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The Vices of Originality

Paul J. Heald  
*University of Georgia School of Law*, heald@uga.edu

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Lately, the Constitution has become an unwelcome guest at the parties of those claiming rights lying on the periphery of intellectual property. Two terms ago, in *Bonito Boats, Inc. v Thunder Craft Boats Inc.*, the Court held that federal patent law preempted a Florida statute forbidding the reproduction of boat hulls by use of any direct molding process. The Court's decision effectively provided a limited constitutional right to copy unpatented product shapes and designs. Most recently, in *Feist Publications, Inc. v Rural Telephone Service, Inc.*, the Intellectual Property Clause was held to create positive restraints on Congress's ability to provide copyright protection. In deciding that telephone directory white pages were uncopyrightable, the Court found that the Intellectual Property Clause imposed an originality requirement on authors seeking protection for their works. It held that Rural Telephone Service's white pages were not original enough to meet the new constitu-
tional requirement. The Intellectual Property Clause, generally presumed to be nothing more than a grant of power to Congress,\(^5\) suddenly grew some substantive claws.

The idea that only "original" works can be copyrighted is hardly novel. The 1976 Copyright Act\(^6\) protects only "original works of authorship," as did its predecessor act as interpreted by courts and commentators.\(^7\) Exactly what "original" meant in a work comprised of a compilation of facts was hotly debated. A unanimous Court in *Feist* dropped two bombshells in the middle of the debate. First, Justice O'Connor's opinion asserts, bludgeoning the point home in at least seven places, that originality exists as a constitutional requirement wholly apart from the Copyright Act.\(^8\) Second, telephone white pages are not original enough to satisfy the new constitutional test. In other words, the familiar white pages are unprotected and Congress apparently can do nothing to render them protectable short of initiating a constitutional amendment.

The opinion is all the more interesting, because the Court bypassed at least four narrower grounds for reversing the Tenth Circuit's decision—the well-worn axiom militating against reaching constitutional questions except when necessary was nowhere to be seen. Doctrinally, these narrow grounds appear far more attractive than the rationale provided in Justice O'Connor's opinion. *Feist*’s constitutionalization of the originality requirement is undesirable because it may frustrate the goals of the Intellectual Property Clause, as described by virtually all modern commentators and the Court itself. Although the likely contours of the post-*Feist* legal landscape are difficult to predict, Justice O'Connor's opinion in *Feist* has direct implications for the copyrightability of other types of statutory compilations, collections of facts found in noncompilations, and other works which evidence little originality such as maps and some computer programs. The opinion may also affect the copyrightability of broadcasts of sporting events and speeches, and raises the question of the legitimacy of a congressional attempt

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\(^6\) 17 USC §§ 101 et seq (1976).


\(^8\) See *Feist*, 111 S Ct at 1288, 1289, 1296, & 1297.
to circumvent the decision by enacting legislation under its power to regulate interstate commerce.

I. THE OPINION AND ALTERNATIVE HOLDINGS

The defendant in *Feist* produced a comprehensive white pages directory covering eleven different telephone service areas in northwest Kansas. It obtained permission from ten of eleven telephone companies to use their local listings to create an all-encompassing directory containing 47,000 alphabetically ordered listings. When Rural Telephone Service refused to grant permission to allow copying of any of its 7,700 listings, Feist used 1,309 of them anyway. Rural then brought suit in federal district court for copyright infringement, prevailing on a motion for summary judgment.\(^9\) Later, the Tenth Circuit affirmed in a short unpublished per curiam opinion.\(^{10}\) Both lower courts relied on consistent authority that white pages directories were copyrightable.\(^{11}\) Since Feist readily admitted to copying some of Rural's listings, the lower courts had little problem finding Feist liable on the basis of precedent broadly protecting those who invest time and labor in the creation of factual compilations.

The Supreme Court, however, rejected this line of lower court cases by holding that telephone white pages are not "original," and therefore not copyrightable at all. The Court noted that cases finding white pages entitled to protection were based on the "sweat of the brow"/"industrious collection" theory\(^{12}\) that rewards an author for her labor and not for her originality. After discussing the requirement of originality, the Court ruled that it was not met by showing that a great deal of labor and expense went into creating the work. Some degree of truly original expression must be present.

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\(^9\) 663 F Supp 214 (D Kan 1987).
\(^{10}\) 916 F2d 718 (10th Cir 1990).
\(^{11}\) See, for example, *Illinois Bell Tel. Co. v Haines & Co.*, 905 F2d 1081 (7th Cir 1990), vacated 111 S Ct 1408 (1991); *Hutchinson Tel. Co. v Frontier Directory Co.*, 770 F2d 128 (8th Cir 1985); *Leon v Pacific Telephone & Telegraph Co.*, 91 F2d 484 (9th Cir 1937); *Southwestern Bell Tel. Co. v Nationwide Independent Directory Service, Inc.*, 371 F Supp 900 (WD Ark 1974).
\(^{12}\) See *Jeweler's Circular Publishing Co. v Keystone Publishing Co.*, 281 F 83, 88 (2d Cir 1922) ("The right to copyright . . . does not depend upon . . . originality, either in thought or language, or anything more than industrious collection").
In the case of factual compilations, the Court stated that a modicum of originality as to selection, coordination, and arrangement would suffice to render most factual compilations copyrightable. However, the copyright so obtained would only extend to the selection, coordination, and arrangement—the facts themselves would fall in the public domain. Moreover, the Court found that alphabetized telephone white pages lacked the modicum of originality as to selection, coordination, and arrangement.

Most surprising was the Court’s willingness to rely on constitutional rather than statutory grounds. Several nonconstitutional grounds are readily available. Obviously, the decision could have relied on the originality requirement found in the Copyright Act. As several commentators and the Court have noted, the “sweat of the brow” theory is not easily teased out of the statutory language. Without even mentioning the Constitution, the Court could have given as the sole basis for decision (it did only in passing) that the telephone white pages are not “original works of authorship” in the language of the Act. Although the bottom line of such an opinion would have been the same as the one actually written—telephone white pages are wholly unprotected—Congress could have responded by amending the statute.

Alternatively, the Court could have held that the labor involved in collecting facts such as those found in telephone white pages did confer a sort of originality to the work. Such a finding of copyrightable through sweat, however, would not necessarily have resulted in a finding of copyright infringement on the facts of Feist. First, copyright law normally requires a finding of “substantial similarity” between the original and infringing works. Given that Feist’s unified directory of 47,000 names and addresses covering 11 telephone districts employed in scattered fashion only 1,309 of Rural’s listings, the Court could have held that the activity engaged in by

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13 See 17 USC § 102(a).
14 See William Patry, Copyright in Compilations of Facts (or Why the “White Pages” are not Copyrightable), 12 Comm & L 37, 43–59 (1990); L. Ray Patterson & Craig Joyce, Monopolizing the Law: The Scope of Copyright Protection for Law Reports and Statutory Compilations, 36 UCLA L Rev 719, 757–77 (1989). Both articles were relied upon by the Court in Feist.
15 17 USC §§ 101 & 102.
Feist was not actionable copying. The two works simply were not similar as a matter of law.

Third, the Court could have held that although Rural's white pages were copyrightable, Feist's independent checking of the information culled from Rural's work added enough of its own sweat to justify its "copying." Feist did not merely copy Rural's listings and print them as its own. Feist's investigators independently verified data culled from Rural's directory; as a result, Feist's listings often had the street addresses of Rural's subscribers while Rural's own listings did not. Feist worked hard and created a truly new and different work. Sanctioning its behavior by a finding of noninfringing use would arguably have advanced the statutory goal of encouraging new creations.

Finally, the Court could have resorted to the fair use doctrine. The only material Feist took from Rural's white pages were raw facts which were themselves uncopyrightable. Use of facts has traditionally been considered to be a fair use. Perhaps photocopying Rural's white pages and distributing them should be infringement (it is not under the Court's opinion as written), but merely using them as a reference work could easily suffice as fair use under section 107 of the Copyright Act.

