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## Copyright Protection in Factual Compilations: Feist Publications v. Rural Telephone Service Company "Altruism Expressed in Copyright Law"

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# COPYRIGHT PROTECTION IN FACTUAL COMPILATIONS: *FEIST PUBLICATIONS v. RURAL TELEPHONE SERVICE COMPANY* “ALTRUISM EXPRESSED IN COPYRIGHT LAW”

## INTRODUCTION

The Constitution grants Congress the power to create copyright laws.<sup>1</sup> This grant contains inherent tensions between protecting the author's fruits of labor and providing the public with access to copyrighted works.<sup>2</sup> Copyright law reflects these tensions.

Until recently two competing theories about what copyright protection is available to factual compilations split the circuit courts of appeal. The Copyright Act defines a compilation as “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.”<sup>3</sup> Fact-based compilations involve factual preexisting materials or data.<sup>4</sup>

The two theories which split the circuit courts of appeal over copyright protection available to fact-based compilations are the “sweat of the brow” theory, previously followed in three circuits,<sup>5</sup> and the “selection, arrangement, or

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1. U.S. CONST. art. I, § 8, cl. 8. *See infra* p. 531.

2. *Id.*

3. 17 U.S.C. § 103 (1988).

4. Traditional examples of factual works include maps, charts, telephone books, photographs, and business forms. Davidson, *Symposium: The Future of Software Protection: Common Law, Uncommon Software*, 47 U. PITT. L. REV. 1037, 1103 (1986).

5. The circuits following the “sweat of the brow” theory were the Seventh, Eighth and Tenth Circuits. *See, e.g.*, *Illinois Bell Tel. Co. v. Haines & Co.*, 905 F.2d 1081, 1085 (7th Cir. 1990), *cert. granted*, \_\_\_ U.S. \_\_\_, 111 S. Ct. 1408 (vacating judgment and remanding for reconsideration in light of *Feist*), *on remand*, 932 F.2d 610 (7th Cir. 1991) (remanding for entry of judgment against plaintiff in light of *Feist*); *Hutchinson Tel. Co. v. Fronteer Directory Co.*, 770 F.2d 128, 131 (8th Cir. 1985); *Feist Publications v. Rural Tel. Serv. Co.*, 916 F.2d 718 (10th Cir. 1989), *cert. granted*, \_\_\_ U.S. \_\_\_, 111 S. Ct. 1282 (1991) (reversing judgment against defendant).

coordination" theory<sup>6</sup> previously followed in four circuits.<sup>7</sup> In *Feist Publications v. Rural Telephone Service Co.*,<sup>8</sup> the Supreme Court clarified the law. The Court rejected the "sweat of the brow" theory which rewarded the labor required to produce a work with copyright protection.<sup>9</sup> Instead, the Court stated that copyright protection extends only to the "manner in which the collected facts have been selected, coordinated, and arranged."<sup>10</sup> The Court noted that the 1976 Copyright Act makes it clear that copyright requires originality,<sup>11</sup> facts are not original,<sup>12</sup> and that therefore copyright does not necessarily extend to facts contained in a compilation.<sup>13</sup>

In the wake of *Feist*, copyright practitioners are scrambling to determine what it all means, and how best to protect their client's intellectual property rights and interests.<sup>14</sup> While different views are presented, an expression of dismay is common.<sup>15</sup> This note will address the question: are the copyright practitioners justified in their concern? Part I will outline the

6. Hereinafter "selection" theory.

7. The circuits following the selection theory were the Second, Fifth, Ninth and Eleventh Circuits. See, e.g., *Financial Information, Inc. v. Moody's Investment Serv.*, 751 F.2d 501, 504 (2d Cir. 1984), 808 F.2d 204, 208 (2d Cir. 1986), *cert. denied*, 484 U.S. 820 (1987); *Miller v. Universal City Studios*, 650 F.2d 1365, 1369-70 (5th Cir. 1981); *Worth v. Selchow & Righter Co.*, 827 F.2d 569, 574 (9th Cir. 1987), *cert. denied*, 485 U.S. 977 (1988); *Southern Bell Tel. & Tel. Co. v. Associated Tel. Directory Pub.*, 756 F.2d 801, 809 (11th Cir. 1985).

8. 111 S. Ct. 1282 (1991) [hereinafter *Feist*].

9. *Id.* at 1291.

10. *Id.* at 1294.

11. *Id.* at 1295. 17 U.S.C. § 102(a) (1988) states in part: "Copyright protection subsists...in original works of authorship fixed in any tangible medium of expression...."

12. *Id.* 17 U.S.C. § 102(b) (1988) states in part: "In no case does copyright protection...extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work."

13. *Id.* 17 U.S.C. § 103(b) (1988) states: "The copyright in a compilation or derivative work extends only to the material contributed by the author of such work, as distinguished from the preexisting material employed in the work, and does not imply any exclusive right in the preexisting material. The copyright in such work is independent of, and does not affect or enlarge the scope, duration, ownership, or subsistence of, any copyright protection in the preexisting material."

