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Copyright Registration after Feist: New Rules and New Roles

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COPYRIGHT REGISTRATION AFTER *FEIST*: NEW RULES AND NEW ROLES?

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I. INTRODUCTION

Marybeth Peters' comprehensive review of procedures for registering claims to copyright in databases and other compilations with the Copyright Office highlights one of the key roles played by the copyright registration process in the overall system of defining and enforcing intellectual property rights under United States copyright law.[1] In that system, copyright registration serves several important functions. It creates a public record concerning assertions to copyright protection, and it also plays a key role in the acquisitions process for the collections of the Library of Congress.[2] But the post-*Feist*[3] environment draws attention to a central function of the registration system: the role of gatekeeper for copyright protection.

Registration acts as a gatekeeper for copyright protection in at least three ways. First, by granting or denying registration of copyright claims, the Copyright Office serves in many cases as a literal gatekeeper to judicial enforcement of copyright: in most cases, the courthouse doors are barred to any claimant who has not persuaded, or at least attempted to persuade, the Copyright Office to register his or her

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1. Marybeth Peters, *The Copyright Office and the Formal Requirements of Registration of Claims to Copyright*, 17 U. DAYTON L. REV. 737 (1992). *See generally* 17 U.S.C. § 408-412 (1988) (description of the copyright registration process and the significance of registration).

2. As section 408(b) of the Copyright Act sets forth, an application for registration of a copyright claim generally must be accompanied by a deposit of at least one copy of the work in question. 17 U.S.C. § 408(b). The Register of Copyrights has described these deposits as "the principal copyright law source for acquisitions by the Library." BERNE CONVENTION IMPLEMENTATION ACT OF 1988, S. REP. NO. 352, 100th Cong., 2d Sess. 22 (1988) (citing *The Berne Convention: Hearings on S. 1301 and S. 1971, Before the Senate Subcommittee on Patents, Copyrights, and Trademarks of the Senate Committee on the Judiciary*, 100th Cong., 2d Sess. 157 (1988) (statement of Ralph Oman, Register of Copyrights), *reprinted in* 1988 U.S.C.C.A.N. (102 Stat. 2853-2861) 3706, 3727 (hereinafter SENATE BERNE REPORT).

3. Feist Publications, Inc. v. Rural Telephone Service Co., 111 S. Ct. 1282 (interim ed. 1991).

claim.[4] Second, with increasing frequency, the Copyright Office has carried out this role in a more modulated fashion, deciding not only whether a particular plaintiff will find the courthouse doors open or closed, but also how wide the aperture will be, and which particular aspects of a claim to copyright in a given work will be allowed to pass through. It does this by requiring a copyright claimant to narrow or focus the contours of the claim, or even to disclaim copyright assertions in some specific aspect of the work, and including these specifications or disclaimers on the face of the registration certificate. Finally, the Copyright Office's practices and guidelines in the registration process, while lacking formal precedential effect, serve to guide the behavior of putative and actual copyright claimants.

Because the courts frequently invest Copyright Office registration practices with preferred status as an authoritative interpreter of the copyright laws, private parties look to the registration process as a more or less valid predictor of the ultimate judicial interpretation of the metes and bounds of copyright protection.[5] In response to this behavioral gatekeeping function, authors may choose to revamp or revise their works in order to win Copyright Office approval of their registration applications, and publishers may choose to de-emphasize or even eschew copyright protection in favor of other methods of safeguarding their investment.

All these gatekeeping functions are particularly important to those claiming copyright in databases and other compilations, where questions of the existence and scope of protection are often difficult and controversial. As Ms. Peters' paper delineates, the *Feist* decision has given the Copyright Office important guidance in its fulfillment of these functions with respect to such works, but many unanswered questions remain.[6] This brief commentary will examine how the gatekeeping functions of the copyright registration process may be changing in the post-*Feist* world, and will highlight a few of the difficulties presented by this evolution. I will also discuss the role of the gatekeeper in achieving the goals of copyright protection, and consider some alternative models of providing that protection while reducing or eliminating the gatekeeping role now played by the Copyright Office in its administration of the registration system.