However, rather than adopt any of these alternatives, the Court chose to rely on an interpretation of the originality requirement implicit in the Intellectual Property Clause of the Constitution. In holding that originality as a constitutional matter did not include a "sweat of the brow" component, the court harkened back over a hundred years to Burrow-Giles Lithographic Co. v Sarony and the Trade-Mark Cases. Neither decision compels (or forbids) the Court's approach in Feist. In considering the definition of "author" in the Intellectual Property Clause, the Burrow-Giles court found that copyright is meant to protect "original intellectual conceptions of the author." It held that a carefully posed and artful studio

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17 See 17 USC § 107 ("the fair use of a copyrighted work . . . is not an infringement of copyright").
18 See 17 USC § 102(b).
19 111 US 53 (1884).
20 100 US 82 (1879).
21 111 US at 58.
portrait of Oscar Wilde was original enough to be copyrighted. However, after considering the copyrightability of mere "ordinary" pictures where the photographer's art was less apparent, the Court succinctly commented, "On the question as thus stated we decide nothing." The decision therefore provided no minimum baseline for its requirement of "original intellectual conception" and clearly passed on the opportunity to declare purely mimetic works of image reproduction unoriginal and uncopyrightable.

In the Trade-Mark Cases, the Court struck down a nineteenth-century predecessor to the Lanham Trademark Act as unauthorized by either the Intellectual Property Clause or the Commerce Clause. In finding the Intellectual Property Clause an inappropriate source of congressional power, the Court held that trademarks are not works of authorship. Trademarks were not found to be independent creations, "original . . . founded in the creative powers of the mind [or] . . . the fruits of intellectual labor." This language is a bit more helpful. It at least tells us that trademarks are not original enough to merit protection under the Intellectual Property Clause.

A trademark, the Court explained, "is the adoption of something already in existence as the distinctive symbol of the party using it." Trademarks embody the goodwill of a business or product.

The ordinary trade-mark has no necessary relation to investigation or discovery. The trade-mark recognized by the common

22 The trial court had found as a matter of fact that the photo was a "useful, new, harmonious, characteristic, and graceful picture, and that plaintiff made the same . . . entirely from his own original mental conception, to which he gave visible form by posing the said Oscar Wilde in front of the camera, selecting and arranging the costume, draperies, and other various accessories in said photograph, arranging the subject so as to present graceful outlines, arranging and disposing the light and shade, suggesting and evoking the desired expression, and from such disposition, arrangement, or representation, made entirely by plaintiff, he produced the picture in suit." Id at 60.

23 Id at 59.

24 19 Stat 141 (1876).

25 15 USC §§ 1051 et seq (providing for the registration of trademarks and remedies for their infringement).

26 Remember the Intellectual Property Clause refers to advancing the useful arts by rewarding "authors."

27 100 US at 94.

28 Id. The Court seemed to have only trade symbols in mind when it discussed the originality requirement, for example, the red triangle trademark of Bass Ale, reputedly the oldest registered trademark in England. See inscription on bottle of Bass Ale on file in author's refrigerator.

29 Id.
law is generally the growth of a considerable period of use, rather than a sudden invention... [a]t common law the exclusive right to it grows out of its use, and not its mere adoption.

Since the statute only authorized the registration of common law trademarks, what it sought to protect was something that attained its value through use, not through inspiration or laborious creation. A trademark becomes valuable when connected to a product in consumers' minds. The law aimed to protect the efforts of businessmen at promoting their goods—their efforts to develop good will, not their efforts to create interesting trademarks. The law was not proposed to stimulate the creation of interesting and original marks. The overtly commercial purposes of the Trade-Mark Act were ill-fitted to the creative goals of the Intellectual Property Clause.

Unfortunately, the Court's analysis in *Feist* does little to tell us why the telephone white pages resemble common-law trademarks. Applying copyright protection to some compilations might stimulate the "investigation or discovery" of works that may be valuable in and of themselves, unlike trademarks that have no value apart from products or businesses independently developed and promoted. The *Trade-Mark Cases* do tell us that the Constitution requires originality as a prerequisite to copyright protection; however, it does little to dispel the possibility that creations owing their existence to perspiration rather than inspiration might conceivably be defined as "original" in order to advance the wealth-maximizing goals of the Intellectual Property Clause discussed below.

II. THE UNDESIRABILITY OF CONSTITUTIONALIZING THE ORIGINALITY REQUIREMENT

A. THE SPECIAL PROBLEM OF FACTUAL WORKS

Works consisting primarily of facts, such as the white pages directory at issue in *Feist*, have traditionally posed the thorniest copyright problems for the courts. Copyright law is supposed to stimulate creation, but facts are not "created." They already exist; therefore, one could conclude that primarily factual (low author-

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works should be utterly unprotected. However, what about facts that beg to be uncovered, collected, arranged, and made available to a needy public? Shouldn't the copyright system extend to provide proper incentives for their creation? The short answer is that it always has to varying degrees. The first copyright statute, enacted in 1790 by the first Congress, provided copyright protection for "any map, chart, book or books." Maps are perhaps the quintessential factual work. The closer a map depicts a precise physical reality, the better it is. Maps are protected under the current copyright statute, as are compilations of "preexisting materials."

However, works of low authorship, including maps, have received inconsistent protection from copying. Some courts, sensitive to the danger of upholding claims that would take facts and ideas from the public domain, have allowed extensive copying. Other courts, sensitive to the need to protect expenditures of resources in developing valuable works of low authorship, have extended broad protection. The result has been chaotic. Courts have privileged some directories that appropriate large amounts of data from existing directories, while condemning others. Some mapmakers have successfully based new maps directly from old ones, others have not. Moviemakers are sometimes, but not always, privileged to borrow plots and storylines from books or plays. Some sorts of information may be gleaned from published lists and tables.

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31 Professor Ginsburg has helpfully denominated primarily factual works (for example, factual compilations, maps, etc.) as those of "low authorship" and primarily fictive works (for example, novels, poetry, etc.) as those of "high authorship." I will use her terminology here. See Jane C. Ginsburg, Creation and Commercial Value: Copyright Protection for Works of Information, 90 Colum L Rev 1865, 1866 (1990).
32 Act of May 31, 1790, ch 15, §1, I Stat 124.
34 17 USC § 103.
while virtually indistinguishable information is privileged.\textsuperscript{38} Prints\textsuperscript{39} and biographies\textsuperscript{40} have suffered similar seemingly random fates.

In a recent article, Professor John Wiley proposes an imaginative explanation to illustrate this confused state of copyright jurisprudence as related to the protection of facts, ideas, and expressions. He blames the opaque state of the law on Duncan Kennedy traveling backward in time to plant the seeds of a subversive plant of copyright indeterminacy which would grow to be “discovered” by his CLS followers decades later.\textsuperscript{41} Indeed, the body of law concerning the scope of copyright protection afforded works of “low authorship” at issue in \textit{Feist} is a morass of elusive and manipulable doctrine and counterdoctrine.

Several indeterminate yet widely accepted doctrines govern disputes involving the copyrightability of materials containing primarily facts. The idea/expression and fact/expression dichotomies teach that the particular expression of ideas and facts, but not the ideas and facts themselves, are copyrightable.\textsuperscript{42} The merger doctrine tells us that when ideas or facts must inevitably be expressed in a particular manner, content and form are said to “merge” rendering the expression itself unprotected.\textsuperscript{43} As noted above, the originality requirement requires that a copyrighted work be, well, original.\textsuperscript{44} Further explanation of these governing “principles” need not be discussed in detail because they are essentially indeterminate and contentless.\textsuperscript{45} They can be defined and discussed in the ab-

\begin{itemize}
\item \textsuperscript{38} Compare \textit{Financial Information Inc. v Moody's Investors Serv.}, 808 F2d 204 (2d Cir 1986), with \textit{Eckes v Card Prices Update}, 736 F2d 859 (2d Cir 1984), and \textit{National Business Lists Inc. v Dun & Bradstreet, Inc.}, 552 F Supp 89 (ND Ill 1982).
\item \textsuperscript{39} Compare \textit{Gracen v Bradford Exchange}, 698 F2d 300 (7th Cir 1983), with \textit{Alfred Bell & Co., Ltd. v Catalda Fine Arts, Inc.}, 191 F2d 99 (2d Cir 1951).
\item \textsuperscript{40} Compare \textit{Toksvig v Bruce Publishing Co.}, 181 F2d 664 (7th Cir 1950), with \textit{Rosemont Enterprises v Random House, Inc.}, 366 F2d 303 (2d Cir 1966).
\item \textsuperscript{41} John S. Wiley Jr., \textit{Copyright at the School of Patent}, 58 U Chi L Rev 119, 126 (1991).
\item \textsuperscript{42} \textit{See Feist, 111 S Ct at 1290; United Video v FCC}, 890 F2d 1173, 1191 (DC 1989).
\item \textsuperscript{43} \textit{See Shaw v Lindheim}, 919 F2d 1353, 1360 (9th Cir 1990).
\item \textsuperscript{44} \textit{See Feist, 111 S Ct at 1294} (a work must “display some minimal level of creativity”).
\end{itemize}
tract, but they fail to generate consistent results in like cases.\textit{46} Saying that only original expressions, but never facts or ideas, are copyrightable proves to be far easier than applying the notion consistently and coherently. Although commentators and the courts generally agree that the purpose of copyright law as a whole is to establish incentives for the creation of works which because of their public goods aspects might otherwise go uncreated,\textit{47} the rules supposedly advancing that uncontroversial goal are incoherent. Interestingly, the cases themselves demonstrate a keen awareness of the haphazard nature of the results, "Obviously, no principle can be stated as to when an imitator has gone beyond copying the 'idea,' and has borrowed its 'expression.' Decisions must therefore inevitably be \textit{ad hoc}."\textit{48}

