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THE SEARCH FOR CERTAINTY*

John P. McDonald**

I. INTRODUCTION

On March 27, 1991, the United States Supreme Court handed down its decision in *Feist Publications v. Rural Telephone Service Co.*¹ The Court's decision clearly eliminated "sweat of the brow," or "industrious collection," as the basis for copyright protection. The Court was unambiguous in its declaration that, as a matter of constitutional law, in order to qualify for copyright protection there must be originality in the work for which protection is sought and, even where originality is present, the protection afforded does not extend to facts or to preexisting materials contained within a compilation.

While the Court's decision did resolve a conflict in the rulings of the various circuit courts regarding the use of the "sweat of the brow" doctrine, the Court has begun a new round of examination as the lower courts and the agencies concerned with the extent and scope of copyrights attempt to digest the *Feist* decision and apply it. Some of those who relied upon the "sweat of the brow" doctrine have lamented the loss of all protections of fact compilations other than those that arise out of contract or trade secrets. They reason that even if the expression or originality that may exist in a fact compilation is protected, the Copyright Act after the *Feist* decision does nothing to protect the real value of the fact compilation—the individual facts that have been gathered at great cost and effort—from being taken by competitors who thereby avoid the expense of gathering and assembling the data and facts themselves. Such a result is perceived to be inequitable. To minimize this inequity, adherents to this line of thought have sought to have the *Feist* decision viewed as narrowly as possible.

Other reviewers of the Court's decision contend that the action taken by the Court does not necessarily result in the total loss of protection for fact compilations as some might suggest. These reviewers contend that the Court's decision merely reinforces the position to which certain circuits have come to adhere and that the *Feist* case has actually done little to alter the evolved status of the law.

* Views expressed in this paper are those of the author and should not be attributed to anyone else.

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

Nearly all reviewers, however, recognize that the *Feist* decision must be taken into account in addressing copyright compilation issues. This need to take *Feist* into account has caused the lower courts to assess whether there is a need to define or formulate new tests for the evaluation of compilation copyright to assure compliance with the import of the *Feist* decision. There is a sense that the *Feist* decision has produced change and that there is a conceptual void that needs to be filled as a result of that change. This article will examine some of the efforts at adjustment that courts have made to accommodate the *Feist* decision.

II. THE 1976 COPYRIGHT ACT

The case presented by *Feist* in response to Rural's claim of copyright infringement was based on the 1976 Copyright Act.² *Feist* expected that it would prevail in the case based on a finding by the Court that, while judicial precedent was important in the interpretation of the Copyright Act,³ where the Copyright Act and judicial precedent varied, the courts were required to adhere to the statutory provisions in the Copyright Act. *Feist* did not argue that it was necessary to address issues of constitutional consequence in order to resolve the dispute before the Court. The Court's decision to address and resolve the case as a constitutional matter necessitates a re-examination of the approach to compilation copyright even by those who supported and advocated the outcome in *Feist*. The Court has declared that there was a much stronger basis for *Feist*'s right to make use of facts than that afforded by the Copyright Act. There is a constitutional requirement of originality and creativity. In addressing issues of copyright and in interpreting the Copyright Act, conformance with this constitutional requirement is mandated.

In the context of the constitutional requirement, provisions of the Copyright Act may be examined. One of the changes in the 1976 Copyright Act was that it specifically addressed "compilations" as part of the overall framework for copyright protection. There are several

2. Copyright Act of 1976, Pub. L. No. 94-553, 90 Stat. 2541 (codified as amended at 17 U.S.C. §§ 101-810 (1988)).

3. When the 1976 Copyright Act was enacted it was intended to acknowledge the existing body of judicial precedent with respect to copyright. In fact, the Judiciary House Report indicates: The two fundamental criteria of copyright protection — originality and fixation in a tangible form — are restated in the first sentence of this cornerstone provision. The phrase "original works of authorship," which is purposely left undefined, is intended to incorporate without change the standard of originality established by the courts under the present copyright.

sections of the 1976 Copyright Act that are relevant to compilations. Section 102(a) defines the scope of copyright protection:

Copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device.⁴

Section 102(b) of the 1976 Copyright Act sets forth what is *not* protected by copyright:

In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated or embodied in such work.⁵

The 1976 Act defines a "compilation" in section 101 as:

a work formed by the collection and assembly of preexisting material 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."⁶

The extent of protection afforded a compilation is specifically addressed in section 103(b) of the 1976 Act:

The copyright in a compilation or derivative work extends only to the material contributed by the author of such work, as distinguished from the preexisting material employed in the work, and does not imply any exclusive right in the preexisting material. The copyright in such work is independent of, and does not affect or enlarge the scope, duration, ownership, or subsistence of, any copyright protection in the preexisting material.⁷

These provisions form the statutory framework for copyright compilations. There is no inconsistency between these provisions and the requirements of the Constitution.