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4. Section 411(a) of the Copyright Act makes registration a prerequisite to infringement actions in most cases. 17 U.S.C. § 411(a); *see also* SENATE BERNE REPORT, *supra* note 2, at 13-14.

5. Section 410(c) of the Copyright Act makes the registration prima facie evidence of the validity of the copyright, if the work was registered before or within five years after first publication. 17 U.S.C. § 410(c).

6. Peters, *supra* note 1, at 442-44.

II. POST-*FEIST* CHANGES IN THE COPYRIGHT REGISTRATION PROCESS

The questions that face the Copyright Office when it is presented with a registration application for a database or similar compilation, while neither unique nor unprecedented, are undeniably complex. Unlike many other types of works, it is by no means immediately apparent to the examiner that the work in question is a work of authorship at all, and, if it is, in which particular elements the authorship inheres. Compilations of factual data—or, indeed, compilations of other types of material in which the individual items are not separately protectible by copyright[7]—can present a difficult problem. In these works, unprotectible elements—the data[8]—are mixed with protectible elements—the "selection, coordination, or arrangement of the data."[9] Extricating these protectible and unprotectible aspects of a compilation can be a daunting task. The same challenge may be presented by other works—for instance, a computer program may also meld protectible and unprotectible elements—but the job of copyright gatekeeper for compilations may be especially baffling and burdensome.

Quite unsurprisingly, therefore, the Copyright Office's chief strategy is to shift much of this burden back to the claimant. Through the detailed and sometimes quite elaborate correspondence procedure described by Peters,[10] the Copyright Office will in many cases require the claimant to dissect the work into its protectible and unprotectible elements. Claimants will be directed to describe in specific detail the selection or arrangement authorship to be found in the work, and to disclaim any assertion of copyright in other elements of the work that do not exhibit sufficient authorship. While correspondence procedures, and even the use of specific claims and disclaimers, were hardly unknown prior to *Feist*, they could become quite frequent or even routine features of the registration process for compilations in the post-*Feist* environment. The Copyright Office's decision to grant or refuse a registra-

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7. For example, the issues described in the text are applicable to compilations of works that have fallen into the public domain through expiration of the term of copyright protection. *See generally* 17 U.S.C. § 302(a)-(e). They are also unprotectible because they are works of the United States government. *See id.* § 105.

8. Section 103(b) of the Copyright Act distinguishes between copyright in a compilation and copyright, if any, in "the preexisting material employed in" the compilation. *Id.* § 103(b).

9. Section 101 of the Copyright Act, 17 USC section 101, specifies that in a compilation eligible for copyright, the "preexisting materials or . . . data . . . are selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes an original work of authorship." *Id.* § 101. "A factual compilation is eligible for copyright if it features an original selection or arrangement of facts, but the copyright is limited to the particular selection or arrangement." *Cf. Feist*, 111 S. Ct. at 1290.

10. Peters, *supra* note 1, at 744-45.

tion certificate, often viewed as a binary, "in or out" process, will become a more finely modulated decision; the gate will be opened for certain specified claims, but specifically held shut for others.

III. THE ROLE OF THE GATEKEEPER IN THE ACHIEVEMENT OF COPYRIGHT PROTECTION GOALS

The consequences of the proliferation of claim specifications and disclaimers, particularly those appearing on the face of a copyright registration certificate, could be significant, if not unpredictable. These effects could be felt throughout the copyright system, beginning with the registration process itself.

For some practitioners, the evolution of the registration process toward a system of claim specifications and disclaimers may inspire a feeling of "deja vu." Copyright practice may come to be viewed as converging with patent practice, a transition that will be comforting for some lawyers and unsettling for others. There is some evidence that this "patentization" process of copyright is already underway, at least in the chambers of some jurists. The decision of the United States District Court for the Central District of California in *Ashton-Tate Corp. v. Fox Software, Inc.*,[11] invalidating a copyright for an alleged failure to disclose prior art adequately to the Copyright Office in the registration process, seemed to import a very patent-like standard of disclosure to a copyright registration setting.[12] Although the decision was quickly rescinded, it could be a harbinger of things to come as a number of trends drive the trajectory of copyright law farther into a patent orbit.

