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RESPONSE OF KURT D. STEELE TO DENNIS S. KARJALA'S COPYRIGHT AND MISAPPROPRIATION*

*Kurt D. Steele***

Professor Karjala in his very extensive paper *Copyright and Misappropriation*[1] has tackled a big job: exploring the need to protect works from "piracy" or "misappropriation" which will be "underproduced" without some form of protection. The central thesis of Professor Karjala's paper is that the concept of misappropriation should play a significant role in answering the difficult question of what copyright protection should be afforded to a variety of non-traditional works.

Although I believe Professor Karjala at some points in his paper becomes mired down in complex theoretical justifications, particularly with respect to establishing originality, what is particularly refreshing about his paper is his strong focus on the socially desirable need to protect certain types of works. Unfortunately, too many discussions about copyright never get beyond an arcane tour of where the copyright law has been. They forget that without appropriate incentives many works that our society and economy increasingly need to grow and prosper will not be produced.

While Professor Karjala discusses the copyright basis for many different types of non-traditional works, he spends much of his time on factual compilations and maps. These works are of great interest to our company and to me.

With respect to compilations, I believe he overstates the point when he says that, to a large degree, the decision in *Feist Publications, Inc. v. Rural Telephone Service Co.*[2] may have been inevitable given the copyright statutory language concerning what a compilation is and the poorly formulated skill-based "sweat of the brow" theory of protection. Professor Karjala raises, however, the very interesting question of whether "the Supreme Court might legitimately have adopted a less literally correct course that nevertheless better meshed with underlying

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1. Dennis S. Karjala, *Copyright and Misappropriation*, 17 U. DAYTON L. REV. 885, 909-17 (1992).

2. 111 S. Ct. 1282 (interim ed. 1991).

social policy."[3] But perhaps more simply, could not the Supreme Court have taken a more expansive view of copyright for compilations that would protect "unfair" takings of them consistent with the copyright law?

Professor Karjala works very hard in his paper to answer this question in the affirmative. Unfortunately, he finally draws the conclusion that given the *Feist* decision an amendment of the copyright law will be necessary to adequately protect many non-traditional works against misappropriation. I believe, however, some of Professor Karjala's ideas effectively support the opposite conclusion and that there should be sufficient room for courts to provide adequate protection without such an amendment. Of course, this is only a preliminary view. While the several post-*Feist* decisions to date have been generally encouraging, it remains to be seen whether the courts will fully rise to this challenge.

As we all know, *Feist* holds that the only protectible expression in a factual compilation is its original selection, coordination and arrangement of facts (the "SCA") and not the facts themselves.[4] The threshold issue, therefore, is whether a particular compilation evidences sufficient originality to be *copyrightable*.

With respect to this issue, at least as it relates to compilations, I think little more needs to be said than what the *Feist* Court itself said:

> 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. . . . 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.[5]

I believe Professor Karjala's concern, that courts will find the minimal level of creativity that *Feist* requires for copyrightability and then will "afford copyright protection to *all* creative aspects of protected works,"[6] is misplaced. Although I am not sure exactly what Professor Karjala means by "creative," it is clear that both the *Feist* decision and the several post-*Feist* decisions to date, while going to great lengths to reaffirm the need for minimal creativity in order for a compilation to be copyrightable, have explicitly and repeatedly affirmed that only the SCA and not the underlying facts of the compilation are protectible.

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3. Karjala, *supra* note 1, at 894.
4. 111 S. Ct. 1282 (interim ed. 1991).
5. *Id.* at 1287 (citations omitted).
6. Karjala, *supra* note 1, at 891.

Professor Karjala deals creatively, however, with the other major issue—the *scope of copyright* for copyrightable works. Although he takes his time in acknowledging that if copyrightability means anything for a compilation it means you cannot make a direct, mechanical copy of it, he also raises the very important question of whether the scope of protection should also cover substantial takings, or even limited takings, of part of an original compilation for use in a variety of contexts without protecting ideas *per se*. Such contexts include use in a competitive work, in a non-competitive work, in connection with a verbatim taking of only the facts but not the coordination and arrangement and in connection with a taking as the basis of a new value-added work.

Professor Karjala reminds us that the difficult problems of deciding where facts end and expression begins is present in both compilations and textual works. As he indicates, in addition to the verbatim language, idea-like elements of structure and plot are protectible in a novel. On the other hand, although expressions of historical and scientific ideas are protectible, courts have usually accorded less protection to those expressions because of their idea content.

Professor Karjala suggests that some courts have shown significant flexibility in drawing the line between idea and expression by implicitly evaluating the "fairness" of the taking. He argues that long-established misappropriation notions inherent in the fair use defense and common law misappropriation should be useful in helping to define the scope of protection for compilations.

Although I recognize I am taking a little editorial license, I believe Professor Karjala is saying several very important things here:

(1) The *Feist* mandate of limiting the *scope of protection* to only the SCA of a compilation could be unfair in many cases because arguably it permits a subsequent "author" to take many of the "facts" of a compilation as long as the selection of such facts and their arrangement and coordination are not substantially the same.

