

1-1-1992

What's Mine Is Yours? The Dilemma of a Factual Compilation

James E. Schatz

Bradley W. Anderson

Holly Garland Langworthy

Follow this and additional works at: <https://ecommons.udayton.edu/udlr>



Part of the [Law Commons](#)

Recommended Citation

Schatz, James E.; Anderson, Bradley W.; and Langworthy, Holly Garland (1992) "What's Mine Is Yours? The Dilemma of a Factual Compilation," *University of Dayton Law Review*. Vol. 17: No. 2, Article 11.
Available at: <https://ecommons.udayton.edu/udlr/vol17/iss2/11>

This Symposium is brought to you for free and open access by the School of Law at eCommons. It has been accepted for inclusion in University of Dayton Law Review by an authorized editor of eCommons. For more information, please contact mschlange1@udayton.edu, ecommons@udayton.edu.

WHAT'S MINE IS YOURS? THE DILEMMA OF A FACTUAL COMPILATION*

James E. Schatz,** Bradley W. Anderson,*** and Holly Garland Langworthy****

I. INTRODUCTION

Copyright law seeks to balance the right of authors to have their works protected and the public's need to have access to such works. One of the many kinds of works protected by the copyright law is factual compilations. Compilations generally involve selection, collection, assemblage, coordination, and arrangement of facts in a way useful to the public.

To a compiler, perhaps the most useful invention of the post-war period is the computer. Computers allow vast databases to be assembled, stored, and retrieved. Using a personalized search, a computer database allows the user to choose the particular data the user wishes to retrieve, whereas a hard copy compilation forces the user to visually search the compilation or at least a portion of it.

Databases are considered compilations under current federal copyright law, namely the Copyright Act of 1976. The protection granted to a database is for the selection of the data to be stored in the database, the coordination of the data so selected, and the arrangement of the data within the database. The effort and investment expended to create the database are not separately protected under copyright law. Since federal copyright law does not presently offer such protection, database developers may have to look to new federal law and/or state statutes and common law for appropriate protection of their databases.

This paper presents an overview of copyright law as applicable to factual compilations such as databases. It describes the protection afforded such compilations under the recent Supreme Court decision in *Feist Publications, Inc. v. Rural Telephone Service Co.*¹ and recent cases following *Feist*. It also briefly responds to some of the points

* © 1991 by Opperman, Heins & Paquin.

** Partner, Opperman, Heins & Paquin; B.A., Macalester College, 1968; J.D., University of Minnesota Law School, 1972.

*** Partner, Opperman, Heins & Paquin; B.S., University of Minnesota, 1981; J.D., University of Minnesota Law School, 1984.

**** Associate, Opperman, Heins & Paquin; B.A., Northern Illinois University, 1984; J.D., The John Marshall School of Law, 1988; LL.M (Intellectual Property), The John Marshall School of Law, 1991.

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

made by Professor Patterson in his paper on the expansion of copyright into "neo-copyright" and Professor Raskind in his paper on *Feist*. The paper concludes that *Feist* and its progeny may not offer the protection a compiler needs in order to have the incentive to create useful and needed factual compilations. Finally, it examines whether state law may protect aspects of compilations that are not protected under federal copyright law.

II. HISTORY OF THE COPYRIGHTABILITY OF COMPILATIONS

A. *Copyright and Patent Clause and Early Statutes*

In 1789, the Framers of the Constitution empowered Congress in the Copyright and Patent Clause 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."² Congress quickly enacted the Copyright Act of 1790 to protect, for a limited period of time, original works of authorship such as books, maps, and charts.

Since this first copyright statute, copyright protection has been broadened to protect new technologies and forms of works. From protection in the nineteenth century for maps, charts, prints, engravings, musical compositions, dramatic compositions, photographs, paintings, drawings, and sculptures to protection in the twentieth century for phonorecords, motion pictures, and computer programs, new technologies have been added to the list of copyrightable formats.³

B. *1909 Act*

1. Originality

There were two components to the originality standard of the 1909 Act: independent creation and a minimal level of creativity. These components were derived from the terms "author" and "writings" in the Copyright and Patent Clause. Both of these terms were explained by the Supreme Court in the late nineteenth century. The Court defined an "author" as "he to whom anything owes its origin; originator; maker."⁴ Similarly, the term "writings" was held to require a minimal degree of creativity.⁵ The Court stated that "while the word *writings* may be liberally construed, as it has been, to include original designs for engraving, prints, &c., it is only such as are *original*, and are

2. U.S. CONST., art. I, § 8, cl. 8.

3. Jane C. Ginsburg, *Creation and Commercial Value: Copyright Protection of Works of Information*, 90 COLUM. L. REV. 1865, 1885 n.69 (1990).

4. *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 58 (1884).

