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PRESENTATION BY JOHN A. ODOZYNSKI, ESQ.

MR. ODOZYNSKI: Good afternoon. It's good to be here. I am sure we are all impressed by the level of thought that went into the presentations earlier today. My focus is a little more mundane.

As a corporate counsel, I am primarily engaged in monitoring the behavior of my clients and of competitors and providing advice in that area. Of course, the last thing clients want to hear is thinking that is going to impede their behavior. So consequently, I would like to focus on what *Feist* said about, and what we think it means to, copyrightability determinations in the future; both copyrightability and copyright infringement.

As we all know, *Feist*, having discarded sweat of the brow as a rationale to support copyright, depending upon the point of view you want, established a new criteria for copyrightability, or better defined the prevailing copyrightability criteria. In any event, what we are left with is a standard of copyrightability for compilations that requires originality in the selection, arrangement, or coordination of the compilation. We are also told that originality now requires not only the fact that the compilation is not copied, but a modicum of creativity.

Feist, however, does not inform us about the character of the creativity that is required; and you are probably aware of the various levels one can think of creativity in: the old originality standard, that is, not copied; this higher level of creativity, novelty standard—that is, new; and perhaps a non-obviousness standard that we are familiar with in patent law. I think we will see over time, some patent-like notions creeping into copyright law.

Because the Court found that Rural's white page listings did not meet even the minimum level required, it was not required to confront a copyright infringement issue in this litigation. But somewhat surprisingly, we think that *Feist* has, or may have, or can be expected to have some effect on the way copyright infringement determinations are made.

Part of this involves the element of creativity. The *Feist* analysis of the copyright infringement takes on a new mode. Part of this is because, prior to *Feist*, courts adopting sweat of the brow, or endorsing a sweat of the brow rationale uniformly found the work before them uncopyrightable and had little difficulty in finding that the accused work, in fact, represented an infringement. On the other hand, courts who did not embrace sweat of the brow, but relied on something more elaborate or elevated for copyrightability, were prone to strike down the

copyrightability of the work in question and never reached the issue of infringement.

As a variation on that, what we now hear, and we have present in *Feist* itself, is the notion that some works by their very nature only afford thin copyright protection (whatever that means). So the character of the work itself will, without much analysis, determine the scope of copyright protection afforded to it. I think that is perhaps an unfortunate way to approach the analysis.

It is my view that what always was required, and remains required after *Feist*, is a determination of what precisely about the work in question is copyrightable and the comparison of the work in hand with the accused's work to determine whether there is substantial similarity—as determined by our copyright laws, between the accused work and the copyrighted work. Having said that, and again reinforcing the notion that *Feist* itself probably did not significantly change the standard of copyrightability—and I think many of the cases that have been handed down in the months since March reinforce that—it remains necessary to get a handle on copyrightability because as I have indicated, it is impossible, in my view, to determine the scope of protection in a given copyright without assessing what, in fact, is copyrightable about the work in hand. So again as I said, probably the majority of the compilation cases, at least those coming down since *Feist*, have gone the same way they might have gone in the absence of *Feist*, or, at a minimum, have upheld copyrightability.

There are a couple of cases that I think are useful to explore to see how *Feist* might operate at the margins. One of those is *Victor Lalli v. Big Red Apple*. The question in *Victor Lalli* involved a work, that in essence was a chart, comprising a compilation of numbers generated by what I would refer to as algorithms. The algorithm was simply the total dollars of two-dollar bets to win, place, and show at a local race track in the New York metropolitan area.

The way the numbers on the charts were generated was simply to take the sums of the two-dollar bets on all nine races, then take a number that represented the sums for the first three races, then a second number that represented the sum for the first five races, and then a third number that represented the sum for the first seven races, then take the last digit of those three sums and generate a three digit number. Those numbers then constituted an element of a chart. The chart had a number for each of the days of a relevant month. In spite of what I would have to perceive as at least a modicum or minimum level of creativity in the creation of those numbers, the Second Circuit held, without much discussion, that the compilation in question was merely a

compilation of preexisting facts and upheld the district court's holding of uncopyrightability.

So the questions, at least two questions, presented by *Victor Lalli* are these: How is it, given the exercise in the algorithm that I have just described, that the results of that algorithm can be deemed to be preexisting facts when, in reality, those facts did not exist, and probably never would have except for the implementation by Victor Lalli of the algorithm? Leaving that question aside, there is a more difficult question: Given the algorithm, which we may agree was creative in some aspects—the simple arithmetic or mechanical acts of computing arithmetic sums based on a creative algorithm can be considered a creative process—the question remains: Do the mechanical operations in implementing that algorithm impart copyrightability to the result when, in fact, the algorithm itself might be an idea, process, or a method and not protected by copyright law? These questions are unanswered, and in fact, unaddressed by the court.