The cases undeniably fail to articulate a rationale that helps resolve the tension inherent in the controversies. The tension arises due to the dual needs to maintain public access to important facts and to stimulate the discovery and publication of those facts through the grant of exclusive rights. A broad doctrine such as the idea/expresssion dichotomy recognizes the tension, but provides no clue as to how the balance should tip in a particular case.

B. RECONSTRUCTING COPYRIGHT LAW

The problems inherent in evaluating the copyrightability of low authorship works has stimulated several interesting proposed solutions worthy of very brief summary to illustrate the unsatisfactory nature of the Court's approach in \textit{Feist}. Professor Wiley has suggested that copyright law has much to learn from patent law. He argues for a functional approach to defining the originality of and therefore the protectability of works of low authorship: "Copyright courts, then, should define as original any work whose creation requires enough effort to deter the creative act absent the copyright's exclusive promise."\textit{49} If this results in the protection of

\textit{46} See notes 35–40.


\textit{48} \textit{Peter Pan Fabrics, Inc. v Martin Weiner Corp.}, 274 F2d 487, 489 (2d Cir 1960) (Hand, J.).

works more the result of their authors' labor and research than their personalities, so be it—as long as the public receives in return a creation it otherwise would not have.

Professor Ginsburg offers the "high authorship"/"low authorship"\(^\text{50}\) distinction and argues that two different sets of rules should govern her categories. She contends that protecting low authorship works from any substantial borrowing would diminish the net information available to society, while the absence of protection for low authorship works would not provide adequate incentives for their creation. She concludes that a compulsory licensing scheme for low authorship works would create the most efficient set of incentives. Professors Patterson and Joyce disagree, believing that works of low authorship are probably overprotected. In an influential article\(^\text{51}\) criticizing the important *West Publishing*\(^\text{52}\) case, they assert that any protection afforded the pagination of West's National Reporter System volumes "turns copyright law upside down: it inhibits the promotion of learning by taking public domain materials which have no author and subjecting them to the monopoly of copyright."\(^\text{53}\)

Professor Litman is also concerned with nurturing the public domain. Like Wiley, she views the originality requirement as "an apparition [that] cannot provide a basis for deciding copyright cases."\(^\text{54}\) She argues forcefully that most works are unoriginal in any real sense. Even works of so-called "high authorship" are full of stock characters, scenes, themes, and motifs that have long been part of our rich public domain. She redefines the notion of originality to better "reserv[e] the raw material of authorship to the commons."\(^\text{55}\) On the other hand, Professors Denicola\(^\text{56}\) and Gorman\(^\text{57}\) are less concerned about the public domain and more concerned with rewarding the industrious efforts of authors who create pri--

\(^{50}\) See note 31.

\(^{51}\) See Patterson & Joyce, 36 UCLA L Rev 719 (cited in note 14). The Court's opinion in *Feist* cites the article on five occasions.

\(^{52}\) *West Publishing Co. v Mead Data Central Inc.,* 799 F2d 1219 (8th Cir 1986).

\(^{53}\) Patterson & Joyce, 36 UCLA L Rev at 810 (cited in note 14).

\(^{54}\) Litman, 39 Emory L J at 1023 (cited in note 45).

\(^{55}\) Id.

\(^{56}\) See Denicola, 81 Colum L Rev 516 (cited in note 45).

\(^{57}\) See Gorman, 76 Harv L Rev 1569 (cited in note 33).
arily factual works: histories, biographies, and news of the day, as well as maps, directories, and forms. They fear the misapplication of copyright doctrine would result in seriously diminished incentives for creation.

On the other extreme is former professor, now First Circuit Judge, Stephen Breyer.\(^8\) He is skeptical about the notion of copyright in general. He would agree with Professor Wiley that protection should be provided when it results in the creation of a work that otherwise would go uncreated. However, he is not convinced as an empirical matter that many such potential works need the prodding of the copyright monopoly.\(^9\) He occupies the far fringe of the antiprotectionist position.

Although commentators disagree on precisely how to reform copyright law, they all agree that copyright law is a complex system of incentives designed to advance knowledge and therefore the public welfare. Contrary to frequent assertions by the publishing industry, copyright is not a natural law right of the author\(^6\) — it exists as positive law “to promote the Progress of Science and useful Arts.”\(^6\) And it does so by establishing a balance between the monopoly costs of the copyright grant and the benefits of creations stimulated thereby.\(^6\) They all tend to see the balance as out of whack due the incoherence of the originality requirement and the idea/expression dichotomy. They disagree on whether the current confusion results in too little or too much protection for works of low authorship; however, the goal of reform seems to be the same: maximize public welfare through a coherent system of incentives.

This is, of course, more easily said than done. As Breyer pointed out twenty years ago, the question of the proper scope of copyright protection is primarily empirical and difficult to quantify.\(^6\) In the absence of convincing studies, it is unclear whether the courts

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\(^9\) Id at 351.

\(^6\) At least one recent commentator makes rights-based arguments, however. See Alfred C. Yen, *Restoring the Natural Law: Copyright as Labor and Possession*, 51 Ohio St L J 517 (1990).

\(^6\) US Const, Art I, § 8, cl 8.

\(^6\) The most formal presentation of the theory is found in Landes & Posner, 18 J Legal Stud at 333–44 (cited in note 47).

\(^6\) Breyer, 84 Harv L Rev at 351 (cited in note 58).
should be left to continue to forge a common law of copyright within the wide interstices of the Copyright Act or whether Congress should step in and try to legislate the efficient answer. The fact situation in *Feist* provides a good hypothetical: To what extent should telephone white pages be protected from copying? Most commentators agree that the correct answer would be: "To the extent necessary to maximize public welfare." The discussion would then center around what that answer necessitates: no protection; protection only from competing uses; protection only from substantially similar uses; protection from all uses. Of course, the lack of empirical evidence would allow for a wide diversity of opinion. Focusing on public welfare hardly guarantees correct answers in the absence of convincing empirical evidence. But it is at least the proper focus.

C. THE STRANGE ROAD TAKEN

On the surface, *Feist* recognizes the welfare goals of the Intellectual Property Clause. As she did in *Bonito Boats, Inc. v Thunder Craft Boats Inc.*, Justice O'Connor asserts the primacy of the public interest as the basis for creating rights to intellectual property. She reaffirms the notion expressed in *Wheaton v Peters* that copyright is a statutory grant of limited power, not a recognition of the natural law right of the author. This acknowledgment is crucial to any reform. In *Feist* and *Bonito Boats*, Justice O'Connor may have the Court pointed in the right direction—the public will almost certainly benefit from the copying blessed by the two cases. In fact, we may be seeing the dawning of a new era of "user's rights." However, the *Feist* decision prevents Congress from focusing directly on the public welfare question when it considers copyrights for works of low authorship formerly protected under the "sweat of the brow"/"industrious collection" doctrine.

In handcuffing Congress with a version of the originality requirement that absolutely forbids protection based on the value of an author's research or labor, the Court clearly rejected the "sweat of the brow"/"industrious collection" rationale for protection.66

65 8 Peters 591 (1834).
66 *Feist*, 111 S Ct at 1291–92.
The "sweat of the brow" doctrine had numerous flaws, the most glaring being that it extended copyright protection in a compilation beyond selection and arrangement—the compiler's original contribution—to the facts themselves . . . "[s]weat of the brow" courts thereby eschewed the most fundamental axiom of copyright law—that no one may copyright facts or ideas . . . [w]ithout a doubt, the "sweat of the brow" doctrine flouted basic copyright principles.

