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Thin But Not Anorexic: Copyright Protection for Compilations and Other Fact Works

David E. Shipley

University of Georgia School of Law, shipley@uga.edu



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THIN BUT NOT ANOREXIC: COPYRIGHT PROTECTION FOR COMPILATIONS AND OTHER FACT WORKS

*David E. Shipley**

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* Thomas R.R. Cobb Professor of Law, University of Georgia School of Law.

I. INTRODUCTION

“While . . . the ‘copyright in a factual compilation is thin,’ we do not believe it is anorexic.”¹ The Court of Appeals for the Second Circuit made this statement shortly after the Supreme Court announced its landmark ruling in *Feist Publications, Inc. v. Rural Telephone Services Co.*² The Second Circuit held that a yellow pages directory of businesses in New York City’s Chinatown was copyrightable because there was originality in the plaintiff’s selection of establishments to include in the publication.³ The court concluded, however, that the defendant’s business guide did not infringe because the organizing principles of the two publications were different.⁴ This is a familiar scenario with litigation over “low authorship” works⁵ like directories. The plaintiff won the battle over copyrightability but lost the war of infringement. The scope of the plaintiff’s copyright might not have been anorexic, but it was certainly lean.

Questions about the copyrightability of compilations and other low authorship fact works, and about the scope of protection, have continued to trouble courts long after *Feist*.⁶ The Supreme Court’s focus was on the protectability of a telephone company’s standard white pages directory⁷ that had been copied by the publisher of an area-wide directory. Justice O’Connor’s opinion, explaining why the directory did not meet the constitutional and statutory requirements for copyright protection, defined an original work of authorship as one that is independently created by its author and that evidences at least a minimal level of creativity.⁸ Most works will satisfy this standard since they will possess some creative spark.⁹

¹ *Key Publ’ns, Inc. v. Chinatown Today Publ’g Enters., Inc.*, 945 F.2d 509, 515 (2d Cir. 1991) (quoting *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 349 (1991)).

² 499 U.S. 340 (1991).

³ *Key Publ’ns*, 945 F.2d at 513.

⁴ *Id.* at 516 (finding there was not substantial similarity of protected expression).

⁵ The term “low authorship” work was applied by Professor Jane Ginsburg to fact works like directories, maps, databases, and other compilations in contrast to works of “high authorship” like novels and narrative histories. Jane C. Ginsburg, *Creation and Commercial Value: Copyright Protection for Works of Information*, 90 COLUM. L. REV. 1865, 1866–71 (1990); see also Paul Heald, *The Vices of Originality*, 1991 SUP. CT. REV. 143, 150 (further applying the term).

⁶ See CRAIG JOYCE, MARSHALL LEAFFER, PETER JASZI & TYLER OCHOA, COPYRIGHT LAW 242 (7th ed. 2006) (“In the aftermath of *Feist*, the distinction between copyrightability, on the one hand, and the scope of copyright protection, on the other, takes on special importance in compilation cases.”).

⁷ *Feist*, 499 U.S. at 356–59.

⁸ See *id.* at 374 (noting that “a slight amount [of creativity] will suffice”) (citing 1 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 1.08[C][1] (2007 ed.)).

⁹ *Feist*, 499 U.S. at 345; see Alan Durham, *Speaking of the World: Fact, Opinion and the Originality Standard of Copyright*, 33 ARIZ. ST. L.J. 791, 793 (2001).

Even though the task of opining on the question of copyrightability should not be onerous because the originality standard is not stringent¹⁰ the modicum of creativity requirement is seen as being elusive.¹¹ For the most part, the Supreme Court defined creativity in *Feist* by negative example, describing how an author's efforts in preparing a compilation might not satisfy the requirement: selections and arrangements that are mechanical, routine, commonplace, typical, garden variety, obvious, inevitable, or dictated by law will fail to pass muster.¹² Reported decisions applying *Feist* to challenged compilations and other low authorship works now provide many examples of unprotectable works deemed to be commonplace, routine, or garden-variety. The courts have added to the Supreme Court's examples of what is not creative by considering the impact of industry standards, customary practices, and regulatory requirements. The post-*Feist* cases also show that the merger doctrine is a significant hurdle for compilers¹³ as is the idea/expression dichotomy's ban on extending copyright protection to ideas, methods of operation, systems, and concepts as codified in section 102(b) of the Copyright Act.¹⁴

Once a compilation is held copyrightable, the court has to rule on whether the work has been infringed. This requires dissection of the work to distinguish protected expression from unprotected facts and ideas. This is easier said than done because of the creativity requirement. Here again, the many decisions applying *Feist* in determining whether a thinly protected low authorship work has been infringed show that winning the infringement war is difficult absent proof of something close to wholesale copying.¹⁵ This is because it is challenging to

¹⁰ *Feist*, 499 U.S. at 358–59.

¹¹ See Durham, *supra* note 9, at 793–94; Russ VerSteeg, *Rethinking Originality*, 34 WM. & MARY L. REV. 801, 803–04 (1993); Diane Zimmerman, *It's an Original!?: In Pursuit of Copyright's Elusive Essence*, 28 COLUM. J.L. & ARTS 187, 188 (2005).

¹² See Howard Abrams, *Originality and Creativity in Copyright Law*, LAW & CONTEMP. PROBS., Spring 1992, at 16. Cf. VerSteeg, *supra* note 11, at 822 (noting that the Court failed to explain how it determined that the white pages lacked the requisite creativity).

¹³ See Durham, *supra* note 9, at 801 (defining and explaining merger).

¹⁴ 17 U.S.C. § 102(b) (2000). But see Dan L. Burk, *Method and Madness in Copyright Law* (Minn. Legal Studies Research Paper 07-34, 2007), available at <http://ssrn.com/abstract=999433> (forthcoming in UTAH LAW REVIEW) (criticizing copyright's treatment of methods, systems, and processes in several post-*Feist* decisions dealing with the protectability of valuation estimates).

¹⁵ See, e.g., *Bucklew v. Hawkins, Ash, Baptie & Co.*, 329 F.3d 923, 928–30 (7th Cir. 2003) (holding plaintiff's tables to be copyrightable because they were configured in an optional way and were the product of format choices that were not unavoidable and for which there were an immense number of alternate combinations defendant could have used instead of slavishly copying plaintiff's tables); see also *Concrete Mach. Co. v. Classic Lawn Ornaments, Inc.*, 843 F.2d 600, 606–07 (1st Cir. 1988); *Cooling Sys. & Flexibles, Inc. v. Stuart Radiator, Inc.*, 777 F.2d 485, 491 (9th Cir. 1985); *Skinder-Strauss Assocs. v. Mass. Continuing Legal Educ., Inc.*, 914 F. Supp. 665, 673 (D. Mass. 1995); *infra* notes 321–34 and accompanying text.

identify protected expression in a compilation and then to show that the defendant copied a substantial amount of that expression. In addition, the fair use defense can be applied to excuse some appropriations of protected expression.¹⁶

This Article, with the help of many post-*Feist* opinions,¹⁷ elaborates on Justice O'Connor's guidance for determining whether a compilation or other low authorship work is entitled to copyright protection and, if so, whether the work has been infringed. It was observed forty years ago that "to make the copyright turnstile revolve, the author should have to deposit more than a penny in the box, and some like measure ought to apply to infringement."¹⁸ This Article explains how much more than a penny is needed to get through that turnstile and concludes that the courts have been relatively consistent in applying the fundamental principles of *Feist* in a variety of contexts and thereby ensuring that copyright does not improperly extend to facts, ideas, systems, and concepts. Traditional case-by-case application of *Feist*'s principles is working well and the "sweat of the brow" rationale¹⁹ for protection has not been resurrected.

II. THE FUNDAMENTALS OF *Feist*

The facts of *Feist* were simple. Rural Telephone published a standard white pages directory with subscribers' names and numbers listed in alphabetical order, and there was no doubt that *Feist*, a competing publisher of phone books, copied roughly 1,300 of Rural's names and numbers.²⁰ The trial court found infringement and the Tenth Circuit affirmed, but the Supreme Court reversed.²¹ It held that Rural's copyright did not protect the names and numbers copied by *Feist*, and it declared that originality—*independent creation and a modest degree of creativity*—is a constitutional requirement for copyright.²²

Since this Article discusses the challenge of applying *Feist*'s principles to close questions on originality and the scope of protection, it is important to state the principles that emerged from ruling on those simple facts. The starting point is the Supreme Court's statement that "facts are not copyrightable" yet

¹⁶ See, e.g., *Consumers Union v. Gen. Signal Corp.*, 724 F.2d 1044 (2d Cir. 1983); *Gulfstream Aerospace Corp. v. Camp System*, 428 F. Supp. 2d 1369 (S.D. Ga. 2006).

¹⁷ Cf. Zimmerman, *supra* note 11, at 211–12 ("The discipline imposed by a system of precedent [and appellate review] will ultimately lead to some reasonable agreement about what kinds of works do and do not exhibit sufficient creativity to warrant protection. . . .").

¹⁸ BENJAMIN KAPLAN, AN UNHURRIED VIEW OF COPYRIGHT 46 (1967).

¹⁹ See *Feist Publ'n's, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 352–54 (1991) (discussing the "sweat of the brow" or "industrious collection" theory of copyright protection).

²⁰ *Id.* at 344.

²¹ *Id.* at 363.

²² *Id.* at 342–44.

“compilations of facts generally are.”²³ The tension between these fundamental propositions is explained by the concept of originality, the *sine qua non* of copyright. An original work is one that is independently created by its author and that possesses at least a minimal level of creativity. The requisite level of creativity is low,²⁴ and most works will satisfy this standard since they will possess some creative spark.²⁵ It does not matter that a work is crude or humble or obvious. Novelty is not required.²⁶

Assuming independent work by the author, the requisite creativity for fact works like compilations may come from the author’s choice of facts, the order in which those facts are placed, or how the data is arranged.²⁷ However, it is not enough for an author to labor hard at the selection or arrangement of facts. Sweat and elbow grease alone do not satisfy *Feist’s* requirements.²⁸ Facts must be selected, coordinated or arranged so that the resulting work as a whole is copyrightable.²⁹ The vast majority of compilations and other fact works will cross the originality threshold but not all because there remains a category of works where the creative spark is lacking or so trivial as to be nonexistent.³⁰ The Supreme Court was emphatic that the requirement of originality, including the creativity component, is imposed by the Constitution.³¹

Feist’s requirements that a work must be independently created and possess some minimal level of creativity in order to be entitled to copyright protection is consistent with the requirements of the Berne Convention for the Protection of Literary and Artistic Works (Berne Convention) and the Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPs). Both use the term “intellectual creation” as a requirement for a compilation or collective work to

²³ *Id.* at 345. See generally *Abrams*, *supra* note 12, at 9–14. Facts are discoverable; they are not created. *Durham*, *supra* note 9, at 794–95.

²⁴ “[A] modicum of intellectual labor . . . clearly constitutes an essential constitutional element.” *Feist*, 499 U.S. at 347 (quoting 1 *NIMMER & NIMMER*, *supra* note 8, § 1.08[C][1]).

²⁵ *Feist*, 499 U.S. at 345.

²⁶ *Id.* at 345–46. But see *CCH Canadian Ltd. v. Law Soc’y of Upper Can.*, [2004] S.C.R. 339 ¶¶ 21–22, 24 (the Canadian Supreme Court misread *Feist’s* originality/modicum of creativity standard as requiring a work to be novel or unique in order to be protected by copyright).

²⁷ *Feist*, 499 U.S. at 348. A compilation is “a work formed by the collection and assembling of preexisting 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 (2000).

²⁸ *Feist*, 499 U.S. at 352–54.

²⁹ *Id.* at 357–58.

³⁰ *Id.* at 359; see also *Heald*, *supra* note 5, at 145–49; *Zimmerman*, *supra* note 11, at 187–88. Many of the post-*Feist* decisions dealing with the copyrightability of compilations assess the creativity involved in selecting and arranging information. See, e.g., *Matthew Bender & Co. v. West Publ’g Co.*, 158 F.3d 674, 681 (2d Cir. 1998).

³¹ *Abrams*, *supra* note 12, at 14.

receive protection as a literary or artistic work,³² and it is recognized that this term applies generally to all works.³³ Works lacking intellectual creation may not receive copyright protection consistent with the requirements of Berne and TRIPs.³⁴ The requirement demands more than a work that simply originates from the author and it includes, if not creativity as such, then at least some intellectual effort.³⁵ Similarly, the French requirement that a work reflect the author's personality through creative choices in order to be protected by copyright is satisfied when an author shows the exercise of some creative choice and not slavish copying.³⁶ These requirements of intellectual effort or intellectual creation echo the Supreme Court's discussion of originality in the 1884 classic, *Burrow-Giles Lithographic v. Sarony*,³⁷ in which the Court used terms like thought, intellectual production, intellectual conception, and intellectual creation in explaining why Sarony's famous photograph of Oscar Wilde was copyrightable.³⁸

The originality, intellectual creation, and creative choices standards are low thresholds for copyright protection, so it is inevitable that the scope of protection for fact works is thin,³⁹ extending only to those aspects that are original to the author.⁴⁰ Determining this is challenging, but if the author's selection and arrangement of facts are original, then those aspects of the work are protected, but not the facts themselves.⁴¹ A subsequent author or compiler can freely use those facts so long as his or her presentation of them does not have the same selection or arrangement.⁴²

In applying these principles to Rural's white pages the Supreme Court re-emphasized that "originality is not a stringent standard," but added "that the

³² See Berne Convention for the Protection of Literary and Artistic Works, art. 2(5), July 24, 1971, S. Treaty Doc. No. 99-27, 1161 U.N.T.S. 3; Agreement on Trade-Related Aspects of Intellectual Property Rights, art. 10(2), Apr. 15, 1994, Marrakesh Agreement Establishing the World Trade Organization, Annex 1C, 1869 U.N.T.S. 299.

³³ Daniel Gervais, *Feist Goes Global: A Comparative Analysis of the Notion of Originality in Copyright Law*, 49 J. COPYRIGHT SOC'Y U.S.A. 949, 971 n.150 (2002).

³⁴ See DANIEL CHOW & EDWARD LEE, INTERNATIONAL INTELLECTUAL PROPERTY: PROBLEMS, CASES & MATERIALS 144-45 (2006).

³⁵ Gervais, *supra* note 33, at 961 (cited with approval in *CCH Canadian Ltd. v. Law Soc'y of Upper Can.*, [2004] S.C.R. 13, 24).

³⁶ CHOW & LEE, *supra* note 34, at 145 (citing PAUL GELLER & MELVILLE NIMMER, INTERNATIONAL COPYRIGHT LAW & PRACTICE § 2[1][b][iii] (France) (2004)).

³⁷ 111 U.S. 53 (1884).

³⁸ *Id.* at 58-60; see also VerSteeg, *supra* note 11, at 836-37; Zimmerman, *supra* note 11, at 188.

³⁹ *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 349 (1991).

⁴⁰ *Id.*

⁴¹ *Id.* (citing William Patry, *Copyright in Compilations of Facts (or Why the "White Pages" are not Copyrightable)*, COMM. & L., Dec. 1990, at 64).

⁴² *Feist*, 499 U.S. at 349-50 (discussing *Harper & Row, Inc. v. Nation Enters.*, 471 U.S. 539 (1985)).

selection and arrangement of facts cannot be so mechanical or routine as to require no creativity whatsoever.⁴³ Rural's directory did not satisfy this low standard because it was a typical, "garden-variety white pages directory, devoid of even the slightest trace of creativity."⁴⁴ The selection of listings was obvious and, notwithstanding Rural's efforts, lacking the modicum of creativity required to transform mere selection into copyrightable expression.⁴⁵ Moreover, since Rural was required by the Kansas Corporation Commission to publish the names and telephone numbers of its subscribers, it was reasonable to conclude that the plaintiff's selection was dictated by state law and not creative.⁴⁶

Similarly, the Court found that Rural's coordination and arrangement of its subscribers' information in alphabetical order lacked originality.⁴⁷ There is nothing remotely creative about arranging names alphabetically. This is a time-honored, age-old practice rooted in tradition that is commonplace and universal. It is unoriginal and practically inevitable.⁴⁸ Thus, the Court determined it was obvious that Rural's white pages did not meet the originality requirement: "Given that some works must fail, we cannot imagine a more likely candidate. Indeed, were we to hold that Rural's white pages pass muster, it is hard to believe that any collection of facts could fail."⁴⁹ Accordingly, since the names, towns and numbers in Rural's directory were not protected by copyright, *Feist's* use of them did not infringe.⁵⁰

The Court did not have to address the issue of substantial similarity of protected expression directly because *Feist* reproduced unprotected facts that were presented as an alphabetical listing that lacked the requisite modicum of creativity.⁵¹ It did, however, make several important statements that weigh heavily in proving infringement, noting for example that "even a directory that contains absolutely no protectible written expression, only facts, meets the constitutional minimum for copyright protection if it features an original selection or arrangement,"⁵² but then adding that this protection is limited: "The mere fact

⁴³ *Id.* at 362.

