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Presentation by John P. McDonald, Esq.

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MR. McDONALD: I have an interesting place in all of this. I had some small role in the *Feist* case in that I sat in the room and was advised by David Lange and Ray Patterson on how it ought to turn out.

After briefing that case and about the time that it went to oral argument, the company I was working for, Ruben H. Donnelly, thought I did a good job and they promoted me to Dun & Bradstreet, Inc.

Upon arriving at Dun & Bradstreet, Inc. I inherited a case that was ongoing. It was in the Seventh Circuit, a copyright infringement case, we were the plaintiff, and we had a very solid sweat of the brow theory that we were relying on. The *Feist* decision, of course, came out on March 27th. On April 7th I was due to go to trial. I had no theory. I had no case. My now general counsel, who I report to, took great pride in taking me around to our various operating units and saying "here's the fool that produced that result." So I have a lot of interest in these cases and can discuss them from sort of a neutral position. I do not need to go very far from my office door. In fact, I do not have to leave my own building to be able to have a battle royale on either side, for example, one on what is protected or what ought to be protected.

I will return for a moment to *Feist*—but first I am going to apologize. My remarks are going to be jumbled because I assumed that there would not be any other speakers on what I prepared. If I gave what I prepared, you would simply be hearing a lot of the things that you have just heard, so I will jump around a bit.

As I viewed the *Feist* case, I was greatly disappointed in the outcome. I personally thought that the Supreme Court copped out. They did not address the hard question. In taking the case they took a wonderfully simple fact situation, a case where there was not much burden to it. The white pages that Rural Telephone had published were fairly straightforward. It was a great case. What I had hoped they would get to were the hard questions in compilations, such as: Where you have a protected compilation and facts are taken from it, where do facts and the rightful taking of public domain material begin? Where is the line where suddenly you have taken that contributed creative element? By saying that all of the white pages were not protected, the Supreme Court never had to address that question.

So, as someone who had an ongoing case pending before the Eleventh Circuit in which I was representing the defendant (and in which the lower court had referred to me as an industrial pirate, which in

Florida, piracy has real meaning—they understand that concept) I was sort of hopeful that the Supreme Court would go all the way and address the heart of the issue, but they did not. By not addressing it, they left open the result in the *BAPCO* case, the *Southwestern Bell v. Donnelly* decision from the Eleventh Circuit, and that case is an interesting case. I liked listening to your remarks about it, because the way the decision is written one has to assume that there may have been a full-blown trial in which all of these discussions of what was contributed, selected, and what was the authorship had been developed. In point of fact, there never was a trial. That whole case is based on motions for summary judgment. There are no facts.

One of the interesting things about the case is we never copied the headings. Quite frankly, they were of little use to us. The Bellsouth book was a much fuller and completed book than ours, and if we had copied all those headings and attempted to use that system or that description of the businesses in southern Florida, our directory would have had a whole bunch of listings with blanks underneath it. But, quite frankly, we did not want that. Our literal taking, the things that we copied, were clearly, name, address, and telephone number. We admitted that we took them, and we thought that the taking of the name, address, and telephone number, as arranged alphabetically in the yellow pages was a lot like what Feist did to Rural Telephone. We saw some similarity there.

The decision that came down in the *BAPCO* case was one of the permutations of what has evolved since *Feist* came out. In *BAPCO* the Eleventh Circuit took a look at this, and they gave credence to *Feist*. They said: "Certainly *Feist* exists, and we understand it and agree that sweat of the brow is dead." They then went on to say, however, that they did like "selection, coordination, and arrangement," and what they literally did was substitute the phrase "selection, coordination, and arrangement" every place you would normally find "industrious collection," without taking any further analysis. The failure on their part to do analysis was perhaps because they did not have any facts to analyze.

I think they were trying to reach what they considered to be the correct result. What they did do was in part, misinterpret, or not properly read some of the direction that I think could be drawn from the *Feist* case.

I think the *Feist* case did a couple of things, and one of the bad things it did was to cause people to argue about what are and are not facts so that they can determine what was contributed. I think what the *Feist* case did was something far more pervasive. It took and shifted the burden of proof.

In any copyright case you now have an entirely different case. It used to be that you could go in, and you could say: "(1) I have got my copyright; (2) this was taken out of what was copyrighted; (3) this is the title of the copyright"—and you were home free. There now is a question and an additional step in the analysis that has to be done. That is the question of whether what was taken was protected by the author's copyright, and in a compilation, where it is largely facts, that becomes a very difficult question.

The *BAPCO* case never examined the material that we took. Their basic analysis was that the heading system is protected; it is copyrightable. That is a conclusion that I do not necessarily disagree with, largely because I understand how heading structures are put together and that they are large elements of the judgment, selection, and criteria of what you do for your heading structure. Large portions of heading structures are so generic or are common that anyone in today's world would find that most of it was already taken and that their contribution would be fairly minimal. I would suggest that if you were to look at heading structures across the country and by different publishers, there would be subtle differences. That publisher's contribution to the range of businesses that might portray themselves in the yellow pages might be classified, described, or expressed. This is kind of fun. It is like I have been contributing all along, and suddenly I have a free period where I can answer everything I did not like.