The second case, also a nondescript infringement case coming down after *Feist*, was *Sem-Torq v. K mart*. What was involved in *Sem-Torq* was a set of five double-sided signs, and I will confess that on my first reading of *Sem-Torq*, I pretty much summarily dismissed it and did not recognize that there was something copyrightable there. What I would suggest we do is apply *Feist's* standards of minimal creativity to *Sem-Torq* and see what we get as an output. In *Sem-Torq* the court admitted that no one had ever compiled a set of signs either identical or substantially similar to *Sem-Torq's* signs. Nevertheless, the court could not recognize any copyrightability or any creativity in that compilation. The court summarily said that the set is no greater than the sum of its parts; in fact, I suppose you can say, ignoring the essence of all copyright.

We see, even in *Feist*, and in other opinions dealing with copyrightability of compilations, the notion that what we have is a set of preexisting elements, preexisting facts, and that the collection of those facts can be no greater than the sum of the individual facts themselves. However, the fact is that the very essence of the compilation is to identify, or recognize, individual items of data with respect to which there are mutual correlations. Essentially, information is created by virtue of the fact that the selection did not exist before. And it is the creation of information that I submit ought to be protectible under the copyright compilation law.

In any event, the Sixth Circuit in *Sem-Torq* pretty much summarily, without much discussion, held the *Sem-Torq* signs to be not copyrightable. In fact, you can glean from that opinion the notion that the court was unimpressed by the level of effort that *Sem-Torq* expended in

compiling those signs. What I submit is the work here is something of a reverse sweat of the brow notion according to which, the court, perceiving not much effort in compiling the signs and really not doing much in the way of creativity analysis, simply struck down copyrightability. I would argue that if sweat of the brow is not an applicable doctrine, is not to be used to determine the copyrightability, it symmetrically ought not be used to strike down copyrightability.

So we are left, in my belief, with a creativity standard that in spite of *Victor Lalli*, has really not been, to me, demonstrably affected by *Feist*. But, again, we need to consider copyrightability in determining the scope of the copyright, so I would like to move to that area.

In my view, the way I think about copyright infringement issues is to determine, or the way I like to see them analyzed, is to determine what the scope of copyright protection in the copyrighted work is, and compare the accused work with the protectible elements of the copyrighted work to determine whether there is a substantial similarity. In effect, what I think that breaks down to after *Feist*, is a threshold determination of whether the purported copyrighted work, in fact, satisfies the criteria of originality, that is, creativity and origination with the author.

The second element of the copyrightability determination, in my view, is the application of idea/expression merger analysis to a work that you may have agreed to have at least complied with or satisfied the initial criteria. Of course, the way merger analysis operates is to draw a line between what is idea and what is expression in the work and then apply the merger doctrine to what is left of the scope of the copyright work in question.

Feist tells us, with respect to scope of copyright protection, that only the selection and arrangement are protectible. Raw facts may be copied at will. And this result is neither unfair nor unfortunate. Against that backdrop we would like to determine, I would feel it is necessary to determine, what the scope of copyright protection is in any compilation.

A case decided pre-*Feist* may give an indication, in my view, of the way the courts have to slide over this analysis and give short shrift to what represents the copyrightable component of a work. I am referring to *Worth v. Selchow & Righter*, and I think many of you are familiar with this case.

Worth, of course, involved the game Trivial Pursuit. The copyright owner, Worth, had compiled an encyclopedia of some twelve thousand entries, each of the entries consisting of the statement of a particular fact. Now we are not told exactly how Mr. Worth compiled his encyclopedia, but we can assume, I think, that these were facts that he

thought were interesting to himself or that he expected would be interesting to readers of his encyclopedia. Selchow & Righter, in the effort to develop their game Trivial Pursuit, copied four thousand of Worth's facts. The Fifth Circuit in *Worth* simply held that in order to constitute infringement, the entire selection of facts in the game Trivial Pursuit would have to have been identical to Worth's encyclopedia. The fact that Selchow & Righter had taken four thousand of the twelve thousand was not sufficient.

I think, speaking for myself, that pretty much flies in the face of what I would consider to be an applicable notion of substantial similarity, the taking four thousand of twelve thousand—thirty or thirty-five percent of any given work should have constituted an infringement—but the court in this case held that in order for infringement to have occurred, what would have been required is a taking of the entire selection of Worth's work.

We see this notion coming up in some more recently decided cases, including *Kregos* and *Key Publications*, where the court indicated that what really was required in order to constitute infringement of a compilation is the taking of the entire compilation. I do not have a reason why that standard would apply; I have a suggestion that I will offer you in a minute.