The perception of patentization, while understandable, is potentially debilitating for the copyright law, since it proceeds from a false premise. It presumes that what the Copyright Office does in its process of granting or rejecting applications for copyright registration is the same as, or at least similar to, what the Patent and Trademark Office does in granting or denying a patent application. But of course the actual processes, although they may be labeled with the same noun—"examination"—are fundamentally dissimilar. While a patent examiner systematically reviews the prior art and applies standards of novelty and nonobviousness, the copyright examiner typically focuses solely on the work as to which the registration application is submitted and looks for indicia of originality, a much lower creative threshold.[13] If the copyright registration certificate in the post-*Feist* era increas-

11. 760 F.Supp. 831 (C.D. Cal. 1991).

12. *Id.* at 835.

13. *See Feist*, 111 S. Ct. at 1287. "[T]he requisite level of creativity [to establish originality] is extremely low, and that '[o]riginality does not signify novelty.'" *Id.*

ingly comes to resemble an issued patent, with claims specified in great detail in both cases, the confusion already abroad in the land may become even more widespread.

If the review of applications for copyright registration is not really akin to patent examination, then what is it? As Peters' paper demonstrates, the review of copyright applications is at best a good-faith evaluation, by existing copyright law standards, of works presented to the Copyright Office for registration.[14] The process is administered by a small corps of dedicated professionals, but the sheer volume of registrations, as well as the growing complexity and difficulty of the law itself, threatens to overwhelm the process. Accordingly, a second strategy adopted by the Copyright Office is to elaborate some bright-line rules that will allow overworked examiners to decide quickly whether to issue a certificate of registration to a given compilation. The goal of these rules—greater efficiency and certainty in the registration process—is desirable; but as with any other process of imposing generalizations upon a diverse reality, the dangers of distorting and ossifying the law lurk not far below the surface.

Two examples of these dangers must suffice for now. First, with regard to the "selection" prong of compilation authorship after *Feist*, the Copyright Office has decided that "listings that are exhaustive . . . are not copyrightable."[15] This is a clear and easily followed reading of *Feist*; unfortunately, it may also be incorrect. *Feist* neither held nor suggested that seemingly "exhaustive" compilations necessarily lacked copyrightable authorship in selection.

The compiler may make original selective decisions at a number of stages in the process of preparing a compilation. First, the compiler must delineate the boundaries of the universe of facts to be compiled. Second, the compiler must choose which of the items falling within those boundaries will be included within the compilation. Third, the compiler must decide which facts pertaining to each item will be specified. An original selection at any stage of the process should be sufficient to establish copyrightable authorship in the selection of data for the compilation. The categorization of a compilation as "exhaustive" signifies, at most, that no copyrightable selection has been made at the second stage of the process. This in no way negates the possibility that an original selection was made in delineating the scope of the compilation or in choosing which facts about the "exhaustive" list of items to include.

14. Peters, *supra* note 1, at 738-40.

Feist is fully consistent with this analysis, although the Court's opinion reverses the logical order in which selection authorship may appear. The Court notes that Rural's white pages directory "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."[16] In terms of the three-step selection analysis outlined above, the white pages are an "exhaustive" listing of all telephone subscribers served by Rural, and the selection of data included about each subscriber—name, town, and telephone number—lacks originality. In other words, there is no selective action taken at the second step, and insufficiently original selection at the third step to constitute authorship.

The Court then turns to what is logically the first step in the compilation process—the delineation of the universe of facts which the compilation will address. The Court notes "in passing" that Rural cannot claim selection authorship at this stage of the process, because the choice of which subscribers to serve—in other words, the demarcation of the universe of facts with which the white pages directory is concerned—was not made by it, but by the state regulatory body that awarded it a telephone service franchise. At this first stage of the process, Rural is not an author at all because "this selection was dictated by state law, not by Rural."[17]