The problem with the *BAPCO* case is they did not do the necessary analysis. They looked at the whole. They said it was protected. They said you took stuff but did not examine what was taken, and therefore we agree, you violated their copyright.

Another case that has come out since the *Feist* case is the *Key* case, the *Chinatown* directory case. The court there, although I generally like the Second Circuit's case, in their analysis made the same fundamental mistake; they looked at the end product. They did not look specifically at what was taken. When you break down their analysis, it ends up saying that one book had 2800 headings and the other had 28, so they certainly do not look the same and therefore it is probably not an infringement. What the court did not look at was what they, whichever one of the two companies was the infringer, actually took and say whether that was protected or not. And again, I think that is a fundamental flaw in the reasoning, in how they ought to be approaching the reasoning.

Earlier today, David Lange talked about the beast rising from the ocean floor. I think what *Feist* stands for is that beast rising; it is not just one case. I think copyright has all along had a bunch of cracks, and a case like *Feist* causes us to go back and examine, to ask ques-

tions, and then causes us to say we have a new scheme of things. How did this impact what we thought about copyright?

So many things are attributed to the *Feist* case which probably are not there. They are simply things that have come to mind, and thus we attribute them to *Feist*. However, some of the things that have emerged are rather interesting and kind of positive. There are two cases. One case I would like to focus on is the *CNN* case.

CNN is a complex case, and it involves some issues that I certainly am not capable of addressing. However, the *CNN* case does address one issue that raises an interesting question because there are many people out there that have picked up on the notion of this breakdown of what is taken. The unanswered question in *Feist* is: "If I take each of the elements, one piece at a time, and I call each of them a fact and end up with the entire package, have I committed a copyright violation if I can identify and take away each piece?"

A case that would have addressed that, but the parties got smart, settled it, and stopped paying lawyers, was *Black's Directory*. *Black's Directory*, a west coast case, was one of the cases involving two publications that both published real estate numbers of some sort. The district court in California, examining that case literally, looked at each component in the publication and said, no, that is a fact, that is standard, that is the standard way of doing things, and when they were finished doing that, there was nothing left. That would have been a neat case had it continued because one of the things that *Feist* referred to was the *Universal Studios - Hoehling* case. The lesson there, the cite that *Feist* cited to, was the reference in *Hoehling* that you had to be careful about deforesting one tree at a time—where you took away everything by just looking at the minuscule. God, they are talking back already.

However, the *CNN* case introduces, along with the copyright office, an interesting twist. As a result of *Feist*, we received a letter from the copyright office saying: "By the way, we have noticed that Dun & Bradstreet databases have names and addresses in them, and we are conducting an inquiry into just what it is in your database that is perhaps subject to registration. We recognize you have been registering with us for a long time, but we would like to know more about it." The things that they asked about were in the nature of: "If you break them down just what is it that you are claiming is your copyright? What are the parts of this that you have contributed? Is this a new compilation or is it an update? Is it a revision? What exactly are you calling this?" This set off a certain amount of clamor in my office because, quite frankly, those notices are filed out by a secretary who for the last hun-

dred years typed in the same things—"selection, coordination, arrangement of something" and "please accept it."

However, it is an interesting approach. It is an elemental approach. It is an approach that I like in some respects; there is some critical analysis because obtaining a copyright ought to mean something, and if it is to mean something, then you ought to have met some criteria.

The place where my heart goes aflutter is in the *CNN* case where Judge Birch goes off on what was perhaps some tangent to the rest of the case and goes through the copyright registration that CNN filed. Apparently, they filed daily programming, and that was it. One can look at the analysis as though Judge Birch were examining it as a patent. This is apparent where, in effect, he was saying: "They did not claim this; they did not say this in their registration; therefore, they didn't have it." If you combine that with the letter I got from the Copyright Office, you begin having the queasy feeling: "Well, I am going to have to articulate exactly what original authorship is." At that point I decided the secretary was more capable of doing it than I was, but I suspect in many instances, the articulation of exactly what your original authorship is could be harder than the thing you authored.

So I look at the *CNN* case and the statements by the Copyright Office and see them as a fragmentation based on *Feist*. It largely goes ultimately to what you can claim, but it is also part of this piece/part analysis of what is copyrightable. I have actually talked to people at the Copyright Office, and they told me that that is not their intent, which I thought was a shame, because I had talked the corporation into giving me a huge staff, a new office, and all sorts of stuff for this dynasty I was going create, and now they tell me, so sorry, our endeavors are not going to be that difficult. However, I would like to have the office and staff back if I could. You begin having a breakdown of what it is and what is the authorship.

