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Victory for the Public: West Publishing Loses Its Copyright Battle over Star Pagination and Compilation Elements

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VICTORY FOR THE PUBLIC: WEST PUBLISHING LOSES ITS COPYRIGHT BATTLE OVER STAR PAGINATION AND COMPILATION ELEMENTS

*Eman H. Jarrah**

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I. INTRODUCTION

Until recently, West Publishing Company and West Publishing Corporation (collectively "West") held a virtual monopoly on the compilation of legal opinions and the star pagination system.¹ With the assertion of broad copyrights, West has held onto its massive market share

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¹ Star pagination enables the reader of an electronic version of a case to pinpoint exactly where a page break occurs in the textual body of a printed version. *Matthew Bender & Co., Inc. v. West Publ'g Co.*, 158 F.3d 693, 699 (2d Cir. 1998). For example, on page two of the computer screen a "***330" would appear reflecting the exact text in a reporter, such as "134 F.3d at 330." Star pagination is also used to correlate page numbers between different printed versions of a case, such as a federal reporter and a state reporter. *Id.* at 700-01.

and has made a considerable profit.² Consequently, West has been involved in a substantial amount of litigation, vigorously defending its perceived copyrights. West's assertion of broad copyrights in its judicial case reporters and star pagination system has received mixed reactions in court: the Eighth Circuit has ruled in favor of West's claimed copyrights³ while the Second Circuit has ruled against West's claims.⁴

The "sweat of the brow" doctrine, as articulated in *Jeweler's Circular Publishing Co. v. Keystone Publishing Co.*,⁵ has previously been rejected by the Eighth Circuit, however, at least one district court within the circuit appears to now advocate the doctrine.⁶ The "sweat of the brow" doctrine rests on the premise of awarding a person for the labor put into compiling a work.⁷ Application of the doctrine has extended copyright protection beyond a compiler's original contribution to actual facts, which are generally understood not to be copyrightable.⁸ The doctrine's misplaced sympathy is incorrect because it fails to consider the essential elements of copyright law: originality and creativity.⁹

In *Matthew Bender & Co. v. West Publishing Co.*,¹⁰ the Second Circuit rejected the reasoning of the court in *Oasis Publishing Co. v. West Publishing Co.*,¹¹ and relied on a 1991 Supreme Court decision to curb the scope of West's copyright monopoly.¹² A divided panel of the Second

² Following the Second Circuit's decision, attorney for West Publishing competitor HyperLaw Inc., Carl Hartmann, projected the cost for online products to be four cents per minute. Michael Higgins, *Go West, Young Publishers*, 85 A.B.A. J. 24 (1999). Current market rates were as high as several dollars per minute. *Id.*

³ *West Publ'g Co. v. Mead Data Cent., Inc.*, 799 F.2d 1219 (8th Cir. 1986).

⁴ *Matthew Bender & Co., Inc. v. West Publ'g Co.*, 158 F.3d 674 (2d Cir. 1998); *Matthew Bender & Co., Inc. v. West Publ'g Co.*, 158 F.3d 693 (2d Cir. 1998) *cert. denied sub nom* *West Publ'g Co. v. HyperLaw, Inc.*, 119 S. Ct. 2039 (1999). The Second Circuit bifurcated the case and issued two separate opinions.

⁵ 281 F. 83, 95 (2d Cir. 1922). The court reasoned that the right to copyright protection does not depend on whether the materials consist of public domain, are the product of literary skill, or are anything more than industrious collection. *Id.* at 88.

⁶ *Oasis Publ'g Co. v. West Publ'g Co.*, 924 F. Supp. 918 (D. Minn. 1996).

⁷ *Jeweler's*, 281 F. at 88.

⁸ A compiler is someone who collects, assembles, and organizes pre-existing material or data into compilations. Compilations are works "formed by the collection and assembling of pre-existing materials or of data that are selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes an original work of authorship." 17 U.S.C. § 101 (1994). The yellow pages are an example of a compilation.

⁹ *Id.* § 102.

¹⁰ 158 F.3d 674 (2d Cir. 1998) *cert. denied sub nom* *West Publ'g Co. v. HyperLaw, Inc.*, 119 S. Ct. 2039 (1999).

¹¹ 924 F. Supp. 918 (D. Minn. 1996).

¹² *Id.* at 681-82. The court relied on *Feist Publications, Inc. v. Rural Tel. Serv. Co., Inc.*, 499 U.S. 340 (1991). In 1885, West published editions nationwide in the states it covered and essentially

Circuit ruled that West's additions and arrangements of information in its judicial opinions lacked the requisite creativity to warrant copyright protection.¹³ Further, the court held that West's system of inserting citations in the online versions of legal opinions, indicating the page location in the printed text, lacked originality and creativity.¹⁴

The fate of West's copyright status is likely to have an astounding impact on the legal profession as well as legal publishers.¹⁵ With the assertion of a copyright in its star pagination system, West holds a significant power over publishers who pay a substantial licensing fee for its use.¹⁶ In all likelihood, this stifling of competition will increase prices and reduce quality for the consumers who use such products. For example, prior to the Second Circuit's decision, the estimated market rates for online products were in the range of dollars per minute.¹⁷ Following the decision, however, some publishers have projected rates for online products in the neighborhood of four cents per minute.¹⁸

This Comment argues that compilations of judicial opinions consisting of individual case reports with additional information such as parallel citations, identification of counsel, and facts on procedural history are not sufficiently original or creative to merit copyright protection. Part II of this Comment discusses the essentials of copyright law including basic tenets, compilation copyrights, case reports, and the now defunct "sweat of the brow" doctrine.¹⁹ Part III of this Comment explores the diverging holdings of the Second Circuit and Eighth Circuit and finds that the Second Circuit's analysis better serves copyright law because it maintains the underlying purpose behind copyright law of promoting the useful arts and

put smaller publishers out of business, as they could not compete. James Wyman, *Freeing the Law: Case Reporters Copyright and the Universal Citation System*, 24 FLA. ST. U. L. REV. 217, 228 (1996). West's editions were preferred to the smaller publishers and to the government's production not only because of their nationwide coverage, but also due to their arrangement of cases and the additional information they offered. Michelle Orton, *House Bill 1822: New Anti-Westopoly Rule Proposed in Congress*, 7 DEPAUL-LCA J. ARTS & ENT. L. 308, 313-14 (1997). West offered indexes, a synopsis of the case, headnotes, key numbers, and star pagination. *Id.* at 314. It is not contested that some of these elements are copyrightable. *Id.* at 315.

¹³ *Matthew Bender*, 158 F.3d at 689.

¹⁴ *Id.*

¹⁵ The Supreme Court denied West's petition for writ of certiorari from the Court of Appeals for the Second Circuit. *West Publ'g Co. v. HyperLaw, Inc.*, 119 S. Ct. 2039 (1999).

¹⁶ *Matthew Bender*, 158 F.3d at 700.

¹⁷ Michael Higgins, *Go West, Young Publishers*, 85 A.B.A. J. 24 (Jan. 1999).