14. See Beck, *Two Views on the Implications of Feist v. Rural Telephone: Copyright Protection for Compilations and Databases after Feist*, 8 THE COMPUTER LAW., July 1991, at 1; Bartz, *Two Views on the Implications of Feist v. Rural Telephone: The Beginning of the End of Software Overprotection?*, 8 THE COMPUTER LAW., July 1991, at 10; Abramson, *High Court Ruling Means New Rules for Compilers*, DIRECT MARKETING NEWS, Apr. 29, 1991, at 54 (NEXIS, OMNI library).

15. See, e.g., Beck, *supra* note 14, at 1; Bartz, *supra* note 14, at 10; Abramson, *supra* note 14, at 54.

Constitutional underpinnings of copyright protection. More specifically, this Part will discuss the two theories underlying the case law in the circuit courts of appeal, including a discussion of their legal philosophies. Part II will examine the Court's decision in *Feist*. Part III will analyze and critique the Court's decision, discuss practical implications, and present various alternate protections for databases. Finally, this note will conclude that there is little cause for concern, and the interests of copyright practitioners must properly yield to the Court's expression of the altruistic principles inherent in copyright law.

## I. THE INHERENT TENSIONS IN COPYRIGHT LAW

Copyright law represents a compromise between social policies.<sup>16</sup> The Constitution gives Congress the power "[t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries."<sup>17</sup> Within this grant lies an inherent tension between affording protection to the individual author, and providing the general public with access to information.<sup>18</sup>

One social policy favors wide dissemination of ideas.<sup>19</sup> This competes with another policy giving writers and artists a fair economic reward by means of a monopoly over their works.<sup>20</sup> One apparent result of these competing policies has been the concurrent development of legal theory promoting the policy of incentive to authors ("sweat of the brow" theory), and a legal theory promoting the policy of wide dissemination and use of ideas ("selection" theory).

### A. THE "SWEAT OF THE BROW" THEORY: PROMOTING THE SOCIAL POLICY FAVORING ECONOMIC REWARD TO WRITERS

The "sweat of the brow" theory evolved from John Locke's natural law theory.<sup>21</sup> Locke's theory posited that one has a

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16. See, e.g., Denicola, *Copyright in Collections of Facts: A Theory for the Protection of Nonfiction Literary Works*, 81 COLUM. L. REV. 516, 519 n.11 (1981).

17. U.S. CONST. art. I, § 8, cl. 8.

18. Denicola, *supra* note 16, at 519.

19. *Id.*

20. *Id.*

21. J. LOCKE, *THE SECOND TREATISE OF GOVERNMENT* para. 27, at 17 (T. Peardon rev. ed. 1952) (1st ed. 1690).

property interest in one's body, and therefore in the work of one's body.<sup>22</sup>

The idea that this property interest is copyrightable was best embodied by the case law in *Jeweler's Circular Publishing Co. v. Keystone Publishing Co.*,<sup>23</sup> the seminal case describing the "sweat of the brow" theory. There, quoting *Kelly v. Morris*,<sup>24</sup> the *Jeweler's Circular* court noted that the defendant was mistaken in arguing that copyright did not protect the exertion of labor required to collect facts. The *Jeweler's Circular* court stated that so long as labor is expended in the preparation of a work, copyright protection is available.<sup>25</sup>

#### B. THE "SELECTION" THEORY: PROMOTING THE SOCIAL POLICY FAVORING WIDE DISSEMINATION OF IDEAS

Recall that the two competing interests inherent in copyright are economic incentives promoting authorship, and limits on copyright availability promoting wide dissemination or sharing of ideas. It is widely accepted that economic incentives are necessary so authors will continue to create works and disseminate them to the public. This has been described as copyright's "core" doctrine.<sup>26</sup>

Recent theorists have recognized that the economic incentive of copyright protection can work against authors "sharing" works in the interest of promoting the progress of arts and sciences.<sup>27</sup> One theorist<sup>28</sup> posits that the natural law theory, relied on in *Jeweler's Circular* and other cases establishing a copyrightable property interest in one's labor, is misguided. According to Alfred Yen, original natural law partook of a moral character which was later replaced by economic efficiency.<sup>29</sup>

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22. *Id.*

23. 281 F. 83 (9th Cir. 1922) *cert. denied*, 259 U.S. 581 (1922) [hereinafter *Jeweler's Circular*].

24. 1 Law Rptr. Equity 697 (1866).

25. *Jeweler's Circular*, 281 F. at 88. The "sweat of the brow" theory is variously known as the "industrious collection" theory. *Id.*

26. Gordon, *Fair Use as Market Failure: A Structural and Economic Analysis of the Betamax Case and its Predecessors*, 82 COLUM. L. REV. 1600, 1619 (1982).

27. See, e.g., Yen, *Restoring the Natural Law: Copyright as Labor and Possession*, 51 OHIO ST. L.J. 517 (1990).

28. *Id.*

29. *Id.* at 517 n.1 (arguing for the restoration of our "natural law heritage" which recognizes both economic and moral values in copyright).

Another theorist has recently challenged the basic assumption that economic incentives are necessary to motivate authors to produce works.<sup>30</sup> Linda Lacey argues that a fundamental flaw of copyright law assumes all artists are primarily motivated by economics.<sup>31</sup> She asserts that in reality, artists<sup>32</sup> are motivated by a variety of interests.<sup>33</sup> One can reason that if authors are motivated to create works by more than mere economics, eliminating the economic incentive will not necessarily spell the end of intellectual property production.