III. THE UNITED STATES SUPREME COURT RULING

The Supreme Court assessed the *Feist* case as involving the interaction of two well-established propositions. The first is that facts are not copyrightable; the other, that compilations of facts generally are. The Court stated that the proposition that there can be no valid copyright in facts is universally understood as the most fundamental axiom of copyright law and added that "[n]o author may copyright his ideas

4. 17 U.S.C. § 102(a) (1988).

5. *Id.* § 102(b).

6. *Id.* § 101.

or the facts he narrates.”⁸ At the same time, however, the Court recognized that it is beyond dispute that compilations of facts are within the subject matter of copyright.⁹

There is an undeniable tension between these two propositions. Many compilations consist of nothing but raw data—i.e., wholly factual information not accompanied by any original written expression. Yet copyright law seems to contemplate that compilations that consist exclusively of facts are potentially within its scope. The Court sought to alleviate this problem by asserting that the key to resolving the tension lies in understanding why facts are not copyrightable.¹⁰ To do this the Court focused on the requirements for copyrightability. To qualify for copyright protection the work must be original to the author.¹¹

Original, as the term is used in copyright, means only that the work was independently created by the author (as opposed to copied from other works), and that it possesses at least some minimal degree of creativity. To be sure, the requisite level of creativity is extremely low; even a slight amount will suffice. The vast majority of works make the grade quite easily, as they possess some creative spark Originality 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.¹²

The Court declared that:

Originality is a constitutional requirement. The source of Congress' power to enact copyright laws is Article I, [section] 8, cl[ause] 8, of the Constitution, which authorizes Congress to “secur[e] for limited Times to Authors . . . the exclusive Right to their respective Writings.” In two decisions from the late 19th Century—*The Trade-Mark Cases*; and *Burrow-Giles Lithographic Co. v. Sarony*—this Court defined the crucial terms “authors” and “writings.” In so doing, the Court made it unmistakably clear that these terms presuppose a degree of originality.¹³

Having declared that originality is constitutionally required in order for a work to qualify for copyright protection, the Court explained how this requirement applies to the Copyright Act:

In summary, the 1976 revisions to the Copyright Act leave no doubt that originality, not “sweat of the brow,” is the touchstone of copyright protection in directories and other fact-based works. Nor is there any

8. *Feist Publications v. Rural Tel. Serv. Co.*, 111 S. Ct. 1282, 1287 (interim ed. 1991) (quoting *Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 556 (1985)).

9. *Id.*

10. *Id.*

11. *Id.*; see also *Harper & Row*, 471 U.S. at 547-549.

12. *Feist*, 111 S. Ct. at 1287 (citations omitted).

13. *Id.* at 1288 (citations omitted).

doubt that the same was true under the 1909 Act. The 1976 revisions were a direct response to the Copyright Office's concern that many lower courts had misconstrued this basic principle, and Congress emphasized repeatedly that the purpose of the revisions was to clarify, not change, existing law. The revisions explain with painstaking clarity that copyright requires originality, [section] 102(a); that facts are never original, [section] 102(b); that the copyright in a compilation does not extend to the facts it contains, [section] 103(b); and that a compilation is copyrightable only to the extent that it features an original selection, coordination, or arrangement, [section] 101.¹⁴

The Court then applied this standard to the facts of the case before it, stating that to establish infringement two elements must be proven: "(1) ownership of a valid copyright, and (2) copying of constituent elements of the work that are original."¹⁵ Feist had already conceded that Rural had a valid copyright in its directory as a whole as the result of the forward text as well as original material in its yellow pages advertisements.¹⁶ With respect to the second element, the raw name, address and telephone number data copied by Feist failed to satisfy the originality requirement since, although Rural may have been the first to discover and report the listings, the data did not owe its origin to Rural.¹⁷ The question that the Court posited was "whether Rural selected, coordinated, or arranged these uncopyrightable facts in an original way."¹⁸ Citing *Burrow-Giles Lithographic Co. v. Sarony*¹⁹ for the proposition that an author who claims infringement must prove "the existence of . . . intellectual production, of thought, and conception," the Court found:

Rural's selection of listings could not be more obvious: it publishes the most basic information—name, town, and telephone number—about each person who applies to it for telephone service. This is "selection" of a sort, but it lacks the modicum of creativity necessary to transform mere selection into copyrightable expression. Rural expended sufficient effort to make the white pages directory useful, but insufficient creativity to make it original.²⁰

14. *Id.* at 1295.

15. *Id.* at 1296.

16. *Id.*

17. *Id.*

18. *Id.*

19. 111 U.S. 53, 59-60 (1884).