⁴⁴ *Id.*

⁴⁵ *Id.* at 362–63.

⁴⁶ *Id.*

⁴⁷ *Id.* at 363.

⁴⁸ *Id.* The selection of facts for the directory and their presentation were evaluated separately by the Court. See *Abrams*, *supra* note 12, at 18.

⁴⁹ *Feist*, 499 U.S. at 364.

⁵⁰ *Id.* at 363–64 ("As a statutory matter, 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 lacks originality.").

⁵¹ *Id.* at 364 ("Because Rural's white pages lack the requisite originality, *Feist's* use of listings cannot constitute infringement.").

⁵² *Id.* at 348.

that a work is copyrighted does not mean that every element of the work may be protected. Originality remains the *sine qua non* of copyright; accordingly, copyright protection may extend only to those components of a work that are original to the author.”⁵³

The Court repeated this, emphasizing that even if a compilation is copyrightable, it receives only limited protection.

As § 103 makes clear, copyright is not a tool by which a compilation author may keep others from using the facts or data he or she has collected. “The most important point here is one that is commonly misunderstood today: copyright . . . has no effect one way or the other on the copyright or public domain status of the preexisting material.”⁵⁴

Thus, according to the Court, facts “may be freely copied because copyright protects only the elements that owe their origin to the compiler—the selection, coordination, and arrangement of facts.”⁵⁵

III. APPLICATIONS OF *Feist*'s FUNDAMENTAL PRINCIPLES

As noted in Part I, the Supreme Court defined creativity negatively by describing how a compiler's work might fail to satisfy the requirement; selections and arrangements that are mechanical, routine, common place, typical, garden variety, obvious, inevitable, time-honored, age-old, or dictated by law will fail to pass muster.⁵⁶ Moreover, the author claiming infringement must prove creativity, defined as “the existence of . . . intellectual production, of thought and

⁵³ *Id.*

⁵⁴ *Id.* at 359 (citing and quoting H.R. Rep. No. 94-1476, at 57 (1976); S. Rep. No. 94-473, at 55 (1975)).

⁵⁵ *Id.*

⁵⁶ See Abrams, *supra* note 12, at 33; Durham, *supra* note 9, at 793 (stating that creativity is the missing term in the *Feist* equation); VerSteege, *supra* note 11, at 823 (the Court defined creativity by default); Zimmerman, *supra* note 11, at 188 (saying that the Court offered no real answer about what was the minimum necessary to satisfy the demand for creativity). The opinion does not make clear whether originality is to be found by looking at the work or by evaluating the mental processes that went into producing it. Leo J. Raskind, *Assessing the Impact of Feist*, 17 U. DAYTON L. REV. 331, 334–35 (1992). The many low authorship cases decided since *Feist* show that courts consider both the work itself and the nature of the author's intellectual labor.

conception.”⁵⁷ Novelty need not be shown nor does the work have to be innovative or surprising,⁵⁸ but effort alone is not enough.⁵⁹

The many decisions applying *Feist* to low authorship works have added to the Supreme Court’s descriptions of what might not be creative by considering the impact of industry standards, customary practices, and regulatory requirements. The blank form doctrine is a limitation on protection,⁶⁰ and the merger doctrine is another significant hurdle for compilers, as is the ban on extending copyright protection to ideas, methods of operation, systems, and concepts in section 102(b) of the Copyright Act.⁶¹

Notwithstanding the creativity requirement, originality remains a low threshold consistent with the Supreme Court’s statements in *Feist*. However, even if a work is copyrightable, the decisions also show, consistent with *Feist*’s principles, that proving substantial similarity of expression is difficult.⁶² This is because protection may extend only to those components of a work that are original to the author.⁶³ The courts are making sure that copyright is not a tool by which a compiler or other low authorship work writer may keep others from using the facts or data he or she has collected.⁶⁴ Sweat of the brow has not been given new life.⁶⁵

A. DIRECTORIES

There is no doubt after *Feist* that a standard white pages telephone directory, with the subscribers’ information arranged in alphabetical order, is not copyrightable.⁶⁶ There is no creativity in either the selection of the names and numbers or in that standard arrangement.⁶⁷ What about the yellow pages? There would seem to be a considerable amount of creativity involved in selecting and

⁵⁷ *Feist*, 499 U.S. at 362 (citing and quoting *Burrows-Giles Lithographic Co. v. Saroni*, 111 U.S. 53, 59–60 (1883)). There must be some exercise of judgment by the author in his or her selection, coordination, or arrangement of the facts. See *Abrams*, *supra* note 12, at 17.

⁵⁸ *Feist*, 499 U.S. at 362; see also Zimmerman, *supra* note 11, at 208–09.

⁵⁹ *Feist*, 499 U.S. at 364.

⁶⁰ Blank forms that are designed to record information rather than to convey it are generally not copyrightable. 1 NIMMER & NIMMER, *supra* note 8, § 2.18[B][4].

⁶¹ 17 U.S.C. § 102(b) (2000); see also Heald, *supra* note 5, at 160–68 (criticizing *Feist* and predicting accurately that it would cause problems for works like law reports, yellow pages, maps, new uses of existing data, live broadcasts, and computer programs).

⁶² See *infra* notes 321–34 and accompanying text.

⁶³ *Feist*, 499 U.S. at 347.

⁶⁴ See *infra* notes 309–10 and accompanying text.

⁶⁵ See *Feist*, 499 U.S. at 352–54 (defining and discussing the discredited “sweat of the brow” basis for protection).

⁶⁶ See *supra* Part II.

⁶⁷ See *supra* notes 44–50 and accompanying text.

presenting the materials that make up the yellow pages.⁶⁸ What about other directories? The answer is that most will pass muster and be protectable, but that does not mean much because the protection will be very thin and infringed only by wholesale reproduction.

The Second Circuit held in *Key Publications* that the plaintiff's classified business directory for New York City's Chinese-American community was copyrightable.⁶⁹ The 9,000 businesses the plaintiff selected for the work were sorted by type of business, each listing was put in one of 260 descriptive categories like Accountants and Art Supplies, and each listing had the English and Chinese names of the establishment along with its address and telephone number.⁷⁰ The court explained that selection implies the exercise of judgment in choosing what to include, and the plaintiff chose from among a multitude of establishments those businesses that, in her opinion, would be of the greatest interest to her audience.⁷¹ The compiler deliberately chose to exclude businesses that she believed would not remain open, such as some insurance brokers, takeout restaurants, and traditional Chinese medical practitioners.⁷² The appellate court felt this degree of selectivity, or this rationale for selection, adequately supported the trial court's conclusion that there was originality and creativity in selection;⁷³ another way to say this is that creativity inheres in the making of non-obvious selections from more than a few options.⁷⁴

The court also said that although Key's arrangement was typical of most directories with listings in standard categories like accountants, bridal shops, and shoe stores, all arranged in alphabetical order, it also included categories of special interest to the Chinese-American community like "Bean Curd & Bean Sprout Shops."⁷⁵ The court concluded that this arrangement was not mechanical. Instead, it showed creativity and was thus copyrightable.⁷⁶ It was not typical, garden-variety, routine, or obvious.

Notwithstanding this conclusion, the court held that Key's directory was not infringed. The Court noted that the substantial similarity inquiry is narrowed with

⁶⁸ See MARSHALL LEAFFER, UNDERSTANDING COPYRIGHT LAW 73–74 (4th ed. 2005).

⁶⁹ *Key Publ'ns, Inc. v. Chinatown Today Publ'g Enters., Inc.*, 945 F.2d 509, 511 (2d Cir. 1991). The yellow pages accounted for roughly two-thirds of Key's directory. Initially, the work included businesses in just Chinatown, but then it was expanded to include businesses in other parts of metropolitan New York as well as Boston and Philadelphia. See JOYCE ET AL., *supra* note 6, at 262; Durham, *supra* note 9, at 812–13.

⁷⁰ *Key Publ'ns*, 945 F.2d at 511–12, 514.

⁷¹ *Id.* at 513.

⁷² *Id.*

⁷³ *Id.* at 512–13.

⁷⁴ See Matthew Bender & Co. West Publ'g Co., 158 F.3d at 682 (2d Cir. 1998).

⁷⁵ *Key Publ'ns*, 945 F.2d at 514.

⁷⁶ *Id.* at 513–14.

compilations because their components are generally in the public domain, and even absolute identity as to matters in the public domain does not establish infringement absent copying of the protected elements of the compilation: Key's selection and arrangement.⁷⁷ Here there was not substantial similarity because the defendant had only twenty-eight categories compared to Key's 260, and only three of the categories overlapped; just 17% of Key's listings were included in the defendant's guide, and at least 25% of the defendant's entries were not in Key's directory.⁷⁸ The court concluded as a matter of law that there was no infringement.⁷⁹ To rule otherwise would have afforded protection to facts and bring back the discredited "sweat of the brow" rationale for protection of compilations.⁸⁰

A standard yellow pages directory was at issue in *BellSouth Advertising & Publishing Co. v. Donnelley Information Publishing*.⁸¹ The parties stipulated that BellSouth's directory, considered as whole, qualified for copyright protection.⁸² The defendant had not copied the text or graphics of BellSouth's ads; it had not used BellSouth's typeface, and it had not photocopied or reproduced the page-by-page arrangements or appearance of the directory.⁸³ The pivotal issue was

⁷⁷ *Id.* at 514–15.

⁷⁸ *Id.* at 515.

⁷⁹ *Id.* at 515–16.

⁸⁰ *Id.* at 514–16. The defendant did not duplicate Key's categories or more than just a few entries. For example, Key listed 124 accountants while defendant's directory had forty-two. *Id.* at 515. See also *Skinder-Strauss Assocs. v. Mass. Continuing Legal Educ., Inc.*, 914 F. Supp. 665, 677 (D. Mass. 1995) (stating that while summary judgment is not appropriate in litigation over competing legal directories because reasonable people might differ on whether the compilations as a whole were substantially similar, the constituent elements of plaintiff's directory were not protectable because of the merger doctrine, the blank form doctrine, common property, and core similarities and differences); *O.P. Solutions, Inc. v. Intellectual Prop. Network, Ltd.*, 52 U.S.P.Q.2d (BNA) 1818 (S.D.N.Y. 1999) (compilation of components in a computer program's screen display/user interface held copyrightable and infringed by defendant's substantially similar selection and arrangement).

⁸¹ 999 F.2d 1436 (11th Cir. 1993). This litigation started in the 1980s before *Feist* was decided. Initially, the trial court granted summary judgment to BellSouth on its infringement claim. *BellSouth Adver. & Publ'g Co. v. Donnelly Info. Publ'g*, 719 F. Supp. 1551 (S.D. Fla. 1988). This judgment was affirmed by the Eleventh Circuit but subsequently vacated by a grant of rehearing en banc. *BellSouth Adver. & Publ'g Co. v. Donnelly Info. Publ'g*, 933 F.2d 952 (11th Cir. 1991), *vacated and en banc reh'g granted*, *BellSouth Adver. & Publ'g Co. v. Donnelly Info. Publ'g*, 977 F.2d 1435 (11th Cir. 1992); see also JOYCE ET AL., *supra* note 6, at 243. The first Eleventh Circuit decision, finding the yellow pages copyrightable and infringed, is discussed and criticized in *Abrams*, *supra* note 12, at 24–28. He argues that the court was wrong for not asking whether the classification scheme was original to the plaintiff and whether the categories were typical or garden-variety. He also says that much of the vacated opinion was inconsistent with *Feist*. *Id.*

⁸² *BellSouth*, 999 F.2d at 1438.

⁸³ *Id.* at 1438, 1445.

whether the defendant had copied any protected expression,⁸⁴ and this required the court to explain what was copyrightable in the yellow pages. Given the court's rigorous application of *Feist*, it might have been more accurate for the Eleventh Circuit to reject that stipulation of copyrightability and state that hardly anything in a standard yellow pages directory is protectable.

The court first held that the company's acts of selection in deciding what to include, such as determining the directory's geographic scope, setting the closing date after which changes could not be made, and its marketing techniques to generate the data, did not meet the required level of originality.⁸⁵ These were techniques for the discovery of facts, not acts of authorship.⁸⁶ The court stated:

Any useful collection of facts, however, will be structured by a number of decisions regarding the optimal manner in which to collect the pertinent data in the most efficient and accurate manner. If this were sufficient, then the protection of copyright would extend to census data, cited in *Feist* as a paradigmatic example of a work that lacks the requisite originality.⁸⁷

The court then ruled that BellSouth's coordination and arrangement of the yellow pages was not copyrightable.⁸⁸ It acknowledged that the yellow pages required "somewhat more organization and arrangement than the white pages," but this was not enough because BellSouth "did not deviate from the arrangement of the typical business directory which employs an alphabetical list of headings to describe the various types of businesses and then alphabetizes the listings under the appropriate headings."⁸⁹ Moreover, although there might have been other ways to arrange the directory, BellSouth's claim of copyright in the arrangement also failed because of "merger."⁹⁰ This doctrine has the effect of preventing copyright protection for original expression when there are only a few ways to express the underlying idea.⁹¹ It was irrelevant whether there might have been

⁸⁴ *Id.* at 1438. See generally Durham, *supra* note 9, at 813–14 (discussing the court's reasoning as to the originality of the directory).

⁸⁵ *BellSouth*, 999 F.2d at 1441.

⁸⁶ *Id.*

⁸⁷ *Id.* (citing *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340 (1991)).

⁸⁸ *Id.* at 1442.

⁸⁹ *Id.*

⁹⁰ *Id.*

⁹¹ See *Morrissey v. Proctor & Gamble Co.*, 379 F.2d 675, 678–79 (1st Cir. 1967) ("When the uncopyrightable subject matter is very narrow, so that the topic necessarily requires, . . . if not only one form of expression, at best only a limited number, to permit copyrighting would mean that a party or parties, by copyrighting a mere handful of forms, could exhaust all future use of the substance."). Even if there are a myriad of ways to express the idea of a particular function or

“some imaginable, although manifestly less useable method of arranging business telephone listings” because the pertinent inquiry was whether BellSouth demonstrated originality in its arrangement.⁹² It had not because the arrangement was typical, following widely used industry standards.⁹³ In essence, although the contents of the yellow pages vary from community to community, the basic arrangement stays the same. My familiarity with using the yellow pages in Atlanta will serve me well when I use the yellow pages in Chicago.

The court also concluded that BellSouth’s heading structure did not merit protection because many of the selected headings, like “Attorneys” and “Banks,” were obvious.⁹⁴ In addition, protection could not be claimed in ideas like dividing churches by denomination or attorneys by area of specialty, and many of the headings resulted from standard industry practices including recommendations of the National Yellow Pages Sales Association.⁹⁵ Furthermore, the court noted that subscribers select the heading under which their information appears from several alternatives, so much of BellSouth’s heading structure was not original because it owed its origin to others.⁹⁶ Accordingly, the high degree of similarity between BellSouth’s and the defendant’s directories was due to the use of common facts, common unprotected arrangements, and the similar coordination of the directories into alphabetized listings under practical and inevitable unprotected classifications.⁹⁷ The court concluded that Donnelly “did not . . . appropriate *whatever original elements* might arguably inhere in the” BellSouth directory.⁹⁸ The court accepted that the directory as a whole might be copyrightable, but it appears that this protection extended only to prevent wholesale reproduction.⁹⁹

concept, expression merges with the underlying function, concept, or idea if efficiency concerns narrow the range of choices to but a few workable options. *See* Computer Assocs. Int’l, Inc. v. Altai, Inc., 982 F.2d 693, 708 (2d Cir. 1992).

⁹² *BellSouth*, 999 F.2d at 1442–43.

⁹³ *Id.*; *see also* Matthew Bender & Co. v. West Publ’g, 158 F.3d 674, 682 (2d Cir. 1998) (noting no creativity demonstrated when industry standard strongly influences categories).