Wide availability of copyrighted works is generally regarded to be in the "public interest."<sup>34</sup> Lacey disputes the commonly used meaning of "public interest." She acknowledges that "[c]ontemporary liberal theory regards the 'public' as a Hobbesian collection of autonomous individuals, each acting out of self interest."<sup>35</sup> However, Lacey asserts that:

[the] 'public' also can be understood as an interdependent community with certain common interests that affect all its members...even individuals who are not direct recipients of artistic work benefit from its availability to society, just as free public education does more for a community than

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30. Lacey, *Of Bread and Roses and Copyrights*, 1989:2 DUKE L.J. 1532, 1571 (1989).

31. *Id.* Lacey admits that "[o]f course, a significant number of people indeed do create exclusively to make money...[b]ut the assumption that the financial motive is universal is simply incorrect and should not continue to be the exclusive foundation of copyright law." *Id.* at 1574.

32. Although Lacey primarily discusses "artists" in her article, her theory is equally applicable to all authors of copyrighted works. Lacey uses the term "'artist'...in its broadest sense to include writers, sculptors, choreographers, etc.--anyone who creates a product that can be protected by copyright law." *Id.* at 1532 n.3. Further, she notes that "[a]ll intellectual property can be categorized roughly as work that has either political, educational, aesthetic, or entertainment value, or as work that has value in several of these contexts." *Id.* at 1588.

33. Lacey notes that even among successful writers, economic gain was "their least popular reason to write." *Id.* at 1574 n.195 (citing P.E.N. International, News Release (undated) (file on copy in journal office), at 4).

34. *Id.* at 1584. For this proposition Lacey cites, e.g., 3 M. & D. NIMMER, NIMMER ON COPYRIGHT, § 13.05[A], at 13-72; Gordon, *Fair Use as Market Failure: A Structural and Economic Analysis of the Betamax Case and its Predecessors*, 82 COLUM. L. REV. 1600, 1601 (1982); Sinclair, *Fair Use Old and New: The Betamax Case and its Forebears*, 33 BUFFALO L. REV. 269, 291-92 (1984); Walker, *Fair Use: The Adjustable Tool for Maintaining Copyright Equilibrium*, 43 LA. L. REV. 735, 754 (1983). *Id.* at 1584 n.229.

35. *Id.* at 1584-85 (citing T. HOBBS, *LEVIATHAN* 63-66, 104-10 (Everyman's Library ed. 1983)).

serving the individual needs of parents of school age children."<sup>36</sup>

One can reason that if the public interest entails shared community interests rather than "the autonomous interests of a large number of people,"<sup>37</sup> "Progress of Science and useful Arts"<sup>38</sup> results when the community at large can reap the benefits of authors building on other's works without having to reinvent the wheel. To serve this "public interest," less copyright protection is necessary.

The "selection" theory can be seen as recognizing a need to reestablish the public's interest in copyright. This can be viewed as a shift in emphasis from individualism to altruism.<sup>39</sup> Individualism is described as self-interest and self reliance,<sup>40</sup> while altruism is defined as a belief that one's own interest should not necessarily be preferred over the interests of others.<sup>41</sup>

According to Duncan Kennedy, individualist and altruistic principles pervade our entire legal system, creating "flatly contradictory visions of the universe."<sup>42</sup> The simultaneous existence of individualism and altruism causes legal theorists, lawyers, and judges to examine the true interaction between law and society.<sup>43</sup> The juxtaposition of these two

36. *Id.* at 1585.

37. *Id.* at 1596.

38. U.S. CONST. art. I, § 8, cl. 8.

39. Lacey, *supra* note 30, at 1533.

40. Kennedy, *Form and Substance in Private Law Adjudication*, 89 HARV. L. REV. 1685, 1713 (1976).

41. *Id.* at 1717.

42. *Id.* at 1776.

43. Kennedy describes a transition "from Classical to modern legal thought...through the imagery of core and periphery." The "core" was: equated with firm adherence to autonomy, facilitation and self-determination. The existence of countertendencies was acknowledged, but in a backhanded way. By its "very nature," freedom must have limits; these could be derived as implications *from* that nature; and they would then constitute the periphery of exceptions to the core doctrines (emphasis in original)."

*Id.* at 1737. In Kennedy's view, today we recognize both the "core" and the "periphery," because both exist in the law and its relation to reality. Kennedy asserts:

What distinguishes the modern situation is the breakdown of the conceptual boundary between the core and the periphery, so that all the conflicting positions are at least potentially relevant to all issues. The Classical concepts oriented us to one ethos or the other -- to core or periphery -- and then permitted consistent argument within that point

seemingly contradictory principles creates tension in the law.<sup>44</sup> This tension results in the generation of new ideas, or a synthesis of the old into a new vision.<sup>45</sup> Similarly, Lacey's definition of the public interest includes a communal aspect. This is an altruistic notion. Her revelation that multiple motivations inspire authors accompanies her scrutiny of copyright's inherent tensions. This examination of the interaction between law and society leads to a new vision of copyright.<sup>46</sup> In this context the "selection" theory is the new vision, better serving the author's and community's needs. Therefore, one can approve the Supreme Court's embrace of the "selection" theory as a welcome attempt to enforce, at the highest level, the altruistic principles inherent in copyright law.