20. *Id.* at 1296.

In so ruling, the Court rejected arguments that alphabetization or determination of geographic "scope" to be covered by the directory constituted original elements taken by Feist.²¹

IV. ANALYSIS OF THE DECISION: UNDERSTANDING ITS MESSAGE

By finding that the white pages in the Rural directory were uncopyrightable, the Court avoided addressing concretely the question of the scope of protection for a fact compilation that is copyrightable. It is possible for a number of elements, which by themselves are facts, to be combined to produce an original work. Although the Court did not demonstrate how it would assess whether there had been an infringement where the compilation as a whole was protected by copyright, it did set forth a conceptual guideline as to how such an amalgamation might be analyzed. That the Court did not delineate with mechanical precision where lines of demarcation may be drawn between facts and infringement should be given consideration. Given the nature of the task—identification of original authorship—it may be that no universal or precise rule can be formulated. Rather, it may be the case that each work will have to be examined in its own right on a case-by-case basis using the generally applicable criteria of the constitutional requirement of original authorship.

The Court offered this general statement about the scope of copyright protection in fact compilations:

The mere fact that a work is copyrighted does not mean that every element of the work may be protected. Originality remains the *sine qua non* of copyright; accordingly, copyright protection may extend only to those components of a work that are original to the author. Thus, if the compilation author clothes facts with an original collocation of words, he or she may be able to claim a copyright in this written expression. Others may copy the underlying facts from the publication, but not the precise words used to present them Where the compilation author adds not 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 question that must be answered on an individualized basis is whether, by taking the facts from a compilation of facts, an alleged infringer may also be taking the selection and arrangement that are original and created by the author of the compilation. It is the require-

21. *Id.* at 1297.

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

ment of individualized and detailed examination of the original authorship contributed to a work that necessitated the rejection of the "sweat of the brow" or "industrious collection" doctrine.

V. INDUSTRIOUS COLLECTION AND SWEAT OF THE BROW

The theory relied upon by *Rural* was developed in cases that interpreted the 1909 Copyright Act in light of nineteenth century English common law cases. Section 5 of the 1909 Act set forth certain categories that an applicant seeking to register a work should indicate as the type of work to be registered. One of the categories that might be selected as a type of work was "directories."²³ Although the 1909 Act did not say that the types of works set forth in section 5 were automatically copyrightable, some courts inferred that directories were copyrightable *per se* and that no further showing was required in order for the benefits of copyright protection to apply to them.²⁴ The theory that was formulated in support of this interpretation of the 1909 Act came to be known as "sweat of the brow" or "industrious collection." The formulation of this doctrine or theory was expressed in *Jewelers' Circular Publishing Co. v. Keystone Publishing Co.*²⁵ wherein the Court of Appeals for the Second Circuit stated:

The right to copyright a book upon which one has expended labor in its preparation does not depend upon whether the materials which he has collected consist or not of matters which are *publici juris*, or whether such materials show literary skill or originality, either in thought or in language, or anything more than industrious collection. The man who goes through the streets of a town and puts down the names of each of the inhabitants, with their occupations and their street number, acquires material of which he is the author.²⁶

The "sweat of the brow" doctrine extended copyright protection in a compilation beyond original selection and arrangement contributed by the author of the compilation to the facts contained within the compilation. Under the doctrine, the only defense to infringement was independent creation. A subsequent compiler was "not entitled to take one word of information previously published," but rather had to "independently [work] out the matter for himself, so as to arrive at the same result from the same common sources of information."²⁷

23. *Id.* at 1291.

24. *Id.*

25. 281 F. 83 (2d Cir.), *cert. denied*, 259 U.S. 581 (1922).

26. *Id.* at 88.

27. *Id.* at 88-89, quoting *Kelly v. Morris*, 1 L.R.-Eq. 697, 701 (1866).

The source of the "industrious collection" or "sweat of the brow" doctrine in *Jewelers'* was the Second Circuit, where the doctrine has been fully repudiated.²⁸ Similarly, the Ninth Circuit originally embraced industrious collection as a basis for copyright protection in *Leon v. Pacific Telephone & Telegraph Co.*²⁹ However, subsequent cases have thoroughly rejected the approach taken in *Leon*.³⁰ Indeed, *Black's Guide, Inc. v. Mediamerica, Inc.*³¹ may not have given selection, coordination and arrangement sufficient weight as elements susceptible to original authorship in its enthusiasm in declaring that facts are not copyrightable.