¹⁸ *Id.*

¹⁹ See *infra* notes 23-80 and accompanying text.

sciences.²⁰ Further, the Second Circuit has properly limited copyrightability to works that satisfy the elements of creativity and originality and is, therefore, in accord with the policy of granting the public free access to facts.²¹ Part IV of this Comment concludes that compilations of judicial opinions and the star pagination system lack sufficient creativity to warrant copyright protection, especially where industry conventions dictate only a few limited selections.²²

II. BACKGROUND

A. Basic Tenets of Copyright Law

Under the Constitution, Congress has the power “[t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.”²³ Pursuant to this constitutional provision, Congress enacted the first federal copyright legislation in 1790 and most recently revised the federal copyright legislation by enacting the Copyright Act of 1976.²⁴ Section 102 of the Copyright Act provides that copyright protection extends only to original works of authorship fixed in a tangible medium of expression.²⁵ In order to be copyrightable, a work must possess the requisite degree of originality, and while the threshold for originality may be minimal, it is still a requirement.²⁶ In fact, originality is the touchstone of copyrightability.²⁷ An author’s written or printed work must be a

²⁰ See *infra* notes 81-178 and accompanying text.

²¹ See *infra* notes 167-78 and accompanying text.

²² See *infra* notes 179-81 and accompanying text.

²³ U.S. CONST. art. I, § 8, cl. 8.

²⁴ 18 AM. JUR. 2D *Copyright and Literary Property* §§ 1, 2 (1985).

²⁵ 17 U.S.C. § 102 (1994).

²⁶ *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53 (1884) (holding that under the United States Constitution’s copyright clause and under federal copyright legislation, a photograph possessed the originality to be copyrightable if the photograph was the photographer’s intellectual creation); *Harper & Row Publishers, Inc. v. Nation Enter.*, 471 U.S. 539 (1985) (finding that with respect to written or printed work constructed by an author from materials that are not original, if the work possesses some originality by representing the author’s expression, it may embody, as a whole, the originality required for the work to be copyrightable as a whole); *Feist Publications, Inc. v. Rural Tel. Serv. Co., Inc.*, 499 U.S. 340 (1991) (stating that works that are independently created by the author, as opposed to being copied from other works, and that entail at least some degree of creativity are sufficiently original to warrant protection).

²⁷ *Feist*, 499 U.S. 340, 359-60 (1991).

product of the creative powers of the author's mind to possess the originality required for protection under federal copyright legislation, not the adoption of something already in existence.²⁸ Novelty is not an issue provided that a work is independently originated.²⁹

The purpose of federal copyright law is to increase the "harvest of knowledge" by allowing an author to rely on facts contained in prior works and by not allowing facts to become copyrightable.³⁰ Facts themselves are not copyrightable because they are not the expression of the author, but rather matters of public domain.³¹ If an author is unable to rely on scientific, historical, or any other type of facts contained in prior works, progress will be hindered and the purpose of the copyright doctrine subverted. It is essential to keep in mind that the primary objective of federal copyright law is not to reward the labor of authors with respect to their writings, but rather "to promote the Progress of Science and the useful Arts."³²

B. Compilation Copyrights

Although facts alone are not subject to federal copyright protection, the Supreme Court has determined that a work consisting of a factual compilation may be protected.³³ Section 103(a) of the Copyright Act provides that the subject matter of copyright includes compilations and derivative works.³⁴ A compilation of facts, despite being derived from uncopyrightable matter, is copyrightable as a whole, so long as the compilation author demonstrates originality in the manner in which the

²⁸ Trade-Mark Cases, 100 U.S. 82, 93 (1879).

²⁹ *Feist*, 499 U.S. 340. To meet the requirement that a work must be original to be entitled to a federal copyright, "a work may be original even though it closely resembles other works so long as the similarity is fortuitous" rather than the result of copying, because originality does not require novelty. *Id.* at 345.

³⁰ *Harper & Row Publishers, Inc. v. Nation Enter.*, 471 U.S. 539, 545 (1985).

³¹ *International News Serv. v. Associated Press*, 248 U.S. 215, 234 (1918) (holding that facts are not copyrightable under federal law, because they are not creations of the writer, but are public matters); *Feist*, 499 U.S. at 347 (holding that facts are not the product of an act of authorship, because "the first person to find and report a particular fact has not created the fact," but has "merely discovered its existence").

³² *Feist*, 499 U.S. at 349 (citing U.S. CONST. art. I, § 8, cl. 8).

³³ *Id.* at 340.

³⁴ 17 U.S.C. § 103(a) (1994).

facts are selected, coordinated, or arranged.³⁵ Section 103(b) provides in part that a compilation copyright "extends only to the material contributed by the author of such work, as distinguished from the pre-existing material employed in the work."³⁶ As a result, the protection extended to compilations is weak and in no event extends to the facts themselves.³⁷

C. Case Reporters

The case reporter copyrightability debate dates back to the early 1800s.³⁸ At that time, it was widely held that the writings produced by judges, which were contained in volumes reporting the decisions of the courts, were not copyrightable under federal law; rather, such decisions were in the public domain.³⁹ In *Wheaton v. Peters*, the Supreme Court indicated that a federal copyright could not be obtained in the Justices' written opinions that were reported in volumes known as "Wheaton's Reports."⁴⁰ Justice M'Lean emphasized that "the courts are unanimously of opinion, that no reporter has or can have any copyright in the written opinions delivered by this court."⁴¹ Over a century later, this statement is still good law because it is codified in section 105 of the Copyright Act of 1976, which provides that "[c]opyright protection under this title is not available for any work of the United States Government"⁴²

The Supreme Court does recognize a modicum of copyrightability concerning compilations of judicial opinions.⁴³ Although judges' official writings contained in law report volumes are not federally copyrightable, a court reporter's own writings such as headnotes, statements of facts, statements of arguments, syllabi, case tables, and other original materials

³⁵ *Id.* § 101; *Feist*, 499 U.S. at 348; see also *Harper & Row*, 471 U.S. at 547 (finding that even a directory which contains absolutely no protectable written expression, only facts, meets the constitutional minimum for copyright protection if it creates original selection or arrangement).

³⁶ 17 U.S.C. § 103(b) (1994).

³⁷ See generally *Feist*, 499 U.S. at 348-49 (finding that while the degree of originality required for protection of factual compilations may be low, the protection afforded is thin).

³⁸ In 1834, the Supreme Court held that a publisher of an individual reporter may not claim a copyright in judicial opinions. *Wheaton v. Peters*, 33 U.S. 591 (1834).

³⁹ 17 U.S.C. § 105 (1994).

⁴⁰ 33 U.S. 591 (1834); see also *Banks v. Manchester*, 128 U.S. 244 (1888) (holding that defendant was not liable as to infringing opinions, syllabi, and statements of cases because in those materials, the Reporter could not claim authorship).

⁴¹ *Wheaton*, 33 U.S. at 668.

⁴² 17 U.S.C. § 105 (1994).