(2) The natural result of such a scope-of-protection standard will be that many compilations that are produced today will be "underproduced" because the economic investment required will not be rewarded and that would be "unfair." Our society and economy will suffer as a result.

(3) Although, as *Feist* makes emphatically clear, only original expression is protectible and "raw facts" may be reused by subsequent authors, what the raw facts are is not easily discernible in many cases. Just as for textual works, fair use or misappropriation concepts would be very helpful in determining the scope of protection. The use of these concepts in defining the scope of protection should result in a better balance between underprotection and overprotection determined in ac-

cordance with the specifics of each situation, and in particular, should address in a fundamentally fairer way how to draw the line between idea and expression.

Using Professor Karjala's approach, I suggest the following possible compilation fair use criteria that could be used to draw a more informed line between expression and idea:

(1) *The substantiality of the taking from the copyrighted compilation.* To a large degree, this criterion would cover the *Feist* elements of selection, coordination and arrangement, but the inquiry would go on to consider the following criteria.

(2) *The nature of the "facts" and in particular the degree to which the "facts" in the compilation are "value-added" versus "raw."* The case law really has not dealt in very much detail with the concept that not all "facts" are the same. Some facts are much more common and widely known, or in the parlance of *Feist*, "raw." Their compilation should obviously be protected less than other "facts" where there is significant "value-added" authorship involved. Of course, in the latter case we probably are talking about "expression" and not "facts" at all.[7]

(3) *The degree to which the second work adds value to the facts taken or transforms them into something else.* While we all know that preparing derivative works is one of the exclusive rights given to a copyright holder, there is still a legitimate issue of what use the appropriated facts have been put to in the second work. If they have only been the starting points for the creation of substantially new "value-added" facts, and depending upon the number taken and an evaluation of the other criteria suggested here, such use might be considered "fair."

(4) *The degree to which the second work is competitive with the first work or can be a substitute for it.* To use the classical "fair use" example, if the second work is scholarly and the first work is published for business uses, in many cases the use of facts from the first work would be considered "fair," depending, of course, on an evaluation of the other criteria suggested here. This would be the case, as Professor Karjala suggests, if the first work contains "hot" facts which lose their

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7. For example, one of Rand McNally's businesses involves the creation of road mileages, which are used as a basis for determining trucking tariffs. While these miles may appear to be just raw "facts," they are in reality the result of a value-added cartographic and algorithmatic process based on a series of complex rules. In many cases, our tariff miles would not be the same as the miles you might measure if you physically measured them yourself. This sounds as if we are not talking about just "facts," but rather protectible expression. Someone else should not be able to copy protectible expression substantially just because they take some lesser, but still substantial, number of the mileages and arrange them differently. This would be particularly so if our mileages were taken and used in a competitive way.

commercial value over time and the second work is published after such facts "cool." On the other hand, there should be a much more difficult burden placed on the author of a second work, which is viewed by the marketplace as very competitive with the first work, even if the taking from the first work was of a limited number of facts and the coordination/arrangement was generally different, unless, of course, after an analysis the facts are only "raw."

By looking to all of these factors *together*, a court should be able to make a much more informed decision about where to draw the line between expression and idea. Although there is no question that several courts that have handed down decisions after *Feist* have struggled to draw the scope-of-protection line by implicitly trying to use these factors, the strong language in *Feist* has not let them do this in a very explicit fashion, particularly with reference to the last three fair use factors suggested above. In large part, I believe this is the result of the unambiguous nature of the "facts" in the *Feist* case, namely telephone listings. If the facts had been "clothed" with more expression, the *Feist* Court would have been forced to give us more guidance on how to separate unprotectible raw facts from protectible factual expression.

Nonetheless, recent cases like *Key Publications v. Chinatown Today Publishing Enterprises*,[8] which was handed down by the Second Circuit a short time ago, shows sensitivity to some of these misappropriation factors. While the court repeats the oft-quoted principle that "[c]ompilers operating under different principles of selection are not obligated to repeat factual research already undertaken . . . by others," it is implicitly concerned with whether the two works in question are in competition when it notes: "Indeed, any consumer faced with the two directories would instantly realize that they are quite different."[9] The court also seems implicitly concerned with the value of taking a limited but commercially significant part of a plaintiff's work when it says: "If the Galore Directory had exactly duplicated a substantial designated portion of the 1989-90 Key Directory—for example, all its listings of professionals such as medical doctors, lawyers, accountants, engineers and architects, an infringement action would succeed."[10]

What about maps? Since Rand McNally is the world's largest commercial mapmaker, I am, of course, gratified by the very extensive treatment Professor Karjala gives to the copyright of maps. As Professor Karjala points out, the copyright issues as they relate to maps are

8. 945 F.2d 509 (2d Cir. 1991).
9. *Id.* at 516.

more complicated in some ways than they are with respect to non-map compilations.