Although the doctrine originated in the Second and Ninth Circuits and was subsequently rejected by both of those circuits, the Seventh, Eighth and Tenth Circuits continued to strongly support the doctrine of "sweat of the brow" until the *Feist* decision. An example of the reasoning used in decisions in these circuits³² can be found in *United Telephone Co. of Missouri v. Johnson Publishing Co.*³³ Even though the defendant, Johnson Publishing Company, had originally conducted an independent door-to-door canvass which it supplemented by verifying updates of listings obtained from the local telephone company and added information not found in the telephone company's directory, an infringement was found. The court found that the directory was copyrightable and that Johnson, by comparing its directory to the telephone company's directory, obtained all of the information concerning new

28. See, e.g., *Financial Info., Inc. v. Moody's Investors Servs., Inc.*, 808 F.2d 204, 207 (2d Cir. 1986), cert. denied, 484 U.S. 820 (1987); *Financial Info., Inc. v. Moody's Investors Servs., Inc.*, 751 F.2d 501, 510 (2d Cir. 1984) (Newman, J., concurring); *Hoehling v. Universal City Studios, Inc.*, 618 F.2d 972, 979 (2d Cir. 1980).

29. 91 F.2d 484 (9th Cir. 1937).

30. See *Harper House, Inc. v. Thomas Nelson, Inc.*, 889 F.2d 197 (9th Cir. 1989); *Worth v. Selchow & Righter Co.*, 827 F.2d 569 (9th Cir. 1987), cert. denied, 485 U.S. 977 (1988); *Cooling Sys. and Flexibles, Inc. v. Stuart Radiator, Inc.*, 777 F.2d 485 (9th Cir. 1985); *Landsberg v. Scrabble Crossword Game Players, Inc.*, 736 F.2d 485 (9th Cir. 1984).

31. 1989-90 Copyright L. Rep. (CCH) ¶ 26,621 (N.D. Cal. Aug. 15, 1990).

32. See *Hutchinson Tel. Co. v. Frontier Directory Co.*, 770 F.2d 128 (8th Cir. 1985); see also *Illinois Bell Tel. Co. v. Haines & Co.*, 905 F.2d 1081 (7th Cir. 1990) (the court rejected the defendant's argument that the copied facts contained no elements of expression and were uncopyrightable). The Seventh Circuit cited *Schroeder v. William Morrow & Co.*, 566 F.2d 3 (7th Cir. 1977), where it was held that an original compilation of names and addresses is copyrightable even though the individual names and addresses in it are in the public domain and not copyrightable, and *Rockford Map Publishers, Inc. v. Directory Service Co.*, 768 F.2d 145 (7th Cir. 1985), cert. denied, 474 U.S. 1061 (1986), where the court held that a second compiler may check his independent work against the original compilation but must do the same basic, industrious collection work. On April 1, 1991 the United States Supreme Court granted certiorari in *Haines and Co., Inc., et al. v. Illinois Bell Telephone Co.*, vacated judgment and remanded the case to the Seventh Circuit for further consideration in light of *Feist*. 111 S. Ct. 1408 (interim ed. 1991); see also *Illinois Bell Tel. Co. v. Haines and Co.*, 932 F.2d 610 (7th Cir. 1991).

subscribers for telephone service which was protected material.³⁴ The court further held that the directories were substantially similar and that, “[b]y taking the names, telephone numbers and addresses of area residents, Johnson copied the ‘idea’ of United Telephone’s protected expression in its compilation or arrangement of the listings.”³⁵

The failure of the *United Telephone* analysis is that it fails to examine whether the expression that is identified is original authorship that is sufficient to meet the constitutional requirements for protection. Clearly, after *Feist* the answer is that there was not sufficient originality. The fundamental problem with *United Telephone* and the “sweat of the brow” cases that have used its analytical format is that they do not reach the critical issue of whether what was copied was protected. *Feist* not only rejects the analytical structure of the “sweat of the brow” doctrine, it imposes an affirmative duty to examine on a case-by-case basis whether the requisite original authorship is present and has been infringed. This requirement is not new. It is the examination that is required for other copyrightable works. To the extent that the “sweat of the brow” doctrine was applied to fact compilations, it represented an aberration from the mainstream of copyright doctrine.

VI. MAINSTREAM COPYRIGHT DOCTRINE

The Supreme Court referenced *Sheldon v. Metro-Goldwyn Pictures Corporation*³⁶ in its discussion of originality. The *Sheldon* case does not involve a compilation, but rather involves the assessment of whether a motion picture infringed the copyright of a play based upon a widely noted historical event.³⁷ The producers of the motion picture contended that they had not relied upon the play for their work, but rather had made reference to a novel founded on the historical event. The trial court judge in this matter “thought that, so far as the defendants had used the play, they had taken only what the law allowed, that is, those general themes, motives, or ideas in which there could be no copyright. Therefore he dismissed the bill.”³⁸ The Second Circuit, in an opinion by Learned Hand, reversed the trial court. After affirming that others may “copy” the “theme,” or “ideas,” or the like of a work, though not its “expression” the court stated:

In the case at bar the distinction is not so important as usual, because so much of the play was borrowed from the story of Madeleine Smith, and the plaintiffs’ originality is necessarily limited to the variants they intro-

34. *Id.* at 608.

