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The Creative as Enemy of the True:The Meaning of Originality in the Matthew Bender Cases

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I. Introduction

II. Background

III. The Meaning of Originality

IV. Conclusion

I. Introduction

{1} The scope of copyright protection for case reports and case reporters has been the subject of litigation since the Supreme Court decided its first copyright case, *Wheaton v. Peters*,[1] in 1834. Prior to the development of electronic technologies, the courts established a fairly consistent set of guidelines on which print publishers could rely. However, the development of electronic research tools raised new questions which the old guidelines did not address. With the founding of Lexis's online research service, and the later development of CD-ROM research products, West Publishing Co., the premier publisher of case reports, found itself in possession of a valuable commodity which previously was of little commercial significance - the page numbers in its print compilations.

{2} Over the years, through general usage later reinforced by rules adopted in various courts, West's National Reporter System had become the standard citation reference.[2] Online publishers were forced to cross reference their electronic versions of court opinions to West's page numbers in order to provide their users with an acceptable means of referencing case law. This development set off a string of lawsuits, beginning

with *West Publishing v. Mead Data Central, Inc.*,[3] which focused on the meaning of the originality requirement in the context of compilations. The scope of the inquiry expanded beyond pagination to include the copyrightability of West's textual additions and revisions.

{3} The latest episode in this long-running, costly saga was enacted before a three-judge panel of the Second Circuit, which handed down two companion decisions in *Matthew Bender & Co. v. West Publishing Co.*[4] denying copyright protection to pagination and to several varieties of textual alterations. While the results reached by the split panel cannot be faulted[5], its analysis of the originality requirement contains several questionable lines of reasoning. The court's articulation and application of the originality standard in the text case obscures significant differences between derivative works and compilations, and imports elements of merger doctrine into the originality determination while denying that merger doctrine is applicable. In the pagination case, the court's unnecessary attempt to define "copies" and substantial similarity of arrangements for purposes of infringement in the electronic context may ultimately raise more questions than it resolves.

{4} This comment does not purport to solve all the issues raised herein, but draws attention to flaws which may become more glaring as time progresses. These cases do not, by any means, represent the last episode in a litigation series which now rivals "Gunsmoke" for longevity, but the court's oblique analysis may have shifted the grounds of argument onto legal and technological quicksand. The comment suggests that a more direct approach to the nature of the works and their originality, or lack thereof, would have produced the same results while providing a clearer statement of the originality standard as applied to compilations in the digital environment.

II. Background

A. Statutory Framework And Pre-Electronic Precedent

{5} Case reporters may be categorized, for copyright purposes, as either compilations or derivative works, both of which are included within the subject matter of copyright by 17 U.S.C. ' 103.[6] All collections of case reports are compilations, but those which contain substantial "value-added materials," such as headnotes or annotations,[7] may also be considered derivative works as to those elements. The *Bender* text case further suggests that individual case reports, and their constituent features, may be characterized as both compilations and derivative works if the reports contain added facts or other original material.[8] Under ' 103, the copyright in such works extends only to the original material contributed by the author, but not to the "preexisting material" employed in the work.[9] Originality and fixation in a tangible medium of expression are the threshold requirements for copyright.[10]

{6} The "preexisting material" for case reports, the basic texts of the court opinions themselves, are "government works" exempted from copyright protection. All United States government works, including case reports from federal courts, are specifically excluded from copyright protection by 17 U.S.C. ' 105. The Copyright Act contains no specific provision regarding state or local government works, but it is well established by case law that state judicial opinions belong to the public domain and cannot be copyrighted.[11]

{7} Almost a century prior to *West Publishing,* a line of cases specifically concerning case reports established that compilers could obtain copyright only in original materials which they contributed to the compilation, such as headnotes, syllabi, indices, and digests, and in their selection and arrangement of the totality. Courts differed somewhat in their exact cataloging of those features of case reporters which were entitled to protection, though the variations were of minimal significance until the advent of online research services.

[12]

{8} However, a second line of cases, involving fact situations less directly relevant to case reporters, also developed in the lower courts early in this century. The "industrious collection" or "sweat-of-the brow" cases rewarded the mere labor of compilation with little regard to the originality requirement.[13] These two lines of cases provided the precedential background for *West Publishing*, the first episode in the modern series of lawsuits over pagination.