⁹⁴ *BellSouth*, 999 F.2d at 1444.

⁹⁵ *Id.*

⁹⁶ *Id.* at 1442.

⁹⁷ *Id.* at 1442, 1444–45; Durham, *supra* note 9, at 813.

⁹⁸ *BellSouth*, 999 F.2d at 1445 (emphasis added). Accordingly, the Eleventh Circuit reversed the trial court’s grant of summary judgment for BellSouth and entered judgment for Donnelly. *Id.* at 1446.

⁹⁹ *Id.* at 1438; *see* Transwestern Publ’g Co. v. Multimedia Mkts. Assocs., Inc., 133 F.3d 773, 776–77 (10th Cir. 1998) (upholding judgment as a matter of law for defendant alleged to have infringed plaintiff’s telephone directory containing both white and yellow pages); Skinder-Strauss Assocs. v. Mass. Continuing Legal Educ., Inc., 914 F. Supp. 665, 673–77 (D. Mass. 1995) (constituent elements of plaintiff’s legal directory did not warrant protection because of the blank form doctrine, merger, and common property such as lists of judges and lawyers).

The Eleventh Circuit's rigorous application of *Feist* to a directory also is seen in *Warren Publishing, Inc. v. Microdos Data Corp.*¹⁰⁰ Sections of the massive *Television & Cable Factbook*, in particular Warren's principal and lead community system, were allegedly infringed by Microdos Data's *Cable Access* software package.¹⁰¹ The lower court granted summary judgment for Warren, ruling that its principal community system was copyrightable.¹⁰² The Eleventh Circuit, however, vacated and remanded, disagreeing on copyrightability while elaborating on what does not satisfy the originality standard.¹⁰³

The defendant did not contest that plaintiff's *Factbook*, considered as a whole, is entitled to copyright protection as a compilation.¹⁰⁴ Instead, it challenged the trial court's finding that Warren's system for selecting principal communities was protectable.¹⁰⁵ The directory of cable systems section contained a huge amount of information including the name, address, and telephone number of each cable system operator, the number of subscribers, the channels offered, the price of service, and the type of equipment.¹⁰⁶ These entries were arranged by state in alphabetical order, and within each state all the communities receiving cable service were listed alphabetically. However, the factual information for each system was not printed under the name of every community served by that cable operator because many communities were part of multi-community systems, and repeating all of the data under every community would have been duplicative and added to the bulk of the publication. Instead, one community was determined to be the lead or principal community served by a particular cable company, and all of the data about that cable system was listed under that community. There were cross-references to that principal community under the entries for the other cities and towns served by that cable operator.¹⁰⁷ The district court said that this system for the selection of communities was original in the industry and a copyrightable part of the compilation's format: "[T]he selection of those communities was

¹⁰⁰ 115 F.3d 1509 (11th Cir. 1997); see also JOYCE ET AL., *supra* note 6, at 243; Durham, *supra* note 9, at 815–16.

¹⁰¹ *Warren Publ'g*, 115 F.3d at 1511–12. The sections, 'Directory of Cable Systems' and 'Group Ownership of Cable Systems in the United States,' comprised 1,340 pages of data on 8,413 cable systems in the nation. *Id.*

¹⁰² *Id.*

¹⁰³ *Id.*

¹⁰⁴ *Id.* at 1516.

¹⁰⁵ *Id.* at 1516 n.18.

¹⁰⁶ *Id.* at 1512.

¹⁰⁷ *Id.* The court used the Georgia section of the book as an example. In that section, Atlanta was designated as a principal community for a particular operator, and then other cities in north central Georgia served by that operator, such as Alpharetta, Avondale Estates, Clarkston and so on, were cross referenced. *Id.* at 1512 n.3.

creative and protectable because Warren uses a unique system in selecting the communities that will be represented in the Factbook.’”¹⁰⁸

The Eleventh Circuit held that it was error to conclude that the selection system was copyrightable so it did not matter whether the defendant used it.¹⁰⁹ The court relied on section 102(b) of the Copyright Act, which excludes protection for ideas, procedures, processes, and systems regardless of the way they are described, explained, illustrated, or embodied in a work, and stated that “[i]f Warren actually does employ a system to select the communities to be represented in the book, then section 102(b) . . . bars the protection of such a system.”¹¹⁰

The court did not, however, stop there. It went on to say that *even if* Warren’s selection of communities could not be called a system, the company’s decisions about which communities to include still would not be a copyrightable selection. There was nothing showing that Warren exercised any creativity or judgment in determining which cable systems to include.¹¹¹ Instead, Warren

included the entire relevant universe known to it. The only decision that it made was that it would not list separately information for each community that was part of a multi-community cable system; in other words, it decided to make the Factbook commercially useful. Therefore, it cannot prevail in its claim that it “selected” which communities to include in the Factbook.¹¹²

The court also explained that the idea of organizing by principal community yielded but a few ways of expressing the data and concluded that the organization of the cable system data merged with the underlying idea of cross-referencing. According to the court, the “people for whom [the directory is] produced are not interested” in alternate methods of presentation.¹¹³ Adding insult to injury, the court also stated that even if the *selection* of the principal communities was creative and thus copyrightable, Warren’s claim for protection still failed because it did not make the actual selections. The record showed that the cable operators

¹⁰⁸ *Id.* at 1516 (quoting district court ruling).

¹⁰⁹ *Id.* at 1517. The trial court found a greater than 90% correlation between the principal communities in the Illinois section of Warren’s book and the Illinois section of defendant’s cable access software. According to the trial court, this evidenced substantial similarity of protected expression. *Id.* at 1516 n.20.

¹¹⁰ *Id.* at 1517 (citing and quoting 17 U.S.C. § 102(b) (2000)).

¹¹¹ *Id.* at 1518 (citing, discussing, and quoting *Key Publ’ns, Inc. v. Chinatown Today Publ’g Enters. Inc.*, 945 F.2d 509, 513 (2d Cir. 1991)).

¹¹² *Id.* (emphasis added); *see also* *Silverstein v. Penguin Putnam, Inc.*, 368 F.3d 77, 86 (2d Cir. 2004) (remanding so the trial court could decide whether compilation of all the uncollected poems of the late Dorothy Parker was sufficiently creative).

¹¹³ *Warren Publ’g*, 115 F.3d at 1518–19, 1519 n.27.

determined, in the case of a multi-community system, the city or town under which the factual data for the entire system was to be listed.¹¹⁴

Warren developed an efficient method for gathering and organizing information, but that method could not be protected for several reasons:¹¹⁵ the system was arguably unprotectable under section 102(b);¹¹⁶ even if it was not a system there was insufficient evidence of creativity in selection because all communities with cable systems were listed;¹¹⁷ the information merged with the idea of cross-referencing,¹¹⁸ and, it was the cable operators themselves who selected their principal community.¹¹⁹ As in *BellSouth*, it meant little to say that Warren's directory was a copyrightable compilation. It would have been difficult to find infringement absent wholesale, verbatim reproduction of almost the entire work because there was no creative selection; the organizational system was unprotectable as was the idea of cross-referencing to a principal community, and what judgment might have been involved in picking a principal community was not exercised by Warren. It is as if this directory was doomed from the start.¹²⁰

In summary, most directories will be copyrightable as compilations when considered as a whole. However, due to *Feist's* principles, this copyright protection will be very thin, only protecting the compiler against wholesale reproduction. It is a "so what" copyright.

B. CATALOGUE NUMBERS FOR PARTS

There was copyright litigation over catalogue numbers and numbering systems prior to *Feist*, and these disputes have continued. The typical scenario involves a manufacturer or distributor of replacement parts for consumer products copying the original manufacturer's parts numbers, its numbering system, or both so it can compete effectively against the original manufacturer in the market for replacement parts. The original manufacturer does not like this competition, so

¹¹⁴ *Id.* at 1519–20. The court noted similarities to how BellSouth relied on its subscribers in setting up the yellow pages.

¹¹⁵ *Id.* Three members of the court joined in a vigorous dissent, arguing that Warren's compilation of data on cable television, in the form of data reporting units with each unit named for a principal community, was original and creative. *Id.* at 1521–31 (Godbold, J., dissenting); see Durham, *supra* note 9, at 816–17.

¹¹⁶ See *supra* note 110 and accompanying text.

¹¹⁷ See *supra* notes 111–12 and accompanying text.

¹¹⁸ See *supra* note 113 and accompanying text.

¹¹⁹ See *supra* note 114 and accompanying text.

¹²⁰ *Cf.* Durham, *supra* note 9, at 817 (explaining that *Warren* is a difficult case because there is a strong argument that creative choices were made, and saying that perhaps the result is best understood as turning on the fact that the organizing principle for the directory was an unprotectable idea).

it sues, alleging that the replacement parts maker has infringed the copyright on its numbers and numbering system. These claims have not fared well.¹²¹

Several years before *Feist*, the Eighth Circuit held in *Toro Co. v. R & R Products Co.* that Toro's parts numbering system for its lawn care products was not copyrightable because it was arbitrary and random.¹²² There was no doubt that defendant R & R, a maker of replacement parts for several brands of lawn care equipment, was using Toro's five or six digit numbers in its parts catalog. It simply preceded them with the letter R.¹²³ The trial court ruled for R & R because it found that Toro's numbers were unprotectable under section 102(b) as a system.¹²⁴ The Eighth Circuit disagreed, saying that although the general idea of using numbers to designate replacement parts could not be protected under section 102(b), there were many different ways to express numbering systems. It also said that the merger doctrine did not preclude protection.¹²⁵ Still, Toro's numbering system did not meet the low originality threshold in large part because of testimony that "once a part is created 'an arbitrary number is assigned' to the part to identify it."¹²⁶ The court stated:

There was no evidence that a particular series or configuration of numbers denoted a certain type or category of parts or that the numbers used encoded any kind of information at all. In short, numbers were assigned to a part without rhyme or reason. This record establishes that the appellant's parts numbering "system" falls short of even the low threshold of originality. The random and arbitrary use of numbers in the public domain does not evince enough originality to distinguish authorship. The expression itself is nothing more than the public domain numbers. There is no variation, other than the trivial hyphen, to establish authorship. Also, it is clear that no effort or judgment went into the selection or composition of the numbers, which distinguishes this case from the telephone directory cases. We are left, then, with the accidental

¹²¹ See JOYCE ET AL., *supra* note 6, at 83 ("Decisions about rights in catalogue numbers for replacement parts demonstrate the tendency of courts to discount and authorship showing minimal creativity.").

¹²² 787 F.2d 1208, 1213 (8th Cir. 1986). See generally VerSteege, *supra* note 11, at 867–73 (discussing the *Toro* decision and possible arguments for upholding copyright on the parts numbers).

¹²³ *Toro*, 787 F.2d at 1210. R & R made and sold only those replacement parts that were in high demand because they wear out. Original manufacturers, like Toro, have to offer a full line of parts, which results in overhead costs that are reflected in higher prices—R & R's prices were generally 10% to 25% below Toro's. *Id.*

¹²⁴ *Id.* at 1211.

¹²⁵ *Id.* at 1212–13.

¹²⁶ *Id.* (quoting from the testimony of Toro's vice president for distribution).

marriage of a part and a number. We do not believe that such a marriage produces an original work of authorship.¹²⁷

This result must have been a surprise to Toro because only a year earlier the Eighth Circuit held in *Hutchinson Telephone Co. v. Fronteer Directory Co.* that a telephone company's white pages directory was original and copyrightable because the "author had 'solicited, gathered, filed, sorted, and maintained the information used in the directory,' " and "the directory was 'derived from information compiled and generated' by the author's efforts."¹²⁸ Toro's admission that the numbers were assigned arbitrarily doomed its infringement claim. Moreover, the Eighth Circuit did not say that numbering systems were per se uncopyrightable. To the contrary, it stated that "[a] system that uses symbols in some sort of meaningful pattern, something by which one could distinguish effort or content, would be an original work."¹²⁹

The Eighth Circuit's statements about the potential copyrightability of numbering systems were made five years before the Supreme Court announced its decision in *Feist*. In addition, the court ignored the prohibition on extending copyright protection to systems in section 102(b). Based on the Third Circuit's post-*Feist* decision in *Southco, Inc. v. Kanebridge Corp. (Southco III)*¹³⁰ and the Sixth Circuit's decision in *ATC Distribution Group v. Whatever It Takes Transmissions & Parts, Inc.*,¹³¹ the Eighth Circuit's statements were wrong.¹³²

Southco manufactured a variety of screw fasteners used in assembling the panels of items like computers and telecommunications equipment. The fasteners came in different thread sizes, finishes, diameters, lengths, and compositions.¹³³ In order to help employees and costumers identify and distinguish among these fasteners, Southco developed a numbering system to serve as a shorthand

¹²⁷ *Id.* at 1213.

¹²⁸ 770 F.2d 128, 132 (8th Cir. 1985) (citations omitted), *cited in Toro*, 787 F.2d at 1213. The "sweat of the brow" basis for protection was alive and well in the Seventh, Eighth and Tenth Circuits prior to *Feist*. JOYCE ET AL., *supra* note 6, at 241–42.

¹²⁹ *Toro*, 787 F.2d at 1213.

¹³⁰ 390 F.3d 276 (3d Cir. 2004). In the *Southco* litigation, the trial court initially granted a preliminary injunction against a competitor's use of Southco's parts numbers to identify and distinguish types of fasteners, but the Court of Appeals reversed and remanded. *Southco, Inc. v. Kanebridge Corp. (Southco I)*, 258 F.3d 148, 149 (3d Cir. 2001). On remand, the trial court granted summary judgment for the competitor, Southco appealed, and the appeals court reversed, and a rehearing en banc was granted. *Southco, Inc. v. Kanebridge Corp. (Southco II)*, 324 F.3d 190, 197 (3d Cir. 2003). The full Court of Appeals then affirmed the summary judgment for the competitor. *Southco III*, 390 F.3d 287 (3d Cir. 2004).

¹³¹ 402 F.3d 700 (6th Cir. 2005).

¹³² See CRAIG JOYCE, MARSHALL LEAFFER, PETER JASZI & TYLER OCHOA, COPYRIGHT LAW 98 (6th ed. 2003) ("Is this a no-win situation for part numbers?").

¹³³ *Southco III*, 390 F.3d at 278.

description of the relevant characteristics of each fastener.¹³⁴ The numbers were not selected and assigned arbitrarily as in *Toro*. Rather, in the words of *Toro*, they were used in a “meaningful pattern, . . . by which one could distinguish effort or content.”¹³⁵ Each fastener was identified by a unique nine-digit number, and each digit of that number described a specific physical aspect of the fastener,¹³⁶ and these numbers were listed in Southco’s handbooks.¹³⁷ Kanebridge, a distributor of fasteners manufactured by one of Southco’s competitors, used the Southco system in comparison charts that made clear to customers that their fasteners were interchangeable with Southco’s and that Kanebridge’s products were less expensive.¹³⁸

Southco did not claim protection for its system.¹³⁹ Instead, to no avail, it sought protection for the numbers themselves.¹⁴⁰ The Third Circuit twice concluded that the parts numbers were not copyrightable even though they were generated by a thoughtfully created system that had become the industry standard. The numbers still fell short of the minimal level of creativity required for protection.¹⁴¹ Each number was “rigidly dictated by the rules of the Southco system” so there was no creative thought in their assignment.¹⁴² In essence, they were “mechanically produced by the inflexible rules of the Southco system.”¹⁴³

In addition, the court also noted that the Register of Copyrights had routinely determined that parts numbers were not copyrightable subject matter because they were analogous to short phrases and titles of works, both of which had been denied registration by the Copyright Office since 1899. The government argued in support of the Register’s position in an amicus brief,¹⁴⁴ and the court concluded that the longstanding practice of denying protection to short phrases was entitled to deference and that it logically extended to parts numbers.¹⁴⁵

Southco’s argument for protection was based on the suggestion in *Toro* that numbering systems that used symbols in a meaningful pattern instead of at

¹³⁴ *Id.*

¹³⁵ *Toro*, 787 F.2d at 1213.

¹³⁶ For example, in part number 47-10-202-10, each group of numbers represented a functional characteristic of the product. *Southco I*, 258 F.3d at 149–50.

¹³⁷ *Id.*

¹³⁸ *Id.* at 149–50; see also *Southco III*, 390 F.3d at 279; JOYCE ET AL., *supra* note 6, at 83.