35. *Id.* at 609.

36. 81 F.2d 49 (2d Cir. 1936).

37. *Id.* at 49.

38. *Id.*

duced. Nevertheless, it is still true that their whole contribution may not be protected; for the defendants were entitled to use, not only all that had gone before, but even the plaintiffs' contribution itself, if they drew from it only the more general patterns; that is, if they kept clear of its "expression." *We must therefore state in detail those similarities which seem to us to pass the limits of "fair use."*³⁹

The *Sheldon* decision provides an articulation of the authorship and originality of the play that are the "very web of the authors' dramatic expression"⁴⁰ that has been copied by the defendant. The court concludes:

The play is the sequence of the confluent of all these means, bound together in an inseparable unity; it may often be most effectively pirated by leaving out the speech, for which a substitute can be found, which keeps the whole dramatic meaning. That as it appears to us is exactly what the defendants have done here; the dramatic significance of the scenes we have recited is the same, almost to the letter. True, much of the picture owes nothing to the play; some of it is plainly drawn from the novel; but that is entirely immaterial; it is enough that substantial parts were lifted; no plagiarist can excuse the wrong by showing how much of his work he did not pirate. We cannot avoid the conviction that, if the picture was not an infringement of the play, there can be none short of taking the dialogue.⁴¹

The *Sheldon* case serves as the prototype analytic structure that should be applied to the assessment of the copyright protection to be afforded to any work. The court identified that which constituted original authorship and then determined whether it had been infringed. The court's analysis carefully separated those elements that (1) constituted historical material, (2) represented common place themes the playwright could not have claimed to have originated, and (3) were ideas and not copyrightable. Having identified that which was contributed authorship from that which was not, the court then identified the elements that the author of the play had contributed and which were copied through "parallelism of incident"⁴² by the infringer. This rigorous analysis is what is to be expected after *Feist* and is the complement to the court's elimination of the "sweat of the brow" doctrine.

39. *Id.* at 54 (emphasis added).

40. *Id.* at 55.

41. *Id.* at 55-56.

The lessons of *Sheldon* can be found in more recent cases. One such case is *Hoehling v. Universal City Studios, Inc.*,⁴³ which also received favorable citation in *Feist*. In this case, the plaintiff asserted that its copyright had been infringed by the defendant's copying of the essential plot of its book.

A grant of copyright in a published work secures for its author a limited monopoly over the expression it contains. The copyright provides a financial incentive to those who would add to the corpus of existing knowledge by creating original works. Nevertheless, the protection afforded the copyright holder has never extended to history, be it documented fact or explanatory hypothesis. The rationale for this doctrine is that the cause of knowledge is best served when history is the common property of all, and each generation remains free to draw upon the discoveries and insights of the past. Accordingly, the scope of copyright in historical accounts is narrow indeed, embracing no more than the author's original expression of particular facts and theories already in the public domain. As the case before us illustrates, absent wholesale usurpation of another's expression, claims of copyright infringement where works of history are at issue are rarely successful.⁴⁴

In so ruling, the court conducted a detailed examination of the various claims of authorship of the plaintiff with respect to materials that were copied by the defendant. Having conducted this examination of the authorship of the plaintiff and finding it to be absent from the material that was copied from its work, the court issued a warning:

All of Hoehling's allegations of copying, therefore, encompass material that is non-copyrightable as a matter of law, rendering summary judgment entirely appropriate. We are aware, however, that in distinguishing between themes, facts, and *scenes a faire* on the one hand and copyrightable expression on the other, courts may lose sight of the forest for the trees. By factoring out similarities based on non-copyrightable elements, a court runs the risk of overlooking wholesale usurpation of a prior author's expression. A verbatim reproduction of another work, of course, even in the realm of nonfiction, is actionable as copyright infringement.⁴⁵

For purposes of the point being made here, it is not important that the court ultimately found that all of the matter taken from Hoehling's book were non-copyrightable. It is important that in making its determination the court did perform a rigorous assessment of each copying.

43. 618 F.2d 972 (2d Cir. 1980); see also *Financial Info., Inc. v. Moody's Investors Serv., Inc.*, 808 F.2d 204 (2d Cir. 1986), cert. denied, 484 U.S. 820 (1987); *Financial Info., Inc. v. Moody's Investors Serv., Inc.*, 751 F.2d 501, 510 (2d Cir. 1984) (Newman, J., concurring).