⁴³ *Feist Publications, Inc., v. Rural Tel. Serv. Co., Inc.* 499 U.S. 340 (1991).

may be copyrightable.⁴⁴ For instance, in *Callaghan v. Myers*,⁴⁵ the Court stated that although there can be no federal copyright in the writings produced by judges acting in their official capacities, the materials prepared by a reporter that are compiled in a manner intended to make each volume convenient and valuable to the reader, may be copyrightable.⁴⁶

D. The Defunct "Sweat of the Brow" Doctrine

In the 1900s, several courts misconstrued the Copyright Act of 1909 and developed a new theory to justify the protection of factual compilations.⁴⁷ The theory was known as "sweat of the brow" or, alternatively, "industrious collection."⁴⁸ The classic formulation of the doctrine appeared in *Jeweler's Circular Publishing Co. v. Keystone Publishing Co.*⁴⁹ The underlying notion behind this doctrine was that copyright was a reward for the hard work that went into compiling the facts.⁵⁰ The doctrine, however, was flawed in several aspects. The most glaring flaw was extending copyright protection beyond the compiler's original contribution of selection or arrangement, to the facts themselves.⁵¹ The "sweat of the brow" opinions essentially shunned the most fundamental axiom of

⁴⁴ *Wheaton*, 33 U.S. 591 (holding that no reporter could own a copyright in the basic text of opinions issued by the Supreme Court); *Banks*, 128 U.S. 244 (extending the principle eschewed in *Wheaton* to state court opinions); *Callaghan v. Myers*, 128 U.S. 617 (1888) (confirming that judicial opinions are not subject to a copyright but that a copyright could be obtained covering portions of a compilation that resulted from intellectual labor).

⁴⁵ 128 U.S. 617.

⁴⁶ *Id.* Under appropriate circumstances, pagination and arrangement may ascend to a level appropriate for copyright protection; however if arrangement of cases depends on accidental circumstances, they are not subject to copyright protection because they involve no creative or original input. *Id.*

⁴⁷ *Jeweler's Circular Publ'g Co. v. Keystone Publ'g Co.*, 281 F. 83 (2d Cir. 1922); *Leon v. Pacific Tel. & Tel. Co.*, 91 F.2d 484 (9th Cir. 1937).

⁴⁸ *Jeweler's*, 281 F. 83; *Leon*, 91 F.2d 484.

⁴⁹ 281 F. at 88. The court reasoned that the right to copyright protection does not depend on whether the materials consist of public domain, are the product of literary skill, or are anything more than industrious collection. *Id.*

⁵⁰ *Id.* Under the doctrine, the only defense to infringement was independent origination (a defendant may present evidence that he or she created the work independently). *Id.* at 88-92. A subsequent compiler was not entitled to take one word of information previously published but rather had to independently arrive at the same result from the common sources of information. *Id.* at 88-89.

⁵¹ *Feist Publications, Inc. v. Rural Tel. Serv. Co., Inc.*, 499 U.S. 340, 347 (1991). The Supreme Court stated that "no one may claim originality as to facts . . . because facts do not owe their origin to an act of authorship." *Id.* "The first person to [discover] and report a fact has not created the fact; he . . . has merely discovered its existence." *Id.*

copyright law, that no one may copyright facts or ideas, by giving copyright protection to undeserving compilations and other such works.⁵²

"Sweat of the brow" decisions did not escape the attention of the Copyright Office.⁵³ In response to such decisions, the Copyright Office recommended that Congress remedy the confusion in the lower courts as to the basic standards of copyrightability.⁵⁴ The Register of Copyrights explained in a report to Congress that "originality" was a "basic requisite" of copyright under the Copyright Act of 1909, but that "the absence of any reference to originality in the statute seems to have led to misconceptions as to what is copyrightable matter."⁵⁵ The Register suggested making the originality requirement explicit.⁵⁶ Congress agreed, and in 1976 replaced "all the writings of an author" with the phrase "original works of authorship."⁵⁷ In making explicit the originality requirement, Congress announced that it was merely clarifying existing law, asserting that:

The two fundamental criteria of copyright protection—originality and fixation in tangible form—are restated in the first provision of this cornerstone provision. The phrase "original works of authorship," which is purposely left undefined, is intended to incorporate without change the standard of originality established by the courts under the present [1909] copyright statute.⁵⁸

The Copyright Office agreed, stating that: "our intention here is to maintain the established standards of originality"⁵⁹

The current trend towards a greater and more selective protection of copyright gained momentum in 1991, following the Supreme Court's decision in *Feist Publications, Inc. v. Rural Telephone Service Co.*⁶⁰ *Feist* clarified the appropriate range of copyright protection for data and fact based compilations.⁶¹ Rural Telephone Service Company ("Rural") was a

⁵² *Id.* at 344-45.

⁵³ STAFF OF HOUSE JUDICIARY COMM., 87TH CONG., REPORT OF THE REGISTER OF COPYRIGHTS ON THE GENERAL REVISION OF THE U.S. COPYRIGHT LAW 9 (Comm. Print 1961).

⁵⁴ *Id.*

⁵⁵ *Id.*

⁵⁶ *Id.*

⁵⁷ 17 U.S.C. § 102(a) (1994).

⁵⁸ H.R. REP. NO. 94-1476, at 51 (1976); S. REP. NO. 94-473, at 50 (1975), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5664.

⁵⁹ STAFF OF HOUSE COMM. ON THE JUDICIARY, 89TH CONG., SUPPLEMENTARY REPORT OF THE REGISTER OF COPYRIGHTS ON THE GENERAL REVISION OF THE U.S. COPYRIGHT LAW 3 (Comm. Print 1965).

⁶⁰ 499 U.S. 340 (1991); David Atlas, *Taming the Wild West: The Scope of Copyright Protection for Compilations after Matthew Bender v. West Publishing*, 38 IDEA 491 (1998).

⁶¹ 499 U.S. at 364. "17 U.S.C. § 101 does not afford protection from copying to a collection of facts that are selected, coordinated, and arranged in a way that utterly lack originality." *Id.*

certified public utility that provided telephone service to several communities in Kansas.⁶² Pursuant to state regulation, Rural annually published and issued a telephone directory consisting of white pages and yellow pages.⁶³ The white pages listed in alphabetical order the names of Rural's subscribers together with their towns and telephone numbers.⁶⁴ Rural obtained data for the directory directly from its subscribers, who were required to provide their names and addresses in order to receive telephone service.⁶⁵ The yellow pages listed Rural's business subscribers alphabetically by category and featured classified advertisements of various sizes.⁶⁶ Rural distributed its directory free of charge to its subscribers because Rural earned revenue from yellow pages advertisements.⁶⁷

Feist Publishing, Incorporated ("Feist") was a publishing company that specialized in area-wide telephone directories.⁶⁸ Unlike a typical directory, which covers only a particular area, Feist's area-wide directories covered a much wider geographic range, reducing the need to call directory assistance or consult multiple directories.⁶⁹ Like Rural, Feist distributed its directory, which included both white and yellow pages, free of charge.⁷⁰ Feist and Rural competed for yellow pages advertising.⁷¹ To obtain white pages listings for its area-wide directory, Feist approached each of the eleven telephone companies operating in northwest Kansas and offered to pay for the right to use their white pages listings.⁷²

Of the eleven telephone companies, only Rural refused to license its listings to Feist, consequently Feist copied the listings it needed directly from Rural's directory without Rural's consent.⁷³ Feist selected 4935 listings that were inside the relevant geographic range, then hired personnel to verify data reported by Rural and to obtain additional information.⁷⁴ Notwithstanding those additions, 1309 out of the 46,878 listings in Feist's

⁶² *Id.* at 342.

⁶³ *Id.*

⁶⁴ *Id.*

⁶⁵ *Id.* at 343.

