnumbered footnote, the United States Supreme Court cites *International News Service v. Associated Press*,³⁵ thus introducing the misappropriation doctrine to the discussion.³⁶ Initially, the Court seems to dismiss the misappropriation doctrine as a basis for protecting compilations, stating that "[t]he . . . [*International News Service*] Court ultimately rendered judgment . . . on noncopyright grounds that *are not relevant here*."³⁷ Yet, in a subsequent paragraph, the *Feist* opinion cites with seeming approval Nimmer and Nimmer's conclusion that

33. 768 F.2d 145 (7th Cir. 1985), *cert. denied*, 474 U.S. 1061 (1986).

34. *Whelan Assocs., Inc. v. Jaslow Dental Labs., Inc.*, 609 F. Supp. 1307 (E.D. Pa. 1985), *aff'd*, 797 F.2d 1222 (3d Cir. 1986), *cert. denied*, 479 U.S. 1031 (1987).

For a critical analysis of the developing law of protection of screen displays, see Richard H. Stern, *Legal Protection of Screen Displays and Other User Interfaces for Computers: A Problem In Balancing Incentives for Creation Against Need for Free Access to the Utilitarian*, 14 COLUM.-VLA J.L. & ARTS 283 (1990).

35. 248 U.S. 215 (1918).

36. *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 111 S. Ct. 1282, 1292 (interim ed. 1991).

“[p]rotection for the fruits of . . . research . . . may in certain circumstances be available under a theory of unfair competition.”³⁸

To the extent that the *International News Service* case may be invoked by federal courts, its scope is limited. For, the misappropriation doctrine, as articulated in the *International News Service* case, is a doctrine relevant only to customer confusion. Misappropriation as the *International News Service* Court applied it, stems from the common law tort of trademark deception or of “passing off.”³⁹ Accordingly, it is a doctrine linked to the relational interest of seller and customer. The thrust of the doctrine is to bar customer confusion by the second seller. The doctrine fits only those cases where the second seller seeks to mislead the consumer into believing that the second seller’s goods are those of the first seller.

Thus, as a doctrine, misappropriation does not reach the conduct of sellers as competitive rivals.⁴⁰ To make the misappropriation doctrine applicable to the task of defining the extent to which one seller may take and use the unprotected intellectual property of a rival, would require its reformulation. Federal courts may continue to invoke the *International News Service* doctrine of misappropriation in rival seller cases, but to do so is merely to announce judicial dissatisfaction with specific aspects of commercial conduct.⁴¹ Absent a major reformulation, the misappropriation doctrine lacks analytical content or predictive value for governing the conduct between rival sellers. It does, however, permit judges to express their own views about commercial “dirty tricks.” It is likely that misappropriation in its present form, will continue to serve this function in the federal courts.

As to the prospects for the misappropriation doctrine in state legislation, there is the added problem of federal preemption. Instead of its cryptic comments about misappropriation, the *Feist* opinion might better have addressed the legislative history of section 301 as a predicate to its misappropriation reference. In the House Report to the 1976 Copyright Act, the House recognized the possibility of a version of the misappropriation doctrine that could survive the federal preemption required by section 301.⁴² Thus, the Report states:

38. *Id.* (quoting NIMMER & NIMMER, *supra* note 18, § 3.04).

39. See Leo J. Raskind, *The Misappropriation Doctrine as a Competitive Norm of Intellectual Property Law*, 75 MINN. L. REV. 875 (1991).

40. *Id.* at 885-89.

41. See *Wainright Sec., Inc. v. Wall Street Transcript Corp.*, 558 F.2d 91, 96-97 (2d Cir. 1977) (defendant’s use of competitor’s literary property described by the court as blatantly self-serving and chiseling for personal profit).