As stated earlier, a strong argument can be made that under the current copyright statute, the Court is correct. Section 103 states that factual compilations are copyrightable, but "factual compilation" is defined as a work "selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes an original work of authorship."6 The statute can plausibly be read to exclude completely protection of any factual information contained in a work. Whether the Constitution mandates such a result, however, is less clear.

The constitutional question can be posed by a brief examination of two appellate cases, the first of which, *Miller v Universal City Studios*, 68 the Court relied on in *Feist*. In *Miller*, the plaintiff coauthored a book with the victim of a bizarre Georgia kidnapping. After Universal, drawing heavily on the book as a reference, made a television motion picture about the crime, Miller sued for copyright infringement alleging that Universal had appropriated many of the details uncovered in his research. The Fifth Circuit reversed a jury verdict for Miller, holding that the trial court erred in instructing the jury that the Copyright Act protected Miller's research as opposed to merely its literal expression. The Fifth Circuit rejected the sweat of the brow rationale, reasoning that no amount of labor in and of itself was sufficient to confer copyright protection.

Does the Constitution mandate the same result? The Intellectual Property Clause suggests that the inquiry should center on whether providing copyright protection would advance the public welfare. In other words, would Miller have created the work in the absence of protection against the sort of behavior engaged in by Universal?

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67 17 USC § 101.
68 650 F2d 1365 (5th Cir 1981), discussed in *Feist*, 111 S Ct at 1288–89, 1291, 1295.
Let's assume the answer is yes. After all, Miller's research consisted primarily in interviewing his coauthor about her experiences—not an overly burdensome or expensive task. In addition, Universal's film did not directly compete with Miller's book. Book sales were probably not adversely affected. Although it has been argued that an author's right to produce derivative works provides a marginal creative stimulus, it would seem unlikely that Miller's book would have gone unwritten due to the fear that an unauthorized film will appear.

One can imagine, however, a case where a disincentive to borrow factual information might be necessary to stimulate creative activity. In *Toksvig v Bruce Publishing Co.*, the plaintiff traveled to Europe to collect and translate original sources relevant to her biography of the life of Hans Christian Andersen. Much of the information presented in the biography was a direct result the plaintiff's time, labor, expense, and fluency in Danish. After the plaintiff's biography was published, defendant published a biography of Andersen which drew broadly from plaintiff's work. The Seventh Circuit held that the subsequent biographer had infringed plaintiff's copyright. The facts of *Toksvig* provide a better ground upon which to argue that protection was necessary to stimulate creation.

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69 And let's also assume, as the framers of the Constitution apparently did, that encouraging authors to create artistic works tends to advance the public welfare. In other words, we assume that Miller would not have discovered a cure for cancer had he not been writing his book. Technically, the public welfare should be measured by taking the difference between the social utility of the authored work and the social utility of the other opportunities of the author. In other words, a work should be copyrightable only if necessary to encourage the work and the work is more socially useful than whatever else the writer would choose to do, for example, child rearing or brickmasonry. Unfortunately, the ramifications of this insight into the marginal utility of creativity in the copyright context have never been fully explored and will not be so here. Cf. Richard A. Posner, *Economic Analysis of Law* 37 (3d ed 1986) (noting in the patent context that "the costs of the patent system include... inducing potentially excessive investment in inventing"); Janusz A. Ordover, *Economic Foundations and Considerations in Protecting Industrial and Intellectual Property*, 53 Antitrust L J 503, 507 (1984) (patent law "may lead to excessive investment in the creation of intellectual and industrial property").

70 The movie even may have stimulated sales to those wanting to learn more about the crime. Of course, others, having seen the movie, may not have wanted to buy the book.


72 181 F2d 664 (7th Cir 1950).

73 As any person fluent in a foreign language can attest, language acquisition represents a substantial investment in resources. Of course, writing the biography was not the plaintiff's sole motivation for learning Danish.
The plaintiff may very well have eschewed the travel, time, expense, and labor involved in researching the book in the absence of the certain ability to reap the full profit of her labor. Affording protection to the sort of research engaged in by Toksvig may very well increase public welfare.

The Toksvig argument, however, is difficult to make on the facts of Feist. A Kansas statute mandated that Rural publish its directory. In addition, it distributed its directory for free. The argument that Rural needed a copyright monopoly to stimulate the creation of its directory is almost impossible to make.

Note we have discussed whether Miller, Toksvig, and Feist are consistent with the constitutional mandate “to promote the Progress of Science and useful Arts” without mentioning the originality requirement or the idea/expression dichotomy. They seem irrelevant when conducting a direct inquiry into whether protecting a particular type of work from a particular type of borrowing is necessary to promote the public welfare. Unfortunately, Feist frustrates Congress from conducting this direct inquiry regarding “unoriginal works.”

Under the Intellectual Property Clause, Congress is charged to increase public welfare by providing incentives for creation. Congress might do this in several ways respecting low authorship works. It might find that: (1) low authorship works in general require strong incentives for creation and provide broad protection to labor and research; (2) only certain types of very labor-intensive and expensive-to-produce works of low authorship require the incentive of copyright protection; (3) virtually no protection should be afforded to labor and research because the cost of such protection is simply too high; or (4) general guidelines suffice and the courts should be left to establish the proper balance of incentives on a case by case basis. According to the Feist, the current copyright statute should most closely embody option 3.

As long as Congress is seeking to realize the constitutional mandate to promote public welfare, then the choice of any of these four options should be constitutional. The Constitution gives Congress the job of initially performing the cost-benefit analysis inherent in copyright law. Traditionally, congressional fact-finding is accorded great weight. Congress may or may not succeed in providing an efficient set of incentives, but in the absence of strong empirical data to the contrary, who can say it will not? Tinkering
The primary vice of *Feist* is that it locks Congress into option 3. The Court could not have made it clearer that the Constitution forbids protection of labor, research, or industrious collection: in simple terms, “sweat.” Even if Congress identifies works which would not be created but for the grant of copyright protection, Congress may not protect them. If Congress determines option 1, 2, or 4 above would maximize the public welfare, Congress may not act. Rather than permitting Congress to scrutinize the market and establish protection for works that merit stimulation, the Court cordoned off a forbidden zone. Looking at the facts of *Feist* illustrates the point. Although probably unlikely, assume that after the *Feist* decision some telephone companies stopped producing white pages directories, and other parties did not fill the void by producing their own white pages and selling them because such works were utterly unprotected. Consistent with its constitutional mandate, Congress might decide to amend the copyright statute to stimulate the creation of what is clearly a valuable resource. The Court’s finding of a constitutional prohibition in *Feist*, as opposed to a statutory prohibition, would prevent Congress from doing precisely that.

One can find some solace in the fact that many white pages directories are required by state statute to be produced and distributed, but many other sorts of valuable low authorship works may require the carrot of the copyright monopoly. Protecting labor and sweat requires the protection of facts and information to a certain degree. The best way to protect the research and labor of Ms. Toksvig may be to protect some biographic material that is entirely factual. Sometimes the only way to stimulate investments in labor and research may be to provide limited protection to the facts and information thereby produced. The fair use doctrine traditionally has provided appropriate limitations to avoid the impoverishment of the public domain.

Would providing protection to the primarily factual fruits of industrious labor generate wealth or impoverish the public domain? Who knows? The salient point is that the debate ended prematurely. Congress is stymied and may not provide any such protection even if it has irrefutable evidence that “the Sciences and useful Arts” would be promoted. In addition, the courts are saddled with
a definition of originality that seems only negative in conception. All we know is that sweat and labor do not confer it.

III. The Post-Feist Terrain

Not all low authorship works are endangered by Feist. Although facts themselves are never protected, an original selection, coordination, and arrangement of facts can still be copyrighted. Presumably, the decision in a case like Adventures in Good Eating v Best Places to Eat74 is still good law. In Good Eating, the plaintiff had prepared a list of restaurants from around the country. He selected a discrete group out of the hundreds of thousands available and provided information on location, menu items, and prices. Such a work easily demonstrates the modicum of originality as to selection, coordination, and arrangement demanded by Feist. Other more formulaic works, however, may be in trouble. In the first appellate decision published after Feist, the Second Circuit held that a newsletter organizing facts from horse racing results relevant to the selection of winning numbers in illegal lottery operations was not entitled to copyright protection. It noted that all other publishers of such charts used the same format, describing them as "purely functional grids that offer no opportunity for variation."75 Although the plaintiff "engaged in a certain degree of labor to compile his charts, his labor [was] irrelevant to the central question of whether his work displayed some modicum of originality entitling it to copyright protection."76 Obviously, Feist will have an impact on other works of low authorship as well.