¹³⁹ *Southco I*, 258 F.3d at 152.

¹⁴⁰ *Southco III*, 390 F.3d at 282.

¹⁴¹ *Southco I*, 258 F.3d at 150, 153; see also *Southco III*, 390 F.3d at 283.

¹⁴² *Southco III*, 390 F.3d at 282.

¹⁴³ *Id.* at 285. The court noted that if any creativity crept into the numbering process, then the system would not work. *Id.* at 282.

¹⁴⁴ *Id.* at 285–87.

¹⁴⁵ *Id.* at 286–87.

random might be copyrightable.¹⁴⁶ The Third Circuit rejected this reliance on *Toro* because it invoked the discredited “sweat of the brow” theory and *Toro* stated only that a system might be protectable, while the dispute in *Southco* was over the originality of the numbers, not the system.¹⁴⁷ Moreover, the court’s en banc opinion quoted a leading treatise’s statement that “copyright protection should not be extended to part numbers that represent ‘an inevitable sequence dictated by the logic of the parts system.’”¹⁴⁸

The copyrightability of parts numbers took another, perhaps fatal, blow in *ATC Distribution*, in which the Sixth Circuit ruled that the organization and numbering system in a transmission parts catalogue was unprotectable.¹⁴⁹ ATC’s catalogue sorted transmission parts into three basic categories: brand, type of transmission, and type of part.¹⁵⁰ There were subcategories within each of these. For instance, in the brand category transmissions were listed by manufacturer, while under the type of parts section it was evident that ATC made certain decisions, like whether to list rings generally or to divide the category between sealing rings and O-rings. Parts within the subcategories were numbered sequentially, but the ordering of the subcategories appeared to be random, and the fact that O-rings were numbered in the 300s and that two parts within the grouping were numbered 311 and 312 instead of 341 and 342 seemed to be accidental.¹⁵¹ ATC argued that its catalogue was a classification scheme or taxonomy that evidenced creativity so the individual parts numbers were protected as copyrightable expression in the overall taxonomy.¹⁵² It also said that the catalogue as a whole was a copyrightable compilation.¹⁵³

The Sixth Circuit acknowledged that classification schemes may be creative enough to be copyrightable but stated that all of the creative aspects of ATC’s classification scheme were unprotectable ideas. ATC could not protect its

¹⁴⁶ *Southco I*, 258 F.3d at 153.

¹⁴⁷ *Id.* at 153–54.

¹⁴⁸ *Southco III*, 390 F.3d at 282–83 (citing and quoting WILLIAM F. PATRY, COPYRIGHT LAW AND PRACTICE 46 (2d ed. 2004)).

¹⁴⁹ *ATC Distribution Group, Inc. v. Whatever It Takes Transmissions & Parts, Inc.*, 402 F.3d 700 (6th Cir. 2005). The underlying dispute was typical; a competitor based its catalogue on plaintiff’s widely distributed catalogue, and plaintiff sued for infringement. The competitor admitted copying the numbering system but asserted the affirmative defense that the work is not eligible for protection, and the court agreed, finding that the parts numbers lacked originality. *Id.* at 703–05. The court also held that plaintiff’s catalogue, illustrations, and manual lacked originality, and the Court of Appeals agreed that none of the works copied by the defendant were protectable. *Id.* at 705.

¹⁵⁰ *Id.* at 705.

¹⁵¹ *Id.* at 706.

¹⁵² *Id.* at 705–06.

¹⁵³ *Id.* at 706.

prediction of how many rings might be developed or its judgment that a new part belonged in a particular subcategory.¹⁵⁴ Also, copyright protection for ATC's expression of its ideas about parts classifications was barred, in part, by the merger doctrine. The court stated:

For example, the only way to express the prediction that a maximum of four additional types of sealing rings might be developed is to leave four numbers unallocated, and the only way to express the idea that a novel part should be placed with the sealing rings rather than with the gaskets is to place that part with the sealing rings.¹⁵⁵

Even assuming that some strings of numbers used to designate items could be sufficiently creative to satisfy the originality standard, the court said that ATC's allocation of numbers to each subcategory and to each part was not protectable because it was essentially a random process.¹⁵⁶ The court elaborated by stating:

Were it not for a series of random orderings within each category field, a given part could be 47165 or 89386. As such, the particular numbers allocated to each part do not express any of the creative ideas that went into the classification scheme in any way that could be considered eligible for copyright protection.¹⁵⁷

The court also held that ATC's catalogue was not protectable as a compilation because the only difference between it and an earlier catalogue was the choice of headings and arrangement of parts into categories; these choices were insufficiently creative to justify protection.¹⁵⁸ Even though ATC might have arranged the information in other ways that were less useful, this fact did not demonstrate creativity.¹⁵⁹

¹⁵⁴ *Id.* at 707. The trial court said that permitting copyright protection for ATC's choice of where in the catalogue to locate a new part would be like granting protection for a grocer's choice about whether to display a new heirloom tomato with gourmet produce, tomatoes generally, or locally grown produce. *See id.* at 707 n.4.

¹⁵⁵ *Id.* at 707.

¹⁵⁶ *Id.* at 709.

¹⁵⁷ *Id.* The court added that there were sound reasons, other than originality, for denying protection to short "works" like parts numbers and, like the Third Circuit in *Southco*, it noted the Copyright Office's policy against registering short phrases. *Id.* at 709–10.

¹⁵⁸ *Id.* at 711–12.

¹⁵⁹ *Id.* The court also concluded that the plaintiff's illustrations of parts were intended to be as accurate as possible and fell short of the "substantial variation" required for protection; plus, the arrangement of the drawings, depicting transmission assembly or disassembly, were not original. *Id.* at 712.

It is difficult to think of any set of parts numbers or parts numbering system that might be copyrightable after *Toro*, *Southco*, and *ATC*. Numbers that are chosen randomly or arbitrarily are not protectable because they lack creativity, and any system that assigns parts numbers in some logical pattern is not protectable because of the explicit limitations in section 102(b). The creativity needed to devise that system does not save it. The merger doctrine also restricts protection for parts numbers, and the Copyright Office treats them like unprotectable short phrases and titles. These generalizations about parts numbers and numbering systems should not, however, be interpreted to mean that catalogues cannot be protected by copyright. To the contrary, many aspects of a catalogue might be copyrightable, including illustrations, descriptions of products, and how those illustrations and descriptions are presented.¹⁶⁰

C. TASTE, OPINION, PREDICTIONS AND SOFT FACTS

Several decisions involving compilations of so-called “soft facts” stand in contrast to the parts numbering cases. There is a substantial market for collectables like coins, stamps, dolls, and memorabilia as well as pre-owned goods like houses, cars, boats, and motorcycles. Buyers and sellers of these goods want to know about values, prices, and demand so they can make informed purchases and sales, and it is not surprising that there are entities that offer compendiums and databases with this information.¹⁶¹ For instance, you can turn to the *Kelley Blue Book* online or in hard copy to find the retail value of particular makes and models of used cars and trucks.¹⁶² Are these listings of products with their costs and prices copyrightable, or are they unprotectable like parts numbers in catalogues? Several decisions have held that price guides like the *Kelley Blue Book* can meet *Feist*'s originality standard when the act of setting the prices requires the exercise of judgment by the author/compiler/valuator.¹⁶³ The *Kelley Blue Book* value of \$14,000 for a 2004 Ford Ranger pickup truck with a V6 engine, relatively low

¹⁶⁰ See, e.g., *Decker, Inc. v. G & N Equip. Co.*, 438 F. Supp. 2d 734 (E.D. Mich. 2006) (involving plaintiff's business catalogues, which used color drawings, text describing the products, and photographs—there was not a numbering system at issue). The court distinguished *ATC*, holding that plaintiff's catalogue satisfied the originality requirement, and denied defendants' motion for summary judgment on the ground that the trier of fact could find substantial similarity of protected expression. *Id.* at 742–43.

¹⁶¹ See SHUBHA GHOSH, RICHARD GRUNER, JAY KESAN & ROBERT REIS, *INTELLECTUAL PROPERTY* 98 (2007).

¹⁶² Official Kelley Blue Book Site, <http://www.kbb.com> (last visited Oct. 7, 2007).

¹⁶³ See, e.g., *CDN, Inc. v. Kapes*, 197 F.3d 1256 (9th Cir. 1999); *CCC Info. Servs. v. Maclean Hunter Market Reports, Inc.*, 44 F.3d 61 (2d Cir. 1994).

mileage, and in good condition arguably is not the same kind of fact as my office telephone number or the list price of a 2007 Ford Ranger at your local dealer.¹⁶⁴

Feist states that in determining whether a compilation satisfies the originality requirement the author's "selection and arrangement of facts cannot be so mechanical or routine as to require no creativity whatsoever."¹⁶⁵ In contrast, selections reflecting the compiler's opinion or taste can be protected because they are not inevitable or mechanical.¹⁶⁶ The Second Circuit, having rejected the sweat of the brow rationale for protection prior to *Feist*, has been applying this principle consistently in a variety of contexts.¹⁶⁷ For instance, in *Eckes v. Card Prices Update*, the court held that a selection of 5,000 premium baseball cards out of a universe of 18,000 was entitled to copyright protection.¹⁶⁸ The exercise of judgment in making these selections evidenced the requisite creativity.¹⁶⁹ On the other hand, in *Financial Information, Inc. v. Moody's Investor Service, Inc.*, the court held that the listing of five items of information concerning municipal bond calls was not sufficiently creative as a selection to warrant protection.¹⁷⁰ The five items had all appeared in "tombstone" advertisements and only "minor additional research" was needed to complete the listings.¹⁷¹ In other words, the five categories were standard in the industry, and including them on the bond calls did not evidence any judgment on the part of the author. There was not even a modest degree of creativity in selecting those categories.

*Kregos v. Associated Press*¹⁷² was rendered shortly after the Supreme Court announced its ruling in *Feist*. At issue was a form that Kregos distributed to newspapers displaying nine categories of baseball pitching statistics concerning the past performances of the opposing pitchers scheduled to start each day's baseball games.¹⁷³ Kregos compiled the form to help readers predict the outcome of baseball games. He did not weight the several statistics in his categories but left the actual prediction, based on those specific statistics, to his baseball fan

¹⁶⁴ See generally Durham, *supra* note 9, at 793–94, 825–37.

¹⁶⁵ *Feist Publ'ns, Inc. v. Chinatown Today Publ'g Enters. Inc.*, 499 U.S. 340, 362 (1991).

¹⁶⁶ Durham, *supra* note 9, at 825.

¹⁶⁷ Abrams, *supra* note 12, at 9.

¹⁶⁸ 736 F.2d 859, 863 (2d Cir. 1984); see also *Worth v. Selchow & Righter, Co.*, 827 F.2d 569 (9th Cir. 1987) (holding copyrightable *Worth's* two volume trivia encyclopedia with 12,000 items arranged alphabetically by subject matter headings, but holding that the works were not infringed by defendant's *Trivial Pursuit*, even though they were the source of many of the facts in the game, because the arrangements were not substantially similar); Durham, *supra* note 9, at 825–28.

¹⁶⁹ *Eckes*, 736 F.2d at 863.

¹⁷⁰ 808 F.2d 204, 207–08 (2d Cir. 1986).

¹⁷¹ *Id.* at 206, 208.

¹⁷² 937 F.2d 700 (2d Cir. 1991); see also Abrams, *supra* note 12, at 21–24; Durham, *supra* note 9, at 831–35.

¹⁷³ *Kregos*, 937 F.2d at 702.

readers.¹⁷⁴ The Associated Press (AP) published a virtually identical pitching form, and Kregos sued for infringement. He asserted no rights in each day's data and limited his claim to the appropriated form.¹⁷⁵ The trial court ruled that the form was not copyrightable,¹⁷⁶ but the Second Circuit disagreed.¹⁷⁷ It noted that the plaintiff selected nine items of information concerning a pitcher's performance from a

universe of known facts only available from inspection of box scores of prior games [that] is considerably greater than nine . . . Kregos could have selected past performances from any number of recent starts, instead of using the three most recent starts. And he could have chosen to include strikeouts, walks, balks, or hit batters. . . . In short, there are at least scores of available statistics about pitching performance available to be calculated from the underlying data and therefore thousands of combinations of data that a selector can choose to include in a pitching form.¹⁷⁸

The court then said that whether the selections showed sufficient creativity was a close question.¹⁷⁹ Kregos had done more than select the five standard facts about bond calls that were routinely grouped together in tombstone ads,¹⁸⁰ and there were no prior pitching forms identical to his nor one from which his varied only slightly.¹⁸¹ His copyright could not "be rejected as a matter of law for lack of the requisite originality and creativity."¹⁸² The selected categories reflected Kregos' opinion about the most important statistics for predicting winners in baseball while the actual prediction was left to readers. He was not monopolizing any ideas.¹⁸³

¹⁷⁴ Durham, *supra* note 9, at 832–33.

¹⁷⁵ Kregos, 937 F.2d at 702.

¹⁷⁶ *Id.* at 702–03, 702 n.1. The lower court said that protection was precluded because the form was not original in its selection of statistics—the limited variations in the selection of statistics given the space in newspapers resulted in merger of the form's idea with expression—and because of the blank form doctrine. *Id.* at 703.

¹⁷⁷ *Id.* at 711.

¹⁷⁸ *Id.* at 704.

¹⁷⁹ *Id.*

¹⁸⁰ *Id.*

¹⁸¹ *Id.* at 705.

¹⁸² *Id.*; see also *Bucklew v. Hawkins, Ash, Baptie & Co.*, 329 F.3d 923, 928–31 (7th Cir. 2003) (plaintiff's copyright claim to certain tables was upheld as enforceable because the tables reflected sufficient originality in formatting choices that were not unavoidable and because defendant closely copied one of the tables).

¹⁸³ Kregos, 937 F.2d at 707. Judge Sweet argued in a partial dissent that the result had the effect of giving Kregos copyright in an idea, in particular his system for predicting the outcome of games.

A leading post-*Feist* decision for the proposition that the originality standard is satisfied where the author/compiler exercises subjective and evaluative judgment to create soft facts is *CCC Information Services, Inc. v. Maclean Hunter Market Reports, Inc.*¹⁸⁴ Maclean Hunter published the *Red Book*, which set forth the editors' projections of the values of used cars differentiated by make, model number, body style, engine type, and region, with adjustments based on mileage and options.¹⁸⁵ The court noted that these values represented the editors' predictions, based on a variety of sources and their professional judgment, of expected values for the various makes and models.¹⁸⁶ CCC also provided its customers with information on used car values, and it utilized Maclean's *Red Book* by loading substantial portions of it onto its computer network and republishing the information in various forms.¹⁸⁷ CCC sought a declaratory judgment that it was not infringing Maclean's copyright by taking and republishing material.¹⁸⁸ Maclean responded by alleging infringement, and there were cross motions for summary judgment.¹⁸⁹

The trial court ruled for CCC, finding that there was no originality or creativity in the selection, coordination, or arrangement of data, and that the valuations were unprotectable facts or interpretations of facts.¹⁹⁰ The Second Circuit disagreed. After discussing *Feist* and many of the circuit's decisions involving compilations, it stated that the district court misapplied precedent and misinterpreted *Feist* as erecting a high barrier of originality.¹⁹¹ It said that the *Red Book* values were not discovered nor were they mechanical derivations of prices and data. Rather, they were based on professional judgment and expertise as well as on multiple data sources.¹⁹² It made no difference that they were expressed in numerical form.¹⁹³ The court also held that Maclean's selection and arrangement displayed ample

Id. at 711–14 (Sweet, J., concurring in part and dissenting in part).

¹⁸⁴ 44 F.3d 61 (2d Cir. 1994). *See also* Durham, *supra* note 9, at 827–29 (discussing case in detail).

¹⁸⁵ *CCC Info.*, 44 F.3d at 63.

¹⁸⁶ The book is published eight times each year; the projections are for the next six weeks for “average” cars up to seven years old, and the nation is divided into three regions plus Wisconsin. *CCC Info.*, 44 F.3d at 63. The court stated that the valuation figures were not historical market prices, quotations, or averages, and they were not derived by mathematical formulas from statistics. *Id.*

¹⁸⁷ *Id.* at 64.

