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Open Discussion of Presentation by Steven J. Metalitz, Esq.

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OPEN DISCUSSION

MR. CHAIRMAN: As we start our discussion, I should first compliment everybody for yesterday for the way they conducted themselves during the discussion. People did introduce themselves so we knew who was speaking, people spoke one at a time, and I hope we continue to do that today.

MR. SPIEGEL: I have listened for the last day and a half, or day and a quarter, to lots of discussion about selection, coordination, and arrangement as it applies to compilations of copyright, but one thing still troubles me. We live in an era now that has been changed by the introduction of new technologies that has made possible compilations of an exhaustive nature which really never previously existed. What does a company who has created an exhaustive database of really unquestionably factual information, and to be more specific about the example, supposing I have a database of the list of the name of every person who has ever appeared in any capacity in connection with a motion picture and to service is rendered a list of credits. What does that company do beyond having contractual limitations to those people who access the database with respect to the Copyright Office? Does that company attempt to register that database and run the risk that it will be rejected or what?

MS. PETERS: I am not the company. I can answer if I step outside the Copyright Office, I personally would not want to risk—if I knew totally what the Copyright Office was going to do, if I knew they were going to say no, I would not register it. And I say that to people with regard to computer programs where there is an issue with regard to the interface screens. If you send us the interface screens, they are going to be examined one by one and the letter will go out that says that we believe that one or some or all of interface screens are uncopyrightable. Almost all practitioners send the program without the screens and say we claim whatever is copyrightable and leave it to a court to decide whether or not a particular screen is copyrightable. But I honestly believe that if you know you are going to get a rejection, unless you want to go to court, and remember we are totally arbitrary and capricious, you are probably better off not registering it. It is a personal view.

PROFESSOR LITMAN: I would think that there are things that the company could do with that database that would greatly enhance the likelihood that the examining division would pass you. You have got this list of names, but you can make all sorts of subcategories within them that will pull up only parts of this thing, sorting them to

some degree by criteria that are colorably subjective, or colorably less than exhaustive, within the database. So that, as a whole, is going to look a whole lot more like a work of art.

MR. SPIEGEL: In the fact situation it does that, but the categories are categories which existed before the company came into existence, because if you look at the list of credits, people are characterized as actors or directors, or whatever, so there is really nothing that they have been able to add to that organization new.

PROFESSOR LITMAN: Sure you can. You can subdivide those into technical people, creative people, people who wrote underlying works, who are union members, nonunion members, and sex and so forth, and then start thinking about adding some ways of categorizing them that do require some judgment, as people who worked on the camera end, people who worked with the film post-production, where you are going have to make some judgment about how given positions fit in, principal actors, and extras. Some of that is going go be defined by the industry contracts but those industry contracts have not been the same through time, and I would think that you can add on to the database some categorizations, some selections that are indeed going to meet the current definition of minimally creative authorship in the selection criteria.

MR. SPIEGEL: Maybe they will, but I would like to refer back to Ms. Peters and ask her what her reaction to that is. I am still troubled by the fact that I do not know whether or not the Copyright Office will accept that as copyrightable material, and I am very much concerned that if I do submit that and I get rejected, I have a much bigger problem than if I never submitted it at all. And I think this also raises sort of a separate question, which is that there needs to be more certainty. I think that a lot of people seem relatively comfortable with the present situation, but I am not. I am very uncomfortable with it, and I am uncomfortable with it because of the uncertainty. In many cases I do not know what to tell my clients in terms of, other than to do whatever they can, but I cannot give them the assurances that I would like to be able to give them, that if they do certain things they are going to be okay.

MS. PETERS: Well, I think everything that I have read about the *Feist* case afterwards is to cloak the database with as many additional things that you can in order to make it copyrightable. Jessica Litman's suggestion bugs me in the sense that I am not so sure breaking it down in all those ways is terribly useful, and now you are going to all this waste to try to get it to be protectible and that bothers me. It is kind of like having to go back into original research and it is not worth it. Going back and adding in categories so it can be registered with the

Copyright Office, I find troubling. But the Copyright Office is not supposed to dissect things, and this comes up a lot of times with genealogies. People do preparatory tasks, people do little hints on how to use a database. I am not sure that helps you with the scope of protection that you get for it, but it gets you through the Copyright Office. And so it depends on what you want and how far you are going to go. I will stop there.