42. H. REP. NO. 94-1476, 94th Cong., 2d Sess. 132 (1976), *reprinted in* 1976 U.S.C.C.A.N.

“Misappropriation” is not necessarily synonymous with copyright infringement, and thus a cause of action labeled as “misappropriation” is not preempted if it is in fact based neither on a right within the general scope of copyright as specified by section 106 nor on a right equivalent thereto. For example, state law should have the flexibility to afford a remedy (under traditional principles of equity) against a consistent pattern of unauthorized appropriation by a competitor of the facts (i.e., not the literary expression) constituting “hot” news, whether in the traditional mold of . . . [the *International News Service* case], or in the newer form of data updates from scientific, business, or financial data bases. Likewise, a person having no trust or other relationship with the proprietor of a computerized data base should not be immunized from sanctions against electronically or cryptographically breaching the proprietor’s security arrangements and accessing the proprietor’s data.⁴³

This legislative statement clearly minimizes the scope of a state misappropriation statute. Such a statute must not describe a “right within the general scope of copyright” or a right equivalent to any of the section 106 rights. Moreover, according to the House Report, such a statute may proscribe only “a consistent pattern of unauthorized appropriation by a competitor,” of the facts (not literary expression) of “hot” news. To the extent that Congress envisioned state misappropriation legislation, it seems to have restricted it to a bar against a consistent pattern of unauthorized taking of current data (data updates), implying that “old and cold” data must remain within the domain of the copyright statute.

Subsequently, the Supreme Court has decided a group of cases involving state unfair competition statutes that further narrowed the ambit of state misappropriation legislation.⁴⁴ Its most recent opinion is

43. *Id.* An earlier version of section 301 and the correlative legislative history would have given wider ambit to state misappropriation laws. This version was defeated during floor debate in response to objection from the Antitrust Division of the Department of Justice that this version would constitute an inappropriate invitation for states to enact anticompetitive legislation. For a discussion of this episode, see Henry David Fetter, *Copyright Revision And The Preemption of State Misappropriation Law: A Study in Judicial and Congressional Interaction*, 25 BULL. COPPR. SOC’Y 367, 418-24 (1978).

44. See *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141 (1989) (striking down a Florida statute barring copying of boat hulls by use of a molding process); *Kewanee Oil Co. v. Bicron Corp.*, 416 U.S. 470 (1974) (Ohio’s trade secret law upheld as not protecting a tenable subject matter or contravening federal patent policy); *Goldstein v. California*, 412 U.S. 546 (1973) (permitting California legislation to bar record disc piracy since these were unprotected by the 1909 copyright statute); *Compco Corp. v. Day-Brite Lighting, Inc.*, 376 U.S. 234 (1964) (invalidating an Illinois unfair competition law making illegal the copying of unpatented lamps); *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225 (1964); see also Howard B. Abrams, *Copyright Misappropriation and Preemption: Constitutional and Statutory Limits of State Law Protection*, 1983 SUP. CT. REV. 509; Symposium, *Product Simulations: A Right Or A Wrong?*, 64

quite clear. Justice O'Connor's opinion in *Bonito Boats, Inc. v Thunder Craft Boats, Inc.*,⁴⁵ invalidated a Florida statute that made it unlawful "to use the direct molding process to duplicate for the purpose of sale any manufactured vessel hull, or component part"⁴⁶ The breadth of this opinion virtually ends the prospect for a viable state misappropriation statute to protect the elements of data bases that are outside copyright protection. The opinion states: "We believe that the Florida statute . . . so substantially impedes the public use of the otherwise unprotected design and utilitarian ideas embodied in unpatented boat hulls as to run afoul of the teaching of . . . *Sears and Compco*."⁴⁷ Moreover, this opinion further restricts the scope of the misappropriation doctrine by recognizing its origin. The opinion continues: "The law of unfair competition has its roots in the common-law tort of deceit: its general concern is with protecting *consumers* from confusion as to source [T]he focus is on the protection of consumers, not the protection of producers :"⁴⁸

Based on *Bonito Boats*, it is unlikely that a state statute controlling conduct between competitors would survive federal preemption in a copyright case. Consider, as an example, the following hypothetical state statute that made it unlawful:

[T]o appropriate information in print, electronic, or other form, that has been gathered at effort, cost, or expense by its possessor, for the purpose of sale, rental, or other dissemination This provision shall apply only to material that is outside the scope of protection under any federal statute.⁴⁹

This statute would likely be impaled on the major premise of *Bonito Boats* that bars an impediment to the public use of an otherwise unpatentable design. After *Feist*, facts are clearly unprotected by copyright. Moreover, the operative language of the hypothetical statute, notwithstanding its last sentence, gives rights that are equivalent to section 106 of the Copyright Statute.⁵⁰ The word, "appropriate" in the hypothetical statute when applied to information, requires replication, and replication is an equivalent of reproduction, a right given under section 106; the derivative work right of section 103 would also be involved in the use of the appropriated material. Similarly, the condition of sale or rental of the appropriated material, so closely approximates

45. 489 U.S. 141 (1989).