⁶⁶ *Id.* at 342.

⁶⁷ *Id.*

⁶⁸ *Id.*

⁶⁹ *Id.* at 342-43.

⁷⁰ *Id.* at 343.

⁷¹ *Id.*

⁷² *Id.*

⁷³ *Id.*

⁷⁴ *Id.* at 343-44.

1983 directory were identical to Rural's 1982-1983 white pages.⁷⁵ Four of those were fictitious listings that Rural had inserted into its directory to detect copying.⁷⁶ The district court ruled, and the Tenth Circuit Court of Appeals affirmed, that telephone directories were copyrightable and Feist had infringed upon portions of Rural's copyright.⁷⁷

The Supreme Court, however, held otherwise.⁷⁸ Citing the Copyright Act of 1976, the Court stated that "originality, not 'sweat of the brow,' is the touchstone of copyright protection in directories and other fact-based works."⁷⁹ The Court emphasized that even though copyright protection is available for compilations, such as telephone directories, the copyright protection will leave the facts unprotected because they are not the products of an act of authorship.⁸⁰

III. ANALYSIS

Copyright protection does not exist for sequential, unedited volumes of judicial opinions or for pagination of those opinions because neither of those works, if they can be considered such, are sufficiently creative or original.⁸¹ Judicial opinions, though usually original and often creative, are considered the government's work and according to section 105 of the Copyright Act are not susceptible to protection.⁸² Likewise, star pagination, which essentially is Arabic numerals placed on pages, lacks creativity and originality. Despite the amount of work West may contribute to putting together a useful compilation, the body of copyright law will not protect some aspects of the compilation. The concepts of public domain,⁸³ the policies underlying copyright doctrine,⁸⁴ the merger

⁷⁵ *Id.* at 344.

⁷⁶ *Id.* It is common practice for publishers to use fictitious names in order to identify copiers. *Id.*

⁷⁷ *Id.*

⁷⁸ *Id.* at 360.

⁷⁹ *Id.* at 359-60.

⁸⁰ *Id.* at 349.

⁸¹ *Matthew Bender & Co., Inc. v. West Publ'g Co.*, 158 F.3d 674, 679 (2d Cir. 1998); Michael Higgins, *Go West, Young Publishers*, 85 A.B.A.J. 24 (1999).

⁸² *West Publ'g Co. v. Mead Data Cent., Inc.*, 799 F.2d 1219, 1224 (8th Cir. 1986).

⁸³ Copyrighted works fall into the public domain; that is, the subject of copyrights is free for public use, after a statutorily determined time period. 17 U.S.C. § 302 (1994).

⁸⁴ The policy behind the copyright doctrine is to promote broad public availability of literature, music, and the other arts. *Twentieth Century Music Corp. v. Aiken*, 422 U.S. 151, 156 (1975). While the immediate effect of copyright law is to secure a fair return to an author, the ultimate aim is to stimulate artistic creativity for the public good. *Id.*

doctrine,⁸⁵ and the elimination of the “sweat of the brow” doctrine justify this conclusion. The Second and Eighth Circuits, however, are split. The Eighth Circuit found that West’s compilations of judicial opinions and star pagination are sufficiently original and creative to be protected,⁸⁶ but the Second Circuit concluded such protection would be against copyright doctrine.⁸⁷

A. *The Eighth Circuit Expands West’s Copyright Scope*

West has spent an enormous amount of time litigating the breadth of the copyrights it holds. In 1986, West began defending any challenge to its publishing monopoly.⁸⁸ The Eighth Circuit ruled in West’s favor as to its arrangement of legal decisions and pagination of its legal reporters.⁸⁹ The validity of the Eighth Circuit’s holding, however, is questionable in the wake of the Supreme Court’s decision in *Feist*.⁹⁰

1. *West Publishing Co. v. Mead Data Central Co.*⁹¹

In June of 1985, Mead Corporation (“Mead”),⁹² who then owned LEXIS-NEXIS Corporation (“LEXIS”), announced that its computer database would begin offering star pagination.⁹³ This would enable a reader to cite to the exact page of an opinion published in one of West’s reporters without ever opening the printed version.⁹⁴ For example, a user of an

⁸⁵ Where there is only one or just a few ways of expressing an idea, courts will find that the idea behind the work merges with its expression so that the work is not copyrightable. *Morrissey v. Proctor & Gamble Co.*, 379 F.2d 675, 678 (1st Cir. 1967).

⁸⁶ *Mead Data*, 799 F.2d at 1229.

⁸⁷ *Matthew Bender & Co., Inc. v. West Publ’g Co.*, 158 F.3d 674, 689 (2d Cir. 1998).

⁸⁸ *Mead Data*, 799 F.2d at 1222.

⁸⁹ *Id.* at 1229.

⁹⁰ See generally *United States v. Thompson Corp.*, 909 F. Supp. 907, 926 (D.C. Cir. 1996) (stating that “this Court has serious doubts about the continuing vitality of the Eighth Circuit’s 1986 opinion in *Mead Data* in view of the subsequent decision of the Supreme Court in *Feist* . . .”); see also M. Nimmer & D. Nimmer, *NIMMER ON COPYRIGHTS* § 3.03 (1996) (stating that it is doubtful that the *Mead* court’s decision survives the Supreme Court’s rejection of the ‘sweat of the brow’ doctrine by a unanimous decision in *Feist*).

⁹¹ 799 F.2d at 1219.

⁹² *Mead Data Central* (“MDC”), a subsidiary of the Mead Corporation, operated LEXIS-NEXIS. Mead Corporation sold MDC to Reed Elsevier who currently owns LEXIS-NEXIS.

⁹³ *Mead Data*, 799 F.2d at 1222.

⁹⁴ *Id.*

electronic database would see a "***124" on the computer screen which would correspond to the page in a text version of the case in a reporter. The ability to cite to West is critical because various courts commonly require citations to West's National Reporter System.⁹⁵ West immediately brought a copyright infringement action against Mead.⁹⁶ West argued that although Mead's use of parallel citations to West opinions was allowable, because the citation only identified the volume and page number on which a particular case appears, Mead's new method of star pagination was an infringement of West's copyright in its arrangement of cases.⁹⁷ The Eighth Circuit held that West was entitled to copyright protection in the particular arrangement of legal decisions and in its pagination of legal case reports.⁹⁸

The Eighth Circuit relied primarily on classic "sweat of the brow" cases which have been subsequently overruled by *Feist*.⁹⁹ Though interspersed with terms such as "creative intellectual or aesthetic labor"¹⁰⁰ in an effort to be in accord with the copyright statute, the Eighth Circuit's analysis, nonetheless, rested squarely on the "sweat of the brow" doctrine. West's judicial opinions and pagination were certainly useful, but could hardly qualify as creative. The court, however, held the arrangement of opinions in a case reporter could qualify for copyright protection because "an original arrangement of opinions is copyrightable whenever it is the product of labor, talent, or judgment."¹⁰¹

The court correctly stated that "the standard for 'originality' is minimal."¹⁰² However, in its application, the court essentially made the

⁹⁵ *Thompson*, 949 F. Supp. at 910 (discussing that West Publishing is only one of two publishers of the "United States Code, the United States Supreme Court case law, the California Code, California case law, the Massachusetts Code, the Michigan Code, the New York Code, Washington case law and Wisconsin case law").