PROFESSOR LANGE: I guess I would like to know more from Jerry about what the database consists of because I could understand what Jessica was saying, but if it's the kind of collection that I imagine it is, you would not want to do that, you really would not want to do that kind of stuff. You are really talking about picture by picture bills, right?

MR. SPIEGEL: Yes. What you have essentially is an exhaustive list and again it is computerized database so there is no organization. It's not as if I could put it in the book and organize it. It is just bits of information and I can call them up in any one of a number of ways, and essentially by doing that, the user is creating his own little database. If I want to call up the name of every film that a particular actor appeared on or whatever, the computer will do that. But the point is that what's on the computer is exhaustive and it is also unquestionably factual, and now what do you do? Does that mean that this company's database is not protectible at all and is that the sort of result that is socially desirable or not?

THE CHAIRMAN: David, do you want to follow that up?

PROFESSOR LANGE: It seems to me that one drift in the response is likely to be toward less deference to the register's office and more use of the register's office for the essentially neutral function of providing a place of registry but I mean actually it seems to me that that is appropriate in any event under section 102, the copyright subsists or it does not subsist and I don't really see that the registry's function—mind you everybody loves the registry and the office.

MS. PETERS: That is all right. I do not take any of this personally.

PROFESSOR LANGE: I do not think that the register now under the '76 Act has the same kind of discretionary function to play that it did have under section 12 and section 10 of registration. The law has just changed on that. I think the deference the courts have continued to give it probably is unwarranted now and may be no longer as feasible after *Feist*.

PROFESSOR KARJALA: I like this example. I think it is a very good one because it shows how completely off focus we are on what is really calling for protection in a work like this. You can put all this

extra organization into this database if you want, maybe you can get into the Copyright Office on that ground, but then if someone has access to it, they can still take all of your facts out anyway without taking your organization and they have not infringed any copyright. In fact, by going through the Copyright Office and answering all the questions they ask you, you may be impliedly saying that that is really the extent of your originality. The information in this database is publicly available, anybody can get it, and anybody can enter into their own database if they want to. What is valuable in your database is that you guys have put it in electronic form. That is what really calls for protection. It is the effort—I have to say it, I do not care what *Feist* says—it is the effort of putting it in. That is what calls for protection here. And the question is whether we can find some way of protecting that effort without going to the other extreme, which I think Steve Metalitz's talk brought up and we talked about yesterday. But, and because I do not think this can be said too often, this emphasis on selection is especially dangerous because it can overprotect. We have to remember that creativity alone is not a ground for giving copyright protection. Ideas are not protected; functionality is largely unprotected, regardless of how creative the works are. Creative ideas and functionality are not as such protected by copyright. And when we are talking about selection in the case of the maps or telephone books, it has been suggested by a number of people here that if Rural had somehow made its own decision as to what area it was going to cover in its telephone directory, that selection might have been enough because the creativity requirement is so minimal. I suggest that we have to remember that idea/expression still applies to these kinds of works, and we have to realize that lots of this selection is either functional or it is idea. I just do not think it makes sense to say that nobody else can make a telephone book covering a given area or, say, that if a map of a particular seacoast shows all the resorts, no one else can make that same map even though she does all independent legwork. That simply expands the notion of expression much too far, and there is a danger of doing that in an effort to get around the *Feist* intellectual creativity requirement. So it is a mess.

PROFESSOR RASKIND: I wanted to ask Marybeth Peters: Assume that there is enough consensus so there is a draft misappropriation statute suggested to Congress under the Commerce Clause or however. Could you describe the processes and structure in the Copyright Office for determining the Copyright Office's position on pending legislation, and if you want to speculate on this one and comment, how do you think it would come out?

MS. PETERS: I will get killed back at home. Usually on a piece of legislation where the Copyright Office is going to testify, it is aware

of what the various positions are of the industry, of the academic community, and of the user community.

PROFESSOR RASKIND: Do you become aware by holding hearings before?