5. *The Trademark Cases*, 100 U.S. 82 (1879).

founded in the creative powers of the mind. The writings which are to be protected are *the fruits of intellectual labor*."⁶

2. Level of Creativity Required

In 1903, the Court clarified the amount of creative intellectual effort a work needed to meet the constitutional requirement of originality.⁷ The Court determined that it is not the role of a judge to weigh the artistic quality or worth of a particular work.⁸ Thus, only a slight degree of intellectual labor or creativity need be present for a work to be considered original.⁹

3. Compilations

Section 5 of the 1909 Act specifically included compilations as a category of works which could be protected. However, one of the fundamental doctrines of copyright law is that facts cannot be copyrighted. Facts are in the public domain; they are neither original nor are they creatively authored.¹⁰ While facts themselves are not copyrightable, the 1909 Act made it clear that a compilation of facts could satisfy the originality requirement.¹¹ The copyright in a factual compilation therefore extended to the original selection, coordination, or arrangement of facts, but it did not extend to the facts themselves.

However, due to ambiguous language in the 1909 Act,¹² some courts effectively granted protection to the "industrious collection" of facts. In effect, if a collection of data had been independently assembled by a compiler, it could not be copied by a competitor. The courts did not examine the compiler's selection, coordination, or arrangement decisions; they simply protected the collection of data.¹³

The "industrious collection" doctrine, also called "sweat of the brow," was thought by some to expand copyright protection to the facts themselves. The only true shield to a claim of infringement of a factual

6. *Id.* at 94 (emphasis in original).

7. *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239 (1903).

8. *Id.* at 251-52.

9. *See, e.g.*, *Universal Athletic Sales Co. v. Salkeld*, 511 F.2d 904, 908 (3d Cir), *cert. denied*, 423 U.S. 863 (1975); *Drop Dead Co. v. S.C. Johnson & Son, Inc.*, 326 F.2d 87, 92 (9th Cir. 1963), *cert. denied*, 377 U.S. 907 (1964); *Alfred Bell & Co. v. Catalda Fine Arts, Inc.*, 191 F.2d 99 (2d Cir. 1951).

10. *Feist*, 111 S. Ct. at 1288; *see also* Robert C. Denicola, *Copyright in Collections of Facts: A Theory for the Protection of Nonfiction Literary Works*, 81 COLUM. L. REV. 516, 525 (1981).

11. *Feist*, 111 S. Ct. at 1291; *see also* Denicola, *supra* note 10, at 523 n. 38.

12. Section 5 of the 1909 Copyright Act permitted protection for a compilation, but only if it were *original* (which was not explicitly stated in Section 4 of the 1909 Act).

13. *See, e.g.*, *Leon v. Pacific Tel. & Tel. Co.*, 91 F.2d 484 (9th Cir. 1937); *Jeweler's Circular Publishing Co. v. Keystone Publishing Co.*, 281 F. 83 (2d Cir. 1922).

compilation protected under the "industrious collection" doctrine was independent creation by the second compiler.¹⁴

C. 1976 Act

When Congress enacted the Copyright Act of 1976, it replaced the 1909 Act's phrase "all the writings of an author" with the phrase "original works of authorship."¹⁵ However, Congress intended to incorporate into the 1976 Act the standard of originality established by the courts in interpreting the 1909 Act.¹⁶ Thus, to qualify for copyright protection, a work still needed to be independently created by an author and possess a minimal degree of creativity.¹⁷

1. Compilation Defined

Unlike the 1909 Act, Congress expressly included a definition of "compilation" in the 1976 Act. The Act defines a compilation as "a work formed by the collection and assembling of pre-existing 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."¹⁸

2. Protection Afforded Compilations

Under the 1976 Act, the copyrightability of a compilation depends upon whether it is an "original work[] of authorship."¹⁹ Thus, original selection, coordination, and arrangement of factual materials continues to receive protection. While the 1976 Act attempted to clarify the originality requirements necessary to achieve copyright protection, the "industrious collection" standard of originality continued to be applied by the courts.²⁰

14. *Feist*, 111 S. Ct. at 1291.

15. 17 U.S.C. § 102(a) (1982).

16. H.R. REP. NO. 1476, 94th Cong., 2d Sess. 51 (1976).

17. 1 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT §§ 2.01[A], [B] (1991).

18. 17 U.S.C. § 101 (1988).

19. *Id.* § 102(a).

20. See, e.g., *Hutchinson Tel. Co. v. Fronteer Directory Co.*, 770 F.2d 128 (8th Cir. 1985); *United Tel. Co v. Johnson Publishing 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); *National Business Lists, Inc. v. Dun & Bradstreet, Inc.*, 552 F. Supp. 89 (N.D. Ill. 1982); *Northwestern Bell Tel. Co. v. Bedco of Minnesota, Inc.*, 501 F. Supp. 299 (D. Minn. 1980); *Northwestern Tel. Sys. Inc. v. Local Publications, Inc.*, 208 U.S.P.Q. (BNA) 257 (D. Minn. 1979).