⁹⁶ *Mead Data*, 799 F.2d at 1222.

⁹⁷ *Id.*

⁹⁸ *Id.* The Eighth Circuit stated that telephone directories and similar publications were subject to copyright protection. *Id.* at 1228 citing *Hutchinson Tel. Co. v. Frontier Directory Co.*, 770 F.2d 128, 130 (8th Cir. 1985).

⁹⁹ *Hutchinson*, 770 F.2d at 130. The *Hutchinson* court relied on *Leon v. Pacific Tel. & Tel. Co.*, 91 F.2d 484 (9th Cir. 1937) as well as *Jeweler's Circular Publ'g Co. v. Keystone Publ'g Co.*, 281 F. 83 (2d Cir. 1922). In *Jeweler's*, the court stated that:

[t]he right to copyright a book upon which one has expended labor in its preparation does not depend upon whether the materials which he has collected consist or not of matters which are publici juris, or whether such materials show literary skill or originality, either in thought or in language, or anything more than industrious collection.

281 F. at 88.

¹⁰⁰ *West Publ'g Co. v. Mead Data Cent. Co.*, 799 F.2d 1219, 1223 (8th Cir. 1986) (citing *Golstein v. California*, 412 U.S. 546 (1973)).

¹⁰¹ *Mead Data*, 799 F.2d at 1224 (citing *Callaghan v. Myers*, 128 U.S. 617 (1888)).

¹⁰² *Id.* at 1223.

originality requirement not merely minimal, but non-existent.¹⁰³ Concluding that the arrangement West produces is the result of considerable labor, talent, and judgment, the Eighth Circuit found that Mead infringed on West's arrangement and pagination of legal reports.¹⁰⁴

In a vigorous dissent, Judge Oliver disagreed with the majority's findings stating that, "I find nothing in the record to support the requisite findings of fact upon which . . . the majority's conclusions of law are based."¹⁰⁵ Commentators have also disagreed with the majority and have argued that "[w]hile certain pagination choices of public domain works might be the product of deliberate choice and creativity . . . the record in *West v. Mead* revealed nothing whatsoever about the pagination choice made by West."¹⁰⁶

The Eighth Circuit's analysis puts an inappropriate emphasis on the labor involved in producing factual work. Throughout history, copyright law has recognized a greater need to disseminate factual works than works of fantasy or fiction.¹⁰⁷ To afford copyright protection based on labor distorts the elements of copyright principles. It creates a monopoly in public domain materials without the necessary justification of protecting and encouraging the creation of writings by authors.¹⁰⁸ A work should not qualify for a copyright merely because it is the product of labor. Despite any amount of hours put into compiling a work, certain aspects of that compilation will not be copyrightable. Hard work is not a substitute for originality and no amount of labor in gathering and arranging facts should reward the compiler with a copyright for the facts themselves. Any apparent injustice directed against the compiler is overcome by the greater good to the public in not having facts locked away for many years by a copyright.

¹⁰³ *Id.*

¹⁰⁴ *Id.* at 1224.

¹⁰⁵ *Id.* at 1233 (Oliver, J., dissenting). In his dissent, Senior District Judge Oliver argued that the majority's analysis is inconsistent with the applicable law. *Id.* at 1234. He argued, merely because "the sequential numbering of the pages of any volume, including a volume of law reports, is an important part of the volume, does not support a finding of fact that such a part of the whole of a particular volume of West's publications is subject to copyright." *Id.* Justice Oliver went on to state "[n]or . . . does such a fact support a finding of fact that West's arrangement of cases is subject to copyright. All parts of a copyrighted volume may not be automatically considered a subject to copyright simply because a publisher claims a copyright on the whole volume." *Id.*

¹⁰⁶ M. Nimmer & D. Nimmer, NIMMER ON COPYRIGHTS § 3.03 (1999).

¹⁰⁷ *Harper & Row Publishers, Inc. v. Nation Enter.*, 471 U.S. 539, 563 (1985).

¹⁰⁸ M. Nimmer & D. Nimmer, NIMMER ON COPYRIGHTS § 3.04 (1999).

2. *Oasis Publishing Co. v. West Publishing Co.*

Although the validity of *Mead Data* is questionable because it was decided prior to *Feist*, in a later case involving West, a court within the Eighth Circuit appeared to again advocate the “sweat of the brow” doctrine. In 1996, a district court within the Eighth Circuit cited *Mead Data* with approval, rejecting the notion that *Mead Data* is void because of *Feist*.¹⁰⁹ Oasis Publishing Company (“Oasis”) sought to market a CD-ROM product, which required scanning West’s reporters, deleting West’s original material, and then selling the opinion with West’s internal page numbers included.¹¹⁰

Before marketing its product, Oasis sued West seeking a declaratory judgment that West’s internal pages were not copyrightable.¹¹¹ Oasis argued that *Feist*, in effect, overruled the Eighth Circuit’s decision in *Mead Data*.¹¹² However, the district court disagreed.¹¹³ Instead, the court granted West’s motion for partial summary judgment in a decision addressing the copyrightability of the arrangement and pagination of cases in West reporters.¹¹⁴ The court held that the creativity standard was minimal and that the internal pagination included in West’s reporters was part of its overall arrangement of cases.¹¹⁵ The court went on to state that if Oasis intended to incorporate cases and pagination from West reporters into its CD-ROM databases, Oasis would violate West’s copyright.¹¹⁶

Insisting that the *Mead Data* court did not apply the “sweat-of-the-brow” doctrine, the *Oasis* court found that “[i]nstead of a mere ‘sweat of the brow’ analysis of West’s arrangement of cases in the National Reporter System, the court considered the ‘originality and intellectual-creation requirements’ of the arrangement.”¹¹⁷ Nonetheless, it is difficult to believe that the *Oasis* court was not influenced by the amount of labor put into

¹⁰⁹ *Oasis Publ’g Co. v. West Publ’g Co.*, 924 F. Supp. 918, 922-23 (D. Minn. 1996). Oasis Publishing Company, a competitor of West, brought an action against West seeking “declaratory judgment that West [had] no federal copyright protection to page numbers in the *Southern Reporter*, and that Oasis [did] not infringe any copyright by referring to the page numbers.” *Id.* at 921.

¹¹⁰ *Id.*

¹¹¹ *Id.*

¹¹² *Id.*

¹¹³ *Id.* at 923. Oasis alternatively argued that its intended use was a fair use, but the court struck down that argument as well. *Id.* at 926.

¹¹⁴ *Id.* at 931.

¹¹⁵ *Id.* at 925.

¹¹⁶ *Id.* at 926.

¹¹⁷ *Id.* at 923 (citing *West Publ’g Co. v. Mead Data Cent., Inc.*, 799 F.2d 1219, 1225-26 (8th Cir. 1986)).

producing a Reporter. The court spent a significant amount of time explaining West's process of putting together a reporter.¹¹⁸ The court highlighted how part of West's process included collecting opinions from every state and federal court, dividing decisions by level of court, and then arranging cases in each volume.¹¹⁹ In doing so, the focus of the court's analysis centered on the "sweat" yielded by West, rather than the originality or creativity of what was generated.