¹⁸⁸ *Id.*

¹⁸⁹ *Id.* There was evidence that *Red Book* customers had canceled their subscriptions and purchased CCC subscriptions. *Id.*

¹⁹⁰ *Id.* The trial court also found that there was merger of idea and expression and that the *Red Book* was in the public domain because it had been incorporated in government regulations. *Id.*

¹⁹¹ *Id.* at 66.

¹⁹² *Id.* at 67.

¹⁹³ *Id.* at 67 n.6 (citing 17 U.S.C. §§ 101 & 102(a) (2000) (the definition of literary works includes works expressed in words, numbers, or other verbal or numerical symbols)).

originality by dividing the national market for used cars into regions, adjusting values for mileage in 5,000 mile increments, using the concept of the “average” vehicle in each category, and selecting the number of years for which models would be included.¹⁹⁴

The Second Circuit acknowledged that CCC’s strongest argument was that it had taken nothing more than unprotected ideas due to application of the merger doctrine.¹⁹⁵ After an extended discussion of merger and its purpose as well as the rationale for copyright protection, the court explained that there is a “dichotomy between types of ideas,” in that the merger doctrine contemplates denying protection to “building block ideas explaining processes or discoveries,” while expressions of subjective opinion can be protected.¹⁹⁶ The court explained:

In cases of wholesale takings of compilations, a *selective* application of the merger doctrine, withholding its application as to soft ideas infused with taste and opinion, will carry out the statutory policy to protect innovative compilations without impairing the policy that requires public access to ideas of a more important and useful kind.¹⁹⁷

Since CCC took virtually the entire *Red Book* compendium and since the copied valuations were not building block ideas or facts but statements of opinion by the editors that explained nothing and described no method, process, or procedure, the Second Circuit directed entry of judgment in Maclean’s favor.¹⁹⁸ CCC remained free to place its own values on used cars by weighing the same data used by Maclean, but it could not make a wholesale copy of what was original to Maclean.¹⁹⁹

The Ninth Circuit applied the *Red Book* decision in *CDN, Inc. v. Kapes*.²⁰⁰ CDN published a weekly report of wholesale prices for collectible coins called the *Coin Dealer Newsletter*.²⁰¹ It included prices for virtually all collectible United States

¹⁹⁴ *Id.*

¹⁹⁵ *Id.* at 68.

¹⁹⁶ *Id.* at 72.

¹⁹⁷ *Id.* (emphasis in original).

¹⁹⁸ *Id.* at 74.

¹⁹⁹ *Id.* at 73–74; see also JOYCE ET AL., *supra* note 6, at 244; Abrams, *supra* note 12, at 30–31 (discussing Project Dev. Group v. O.H. Materials Corp., 766 F. Supp. 1348 (W.D. Pa. 1991) and noting that differences in judgment, errors, optimism and pessimism, and strategies have an effect on how things like prices, bids, and values are set and that all of this seems to militate against finding works unoriginal).

²⁰⁰ 197 F.3d 1256 (9th Cir. 1999). See Durham, *supra* note 9, at 829–31.

²⁰¹ *Kapes*, 197 F.3d at 1257.

coins.²⁰² Kenneth Kapes, a coin dealer, acknowledged using CDN's wholesale prices in setting up an internet website with retail prices for many coins.²⁰³ CDN sued Kapes for infringement, and Kapes responded by arguing that the prices themselves were unprotectable.²⁰⁴ The trial court held that the price lists were not like the phone number listings in *Feist*; they were not facts but rather the product of CDN's creativity and judgment.²⁰⁵ The Ninth Circuit agreed:

CDN's process to arrive at wholesale prices begins with examining the major coin publications to find relevant retail price information. CDN then reviews this data to retain only that information it considers to be the most accurate and important. Prices for each grade of coin are determined with attention to whether the coin is graded by a professional service (and which one). CDN also reviews the online networks for the bid and ask prices posted by dealers. It extrapolates from the reported prices to arrive at estimates for prices for unreported coin types and grades. CDN also considers the impact of public auctions and private sales, and analyzes the effect of the economy and foreign policies on the price of coins. . . . The prices CDN creates are compilations of data that represent its best estimate of the value of the coins.²⁰⁶

If CDN had simply reported the prices paid by dealers throughout the country, those prices would not have been copyrightable.²⁰⁷ But CDN did much more than that; the prices it listed were the company's best estimates of the fair value of coins.²⁰⁸ The court cited and discussed with approval the Second Circuit's decision in *Maclean Hunter*,²⁰⁹ and rejected the defendant's merger and estoppel arguments: "CDN does not, nor could it, claim protection for its idea of creating a wholesale price guide, but it can use the copyright laws to protect its idea of what those prices are."²¹⁰

It is always difficult to draw the line between unprotected facts and ideas and protected expression, and this line arguably becomes even more blurred when

²⁰² *Id.* at 1258.

²⁰³ *Id.* at 1257.

²⁰⁴ *Kapes*, 197 F.3d at 1258–59. CDN did not allege that Kapes had copied the entire lists. Rather, the issue was whether the prices themselves were sufficiently original as compilations. *Id.*

²⁰⁵ *Id.* at 1259–60.

²⁰⁶ *Id.* at 1260.

²⁰⁷ *Id.*

²⁰⁸ *Id.*

²⁰⁹ *CCC Info. Serv. Inc. v. Maclean Hunter Reports, Inc.*, 44 F.3d 61 (2d Cir. 1994).

²¹⁰ *Id.* at 1262.

courts extend protection to “soft facts” like Maclean Hunter’s used car values or CDN’s wholesale coin prices.²¹¹ Distinguishing what is a fact versus an opinion versus a question of taste is not always easy. Lurking in the background is the risk of resurrecting the sweat of the brow doctrine and extending protection to facts, contrary to the teachings of *Feist*. These risks, however, are minimized due to the merger doctrine,²¹² the rigorous standard for proving infringement of compilations that requires by virtually wholesale appropriations of protected expression, and sound application of the fair use defense.²¹³

D. CLASSIFICATIONS AND TAXONOMIES

Works like almanacs, diaries, journals, calendars, and catalogues often have categories for displaying and recording information. A compiler’s decisions about selecting categories, establishing classifications, organizing the categories, and choosing the information to include in the categories can evidence creativity. It is not surprising that classification schemes (taxonomies) can be copyrightable, assuming they are not routine, typical, standard, or run-of-the-mill ways of organizing the relevant information.

*Matthew Bender & Co. v. Kluwer Law Book Publishers*²¹⁴ is a pre-*Feist* decision involving Chapter 59, Illustrative Awards & Settlements, in Volume 6 of Bender’s nine volume *Damages in Tort Actions* and Kluwer’s single volume book, *What’s It Worth? A Guide to Personal Injury Awards and Settlements*.²¹⁵ There were many similarities in formats, with both works organizing selected cases into virtually identical subchapters according to the injured body part.²¹⁶ The subchapters were arranged alphabetically and divided identically as settlement or judgment, and as adequate, inadequate and excessive settlements or judgments.²¹⁷ Both works were set up by state in alphabetical order and by amount, from large to small, and both utilized six columns with almost identical headings.²¹⁸ However, the actual case descriptions were different.²¹⁹

²¹¹ See Durham, *supra* note 9, at 795, 838–42.

²¹² See *New York Mercantile Exch., Inc. v. IntercontinentalExchange, Inc.*, 497 F.3d 109, 118 (2d Cir. 2007) (whether “settlement prices” with regard to exchanges are creative works of authorship or factor is not dispositive because under the merger doctrine whatever creative expression is in the settlement prices merges with the underlying idea).

²¹³ See *infra* Parts IV.B. & IV.C. But see Burk, *supra* note 14 (strong criticism of the *CCC Information* and *Kapes* decisions).

²¹⁴ 672 F. Supp. 107 (S.D.N.Y. 1987).

²¹⁵ *Id.* at 108.

²¹⁶ *Id.*

²¹⁷ *Id.*

²¹⁸ *Id.*

²¹⁹ *Id.* at 108–09. It was conceded that Kluwer had not copied Bender’s case descriptions. *Id.*

Notwithstanding these similarities, Bender lost the case because its categories and their organization were unprotectable. The court stated that the idea of compiling settlement and award data for personal injury cases is not copyrightable, and that due to the merger and blank form doctrines, as well as the originality requirement, Bender's use of a practical chart with chapter and subchapter headings was not copyrightable.²²⁰ The court noted that there were a limited number of ways to organize the information in a useful manner and that the various components of Bender's chart were seen in other publications.²²¹ They were not original to Bender's editors. Terms like "amount" and "jurisdiction" and their synonyms could not be protected, and the modicum of creativity requirement was not satisfied.²²²

The categories which Bender employed in its charts are the only sensible ones which could have been used to compile the data contained in Damages. The use of nearly identical charts to compile data on future cases would not constitute a copyright infringement since the chart's components by themselves are not copyrightable in this case.²²³

The only suspect point in this pre-*Feist* decision is the court's citation to an earlier opinion in which the trial court said that compilations are copyrightable for two reasons: the labor expended in their preparation and the author's use of subjective judgment and selectivity.²²⁴ The labor or sweat of the brow rationale for protection was, of course, discredited in *Feist*.²²⁵ As for judgment and selectivity, there were only a few ways to organize personal injury awards and settlement data in a logical and effective manner, and the categories and subcategories used by the plaintiff were standard and obvious. What Bender did might have been doomed from the start because it was obvious or even inevitable.

*American Dental Ass'n v. Delta Dental Plans Ass'n (American Dental II)*²²⁶ is a post-*Feist* decision that considered whether a taxonomy was copyrightable. At issue was the ADA's *Code of Dental Procedures and Nomenclature* that classifies all dental procedures in groups, assigns numbers to each procedure, and gives short and

²²⁰ *Id.* at 109–12.

²²¹ *Id.* at 110–11.

²²² *Id.* at 110–12 (citing and discussing *Fin. Info., Inc. v. Moody's Investor Serv., Inc.*, 751 F.2d 501, 507 (2d Cir. 1984)).

²²³ *Id.* at 112.

²²⁴ *Dow Jones v. Bd. of Trade*, 546 F. Supp. 113, 115 (S.D.N.Y. 1982).

²²⁵ See *supra* note 28 and accompanying text.

²²⁶ 126 F.3d 977 (7th Cir. 1997); see also *Durham*, *supra* note 9, at 817–22 (discussing the case).

long descriptions of each procedure.²²⁷ Defendant Delta Dental published a work that included most of the numbering system and short descriptions from the ADA's *Code*.²²⁸ Delta Dental argued that the *Code* was not copyrightable, and the trial court agreed in a sweeping opinion that effectively held that a taxonomy that comprehensively catalogues a field of knowledge cannot be selective in scope or arrangement.²²⁹ The opinion also treated the *Code* like a useful article, said that it was intended as a means to an end, and concluded that if the functional components of the work were removed, the remaining creative component was negligible.²³⁰

The Seventh Circuit vacated and remanded. Judge Easterbrook, writing for a unanimous panel, pointed out that the breadth of the district court's reasoning had the effect of removing copyright protection from a wide variety of works routinely regarded as copyrightable, such as West's Key Numbering System, the *Kelley Bluebook*, commercial software, blueprints, and maps. He stated that taxonomies may be copyrightable because "[c]lassification is a creative endeavor. Butterflies may be grouped by their color, or the shape of their wings, or their feeding or breeding habits, or their habitats, or the attributes of their caterpillars, or the sequence of their DNA; each scheme of classification could be expressed in multiple ways."²³¹ The same was true for dental procedures, which could be classified in a variety of ways.²³² Moreover, the descriptions in the *Code* did not merge with the facts.²³³ The court concluded that all three elements of the *Code*—numbers, short descriptions, and long descriptions—were copyrightable subject matter: "Delta Dental Association could have written its own classification of dental procedures."²³⁴

The Seventh Circuit did not stop at this point. It explained that the *Code* was not a compilation under section 103 because it did not collect or compile bits and pieces of independently existing elements.²³⁵ This statement was unnecessary and arguably wrong by improperly narrowing what falls within the Copyright Act's definition of "compilation" as a work "formed by the collection and assembling

²²⁷ *American Dental II*, 126 F.3d at 977.

²²⁸ *Id.* at 977–78.

²²⁹ *Id.* at 978.

²³⁰ *Am. Dental Ass'n v. Delta Dental Plans Ass'n (American Dental I)*, No. 92C5909, 1996 U.S. Dist. LEXIS 5809, at *29–32 (N.D. Ill. Apr. 25, 1996); *see also* Durham, *supra* note 9, at 818–20 (discussing trial court's reasoning).

²³¹ *American Dental II*, 126 F.3d at 979. The district court had said that taxonomies are designed to be useful and if nothing remains after the usefulness is taken away, then the taxonomy is devoid of that modicum of creativity required for protection. *Id.* at 978.

²³² *Id.* at 979.

²³³ *Id.*

²³⁴ *Id.*

²³⁵ *Id.* at 980.

of preexisting 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.”²³⁶ For instance, the Second Circuit treated the person who gathered the uncollected poems of the late Dorothy Parker as a compiler and questioned whether his selection satisfied the creativity requirement.²³⁷ If a collection of poetry is a compilation, then so is the ADA’s *Code*. It is the collection and assembly of dental procedures. These procedures were placed in classification groups and assigned numbers. The descriptions were drafted by a committee after heated discussions.²³⁸ These descriptions could have been written in a variety of ways.²³⁹ Putting all of this together makes a compilation.

The Seventh Circuit also explained that the trial court had mistakenly applied the Copyright Act’s limitations on the scope of protection for useful articles and had improperly mixed two distinct issues: originality and functionality.²⁴⁰ The court reasoned that determining whether a literary work like the *Code* is original should be relatively easy and not complicated by questions concerning limitations the Copyright Act places on the protection of pictorial, graphic, and sculptural works.²⁴¹ Finally, the court concluded that copyright protection for the *Code* was not precluded by section 102(b) because it was not a system that monopolized a field of practice.²⁴² The ADA encouraged dentists, insurers, and others to use the *Code*, but Delta Dental was not simply using it. Rather, Delta Dental copied the *Code* itself and then made and distributed a derivative work based on the *Code*. That constituted infringement.²⁴³

The Seventh Circuit held that a classification system was a copyrightable compilation in *Assessment Technologies of Wisconsin, LLC v. WIREdata, Inc.*²⁴⁴ In this case, the plaintiff had developed a computer program called Market Drive. The program took real estate data, such as address, owner’s name, age of property,

²³⁶ See 17 U.S.C. § 101 (2000).

²³⁷ *Silverstein v. Penguin Putnam, Inc.*, 368 F.3d 77, 83 (2d Cir. 2004). Even though 121 of the 122 poems that Silverstein found in magazines and newspapers that had not been included in any collection of Parker’s poems were included in defendant’s Penguin book, the court vacated summary judgment for the compiler and remanded so the trial court could decide whether there was sufficient creativity exercised by the compiler. *Id.* at 78, 86.

²³⁸ *American Dental II*, 126 F.3d at 979.

²³⁹ *Id.*

²⁴⁰ *Id.* at 980.

²⁴¹ *Id.*

²⁴² *Id.* at 981.

²⁴³ *Id.*; see also *Bucklew v. Hawkins, Ash, Baptie & Co.*, 329 F.3d 923, 928–29 (7th Cir. 2003) (holding that plaintiff’s tables were copyrightable due to formatting choices that were not unavoidable, and that defendant copied plaintiff’s tables when alternative options were available to it).

²⁴⁴ 350 F.3d 640 (7th Cir. 2003).

assessed valuation, and number of rooms in the property, and automatically arranged the data into 456 fields grouped in thirty-four master categories such as “Income Valuations” and “Residential Buildings.”²⁴⁵ Municipal tax officials could use a number of queries to view this information.²⁴⁶ The court, through Judge Posner, held that the

modest [originality] requirement is satisfied by Market Drive because no other real estate assessment program arranges the data collected by the assessor in these 456 fields grouped into these 34 categories, and because this structure is not so obvious or inevitable as to lack the minimal originality required, [citing Key Publications] as it would if the compilation program simply listed data in alphabetical or numerical order. [citing *Feist*] The obvious orderings, the lexical and the numeric, have long been in the public domain, and what is in the public domain cannot be appropriated by claiming copyright.²⁴⁷

Notwithstanding the court’s conclusion that its program was copyrightable, the plaintiff lost because it tried to use its copyright improperly to block defendant Wiredata’s access to and use of uncopyrightable facts and data that had not been created or obtained by the plaintiff.²⁴⁸ The plaintiff’s copyrightable classification scheme for presenting the real estate data did not extend protection to the data itself.²⁴⁹

*BUC International Corp. v. International Yacht Council Ltd.*²⁵⁰ is a recent Eleventh Circuit decision upholding a jury verdict of copyright infringement on the equivalent of a multiple listings service for yachts. The plaintiff’s BUCNET listing service was a centralized directory of yacht listings that enabled yacht brokers to access industry information.²⁵¹ It utilized a standard form and format that brokers used to submit information about vessels.²⁵² The plaintiff selected and arranged the format’s section headings that appeared on the computer screen, and these headings included categories like accommodations and layout, overview, vessel walkthrough, galley/laundry, electronics and navigation, hull, construction, sails

²⁴⁵ *Id.* at 642–43.