By establishing a bright line rule that original selection is lacking in any "exhaustive" compilation, the Copyright Office overlooks the fact that decisions about the universe of items to be compiled, and about the inclusion or omission of specific facts about each item, may supply the selection authorship that is lacking at the second stage of the process. A compilation of every restaurant in a certain neighborhood of Dayton, Ohio may be protectible as to selection, if the choice of geographical boundaries is original with the compiler and displays a "modicum of creativity."[18] Authorship may inhere in the delineation of the boundaries within which to collect all the facts, as well as in the decision of which facts to collect. In the case presented in *Feist*, Rural made neither of these decisions—the first was made by others, the second was not made at all—but originality and a "modicum of creativity" at either stage should suffice to establish authorship. By presuming

16. *Feist*, 111 S. Ct. at 1296.

17. *Id.* at 1297.

18. Of course, there may also be protectible authorship in the selection of facts to report in even an "exhaustive" list of restaurants: for example, the price ranges for entrees and appetizers, the availability of menus for patrons on special diets, the availability of parking or public transportation, etc.

to the contrary, the post-*Feist* registration practices of the Copyright Office may unnecessarily narrow the straits through which a compilation must pass in order to enjoy enforceable copyright protection.

Far more is at stake than a doctrinal quibble or a split hair. The protection of "exhaustive" compilations is one of the major areas of uncertainty and unease in the database marketplace in the wake of *Feist*. Some of the most commercially and socially valuable databases are precisely those that comprehensively amass and aggregate all the known data on a particular subject or category of items, be it a family of chemical compounds, a group of marketable financial instruments, or a demographically defined class of consumers or neighborhoods. The design, development, and production of these databases may represent a considerable investment, not only in terms of money or "sweat of the brow," but also of creative resources in delineating and defining the scope of the comprehensive compilation and the particular facts to be compiled. It would be ironic if *Feist* were to be applied to offer such an "exhaustive" compilation less protection against verbatim copying than a compilation that omits, perhaps arbitrarily or through inattention, some data that might be of value to some users. That result would not only be ironic, but potentially devastating to the "Progress of Science and useful Arts,"[19] the constitutional goal of copyright legislation, because it would establish a significant disincentive for the creation of precisely those types of compilations that may prove to be most useful to the public.

Another problem with the Copyright Office's approach to registration of compilations after *Feist* is its treatment of originality in the "coordination." The examiners apparently equate this aspect of compilation authorship with "arrangement," and have no apparent plans for dealing with a claim of copyrightable "coordination." Certainly this is a defensible posture, but not ultimately a satisfactory one. To treat this statutory criterion as surplusage is no more useful than to ignore it altogether, as the *Feist* decision itself did, or to read it, as did the court in the *BAPCO* case,[20] to cover precisely the sort of activity—bringing together name, address, and telephone number—rejected by the *Feist* decision as lacking authorship. Without venturing a suggestion as to what "coordination" now means in the post-*Feist* legal terrain, I can simply say that it must mean something, and that the Copyright Office's decision to treat it—at least provisionally—as if it means nothing is inconsistent with most accepted canons of statutory construction.

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19. U.S. CONST. art. I, § 8, cl. 8.

20. Bellsouth Advertising & Publishing Corp. v. Donnelley Info. Publishing, Inc., 933 F.2d 952, 957 (11th Cir. 1991).

IV. REDUCTION OF GATEKEEPING ROLE THROUGH ALTERNATIVE MODELS OF COPYRIGHT PROTECTION

The final question about the evolution of the gatekeeping function is how it will affect the world that lies past the gates. In other words, how courts will react to the Copyright Office's interpretation and application of *Feist*, and, in particular, to the more detailed, specific lists of protectible and unprotectible elements that may more commonly appear on the face of registration certificates for compilations. At this stage, there are only questions and no answers. Will a detailed certificate be transformed, in the eyes of the courts, from a pass through the courthouse doors into a presumptive adjudication of the merits of a claim of copyrightability in particular aspects of a compilation? Will a copyright claimant who acquiesces to the inclusion of a disclaimer in a certificate of registration be estopped from later asserting a claim of copyright in the disclaimed aspect of a compilation? Will the courts become more constrained in the exercise of their independent obligation to determine copyrightability, thereby granting increased deference to the findings implicitly made by the Copyright Office in issuing a certificate that bears specific limitations? Or, conversely, will courts give more intensive scrutiny to the Copyright Office's application of the *Feist* principles to compilations than might be the case in other, more settled areas of the copyright law? Finally, will the determinations of the Copyright Office with respect to the issue before it in the registration process—whether the work "constitutes copyrightable subject matter"[21]—spill over into the courts' rulings on the scope of protection and the existence of infringement?