III. *Feist* AND ITS PROGENY

The Supreme Court's decision in *Feist* clarified much of the law regarding copyright protection for factual compilations. The *Feist* decision discusses the history of protection of factual compilations under federal copyright law and reaffirms that compilations are within the subject matter of copyright. The decision distinguishes the originality requirement for compilations from the protection granted by courts under the "sweat of the brow" doctrine and disavows protection for compilations under that doctrine. Finally, the opinion gives some limited guidance on how to determine whether a factual compilation contains the minimal creativity required for copyright protection.

The Court first held that the Constitution requires a work to be original in order to be protected by copyright. This is the first time it has been explicitly stated that originality is a *constitutional* requirement. To be original, a work must be created by the author and must possess "at least some minimal degree of creativity."²¹ Because facts can never be original to an author, they are unprotectible by copyright. Factual compilations, on the other hand, are copyrightable if they possess the constitutional requirement of originality. The Court examined the elements of compilations of facts which could be considered original:

The compilation author typically chooses which facts to include, in what order to place them, and how to arrange the collected data so that they may be used effectively by readers. These choices as to selection and arrangement, so long as they are made independently by the compiler and entail a minimal degree of creativity, are sufficiently original that Congress may protect such compilations through the copyright laws. Thus, even a directory that contains absolutely no protectible written expression, only facts, meets the constitutional minimum for copyright protection if it features an original selection or arrangement. . . . Where the compilation author adds no written expression but rather lets the facts speak for themselves, the expressive element is more elusive. The only conceivable expression is the manner in which the compiler has selected and arranged the facts. Thus, if the selection and arrangement are original, these elements of the work are eligible for copyright protection.²²

The Court therefore concluded that, in the absence of original written expression, "only the compiler's selection and arrangement [of factual material] may be protected."²³

21. *Feist*, 111 S. Ct. at 1287.

22. *Id.* at 1289 (citations omitted).

The Court then examined whether the definition of compilation contained in section 101 of the Copyright Act complied with the constitutional requirements of originality discussed above. The Court noted that "the statute dictates that the principal focus should be on whether the selection, coordination, and arrangement are sufficiently original to merit protection."²⁴ In analyzing the level of creativity required for protection of a compilation, the Court concluded:

Not every selection, coordination, or arrangement will pass muster. . . . A compiler may settle upon a selection or arrangement that others have used; novelty is not required. Originality requires only that the author make the selection or arrangement independently (*i.e.*, without copying that selection or arrangement from another work), and that it display some minimal level of creativity. Presumably, the vast majority of compilations will pass this test, but not all will.²⁵

The Court distinguished the constitutionally mandated requirement of originality from the "sweat of the brow" doctrine and concluded that the doctrine had arisen from "ambiguous language" in the 1909 Act.²⁶ Section 5 of the 1909 Act listed several categories under which a work might be classified on the application:

One of these categories was "[b]ooks, including composite and cyclopaedic works, directories, gazetteers, and other compilations." . . . [T]he fact that factual compilations were mentioned specifically in § 5 led some courts to infer erroneously that directories and the like were copyrightable *per se*, "without any further or precise showing of original—personal—authorship."²⁷

According to the Court, "the 'sweat of the brow' doctrine flouted basic copyright principles" and resulted in the "hand[ing] out [of] proprietary interests in facts."²⁸ The Court concluded that protection for "sweat of the brow" was not a proper reading of the 1909 Act, and it held that only a compiler's original expression in the selection, coordination, or arrangement of facts could be protected.

The Court proceeded to determine whether the white pages telephone directory at issue contained an original selection and arrangement of facts. In analyzing the selection and arrangement of the listings in Rural's directory, the Court cautioned that "the selection and arrangement of facts cannot be so mechanical or routine as to require

24. *Id.* at 1294.

25. *Id.*

26. *Id.* at 1290.

27. *Id.* at 1291 (citations omitted).

no creativity whatsoever.”²⁹ The Court noted that Rural’s white pages were “entirely typical . . . a garden-variety white pages directory”³⁰ which seems to indicate that a work which has a well-established, traditional arrangement is less likely to be considered minimally creative.

According to the Court, “Rural’s selection of listings could not be more obvious: it publishes the most basic information . . . about each person who applies to it for telephone service.”³¹ Further, because Rural included *all* of its subscribers in its directory (as it was required to do by state law), the Court concluded that no protectible expression was present in Rural’s selection of facts.

Finally, with respect to Rural’s arrangement of its subscriber listings in alphabetical order, the Court declared that:

[T]here is nothing remotely creative about arranging names alphabetically in a white pages directory. It is an age-old practice, firmly rooted in tradition and so commonplace that it has come to be expected as a matter of course. . . . It is not only unoriginal, it is practically inevitable. This time-honored tradition does not possess the minimal creative spark required by the Copyright Act and the Constitution.³²

Feist, therefore, explicitly made originality a constitutional requirement, abolished the “sweat of the brow” doctrine, and concluded that copyright protection for a factual compilation would extend only to the compiler’s original selection, coordination, or arrangement.