Due to the similar fact patterns *Oasis* and *Feist* are actually analogous. The Court held that *Feist* was free to copy the names, towns, and telephone numbers straight from Rural's white pages for use in its own directory.¹²⁰ The Court dismissed Rural's argument that it had selected, coordinated, or arranged the facts in an original way so as to procure copyright protection.¹²¹ Rural's choice of arrangement was considered by the Court to be "an age-old practice, firmly rooted in tradition and so commonplace that it has come to be expected as a matter of course."¹²² The "sweat of the brow" doctrine was unequivocally rejected and in its place the Court affirmed that copyright protection depends on originality and some degree of creativity.¹²³ Likewise, the opinions published by West are a matter of public record. Further, as the district court in *Mead Data* noted, West's method of compilation "is the most common method of referencing cases in the field of legal research."¹²⁴ Accordingly, *Oasis* or any other legal publisher should be free to use the non-copyrightable elements of West's work.

The *Oasis* court's veiled attempt to use "sweat of the brow" doctrine is, therefore, invalid. Despite the work that may occur in putting together a

¹¹⁸ *Id.* at 924. The court stated that:

First, West divides the cases by state, separating Alabama, Florida, Louisiana, and Mississippi court decisions. Next, West divides the decisions by court level . . . Within each state and court level, West divides the decisions and arranges them by placing first the fully headnoted opinions and jacketed memoranda, next sheet memoranda, and finally table dispositions.

Id.

¹¹⁹ *Id.* at 923.

¹²⁰ *Feist Publications, Inc. v. Rural Tel. Serv. Co., Inc.*, 499 U.S. 340, 363 (1991). The Supreme Court found that although Rural held a copyright in its directory because it contained original material in the yellow pages, it did not hold a copyright in the facts. *Id.*

¹²¹ *Id.* at 363-64.

¹²² *Id.* at 363.

¹²³ *Id.* at 353-54, 358.

¹²⁴ *West Publ'g Co. v. Mead Data Cent. Inc.*, 616 F. Supp. 1571, 1578 (D. Minn. 1985). The court's use of the term "self-indexing" essentially refers to star pagination. *Id.*

reporter, certain aspects are simply not copyrightable.¹²⁵ Section 103 of the Copyright Act of 1976 and *Feist* make it clear that a copyright in a compilation extends only to the selection and arrangement contributed by the author, as distinguished from the pre-existing material employed in the work.¹²⁶ A compilation copyright does not create any exclusive right in the pre-existing or uncopyrightable material.¹²⁷ Selection and arrangement of cases must contain the requisite degree of originality in order to merit copyright protection.

Because of these decisions, LEXIS has expended millions of dollars to license the star-pagination system from West. The cost is inevitably passed on to consumers and practitioners, who regularly use such works. Because of the necessity to use volumes of judicial reports and the star pagination system, consumers are not in a position to refuse to pay for the right to use such resources. Therefore, West's dominion has remained in certain jurisdictions.¹²⁸

B. The Second Circuit Narrows West's Copyright Scope

The Second Circuit has also addressed these same issues concerning the scope of West's copyrights. In 1994, Matthew Bender & Company ("Matthew Bender") sought a declaratory judgment against West arguing that West did not possess a federal statutory copyright in the volume numbers of its reporters or in the pagination of the opinions within each volume, and that Matthew Bender could non-infringingly use such information in its CD-ROM products.¹²⁹ HyperLaw, Incorporated, also a publisher of legal CD-ROM products, intervened as a plaintiff in the action and sought a declaration of non-infringement with respect to activities including scanning the title, text, and certain other information directly from the West reporters for use in one of its research products.¹³⁰ The

¹²⁵ It is not disputed that certain aspects of a case reporter, including, case synopsis, syllabi, digests, key numbers, and tables of statutes, may be copyrightable. *Id.* at 1576.

¹²⁶ *Id.* at 1580.

¹²⁷ *Id.*

¹²⁸ *Matthew Bender & Co., Inc. v. West Publ'g Co.*, 158 F.3d 693, 696 (2d Cir. 1998). The Bluebook "recommends-and some courts require-citation to the West version of federal appellate and trial court decisions and New York State court decisions." *Id.*

¹²⁹ *Id.* at 693.

¹³⁰ *Id.* West offered into evidence memoranda, which succeeded only in demonstrating that West is simply concerned with accurate presentation of caption information; they also set forth a uniform system for abbreviating certain words, which is not original or copyrightable. *Id.* at 683. West also introduced into evidence certain guidelines for citation alterations, but most of the guidelines involved obvious, garden-variety decisions to cite to West case reporters and to Westlaw. *Id.* at 686.

Second Circuit's ruling on these two issues had important ramifications on the legal field, as well as the field data storage and retrieval systems.

1. *Matthew Bender & Co. v. West Publishing Co.*:¹³¹ Judicial Opinions

Feist's rejection of the "sweat of the brow" doctrine has caused controversy as to whether volumes publishing judicial opinions are copyrightable.¹³² In direct conflict with the Eighth Circuit, the Second Circuit held that the changes West makes to an opinion do not represent a sufficient creative effort to warrant copyright protection.¹³³ The Second Circuit's holding implies that West's copyright protection for case editorial changes is limited to headnotes, key numbers, and a limited amount of other added material. Although at odds with the Eighth Circuit,¹³⁴ the Second Circuit reached the correct result in accord with the Supreme Court's precedent and copyright doctrine.¹³⁵

Works of the federal government are not subject to copyright protection; the text of judicial decisions may therefore be copied at will.¹³⁶ The effect of section 105 of the Copyright Act of 1976 is intended to place all works of the United States Government, published or unpublished, in the public domain.¹³⁷ Certainly, judicial opinions may form part of a compilation subject to a copyright, if the requisite degree of originality and creativity is met.¹³⁸ In order to determine copyrightability, the key question then is whether a publisher's alterations to the case reports when considered

As proof of its creativity in electing to parallel-cite to *United States Reports*, *Supreme Court Reporter*, and *Lawyer's Edition*, West lists eight other reporters of Supreme Court opinions that did not parallel cite . . . [However] all of these reporters are *daily* or *weekly* updates intended to provide quick copies of the slip opinions, not to serve as research tools or permanent records, and they are not recognized as standard sources for citation in the legal profession.

Id. at 687.

¹³¹ 158 F.3d 674 (2d Cir. 1998).

¹³² *Id.* at 689; *West Publ'g Co. v. Mead Data Cent., Inc.*, 799 F.2d 1219, 1229 (8th Cir. 1986).

¹³³ *Matthew Bender*, 158 F.3d at 689.

¹³⁴ *Mead Data*, 799 F.2d at 1229.

¹³⁵ See *infra* notes 136-159 and accompanying text.

¹³⁶ 17 U.S.C. § 105 (1994). Stating that: "[c]opyright protection under this title is not available for any work of the United States Government, but the United States Government is not precluded from receiving and holding copyrights transferred to it by assignment, bequest, or otherwise." *Id.*

¹³⁷ Notes of Committee on the Judiciary House Report, No. 94-1476, at 5664-65 (1976).