A. Law Reports

The Eight Circuit's decision in West Publishing Co. v Mead Data Central, Inc.77 is almost certainly a casualty of Feist. In West, the court held that Mead Data's Lexis computerized legal research service could not reference page numbers contained in volumes of West reporters, other than the first page of a case.78 In other words,

74 131 F2d 809 (7th Cir 1942).
76 Id at 674.
77 799 F2d 1219 (8th Cir 1986).
78 West did not seek to protect the numbers of the initial page of cases it publishes.
Lexis could not provide "pinpoint" or "jump-cites" to cases published by West without its permission. Although the cases themselves are not copyrightable, the Eight Circuit enjoined Mead Data's jump-cite service on the basis that it infringed West's copyright in the arrangement of its cases. The case was vigorously attacked in an article which apparently impressed the Feist Court.

Is there anything original about labeling consecutively the pages of the Feist opinion in volume 111 of the Supreme Court Reporter from 1282 through 1297? Certainly no more than choosing to follow "Anne Zwerling" by "Mark Zwolak" in my local telephone white pages. Perhaps West's arrangement of cases in F2d is copyrightable, but that should only prevent Mead Data from putting out competing reporter volumes with the same arrangement. Its mere lifting of the fact that a particular set of words rests on a particular page of a West reporter clearly would seem to be privileged by Feist. Mead borrowed numbers that are ordered in West's volumes from smallest to largest. Given the Court's finding that alphabetical arrangement is unprotected, it is hard to see how the Eighth Circuit's protection of numeric arrangement can survive Feist.

B. THE YELLOW PAGES

Telephone directory yellow pages present a slightly different problem than the white pages. They are not merely alphabetized listings of all the businesses in a particular area. The yellow pages typically contain advertisements, artwork of various sorts, and other material arranged alphabetically along with phone numbers and addresses within particular subject headings. Obviously, a greater opportunity for original selection, arrangement, and coordination exists. Most yellow pages would seem to be copyrightable.

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79 See Wheaton v Peters, 8 Peters 591 (1834).
80 799 F2d at 1224. Mead has since agreed to pay West tens of millions of dollars to obtain a license. See Patterson & Joyce, 36 UCLA L Rev at 722 n 6 and accompanying text (cited in note 14).
81 See Patterson & Joyce, 36 UCLA L Rev 719 (cited in note 14).
82 Athens, Georgia, Phone Directory at 156 (BellSouth 1990).
83 Federal Reporter (Second) volumes are arranged in roughly chronological order. But see Boeing v United States, 650 F2d 493 (8th Cir June 17, 1981), which is in between NLRB v Kiwas Island Co., Ltd, 650 F2d 485 (4th Cir May 27, 1981), and Federal Leasing, Inc. v Underwriters at Lloyd's, 650 F2d 495 (4th Cir June 2, 1981).
However, under *Feist*, copyrightability does not mean full protection under all circumstances. The Court made it clear that only selection, arrangement, and coordination are protectable. For example, although BellSouth's Athens, Georgia, yellow pages are copyrightable, the facts contained therein can be used for any purpose. Since “[t]he originality requirement ‘rule[s] out protecting . . . names, addresses, and telephone numbers,’” only a reproduction of original elements of yellow pages formatting is prohibited.  

Several courts have held that a directory publisher may not use the listings contained in an existing yellow pages to produce a competing product. This conclusion now seems highly questionable. Under *Feist*, names and addresses are not copyrightable, so any competitor can feel free to use an existing yellow pages to compile a list of potential advertisers in its own yellow pages. A slightly more difficult question involves whether the competing yellow pages can utilize the same subject headings as the existing directory. Through the work of the National Yellow Pages Service Organization, virtually all yellow pages in the United States adhere to a standardized format. Therefore, the standard format is unprotectable as a practice “firmly rooted in tradition and so commonplace that it has come to be expected as a matter of course.” 

A final sticking point may arise when a business wishes to use the same advertisement in both yellow pages. Must the producer of the competing yellow pages demand that its customers invent new advertisements for its directory? The answer is probably “no,” given that the copyright to the advertisement belongs to the business and not the producer of the first yellow pages. Contrary to prior lower court precedent, *Feist* clearly sanctions the production of competing yellow pages as long as the second-comer's product does not substantially reproduce the individual page-by-page arrangements of materials found in the first (something only likely to result from photocopying).

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84 See *Feist*, 111 S Ct at 1296, citing Patterson & Joyce, 36 UCLA L Rev at 776 (cited in note 14).


86 *Feist*, 111 S Ct at 1297.

87 See 17 USC § 201(b).
C. MAPS

The most troubling victim of the *Feist* opinion may be the map-making industry. Cartographers typically expend painstaking time, energy, and expense in making accurate representations of parcels of terrain. When their surveys are finished, their ability to recoup their investment is enhanced by the power to exclude unauthorized copying. However, this merely suggests that we might increase public welfare by affording copyright protection to maps; it does not tell us that a map is original under *Feist*.

Unfortunately for modern-day Amerigo Vespuccis, the map is one of the least original works protected by pre-*Feist* copyright law. Although a great deal of expense, labor, and sweat go into creating a map, a good map is usually not original. Its subject matter is certainly not a creation of its author, and its formatting is usually dictated by standard mapmaking conventions. One can imagine maps that might be original; for example, the famous humorous rendition of the map of the world as seen by New Yorkers, consisting 90 percent of oversized images of New York City with tiny figures labeled "Texas" and "Pacific Ocean" in the far background. Or perhaps a map that listed streets as "Puddings" and schools as "Grapefruit" might be original. Maybe the choice to include certain street names or use a particular scale or typeface might consist of a sort of originality as to selection. But once selection is made, arrangement and coordination are completely dictated by physical reality.

The most endangered map is probably the most useful: the technical survey plat. These maps are carefully produced in a standardized manner sometimes dictated by law. Before *Feist*, the Seventh Circuit recently confirmed the copyrightability of plat maps. That decision may also be on our endangered list, although it hardly seems conceivable that the Court would completely deny protection to a type of work mentioned specifically by Congress in 1790 as being one of the three objects of the first copyright act. In fact, given the presence of some of the framers of the Constitution in that first Congress, the conclusions reached in *Feist* regarding the availability of sweat-based copyright protection seem even more suspect.

88 See, for example, OCGA § 15-6-67 (1990).
D. NEW USES FOR EXISTING DATA

Given that *Feist* protects only the selection, arrangement, and coordination of low authorship works, it seems generally to authorize the incorporation of existing data in dissimilar works. For example, in *National Business Lists, Inc. v Dun & Bradstreet, Inc.* 90 ("NBL") the court enjoined a creator of business mailing lists from using information copied from Dun & Bradstreet credit reports. The information taken from Dun & Bradstreet was entirely factual. The mailing list compiler did not produce competing business credit reports—it created a different product with a different purpose. When factual information is used to create a work that lacks substantial similarity to a prior work, then the selection, arrangement, and coordination have not been copied. In a case like *NBL*, *Feist* would seem to permit the copying because "[t]he originality requirement 'rule[s] out protecting . . . names, addresses, and telephone numbers of which the plaintiff by no stretch of the imagination could be called the author.'" 91

E. LIVE BROADCASTS

One of the most surprising casualties of *Feist* may by the copyright currently afforded certain live television and radio broadcasts. Under sections 101 and 102 of the Copyright Act, broadcasters of live events on television and radio receive a copyright on the broadcast that permits them to prevent unauthorized taping, simultaneous broadcasting, or taped rebroadcasting of the event. For example, the Seventh Circuit has held that Major League Baseball owns the copyright to broadcasts of professional baseball games. 92 This is somewhat curious given that the games themselves (as opposed to the broadcasts) are clearly not copyrightable, not because they are not original, but because they are not authored. 93 A contrast with ballet is instructive on this point. A ballet is scripted before it is performed—the movements of the dancers are planned in

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90 552 F Supp 89 (ND Ill 1982).
91 *Feist*, 111 S Ct at 1296, quoting Patterson & Joyce, 36 UCLA L Rev at 776 (cited in note 14).
92 *Baltimore Orioles, Inc. v Major League Baseball Players Assoc.*, 805 F2d 663 (7th Cir 1986).
advance\textsuperscript{94} and painstakingly rehearsed. A choreographer may therefore obtain a copyright in an original work of dance.\textsuperscript{95} It is truly a work of authorship as demanded by the Intellectual Property Clause.

