University of Dayton Law Review

Volume 17
Number 3 *Copyright Symposium, Part II*

Article 21

4-1-1992

Open Discussion of Presentation by David O. Carson, Esq.

University of Dayton

OPEN DISCUSSION

PROFESSOR KARJALA: David [Carson], you said earlier in your talk that you did not think the creativity requirement posed much of a problem. You talked primarily about factual compilations. But I would like to return—do you remember the *Rockford Map* case? You have seen the maps in that case?

MR. CARSON: I have not.

PROFESSOR KARJALA: Well, they consist of lines on paper showing the physical boundaries of the plats of land in a square block and names of people who owned them, in some cases with false middle initials, to catch copiers. That is it. Can you find creativity within the realm of *Feist* in that map? I wanted to ask Kurt [Steele] that, and I'm sorry he has gone. I think he said that he would find creativity in that map, and I would kind of like to know where it is.

MR. CARSON: Kurt [Steele] could probably answer you better than I, since I do not purport to be an expert on what goes into the making of a map and what does not.

PROFESSOR KARJALA: As to this one, we know pretty much. They went to the records, the deeds—they did not do a survey—they looked at the deeds giving the metes and bounds information and used that information to draw the picture.

MR. CARSON: I do not purport to know what Justice O'Connor meant when she talked about a modicum of creativity. What is pretty clear to me is that it means not a whole lot. What is creative to her may not be what is creative to me, but I am not one hundred percent persuaded that the act of looking at that information, which I guess is just from land records, not maps, and actually plotting it out and creating a physical representation of what those records show is not creative.

PROFESSOR KARJALA: Now you are actually looking at the process of creating the pictures.

MR. CARSON: It is a process but it is an intellectual process. You have to be able to conceptualize what these facts you are looking at are, and you have to represent them in a way that one who looks at it can understand what is being represented. I am not so sure that is not creative.

PROFESSOR KARJALA: Nor am I at that stage, but it is the process of creating the picture, right, it is not in the picture itself. The picture itself I think is purely factual. Anybody who goes to those records and reads the information correctly and represents it in two dimensions is going to come up, essentially almost exactly, except for error, with the same results. So where is the personal creativity, where

is the sign of authorship, the personality or whatever it is, that she talked about? I just do not see it in that case.

MR. CARSON: Is personality of the author something in her opinion?

PROFESSOR KARJALA: That is a good point. Somehow I convinced myself that it was. Am I wrong about that? Is that not in *Feist*?

MR. CARSON: I am not sure that that term is in there.

PROFESSOR KARJALA: And you may be right.

MR. CARSON: It is in some of the other cases, but I do not think it is in there. I think when you start taking about personality of the author, you start getting into trouble for someone who is saying creativity does not mean much. That is not in there and that is perhaps why I feel that perhaps creativity does not mean a whole lot. I have to agree a map is a tough case.

PROFESSOR KARJALA: But if you are agreeing, if you are looking at the process of making the map, then I presume that even in making a database, even without selection and arrangement in the result, if you are somehow using intellectual creativity—what would that be, using a special computer program to dial the people to get the information, I do not know—in making your database, do you think that would be enough to get around *Feist*? There is no selection or arrangement in the result, but there is some creativity somehow in the process of gathering the facts.

MR. CARSON: I would like to think that. I like your approach to creativity in that kind of work. I think it is an open question, doubtful certainly, but let's hope (those of us who would like to think that *Feist* has not changed things so much). That is an attractive way of looking at what creativity is, and I would not be surprised to see some lower courts try to get away with that, and perhaps the Supreme Court will revisit that. I am not so sure that it will, but perhaps the answer is you will be able to get away with that.

PROFESSOR KARJALA: So it will become creativity of the brow instead of sweat of the brow.

MR. SCHATZ: I think what Kurt Steele would say was there was a lot of creativity. I am not too familiar with the *Rockford Map* case, but as you describe it, I would say there certainly was a selection of what area to do, no question about that.

PROFESSOR KARJALA: There is some question. They did the whole county.