B. *West Publishing*

{9} In the mid-1980's, Lexis-Nexis, West's only major competitor in case-related research services, announced its intention to star paginate to the West reporter system in its online case reports.[14] It intended to indicate not only the initial page number of each report but each page break within the report. West claimed copyright infringement and won preliminary injunctions first in the District Court for Minnesota,[15] then in the Eighth Circuit. Both courts rendered full opinions which seemed to determine the merits of the case.

{10} The Court of Appeals largely eschewed analysis of the 1976 Copyright Act, but focused on prior judicial precedent, in particular dictum in *Callaghan v. Myers*[16] which listed pagination among the protectable elements of compilations. Giving the originality requirement relatively short shrift, the court concluded that only a minimal showing was required and that West's case arrangement was sufficiently creative to support copyright protection. Though the court confessed that pagination, in itself, was insufficiently original to merit copyright, it elaborated a connection between pagination and the protected arrangement.[17] The court found that Lexis users could, if so inclined, use star pagination as a guide enabling them to view the complete arrangement of cases in the entire West reporter system as well as the particular location of each portion of an opinion. Consequently, they would have no need to consult West's print volumes, and West's market would be harmed. The court did not address the argument that the same result could be achieved by using the citations to the first page of the report, which West admitted then, and continues to admit, to be a fair use. It rejected the argument that page numbers are mere facts, not protected by copyright, citing a case of the industrious collection school.[18]

{11} *West Publishing* appeared to foreclose the unlicenced use of West's pagination by competitors and emboldened West, in later litigation, to extend its copyright claims to textual additions and corrections in case reporters and to section numbering in statutory compilations.[19] However, the Supreme Court's decision in *Feist Publications Inc. v. Rural Telephone Service Company, Inc.*,[20] cast serious doubt on the Eighth Circuit's interpretation of the originality requirement.

C. *Feist Publications*

{12} In *Feist*, the Supreme Court addressed the scope of copyright protection for compilations in the context of a copyright infringement suit between two compilers of telephone directories. Such directories formerly found protection in those courts endorsing reward for industrious collection.[21] The *Feist* court stated unequivocally that "originality is a constitutional requirement."[22] Since facts are not authored, but are merely discovered, they are part of the public domain. Factual compilations meet the originality standard for copyright only if the compiler independently makes choices as to selection and arrangement of the facts which entail a minimal degree of creativity. However, such selections and arrangements receive only "thin protection" against near-verbatim copying. The court explicitly rejected the "sweat of the brow" cases, which rewarded the mere labor of fact compilation without a showing of originality.[23] While the originality standard requires only "some minimal level of creativity" for a compilation to achieve copyright protection, not all compilations will be sufficiently original to trigger copyright protection. Even where the work is copyrightable, ' 103 specifically limits its protection to the author's original contributions.[24]

{13} Feist definitively established several guiding principles for protection of compilations: (1) originality is the touchstone for copyright protection not only under the statute but under the Constitution's Copyright Clause; (2) the mere labor of collecting data, i.e., "sweat of the brow," does not warrant protection absent originality in the selection and arrangement of data; (3) compilations receive only "thin" protection even for original selection and arrangement - the underlying information cannot be copyrighted.[25]

{14} The court's opinion offered some guidelines - the work need not be "novel,"[26] but cannot be "mechanical" or "routine" or "entirely typical"[27] - and suggested that the vast majority of compilations will pass the originality test, save for "a narrow category of works in which the creative spark is utterly lacking or so trivial as to be virtually nonexistent." [28] Lower courts interpreted these guidelines case-by-case, gradually developing a body of law implementing *Feist*.**[29]** These cases suggest that originality requires some degree of individualized judgment and that alphabetical, geographical, or chronological arrangements are likely to be considered unoriginal.[30]*Feist* and its successor cases clearly reopened the question of copyrightability of pagination and litigation inevitably followed.