In the months since *Feist* was handed down, a number of cases involving factual compilations have been decided. In deciding these cases, the courts involved generally have been quite sensitive in examining the selection, coordination, and arrangement activities of compilers and in applying the creativity/originality test of *Feist*.

The Second Circuit reversed a grant of summary judgment against a compiler in *Kregos v. The Associated Press*,³³ holding that the compiler was entitled to a trial on the issue of whether his pitching forms met the required creativity standard. Kregos distributes a pitching form that displays information highlighting the past performance of the opposing pitchers scheduled to start each day’s baseball games. Kregos’ compilation contains nine items of information concerning a pitcher’s performance. These nine items are arranged into four categories. The first category in Kregos’ form, performance during the entire season,

29. *Id.* at 1296.

30. *Id.*

31. *Id.*

32. *Id.* at 1297.

comprises two items: won/lost record and earned run average. The second category, performance during the entire season against the opposing team at the site of the game, comprises three items: won/lost record, innings pitched, and earned run average. The third category, performance in the last three starts, comprises four items: won/lost record, innings pitched, earned run average, and men on base average. This last item is the average total of hits and walks given up by a pitcher per nine innings of pitching. Kregos argued that his compilation is "an outcome predictive pitching form"³⁴ in that he has selected the pitching statistics that he thinks are the most important to newspaper readers when they are making their predictions on the games of the day.

The court concluded that it could not be said as a matter of law that Kregos' selection of statistics lacked the required creativity. The court looked to the number of pitching-related statistics which *could be* selected from a box score, but which were not selected by Kregos, such as strikeouts and walks. Further, Kregos could also have included such facts as the number of innings in which the opposing side was retired in order, and statistics on pitching under pressure. The court concluded that there were "scores of available statistics about pitching performance available to be calculated . . . and therefore thousands of combinations of data that a selector can choose to include in a pitching form."³⁵

Copyright protection was not extended to a publisher of charts comprised of the "lucky numbers" derived from gambling operations in *Victor Lalli Enterprises v. Big Red Apple, Inc.*³⁶ Lalli published a chart called "Val's Original Genuine Black Cat Weekly Card" which contained winning numbers, determined by gambling activity at local race tracks. The chart showed the last three digits of the total sum of money bet each day at New York race tracks for the past thirteen months. The numbers were displayed with the months of the year in a row across the top of the chart and the days of the month, from one to thirty-one, in a vertical column. There were numerous publishers of these charts. The information in these competing charts did not vary at all, unless a publisher made a mistake and inserted the wrong number. The court held that Lalli's selection, coordination, or arrangement of these numbers failed to meet the creativity requirement. The court noted that Lalli arranged the factual data into "purely functional grids

34. *Kregos v. The Associated Press*, 731 F. Supp. 113, 119 (S.D.N.Y. 1990), *rev'd in part*, 937 F.2d 700 (2d Cir. 1991).

35. *Kregos*, 937 F.2d 700, 704 (2d Cir. 1991).

36. *Victor Lalli Enterprises v. Big Red Apple, Inc.*, 937 F.2d 700, 704 (2d Cir. 1991).

that offer no opportunity for variation."³⁷ Thus, the selection and arrangement of these charts, like the selection and arrangement of Rural's listings, was considered to be "mechanical," "conventional," "garden variety," and hence not protectible.³⁸

In *Bellsouth Advertising & Publishing Corp. v. Donnelley Information Publishing, Inc.*³⁹ the court held that a yellow pages directory was sufficiently original to be protected by copyright. In creating the work, Bellsouth Advertising & Publishing Corp. (BAPCO) selected the boundaries encompassed in the directory, the close date to stop adding new entries and the particular categories in which to list the various businesses. Then, BAPCO coordinated all current information on a business into a complete business listing, including the name of the business, business address, and phone number. Finally, BAPCO arranged these coordinated listings according to its business classifications. The court held that these acts of selection, coordination, and arrangement met the requisite level of originality. The court stated: "[b]ecause the Yellow Pages directory published by BAPCO provides a convenient, unique organization of business listings and advertisements, it merits originality."⁴⁰

*U.S. Payphone, Inc. v. Executives Unlimited of Durham, Inc.*⁴¹ involved a compilation of information about state regulations regarding pay telephones. U.S. Payphone created the "Payphone Magazine Reference Guide" containing a 51-page Tariff Section which "summarized the state tariffs regulating the fees payable to telephone utilities by owners and operators of pay telephones."⁴²

The court determined that U.S. Payphone exercised "subjective judgement and selectivity"⁴³ in condensing over 2700 pages of state tariff documents into a single page per state format. The court concluded that this Tariff Section could have been arranged in "many different ways."⁴⁴ The reduction of 2700 pages of documents into the 51-page format involved a significant degree of original selection, coordination, and arrangement. Thus, the resulting compilation could be protected by copyright.