MR. SCHATZ: They did the whole county, but they could have done half a county or a quarter of a county. Usually counties are cut up by section. They could have done it in sections. In addition to that, I do not know if you call it coordination or arrangement, but it took a lot

of facts and data, and somehow you have made it into a completely different form that you created. I do not know whether you coordinated it or arranged it, but you did a lot of work. And I guess I agree with David [Carson] wholeheartedly that it is certainly intellectual work because you would have to know a heck of a lot, you would have to apply a lot of knowledge to take the metes and bounds and put that all together.

PROFESSOR KARJALA: If that is where the creativity is, that is where the originality is, do I infringe if I have not seen your map and I go to the recorder's office and do the same thing and come up with an identical map?

MR. SCHATZ: Absolutely not.

PROFESSOR KARJALA: What is the reason?

MR. SCHATZ: You have done it independently and creatively yourself.

PROFESSOR LANGE: Because others are free to copy, but no one is free to copy the copy because if by some magic a man somehow might compose a new Keats' *Ode on a Grecian Urn*, et cetera.

PROFESSOR KARJALA: Paul Goldstein, just for what it is worth, apparently takes the opposite view and says you go and retrace the steps of the survey mapmaker you do not get a copyright because it is only repeating what the original mapmaker has done.

PROFESSOR LITMAN: That requires you having seen the map first. Once you see the map you can—

PROFESSOR KARJALA: Maybe if you put your feet in different spots, you would be okay. That sounds facetious, but the way Paul [Goldstein] described it, at least in his book, if you trod the same path you are not doing anything original, but he's hunting for—well, I am not saying I endorse that.

MR. CARSON: Without having seen the original or the copy?

PROFESSOR LANGE: Paul [Goldstein] does not say that would happen if you had not had access to the original. He is saying if you have access to the original. This is the *Moon over Hernandez* problem. You like the photo and you decide some October you are going to do one yourself and then you produce a strikingly similar work. I think Paul's view is, if I remember him on this treatise, that you would be an infringer. Although I think that is absolutely wrong, nonetheless I think that is his position on that, not on the other one that you propose there. There is no way, at least in conventional terms, that that is an infringement. It is one of the rare cases where you lay down hands on a noninfringement and you can show no access.

MR. SCHATZ: Maybe the difference is if you go out and try to create exactly the same photograph as closely as you can, maybe that is

an infringement. And if you go out and say gee, that is a great idea, and take a picture in the fall and do not try to create it exactly, maybe that is not an infringement.

PROFESSOR LITMAN: What you intend is not an element. The question is whether or not in your subconscious mind, the template that is causing you to say, "this is a good time to push the shutter" is your memory of that photograph, or whether you have forgotten it entirely and the moon is just hitting a striking pose on the desert. You can't prove which of those it was. You're not going to know.

PROFESSOR LANGE: Maybe I am wrong, maybe I am doing him an injustice, but I am pretty sure that his position is that you at least have the burden of overcoming the presumption that there was an infringement there if the result of your having gone out to do what you have in mind is to produce a strikingly similar work. And in support I think that is not so, but I understand it, but in support of that point, in dictum actually, which I misquoted, actually says, if by some chance a man who had never known were to compose a new Keats' *Ode on a Grecian Urn,* and that does suggest that they are very different undertakings, to go out after having had access and then to, and I do not know anymore, and hopefully—

PROFESSOR RASKIND: What do you think if the person came and just decided that the map was useful and they wanted to add to it the crops that the various farmers sell from the different pieces of land that are depicted and you add the scale of which they operate, how mechanized they are and a couple of other things. Can the second mapmaker, without having gone back to the records, take the name and data off the map?

PROFESSOR LANGE: You are going to a derivative works problem. That is the Catch-22 in all of these settings. Once you have had access and are prompted to go out looking, because of the access to the work that you have had, the result is in one view—which is why I think Paul [Goldstein] has to be wrong—that you end up not just commanding the view of Hernandez that Ansel Adams actually shot but a 380 degree circle because there is no view that is not derivative of the first view. And if your purpose is to go out and actually—and I mean that has to be wrong. It has to be wrong because the alternative is an insight more important that we can use.