## THE COURT'S DECISION IN *FEIST*

### A. THE FACTS OF *FEIST*

*Feist* concerned the unprivileged use of information contained in a white pages directory published by Rural Telephone Company.<sup>47</sup> Rural Telephone Company had published the directory as part of its mandate as a public utility.<sup>48</sup>

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of view, with a few hard cases occurring at the borderline. Now, each of the conflicting visions claims universal relevance, but is unable to establish hegemony anywhere.

*Id.*

44. Kennedy describes this tension as "the sticking points of the two sides--the moments at which the individualist, in his movement towards the state of nature, suddenly reverses himself and becomes an altruist, and the symmetrical moment at which the altruist becomes an advocate of rules and self-reliance rather than slide all the way to total collectivism or anarchism." *Id.* at 1767.

45. Kennedy gives the example of a judge in a contract dispute faced with following precedent or recognizing the injustice such slavish rule following would work: "there is value as well as an element of real nobility in the judicial decision to throw out, every time the opportunity arises, consumer contracts designed to perpetuate the exploitation of the poorest class of buyers on credit. Real people are involved, even if there are not very many whose lives the decision can affect." *Id.* at 1777.

46. Indeed, Lacey's new vision reaches beyond copyright to property law in general. Lacey argues that limited ownership logically should not extend only to intellectual property:

The spirit of altruism that permeates the language of copyright theory is indeed moving. But until we apply that selfless spirit and those persuasive reasons why intellectual property must be shared with the community to other forms of property, we are being hypocritical at the expense of the artist and society. The anthem of the striking women textile workers, which has become a feminist rallying cry, is right: We must have both bread and roses—one without the other never will be enough.

Lacey, *supra* note 30, at 1596.

47. *Feist*, 111 S. Ct. at 1286.

48. *Id.*



Feist Publications, an independent publisher, began to publish white and yellow pages directories.<sup>49</sup> The white page directories were organized into separate geographic areas.<sup>50</sup> The yellow pages were similarly organized and marketed to geographic areas corresponding to those in the white pages.<sup>51</sup> In order to obtain the white pages information, Feist Publications entered into licensing agreements with all utilities except Rural Telephone Company who declined to enter into such an agreement.<sup>52</sup>

In an effort to obtain the necessary listings, Feist Publications extracted the information from Rural Telephone Company's directory.<sup>53</sup> Rural Telephone Company had suspected Feist Publications of extracting information from its directory, and therefore had included several fictitious listings.<sup>54</sup> When Feist Publications published its directory, 1,309 of its 46,878 listings were identical to those contained in Rural Telephone Company's directory, including four fictitious listings.<sup>55</sup>

Rural Telephone Company sued Feist Publications for copyright infringement in the District Court for the District of Kansas.<sup>56</sup> Rural Telephone Company asserted that Feist Publications was obliged to separately canvass for the information contained in its directory.<sup>57</sup> Feist Publications countered that Rural Telephone Company's directory was outside the protection of copyright,<sup>58</sup> and alternatively defended on antitrust grounds.<sup>59</sup> The district court determined that antitrust was not a defense to copyright, and severed that issue from the case.<sup>60</sup> The district court then found that Feist Publications had infringed Rural Telephone Company's copyright.<sup>61</sup> Feist Publications appealed. The Court of Appeals for the Tenth

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49. *Id.*

50. *Id.*

51. *Id.*

52. *Id.*

53. *Id.*

54. *Rural Tel. Serv. Co. v. Feist Publications*, 663 F. Supp. 214, 217 (D. Kan. 1987) [hereinafter *Rural*].

55. *Feist*, 111 S. Ct. at 1287.

56. *Rural*, 663 F. Supp. at 216.

57. *Feist*, 111 S. Ct. at 1287.

58. *Rural*, 663 F. Supp. at 217.

59. *Id.* at 216.

60. *Id.*

61. *Id.* at 220.

Circuit affirmed,<sup>62</sup> without opinion. The Supreme Court granted certiorari on the issue of copyright.<sup>63</sup>

**B. ORIGINALITY: "THE SINE QUA NON OF COPYRIGHT"<sup>64</sup>**

In *Feist*, the Supreme Court noted that *The Trade-Mark Cases*<sup>65</sup> addressed the scope of the Constitutional source of Congressional power to "secur[e] for limited Times to Authors...the exclusive Right to their respective Writings."<sup>66</sup> There, the Supreme Court determined that originality is Constitutionally required in order for a work to qualify as the writing of an author.<sup>67</sup> The Court stated that "[t]he writings which are to be protected are *the fruits of intellectual labor*, embodied in the form of books, prints, engravings, and the like."<sup>68</sup>

In *Feist*, the Court concluded that the touchstone of copyright protection is the originality requirement articulated in *The Trade-Mark Cases*.<sup>69</sup> As applied to factual compilations, the Court held that the basis for originality lies in choosing facts for inclusion, as well as ordering and arranging them in a useful fashion.<sup>70</sup> The Court further stated that so long as such compilations are independently assembled and contain minimal creativity, they are protected by copyright.<sup>71</sup>

**C. ORIGINALITY IN FACTUAL COMPILATIONS STATUTORILY REQUIRES SELECTION AND ARRANGEMENT, NOT "SWEAT OF THE BROW"<sup>72</sup>**

In *Feist*, the Supreme Court cited its decision in *International News Service v. Associated Press*<sup>73</sup> for the proposition that the copyright statute does "not permit the 'sweat of the brow' approach."<sup>74</sup> Although the Court in *International News* noted that the 1909 Copyright Act included newspapers among copyrightable materials, the idea that copyright

62. *Feist Publications v. Rural Tel. Serv. Co.*, 916 F.2d 718 (10th Cir. 1989).