44. *Hoehling*, 618 F.2d at 974.

The court's warning regarding the "wholesale usurpation of the prior author's expression"⁴⁶ is also of importance since it emphasizes the need to be mindful of the particulars of each instance examined.⁴⁷

A. *The Post-Feist Cases*

Since the *Feist* decision, there have been more than a dozen district and circuit court decisions that have referenced the *Feist* decision.⁴⁸ An examination of several of these cases provides insight into the extent to which the courts are drawing upon the insights contained in the citations referred to in *Feist* and the extent to which courts are seeking to formulate new criteria for the examination of compilation copyright issues. Insight may also be gained as to how parties to copyright litigation are faring as *Feist* is interpreted by the courts.

1. *Bellsouth Advertising & Publishing Corporation v. Donnelley Information Publishing, Inc.*

Among the first decisions to be issued by the courts was *Bellsouth Advertising & Publishing Company v. Donnelley Information Publishing* ("BAPCO").⁴⁹ This case involved the infringement of a yellow page directory by a defendant who asserted that all it had taken from the copyrighted compilation were facts. The Eleventh Circuit addressed the importance and applicability of the *Feist* decision to other directory cases acknowledging that the *Feist* decision required the copying of constituent elements of the work that are original for the finding of infringement and that the Supreme Court had disapproved the "sweat of the brow" standard.⁵⁰ The court found that the proper standard for copyright is found in the statute itself. The court stated:

Therefore, in the case of compilations, the protected expression is in the manner of selection, coordination, or arrangement of the information that constitutes the originality, not the information itself that is accumulated by the "sweat of the brow." Hence, copyright protection only ex-

46. *Id.*

47. It would be an error in logic to assume that the court has imposed a requirement that there be a complete copying in order for there to be infringement of a historical or factual work. While wholesale copying has a substantial likelihood of infringing protectable expression of an author, it does not mean that a lesser taking could not equally infringe by taking protectable expression.

48. *Key Publications v. Chinatown Today Publishing Enters.*, 945 F.2d 509 (2d Cir. 1991); *Cable News Network v. Video Monitoring Servs. of Am.*, 940 F.2d 1471 (11th Cir. 1991); *Bellsouth Advertising & Publishing Corp. v. Donnelley Info. Publishing*, 933 F.2d 952 (11th Cir. 1991); *Kregos v. The Associated Press*, 937 F.2d 700 (2d Cir. 1991).

49. 933 F.2d 952 (11th Cir. 1991).

tends to the selection, coordination and arrangement which comprises an original *format* of the compilation work.⁵¹

The court in applying this standard determined that selection of geographic boundaries corresponding to the scope of each directory and directory close dates upon which no more listing modifications would be reflected in the pending directory constituted protectable acts of selection.⁵² With respect to coordination, the court found that the plaintiff "had to coordinate all the current informational components of a particular business into one complete business listing. The name of the business had to be coordinated with the business' address and the business' phone number."⁵³

The court found that "[t]he format of the Yellow Pages is sufficiently distinctive from the 'white pages' phone directory involved in *Feist* to meet the minimal level of independent creativity required to qualify as original."⁵⁴ Having found that the yellow pages as a whole were copyrightable, the court went on to find that since the defendant had taken material from the yellow pages, there had been an infringement of the copyright in them.⁵⁵

Because the court failed to identify with particularity what constituted the original authorship contributed by the plaintiff, it was unable to differentiate between: (1) material which was preexisting material that was not original to the plaintiff; (2) factual material; or (3) functionalities that are not protected by copyright and original authorship that was contributed by the plaintiff. This failure to examine the details of the work in which an infringement was claimed is contrary to the lessons found in *Sheldon* and *Hoehling*.

The Eleventh Circuit's failure to identify the elements of authorship contributed to the work has caused the court to achieve the very same result that would have been achieved had the court applied the "sweat of the brow" doctrine. The error produced by the "sweat of the brow" doctrine is that copyright protection is extended to material that is in the public domain and to which no copyright attaches. In this instance, the court found that the work as a whole was copyrightable since it contained aspects that could be classified as selection, coordination or arrangement. No examination was made beyond this to determine whether these aspects constituted original authorship. The Eleventh Circuit, being unable to differentiate between the protected

51. *Id.* (footnotes omitted).

52. *Id.*

53. *Id.* at 957-58.

54. *Id.* at 958.

55. *Id.* at 958-59.

material and that which was in the public domain, defaulted on its responsibility with the explanation that:

Donnelley attempts to evaluate individually each element of the BAPCO directory in asserting that they lack originality, and are thereby unprotected by copyright. However, each component must not be evaluated in a literary vacuum but as an *integral part of the whole* to determine if BAPCO's original format was copied.⁵⁶

This is simply a restatement of the "sweat of the brow" doctrine wherein the copyright of the whole applies to each of the component parts. This analysis and result was clearly rejected by *Feist*.