²⁴⁶ *Id.* The information was gathered and typed into computers by local tax assessors. *Id.* at 642.

²⁴⁷ *Id.* at 643 (citations omitted).

²⁴⁸ *Id.* at 642. The court raised the issue of whether Assessment Technologies was guilty of copyright misuse. *Id.* at 647–48.

²⁴⁹ *Id.* at 645.

²⁵⁰ 489 F.3d 1129 (11th Cir. 2007).

²⁵¹ *Id.* at 1134.

²⁵² *Id.*

and rigging, and several other classifications.²⁵³ The defendants set up a competing computerized listing service that replicated 4,400 listings from BUCNET,²⁵⁴ and plaintiff sued for infringement. The case went to trial; the trial court denied defendants' motions for judgment as a matter of law, and the jury returned a verdict for BUC with an award of damages.²⁵⁵

On appeal the defendants argued that BUC's compilation lacked originality as a matter of law because (1) the brokers were the real authors of the selection and arrangement, (2) the merger doctrine precluded protection for the selection of section headings, and (3) the plaintiff's selection and arrangement lacked the requisite level of creativity.²⁵⁶ The Eleventh Circuit said that the first contention lacked merit because in only 2% of the plaintiff's 4,667 listings had the brokers modified the BUCNET format, and this did not render them authors of the compilation.²⁵⁷ In regard to merger, the court concluded that the defendants defined the idea too narrowly, that the general idea was how to present information about boats to brokers, and that there were many ways to select and organize all the information in a yacht listing.²⁵⁸ Defendants could use standard terms like "hull" and "galley," but not in the same manner as BUC.²⁵⁹ As for creativity, the court reviewed the testimony from the trial regarding how the categories were selected and structured and concluded that there was no error in the district court's denial of defendants' motions for judgment as a matter of law.²⁶⁰

The defendants also argued that they should be afforded a new trial because the jury was instructed that it could find infringement if there were "substantial similarities" between the original elements of BUC's compilation and the corresponding elements of defendants' compilation.²⁶¹ Instead, defendants asserted that the jury should have been instructed that the works needed to be "virtually identical."²⁶² The court of appeals found no error in the trial court's instructions and said the substantial similarity standard applied for the

²⁵³ *Id.* at 1134–35.

²⁵⁴ *Id.* at 1137.

²⁵⁵ *Id.* at 1138. About 65% of the defendants' listings were from the BUCNET listings. *See* Filewrapper, *Eleventh Circuit: Copyright in compilation of used boat listing infringed*, <http://www.filewrapper.com/index.cfm/2007/6/22> (June 22, 2007, 10:38 CST).

²⁵⁶ *BUC Int'l*, 489 F.3d at 1142.

²⁵⁷ *Id.* at 1140–41. BUC was not seeking copyright protection for the information entered by the yacht brokers, but for categories and headings. In essence, BUC was seeking protection for the template. *See* Filewrapper, *supra* note 255.

²⁵⁸ *BUC Int'l*, 489 F.3d at 1144.

²⁵⁹ *Id.* at 1141–42.

²⁶⁰ *Id.* at 1145.

²⁶¹ *Id.*

²⁶² *Id.*

infringement of factual compilations.²⁶³ It acknowledged that “it is the original selection and arrangement of the collected data that bear legal significance for factual compilations.”²⁶⁴ The court concluded, after analyzing BUC’s work, that the listing service presented the jury with substantial claims for infringement of the selection, order, and arrangement of the compilation, in particular the categories and section headings.²⁶⁵ There was no error in the instruction.²⁶⁶

Most taxonomies will satisfy the creativity requirement of the originality standard unless the compiler’s categories or classifications are standard, commonplace, or obvious, like the presentations of personal injury awards and settlements in the *Bender* case.²⁶⁷ Similarly, it is difficult to support protection for the alphabetically arranged categories and subcategories in a standard yellow pages directory because they are routine and commonplace.²⁶⁸ Still, the classifying information will ordinarily be a creative exercise by the compiler as Judge Easterbrook noted in *American Dental II*.²⁶⁹ Of course, the compiler’s copyright protection does not extend to the facts or the data he or she has classified. This is shown vividly by *Worth v. Selchow & Righter Co.*,²⁷⁰ in which the Ninth Circuit ruled that the creators of the Trivial Pursuit game did not infringe Worth’s copyright in his two volume trivia encyclopedia even though the game creators drew on those books for many of their questions and answers. Worth’s trivia came from books, films, television, and other sources, and the 6,000 items in each volume were arranged alphabetically by subject matter headings.²⁷¹ He exercised significant creativity in selecting and organizing all the interesting facts but lost because there was not substantial similarity of protected expression; Trivial Pursuit’s arrangement was much different, plus the entire selection of facts in the game and the plaintiff’s books was different.²⁷²

²⁶³ *Id.* at 1149.

²⁶⁴ *Id.* at 1148.

²⁶⁵ *Id.* at 1147–49.

²⁶⁶ *Id.* at 1149.

²⁶⁷ See *Matthew Bender & Co. v. Kluwer Law Book Publishers*, 672 F. Supp. 107 (S.D.N.Y. 1987); *supra* notes 214–26 and accompanying text.

²⁶⁸ See *BellSouth Adver. & Publ’g Corp. v. Donnelly Info. Publ’g, Inc.*, 999 F.2d 1436, 1442 (11th Cir. 1993) (en banc) (stating that such arrangements are usual and unoriginal).

²⁶⁹ *Am. Dental Ass’n v. Delta Dental Plans Ass’n (American Dental II)*, 126 F.3d 977 (7th Cir. 1997); *supra* notes 226–43 and accompanying text.

²⁷⁰ 827 F.2d 569 (9th Cir. 1987).

²⁷¹ *Id.* at 570.

²⁷² *Id.* at 573; see also *Durham*, *supra* note 9, at 845–46 (noting that the court found the game and the book to be lacking in substantial similarity).

E. CHARTS, FORMS AND JUDICIAL REPORTS

Simple charts or formats for recording information rarely will be protectable based on the post-*Feist* decision in *Victor Lalli Enterprises v. Big Red Apple, Inc.*²⁷³ as well as the old rule that blank forms for simply recording information are not copyrightable.²⁷⁴ The *Victor Lalli* litigation was about a collection of numbers drawn from available horse racing statistics that were used in betting on illegal numbers games. The numbers were recorded in charts with identical formats showing the months of the year in a row on top and the numbers one to thirty-one in a vertical column for the days of the month.²⁷⁵ Defendant Big Red directly photocopied Lalli's chart.²⁷⁶ The Second Circuit affirmed the trial court's decision that the chart was not copyrightable because the functional grids offered no opportunity for variations in arranging the statistics.²⁷⁷ The format was conventional, and the plaintiff did not exercise selectivity in what was reported or creativity in how the statistics were reported.²⁷⁸

Even if the format or chart for recording information is more complex than what was at issue in *Victor Lalli*, the venerable blank forms doctrine²⁷⁹ may limit or even preclude protection. For instance, the Ninth Circuit held in *Harper House, Inc. v. Thomas Nelson, Inc.* that the plaintiff's organizer was copyrightable as a compilation when considered as a whole based on Harper House's selection, coordination, and arrangement of the various elements, but that it merited only "extremely limited" protection because so much of it consisted of blank forms and common property.²⁸⁰ The case was, however, remanded because the jury was not told that blank forms and common property are unprotectable so that their finding of infringement might have been based on copying of such unprotectable material instead of copying of the plaintiff's selection, coordination or arrangement.²⁸¹

²⁷³ 936 F.2d 671 (2d Cir. 1991).

²⁷⁴ See *Harper House, Inc. v. Thomas Nelson, Inc.*, 889 F.2d 197, 205 (9th Cir. 1989) (holding as copyrightable compilation of blank forms but not individual forms); *Brown Instrument v. Warner*, 161 F.2d 910 (D.C. Cir. 1947) (holding as not copyrightable graphic temperature/pressure charts designed to record); *Taylor Instrument v. Fawley-Brost Co.*, 139 F.2d 98 (7th Cir. 1943) (holding as not copyrightable blank form for recording temperatures).

²⁷⁵ *Victor Lalli*, 936 F.2d at 672; see also *Abrams*, *supra* note 12, at 28–29.

²⁷⁶ *Victor Lalli*, 936 F.2d at 673.

²⁷⁷ *Id.* at 673–74.

²⁷⁸ *Id.* at 673. The trial court ruled before *Feist* was decided and relied on Second Circuit decisions that were cited with approval by the Supreme Court in *Feist*. *Id.* at 673–74.

²⁷⁹ The Copyright Office has a regulation against copyright of blank forms "which are designed for recording information and do not in themselves convey information." 37 C.F.R. § 202.1 (2006).

²⁸⁰ 889 F.2d 197, 204–05 (9th Cir. 1989).

²⁸¹ *Id.* at 208.

It is well accepted that while judicial cases are not subject to copyright protection, the headnotes, case summaries, and other materials added by publishers are protectable.²⁸² What else might be protected in a volume of cases assembled, edited, and arranged by a publisher like West? Prior to the Supreme Court's decision in *Feist*, West was successful in protecting its "star pagination" page breaks in litigation against the "jump cites" used by Lexis.²⁸³ The Eighth Circuit upheld an injunction and noted that West's arrangement was the result of labor, talent, and judgment that easily met the modicum of intellectual labor standard.²⁸⁴ The proposed use of West's page numbers would infringe.²⁸⁵ The parties ultimately settled, but the reported decision was controversial.²⁸⁶

Several years after *Feist* the Second Circuit held, in contrast to the Eighth Circuit, that several aspects of West's case reports were not copyrightable.²⁸⁷ In one of the companion declaratory judgment actions brought against it, West claimed protection for

- (i) the arrangement of information specifying the parties, court, and date of decision;
- (ii) the selection and arrangement of the attorney information;
- (iii) the arrangement of information relating to subsequent procedural developments such as amendments and denials of rehearing; and
- (iv) the selection of parallel and alternative citations.²⁸⁸

The Second Circuit analyzed these claims and concluded that the trial court had not erred in holding that these elements of the reports were not copyrightable.²⁸⁹ In regard to the captions, courts, and date information, West claimed originality in its decisions to reference a case by the names of the first

²⁸² JOYCE ET AL., *supra* note 6, at 244–45.

²⁸³ West Publ'g Co. v. Mead Data Cent., Inc., 799 F.2d 1219 (8th Cir. 1986).

²⁸⁴ *Id.* at 1226–27.

²⁸⁵ *Id.* at 1227.

²⁸⁶ See Abrams, *supra* note 12, at 33–34; L. Ray Patterson & Craig Joyce, *Monopolizing the Law: The Scope of Copyright Protection for Law Reports and Statutory Compilations*, 36 UCLA L. REV. 719, 722 (1989).

²⁸⁷ Matthew Bender & Co. v. West Publ'g Co. (*West I*), 158 F.3d 674, 677 (2d Cir. 1998); Matthew Bender & Co. v. West Publ'g Co. (*West II*), 158 F.3d 693 (2d Cir. 1998). West's syllabi, headnotes, and key numbers were not at issue. Defendant/declaratory-judgment plaintiff Hyperlaw did not propose to copy those aspects of the case reports. *Id.* at 677–78; see also JOYCE ET AL., *supra* note 6, at 246–47.

²⁸⁸ *West I*, 158 F.3d at 681. West had also asserted some creativity in its corrections to the text of opinions but dropped this claim, perhaps due to the triviality of punctuation and spelling changes. See *id.* at 681 n.4.

²⁸⁹ *Id.* at 689.

plaintiff and first defendant, to shorten long case names, to include the dates of argument, and to capitalize the first named plaintiff and defendant. The court said that these changes were insubstantial, unoriginal, and uncreative, reflecting garden-variety decisions of elementary importance.²⁹⁰ West's decision to include information about the attorneys lacked the requisite modicum of creativity because the practice was typical and garden-variety. Moreover, the options available to publishers were quite limited.²⁹¹ Similarly, in regard to West's inclusion of information about the subsequent procedural developments, such as denials of rehearing, the court stated:

Given the few practical options available to West, and the fact that the choice among these narrow options will be dictated by the timing and nature of the court's action, we do not think the district court clearly erred in determining that this element of West's case reports does not demonstrate sufficient creativity to be protectable.²⁹²

The closest question was West's determination of which parallel citations to include, but again the Second Circuit agreed with the district court that "almost every one of West's decisions relating to citation alterations is inevitable, typical, dictated by legal convention, or at best binary."²⁹³ The court stated:

One way of saying that West's "choices" are obvious and typical is that a competitor would have difficulty creating a useful case report without using many of the same citations. Affording these decisions copyright protection could give West an effective monopoly over the commercial publication of case reports (at least those containing supplemental citations).²⁹⁴

West argued that the decisions in *Kregos*, *Eckes*, *Key Publications*, and *CCC Information Services* established that only a low level of creativity was necessary in order to protect works involving selection among facts.²⁹⁵ The court responded that these cases "involved the exercise of judgments more evaluative and creative

²⁹⁰ *Id.* at 683.

²⁹¹ *Id.* at 684.

²⁹² *Id.* at 685.

²⁹³ *Id.*

²⁹⁴ *Id.* at 688.

²⁹⁵ *Id.* at 688–89.

than West exercises in the four elements of the case reports that HyperLaw intends to copy.”²⁹⁶

A vigorous dissent by Judge Sweet argued that the majority had imposed a “standard that demands significantly more than the ‘modicum’ of creativity required by *Feist*.”²⁹⁷ He said that the outcome was not consistent with the Second Circuit’s decision in *Key Publications*, and that unlike the selections and arrangements that were denied protection in *Victor Lalli* and *Financial Information Inc. v. Moody’s Investors Service, Inc.*,²⁹⁸ because the choices were inevitable, all of West’s basic choices involved subjective judgment.²⁹⁹ He concluded:

To the extent that the West selection of factual annotation may seem obvious to anyone familiar with legal sources, it may be because of West’s success in the market. There is no support for the proposition that West’s success in achieving an ‘industry standard’ citation arrangement obligates them to donate the material to the public domain.³⁰⁰

The companion case focused once again on West’s rights, if any, in “star pagination.”³⁰¹ The Second Circuit did not follow the Eighth Circuit’s pre-*Feist* ruling in the Mead Data/Lexis suit, stating that the outcome was based on the discredited sweat of the brow rationale for protection, and found no basis for concluding that page numbers were a protected aspect of West’s arrangement.³⁰² The Second Circuit stated:

At issue here are references to West’s volume and page numbers distributed through the text of plaintiffs’ versions of judicial opinions. West concedes that the pagination of its volumes—*i.e.*, the insertion of page breaks and the assignment of page numbers—is determined by an automatic computer program, and West does not seriously claim that there is anything original or creative in that process. As Judge Martin noted, “where and on

²⁹⁶ *Id.* at 689.

²⁹⁷ *Id.* at 690 (Sweet, J., dissenting).

²⁹⁸ 808 F.2d 204 (2d Cir. 1986).

²⁹⁹ *Id.* at 692.

³⁰⁰ *Id.* at 692–93 (citation omitted); *see also* VerSteeg, *supra* note 11, at 857–61 (discussing the pre-*Feist* decision *West Publ’g Co. v. Mead Data Cent., Inc.*, 799 F.2d 1219 (8th Cir. 1986) and noting that West’s arguments about its selection and arrangement of cases might satisfy the originality standard as defined by *Feist*, but still indicating that the ruling in West’s favor might not have been correct).

³⁰¹ *West II*, 158 F.3d 693, 695 (2d Cir. 1998).