¹³⁸ 17 U.S.C. § 101 (1994).

collectively demonstrate sufficient originality and creativity to warrant a copyright.¹³⁹ The Second Circuit held that “[t]he creative spark is missing where: (i) industry conventions or other external factors so dictate selection that any person composing a compilation . . . would necessarily select the same categories of information . . . or [where] (ii) the author made obvious, garden-variety, or routine selections.”¹⁴⁰

West claimed originality as to several aspects of its compilations such as captions, courts, and date information, attorney information, subsequent history, and parallel/alternate citations.¹⁴¹ West stated that capitalizing the first named plaintiff and defendant to derive a “West digest title” standardizes the format of the party names.¹⁴² West also claimed that the name of the deciding court and the dates of a case are restyled to a particular format making it sufficiently original.¹⁴³ Lastly, West claimed that the caption, the court, the docket number, and the date are presented in a particular order making them subject to copyright protection.¹⁴⁴

West, however, seems to disregard that it has only limited useful options as to arrangement and selection. The Second Circuit was aware of West’s limited options stating that:

West’s claim illustrates the danger of setting too low a threshold for creativity or protecting selection when there are [only] two or three realistic options If all of these arrangements were protected, publishers of judicial opinions would effectively be prevented from providing any useful arrangement of attorney information . . . that is not substantially similar to a copyrighted arrangement.¹⁴⁵

According to the Second Circuit, almost all of West’s decisions with regard to its judicial opinion layout were “inevitable, typical, dictated by legal convention, or at best binary.”¹⁴⁶

The Second Circuit stated that its holding does not imply that compilations are never copyrightable.¹⁴⁷ The court stressed that to find a compilation copyrightable the exercise of judgment must be more

¹³⁹ *Feist Publications, Inc. v. Rural Tel. Serv. Co., Inc.*, 499 U.S. 340, 357 (1991). Originality requires only that the author makes the selection or arrangement independently and that it displays some level of creativity. *Id.* In some instances, the creative aspect is utterly lacking to be non-existent in which case the work is incapable of sustaining a valid copyright. *Id.*

¹⁴⁰ *Matthew Bender & Co., Inc. v. West Publ’g Co.*, 158 F.3d 674, 682 (2d Cir. 1998).

¹⁴¹ *Id.* at 681.

¹⁴² *Id.* at 683.

¹⁴³ *Id.*

¹⁴⁴ *Id.*

¹⁴⁵ *Id.* at 684.

¹⁴⁶ *Id.* at 685.

¹⁴⁷ *Id.* at 688.

evaluative and creative than West exhibited.¹⁴⁸ The court also noted that compilation copyrights are usually granted where “the compiler selected from among numerous choices, exercising subjective judgments relating to taste and value that were not obvious and that were not dictated by industry convention.”¹⁴⁹

West’s manner of shortening long case names, even if the result of original inspiration, is not sufficiently creative.¹⁵⁰ Any changes West makes, such as names and titles, and mere variations of typographic ornamentation or lettering, are simply not copyrightable.¹⁵¹ Nor does West’s overall choice regarding which procedural facts to include demonstrate the requisite originality and creativity to grant its case reporter copyright protection.¹⁵² Facts including names of parties, the deciding court, and the dates of argument and decision are “elementary items” whose inclusion is not the product of West’s decision but rather the product of their necessity.¹⁵³

The merger doctrine also undermines West’s position. Although the Second Circuit declined to invoke the merger doctrine in this instance,¹⁵⁴ its application would have been appropriate. The merger doctrine is an extension of the idea-expression dichotomy¹⁵⁵ and proclaims that “[i]n no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such a work.”¹⁵⁶

Expression is not protected where there is only a few ways of expressing an idea because the protection of the expression would effectively protect the idea as well.¹⁵⁷ The merger doctrine limits the scope of protection to

¹⁴⁸ *Id.* at 689; see also *Kregos v. Associated Press*, 937 F.2d 700, 704 (2d Cir. 1991); *Eckes v. Card Prices Update*, 736 F.2d 859, 863 (2d Cir. 1984).

¹⁴⁹ *Matthew Bender*, 158 F.3d at 689.

¹⁵⁰ *Id.* at 683.

¹⁵¹ *Id.*

¹⁵² *Id.*

¹⁵³ *Id.*

¹⁵⁴ *Id.* at 688 n.12.

¹⁵⁵ Simply stated, in the realm of copyrights there is a division between protectable expression and unprotectable ideas. *CCC Info. Serv., Inc. v. Maclean Hunter Mkt. Reports, Inc.*, 44 F.3d 61, 69 (2d Cir. 1994).

¹⁵⁶ 17 U.S.C. § 102(b) (1994).

¹⁵⁷ See generally *Williams v. Crichton*, 84 F.3d 581 (2d Cir. 1996) (when an author of children’s books alleged that the novel and movie *Jurassic Park* infringed upon his copyright, the court found that the claim was unfounded because the similarities between the works, citing the concept of dinosaur zoos, involved only uncopyrightable ideas); *CSM Investors, Inc. v. Everest Dev., Ltd.*, 840 F.

ensure that ideas remain freely accessible.¹⁵⁸ In other words, copyright doctrine prohibits a holder from monopolizing widely used expression or expression selected from a few options in order to protect the public from losing access to information. In the field of judicial reporting, the captions, courts, date information, attorney information, and subsequent history can be expressed in only a limited number of useful ways.¹⁵⁹ Copyright protection of West's particular arrangement would effectively limit any other possible arrangement.

2. *Matthew Bender & Co. v. West Publishing Co.*:¹⁶⁰ Star Pagination

Matthew Bender uses a file retrieving program that allows a user to access opinions in several ways, including the order in which they are stored on the disc, via search terms, or by use of a West or LEXIS page citation.¹⁶¹ Citations that appear in judicial opinions are "hyperlinked" so a user may retrieve that case by clicking the mouse on the case citation.¹⁶² Essentially, West's star pagination system correlates text of an opinion on its electronic database to the page on which the text would appear in the printed volume. The Second Circuit held that because "internal pagination of West's case reporters does not entail even a modicum of creativity, the volume and page numbers are not original components of West's compilations and are not themselves protected by West's compilation copyright."¹⁶³

The Second Circuit acknowledged that star pagination enables users to locate text within the West volume, but "this location does not result in any proximate way from West's original arrangement of cases."¹⁶⁴ Star

Supp. 1304 (D. Minn. 1994) (holding that expression of building design and expression of idea were not so extreme as to preclude protection of architectural plans for the site); *Wildlife Express Corp. v. Carol Wright Sales, Inc.*, 18 F.3d 502 (7th Cir. 1994) (holding that animal styled children's duffel bags were neither generic designs nor lifelike representations deserving of only narrow protection, when there was sufficient artistic expression in the soft sculptured animal heads and tails to support copyright protection).

¹⁵⁸ *Maclean Hunter*, 44 F.3d at 71.

¹⁵⁹ Other aspects of West's compilation may be subject to copyright protection if they satisfy the requisite degrees of originality and creativity.

¹⁶⁰ 158 F.3d 693 (2d Cir. 1998).

¹⁶¹ *Id.* at 697.

¹⁶² *Id.*

¹⁶³ *Id.* at 699.

¹⁶⁴ *Id.* at 708.

pagination gives the online user the correct location of page breaks within each judicial opinion corresponding to the textual work.