The second case I would like to discuss in the scope of copyright protection vein is the case of *Bellsouth v. Donnelly*. Just when things were looking bad for the publishers of telephone directories, *Bellsouth* comes down, and, in fact, I suppose turns the whole thing on its head.

In *Bellsouth*, the Eleventh Circuit held the directory in question to be copyrightable as a result of an original selection, arrangement, and coordination. The selection engaged in by Bellsouth was the selection of geographic areas, the geographic boundaries of any telephone directory, the close date after which they would include no additional listings in the directory, and the selection of the business classifications that constituted the yellow pages of the directory. I am sure you are all familiar with those. The creative arrangement was, in fact, taking the listings that they had collected from their business customers or from their advertising customers and assigning them to one of the roughly two hundred categories in the directory.

Donnelly's copying occurred in three parts: the keying of data from a given Bellsouth directory into a computer; preparation of sales lead sheets based on that data; and, the subsequent publishing of a directory that was substantially identical to Bellsouth's directory. So, although what we have here again is an activity on the part of the accused infringer—two activities, the keying of the data into the database and the generation of the sales lead sheets, the results of the product of which

bore little similarity to Bellsouth's copyrighted work—and we have the court, in fact, here finding at least the requisite or appropriate scope of the protection and the substantial similarity to have been sufficient to uphold the finding of infringement.

The questions presented in *Bellsouth*, in my mind, are primarily these. The Eleventh Circuit in *Bellsouth* pretty much assumed, without much discussion, that the categories of business classifications selected by Bellsouth were original. And I think, as we are all aware when we take a look at a yellow pages directory, although it would be difficult to probably find two directories that are identical, there is a high degree of commonality between the business classifications included in any directory, with maybe some minor modifications in the way the classifications in fact are articulated. However, there is a core area of commonality that I would submit is traceable from one directory to another. The Eleventh Circuit, for whatever reason, did not explore this factor and simply held that those categories were copyrightable. I think what would have been required was a closer look into the categories used by Bellsouth in their directory in comparison with what was existing in other directories. What I am looking for here would be a degree of similarity between Bellsouth's categories and categories in other directories. The similarity in my mind would be relevant evidence to establish that either Bellsouth's directory was not copyrightable because it was not creative, that is, it did not vary in any significant degree from other directories, or that the substantial similarity between Bellsouth's directories and other directories might be an indication that those classifications had not originated with Bellsouth, but were either copied or derived from classifications that existed fairly pervasively through the industry.

If the court had gone that route and examined Bellsouth's directory classification scheme to determine what in that scheme was original to Bellsouth, that is, creative, the court would have been required to compare Donnelly's classification scheme to Bellsouth's. Presumably, the court would have looked for some similarity or substantial similarity between the aspects of Bellsouth's directory that are copyrightable and similar aspects in Donnelly's. Of course, that did not occur.

Let us talk a little bit about the idea/expression merger because, as I said earlier, it is my view that the scope of copyright protection in compilations, as in any other work, is determined by how the idea/expression line is drawn and what effect, if any, the merger doctrine has to play in that. I think a recent case that highlights that reasonably well is *Kregos v. The Associated Press*. As you may be aware, the Kregos' compilation consisted of the selection of pitching statistics, nine
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In *Kregos*, the Second Circuit held that no previous compiler of statistics of this sort had used the same statistics that *Kregos* had used. Although the district court had found *Kregos*' compilation to be non-copyrightable, the fact that, assuming only twenty possible statistics could be used to create a compilation of *Kregos*' original collection of statistical items, nine represents one of one hundred sixty-seven thousand ways of combining nine out of twenty. The fact that no one else had done it, according to the Second Circuit, was clearly evidence of originality.

The problem was in articulating what the idea of *Kregos*' work was in order that the merger doctrine might be applied. There was a dispute as to what the appropriate idea of *Kregos*' work was. The contending ideas were simply a compilation that would predict the outcome of baseball games. The contending idea submitted by and urged by the dissent was a compilation of pitching statistics that would provide the most useful predictor of the outcome of the baseball game.

So what we have here, the difficulty we often perceive in courts, is idea/expression line drawing and the dispute between the majority and dissent as to what was the appropriate line of demarcation. Of course, the majority prevailed after holding that, with respect to these kinds of compilations, there was a continuum spanning matters of pure taste, for example, to matters of predictive analysis. Although *Kregos*' compilation in this case clearly had some predictive purposes, to define the idea of his work as precisely as the dissent would suggest would be to deprive it of all copyright protection whatsoever, because defining that precisely would require the idea to merge with the expression.

There are a couple other issues that were raised by the dissent in *Kregos* in the context of idea/expression merger analysis which might be useful to discuss.