MS. PETERS: No, we do not. We read everything. We are part of the Library of Congress, which is a very large user community, and we hear their views day in and day out. We read a lot. The Copyright Office personnel have a lot of connections to a lot of different places, but we do not hold a hearing. That is Congress' purpose to have the hearing. We basically perform more of an academic kind of exercise to look specifically at the legislation, to look at what the Constitution says, what was done with regard to the law in legislative history, it is really quite a legislative history with regard to misappropriation, and what Congress, especially the House, thought it was doing and what was in and what was out, and make a recommendation. It pretty much is a total independent, aware of what is going on, but it does not seek—Congress is having a hearing, Congress is going to be doing that, Congress is going to get those views. That is not what they are asking the Copyright Office for.

PROFESSOR RASKIND: How many people, how big a staff would be involved, how big an operation is it?

MS. PETERS: It depends. The legal department from the Copyright Office general counsel, and she has a staff, and then there are four policy advisors, who are all lawyers who report directly to the register, kind of like a kitchen cabinet. So the general counsel's office, they do their thing, and then the policy people get together and do their thing, and it all comes together. And I can tell you right up front most issues there is not agreement in the Copyright Office. Right now we're doing digitized typeface and computer programs, and we are split right down the middle as to what we should do. So, all the things that you hear in the world happen in the Copyright Office too before a position is reached.

MR. ODOZYNSKI: Marybeth, you referred in your talk to the *Sem-Torq* case about the double-sided signs. In that case the copyright claimant received a letter back from the Copyright Office indicating somewhat inscrutably to me that they had doubts about the copyrightability of the designs because of the nature of the authorship or lack of authorship. That can be taken to mean a number of things. What I have assumed it meant was that because of the minimal quantum of subject matter that the claim that was submitted to the Copyright Office, that is there were five sides, ten sides, or whatever, that was what the Copyright Office was referring to in terms of authorship and that

was not a pronouncement about the originality or creativity in that sense?

MS. PETERS: Yes. Usually what it is saying when it does a rule of doubt on the subject matter, that is usually the area that it is in. It is really saying we are not sure that this is enough, but under the rule of doubt we are willing to let it go forward.

MR. ODOZYNSKI: So it really is a comment on the quantity of the subject matter not on the quality?

MS. PETERS: Certainly. We really cannot judge that. It really is a compilation; it is a literary work. Is there enough? We are not sure. And David Lange's point over here is an interesting one, because I think the Copyright Office section has more authority under this Act than it did under the previous one, but one of the interesting questions is the rule of doubt. I am not sure as an individual given you register it if it is copyrightable, and you reject it, if you do not, whether there should be a rule of doubt. We keep it because it benefits applicants, but I think you can argue that you have to make a decision that it is or it is not and this rule of doubt does not fit in the language of the law.

PROFESSOR REICHMAN: I want to ask you just a specific example as a hypothesis. I have here a little card for your wallet put out by AT&T, U.S.A. direct or express call to the United States; dial access countries, dial one most phones; and a column down the middle in the back, and alphabetically going down the middle, Italy, it gives the access code then on the back, designated countries. Down here I notice tucked around in the corner copy, has a "C" copy with a circle around it, then 99 AT&T.

MS. PETERS: We would register that.

PROFESSOR REICHMAN: You would register that notwithstanding the *Feist* decision.

MS. PETERS: I think that is right on the basis of the selection of the cities.

PROFESSOR REICHMAN: I think that they put in every city that they could get access to.

MR. CUTLER: That card has every AT&T direct phone number available in the world on it.

MS. PETERS: If it is every direct one that they have, they are going to get a letter from the Copyright Office, like the letter that is in my material, and if the answer is it is all the access that there is in the world today and it is ordered alphabetically—

PROFESSOR KARJALA: All the largest cities.

PROFESSOR LANGE: The one hundred best cities.

PROFESSOR REICHMAN: This really shows the power of Dennis Karjala's point. The question in *Feist*—and I heard the point raised

in Salamanca by Adolph Deist as well—is that *Feist* did not delve into what we mean by "originality." The term cannot mean what the Court thought it meant because "originality" signifies independent creation, and there are not degrees of independent creation. Therefore, it had to mean creativity; and given the statutory wording of section 102(a) it had to mean a "work of authorship." And the question is what do we mean by copyrightable, creative work of authorship?