³⁰² *Id.* at 707–08.

what particular pages the text of a court opinion appears does not embody any original creation of the compiler.” Because the 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.³⁰³

Judge Sweet also dissented in this case. He stated that “[b]y characterizing star pagination as a fact, rather than as an essential part of the selection or arrangement the majority deprives the West pagination of its originality and consequent copyright protection.”³⁰⁴ Continuing, Judge Sweet argued:

Here the pagination results from West’s arrangements, selections, syllabi, headnotes, key numbering, citations and descriptions. The page number, arbitrarily determined, is the sole result of the West system, appears nowhere else, and is essential to its coordinated method of citation. It is, so to speak, an original fact resulting from West’s creativity.³⁰⁵

These arguments for protection of West’s page numbers sound, in many respects, like the arguments against the protection of parts numbers and parts numbering systems. The page numbers are determined arbitrarily (this was fatal in *Toro*) and are the result of a system (barred by section 102(b) as in *Southco*).³⁰⁶ Judge Sweet is troubled, of course, that by treating the page numbers as facts instead of as protected expression permits Bender and Hyperlaw to “appropriate the practical and commercial value of the West compilation,”³⁰⁷ but he forgets that this is very much a part of the copyright balance.

To paraphrase a portion of Justice Brennan’s dissent in *Harper & Row Publishers, Inc. v. Nation Enterprises*, it is understandable that Judge Sweet wants to compensate West for the subsequent use of the page numbers.³⁰⁸ Justice Brennan stated:

An inequity seems to lurk in the idea that much of the fruit of the [compiler’s] labor may be used without compensation. This, however, is not some unforeseen byproduct of a statutory scheme

³⁰³ *Id.* at 699.

³⁰⁴ *Id.* at 709 (Sweet, J., dissenting).

³⁰⁵ *Id.* at 710.

³⁰⁶ See *supra* notes 122–48 and accompanying text.

³⁰⁷ *West II*, 158 F.3d at 708 (Sweet, J., dissenting).

³⁰⁸ 471 U.S. 539, 589 (1985) (Brennan, J., dissenting).

intended primarily to ensure a return for works of the imagination. Congress made the affirmative choice that the copyright laws should apply in this way: “Copyright does not preclude others from using the ideas or information revealed by the author’s work. It pertains to the literary . . . form in which the author expressed intellectual concepts.”³⁰⁹

The Second Circuit, like the Eleventh Circuit, has been rigorous in its application of *Feist*’s principles in a variety of contexts. The unwillingness of these courts to protect facts and information notwithstanding apparent “free-riding” by the defendant supports the basic principles announced in *Feist*. Protection for compilations is thin because facts are not protected notwithstanding the labor and efforts of the compiler. There must be a modest amount of creativity in the selection, coordination, and arrangement of facts and information.³¹⁰

IV. SYNTHESIS

A. COPYRIGHTABILITY

There is no bright line test for determining originality because of the nature of the creativity requirement, but the courts have applied *Feist* with a reasonable degree of consistency since 1991.³¹¹ The decisions teach several lessons.

It is relatively safe to conclude that a comprehensive compilation that includes all the facts, data, or information from a defined class will rarely exhibit sufficient creativity in selection. The compiler exercises no intellectual judgment in deciding what to include in such a work. A telephone directory’s alphabetical listing of the names and numbers of everyone in a community is an example,³¹² as is the comprehensive listing of cable system operators in the *Warren* case.³¹³ On the

³⁰⁹ *Id.* (quoting H.R. REP. NO. 94-1476, at 56–57 (1976); *see also* *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 349 (1991) (quoting *Harper*, 471 U.S. at 556).

³¹⁰ *See* LEAFFER, *supra* note 68, at 77.

³¹¹ *See* Abrams, *supra* note 12, at 24.

³¹² *Id.* at 18–19; *Feist*, 499 U.S. 340; *see also* *National Rifle Ass’n of Am. v. Handgun Control Fed’n of Ohio*, 15 F.3d 559, 560–61 (6th Cir. 1994) (discussing the trial court’s decision that the NRA’s list of all of Ohio’s legislators was not copyrightable because it was mechanical and routine); *Skinder-Strauss Assocs. v. Mass. Continuing Legal Educ., Inc.*, 914 F. Supp. 665, 676 (D. Mass. 1995) (directory of lawyers and judges lacks requisite creativity notwithstanding decision to exclude those who are retired or who have suspended licenses).

³¹³ *Warren Publ’g, Inc. v. Microdos Data Corp.*, 115 F.3d 1509 (11th Cir. 1997); *see also* *Silverstein v. Penguin Putnam, Inc.*, 368 F.3d 77 (2d Cir. 2004) (dispute over whether compiler of all the uncollected poems by the late Dorothy Parker exercised sufficient creativity in selecting the poems for inclusion in his book).

other hand, a comprehensive listing of information might be placed in categories and presented in a manner that evidences sufficient creativity. An example is the code of dental procedures at issue in *American Dental II*.³¹⁴

Selections that evidence the author's or compiler's exercise of judgment or taste might evidence sufficient creativity, as shown by the premium baseball cards at issue in *Eckes* or the estimates of used car values in *Maclean Hunter*.³¹⁵ Selections dictated by industry standards, custom, external forces, or government requirements might not satisfy the creativity requirement.³¹⁶

Selections made by someone other than the compiler/author, such as the decisions by subscribers to the yellow pages or purchasers of the advertisement space about where to place their entries, are not creative.³¹⁷ Taxonomies and classification schemes usually are copyrightable if they are not obvious or standard like the categories or classifications in the yellow pages.³¹⁸ Arbitrarily or randomly generated parts numbers for catalogues do not evidence authorship,³¹⁹ and parts numbers generated by applying a formula or following a system cannot be protected because of the prohibition in section 102(b) on extending copyright protection to ideas, concepts, and systems.³²⁰ Parts numbers also do not fare well

³¹⁴ 126 F.3d 977 (7th Cir. 1997).

³¹⁵ See *supra* notes 172–99 and accompanying text; see also *DF Inst., Inc. v. Marketshares EDS*, No. 07-1348, 2007 WL 1589525, at *7 (D. Minn. June 1, 2007) (“[A]ll multiple-choice questions must contain the correct answer, and these answers are not creative. However, the court finds that the wrong answers very likely demonstrate protectable original expression.”); cf. *N.Y. Mercantile Exch., Inc. v. IntercontinentalExchange, Inc.*, 497 F.3d 109, 118 (2d Cir. 2007) (whatever creative expression is embodied in published settlement prices merges with the underlying idea); see also *Burk*, *supra* note 14 (rightly critical of the results in *Maclean Hunter* and *Kaper*).

³¹⁶ See *Feist*, 499 U.S. at 363 (noting that telephone company was required by the Kansas Corporation Commission to include subscribers' names); *Mid Am. Title Co. v. Kirk*, 59 F.3d 719, 722 (7th Cir. 1995) (holding compilation of land title data not to be copyrightable because the title examiner was restricted by external forces to simply list all factual information that affected marketable title); *Eng'g Dynamics, Inc. v. Structural Software, Inc.*, 26 F.3d 1335, 1351 (5th Cir. 1994) (ordering remand to determine whether existence of industry standards precluded copyright protection for user interfaces).

³¹⁷ See *BellSouth Adver. & Publ'g Co. v. Donnelly Info. Publ'g*, 999 F.2d 1436 (11th Cir. 1993) (en banc); *Warren*, 115 F.3d 1509 (11th Cir. 1997).

³¹⁸ See *supra* notes 213–72 and accompanying text.

³¹⁹ See *Toro Co. v. R & R Prods. Co.*, 787 F.2d 1208 (8th Cir. 1986).

³²⁰ See *ATC Distribution Group v. Whatever It Takes Transmissions & Parts, Inc.*, 402 F.3d 700 (6th Cir. 2005); *Southco, Inc. v. KaneBridge Corp.*, 390 F.3d 276 (3d Cir. 2004); cf. *N.Y. Mercantile Exch.*, 497 F.3d at 118 (whatever creativity is embodied in market settlement prices unprotectable under the merger doctrine); see also *Windgate Software L.L.C. v. Minn. Computers, Inc.*, 504 F. Supp. 2d 582 (D. Minn. 2007) (no likelihood of success on merits because the only things defendants copied from plaintiff's website were unprotected parts numbers and parts descriptions that were not creative).

because of the merger doctrine and the settled practice of the Copyright Office denying protection to words, titles and short phrases.³²¹

B. PROVING INFRINGEMENT

Even if a low authorship work satisfies the originality standard, the copyright owner must still prove substantial similarity of protected expression in order to prevail. One court said that this requires that the plaintiff compiler show that there are no more than trivial differences between those elements that provide copyrightability to its work and to the allegedly infringing work.³²² This means that while the works need not be identical, there must be sufficient congruence between the original elements of the works such that a jury could find infringement. The substantial similarity test varies to some extent on the nature of the works at issue, and this makes the factual-compilation plaintiff's case difficult.³²³ *Feist* makes clear that it is the original selection, coordination, and arrangement of the collected data that have legal significance for compilations.³²⁴

The Ninth Circuit has stated that "copyright infringement of compilations consisting largely of uncopyrightable elements should not be found in the absence of 'bodily appropriation of expression.'"³²⁵ What this ordinarily means is that the plaintiff will have to show something close to wholesale appropriation as in *CCC v. Maclean Hunter* and *CDN v. Kapes*³²⁶ or *BUC v. International Yacht*.³²⁷ Copyright protection for compilations is thin, and the protected aspects of these works will be found in the author's selection, coordination, or arrangement of the facts, data, or information. For instance, a compilation of blank forms in an executive organizer might be copyrightable when viewed as a whole, even though the individual blank forms are not protectable.³²⁸

³²¹ See *supra* notes 121–60 and accompanying text.

³²² *O.P. Solutions, Inc. v. Intellectual Prop. Network, Ltd.*, 52 U.S.P.Q.2d 1818, 1824–25 (S.D.N.Y. 1999) (citing and quoting *Kregos v. Associated Press*, 937 F.2d 700 (2d Cir. 1991) and *Key Publ'ns, Inc. v. Chinatown Today Publ'g Enters., Inc.*, 945 F.2d 509 (2d Cir. 1991)).

³²³ See *BUC Int'l Corp. v. Int'l Yacht Council, Ltd.*, 489 F.3d at 1148 (11th Cir. 2007) (citing *BellSouth* and *Key Publications*); *BellSouth Adver. & Publ'g Co. v. Donnelly Info. Publ'g*, 999 F.2d 1436, 1445 n.22 (11th Cir. 1993).

³²⁴ *Feist Publ'ns v. Rural Tel. Serv.*, 499 U.S. 340, 348 (1991).

³²⁵ *Harper House, Inc. v. Thomson Nelson, Inc.*, 889 F.2d 197, 205 (9th Cir. 1989) (quoting from *Worth v. Selchow & Righter Co.*, 827 F.2d 569, 573 (9th Cir. 1987)).

³²⁶ See *supra* notes 184–210 and accompanying text; see also *O.P. Solutions*, 52 U.S.P.Q.2d 1818 (holding that selection, coordination, and arrangement of input fields for computer program's user interface screen display was sufficiently creative and infringed by defendant's substantially similar display—the differences were trivial).

³²⁷ See *supra* notes 250–65 and accompanying text.

³²⁸ See *Harper House*, 889 F.2d at 204 ("A copyrightable compilation can consist mainly or entirely of uncopyrightable elements.").

In the context of computer software infringement litigation, some courts have stated that when the range of protected expression is limited, the appropriate standard for illicit copying is virtual identity or even “virtual identicality.”³²⁹ Does this test apply to compilation litigation generally? A leading treatise states:

[T]he measure of how substantial a “substantial similarity” must be may vary according to the circumstances. For many copyrights represent significant creative effort, and are therefore reasonably robust, whereas others reflect only scant creativity; the Supreme Court labels the latter “thin.” It would seem to follow analytically that more similarity is required when less protectible matter is at issue. Thus, if substantial similarity is the normal measure required to demonstrate infringement, “*supersubstantial*” similarity must pertain when dealing with “thin” works.³³⁰

This arguably calls for a more demanding showing than the traditional “substantial similarity” of protected expression test, confuses the issue of copyrightability with infringement, and misleads courts.³³¹ The Eleventh Circuit’s decision in *BUC International*³³² rejected the defendants’ plea for a “virtual identicality” instruction. The court stated that this test was for claims of compilation copyright infringement of nonliteral elements of a computer program and upheld a jury’s finding of infringement after being instructed about substantial similarity.³³³ Perhaps the best way to explain this disagreement is to say that the substantial similarity of protected expression test is the standard for infringement, and as applied to low authorship works or works with thin copyrights, it is sometimes necessary for the works to be virtually identical in order for the plaintiff to win.

Moreover, the merger doctrine looms large against proving infringement in low authorship cases. A trial court explained that as idea and expression merge: “a

³²⁹ *MiTek Holdings, Inc. v. Arce Eng’g Co.*, 89 F.3d 1548, 1558 n.24 (11th Cir. 1996); *Apple Computer, Inc. v. Microsoft Corp.*, 35 F.3d 1435, 1439 (9th Cir. 1994); *cf. Transwestern Publ’g Co. v. Multimedia Mktg. Assocs.*, 133 F.3d 773, 776–77 (10th Cir. 1998) (yellow pages case).

³³⁰ 4 NIMMER & NIMMER, *supra* note 8, § 13.03[A] (emphasis added); *see also* Jane C. Ginsburg, *No “Sweat”? Copyright and Other Protection of Works of Information After Feist v. Rural Telephone*, 92 COLUM. L. REV. 338, 349 (1992) (“‘Even if the compilation is deemed original, what kind of copying will be held to infringe it?’ The answer [after *Feist*] appears to be: ‘Virtually none, short of extensive verbatim copying.’”).

³³¹ The Patry Copyright Blog, <http://williampatry.blogspot.com> (June 22, 2007, 05:16 EST).

³³² *BUC Int’l Corp. v. Int’l Yacht Council Ltd.*, 489 F.3d 1129 (11th Cir. 2007).

³³³ *Id.* at 1148–49.

copyright holder must then prove substantial similarity to those few aspects of the work that are expression not required by the idea.”³³⁴ This court continued:

It further follows that “the fewer the methods of expressing an idea, the more the allegedly infringing work must resemble the copyrighted work in order to establish substantial similarity.” “In such a case, the burden of proof is heavy on the plaintiff who may have to show ‘near identity’ between the works at issue.”³³⁵

C. FAIR USE

Fair use³³⁶ will often be a strong defense for an alleged infringer if there is more than a de minimis taking of protected expression from a low authorship work.³³⁷ The sound application of fair use in the context of compilation litigation

³³⁴ *Skinder-Strauss Assocs. v. Mass. Continuing Legal Educ., Inc.*, 914 F. Supp. 665, 673 (D. Mass. 1995) (citing and quoting *Concrete Mach. Co. v. Classic Lawn Ornaments, Inc.*, 843 F.2d 600, 607 (1st Cir. 1988)).

³³⁵ *Id.* (citing and quoting *Cooling Sys. & Flexibles, Inc. v. Stuart Radiator, Inc.*, 777 F.2d 485, 491 (9th Cir. 1985) and *Concrete Machinery*, 843 F.2d at 606); *see also* *Eng’g Dynamics, Inc. v. Structural Software, Inc.*, 26 F.3d 1335, 1348 (5th Cir. 1994) (remanding case for trial on whether plaintiff’s copyright in input/output formats was infringed, but noting that “[t]o the extent that they are highly functional, or, like the output formats in this case, to the extent that they contain highly standardized technical information, they may lie near the line of uncopyrightability”).

³³⁶ 17 U.S.C. § 107 (2000) provides:

Notwithstanding the provisions of sections 106 and 106A, the fair use of a copyrighted work, including such use by reproduction in copies or phonorecords or by any other means specified by that section, for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research, is not an infringement of copyright. In determining whether the use made of a work in any particular case is a fair use the factors to be considered shall include—

- (1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes;
- (2) the nature of the copyrighted work;
- (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and
- (4) the effect of the use upon the potential market for or value of the copyrighted work.

The fact that a work is unpublished shall not itself bar a finding of fair use if such finding is made upon consideration of all the above factors.