I believe we can agree that a map is something more than just a compilation of facts. Each map is an attempt to portray three-dimensional reality on a two-dimensional sheet and represent that on a much smaller scale. A map has some elements of a compilation, however, since the creation of a map from facts in the public domain necessarily involves a selection, coordination and arrangement of facts and their translation into a pictorial/graphic form.

As a starting matter, I believe Professor Karjala takes too restrictive a view of the issue of whether most maps will evidence sufficient originality under the *Feist* standard to be copyrightable. I am not sure what he means when he says: "[W]here the landmarks shown are the obvious ones or the result of some standard classification scheme, as will often be the case, there will be no creativity of selection under *Feist*."[11] For almost all maps, there is judgment involved in selecting the degree of detail that will be displayed on the map and the geographic scope of the map.

I also do not know what Professor Karjala means by: "Nor is there creativity in the resulting picture, at least if it follows typical mapmaking standards, because all shapes and locations are constrained by the actual geography of the region presented."[12] A map's presentation of three-dimensional reality on a two-dimensional surface, and on a much smaller scale, necessarily involves a change or even a distortion of reality which is determined by a mapmaker's judgment.

Instead, Professor Karjala labors to find sufficient originality to make maps *copyrightable* by suggesting that we should look at the originality in the process of fixation as contrasted to the finished work. He says: "In the case of maps, these would be skills in displaying spatial and quantitative relationships through scale, color, symbols, and overall design, including skills in compiling new maps from existing maps."[13]

Although Professor Karjala presents some very interesting ideas, given the minimal original authorship required under *Feist*, I believe the judgment that goes into the selection, coordination and arrangement of cartographic data should make almost all maps *copyrightable* without having to resort to novel theories of originality.[14] In addition,

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11. Karjala, *supra* note 1, at 895.

12. *Id.*

13. *Id.* at 900.

14. However, at least one court never really considered originality under *Feist*. Mason v. Montgomery Data, Inc., 765 F. Supp. 353 (S.D. Tex. 1991). In the recent *Mason* case, the court denied protection for legal survey maps under the merger doctrine because it believed that there

the copyright law gives maps broader protection than that given to non-map compilations by including them within section 101's definition of "pictorial, graphic and sculptural works."[15] The clearest statement of protection for the pictorial/graphic expression in maps was in the case of *United States v. Hamilton*[16] where future Supreme Court Justice Kennedy held that the "synthesis" of features of a terrain from prior maps was an "element of originality" entitling the map at issue to copyright protection.[17] The court said: "Expression in cartography is not so different from other artistic forms seeking to touch upon external realities that unique rules are needed to judge whether the authorship is original."[18] Noting that a photographer's "selection of subject, posture, background, lighting, and perhaps even perspective alone" are granted protection, the court found that a "similar attention" should be given to the cartographer's art: "[T]he elements of authorship embodied in a map consist not only of the depiction of a previously undiscovered landmark or the correction or improvement of scale or placement, but also in selection, design, and synthesis."[19]

Assuming copyrightability, however, the same difficult issue is presented: What scope of protection should be given to maps? Although Professor Karjala takes a different approach in finding originality to support copyrightability, he suggests that at the very least a direct, mechanical copy should not be permitted of a copyrightable map.

As he did for non-map compilations, he poses the very important question of what else should be protected. Although Professor Karjala has a very extensive and quite provocative discussion of this issue, for our purposes now let me just say that I agree very much with him that this issue should be approached with the same concern for misappropriation principles that he argues for with respect to non-map compilations. In fact, I believe the fair use criteria suggested earlier for non-map compilations should be largely transferable to the map context in determining what is protectible expression.

Whether courts will be able, after *Feist*, to adequately utilize misappropriation concepts in determining the scope of protection of both

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was only one way to express the data. *Id.* at 356. We can hope that the Fifth Circuit on appeal realizes that this is not the case and that it applies *Feist* copyrightability principles to find that the maps in question are at least copyrightable even though there may be a very limited scope of protection.

15. 17 U.S.C. § 101 (1988); *see* Kern River Gas Transmission Co. v. Coastal Corp., 899 F.2d 1458, 1463 (5th Cir. 1990) ("Maps are included in the category of 'pictorial, graphic, and sculptural works.' ").

16. 583 F.2d 448 (9th Cir. 1978).

17. *Id.* at 452.

18. *Id.* at 451.

19. *Id.* at 452.

map and non-map compilations remains to be seen. It is simply too early, however, to heed the call for a statutory amendment because these types of works will be underprotected without such an amendment. We should let the courts wrestle with this issue before deciding that *Feist* improperly limits them. Similarly, there is no justifiable basis for arguing now that *Feist* may permit courts to overprotect these types of works in certain circumstances. Properly understood, misappropriation concepts can be a powerful tool to use in deciding what is the appropriate scope of protection for both map and non-map compilations without a statutory amendment.