MR. SCHATZ: Leo [Raskind], I think the answer is if the first step in creating the second map is to copy the first map and then put on whatever you want, then I think that is an infringement. You have taken the selection, coordination, and arrangement or whatever you call it, you have taken that. If you take the idea and say that is great, that is a great map, but I think you ought to add this, and go back and at

least create the same thing independently and add the additional data, then I do not think it is.

PROFESSOR RASKIND: Are you suggesting it would make a difference if you put the added information on first and then put the other stuff on second? If facts under *Feist* are not within the scope of copyright protection, then it seems to me that *Feist* does say that the second person can take the data from the first map.

MR. CUTLER: I think there is a little—

MR. SCHATZ: I think that you are taking the expression when you take the first map. The facts are the public records. The expression is in the map.

PROFESSOR RASKIND: What is it the second person is expressing?

MR. SCHATZ: There is no map in the public records. There is no visual description. There are words, go 120 feet this way, 300 feet that way, and 380 feet that way.

PROFESSOR KARJALA: Suppose you take that map and you take your ruler and compass and you measure every line and write down the results of your measurements. Now you have got facts that are in the public records. Now you use that list of facts. But you said I had to go to the public records, the dusty books. All I have done is take factual information from a protected work and used that to make another map. How have I taken the creativity?

PROFESSOR RASKIND: When the county recorder of deeds put his information on the map, would the second person be an infringer? In other words, if you looked at the record book and the record book used the county map.

MR. SCHATZ: You cut the details finer and finer. I do not know exactly where it ceases to be an infringement. I think the original example or your example is clearly infringement. I think reversing them and going back the other way to find the facts, I do not have as much trouble. First of all, you are not creating a copy that way. I mean copyright infringement requires some copy. There you are just using the map to determine the facts or to determine information.

PROFESSOR LITMAN: If you are creating a copy when you look at the map and take all the factual information that is represented in the expression and draw it out so it looks just the same, if that's creating a copy, it is equally creating a copy to go through Dennis' [Professor Karjala's] procedure of translating the thing back into its information and then retranslating it back—

PROFESSOR KARJALA: It is just a different way of making a copy.

MR. SCHATZ: I think the chance of replicating the original data is almost nil because you are going to find it in all sorts of places in the property records. You are never going to be able to replicate that data because you are not going to know where those facts came from.

PROFESSOR LITMAN: But you are going to be able to replicate whatever it is, any facts expressed on the map, assuming a good measuring device, you can absolutely make a copy of that by just scanning it, making it digital, and then printing it back out again.

MR. SCHATZ: Again, I think you are slicing this too finely, but you are never going to be able to replicate the exact facts because you will never know where those facts appear and you are never going to be able to put them in the same order. I think the chances are almost nil.

PROFESSOR KARJALA: But is it okay with you to use these map readings for the purpose of replicating the map?

MR. SCHATZ: I do not see where there is a copy. In Leo's [Professor Raskind's] example, you are making a copy of the map. When you are using the map to draw things on and recreate some other facts, you are not making a copy.

PROFESSOR KARJALA: Even though they both look the same?

MR. SCHATZ: They do not look the same. One is going to be a whole series of property descriptions which is not going to be the same as the original data.

PROFESSOR KARJALA: Okay. It's a whole series of property descriptions and then I use those descriptions to draw another picture. Now my picture looks a lot like your picture, right?

MR. SCHATZ: Right.

PROFESSOR KARJALA: And you are saying that's not a copy? It is just a different way of making a copy.

MR. SCHATZ: It may be a different way of making a copy. I have a hard time going this far because no rational human being would.