Whatever the answers to these questions, their pertinence should impel us to look at the gatekeeping function of copyright registration anew. If the process evolves to the point that major statutory and even constitutional issues about copyright protection for compilations are being resolved, for all intents and purposes, in ex parte, quasi-administrative registration proceedings rather than in adversary proceedings based on a full factual record, there will be cause for concern. Even if these consequences do not occur, it is worth considering whether the gatekeeping function of copyright registration is an essential part of an effective system for defining and enforcing intellectual property rights in compilations, and, if not, what alternatives are available.

This is not the place to revisit the extensive debate over whether copyright registration as a prerequisite to enforcement is compatible with the Berne Convention, although the temptation to do so is particu-

21. 17 U.S.C. § 410(a) (1988).

larly strong in light of the misreading of that debate by the panel of the Eleventh Circuit which decided the *CNN* case.[22] Rather, the question is whether it would be possible, and if so, whether it would be desirable, to diminish or eliminate altogether the gatekeeping function of the current copyright registration system with respect to compilations. The question is not mine alone, but is implicitly posed by three recent or impending developments in copyright law that have taken on new significance in the wake of *Feist*: the treatment of compilations that are not works of United States origin; protection of compilations through misappropriation or unfair competition doctrines; and the forthcoming European Commission directive on databases.

The first feature is already on the books, but may be in fact of mostly theoretical interest. The Berne Convention Implementation Act of 1988[23] eliminated the gatekeeping function of registration for "Berne Convention works whose country of origin is not the United States."[24] Because many commercially significant databases and other compilations, even in the United States market, are prepared by employees of companies of non-United States (mostly European or Canadian) origin, many unpublished compilations could easily, and even published compilations could, without great difficulty, qualify for this status.[25] Infringement actions with respect to such works could be brought in United States courts without first seeking to register the work with the Copyright Office, and any difficulties arising from a qualified or restricted registration certificate could thereby be avoided. As a practical matter, however, we are unlikely to see many examples of this, because Congress left the other significant statutory incentives for copyright registration undisturbed. The attractiveness of remedies such as attorneys' fees and statutory damages[26] is likely to outweigh the desire to avoid running the gauntlet of the registration process in

22. *Compare* Cable News Network, Inc., v. Video Monitoring Servs. of Am., Inc., 940 F.2d 1471, 1483 (11th Cir. 1991) (doubt should be resolved in favor of compatibility) *with* SENATE BERNE REPORT, *supra* note 2, at 14-19 *and* 134 CONG. REC. S14554 (daily ed., Oct. 5, 1988) (Joint Explanatory Statement on Amendment to S. 1301) (Berne Convention Implementation Act as passed is "fully consistent" with Senate Judiciary Committee conclusion that registration prerequisite is incompatible with Berne).

23. Pub. L. No. 100-568, § 1, 102 Stat. 2853 (1988).

24. 17 U.S.C. section 411(a), as amended by the Berne Convention Implementation Act, exempts such works from the registration prerequisite to enforcement. 17 U.S.C. § 411(a) (1988).

25. The Berne Convention Implementation Act amended 17 USC section 101 to establish rules for determining whether or not the country of origin of a Berne Convention work is the United States, in which case the registration prerequisite still applies, or is not the United States, in which case registration is no longer a prerequisite to an enforcement action. Pub. L. No. 100-568, § 1, 102 Stat. 2853 (1988).

26. See 17 U.S.C. § 412 (1988).

most cases, although that balance could change if the registration process comes to be seen as onerous and unproductive.