Finally, in *Key Publications, Inc. v. Chinatown Today Publishing Enterprises*,⁴⁵ the Second Circuit addressed the copyright protection to

37. *Id.* at 673.

38. *Id.*

39. 933 F.2d 952 (11th Cir. 1991).

40. *Id.* at 958.

41. 18 U.S.P.Q. 2d (BNA) 2049 (4th Cir. 1991).

42. *Id.* at 2050.

43. *Id.*

44. *Id.*

45. 945 F.2d 309 (2d Cir. 1991).

be accorded a yellow pages directory of Chinese-American businesses aimed at the New York City market. In compiling its directory, plaintiff collected business cards from professionals affiliated with the Chinese-American community, companies that did business in the New York Chinese-American community, and other organizations it thought ought to be included in a Chinese-American yellow pages directory for the New York area. The plaintiff's directory contained 260 different categories describing the businesses in the community. The directory contained a total of 9000 listings for which plaintiff included an English and a Chinese name, address, and telephone number. The defendant's yellow page directory was much smaller. Defendant's directory contained approximately 2000 listings sorted into only 28 categories. However, 75% of defendant's listings had been copied from plaintiff's directory. This copying amounted to about 17% of plaintiff's directory.

The court defined selection as "the exercise of judgement in choosing which facts from a given body of data to include in a compilation."⁴⁶ Plaintiff had to select from the vast number of businesses in the New York metropolitan area those businesses of greatest interest to its targeted market, the New York City Chinese-American community. In addition, the court concluded that plaintiff showed thought and creativity in the selection of the businesses for the directory because it excluded certain businesses which it judged would not remain open for very long, such as insurance brokers, take-out restaurants and traditional Chinese medical practitioners.

The court also found original arrangement in the plaintiff's directory: "arrangement 'refers to the ordering or grouping of data into lists or categories that go beyond the mere mechanical grouping of data as such, for example, the alphabetical, chronological, or sequential listings of data.'"⁴⁷ The court reviewed the 260 categories in plaintiff's directory, noting that many of these categories were not common to other yellow pages directories. For example, a heading such as "Bean Curd & Bean Sprout Shops" was of specific interest to the Chinese-American community and evidenced creativity in the categorized arrangement. The court concluded that the arrangement of the directory was "in no sense mechanical, but involved creativity on the part of [plaintiff] in deciding which categories to include and under what name."⁴⁸

46. *Id.* at 513 (citing William Patry, *Copyright in Compilations of Facts (or Why the "White Pages" are not Copyrightable)*, 12 *Comm. & L. Dec.* 57 (1990)); see also *Eckes v. Card Prices Update*, 736 F.2d 859, 862-63 (2d Cir. 1984).

47. *Key Publications*, 945 F.2d at 513 (quoting Copyright Office, *Guidelines for Registration of Fact-Based Compilations* 1 (Rev. Oct. 11, 1989)), quoted in Patry, *supra* note 46, at 60.

<https://ecommons.cmu.edu/handle/document/14/iss2/11>

However, while the court found sufficient originality in plaintiff's directory, it did not find infringement by defendant. The court posed the question as follows: "if the [defendant's directory] is substantially similar to [plaintiff's directory] with regard to [plaintiff's] arrangement of categories and [plaintiff's] selection of businesses, then a finding of infringement can be supported."⁴⁹

The court determined that the arrangement of defendant's directory was not "even remotely similar"⁵⁰ to the plaintiff's directory. The plaintiff's directory contained 260 different categories while the defendant's contained only 28 different categories. Only 3 of the 28 categories duplicated categories in the plaintiff's directory.

The court also found no infringement of plaintiff's selection despite the fact that 75% of the defendant's directory was copied from plaintiff's directory. The court noted that the copied listings did not come primarily from any particular portion of the plaintiff's directory and that only 17% of the plaintiff's listings were copied. The court concluded that "[t]he key issue is not whether there is overlap or copying [of listings] but whether the organizing principle guiding the selection of businesses for the two publications is in fact substantially similar."⁵¹

As can be seen, the courts in these post-*Feist* decisions diligently examined whether a factual compilation contains an original selection, coordination, or arrangement of factual material and whether the alleged infringer has copied that creativity. Thus, it is clear that the lower courts are not "consistently providing copyright protection"⁵² for public domain materials as Professor Patterson argues in his paper. Instead, the lower courts are providing protection *only* for the original contribution of the compiler.