The case that I like that I think draws a pretty decent balance is the *Kregos* case. I am not sure I am comfortable with all of the things that they did in there, but if you just look at the approach, the approach that is urged in *Kregos*, it is very much a case-by-case approach. It is case-by-case approach where you attempt to identify what is the contributed authorship. The court in that case was very candid. The court did not think the statistics were protected, and it did not think there was much there that was protected. However, somewhere in there the court had a feeling that Kregos, or the compiler of that sheet, took and made some judgment, made some selection, had some criteria that was used that was somehow unique to him, that expressed some

sort of condition, and that was worth protecting. The question then becomes one of whether what you took is protected.

That case represents to me that the attempts to come up with blanket rules, blanket standards, that you can rely on are not going to work. What you are going to have to do is recognize that copyright analysis is case-by-case. In each case you are going to have decide, in the context of the case, whether what the author has done is original, is creative, and meets all the classic criteria for copyright protection. You are going to have to examine whether it is too mundane and whether it meets basic going-forward type criteria. I do not think that is subject to generalization, although for the professors here and certainly for the practicing lawyers, our clients certainly demand it.

I do not know how many times I have been asked: "What exactly does *Feist* mean? Does that mean I can do this? Does that mean they can do this to me?" I do not know that there is a good answer. I think it is like many areas of the law; you are going to have to look at each case on its own merits, and attempt to draw rigid lines—this is and that is not—just are not going to work.

One of the other interesting things that I think has emerged, along with the shifting of the burden of proof, is that now you have to prove that what they took was actually what you contributed. This comes from *CNN* where Judge Birch basically overruled both parties before him. The parties before him had stipulated that the material taken was subject to copyright protection, and the trial court judge took them at their word. Judge Birch altered the equation by saying that in reviewing this sort of thing the judge had to look out for the public interest, had an obligation to protect the public domain, and had, on his own initiative, to go back and examine whether what was taken was actually subject to copyright protection or whether it ought to be stated as being public domain material that anybody could take.

The combination of shifting of the burden of proof to the plaintiff—to show what it was that he had contributed and that it was taken—with the independent duty of the court in examining these cases to go forward and make up its own mind about that, changes the classic presumption that had accompanied copyright registration.

In a different vein, I am not quite sure what *Feist* has done in the following area. There exists under one umbrella within the copyright realm probably four or five, depending on how discerning you are, maybe more, lines of copyright thought. There is copyright thought associated with software. There is copyright with old novels and literary work. There is copyright associated with compilations. Indeed, in the Copyright Act itself, compilations are given their own special section, their own special definition, which seems to say that maybe they are

different. They certainly have been, since *Feist* has focused attention on them, subject to all types of scrutiny. However, I would suggest that while there are some characteristics about them that make them different and that the individualized sections are intended purely to be delimiting, the fundamental analysis to be applied to compilation is the same that would be applied in any classic consideration of whether something is protected by copyright.

You must go back to the basics. In compilation analysis, because it is easy to do, you often end up looking at the facts. You end up looking at the data that was taken, and you look at the information. In doing that, in focusing on that and not on what the creative authorship was, you quickly depart from what has been the classic analysis of what is protectible. Have you ever had a thought totally leave you? You end up in discussions of what is fact, what is not fact, and that really is the wrong way to go about it. What you end up doing, in part, is instead of doing the substantial similarity test to determine whether the two works are so similar that there has been infringement, you begin looking at the output. In doing so, as we discussed earlier, you might say that if I take your work and I add one element to it, then it is all my work. Jimmy Stewart's case, the *Rear-Window* case, certainly says that cannot be right. You begin getting into discussions: Do you have to take the whole thing or can you take piece/parts of it? Well, if I take a key part of a database that contains an important contribution by the author to that database, but I do not take the whole thing, in my mind I have still infringed. It cannot be a question of all or nothing. The example I like to use on this is the following: Suppose I have a bunch of tiles in front of me, different colored tiles, and we will call each of those tiles a fact. I sit there and very carefully select tiles one at a time and arrange them and coordinate them into a pattern that becomes a mosaic. Somebody else comes along looks at this mosaic and says that it is pretty good. That person says "I am going to take those pieces of tile out of it; I am going to take the facts and use them as my own." They certainly are entitled to do that. They are entitled to take those facts. However, at some point in the process of taking those facts and putting them down in their own sandbox, a pattern begins to emerge, a visualization, and it begins to look a lot like my original mosaic. I do not know when I can say that they are copied—when there are three tiles there, when there are ten thousand tiles, when they have an exact replication, or when they simply have a replication that, although skeletal, is clearly identifiable as my work, my mosaic.

This comes back to the question of why the *Feist* decision does not go as far as it needed to. *Feist* does not answer that question. It is a question that could be answered in the traditional case law associated

with copyright, the case law that deals with why one novel is a copy of another. They have used different characters; they have used a slightly different plot. The question there is: Is there substantial similarity such that you could recognize it?

I think with respect to compilations that same sort of analysis needs to be applied. That sort of analysis can only be applied once you have undertaken the fundamental steps of identifying what has been contributed and focusing on the contribution rather than the facts that make up the compilation. Thank you very much.