63. *Feist*, 111 S. Ct. at 1286.

64. *Id.* at 1287.

65. 100 U.S. 82 (1879).

66. *Feist*, 111 S. Ct. at 1288 (quoting U.S. CONST. art. I, § 8, cl. 8).

67. *The Trade-Mark Cases*, 100 U.S. at 94.

68. *Id.*

69. *Feist*, 111 S. Ct. at 1288.

70. *Id.* at 1289.

71. *Id.*

72. *Id.* at 1292.

73. 248 U.S. 215 (1918) [hereinafter *International News*].

74. *Feist*, 111 S. Ct. at 1292.

extended to facts contained in an article was completely rejected.<sup>75</sup> There, the Court held that the information forming the news reported in newspapers is not an original creation but rather a report of information rightfully belonging to the public.<sup>76</sup>

Further, the Court noted that historically copyright law has comprehended a distinction between the necessity for disseminating factual works and the necessity for disseminating fictional works.<sup>77</sup> Therefore copyright in factual works is necessarily "thin"<sup>78</sup> since copyright may only extend to the author's artistic expression, and not to the facts expressed.

The Court looked to the legislative histories of all the copyright acts for further support for its interpretation of the originality requirement. The Court noted that Congress incorporated the Register's advice contained in the Report of the Register of Copyrights on the General Revision of the U.S. Copyright Law.<sup>79</sup> The report suggested that the originality requirement be explicit in order to clear up "misconceptions as to what is copyrightable matter."<sup>80</sup>

The Court acknowledged that after the 1976 revisions to the Copyright Act, the touchstone of copyright protection in fact-based compilations was originality and not "sweat of the brow."<sup>81</sup> The Court summarized the Congressional responses to confusion in this area.<sup>82</sup> The Court concluded that copyright revisions clearly explain that copyright requires originality,<sup>83</sup> facts are not original,<sup>84</sup> copyright does not extend to the facts

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75. *Id.* (quoting *International News*, 248 U.S. at 234).

76. *Id.*

77. *Id.* (quoting *Harper & Row v. Nation Enters.*, 471 U.S. 539, 563 (1985)).

78. When an author recounts historical facts, copyright extends only to his "subjective descriptions," and if there are none, copyright is only available to "[t]he only conceivable expression...the manner in which the compiler has selected and arranged the facts." *Id.* at 1289.

79. *Id.* at 1292.

80. *Id.* (quoting STAFF OF HOUSE COMM. ON THE JUDICIARY, 87th Cong., 1st Sess., REPORT ON COPYRIGHT LAW 9 (Comm. Print 1961)).

81. *Id.* at 1295.

82. *Id.*

83. *Id.* 17 U.S.C. § 102(a) (1988) states, in part: "Copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device."

84. *Id.* 17 U.S.C. § 102(b) (1988) states: "In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work."

contained in a compilation,<sup>85</sup> and that copyright protection available to a compilation extends only to original selection, coordination, or arrangement.<sup>86</sup>

#### D. THE ORIGINALITY REQUIREMENT AFTER *FEIST*

The Court explained that the key to originality lies in the “manner in which the collected facts have been selected, coordinated, and arranged.”<sup>87</sup> The Court suggests that a mechanical or routine manner of selection, coordination or arrangement may not meet the low standard of originality.<sup>88</sup> Further, the Court notes that the originality standard is not met in arrangements which are obvious, common place, expedient, traditional, or inevitable.<sup>89</sup>

The Court determined that Rural Telephone Company’s arrangement of its white pages was “entirely typical,” and “could not be more obvious.”<sup>90</sup> Additionally, the Court hinted in dicta that Rural Telephone Company did not engage in any selection process whatsoever, but rather that, by virtue of its monopoly franchise, it “selected” included information based on a mandate by the Kansas Corporation Commission.<sup>91</sup>

Finally, the Court noted that constitutionally, copyright anticipates that some works will fail to achieve originality, and that if Rural Telephone Company’s alphabetized list of subscribers is deemed “original,” then all works are original.<sup>92</sup> The Court stated that to warrant copyright protection, a work’s creative spark must be more than *de minimis*.<sup>93</sup> The Court

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85. *Id.* 17 U.S.C. § 103(b) (1988) states: “The copyright in a compilation or derivative work extends only to the material contributed by the author of such work, as distinguished from the preexisting material employed in the work, and does not imply any exclusive right in the preexisting material. The copyright in such work is independent of, and does not affect or enlarge the scope, duration, ownership, or subsistence of, any copyright protection in the preexisting material.”

86. *Id.* 17 U.S.C. § 101 (1988) states, in part: “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. The term ‘compilation’ includes collective works.”

87. *Id.* at 1294.

88. *Id.* at 1296.