D. *Oasis*

{15} In *Oasis Publishing Co. v. West Publishing Co.*,[31] a Florida CD-ROM publisher which planned a CD compilation of Florida cases, challenged West's right to copyright protection in page numbers in the Southern Reporter. The District Court of Minnesota relied heavily on *West Publishing* in holding that West's arrangement of cases was sufficiently original to be protected, that internal pagination was protected as a corollary to the arrangement, and that star pagination would infringe Wests copyright in the arrangement. The court rejected Oasis's contention that *Feist* implicitly overruled *West Publishing* stating that the *West Publishing* court applied "essentially the same" creativity standard applied in *Feist*.[32] The court specifically rejected the argument that pagination was a mere system or process not subject to copyright[33] as well as the argument that a user could as easily replicate West's arrangement from the first page of the citation as from the internal cites.[34] Like the *West Publishing* court, the *Oasis* court focused on anticipated harm to West's market, averring that replication from the first page cites would not supplant the need for West's products while replication from the jump cites would do so and, consequently, would constitute infringement.[35] The case was settled after issuance of the District Court opinions in the *Bender* cases.[36]

E. The *Bender* Cases - District Court

{16} In a fact situation nearly identical to that in *Oasis*, Matthew Bender sought a declaratory judgment that its use of star pagination to West Reporters on a CD-ROM containing New York case law would not constitute infringement.[37] It brought its action in the district court for the Southern District of New York, within the Second Circuit which has developed the most substantial body of law interpreting the post-*Feist* originality requirement. Rejecting the "protection-by-reference-to-arrangement" approach, the district court held that page numbers are mere facts, do not embody any original creation of the compiler and are not copyrightable.[38]

{17} In a companion case,[39] the New York court reviewed the copyrightability of a different set of compilation elements. Hyperlaw, Inc., planned to scan West Reporters to obtain the title, text, and certain other information for a number of United States Supreme Court and Court of Appeals cases.[40] West contended that its editorial revisions and additions to case text were protected under the "minimum creativity" standards for compilations. Hyperlaw argued, and the court agreed, that, since Hyperlaw scanned only the text of individual opinions, the extent of West's copyright in any single opinion must be determined under the derivative works standard, which requires a substantial, not merely trivial, variation from the base text.[41]

{18} The court found that Hyperlaw's scanning would not affect any elements which represented West's original creation, such as its arrangement, indices, headnotes, and selection of cases. The court reviewed a

plethora of editorial additions and corrections to text and found that none of them, separately or collectively, amounted to a distinguishable variation from the opinion as written by the court.[42] West, the court held, had no protectable interest in any portion of the opinions.[43] West appealed both decisions to the Second Circuit where a three-judge panel, splitting 2-1, affirmed the District Court holdings.

F. The Bender Cases - Second Circuit.

1. The Pagination Case

{19} In the pagination case, West conceded that its pagination was inserted by an automated computer program and did not seriously press its claim that pagination, in itself, is sufficiently original to obtain copyright protection. The court ruled decisively that internal pagination does not possess even a modicum of creativity and that volume and page numbers are not protected by copyright and may be copied. However, West resurrected the protection-by-reference-to-arrangement argument with a new technological twist, alleging that, under the definition of "copies" in 17 U.S.C. ' 101, any work that allows perception of the arrangement through the aid of a machine creates a copy of the compilation. Since a user could employ Bender's CD-ROM file-retrieval programs to perceive West's arrangement, West's copyright was infringed.[44]

{20} The court rejected this argument on two grounds. First, West admitted that identification of volume and first page number of each case was fair use. Since use of these citations already allowed the user to perceive the arrangement of West's reporters, the only incremental information provided by star pagination to internal page numbers was the location of page breaks which did not result from any creative activity by West and could be freely copied. Since fair use pagination already created a lawful copy, star pagination to internal cites could not create an infringing copy even assuming that West's definition of "copying" was valid. The court specifically rejected the *Oasis* court's holding to the contrary.[45]

{21} Second, and more importantly, the court held that, in order for a CD to infringe West's arrangement, the machine or device that reads it must perceive the embedded material in a substantially similar arrangement. If the intervention of a third party is required to rearrange the materials into the copyright holder's arrangement, there can be no infringement by the CD absent some invitation to users to commit infringement.[46] The court noted that ' 101's definition of "copies" to include machine-readable works was directed only to the fixation requirement and was meant to define the material objects in which copyrightable and infringing works may be embedded, not to address questions of arrangement or rearrangement of content.[47] Nonetheless, the court then engaged in a complete infringement analysis based on West's claims that the CDs were copies which infringed its arrangement.