This critical error in analysis led the court to find that the taking of name, address and telephone number from the yellow pages constituted a copyright infringement.⁵⁷ This finding cannot be reconciled with the findings made in *Feist*. In practical effect, the Eleventh Circuit in the *BAPCO* decision simply substituted the phrase "selection, coordination and arrangement" for "sweat of the brow." In applying its analysis it failed to heed the message of *Feist* that the examination for copyright infringement must extend to whether the actual *material taken* constituted original authorship contributed to the work by the copyright holder. Thus, by limiting the application of the *Feist* case to simply the eradication of the "sweat of the brow" doctrine, the *BAPCO* court has sought to evade the broader import of the *Feist* decision.

2. *Key Publications, Inc. v. Chinatown Today Publishing Enterprises, Inc.*

*Key Publications, Inc. v. Chinatown Today Publishing Enterprises, Inc.*⁵⁸ is a yellow page directory case that was heard in the Second Circuit. The district court had found that there had been infringement.⁵⁹ The circuit court, after finding that the plaintiff's work was subject to copyright protection, found that the defendant had not infringed the plaintiff's work. The circuit court in examining the aspects of the plaintiff's work that constituted original authorship and which thereby warranted copyright protection addressed the question of infringement:

Whether a compilation has been infringed requires a somewhat more refined analysis than is applied in a case involving a wholly original

56. *Id.* at 959 n.18 (emphasis added).

57. *Id.* at 958-60.

58. 945 F.2d 509 (2d Cir. 1991).

work. The individual components of a compilation are generally within the public domain and thus available for copying.⁶⁰

The Second Circuit rejected the notion that there had to be an exact replica of a compilation in order for there to be a finding of infringement.⁶¹ This court accepted the following test for infringement:

Although the test for infringement of original works and compilations is one of "substantial similarity," the appropriate inquiry is narrowed in the case of a compilation. As noted, the components of a compilation are generally in the public domain, and a finding of substantial similarity or even absolute identity as to matters in the public domain will not suffice to prove infringement. What must be shown is substantial similarity between those elements, and only those elements, that provide copyrightability to the allegedly infringed compilation.⁶²

The circuit court in *Key* adopted the analysis utilized in *Sheldon* in its discussion of "parallelism of incident." The analysis utilized in *Key* has as its core, a detailed examination of the work in which copyright is claimed and of the material that was copied from it. A comparison of the analytical method applied in the *BAPCO* and the *Key* decisions reveals the deficiencies in the approach taken in the *BAPCO* decision. In *BAPCO*, the court's analysis of originality ended when the court determined that there was sufficient originality to provide copyright protection to the work as a whole. No examination was made by the *BAPCO* court as to the particular materials that were copied. This failure in analysis allowed it to reach a determination that contradicts the findings of the Supreme Court in *Feist*. The *Key* court, however, did perform an examination of the particular materials that were copied and compared them to the authorship found to have been contributed by the author. By using the correct analysis the *Key* court reached a result that conforms with the meaning of *Feist*.

3. *Kregos v. The Associated Press*

In *Kregos v. The Associated Press*,⁶³ the Second Circuit considered the extent to which the copyright law protects a compiler of information. After a detailed analysis of the work in question, the court noted:

Thus, as to compilations of facts, independent creation as to selection and arrangement will not assure copyright protection; the requirement of minimal creativity becomes an important ingredient of the test

60. *Id.* at 514.

61. *Id.*

62. *Id.* (citations omitted).

63. 937 F.2d 700 (2d Cir. 1991).

for copyright entitlement. “[T]he selection and arrangement of facts cannot be so mechanical or routine as to require no creativity whatsoever.”⁶⁴

Although the court recognized that there was minimal protection that would apply to the work in question it drew the following conclusion:

D. *Extent of Protection.* Our ruling that Kregos’ copyright claim survives defendants’ motion for summary judgment does not, of course, mean that he will necessarily obtain much of a victory. “Even if a work qualifies as a copyrightable compilation, it receives only limited protection Copyright protects only the elements that owe their origin to the compiler—the selection, coordination, and arrangement of facts.” If Kregos prevails at trial on the factual issues of originality and creativity, he will be entitled to protection only against infringement of the protectable features of his form. Only the selection of statistics might be entitled to protection. We agree entirely with Judge Goettel that nothing in Kregos’ *arrangement* of the selected statistics displays the requisite creativity. As to the arrangement, Kregos’ form is surely a “garden-variety” pitching form. The statistics are organized into the “obvious” arrangement of columns, and the form follows the pattern of most other forms: the statistics are organized into three groups, first the statistics about each pitcher’s performance for the season, then the statistics about the pitcher’s performance against the day’s opponent, and finally the statistics concerning the pitcher’s recent starts.⁶⁵

In this conclusion the court approaches the material before it as unique and requiring individualized analysis. It would seem that this approach, wherein the author claiming protection under copyright must demonstrate not only originality sufficient to qualify the work as a whole for copyright protection, but also the particular originality of the material that has been copied, is what is required by *Feist*. To the extent that this requirement differs from the notion that all that a copyright plaintiff must do is show that its work is copyrighted and that there has been copying, then *Feist* has imposed a more detailed and exacting standard.