³³⁷ In some cases involving a compilation it might be reasonable for a court to rule no infringement notwithstanding some taking of a compilation’s protected expression if the taking is slight or de minimis. *Cf.* *Nat’l Rifle Ass’n of Am. v. Handgun Control Fed’n of Ohio*, 15 F.3d 559 (6th Cir. 1994) (the Sixth Circuit found fair use but could have said no infringement because what the defendant copied—the NRA’s mailing list of Ohio’s legislators with asterisks by those serving

is illustrated by *Gulfstream Aerospace Corp. v. Camp Systems International, Inc.*³³⁸ This case involved a claim of copyright infringement of Gulfstream's maintenance manuals for its corporate aircraft. These complex and detailed manuals were written for each of Gulfstream's models in accordance with Federal Aviation Administration (FAA) regulations. These manuals were required so that maintenance mandated by the FAA was performed on schedule. The manuals were organized in keeping with an industry standard, and Gulfstream itself performed the required maintenance for many, but by no means all, of its aircraft.³³⁹ Defendant Camp was also in the business of performing scheduled maintenance on all makes and models of corporate aircraft, and it reproduced portions of Gulfstream's manual in connection with its computerized maintenance tracking service. This service informed subscribers when work had to be performed and specified the exact maintenance tasks.³⁴⁰ Gulfstream alleged that this reproduction of portions of its manuals was copyright infringement.³⁴¹ Camp defended by saying that the copyrights on Gulfstream's manuals were invalid and that even if aspects of the manuals satisfied the originality standard, its use of the manuals was a fair use.³⁴²

The court stated:

[F]ederal regulations mandate that “[t]he Instructions for Continued Airworthiness must be in the form of a manual or manuals as appropriate for the quantity of data to be provided,” and that “[t]he format of the manual or manuals must provide for a practical arrangement.” Thus, not only is the *content* of the manuals specified by regulation, but also the *format* of the manuals is specified so that an aircraft manufacturer may not add unnecessary sections to give the manuals a “creative” or “original” touch.

From the facts presented by Camp, then, and from the facts judicially noticed by the Court—that is, that Gulfstream seeks to

on the key committees—was not copyrightable (the trial court's ruling) or so thinly protected that there was de minimis copying of protected expression). Regarding de minimis infringements, see *Ringgold v. Black Entm't Network*, 126 F.3d 70 (2d Cir. 1997) and *Knickerbocker Toy Co. v. Azrak Hamway Int'l Inc.*, 668 F.2d 699 (2d Cir. 1982).

³³⁸ 428 F. Supp. 2d 1369 (S.D. Ga. 2006). The author served as an expert for defendant Camp Systems in this litigation.

³³⁹ *Id.* at 1371–72.

³⁴⁰ *Id.* at 1372.

³⁴¹ *Id.* at 1372–73. Gulfstream was the only aircraft manufacturer that refused to sell or provide its manuals to Camp, so Camp obtained the manuals from its customers who owned or leased Gulfstream aircraft. Camp copied parts of those manuals so its customers would know when maintenance was due and what had to be done (due lists and task cards). *Id.* at 1373.

³⁴² *Id.* at 1371, 1375.

copyright here maintenance manuals written in accordance with federal guidelines that significantly prescribe the content and format of those manuals—it is clear that much, if not all, of Gulfstream’s manuals are *not* copyrightable in light of 17 U.S.C. § 102(b).³⁴³

Nevertheless, Camp conceded that there was a thin copyright for Gulfstream’s manuals³⁴⁴ and that it had copied pages that contained some copyrightable expression.³⁴⁵ The court then proceeded to a thorough fair use analysis and concluded that there was no infringement.³⁴⁶ In regard to the second fair use factor, the nature of the copyrighted work,³⁴⁷ the court explained:

Under the second fair use factor, the nature of Gulfstream’s work is predominantly factual rather than creative. As the Court has already noted, the manuals contains mostly procedures, lists of systems, and detailed methods of operations. This factor points in favor of finding that Camp has made a fair use of the manuals.³⁴⁸

In addition, there was no evidence that Camp’s use of the manuals affected the market for the original copyrighted work.³⁴⁹ Moreover, the court explained that Gulfstream’s real desire for copyright protection on the manuals was to gain a judicially enforced monopoly in maintenance-tracking services for its aircraft and that this was contrary to the purpose of copyright law.³⁵⁰ Accordingly, the court found fair use even though its analysis of the first and third factors weighed against Camp.³⁵¹

³⁴³ *Id.* at 1375–76 (citations omitted) (emphasis in original).

³⁴⁴ *Id.* at 1376. The defendant in the *BellSouth* yellow pages litigation also conceded copyright on the work as a whole. See *supra* notes 81–99 and accompanying text.

³⁴⁵ *Gulfstream*, 428 F. Supp. 2d at 1376.

³⁴⁶ *Id.*

³⁴⁷ See 17 U.S.C. § 107(2) (2000).

³⁴⁸ *Gulfstream*, 428 F. Supp. 2d at 1378 (citations omitted).

³⁴⁹ *Id.* at 1379–80.

³⁵⁰ *Id.* at 1380; see also *Assessment Tech. of Wis., LLC v. WIREdata, Inc.*, 350 F.3d 640 (7th Cir. 2003); *supra* notes 244–48 and accompanying text.

³⁵¹ The factual nature of the work also was discussed in regard to the third fair use factor:

Camp does not copy or use all of Gulfstream’s manuals. . . . Camp does not load the entire soft copy of the manual onto its own system; it merely “extracts” the specific pages that describe the maintenance tasks to be performed.

Thus, while Camp does not use the entire manuals—and, for that matter, might not use any copyrighted portions of the manuals—it still admittedly uses a significant amount of Gulfstream’s work, from both a quantitative and qualitative standpoint.

Gulfstream, 428 F. Supp. 2d at 1378 (citation omitted).

It is important to note that fair use is an affirmative defense that comes into play only after the plaintiff has made a prima facie case of infringement.³⁵² It is a well-established doctrine, and the decisions applying this equitable rule of reason are legion. The drafters of section 107 explained that “the endless variety of situations and combinations of circumstances” presented in copyright litigation “precludes the formulation of exact rules” and that “courts must be free to adapt the doctrine to particular situations on a case-by-case basis.”³⁵³ Accordingly, in the event a compiler plaintiff makes the difficult prima facie case that the defendant copied protected expression from his or her thinly protected work, the defendant should raise fair use like Camp Systems in the Gulfstream instruction manual litigation.

D. UNPROTECTED SOFT FACTS

Can the cases involving soft facts be used to push *Feist*'s principles about creativity and infringement out of shape to extend protection to facts?³⁵⁴ For example, the copyrightability of used car values published in Maclean Hunter's *Red Book* was upheld because the editors exercised considerable creativity in setting the values of cars manufactured in a certain range of years and breaking up these values by region.³⁵⁵ The values for the particular makes and models were not based solely on historical prices or a formula but on a variety of factors and the judgment of the company's editors/writers. Those values were thus regarded as soft facts and entitled to protection against the defendant's wholesale appropriation.³⁵⁶

Is a soft fact always a soft fact? Would this be true to the spirit of *Feist*? The wholesale reproduction of the *Red Book* by CCC infringed, but would a Toyota dealer in Athens, Georgia, infringe Maclean Hunter's copyright if it took information from the most recent edition of the *Red Book* about the resale value of Toyotas and included those figures in an advertisement promoting how well Toyotas hold their value? What if the Toyota dealer included *Red Book* data about

³⁵² JOYCE ET AL., *supra* note 6, at 773.

³⁵³ H.R. Rep. No. 94-1476 at 66, *reprinted in* 1976 U.S.C.C.A.N. 5659, 5679.

³⁵⁴ See JOYCE ET AL., *supra* note 6, at 244 (discussing copyrightable compilations); Burk, *supra* note 14 (critical of *Maclean Hunter* and *Kaper*); Durham, *supra* note 9, at 795, 822–37 (discussing standards of originality in the fact/expression of dichotomy).

³⁵⁵ It can be argued, however, that the decisions to divide the nation into regions and to limit the car values to the last seven years were not especially creative because it is understood that car values vary by region and because the market for older cars (seven years or so) is unpredictable given factors like mileage, wear and tear, maintenance, and the like. Moreover, Maclean Hunter did not exercise any judgment in selection because it included all makes and models in the *Red Book* for the particular years in question.

³⁵⁶ See *supra* notes 184–99 and accompanying text.

other makes and models in a comparative advertisement showing that Toyotas hold their value better than those other makes and models? The dealer has not copied any of MacLean's coordination or arrangement, but it has copied some of Maclean's soft facts and used them factually and accurately. Are Maclean's protected soft facts turned into unprotectable hard facts in these hypothetical ads? If not, is this use a fair use?

Based on the decisions that have upheld the copyrightability of low authorship works and then moved to the issue of infringement, it is doubtful that this hypothetical Toyota dealer would be liable. A court could reasonably conclude, as in *Key Publications*, that there is no substantial similarity of protected expression.³⁵⁷ Moreover, this use of the protected "soft facts" from Maclean Hunter's low authorship *Red Book* would in all likelihood be ruled a fair use under section 107.³⁵⁸

This hypothetical is similar to the *General Signal* case.³⁵⁹ The plaintiff there published Consumer Reports, and an article its July 1983 issue reported an evaluation of lightweight vacuum cleaners. Defendant General Signal's Regina Powerteam model received a check rating and considerable praise because it tested "to be of high overall quality, low price, and appreciable superiority to the non-check rated models examined."³⁶⁰ The article also said the Powerteam was "ahead of the pack in cleaning ability," the only model that was "an adequate substitute for a full-sized vacuum," and the only one to have " 'vacuumed the floor thoroughly.' "³⁶¹ After this article was published, General Signal broadcast two thirty-second television commercials that quoted these favorable statements from the article.³⁶² Consumers Union, which does not accept advertising or permit its ratings and reports to be used in advertising, sued General Signal alleging copyright infringement and other claims.³⁶³

General Signal did not challenge the copyright on the article. However, it argued that it was a "fact" that Consumer Reports check-rated the Powerteam and praised it as superior to other models.³⁶⁴ Moreover, General Signal quoted the

³⁵⁷ See *supra* notes 69–80 and accompanying text. In addition, a court might rule that this is a de minimis taking and thus not infringement. See *supra* note 337. But see *Ringgold v. Black Entm't Television, Inc.*, 126 F.3d 70 (2d Cir. 1997) (defendant's use held as not de minimis).

³⁵⁸ See *Nat'l Rifle Ass'n of Am. v. Handgun Control Fed'n of Ohio*, 15 F.3d 559 (6th Cir. 1994); *Consumers Union of the U.S. v. Gen. Signal Corp.*, 724 F.2d 1044 (2d Cir. 1983); *Gulfstream Aerospace Corp. v. Camp Sys. Int'l, Inc.*, 428 F. Supp. 2d 1369 (S.D. Ga. 2006).

³⁵⁹ *Consumers Union of the U.S. v. Gen. Signal Corp.*, 724 F.2d 1044 (2d Cir. 1983).

³⁶⁰ *Id.* at 1046.

³⁶¹ *Id.* at 1047 (quoting *Lightweight Vacuum Cleaners*, CONSUMER REPORTS, July 1983).

³⁶² *Id.*

³⁶³ *Id.* at 1046–47. State law claims were also asserted. Consumers Union was not satisfied with General Signal's disclaimer stating that it was not affiliated with Consumer Reports. *Id.* at 1048.

³⁶⁴ *Id.* at 1047.

article accurately, stating in the advertisements exactly what Consumer Reports had written about the product.³⁶⁵ Under *CCC v. Maclean Hunter*, these evaluative statements about the Powerteam would seem to be protectable soft facts, reflecting the good judgment and sound opinion of Consumer Reports after thorough testing. However, that is not how the Second Circuit treated these test results in holding that General Signal's use of the article was a fair use:

Facts cannot be copyrighted. CU cannot prevent Regina from accurately reporting facts about the results of CU's independent testing, irrespective of Regina's motive in doing so. Regina wants to communicate *Consumer Reports'* favorable rating of its product. Regina uses CU's words in the interest of accuracy, not piracy. Where an evaluation or description is being made, copying the exact words may be the only valid way precisely to report the evaluation.³⁶⁶

The court also emphasized that although the television advertisements advanced General Signal's commercial interests, they also reported factual information, which is conducive to fair use.³⁶⁷ Moreover, the advertisements borrowed only twenty-nine words out of the 2,100-word article, and there was no evidence that it had a deleterious effect on the market for or value of Consumer Reports.³⁶⁸

Although the Consumer Reports litigation did not involve alleged infringement of a compilation, there are significant parallels between what General Signal did and the hypothetical Toyota dealer's advertisements using soft facts from *Red Book*. The dealer is using only a few soft facts out of thousands; it is using them accurately, and *Red Book* should not be able to use its copyright to prevent Toyota from reporting the "facts" of *Red Book's* independent valuation of various makes and models. Moreover, it is doubtful that the dealer's advertisements would have any negative impact on the market for or value of the *Red Book*. In short, even if a court concluded that the Toyota dealer copied more than a de minimis amount of protected expression,³⁶⁹ it would still hold that this small amount of copying was a fair use under section 107.

³⁶⁵ *Id.*

³⁶⁶ *Id.* at 1049–50 (citations omitted).

³⁶⁷ *Id.* at 1049.

³⁶⁸ *Id.* at 1049–51.

³⁶⁹ See *Knickerbocker Toy Co. v. Azrak-Hamway Int'l, Inc.*, 668 F.2d 699 (2d Cir. 1982) and *Ringgold v. Black Entm't Television, Inc.*, 126 F.3d 70 (2d Cir. 1997) for a discussion of de minimis takings of protected expression.

V. CONCLUSION

The Supreme Court stated in *Feist* that “the vast majority of compilations will pass [the modicum of creativity] test, but not all will. There remains a narrow category of works in which the creative spark is utterly lacking or so trivial as to be virtually nonexistent.”³⁷⁰ The Court’s prediction was correct. Most compilations have been unaffected by the elusive “creativity” requirement.³⁷¹ There were concerns expressed after *Feist* that the Court had failed to define the originality requirement with sufficient clarity.³⁷² Concerns have also been raised about the creativity requirement being satisfied too easily with compilations of soft facts, predictions, and opinion.³⁷³ However, the post-*Feist* cases show that the courts do not have a blurred vision of what originality means in regard to compilations and other low authorship works.

There is no need to develop an alternative test of originality such as a heightened standard or the “more than a trivial variation” standard often used to assess the copyrightability of derivative works. There is ample guidance from Justice O’Connor’s opinion and subsequent cases applying *Feist* to enable courts to determine whether otherwise original works satisfy the modicum of creativity requirement. Moreover, the difference between “more than a trivial variation” and “at least a modicum of creativity” is largely semantic. In addition, courts have enough tools at their disposal to prevent the thin protection enjoyed by works like the comprehensive price guides in *Maclean Hunter* and *CDN v. Kapes* or the predictive list of baseball statistics in *Kregos* from being used improperly to extend a copyright holder’s limited monopoly.

The originality standard remains low,³⁷⁴ so it does not take much more than a penny to turn the copyright turnstile.³⁷⁵ The discipline imposed by *Feist*’s principles, precedent, and rigorous appellate review has led to considerable agreement about what kinds of works have sufficient creativity to warrant protection.³⁷⁶ Protection remains thin,³⁷⁷ and establishing substantial similarity of protected expression with low authorship works often requires proof of close to wholesale copying. Modest appropriations of protected aspects of compilations

³⁷⁰ *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 359 (1991).

³⁷¹ *Cf. Abrams*, *supra* note 12, at 43 (predicting minimal effect on future production of compilations).

³⁷² *See VerSteeg*, *supra* note 11, at 803–04.

³⁷³ *See Burk*, *supra* note 14; *Durham*, *supra* note 9.

³⁷⁴ *Feist*, 499 U.S. at 358–59.

³⁷⁵ *See KAPLAN*, *supra* note 18, at 46.

³⁷⁶ *See Zimmerman*, *supra* note 11, at 211–12 (discussing the disciplinary effect of precedent and appellate review).

³⁷⁷ *Feist*, 499 U.S. at 349.

like soft facts often can be excused under fair use. The courts have not permitted compilers' copyrights to be used improperly to block access to and use of uncopyrightable facts and data. The protection copyright grants to a compilation may not be anorexic, but it certainly remains very lean. After all, the essence of copyright is that the fruits of a compiler's labor may be used by others without compensation.³⁷⁸

³⁷⁸ *Id.* (citing and quoting *Harper & Row, Inc. v. Nation Enters.*, 471 U.S. 539, 589 (1985) (Brennan, J., dissenting)).