{22} Having determined that the relevant arrangement of cases on the plaintiff's CDs was the arrangement in which the data was physically embedded and perceived by a machine, without user intervention, the court applied the standard infringement test assessing substantial similarity between the plaintiffs' arrangements and West's arrangement. Since the fixed arrangement of the plaintiffs' CDs contained many additional cases and was arranged in a different sequence than West's, there was no direct infringement by the plaintiffs. Only the intervention of a third party, the user, could create an actionable copy.

{23} The court further rejected West's argument that the CD-ROM manufacturers were guilty of contributory infringement by making it possible for users to retrieve and print cases in the same arrangement as West's reporters. West could neither identify any direct infringer, other than its own counsel, nor offer any evidence that Bender or Hyperlaw encouraged such infringement. Additionally, the CDs clearly were capable of substantial noninfringing uses which exempted their makers from contributory infringement.[48]

{24} The majority opinion specifically rejected the Eighth Circuit's opinion in *West Publishing* finding that

"at bottom, West Publishing Co. rested upon the now defunct >sweat of the brow doctrine" and erroneously protected West's industrious collection rather than its original creation.[49] Judge Sweet, in dissent, argued that *West Publishing*, on the contrary, was still good law after *Feist* and that pagination was an essential part of the protectable selection and arrangement of the case reporters.[50]

2. The Text Case

{25} In the text case, West dropped its claim to copyright in textual corrections of spelling and grammar, but maintained claims to four other categories of editorial changes: "arrangement" of information specifying the parties, court and date of decision; "selection and arrangement" of information concerning counsel; "arrangement of information" to reflect subsequent procedural developments; and "selection" of parallel and alternate citations to cases cited in the opinions.[51] The first category, notwithstanding the claim's recital of the word "arrangement," also included capitalization and shortening of case names, restyling of dates, names of courts, and other word changes. The third and fourth categories included alterations in case text or in citations to reflect later history.

{26} The court initially addressed conflicting claims by the parties as to whether individual case reports should be considered as a compilations or derivative works. The court found that case reports contain elements of both compilations and derivative works, but that the reports need not be characterized as either for the purposes of its determination. The originality standard for both works is "essentially the same," the court asserted, notwithstanding that originality for compilations is defined as "a minimal level of creativity" while the standard for derivative works is a "substantial, not trivial variation" from the original.[52] Since each of the claimed elements merely added or rearranged preexisting facts, the court found that they were unprotectable in themselves and could only be protected if West exercised creativity in its selection or arrangement. The court established a three-part standard for creativity in selection and arrangement based on: (1) the total number of options available; (2) external factors that limit the viability of certain options and render others noncreative; and (3) prior uses that render certain selections "garden variety."[53]

{27} Applying that test to the first three categories of West alterations, the court found them to be standardized, garden variety decisions in which only one to three realistic options were available to West. West's choices were narrowly limited by industry standards. The parallel citations presented a closer question but the court concluded that West's decisions concerning citation alterations were inevitable, typical, dictated by legal convention, or at best binary. The court observed that, if West's citation decisions were copyrightable, competitors would find it nearly impossible to create a noninfringing, useful case report and West would obtain an effective monopoly over the commercial publication of case reports containing parallel citations. Reviewing West's overall decision to make all of the claimed changes, the court found them to exhibit little creative insight. [54]

{28} Despite its reliance on limited options as a factor in the originality determination, the court specifically refused to apply merger doctrine per se, stating that the doctrine was only appropriately used in infringement determinations not determinations of copyrightability. Moreover, West's work did not constitute a "building block of understanding" to which merger doctrine appropriately applied.[55]

{29} Judge Sweet once again dissented,[56] suggesting that West's decisions are sufficiently original given that federal judges may not include the same alterations in their opinions. He urged that West's decisions must be considered in their aggregate, not individually, suggested that Hyperlaw's desire to copy West's reports indicated originality, and argued that West's selections only seem obvious because of West's success in the market, that is, because West's system has become the industry standard.[57] Addressing merger doctrine directly, he suggested that granting West copyright in its additions posed no danger of granting them a

monopoly in the "idea" of publishing judicial opinions.