89. *Id.*

90. *Id.*

91. *Id.*

92. *Id.* at 1297.

93. *Id.*

found that Rural Telephone Company's white pages unquestionably did not meet this low standard.<sup>94</sup>

### III. CRITIQUE: WHY THE COURT'S DECISION WAS CORRECT

The Court's decision in *Feist* was supported by prior case law in the majority of the circuits,<sup>95</sup> the plain language of the copyright statute,<sup>96</sup> the purpose of the Constitutional grant to Congress,<sup>97</sup> and the original moral meaning embodied in the notion of natural law<sup>98</sup> as well as the altruistic principles which underlie our jurisprudence in general.<sup>99</sup> Some theorists have posited that the lack of legal debate regarding the duration of copyright protection can be seen as a rejection of the "natural law, fruit-of-the-creators-labor theory...."<sup>100</sup>

The Court's decision was narrow: to the extent Rural Telephone Company was not found to have satisfied originality in its selection, its status as a public utility arguably played a part.<sup>101</sup> This means *Feist's* decision could be limited to instances involving public utilities or other situations where selection is pre-determined by mandate.

The Court seemed to implicate Rural Telephone's Company standing as a public utility as an issue when it hinted in dicta that Rural Telephone Company did not voluntarily engage in any selection process, but rather made its selections based on requirements dictated by the Kansas Corporation Commission.

94. *Id.*

95. More circuits previously followed the "selection" theory than the "sweat of the brow" theory. See, e.g., *Harper House, Inc. v. Thomas Nelson, Inc.*, 889 F.2d 197, 205 (9th Cir. 1989) on remand 1991 W.L. 138317 (only selection, coordination and arrangement were protectable, blank forms were not); *Harper & Row v. Nation Enters.*, 471 U.S. 539, 548 (1985) [hereinafter *Harper & Row*] (stating it is permissible to copy facts "from a prior author's work"); *Eckes v. Card Prices Update*, 736 F.2d 859 (2d Cir. 1984); *Financial Information, Inc. v. Moody's Investors Serv.*, 751 F.2d 501 (2d Cir. 1984), *aff'd*, 808 F.2d 204 (2d Cir. 1986), *cert. denied*, 484 U.S. 820 (1987).

96. Patry, *Copyright in Compilation of Facts (Or Why the 'White Pages' Are Not Copyrightable)*, 12 COMM. & LAW 37 (Dec. 1990).

97. *Id.* at 64.

98. Yen, *supra* note 27, at 517 n.1.

99. Kennedy, *supra* note 40, at 1713.

100. Lacey, *supra* note 30, at 1547 n.73.

101. *Feist*, 111 S. Ct. at 1296-97. The Court stated: "[w]e note in passing...Rural did not truly 'select' to publish the names and telephone numbers of its subscribers; rather it was required to do so by the Kansas Corporation Commission as part of its monopoly franchise." *Id.*

Indeed, the Court seems to hint that, by virtue of its monopoly status as a public utility, Rural Telephone Company merely waited for the listing information to come to it, and was required to include all of this material in its directory.

Facts have never been copyrightable,<sup>102</sup> and therefore *Feist* should have come as no surprise. The First Amendment mandates copyright's idea/expression dichotomy, which ensures copyright law will not restrict freedom of speech by protecting ideas.<sup>103</sup> The "sweat of the brow" theory was merely used to put the round peg of copyright into the square hole of protection for labor.

The Court's decision was unanimous.<sup>104</sup> In *Feist*, the Court insists it has merely stated the law as it has always been. Certainly, if the Court were suddenly announcing new law, one would expect to see either an opinion which somehow reflected that fact, or dissenting opinions. There are no such indications in *Feist*. The Court's clear unified stance should create certainty and uniformity.

Additionally, the Court's decision leads to many practical results demonstrating its propriety. These practical implications follow.

#### A. PRACTITIONER FEARS AND *FEIST*'S IMPLICATIONS FOR OTHER DATABASES

Before turning to implications for other databases, a brief discussion of what comprises a database is in order. Briefly, a database is any compilation of information arranged in a useful fashion. This includes ordinary printed library card catalogues indexed on three-by-five cards, as well as sophisticated compilations designed for computer use such as LEXIS. *Feist* involved a database, since the directory was a compilation of subscriber information arranged alphabetically.

Practitioner fears that *Feist* means a loss of income from or protection to most databases is unfounded. This is so because:

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102. *Harper & Row*, 471 U.S. at 558 ("[t]he public interest in the free flow of information is assured by the law's refusal to recognize a valid copyright in facts").

103. *Id.* at 556.

104. Justice Blackmun concurred in the judgment, but did not write a separate opinion.

1) arrangement, coordination and selection provide copyright protection; 2) databases are protected from wholesale copying and reshuffling; and 3) telephone utilities, in particular, have built-in assurances that licensing agreements will not end.