Here Dennis Karjala's point becomes very powerful. I thought it was always powerful, but after *Feist*, it becomes very powerful. Because the question becomes what kind of authorship is it for which we are giving seventy-five to a hundred years of protection? If it is not literary and artistic expression, if it is just technique, then we would not give a cure for cancer more than seventeen years. Why are we going to give this little bit of technical selection seventy-five to one hundred years in copyright law, with a strong derivative included in the bargain?

MS. PETERS: Well, I asked a question last night which is: Assume that you do make a decision on the categories and let's say they are not all inclusive and they are judgmental. There are ten of them and that is enough. But once you—and then you publish it day in, every day. Technically, every day you get a new copyright and if you do not change the criteria for a hundred years, a hundred years on the basis of the criteria because you impute that authorship that was made up front to what happens every day, but every day it is automatic.

PROFESSOR REICHMAN: Would that be a point for Mr. Metalitz'—would that strengthen the case for eliminating the registration system?

MS. PETERS: We face it with the registration system every day.

PROFESSOR REICHMAN: No. On the theory that ninety percent of it is going to remain outside the system anyway because it is changing every day, and that it is too arbitrary a selection of stuff that happens to come along, then anything that happens to get a determination from the Copyright Office could have an untoward effect on litigation. Why did that particular bundle of information, that random aggregate of data that filtered through the Copyright Office and provoked a decision, become legally cognizable? Whereas, tens of thousands of units or items that are equally important—I do not mean stuff that is necessarily out of the system, but stuff that is equally important and that could be litigated about at any moment—just does not come through the system because it is being revised and rewritten every day. I do not know.

MR. METALITZ: I think the point there is that imputation of authorship is really kind of an artifact of the registration process. You would not be that concerned—

MS. PETERS: You would not care if you did not have to register it.

MR. METALITZ: Because you are going to change your selection criteria in seventy-five years.

MS. PETERS: Yes. You can be out of business.

MR. METALITZ: But the fact is that January 1, and January 2, and January 3, and January 4, you want those registered because if somebody copies your January 4 edition, you want to be clear that you are entitled to something. I guess the *CNN* decision kind of puts more of a spotlight on that, to try to register things that have not come into existence yet, but I guess that is the logical step beyond.

PROFESSOR GORDON: I would like to clarify the duration issue you just spoke about. If I understand your example, it seems to me you would not get a new copyright each time. Let me try to see if I understand.

You have something that uses selection criteria and you come up with some sort of original way to organize material. Everything after that is routine and rote. Now, it seems to me that you might very well get a very strong copyright on your mode of organization but that only happened once. Then on day two, three, four, and five, you do not get new copyrights because to get a new copyright you have got to do something original.

The question is posed: What happens if somebody copies day fifty-six? At that point you do have a copyright infringement action, but it is not because it infringes an independently copyrightable work on day fifty-six. What you did as a copyright creator on day fifty-six was produce a mere copy of the thing that you created on day one. It looks a little different because the computer turned up something new, but all you have done is make a copy that looks a little different from what you did on day one. And a person who copies what you do on day fifty-six is infringing what you did on day one. That is, they are taking the creativity of the selection and organization decisions you made on day one. So I do not think the duration problem is as bad as you describe, and it would really upset me, I guess, if I thought the Copyright Office was really giving separate registration to day two, three, four, five, and six, when there is nothing creative in those days.

MS. PETERS: We are and we do, and that is group registration of ordinary databases.

PROFESSOR GORDON: I protest. Seriously—if my analysis of what you do is right, would you tell me why you do it?

MS. PETERS: I will tell you I made the arguments you did up front. But from a perspective of it, it never has been in a rule-making procedure. It never has been discussed openly, but what you have is new data going in constantly, people copying that data, and, in essence, although the selection criteria have not changed, they are just being applied in data day in and day out, it was just felt there was "new representation of that authorship" day in and day out and on that basis they are registered.

MR. METALITZ: I suggest again it is an artifact of the gatekeeper function—

MS. PETERS: I think it is too.

MR. METALITZ: —because when someone copies on day fifty-six, you want to sue them. If you come in with day one, the courts are going to say, they did not copy this. This is a—

PROFESSOR GORDON: I do not understand. The copy argument you made seems to be a right of action regardless of whether you registered number fifty-six or not.