III. The Meaning of Originality

{30} There are several key areas of both opinions which demand closer scrutiny: the court's assertion that originality standards for compilations and derivative works are identical, its inclusion of "limited options" as a factor in the originality test, and its treatment of the definition of "copies" under 17 U.S.C. '101.

A. The Text Case

1. The Distinction Between Derivative And Compiled Works

{31} The court would have clearly been correct in concluding that case reporters contain elements of both compilations and derivative works. Each reporter contains a selection of cases, compiled within a certain arrangement, as well as substantial materials, such as headnotes, indices and digests, which are derived from and transform the basic texts. However, the court's conclusion that the editorial alterations of individual case reports contain elements of both kinds of works is unconvincing. The court relied on the addition of discrete facts such as attorney's names, parallel citations and later history to support the definition of the report as a compilation. The other changes made by West, including rearrangement and stylistic editing of prefatory information, text, and citations are clearly editorial and derivative in nature. However, in common parlance and in actual practice, all of West's alterations would be considered "editorial revisions, annotations, elaborations, or other modifications" within the clear meaning of the derivative works definition.[58] All of them build from the basic text of the opinion and have no meaning apart from it. Individual case reports, as edited by West or anyone else, are correctly classified as derivative works, not compilations, and that categorization has some consequences for the originality analysis.

{32} The Second Circuit purported that it need not definitively decide whether the case reports are derivative works or compilations because the originality standard required for copyright is the same for both kinds of works. Its task was simply to determine whether West's alterations, considered collectively, demonstrated sufficient originality and creativity to be copyrightable.[59]

{33} However, West, Hyperlaw and the District Court clearly believed that the determination whether case reports are compilations or derivative works would affect the originality standard. West's claims were carefully phrased to emphasize that all elements involved arrangement or selection of data, features typical of compilations, as opposed to editorial revision or correction. It seems likely, in fact, that the claim to copyright in spelling and grammatical corrections was dropped, not only because it was a clear loser, but in order to bolster West's claim that case reports are compilations, not derivative works. Wests obvious presumption was that the "substantial, not trivial variation" requirement for derivative works was at least different in kind, and probably more stringent, than the minimum creativity standard for compilations.

{34} Certainly both kinds of works must meet a threshold creativity requirement in order to obtain copyright. The additional matter added or the manner of rearranging or transforming the prior works must constitute more than a minimal contribution.[60] However, the originality inquiries for the two categories start from different bases. In the case of compilations, the compiler's originality must inhere in its selection or arrangement of data or the quality of its added materials. In the case of derivative works, the transformed product must be compared directly against the underlying work and must represent a sufficiently substantial variation therefrom to establish minimum creativity. The compilation inquiry is a free form inquiry into creativity in the context of all prior art; the derivative works inquiry must show minimum creativity but

demands direct comparison with an underlying work which may already contain many of the elements normally associated with originality. The derivative works comparison is, at least arguably, a tougher test. Under a derivative works standard, the compiler of case reports must show not only its additions and alterations to text are minimally creative in the sense that they involve individualized judgments not governed by rote practices common to the industry, but also that the alterations create nontrivial variations from the original text of the court's opinion.

{34} Because of its failure to recognize this distinction, the court applied its three-factor test for creativity in selection and arrangement to every feature claimed by West, regardless of whether the alteration related to selection or arrangement of data or was a direct revision of existing text. The Second Circuit's conflation of the two analyses may have been based on an underlying, and probably correct, determination that West's case reports would not withstand inquiry under either a compilation or derivative works analysis. If case reports are viewed as compilations, the added data (attorney's names, etc.) are facts, not protectable in themselves, and their selection and arrangement are, as the court suggests, constrained by "industry practice" in the legal profession to a very small number of options. If reports are viewed as derivative works, West's edited reports retain those faults and, additionally, vary in only minor ways from the underlying public domain texts. As the court notes, "faithfulness to the public-domain original is the dominant editorial value, so that the creative is the enemy of the true."[61]

{35} The court's avoidance of the categorization issue and imposition of the same standard to both compilations and derivative works, while convenient in the case at hand, obscures differences in the originality analyses for the works which may create difficulties if applied to works other than case reports. Similarly, its formulation of the three-part test for creativity, though producing a laudable result in this case, seems to surreptitiously import elements of merger doctrine into the copyrightability determination, without directly addressing the usual issues of merger analysis.