### 1. *Arrangement, Coordination and Selection Provide Copyright Protection*

Some practitioners believe that databases are now vulnerable to copyright protection attacks because selection may be lacking when all available information is included on an individual topic.<sup>105</sup> However, these fears fail to recognize that copyright can also be based on arrangement and coordination. Even if a database does include an entire universe of information, it is likely to be arranged and coordinated in such a way as to meet the low test of originality.<sup>106</sup> Additionally, an argument can be made that the decision to include an entire universe of information is itself selection. Such selection expresses the judgment that all data is useful in a particular application, and should therefore be included.<sup>107</sup> This argument is likely viable despite Rural Telephone Company's inclusion of its entire universe of information and subsequent failure to satisfy originality in selection in *Feist*. This is because of the Court's hint in dicta that selection was imposed on Rural Telephone Company by reason of its status as a public utility, rather than Rural Telephone Company originating its selection.

### 2. *Databases are Protected From Wholesale Copying and Reshuffling*

Some practitioners fear that copyright protection based on originality in selection, arrangement or coordination is insufficient to prevent databases from wholesale copying and reshuffling, even if the requisite originality is present.<sup>108</sup> It is true that regardless of originality, facts have always been subject to copying.<sup>109</sup> However, copyright protection is available for formats of factual compilations. For example, yellow pages

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105. Celedonia, *Feist v. Rural Telephone: Is the Sky Falling for Directory Publishers?*, N.Y.L.J., Apr. 12, 1991, at 28, col. 5.

106. *Feist*, 111 S. Ct. at 1296-97. (The Court in *Feist* defined originality as not being "mechanical" or "inevitable").

107. Celedonia, *supra* note 105, at 28, col. 5.

108. *See, e.g.*, Abramson, *supra* note 14, at 54.

109. Celedonia, *supra* note 105 at 4, col. 4.

compiled on a software disc are still likely to receive considerable protection from wholesale copying and reshuffling. In the recent case of *Bellsouth Advertising & Publishing Corp. v. Donnelley Information Publishing, Inc.*,<sup>110</sup> the court found, relying on *Feist*, that “yellow” pages were sufficiently original in their selection, coordination and arrangement to be copyrightable.<sup>111</sup> Furthermore, the court found that for copyright purposes, a work is “fixed in a tangible form” if the information has been stored on magnetic tape. Additionally, any keying of this formatted information into a computer and storing it, regardless of an intent to subsequently reshuffle it to create a “new” work, amounts to copyright infringement of the format.<sup>112</sup> This provides copyright protection to yellow pages, by recognizing that simply keying the copyrighted format into a computer and storing it in any fashion results in copying.

Thus, misappropriation is prevented because taking and rearranging unprotected information results in copyright infringement of the arrangement. Once the copyrighted format has been copied and stored, the infringement is complete. Because any misappropriation would necessarily require that one first copy and then change the format, this provides substantial protection.

### 3. *Telephone Utilities have Built-In Protection from Loss of Licensing Revenues*

Telephone companies traditionally enter into agreements licensing use of their subscriber information, rather than selling it to competitors. Some telephone utilities believe the *Feist* decision will lead to fewer or no licensing agreements between themselves and competing book publishers, resulting in a loss of revenue that will ultimately be made up by ratepayers.<sup>113</sup> In reality, utilities have built-in protection from such loss of revenues.

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110. 933 F.2d 952 (11th Cir. 1991) [hereinafter *Donnelley*].

111. *Id.* at 958. Compare *Bellsouth Advertising & Publishing Corp. v. Donnelley Information Publishing Inc.*, 933 F.2d 952 (11th Cir. 1991) with *Key Publications, Inc. v. Chinatown Today Publishing Enters., Inc.*, 945 F.2d 509 (2d Cir. 1991) (holding that yellow-page phone directory listings can be copied as long as the material is organized in a different manner by the copier; so long as this “copying” does not involve keying formatted information from magnetic tape into a computer, this decision is consistent with *Donnelley*).

112. *Id.*

113. *Communications Daily*, Mar. 28, 1991, at 6 (quoting Marie Guillory of Nat'l Tel. Coop. Assoc.: “[I]f duplicated white pages cut into revenue of Yellow Pages, which supports basic rates, then ratepayers could be harmed.”)



a. *It is Unlikely Licensing Agreements will be Lost*

The Court's decision in *Feist* is not seen as a major setback by many telephone utilities.<sup>114</sup> This is so because it is doubtful that white page competitors will completely abandon license agreements. The utilities are the first source of current information regarding customer changes in service and information, including new connects and disconnects.<sup>115</sup> This means that if a publisher desires the most current and therefore most accurate information, a licensing agreement is still the only way to obtain this information from the utility. This is so because the printed copies of a utility's book are about six weeks out of date the day they are published, so that an independent publisher who relies on them will ultimately publish a book whose information is months out of date.<sup>116</sup> Realistically then, independent publishers of white pages will still most likely find it necessary to enter into license agreements with utilities. This assumes independent publishers are interested in competing in the market.

(1) *Even Assuming Loss of Licensing Agreements, Ratepayers are not Necessarily Disadvantaged*

Even if licensing agreements were no longer entered into between utilities and independent publishers resulting in higher utility rates, since competing directories would be saving licensing costs, it is likely this would be reflected in lower advertisement rates to yellow pages advertisers in independent directories. This would in turn mean that, in order to remain competitive, utility yellow page directories could not continue to charge as much for their advertisements.

Ultimately it seems likely that these cost savings to various businesses and retailers who advertise in the directories would in turn be passed on to the ultimate consumers, who are

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114. *Id.* (quoting spokesperson for Bell Atlantic: “[*Feist*] does not affect our business dealings with any of our independent directory dealers.”)