PROFESSOR KARJALA: I'm not at all sure. It seems to me that is the way a rational copyist in a *Rockford Map* situation, where the court found infringement in the actual case, and I think properly so, might do just that now. But I think if Leo's [Professor Raskind's] analysis is correct, and under *Feist* it is correct, there is no infringement on the description that we have just given. Maybe the copyist would rather trace, but that somehow or another under both David's [Professor Lange's] and your theory of creativity in the making would infringe, so we agree you can't make a photocopy or a copy by tracing. But this other way now, this indirect sort of way of making a copy, if that is okay, it is a lot easier than going down to the recording office and trying to make it from there. It seems to me, if that is the result here,

then we are making a severe reduction of copyright protection and it is being done without regard to policy.

This is why I think we have to think in terms of policy. Fact, expression, idea, all that kind of stuff, they are big conceptually but they are really pretty useless analytically. And I think the only way to resolve these problems is to look at the policy tensions and try to decide which ones make some sense and which ones do not. It is a serious problem. I do not think you can just say, well, that is a copy, and that is infringement, and this one is not a copy, and this is expression, and that is creativity. You are going to get to some wrong results using those kinds of terms.

MR. SCHATZ: I do not know what a wrong result is. I am saying that is what my view of that is. The Court may or may not agree with that.

PROFESSOR KARJALA: I meant wrong from a social policy point of view. I am assuming we got some agreement on right or wrong here.

MR. SCHATZ: I do not think you are. I do not think the Eleventh Circuit and the Second Circuit are coming at things the same way. I think that depending on which circuit, and there are a lot of circuits that have not spoken yet, depending on which circuit you put those facts in, you would come up with a different result. Maybe it happens first in the Eleventh Circuit and then the Second Circuit feels somewhat inclined to agree because it is a very similar case. But all you can do is get one opinion out of it. It is, unfortunately, a practical world. The court has to make a decision. They have to make a decision one way or the other. Often it is a difficult decision.

MR. CUTLER: With everybody chiming in as to what Paul Goldstein meant with the *Moon over Hernandez* argument, since Bob [Kreiss] and I were both students of his we were often wrong in trying to interpret what he said in class anyway, but I will take a chance and tell you what I still think he says is if you authors go shoot that picture, you cannot get a copyright; it is not original what you did, but that is not an infringement of Ansel Adams' picture because you did not make a copy. What you really did was copy his idea which is not protected.

I really do think—and I do not practice in databases, I practice in computers and software—I think *Feist* is a revolution because looking at the yellow pages cases, I mean I agree that *Donnelly* and *Bellsouth* say what they say, but they cannot be right if *Feist* is. Where is there any creativity in the yellow pages?

MR. CARSON: It depends on how you define creativity. If you take the court at its word, creativity was primarily determining what category each listing goes into. That is a very low level of creativity. I

grant that. It may be so low as to be absent, and I think other courts might find that. Yes, if you take everything in *Feist* seriously—and since it is the Supreme Court's opinion I suppose we ought to give it some deference—you have got a problem. What I am saying is that at least one court which we presume knew what it was doing—maybe it was ignoring *Feist*, I do not know—chose to find creativity in something that most of us in this room would agree, to be charitable, perhaps has a modicum of creativity. I am not quite sure of that. If that is the direction some courts are willing to go, I am willing to say fine, let's wait and see if some other courts are willing to go that way too before we turn everything upside down in an attempt to right what may or may not be a major revolution.

MR. SCHATZ: The Eleventh Circuit did say, and it was following *Feist*, it did find selection, coordination, and arrangement, and it did not take very long to discuss it.

MR. CUTLER: My reaction is what Professor Raskind has already said, that maybe some courts will start out and ignore *Feist*. Maybe that will happen.

MR. CARSON: It would not be the first time that the Supreme Court precedent gets whittled down in a practical matter to be much more diluted than what one would have thought when one first read it.

MR. CUTLER: If Justice O'Connor continues writing opinions, surely results in intellectual property like *Bonito Boats* followed by *Feist*, it does not look good.