2. Originality and Merger

{36} Merger doctrine is a collateral branch of the idea/expression dichotomy which informs the entire body of copyright law. Ideas belong to the public domain from which all authors may freely draw the building blocks for their creative works. Copyright protects only the individualized expression of the idea. Merger doctrine precludes copyright protection for some expressions of ideas if the idea behind the expression is such that it can be expressed only in one way or in a very limited number of ways. The doctrine prevents an author from monopolizing an idea by copyrighting a few expressions of it.[62] Courts vary in their treatment of merger doctrine as either a threshold bar to copyright protection or simply a defense to the charge of infringement on grounds of substantial similarity. Nimmer asserts that the latter is the better view because it evaluates separability of idea from expression in particular factual contexts, rather than per se.[63]

{37} In the text case, Hyperlaw urged that the court apply merger doctrine to bar copyrightability of West's revisions to opinions. The court specifically declined to do so on the grounds that the Second Circuit considers merger doctrine only in the context of the infringement analysis. Under that approach, a defendant who copied the plaintiff's work would not be allowed to rely on merger to avoid liability. Since Hyperlaw sought to copy West's case reports, it could not take advantage of the merger doctrine. Moreover, West's opinions were not a "building block" of understanding which was the type of expression to which merger doctrine applies.[64]

{38} However, the court nonetheless incorporated a merger-like analysis into its originality test by defining creativity in selection and arrangement as, in large part, a function of the total number of options available and external factors limiting the viability of certain options. It asserted that "selection from among two or three options, or of options that have been selected countless times before and have become typical, is insufficient. Protection of such choices would enable a copyright holder to monopolize widely used

expression and upset the balance of copyright law."[65] While the court refers to monopolization of expression, rather than idea, its rationale incorporates the guiding principle of merger doctrine without troubling the court with the attendant, often painful, necessity of defining the particular idea which may have merged with the expression.[66]

{39} In practical effect, the number of options available will always be influenced by external factors limiting the viability of certain options so that the first two factors in the court's originality analysis tend to merge with one another to establish the scope of permissible variations. The analysis is reminiscent of the analysis in software cases, an area of law in which merger doctrine has become particularly important, because options for expression are limited by industry standards and interoperability requirements.[67] The court may have formulated a merger-like originality standard which will deny protection in any industry in which standardization is a dominant factor and creativity "can only proceed in a narrow groove."[68] The unanswered question, presumably to be determined on a case-by-case basis, is the precise number of options beyond which choices may rise to the level of creativity. Three options are not enough, but are four or five sufficient? If the four or five options are widely used, does the prior use prong of the test preclude originality notwithstanding the wider selection of choices?

{40} In this particular case, the court's originality analysis renders the same result which might be anticipated under a more straightforward application of merger doctrine to the issue of copyrightability. Judge Sweet's dissenting approach, which weighs the likelihood of monopolization of the "idea" of publishing judicial opinions, is at least direct, though his definition of the idea may be overly broad. While the complexities of merger analysis are well beyond the scope of this comment, some clarification of the Circuit's approach to merger doctrine in the context of determinations of copyrightability would seem to be in order.

B. The pagination case: Losing the Focus on Originality

{41} In the pagination case, the court's focus shifted from the individual case report to the reporter volume as a whole. The court's position that pagination, in itself, is not remotely original enough to support copyright, now seems to represent the universal consensus. This position supported the second step in the court's logic, that inclusion of star pagination to internal page breaks did not impact protected material. With the copyrightability of pagination per se disposed of, the logical third step in the analysis of West's claims should have been a determination of the copyrightability of West's reporter arrangement. However, the court eschewed Hyperlaw's invitation to assess whether West's arrangement was, in fact, original enough to be copyrighted.[69] Instead, it assumed copyrightability for purposes of the argument and turned directly to an infringement analysis, evaluating West's argument that a work which allows the perception of a protectable element of a compilation through the aid of a machine amounts to an actionable copy of the compilation. Following West down a path best left untravelled, the Court engaged in successive rounds of analysis of "copying," infringement and substantial similarity, wading hip deep into murky waters which its opinion does nothing to clarify.