Consider, however, a typical baseball game. No one knows what will happen next. No single author or group of authors is orchestrating, planning, or scripting the game. It may be original, but it is not authored. Something different happens every game. Will the pitcher strike out the lead-off hitter or will the batter hit a home run? How many pitches will he foul off? If he gets a base hit, will he steal a base? Given the proper conditions, a baseball game is not unlike a thunderstorm: it just happens. Therefore, both events are uncopyrightable. Under the current statute, however, the electronic broadcasts of both a baseball game and a thunderstorm are copyrightable merely by the fact of their transmission over the airwaves. The legislative history indicates that Congress thought that some broadcasting was original enough to confer copyright protection even when the underlying work was uncopyrightable due to lack of authorship:\textsuperscript{96}

When a football game is being covered by four television cameras, with a director guiding the activities of the four cameramen and choosing which of their electronic images are sent to the public and in which order, there is no doubt that what the cameramen and the director are doing constitutes authorship.

This rationale seems to comport with \textit{Feist}'s emphasis on originality in selection, arrangement, and coordination when the underlying materials are uncopyrightable works. Although the underlying game is uncopyrightable (as are facts in compilations), some elements of the broadcast may be sufficiently original to merit a copyright.

This rationale explains why the broadcasting of an entire game may well pass constitutional muster, but at the same time it casts doubt on whether bits and pieces of games, like individual facts in a compilation, are protected. The originality requirement of \textit{Feist} may well provide for more leeway in the borrowing of unoriginal

\textsuperscript{94} I suppose with the exception of some totally freeform modern dancing.

\textsuperscript{95} See \textit{Horgan v Macmillan, Inc.} 621 F Supp 1169 (SDNY 1985) (George Balanchine production of "The Nutcracker" copyrightable).

\textsuperscript{96} HR Rep No 94-781 at 52, 98th Cong, 2d Sess (1981).
individual clips of athletic performance without the broadcaster's permission—for example, a clip of Nolan Ryan striking out his 4,000 batter taken entirely from the standard behind-the-plate camera location. Much more seriously endangered are cases affording broad protection to television news broadcasts.\(^9\)

Take, for example, typical nightly newsfare: a live speech by a candidate for political office. Normally there will be no coordination of cameras, no real choices as to where to point the camera, no arrangement of images to consider. The task of the cameraman is to stand in the back of the room and transmit images. The event is purely factual; therefore, under \textit{Feist}, only originality as to selection, coordination, and arrangement of the broadcast speech is entitled to protection. Many televised speeches and interviews presumably lack the requisite originality. Unlike broadcasts of some athletic events, the goal of a televised speech or interview is not originality, but mere transmission of facts. This is not to say that television stations should not be rewarded for the enormous effort and expense entailed in broadcasting the news. This section simply notes that \textit{Feist} makes it clear that originality and not effort is the constitutional prerequisite for protection.

In rejecting the sweat of the brow doctrine, the Court noted its historical refusal to allow the news of the day to be copyrighted.\(^8\) This suggests a hostility to the notion that standard and pedestrian broadcasting of a speech or interview should be protected absent the sort of originality as to selection, arrangement, and coordination described above in reference to the filming of some sporting events. Originality must be the public’s reward when protection renders news of the day less available. Surely, some live news broadcasting meets the low threshold established by the Court. Equally surely much does not. The sort of protection afforded any broadcast of television news interviews and speeches by the Eleventh Circuit in \textit{Pacific and Southern Co. v Duncan}\(^9\) certainly is overbroad.

\(^9\) See \textit{Pacific and Southern Co., Inc. v Duncan}, 792 F2d 1013 (11th Cir 1986) (affirming permanent injunction against the taping of WXIA newscasts).

\(^8\) 111 S Ct at 1292, citing \textit{International News Serv. v Associated Press}, 248 US 215, 234 (1918). Ironically, the Court in \textit{INS} did provide limited protection to news of the day by finding a proprietary interest worthy of short-term protection under pre-Erie federal law of unfair competition.

\(^9\) 792 F2d 1013 (11th Cir 1986).

In *Pacific and Southern*, the court affirmed an injunction against a service that copied news broadcasts and sold tapes to the subjects of the broadcasts. It held, “Television interviews with or speeches by public officials, for example, seem to us . . . likely to qualify as the work of WXIA staff—who make audio, filming and editing choices in the presentation of this material.”\(^1\) Although the court’s focus on “choices” seems well placed, it granted complete protection to all past and future news broadcasts without regard to the “choices” it thought the station would make (analyzing past broadcasts would have been impossible because the plaintiff television station routinely destroyed all its tapes within seven days after they were made). The court’s permanent injunction as to future copying can only be read to establish a per se copyright to WXIA’s broadcasts without proof of originality.

F. COMPUTER PROGRAMS

*Feist’s* implications for the computer industry are largely beyond the scope of this article. However, the decision does add some ammunition to those who attack the copyrightability of screen displays that are dictated primarily by function.\(^2\) The alphabetical listing of the telephone white pages in *Feist* was unoriginal in large part because it was “practically inevitable.”\(^3\) This same argument against the protection of computer screen displays has arisen in cases such as *Lotus Development Corp. v Paperback Software Intern.*\(^4\) The content of many screen displays is dictated by function rather than the imagination of the programmer. *Feist* suggests that whenever the choices made by a programmer are “inevitable,” the constitutionally required modicum of originality may very well be absent.

Although the impact of *Feist* is difficult to predict, case law protecting law report pagination, telephone yellow pages, and existing data from new uses appears to be jeopardized. Broadcasters and computer programmers may also find that standard, routine, or

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\(^1\) Id at 1014 n. 1.
\(^3\) 111 S Ct at 1297.
\(^4\) 740 F Supp 37 (D Mass 1990).
inevitable aspects of their works have entered the public domain. In theory, the most endangered class of creations should be maps; however, it would be surprising to find courts stripping protection away from one of the recipients of the original 1790 copyright grant. Finally, even when works of low authorship are entitled to a copyright, the protection extends only to selection, arrangement, and coordination. This narrow scope of protection may often prevent little more than photocopying or verbatim transcription.

IV. ALTERNATIVES OPEN TO CONGRESS

Although *Feist* constitutionalizes the originality requirement, Congress may have several options if it finds *Feist*’s regime overly restrictive.

A. COMMERCE CLAUSE

The opinion in *Feist* makes it clear that the Intellectual Property Clause does not authorize Congress to protect works of low authorship under a sweat of the brow rationale. Whether the opinion prevents Congress from providing protection under its general power to regulate interstate commerce104 is a difficult question. Representatives of the publishing industry have urged Congress to overrule *Feist* before its own ink dried. If Congress chooses to respond, it could attempt to negate *Feist* on its facts by passing a law forbidding the copying of telephone white pages, or it could enact a broader unfair competition statute prohibiting the copying of any “industrious collection.”

No cases have expressly held that Congress can resort to the Commerce Clause to evade limitations present in the Intellectual Property Clause.105 Such a question would have presented itself in another context, if, for example, Congress had ever attempted to use the Commerce Clause to justify the grant of an eternal patent. The Intellectual Property Clause authorizes Congress to promote science by granting monopoly rights to inventors “for limited times.” A law granting an eternal patent would clearly contravene

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104 US Const Art 1, § 8, cl 3.
105 See 1 Nimmer § 1.09 at 1-60 (cited in note 5) (“no judicial or legislative authority exists for this proposition”).
the express language of the clause. According to *Feist*, a law protecting the white pages or any other "unoriginal" writings would directly contravene the implicit language of the clause.

This interpretation suggests that section 8 of Article I does more than grant Congress a laundry list of powers—it also places substantive limitations on Congress. This interpretation is plausible on the face of section 8, which contains several other express limitations on the federal legislative power. For example, the first clause of section 8 grants Congress the power to levy taxes, but requires that "all Duties, Imposts and Excises shall be uniform throughout the United States." Clause 4 establishes congressional power to enact bankruptcy laws, provided they are "uniform." Clause 12 authorizes Congress to raise armies, but provides that "no appropriation of Money to that Use shall be for a longer Term than two years." Similarly, clause 17 provides for the creation of the District of Columbia in a size "not exceeding ten Miles square." Such limitations on Article I power recently were illustrated—at least nominally—by the Court's decision in *Railway Executors Ass'n v Gibbons*,106 holding that the substantive limitation against nonuniform bankruptcy laws could not be overridden under the general commerce power.