MR. CARSON: I have not seen one of these cases for years. All I am saying is I look at it from a practical view. A lot of people in this room do not, and I understand they are concerned with consistency, with intellectual copyright theory, and so on. That is fine. I understand why and I can understand when some of them look at what happened in the Eleventh Circuit and say that is intellectually dishonest, and that is the wrong result. I do not necessarily disagree with them if what we are trying to do is say *Feist* says this, therefore, the Eleventh Circuit should have said that. That may be true.

All I am saying is: I guess I have the luxury of not having to worry about being theoretically or intellectually consistent. All I want to do is get the results that I think are the right results. There are some things in *Feist* that I am not too happy with. I am willing to hope that perhaps they will be swept under the rug and I am willing to wait and see. That is a very pragmatic point of view, which some people find hard to swallow, but to me it serves my needs.

PROFESSOR LANGE: I do not think of that as a practical point of view. I actually happened to be one of the lawyers who actually was involved in the litigation in *Feist*, so I actually briefed the case. That is

a claim that in practical terms I think takes my participation in the process beyond the academic perspective a fair ways, and I was in that case because I got hired, as I am frequently hired, the position being of counsel to a big law firm who does this kind of work to take on a bunch of litigation.

Now, I do not think it is a practical response to the client's question. If I were your client my question would be, why now, how come *Feist* is the subject of a cert petition. And it came to me from out of left field, and let me tell you why. Jane Ginsburg's big article on factual compilation, it was being put together as a tender piece and had not one word in it that contemplated any kind of media change at the Supreme Court because I know, I reviewed it before *Feist*, before the cert petition came down in *Feist*. Bill Patry's article, which is a really wonderful piece of work in the circumstances, got put together basically between October whatever and, you know, the filing. And I have to ask and would ask you if I were your client, given your profession to be out there on the shoe sign with your smile and day-to-day nitty-gritty of it, why now? Because if you do not tell me something that sounds plausible, then you are blowing smoke, and if I have got Norton [Cutler] over here who happens to leave his place and go into private practice, I may come to him because I want to hear an explanation from somebody who, at least, has got a plausible theory that does not sound like, you know, our heads are in the sand. Why was *Feist* decided? Why should I read that opinion and not give some weight to what is said there in pretty clear and direct terms, things that are there that come right out of earlier cases, one of which she wrote only a couple or three years ago? I want to know why I can count on you to be right when you say, ah, do not worry about it, because it sounds to me as though eventually I am going to be like the subjects in one of those [Daumier] prints. I may have lost the case to be sure, but I will have had peace of mind meanwhile, and that is not me, practical lawyer, what is your answer? Why now?

MR. CARSON: First of all, I have no peace of mind whatsoever. What I will be telling my client is, look, we are not living in the best of all possible worlds right now. *Feist* is a decision that you have to take seriously, but if I counsel my client today on what he can do, I have to look as a practical matter at what tools I have available to me now. Now, between now and next year, I am not going to get any statutory changes through Congress or through my state legislature. It is just not going to happen.

PROFESSOR LANGE: If I were your client, I would say to you that I am not sure you are ever going to get statutory changes, not the

kind I want because they may now be precluded. How are you going to answer me then?

MR. CARSON: They may be precluded by preemption, you mean?

PROFESSOR LANGE: No. They may be precluded if sweat of the brow in which you are lingering over lovingly is such a great standard, you are not going to get that through Congress because surely nobody in Congress is going to so undervalue the opinion that O'Connor has written as to suppose that that can be made the subject of a statutory reenactment. What am I going to get?

MR. CARSON: If I came across as though I were advocating reinstituting sweat of the brow, I am sorry. I did not make myself clear.

PROFESSOR LANGE: I just said you were lingering over it lovingly.

MR. CARSON: I would not regret if we still had it. Do I regret its passing? I do not think so. I think we can live with selection, coordination, and arrangement. I think we can.

PROFESSOR LANGE: Is the answer to my question "why now" that you do not know or you do not wish to speculate or—?

MR. CARSON: Primarily, I do not know. Secondarily, I see some indication that the sky is not falling when I look at what the courts have done since *Feist*.