115. *See, e.g.,* Celedonia, *supra* note 105, at 28, col. 5 (stating: “[i]t is this 'value added' -- the currency of the information -- which the various telephone companies can continue to license”); Moses, *Publishers Move to Prevent Directories From Becoming Open Books for Rivals*, Wall St. J., Dec. 27, 1991, at B4, col. 6 (quoting Russell Perkins, publisher of a directory-industry newsletter, stating: “Information ages...and they can only steal it from you once.”)

116. Celedonia, *supra* note 105, at 29 n.24, col. 2.

also the ratepayers. Therefore, consumers are beneficiaries of the *Feist* decision whether or not rates rise.

## B. ALTERNATIVE PROTECTIONS FOR FACTUAL COMPILATIONS

While the decision in *Feist* makes it clear that facts are not copyrightable, there are ample protections available to compilations when necessary.

### 1. *Copyright Protection is Not Appropriate in All Circumstances*

Not all fact-based compilations are contemplated for copyright protection.<sup>117</sup> Clearly, the language of both the Constitution and copyright legislation do not comprehend copyright protection for mere facts.<sup>118</sup>

This is as it should be. The Constitutional purpose of copyright is “to encourage the widest possible production and dissemination of literary, musical and artistic works.”<sup>119</sup> Concomitantly, the First Amendment demands that factual expression not be restricted by copyright.<sup>120</sup>

The altruistic principle which dictates the moral sharing of individual accomplishments in order to promote the public welfare would wither under a scheme extending copyright protection to facts. As previously noted, protection of facts was “the most glaring flaw” of the “sweat of the brow” theory.<sup>121</sup>

### 2. *Ample Alternative Protections Exist Where Copyright is Not Appropriate*

To the extent the courts find it advantageous to grant protection to non-copyrightable works, this may be accomplished

117. *Feist*, 111 S. Ct. at 1297.

118. 17 U.S.C. § 102 (b) (1988) states, in part: “In no case does copyright protection...extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.”

U.S. CONST. art. I, § 8, cl. 8 states, in part, that Congress has the power to “promote the Progress of Science and useful Arts.” See, e.g., *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 429 (1984), *reh’g denied*, 465 U.S. 1112 (1984) (interpreting the Constitutional grant of power as primarily designed to evolve new works, not compensate authors).

119. P. GOLDSTEIN, *COPYRIGHT: PRINCIPLES, LAW AND PRACTICE*, § 1.2, at 11 (1989).

120. *Harper & Row*, 471 U.S. at 558.

121. *Feist*, 111 S. Ct. at 1291.

through a variety of alternative theories. These include unfair competition,<sup>122</sup> contract and trade secret law,<sup>123</sup> and restitution.<sup>124</sup>

In *Feist*, the Court suggests that “[p]rotection for the fruits of...research...may in certain circumstances be available under a theory of unfair competition.”<sup>125</sup>

One copyright practitioner suggests the use of contract and trade secret law.<sup>126</sup> Recently, one theorist has posited that not only is restitution law available for protection of non-copyrightable works, but that it has previously been used for this purpose.<sup>127</sup>

#### IV. CONCLUSION

In sum, the Court’s decision in *Feist* has created no new law, but merely clarified it by holding that the “sweat of the brow” theory was never capable of meeting the Constitutionally mandated originality requirement. The decision was narrow, and perhaps in some ways limited due to Rural Telephone Company’s status as a public utility.

The decision in *Donnelley* suggests that substantial protection is available because formats are copyrightable. This includes various fact-based databases.

To the extent non-copyrightable materials should be provided protection, there are alternative theories available such as unfair competition, contract and trade secret law, and restitution.

Finally, the higher moral purpose of individual sharing for the public good is promoted because others now have access

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122. *Id.* at 1292 (quoting M. NIMMER & D. NIMMER, NIMMER ON COPYRIGHT, § 3.04, at 3-23 (1990)).

123. *Celedonia*, *supra* note 105, at 28, col. 6.

124. Gordon, *An Inquiry into the Merits of Copyright: The Challenges of Consistency, Consent, and Encouragement Theory*, 41 STAN. L. REV. 1343, 1455 (1989).

125. *Feist*, 111 S. Ct. at 1292 (quoting M. NIMMER & D. NIMMER, NIMMER ON COPYRIGHT, § 3.04, at 3-23 (1990)).

126. *Celedonia*, *supra* note 105, at 28, col. 6.

127. Gordon, *supra* note 124, at 1455 n.490 (suggesting that the Supreme Court’s protection to non-copyrightable works on a “quasi-property” theory was a device meant to be used in reaching fair results where allowing use of another’s labor seems unfair, in *International News Serv. v. Associated Press*, 248 U.S. 215, 242 (1918)).

to compiled factual information on which new ideas can be built without fear of copyright infringement. That the Court has seen fit to inject altruistic principles into this area of copyright law should be welcomed.<sup>128</sup>

*Sherrie Callis\**

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128. Kennedy notes that, "the judge...is at work on the indispensable task of imagining an altruistic order....It seems to me that we should be grateful for this much, and wish the enterprise what success is possible short of the overcoming of its contradictions." Kennedy, *supra* note 40, at 1778.

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