We should recognize, however, that the limitations in clauses 1, 12, and 17 seem further removed from the Commerce Clause than the Intellectual Property or Bankruptcy Clauses. Although we might imagine Congress enacting legislation providing for nonuniform duties and taxes in order to regulate interstate commerce in some way (thereby conflicting with clause 1) or annexing an extra square mile of Maryland in order to build a new headquarters for the ICC (thereby conflicting with clause 17), an attempt to protect the telephone white pages is arguably closer to the core of the commerce power. Congress' bankruptcy power contained in clause 4 similarly seems to overlap its power to regulate commerce. Not surprisingly, then, the interrelation of the Bankruptcy and Commerce Clauses canvassed by the Court in *Gibbons* provides clear guidance in evaluating the Intellectual Property Clause/Commerce Clause conflict that would arise from the enactment of a statute purporting to override *Feist*. The Intellectual Property/Commerce

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Clause problem, however, was partially addressed by the Court in the Trade-Mark Cases,\(^{107}\) where we should first turn.

In 1870, Congress passed the first law providing for the federal registration of trademarks. Although the law purported to find its basis in the Intellectual Property Clause,\(^{108}\) the Court held that the clause did not authorize the statute. In response to the argument that the Commerce Clause could serve as an alternative basis for the legislation, the Court found fault with the wording of the statute which was interpreted to provide for registration of trademarks whose use was wholly intrastate. However, the Court strongly suggested that the Commerce Clause could properly authorize the registration of marks used in interstate commerce.\(^ {109}\) Because of this suggestion, the case arguably stands for the broad proposition that Congress may do under the Commerce Clause what it may not do under the Intellectual Property Clause.

Because such a reading of the case would nullify the substantive limitations contained in the Intellectual Property Clause, closer reading of the decision is warranted. Of particular importance is why a statute providing for the federal registration of trademarks failed as a matter of Congress' power to grant copyrights. As discussed earlier,\(^ {110}\) the Court in the Trade-Mark Cases adhered to traditional notions of what constitutes a trademark. Under the traditional view, a trademark does nothing more than embody the good will of a business: "Good will and its symbol, a trademark, are inseparable. A trademark has no independent significance apart from the good will it symbolizes. If there is no business and no good will, a trademark symbolizes nothing."\(^ {111}\) This understanding

\(^{107}\) 100 US 82 (1879).

\(^{108}\) Id at 92. See 16 Stat 198 (1870) ("An act to revise, consolidate, and amend the statutes relating to patents and copyrights.").

\(^{109}\) Id at 95–99. Of course, the Lanham Act, 15 USC §§ 1051 et seq., which currently provides for the federal registration, is based on the Commerce Clause. See, for example, J. Thomas McCarthy, 2 Trademarks and Unfair Competition § 25:15 at 270 (1984); Purolator, Inc. v Efra Dist., 687 F2d 554 (1st Cir 1982). The Court has never directly confronted the constitutionality of the Lanham Act, but it has presumed it in a number of recent cases. See San Francisco Arts & Athletics Inc. v United States Olympic Committee, 483 US 522 (1987); Park 'N Fly, Inc. v Dollar Park & Fly, Inc., 469 US 189 (1985). It cannot be seriously doubted that the commerce power extends to the protection of trademarks.

\(^{110}\) See text accompanying notes 24–29 above.

\(^{111}\) McCarthy, 1 Trademarks § 2.8 at 76 (cited in note 109). See also Comment, Money Damages and Corrective Advertising: An Economic Analysis, 55 U Chi L Rev 629, 642–58 (1988) (discussing the economic value of good will and function of trademarks); Trade-Mark Cases,
of the function of trademark law explains the Court's holding that a trademark cannot be "original." In layman's terms, a trademark often is original. Many trademarks are new and different—the result of hours of creative labor. However, according to the Court, the value of a trademark is a result of its use and not its design. Even if a trademark is attractive and artistic, its merit cannot be separated from consumer perceptions of the business or product it serves to identify. The purpose of trademark law is to protect the integrity of that perception by preventing confusing uses of similar trademarks.

Imagine "Mona Lisa" beer, the product of a micro-brewery that utilizes a picture of the Mona Lisa as its trademark. Under the Trade-Mark Cases, Congress may find in the Intellectual Property Clause the power to grant Da Vinci (if he were still alive) a copyright for his painting. Congress clearly advances the arts by providing such protection. However, if Congress provides protection for the use of the Mona Lisa as a trademark on a bottle of beer, it is advancing a different interest. Federal registration of the Mona Lisa beer trademark will help protect the trademark owner and consumers from competitors wishing to capitalize on the Mona Lisa Company's good will by selling an inferior product under the Mona Lisa label. Trademark law protects the ability of a consumer to identify products and also provides incentives for the creation of higher quality products.112 Although trademark law, like copyright and patent, is concerned with economic efficiency and the creation of wealth, it does not accomplish its goals by advancing "Science and Useful Arts." Therefore, the Intellectual Property Clause does not authorize the protection of a trademark no matter how new, different, elaborate, or artistic it may be. When the Court said a trademark is not "original," therefore, it meant that the values protected by trademark law are not "the fruits of intellectual labor... depending upon novelty, invention, discovery, or any work of the brain."113 Trademark law does not protect creativity per se, but

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100 US at 93–94. For the minority contrary position, see Frank Schecter, The Rational Basis for Trademark Protection (1927) (some trademarks may be so distinctive that they are valuable even before they are used and good will can attach). Cf Miskawaka Rubber & Woolen Mfg. Co. v S. S. Kresge Co., 316 US 203 (1942) (discussing the psychological attraction of some distinctive marks).

112 Why incur the increased cost of creating a high quality product if the competition can produce an inferior version and attract consumers by using the same trademark?

113 100 US at 94.
rather consumer perceptions and quality incentives. Since creativity is at the heart of copyright protection, trademark protection rightfully falls outside its ambit.

The crucial question, however, is whether the Intellectual Property Clause contains an express limitation on the protection of trademarks that should prevent their protection under the Commerce Clause. Such a limitation is difficult to find. As noted above, the Intellectual Property Clause authorizes Congress to "promote the Progress of Science and useful Arts" by granting limited and exclusive rights to creators. Given the Court's understanding of trademark law, the limitations inherent in that authorization seem inapposite. Trademark law does not hinder the progress of the Arts and Sciences, nor does it grant rights to authors. It merely protects convenient source identification devices, as evidenced by the fact that nonconfusing uses of another's trademark are not actionable under federal law. Use of the Commerce Clause to authorize the protection of trademarks would not seem to conflict with the language, goals, or purpose of the Intellectual Property Clause.\footnote{\textsuperscript{114}}

Legislation protecting telephone white pages or other works of low authorship under the Commerce Clause poses more serious difficulties because the Court made it clear in \textit{Feist} that such protection would directly conflict with the purpose of the Intellectual Property Clause. According to the Court, the clause not only tells us what may be protected, but what must remain in the public domain. The progress of the arts and sciences would be impeded if a healthy public domain were not maintained. The primary inhabitants of that domain are facts and ideas that may be copied at will. This result is neither unfair nor unfortunate—it is the means by which copyright advances the progress of science and art.\footnote{\textsuperscript{115}} To that end, the Court labels as a "constitutional requirement" that "much of the fruit of the compiler's labor may be used by others without compensation."\footnote{\textsuperscript{116}} The Court sees, although perhaps incorrectly, that the protection of works such as the white pages would

\textsuperscript{114} This formulation sounds a bit like preemption analysis. In a sense, the Constitution limits (preempts) congressional action in the same way that congressional action can preempt state action. There is a presumption against both sorts of limitations, and the key is finding a frustration of purpose or a direct conflict in goals.

\textsuperscript{115} 111 S Ct at 1289–90.

\textsuperscript{116} Id.
frustrate the goals of the Intellectual Property Clause by diminishing the raw materials available for others' creations.

Given the Court's recognition of the danger of protection, it seems unlikely it would permit its perception of the framer's vision of the public domain to be circumvented. Unlike trademark law, a statute providing protection for industrious collections that flunk *Feist*'s originality test would seem to run directly counter to the goals of the Intellectual Property Clause as defined by the Court.