The availability of protection against copying of compilations under a misappropriation or unfair competition theory is a matter of lively debate, as other articles in this Symposium illustrate.[27] To the extent that such protection is currently available under state law, or under future state enactments that are not preempted, registration would not be a prerequisite to enforcement. However, a clear delineation between copyrightable and non-copyrightable aspects of the compilation would certainly be a central focus of such litigation, since protection of the former would clearly be preempted.[28] Decisions of the courts in these cases could provide a testing ground for determining whether the gatekeeping function of copyright registration aids or hinders the efficient and consistent resolution of statutory and constitutional questions of copyrightability of compilations.

If, in response to *Feist*, the statutory preemption standards of section 301 were changed to allow a plaintiff to elect whether to pursue copyright or non-copyright remedies against a given act of copying, then the presence or absence of registration as a prerequisite would be one factor, and perhaps a significant one, in the plaintiff's election of remedies. Of course, the enactment of a federal anti-misappropriation statute applicable to compilations would provide a similar laboratory for evaluating the importance of copyright registration as a gatekeeper, assuming that the new statute did not require a similar registration process.[29]

However, the first post-*Feist* development on protecting compilations without copyright registration as a prerequisite may well come from Europe. While at this writing, the European Commission (the "EC") has not yet unveiled its draft directive on intellectual property protection for databases, it may well include both copyright and non-copyright provisions.

Although, in the United States, the advent of *Feist* has had little immediate impact on the existence of copyright protection for compilations and has raised more controversy with regard to the scope of that protection, in some European circles the emphasis of post-*Feist* commentary has been reversed. As the *Feist* decision noted, the "vast ma-

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27. *See, e.g.*, L. Ray Patterson, *Copyright Overextended: A Preliminary Inquiry into the Need for a Federal Statute of Unfair Competition*, 17 U. DAYTON L. REV. 385 (1992); Dennis S. Karjala, *Copyright and Misappropriation*, 17 U. DAYTON L. REV. 885 (1992).

28. Section 301 of the Copyright Act preempts claims under state statutory or common law that protect rights equivalent to those protected under copyright, and that apply to works of authorship that come within the subject matter of copyright. 17 U.S.C. § 301 (1988).

29. Section 301 does not pre-empt any claims under federal law. *Id.* § 301(d).

jority" of compilations will receive at least some protection under United States copyright law, although the scope of that protection is "inevitably . . . thin."[30] Under the relatively high originality standards prevailing under some continental European copyright systems, by contrast, it is felt that a somewhat higher proportion of compilations may fail to meet these standards. Accordingly, even though a hearing convened by the EC in 1990 demonstrated a consensus in favor of protecting databases under traditional copyright principles,[31] the EC draft directive may include a multi-tier system of protection. Compilations meeting a stated originality standard will be protectible under copyright; in addition, a species of misappropriation or anti-parasitism protection will provide remedies against at least some types of copying of all compilations, whether or not copyright protection also applies.

Presumably neither tier of protection will be conditioned upon compliance with a registration procedure or similar gatekeeping function; the copyright laws of all EC countries allow for enforcement without the imposition of any such formalities, in keeping with the general view of the requirements of the Berne Convention.[32] If indeed the directive is ultimately adopted in this form and is so implemented by the laws of the individual EC member states, then the European single market could provide a fertile ground for study of the effectiveness of intellectual property protection for databases and other compilations in the absence of a gatekeeping function such as that provided by the United States copyright registration process.

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30. Feist Publications, Inc. v. Rural Tel. Serv. Co., 111 S. Ct. 1282, 1289, 1294 (interim ed. 1991).

31. The statement of conclusions of the hearing prepared by the European Commission staff noted that "as to the applicability of an alternative form of protection instead of copyright (neighboring right or sui generis right), a large majority of participants rejected this approach." *Commission Hearing on Copyright and Databases: Conclusions*, item 5, Commission of the European Communities (Apr. 26-27, 1990) (Directorate Generale III: Brussels) (on file with author).

32. "No major player in the Berne system, such as the European nations or Japan, requires registration as a condition of judicial enforcement of copyright." SENATE BERNE REPORT , *supra* note 2, at 18; *see also id.* at 14-19.