Nevertheless, the admittedly "thin" copyright protection which *Feist* accords to factual compilations with little original expression, and the requirement that a compiler demonstrate a minimal degree of creativity in its selection, coordination, or arrangement of factual material may make copyright too uncertain a vehicle for compilers to rely upon. Many compilations (especially databases) require the investment of vast amounts of time and effort in order to collect and assemble the data. These are generally continuing costs because compilations tend to require frequent updates in order to have value to users. Often these compilations are intended to be comprehensive collections of data on a particular subject, and, as a result of *Feist*, their comprehensiveness

49. *Id.* at 515.

50. *Id.*

51. *Id.* at 516.

52. L. Ray Patterson, *Copyright Overextended: A Preliminary Inquiry into the Need for a General Statute on Unfair Competition*, 17 U. DAYTON L. REV. 385 (1991).

may be used against them in determining whether the compiler exercised original "selection" in creating the work. Further, it may be difficult to demonstrate any meaningful original arrangement of data contained within a computer database; the arrangement of data may tend to be important only from a computer science standpoint.

Worse still, electronic databases, though difficult and expensive to create, may be extremely cheap to steal. Pirates may be able to simply download huge amounts of data—in convenient machine-readable form—directly from the database. In such circumstances, the fact that the compiler's original selection, coordination, or arrangement may be protected, but not the labor expended and investment made in collecting and assembling the data included in the compilation, may give little or no real comfort. While courts probably will be receptive to demonstrations of a compiler's original selection, coordination, or arranging activities, the parameters of the protection granted to these efforts may not be enough to maintain the incentive needed to create certain types of factual compilations.

Professor Raskind's observation that the Supreme Court in *Feist* is instructing lower courts to "compare the contents of the compilation to public domain material"⁵³ has already surfaced in several recent decisions. The analysis in several post-*Feist* cases involving factual compilations has included a comparison of the plaintiff's compilation with competing works in the marketplace in order to determine if "originality" is present. Thus, in *Kregos*, the Second Circuit compared the selection of pitching statistics in plaintiff's form to the statistical selection in other pitching forms in analyzing the creativity displayed in plaintiff's selection.⁵⁴ Similarly, in *Victor Lalli Enterprises*, the court reviewed the charts of other publishers of "lucky numbers" and concluded that the form of the plaintiff's chart was "a convention" and hence not original.⁵⁵

Professor Raskind's point that *Feist*'s focus upon the non-protectibility of "facts" distorts the inquiry of whether a compilation contains originality also has merit. Certainly, there is little in the *Feist* opinion which would give guidance as to how to characterize, for authorship purposes, a compiler's initial decision to create, for example, a comprehensive directory of congressional staff in Washington, D.C.—a decision which truly involves "the creative conduct of authorship."

As Professor Raskind notes, the *Feist* Court's conclusion that facts are not original because they are discovered, not created, will only

53. Leo Raskind, *Assessing the Impact of Feist*, 17 U. DAYTON L. REV. 331 (1991).

54. *Kregos v. The Associated Press*, 937 F.2d 700 (2d Cir. 1991).

55. *Victor Lalli Enterprises v. Publ. Int'l Ass'n*, 937 F.2d 671 (2d Cir. 1991).

make the task of demonstrating authorship in a compilation more difficult. It would have been far more sound analytically to state that facts are not copyrightable because it is far more damaging policy for society to grant protection for the publication or use of such material, than it is to argue that such information is not protectible because it is not "original." The Court's reliance on the nostrum that "facts are not original" may result in an analytical bog.

IV. COMMENTS ON THE MEANING OF THE COPYRIGHT AND PATENT CLAUSE

Professor Patterson's fascinating efforts to uncover the Framers' "original intent" in drafting the Copyright and Patent Clause raise a number of questions and prompt several observations. Not being in a position to challenge his assertion that the "source" of the Copyright Clause was the title of the Statute of Anne, we will assume that the Statute was looked to by the drafters of the Copyright and Patent Clause. While there are undeniable similarities between the two provisions, it does seem significant that the drafters chose to use the broader term "writings"⁵⁶ instead of the more specific term "printed books"⁵⁷ that was used in the Statute of Anne.

If the Framers intended "writings" to have the more circumscribed meaning advocated by Professor Patterson, it is interesting that our first Congress, sitting only one year after the adoption of the Constitution, enacted a copyright statute which provided protection for such "writings" as maps and marine charts.⁵⁸ Professor Patterson details no objection by the President or any member of Congress (or even a Framers, for that matter) that extending copyright protection to maps and marine charts exceeded Congress' power under the Copyright and Patent Clause.

Nor does Professor Patterson identify any public challenge being raised when Congress acted to protect "writings" such as prints and engravings in 1802,⁵⁹ or photographs in 1865.⁶⁰ Such a complete lack of contemporaneous objection to Congress' decisions to extend protection to more and more types of works counsels against the conclusion that the Framers intended the word "writings" to be limited to printed works.⁶¹

56. U.S. CONST., art. I, § 8, cl. 8.

57. 8 Anne, c. 19 (1709).