46. *Id.* at 143.

47. *Id.* at 146.

48. *Id.*

49. It is assumed that federal jurisdiction would be grounded in the Congressional power to regulate commerce.

the distribution right of section 106, as to be considered an equivalent. Although there cannot be absolute certainty as to the fate of such proposed legislation, there are clearly grounds for a challenge to the hypothetical statute on grounds of preemption.

Were federal legislation to be proposed to protect data bases, it most likely would be by an amendment to the Lanham Act, section 43(a).⁵¹ As noted above, a refined definition of "appropriation" would be required, because section 43(a) has its roots in consumer deception. A reformulated statement of actionable "appropriation" would be needed to address the relational interest of competitors. Such an exercise would become ensnared in a statement of "fair" competition and a reminder of the objection of the Antitrust Division of the Department of Justice to a version of section 301 of the then proposed Copyright Act, as encouraging anticompetitive legislation by states.⁵² One commentator on the misappropriation doctrine has described the difficulty of proscribing a competitor's taking of unprotected intellectual property as the "utter impossibility of having any general principle against appropriation of published trade values. The courts have thoroughly rejected any broad principle of unfair competition based on the mere adoption, copying, imitation or use of trade values which have successfully reached the market."⁵³

Further doubt as to the viability of a proposal for federal legislation to protect data bases may be drawn from the protracted, unsuccessful history of kindred legislation dealing with design protection.⁵⁴ Moreover, there does not yet seem to be the requisite appearance of interest groups to sponsor such legislation.⁵⁵ At present, the prospect of a legislative response to the *Feist* decision seems remote.

51. 15 U.S.C. § 1125 (1988).

52. See *Bonito Boats*, 489 U.S. 141 (striking down a Florida statute barring copying of boat hulls by use of a molding process); *Kewanee Oil Co. v. Bicron Corp.*, 416 U.S. 470 (1974) (Ohio's trade secret law upheld as not protecting a tenable subject matter or contravening federal patent policy); *Goldstein v. California*, 412 U.S. 546 (1973) (permitting California legislation to bar record disc piracy since these were unprotected by the 1909 copyright statute); *Compco Corp. v. Day-Brite Lighting, Inc.*, 376 U.S. 234 (1964) (invalidating an Illinois unfair competition law making illegal the copying of unpatented lamps); *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225 (1964). See generally *Abrams*, *supra* note 43; Symposium, *supra* note 43.

53. See James A. Rahl, *The Right To Appropriate Trade Values*, 23 OHIO ST. L.J. 56, 57 (1962).

54. A proposal for design protection was initially included as Title II of the 1976 Copyright Revision measure and not enacted. Since 1985, there have been several proposals for similar protection, all unsuccessful. For a review of this history, see Ralph S. Brown, *Copyright-Like Protection for Designs*, 19 U. BALT. L. REV. 308 (1989).

55. For a review of the literature describing the role of interest groups in the legislative process, see Einer R. Elhauge, *Does Interest Group Theory Justify More Intrusive Judicial Review?*, 101 YALE L.J. 31, 35-44 (1991).

A more likely response is in the management arena. As legal protection for data is limited by *Feist*, managers of enterprises dealing in print and electronic data will doubtlessly begin to review both their product lines and their market positions as against their present and potential competitors. Such a review could well lead to decisions by managers to undertake substantial improvement and enhancement of existing products as a means of fending off loss of sales. This perspective might have the added consequence of accelerating research for the improvement of existing products and the development of new ones. As part of this process, price competition might be stimulated, an outcome not necessarily detrimental to the public interest. As part of such a management review, it is also likely that renewed attention will be given to contractual arrangements to obtain some protection. There might then be expanded use of shrink-wrap licenses, direct subscription agreements, and contracts of adhesion. This response raises a cluster of issues beyond the scope of this paper.