There were, in fact, three strains of merger, idea/expression merger, that can be identified in *Kregos* and were urged by the dissent. The first is the one that I have already addressed — the notion that if there is one or only a limited number of ways to express an idea, then that idea will be deemed to be a merger with the expression, and, therefore not protectible by the operation of merger doctrine. The second is what I view as emanating from *Baker v. Selden* and codified in section 102(b)—that if a compilation or any other work defines a process, method, or art, that that expression would not be protectible because that subject matter is outside the scope of copyright protection. The third strain of idea/expression merger seems to be creeping in, although *Feist* did not rely on this explicitly in the dissent, you can see a clear nexus. Among the ideas that were offered as an appropriate Published by Core Press, Inc. 1992 *Kregos*' compilation was to say that pitching statis-

tics are useful as predictors of outcomes of baseball games. Judge Sweet, for his part, was unwilling to accept this as the appropriate definition of Kregos' idea because it was an old idea—that pitching statistics had been used before to predict the outcomes of baseball games. This was old. This was not creative; therefore, he would only accept an idea that more precisely defined and distinguished from a prior art (again, a patent term creeping into copyright law). He would only accept an idea that was sufficiently creative to distinguish it from that which came before. I would suggest that this was an inappropriate requirement for at least three reasons.

First, *Feist* provides no warrant for the imposition of a creativity requirement on the idea of a work. Second, the kind of creativity that Judge Sweet seemed to be imposing was at a standard higher than *Feist* would require. That is, it was as if he seemed to be suggesting something of an obviousness, or at least a novelty, standard when, in fact, the standard in *Feist* is bare bones; simply, we are looking for some brain wave activity kind of creativity. Third, what this would introduce into copyright law are notions common to patent protection. That is, notions that in order for the subject matter to be copyrightable, it has to be sufficiently distinguished from that which came before according to a standard of creativity. It is really like the patent law standard of obviousness, and I think this is an inappropriate requirement to insert into copyright law.

In any event, what the Second Circuit did with Kregos' compilation was reverse the district court's holding of uncopyrightability and remand for a determination of infringement. However, when remanding, the appellate court indicated that it felt that there was little likelihood that AP's form would be found to infringe, at least AP's 1986 form would be found to infringe Kregos' form because AP's 1986 form had only used six of the nine categories that Kregos used in his copyrighted form.

Again, we find the notion that, at least with respect to the compilations of fact, the Court is going to require—for a reason I will suggest in a minute—that there be, rather than substantial similarity, almost identity of the two compilations. The Court also brings into reality the suggestion, or the notion, that copyright of factual compilations is thin. It is my belief that this avoids copyright infringement, both copyrightability and the copyright infringement analysis in a way that is undesirable. I think what is required, as I said earlier, is an analysis of the scope of protection of the copyrighted work and an analysis of substantial similarity in the way it is conducted in most all other

The last case I would like to talk about is *Key Publications v. Galore*, that is, as you're probably familiar with it, the directory published primarily for the population in the Chinatown of New York City. The selection criteria was simply to list the businesses—this is again a yellow pages directory—that would be of interest to the Chinese population in Chinatown, selecting businesses from New York's Chinatown, New York City's metropolitan area, and the areas of Boston and Philadelphia. There was a listing of business categories similar to what we had in the yellow pages directory, including Bellsouth's; that is, there were two hundred sixty categories. The directory was held to be copyrightable both because of the subjective selection engaged in, including the nine thousand listings, as well as the two hundred sixty categories that the compiler of the Key directory selected.

What we have again is a finding that the work in question was copyrightable but not infringed. The lack of infringement was due to the fact that the accused directory included only twenty-eight of the two hundred sixty categories and only fifteen hundred of nine thousand listings. Again, I would submit that fifteen hundred of the nine thousand should have been, under conventional substantial similarity criteria, found sufficiently similar to the nine thousand original listings in the Key directory to warrant a finding of infringement.

What we have again is a court requiring, or at least indicating, that what would be required in order to find infringement of this particular compilation of facts is almost precise identity between the two works. Because Galore had taken only fifteen hundred of nine thousand, that identity did not exist, and, therefore, there was no infringement.

As I said, I do not really know from what notion the requirement of identity between the two works derives, except that I can only say that with an element of creativity inserted as a requirement of copyrightability of a work, if you assume that in order to adequately conduct an infringement analysis the court would be required to identify that which is copyrightable in the copyrighted work and find substantial similarity in the accused work, it just might be too difficult a job. So in fact the default mode would be to require that the two works be substantially identical and, therefore, avoid entirely the comparison of the copyrighted work and the original work to whatever existed in the accused's work.