58. Act of 1790, ch. 15, 1 Stat. 124-26 (1790).

59. Act of April 29, 1802, ch. 36, 2 Stat. 171-72 (1802).

60. Act of March 3, 1865, ch. 126, 13 Stat. 540-41 (1865).

61. Certainly the Supreme Court has never adopted such a narrow view of the term "writings." The Court has stated that "[t]he writings which are to be protected are the fruits of intel-

But the word “writings” differs from “printed books” on a more fundamental level, especially considering the history of English copyright law which Professor Patterson details.⁶² “Printed books” clearly exist only upon publication, whereas a “writing” exists *from the moment* it is scribbled out by its author. The English common law copyright, according to Professor Patterson’s description of *Donaldson v. Beckett*,⁶³ came into existence upon the creation of the work by the author, but lasted only until the author published the work. Assuming the Framers were cognizant of the three types of copyrights identified by Professor Patterson, their use of the term “writings” and not “printed books” in the Copyright and Patent Clause could well be viewed as a decision to allow Congress to protect an author’s work *from its inception*, which is what English common law copyright apparently did. Thus, given the history of English copyright law, the Framers’ use of the term “writings,” and not “printed books,” leads one to question whether the Copyright and Patent Clause was intended to empower Congress “to grant copyright only for published works” as Professor Patterson argues.⁶⁴

Nonetheless, it seems quite unlikely that any of the Framers could have possessed the knowledge of English copyright law which Professor Patterson ascribes to them, or that they made such major technical decisions about the future of American copyright law in the brief Copyright and Patent Clause. Specifically, it seems unlikely that the Framers were aware of (1) the policy problems with the Stationers’ copyright, (2) the Statute of Anne’s apparently crucial “separation of the work from the copyright,”⁶⁵ (3) the fact that the litigious English booksellers had “corrupted” statutory copyright “almost from its beginning” by obliterating the distinction between the work and its copyright and by creating an “author’s property right,”⁶⁶ or that, (4) in the spare twenty-seven words of the Copyright and Patent Clause, the Framers felt they were clearly re-establishing the admittedly “subtle differ-

lectual labor, embodied in the form of books, prints, engravings, and the like.” The Trade-Mark Cases, 100 U.S. 82, 94 (1879)(emphasis in original). The various decisions by Congress that the word “writings” can include such works as photographs, motion pictures, and databases seem to be nothing more than, in Justice Scalia’s words, “[t]he application of existing principles to new phenomena,” such as the application of the Fourth Amendment to electronic surveillance and the First Amendment to broadcasting. *Ollman v. Evans*, 750 F.2d 970, 1038 n.2 (D.C. Cir. 1984) (Scalia, J., dissenting).

62. Patterson, *supra* note 52, at 397-401.

63. 1 Eng. Rep. 837 (1774).

64. Patterson, *supra* note 52, at 396-403.

65. 8 Anne, c. 19 (1709).

66. Patterson, *supra* note 52, at 402-03.

ence"⁶⁷ between the Stationers' copyright (as continued by common law copyright) and the statutory copyright of the Statute of Anne. Yet, the Framers had to be aware of each of these points for Professor Patterson's argument to have force.⁶⁸

It seems more likely that the Framers intended only to make the broadest policy decisions, allowing that copyrights would be granted to authors, that they would be exclusive, and that they would exist only for limited times. The Framers likely left decisions such as whether the work would be separate from the copyright, whether copyright would exist from creation or publication, and the scope of what was a "writing" and who was an "author" to Congress in exercising its power.

In short, the level of "copyright learning" necessary to conclude that the Copyright and Patent Clause was making a very specific reference to an *earlier* regime of English copyright law (and not the regime in existence in 1789) probably was not present in a single Framers. Therefore, it is very unlikely that such a meaning could have been intended by them. At the very least, we would need far more evidence of the *Framers'* copyright erudition (as opposed to *Professor Patterson's* copyright erudition) before being able to concur with his conclusions. In sum, the Framers were mere mortals; they were not professors of copyright law.

V. STATE LAW PROTECTION OF FACTUAL COMPILATIONS

We are faced with a situation where the labor and expense necessary to create a factual compilation is not itself protected by copyright. Since the decision in *Feist* has circumscribed copyright protection for factual compilations, compilers have begun to look to state statutes and common law to protect their efforts and investments. Protection is not needed for literal expression as that is already protected by copyright. Rather, compilers are seeking protection for the huge investments in time and effort it takes to develop these works.