[W]here and on what particular pages the text of a court opinion appears does not embody any original creation of the compiler . . . star pagination does not in any way take advantage of that part of West's effort in making the compilation that reflects its intellectual effort. It simply . . . reflects that accident of where a particular portion of an opinion ended up in a West reporter.¹⁶⁵

The pagination system is performed automatically by a computer program.¹⁶⁶ Because the page breaks do not result from any original creation by West's star pagination, the volume and the page numbers convey unprotected information and, therefore, may be lawfully copied.

C. Addressing Counter-Arguments

The scope of West's copyright for certain aspects of its reporter should not only be limited for reasons enunciated in copyright doctrine, but also for reasons of public policy. There is a strong policy interest in allowing the public to have free access to facts.¹⁶⁷ Access to judicial opinions is every citizen's right and is necessary to promote the progress of the useful arts and sciences as stated by the Constitution.¹⁶⁸ Facts are the building blocks of intellectual activity and should remain in the public domain where they are available for all to use.¹⁶⁹ A copyright would lock up the "building blocks" for a time upwards of seventy-five years.¹⁷⁰ Depriving the public of free access to facts, for such an extensive period, would undermine thoughtful discussion among citizens and hinder progress.

A counter-argument to this thesis, one that is pro-compiler and essentially pro "sweat of the brow," is that compilers will lose the incentive

¹⁶⁵ *Matthew Bender & Co. v. West Publ'g Co.*, 41 U.S.P.Q. 2d 1321, 1330 (S.D.N.Y. Nov. 22, 1996).

¹⁶⁶ *Matthew Bender*, 158 F.3d at 699.

¹⁶⁷ See U.S. CONST., art. I, § 8, cl. 8.

¹⁶⁸ *Id.*

¹⁶⁹ J. H. Reichman & Pamela Samuleson, *Intellectual Property Rights in Data?*, 50 VAND. L. REV. 51, 76 (1997).

¹⁷⁰ The duration of copyright protection has evolved over the years. Under the 1909 Copyright Act, the duration of copyright protection extended for twenty-eight years from the date of first publication and could be extended upon renewal for an additional twenty-eight years. 17 U.S.C. § 304(b) (1994). The 1976 Copyright Act eliminated the renewal requirement and lengthened the term of protection. *Id.* § 304(a)(1)(A).

to create works if not granted copyright protection.¹⁷¹ The basis of the counter-argument is that facts will not circulate to the public if a compiler cannot restore his costs of making such facts available.¹⁷² This counter-argument is lacking in several respects. First, "sweat of the brow" doctrine protection may very well restore a compiler his costs of producing the publication. However, it does so by eliminating the essential requirement of creativity in lieu of the expense, time, and effort of the compiler. This argument is in direct conflict with copyright doctrine, which requires originality and a degree of creativity, and thus will allow for the compiler to be overcompensated for his efforts.¹⁷³ The true incentive for compilers is to produce a work with some semblance of creativity and thus be properly subject to a copyright.¹⁷⁴

Second, the tension between author control and public dissemination, especially concerning factual compilations, will likely continually exist.¹⁷⁵ If the tension must be resolved, it should be resolved in favor of the public. Although author incentive is necessary to get facts promulgated to the public, copyright doctrine already takes into account this supposed problem. The rule, as set forth in *Feist*, does account for author incentive. Socially beneficial compilations, which may otherwise not be produced absent the guarantee of cost recompense, are afforded copyright protection if certain requisites are met. Compilers are encouraged to creatively select and arrange facts and to make subjective decisions regarding such compilations. If these requisites are met, the compiler may be awarded copyright protection.

Although it may appear "unfair that much of the fruit of the compiler's labor may be used by others without compensation," it is not the primary objective of copyright law to reward the labor of the authors.¹⁷⁶ Copyright doctrine assures authors the right to their original expression, but

¹⁷¹ Denise R. Polivy, *Feist Applied: Imagination Protects But Perspiration Persists - Bases of Copyright Protection for Factual Compilations*, 8 FORDHAM INTELL. PROP. MEDIA & ENT. J. L. 773, 777-78 (1998).

¹⁷² Jane C. Ginsburg, *Creation and Commercial Value: Copyright Protection of Works of Information*, 90 COLUM. L. REV. 1865, 1866 (1990).

¹⁷³ Under the 1976 Copyright Act, copyright subsists "in original works of authorship fixed in any tangible medium of expression." 17 U.S.C. § 102(a) (1994). Originality requires independent creation plus a modicum of creativity. *Trade-Mark Cases*, 100 U.S. 82, 94 (1879).

¹⁷⁴ For example, in *Feist* the telephone directory compiler's real source of revenue was not in the residential number listings, but rather in the yellow page directory advertisements. 499 U.S. 340, 343 (1991). Because the yellow pages were creative and original, they were subject to a copyright. *Id.*

¹⁷⁵ The Constitution grants Congress the power "[t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries." U.S. CONST. art. I, § 8, cl. 8.

¹⁷⁶ *Feist*, 499 U.S. at 349.

encourages others to build freely upon the ideas and information conveyed in an author's work.¹⁷⁷ Supreme Court Justice Sandra Day O'Connor most succinctly states this particular consequence of copyright law: "[t]his result is neither unfair nor unfortunate. It is the means by which copyright advances the progress of science and art."¹⁷⁸

IV. CONCLUSION

The copyrightability of legal compilations has a tremendous impact on attorneys, judges, and others in the legal profession, as well as society as a whole. Because West implemented a successful system and because of lack of competition, West has held a virtual monopoly on the publishing of judicial opinions. West's success however was not the result of creative innovation, but rather was a result of organizing information in a manner dictated by convention. West's monopoly has been curbed though, in *Matthew Bender*, where the Second Circuit ruled that West's compilations would be, for the most part, fair game for copying by competitors. Accordingly, a publisher's enhancement of official court opinions does not involve sufficient originality to be copyrightable.

Because the Supreme Court, by denying review of the Second Circuit's decision in *Matthew Bender*,¹⁷⁹ has implicitly placed its mark of approval on the decision, there is the possibility that greater competition in the legal information field will result. Greater competition will ultimately reduce the cost for consumers who use such products. Those in favor of West's arguments need only look to the basics of copyright doctrine to discover that public domain works cannot be imprisoned by a copyright. One cannot steal what one already owns. The public has the right to the text of judicial decisions, as well as to star pagination, and the public's use in no way impinges upon West's so called "intellectual property" rights. As stated by James Love, head of the Consumer Project on Technology,¹⁸⁰ "[the] law belongs to the people, not a private monopoly."¹⁸¹

¹⁷⁷ *Id.* at 350-51.

¹⁷⁸ *Id.* at 350.

¹⁷⁹ *West Publ'g Co. v. HyperLaw, Inc.*, 119 S. Ct. 2039 (1999).

¹⁸⁰ The Consumer Project of Technology, created by Ralph Nader, is active in a number of areas including Intellectual Property, telecommunications, privacy, and electronic commerce. James Love, *The Consumer Project of Technology* (visited Jan. 17, 2000) <<http://www.cptech.org>>. CPT is also involved in a variety of projects relating to anti-trust enforcement and policy. *Id.*

¹⁸¹ *New York Court Rules West Cannot Copyright Opinions*, ELEC. PUBL. INFO. NEWSL. (Washington, D.C.), Nov. 1998, at 73.