Some support for this proposition may be gleaned from a surprising source, the Bankruptcy Clause. In 1980, Congress attempted to protect the employees of the bankrupt Rock Island railroad by authorizing payments to them out of the railroad's estate in bankruptcy. Since the law applied only to the Rock Island estate, and not to other railroad bankruptcies, it was not "uniform" as mandated by the Bankruptcy Clause. In *Railway Labor Executors Assn v Gibbons*, the Court considered whether Congress could enact this nonuniform bankruptcy legislation under the Commerce Clause. A unanimous Court answered negatively: "if we were to hold that Congress had the power to enact non-uniform bankruptcy laws pursuant to the Commerce Clause, we would eradicate from the Constitution a limitation on the power of Congress to enact bankruptcy laws."  

In *Feist* the Court similarly held that the originality requirement was a limitation on Congress' power to enact copyright legislation. *Gibbons* provides strong support for the proposition that Congress may not circumvent that limitation through the Commerce Clause despite the implications of the *Trade-Mark Cases* discussed above. The same rationale that prevents Congress from enacting nonuniform bankruptcy laws should prevent it from enacting laws protecting unoriginal creations.

The history of the Intellectual Property Clause sheds additional light on the propriety of the Court's insistence that it functions as not only a grant of power but a strong substantive limitation. The language of the clause is almost certainly borrowed from the Statute of Anne,* which was enacted in response to problems which

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118 *Gibbons*, 455 US at 468-69.

arose during the pendency of the copyright monopoly enjoyed by
the London Stationer's Company. The Stationer's copyright "was
used as an instrument of both monopoly and press control until
the last of the English censorship acts."\textsuperscript{120} The Statute of Anne
"was designed to ensure that the statutory copyright would be used
for neither purpose."\textsuperscript{121} The Statute of Anne led to the end of
the Stationer's monopoly, helped increase the public domain, and
enhanced the free flow of information.

This lesson was not lost on the framers of the Constitution. They
worded the Intellectual Property Clause to prevent abuses like
those perpetrated when the Stationer's Company exercised com-
plete control over publishing in England. According to the clause,
only authors may be granted a copyright, only for a limited time,
and only for original works. Most importantly, the copyright law
should promote the progress of science, which in the eighteenth
century sense meant "knowledge."\textsuperscript{122} This progress is meant to
benefit the public as a whole, and the Court has often spoken in
economic terms to describe the benefit: "The economic philosophy
behind the clause empowering Congress to grant patents and copy-
rights is the conviction that encouragement of individual effort by
personal gain is the best way to advance public welfare."\textsuperscript{123} The
rationale for copyright protection fails without "public access to
the products of [authors'] genius."\textsuperscript{124} Public access "is the means
by which copyright advances the progress of science and art."\textsuperscript{125}

Therefore, the clause can properly be seen to tie Congress' hands
to a certain extent. The systematic grant of monopoly rights should
be designed to ensure the public welfare, not profit the few at the
expense of the many. History indicates that any use of the Com-
merce Clause to subvert that end should be rebuffed. This is not
to say that the Court is correct in its assertion that the sweat of the
brow rationale inevitably diminishes public wealth. Strong argu-
ments can be made that the Court has made a grave mistake in
holding the rationale unconstitutional. However, once the Court

\begin{itemize}
\item \textsuperscript{120} Patterson & Joyce, 36 UCLA L Rev at 785 (cited in note 14).
\item \textsuperscript{121} Id.
\item \textsuperscript{122} See Ginsburg, 90 Colum L Rev at 1876 (cited in note 31).
\item \textsuperscript{123} \textit{Mazer v Stein}, 347 US 201, 219 (1954).
\item \textsuperscript{124} \textit{Sony Corp. v Universal Studios, Inc.}, 464 US 417, 429 (1984).
\item \textsuperscript{125} \textit{Feist}, 111 S Ct at 1290.
\end{itemize}
finds that the Intellectual Property Clause forbids the protection of works under a sweat of the brow rationale, Congress cannot avoid the holding by resorting to the Commerce Clause. History demonstrates that Congress does not have carte blanche—in order to promote the public welfare, the Intellectual Property Clause tells Congress what it may not do.

B. DIRECT SUBSIDIES

In New Energy Co. of Indiana v Limbach, the Court considered an incentive taxation scheme enacted by Indiana to encourage its budding ethanol industry, and struck down the Indiana law as discriminating against interstate commerce in violation of the Commerce Clause. However, Justice Scalia, writing for the majority, noted that direct subsidies of the state’s ethanol producers would not be unconstitutional. Although Limbach deals with the question of what states may do under the Constitution, its reasoning may be applicable to how Congress can respond to Feist. Rather than enacting a potentially unconstitutional statute granting monopoly rights to producers of telephone white pages, Congress might choose to subsidize their production if it determined such a subsidy would be necessary to ensure their continued existence. Given that many telephone companies are required by state law to compile and publish alphabetical lists of their subscribers, such a subsidy program would not seem necessary in the case of telephone white pages. However, it might be necessary to ensure the production of other valuable works of low authorship.

The suggestion—that subsidizing works ineligible for copyright protection would be constitutional—may seem somewhat paradoxical. However, the Court has never taken an active role in policing congressional action taken under the spending clause. Congress subsidizes numerous sorts of production through its power of the purse. The Intellectual Property Clause should only be implicated when Congress acts through the grant of monopoly power.

C. CIRCUMVENTION OF FEIST BY THE STATES

Although Congress is powerless to protect “unoriginal” works, the possibility of a response to Feist by the states remains. Since

the limitations present in the Intellectual Property Clause are found in the enumeration of powers of the federal Congress in Article I, the states could plausibly argue that they are free to provide a different scope of protection for "unoriginal" works. This issue, however, is unlikely ever to arise. Since the Copyright Act itself contains an originality requirement, under *Bonito Boats, Inc. v Thunder Craft Boats, Inc.* any state law protecting unoriginal creations would be preempted as conflicting with the goals and purposes of the Act's originality requirement. In *Bonito Boats*, the Court struck down a Florida statute prohibiting the duplication of boat hulls by any direct molding process. The Florida statute frustrated the purpose of federal patent law because it provided protection without requiring satisfaction of any of the qualitative criteria (novelty, nonobviousness, or usefulness) present in the patent law. Similarly, a state law protecting unoriginal creations would run afoul of the originality criteria contained in the Copyright Act.

This analysis, however, does not apply to all types of creations, only those categorized in sections 102 and 103 of the Act. In *Goldstein v California*, which was cited with approval in *Bonito Boats*, the Court held that states may protect categories of works (in that case sound recordings before they were protected under the Act) left unregulated by Congress. For example, although a state may not protect an unoriginal literary work, piece of music, or compilation, it may protect something like a right of publicity which Congress has not yet made a category of work eligible for protection. So, an unoriginal work of a type not yet categorized in sections 102 and 103 of the Copyright Act might be amenable to protection by the states. Given the difficulty of imagining such a work, it seems safe to say generally that state attempts to circumvent *Feist* will be futile.

V. CONCLUSION

Before *Feist* was decided, a sophisticated scholarly debate raged about the need to protect low authorship works. Although

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128 Listing literary works, musical works, dramatic works, pantomimes, choreographic works, motion pictures, sound recordings, compilations, and pictorial, graphic, and sculptural works.

no agreement was reached on the contours of the necessary protection, a general consensus found that valuable works of low authorship should be protected if they would otherwise go uncreated. The debate focused on the proper balance of incentives necessary to increase public wealth. Originality was recognized to be a term of art: works worth protecting were original; those not needing protection were not. As the opinion recognizes, telephone directory white pages are almost certainly not worth protecting from the sort of activity engaged in by Feist. However, other works that are the product of perspiration rather than inspiration might be. The primary vice of Feist is its broad language forbidding Congress from protecting any sweat of the brow works or industrious collections in the future. This flaw is especially glaring given that copyright law as currently enacted clearly does not provide for such protection, and therefore the decision could have rested on purely statutory grounds.

The potential effect of Feist may well be far-reaching. Its particular definition of originality casts doubt on the copyrightability of maps, systems, lists, tables, historical works and research, and pagination of law reports. Perhaps the most interesting question left after Feist is not what works will be cast to the public domain, but whether Congress can constitutionally overrule the decision.