Feist makes clear that Congress has no power to extend *copyright* protection to collections and assemblages of facts which lack originality, however great the investment of time and labor by a compiler. This follows from the Court's conclusion that originality is a constitutional requirement for the extension of copyright protection and the Court's

67. Patterson, *supra* note 52, at 401-03.

68. Professor Patterson is less than expansive in describing the Framers level of copyright knowledge: we "cannot be sure" that the Framers were even "aware" of the common law performance copyright, and apparently the most that can be said of the Framers' knowledge of common law copyright is that they were "conscious" of it. Patterson, *supra* note 52, at 402. This is hardly a ringing endorsement of the Framers' familiarity with English copyright law.

characterization of facts as bits of information which "do not owe their origin to an act of authorship."⁶⁹

If Congress has not been delegated the power to protect the collection and assemblage of factual material under the Copyright and Patent Clause, then, under the Tenth Amendment, that power may be "reserved to the States."⁷⁰ Certainly, if Congress lacks constitutional power to protect the unoriginal collection and assemblage of factual material, as the Court implicitly held in *Feist*, then it cannot act to preempt state attempts to protect such effort from unauthorized appropriation.⁷¹

Congress has acknowledged that, in certain circumstances, states may provide protection for the presentation of facts, apart from their selection, coordination, and arrangement:

"Misappropriation" is not necessarily synonymous with copyright infringement For example, state law should have the flexibility to afford a remedy . . . 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 *International News Service v. Associated Press*, 248 U.S. 215 (1918), 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.⁷²

The states, therefore, can act to protect a compiler's investment of time and labor in collecting and assembling the data contained in factual compilations.

Professor Raskind postulates that, under *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*,⁷³ a state statute protecting the collection and assemblage of information contained in a directory, database, index or other form of assembled information would likely be preempted by section 301 of the Copyright Act.⁷⁴ The opinion in *Bonito Boats*, however, implies that Congress has the power to protect the unpatented

69. *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 111 S. Ct. 1282, 1288 (1991).

70. U.S. CONST. amend. X. The Tenth Amendment provides as follows: "The powers not delegated to the United States by the Constitution, nor prohibited by it to the States, are reserved to the States respectively, or to the people." *Id.*

71. NIMMER & NIMMER, *supra* note 17, at § 2.11[E] n.30 ("Since Congress may not legislate a copyright in facts, it likewise may not preempt the states from enacting such legislation.")

72. H.R. REP. NO. 1476, 94th Cong., 2d Sess., 132, *reprinted in* 1976 U.S.C.C.A.N. 5659, 5748. *See also* NIMMER & NIMMER, *supra* note 17, at § 1.01[B], 1-25 (the limitations of the Copyright and Patent Clause "offer no basis for preemption of state protection of facts").

73. 489 U.S. 141 (1989).

74. Raskind, *supra* note 17, at 342-43.

boat hulls at issue, but has elected not to extend patent protection to such products: "[t]aken together, the novelty and nonobviousness requirements express a *congressional determination* that the purposes behind the Patent Clause are best served by free competition and exploitation of that which is either already available to the public, or that which may be readily discerned from publicly available material."⁷⁵ Thus, since Congress chose not to provide patent protection in such cases, this was an area Congress felt was "best left unregulated," and this congressional decision was accorded the same "pre-emptive force as a decision to regulate."⁷⁶

Based on *Feist*, however, it is clear that Congress does not have the *power* to grant copyright protection to unoriginal collections and assemblages of "facts." As a result, *Bonito Boats* does not appear to mandate preemption of Professor Raskind's hypothetical state statute.

VI. OTHER FEDERAL LAW PROTECTION OF FACTUAL COMPILATIONS

May *Congress* enact a copyright provision which would protect only the time and effort invested in collecting and assembling the data included in compilations as Professor Patterson urges? After *Feist*, the answer seems to be clearly "no" under the Copyright and Patent Clause. What then would be the source of Congress' power to enact such a statute? The obvious answer is the Commerce Clause, but this is a subject which exceeds the scope of this paper. However, it is certainly an interesting issue which is worthy of exploration.

VII. CONCLUSION

The *Feist* dichotomy between unprotectible "facts" and protectible selection, coordination, and arrangement does not provide much analytical guidance for the lower courts to follow when presented with factual compilations. Nor does the Supreme Court's analysis of the creativity present in the selection, coordination, and arrangement of the white pages at issue in *Feist* offer much aid in trying to determine which types of data selections, coordinations, and arrangements will meet the level of intellectual creativity needed for protection. This paucity of guidance will generate uncertainty as to whether various types of factual compilations are protected by copyright. Compilers cannot afford to "whistle in the graveyard," hoping that the lower courts will see beyond the limitations of the Supreme Court's analysis and focus upon the actual authorship decisions which are made by compilers. Specific

75. 489 U.S. at 150 (emphasis added).

76. *Id.* at 151 (quoting *Arkansas Elec. Coop. Corp. v. Arkansas Pub. Serv. Comm'n*, 461 U.S. 584 (1983) (emphasis in original)).

statutory protection may be the only answer to maintain the economic incentive so necessary to ensure that these important works continue to be created and made available to the public.