PROFESSOR LANGE: What the courts have done since *Feist*, they have done within about a nine month period and that is very consistent with what the courts did after [*Sears* and *Compco*] in over even a longer period than that. In fact, *Sears* and *Compco* were not dead; they were merely sleeping.

MR. CARSON: I do not disagree with a word you are saying. All I am saying is let's not think that the sky is falling and that we have to undertake drastic change now. Let's see what direction we are going in, let's have a little bit more experience before we start deciding whether—either by statutory amendment or through perhaps new creation of common law over a period of time, or whatever—we need to try to find new solutions because we may not need new solutions. And it is going to take time even if we do need new solutions.

PROFESSOR LANGE: And all I need to tell you, David [Carson], if I were your client, I would want to start buying my tickets out of Paris just in case it turned out it was not a phony war after all.

I think there is usually some lingering period of lull that follows a major event, but I agree with Norton [Cutler] that this is a major event and that it is really whistling past the graveyard to think that it is not

MR. CARSON: You may be right.

MR. METALITZ: Let me follow up on this question of how seriously to take everything in *Feist*, and I think it is useful to do as you did in your presentation, David [Carson], focus a little on the facts of *Feist*, on what actually was said there.

Maybe this is because I have not heard this said because it is too obvious a point. From a LEXIS point of view there are two pretty good reasons for not taking everything that is written in *Feist* too seriously.

One is a blatant violation of prudential canons that the Court claims it is going to follow and, in fact, Justice O'Connor has burnished her reputation as following as a rejecter of judicial activism, and that is the fact that she reached out to constitutionalize an issue or to express an issue in constitutional terms and with no justification for doing so. That is certainly contrary to the way the Court has always said it should operate. It is not, of course, contrary to the way the Court always does operate.

The other aspect of it which is even more serious is when we look at the two different parts of the *Feist* decision on copyrightability, I feel sure that we should take it very seriously. Leaving aside the constitutional trappings, it is unassailable as an interpretation of the copyright act. But as far as the scope of protection I think a good argument could be made in theory that it is all dicta, because this is a case in which the listings anyway, although there is some fuzziness about that book as a whole, but certainly the white page listings did not have any copyright protection at all. Therefore, all of the explication about how thin copyright is and what it really amounts to is pure dicta.

Does the fact that the decision is rendered eight to nothing and written by the justice who is clearly the member of the Court most interested in and most active on intellectual property and who is going to be around for a while, does all of that negate the argument that, much of the opinion is dicta and certainly on LEXIS grounds extremely suspect because of its unnecessary constitutionalization?

MR. CARSON: Well, I think that has to make you feel a little more nervous in feeling that the next time around when infringement is the issue, and the mode and scope of protection, the Court is not going to pay attention to what was in that opinion. I would not feel totally comfortable about it. But I think you are absolutely right.

First of all, I would choose to think that precious few works that we are dealing with today would be found to be not copyrightable under *Feist*. The white pages are not copyrightable. We did not know that before; at least, we did not necessarily know that before; we now know that I have not heard a whole lot of examples of things that I

would think necessarily are not going to be held copyrightable under *Feist*.

Thin protection—I think you have to take that line seriously and I do not think anyone who would counsel their client that protection is anything other than thin is doing his client a disservice. But given that, I think the fact of the matter is it is dicta, and if pressed in a situation where I had to defend the position that Justice O'Connor understated the scope of protection for a fact work, I think it certainly is intellectually respectable to do that. There would be some reason to think that the next time you get the Court's attention, and really make them think about this issue, maybe only one of the nine justices was thinking about it when that opinion was written, because it was not the issue that was before them. Perhaps then they will have a different take on it.

MR. METALITZ: I do not know if someone will explain the varying responsibilities that the lower courts have. I do not know that the Second and the Eleventh Circuit will get together—certainly the Eleventh Circuit has not gotten together with itself yet—but perhaps those considerations are a factor there. There are some very plausible defensible reasons for courts not taking everything in *Feist* equally seriously.