MS. PETERS: I think you would have a very difficult time in the court. I agree with Steve [Metalitz]. I think that this thing about new copyright day in and day out with the registration requirement that you must register each published edition does not fit comfortably with our system of automatic copyright, and I think that what the Copyright Office does is try to make that work. But I think, up front, the idea that you have automatic copyright and you do not have to do it, but we have a rule that says that you register every published edition has caused this. And I would not want to go to court on day fifty-six and argue I have not registered, your Honor, because way back here, it does not look anything the same, my copyright is back here.

PROFESSOR GORDON: It seems to me that you just opened the door to your answer, that you did register it as another published edition not as a new work. That is like saying you have got to register a copy of each printing.

MS. PETERS: We only have authority to register a new work.

PROFESSOR GORDON: We know under administrative gatekeeping you could extend your authority to do that, if you want to.

MS. PETERS: They changed the law.

PROFESSOR KARJALA: There is no more new authorship.

MS. PETERS: That is what I am saying.

PROFESSOR GORDON: I am saying as an administrative matter, it seems arguable for housekeeping purposes, you can authorize the office to keep track of each new edition even without the copyright, like each new printing of a paper book, without giving a new copyright date each time, and that way at least you could show it was part of this

stream and it would be easier to make a court case without raising the significant durational question.

MS. PETERS: I would just say I really do think you have to change the law to do it because it is worded that if a work is published you may only register a new published edition if there is new material. And I will just give you a quick example whereby it can be very problematic. We had cases with regard to video games that were first published in Japan. They got changed a little bit for the United States market but not copyrightable authorship. They want to try to register the United States version and we say no copyrightable changes. They go to court and they say it is not the same work. We end up getting involved saying they tried to register it. We said that the Japanese version covers everything, no changes. But it is very difficult when you are marching into court, and it looks different than the thing that got registered.

MR. ODOZYNSKI: I think I understand about this subsequent registration time on the fourth and fifth and sixth of the month. Let's change it a little bit, and let's suppose, getting back to the hundred best restaurants in Phoenix, and we did this in 1981 and generated a compilation that was copyrightable, did it again in 1990. As people who know Phoenix, there will be a hundred restaurants in 1990. You have the same selection criteria, you have a different work. That is the same variable of the hypothetical I think she is posing except that what happens is the time span is different and therefore you can expect the result to be different. So I think that there is a possibility that the compilation that is generated on the fourth can be copyrightable as well as the one that is generated on the fifth. The problem is if the quantum, if the background match is such that the incremental change between the compilation on the fifth and the sixth and the one on the fourth is minimal, then we may not have different subject matter, but the problem does not result or emanate from the fact we are applying the same selection criteria there on the different days to different works I do not think.

MR. METALITZ: I would argue that that is a different selection, because the universe out there from which you are selecting is different from what it was in 1990.

MR. ODOZYNSKI: So, the selection or the database we selected on the fourth will be different from the one we selected on the fifth, probably. The difficulty is it may be only incrementally different. It might not on its face then be enough to support a second copyright.

MR. METALITZ: You did not say what it was, but—

MR. ODOZYNSKI: I guess the other question I have is whether

PROFESSOR PATTERSON: That would be a lack of authorship if he was simply copying what he has already done.

MR. ODOZYNSKI: I am not assuming the answer. I am just asking whether, for example—never mind.

PROFESSOR LANGE: That is an interesting point. I wish you would spell out that example because if it goes where I think you are going, I would just like to hear it.

MR. ODOZYNSKI: I was groping for the example.

PROFESSOR GORDON: Ms. Peters' example is exactly the one where the Copyright Office does allow you to copy yourself and still get copyright; the case involves an adapted compilation. That is why I presume you had trouble with that one.

MR. ODOZYNSKI: What I was going to say, for example, in patent law, as you are probably aware, there is a statutory bar that operates in patent law that is if you do not file or make patent application within a certain period of time after some other event, then you are barred. An inventor's own activity cannot absent the application, the statutory bar cannot be prior art to him. So, that is what I was thinking, when I asked whether or not it would be possible, conceivable under sort of that same sort of thinking for an author to copy from himself. Copying has always been taking someone else's work, not your own.