4. *Cable News Network, Inc. v. Video Monitoring Services of America, Inc.*

In *Cable News Network, Inc. v. Video Monitoring Services of America, Inc.*,⁶⁶ a panel of judges in considering this copyright infringement case placed heavy emphasis on the statements contained in the copyright registration statement of Cable Network News

64. *Id.* at 704 (citation omitted).

65. *Id.* at 709.

66. 940 F.2d 1471 (11th Cir. 1991).

("CNN"). Emphasizing the need to preserve materials in the public domain, the Eleventh Circuit looked to the requirements for copyright registration as a protection against aggressive overreaching by copyright holders.

In the instant case, had CNN registered a claim of copyright in a typical broadcast day, its registration application would have been compelled to identify under section 6a "any preexisting work or works that this work is based on or incorporates." Hence, all prerecorded segments and commercials, many of which are either in the public domain or are the copyrighted work of others, would have to be disclosed. More importantly, under section 6b, CNN would be required to "[g]ive a brief, general statement of the material that has been added to this work and in which copyright is claimed." A review of the registration certificate and the deposit materials by the district court would have allowed it to fashion an injunctive remedy that balanced the rights of the copyright owner fairly against the rights of the public.⁶⁷

The court here appears to be taking the *Feist* decision a step further. Not only would the court require that original authorship be identified and found to have been taken for the finding of copyright infringement, the copyright holder would have to have identified its authorship in the registration statement in order to receive protection. Under the approach taken here, a failure to fully articulate in a copyright registration the extent of your claimed contribution would bar you from recovery in an infringement action. This analysis recognizes the complementary aspect of the Supreme Court's rejection of the "sweat of the brow" doctrine. Not only does copyright not extend to the non-copyrightable elements in a work, it only extends to those elements in which original authorship can be demonstrated.

B. *The United States Copyright Office*

In response to the *Feist* case the Copyright Office in apparent agreement with the Eleventh Circuit has raised new considerations with respect to copyright registration. The Copyright Office following the *Feist* decision began an examination and inquiry as to whether its registered compilations that contain name, address and telephone number had sufficient originality to qualify for copyright registration. Correspondence was sent to copyright holders of databases containing name, address and telephone number, making inquiry as follows:

As far as your work is concerned, it is not clear whether the selection and/or arrangement of entries meets the requirements of original compilation authorship. If you believe the work contains copyrightable compi-

lation authorship . . . please explain how the work was created and on what basis you believe it is copyrightable—

1. Describe any selection authorship inherent in the creation of this compilation—
 - (a) Is this an exhaustive listing of all items available, or were some used here and others not included?
 - (b) If some items were excluded, what factors determined whether an item was included or not?
2. Is there some particular originality in the way these entries are arranged? Is there a conscious system in the presentation or order . . . ?⁶⁸

Through this inquiry, the Copyright Office is enhancing its examination and may be requiring copyright registrants to articulate the original authorship that they have contributed to a compilation. This, of course, is an expansion of the current copyright filing requirements. It might be suggested that articulating the nature of original authorship might be more difficult than the authorship itself. The activities of the Copyright Office and the extent to which they will carry their examination are yet to be seen. However, the Eleventh Circuit's decision in *CNN* is supportive of the Copyright Office's approach to copyright registration.

VII. CONCLUSION

The *Feist* decision may have done significantly more than eradicate the "sweat of the brow" doctrine. An examination of the rationale for the elimination of the "sweat of the brow" doctrine and the case law approved by the Court suggests that there will be a closer examination of the works in which copyright protection is claimed. Plaintiffs in copyright actions will not only have to demonstrate with greater particularity the originality that they have contributed to a work, but will have the burden of showing that their contributed authorship was copied by the alleged infringer. While some may claim that this is a change in copyright law, it may be more correct to state that it is a correction in the treatment afforded compilations to bring them into conformance with the criteria for assessment that has been standard for other literary works.

68. See Marybeth Peters, *The Copyright Office and the Formal Requirements of Registration*, 17 *U. Dayton L. Rev.* 737, 745 (1992).