{42} The courts have rarely distinguished themselves in their efforts to define the word "copies" in response to new technologies. In *White Smith Publishing Co. v. Apollo Co.*,[70] the Supreme Court held that piano rolls for player pianos were not "copies" of the musical compositions whose performance they enabled, because they did not mimic the format of a printed sheet of music and were not intelligible to the human eye. That limited definition was intentionally quashed by Congress when it enacted the 1976 Copyright Act, defining copies to include any material object "in which a work is fixed by any method now known or later developed, and from which the work can be perceived, reproduced or otherwise communicated, either directly or with the aid of a machine or device."[71] The definition expanded the fixation requirement to include new technologies like CD-ROMs or computer hard drives.

{43} Faced with the implications of computer technology, the Ninth Circuit subsequently went so far as to

define actionable "copying" to include downloading of data into random access memory.[72] While its position is heartily endorsed by content providers and has now been endorsed by some other circuits,[73] but the court failed to appreciate that virtually any use of a computer entails such "copying" and thereby made potential infringers of almost everyone who "boots up" a computer and explores the World Wide Web. Now the Second Circuit adds yet another gloss which inserts machine capabilities into the infringement analysis in a way probably unanticipated by Congress.

{44} As the court itself notes, the sole purpose of ' 101's definition of "copies" is to explicate the fixation requirement.[74] The legislative addition of the language concerning perception with the aid of a machine was meant to insure that reproductions in machine-readable media would meet the fixation requirement for copyrightability.[75] Congress' intention was to ensure media-neutrality, making the law flexible enough to adapt to new technologies. Standards for infringement parallel the standards for copyright protection, but it may be questioned whether the Aperception by machine language@ of the definition of "copy" ought to be so directly injected into an infringement analysis as to govern what constitutes an infringing arrangement.

{45} The court avoids the potential consequences of its definition, in this case, by virtue of the fact that the CDs in question contained additional data in arrangements quite different from West's. The disks could only be made to mimic West's arrangement though the active intervention of a user electronically "cutting and pasting" a copy, a task which the court recognizes to be "thankless toil" extremely unlikely to occur.[76] However, the court's statement of the appropriate scope of infringement analysis indicates that a CD which could be directly read by a device which renders a protected arrangement perceptible without user intervention would infringe on West's arrangement. If, for example, a third party competitor provided a search and retrieval device which automatically allowed Matthew Bender's disks to be read in West order, would Matthew Bender then become a contributory infringer merely by proffering a CD which could be so read? Would the third party also be a contributory infringer? What if the device's ability to read West's arrangement were entirely incidental to other capabilities with substantial noninfringing uses?

{46} The court's clear identification of direct and contributory infringers and its acknowledgment of the complete dearth of evidence of any direct infringement are welcome, but the court should have avoided this line of analysis altogether. *White-Smith* illustrated the dangers of tying the definition of a "copy" to an infringement analysis involving a particular technology in a particular fact situation. Congress intentionally drafted the definition of "copies" to avoid technology-specific readings of the statute and achieve media neutrality. However, the Second Circuit has now made specific technological capabilities the central focus of the definition, at least for infringement purposes. Moreover, the mere formulation of the scenario in the preceding paragraph clearly begs the response "Why would anyone trouble to create a device which emulates Wests arrangement?"

{47} The plain fact of the matter is that West's arrangement as such is entirely irrelevant in the electronic context. No user of electronic products is interested in employing West's arrangement, much less copying it. If West were to rearrange its reporters into strictly chronological order, users of electronic research technologies would care little as long as practitioners could correlate opinion text with page numbers for purposes of citation. The valuable element of West's print compilations, which it has sought to protect through increasingly convoluted legal arguments in seemingly endless rounds of litigation, is simply its pagination, those electronically-generated Arabic numerals which even the *West Publishing* court could not find original in their own right.

{48} Even if that were not the case, it is clear, following *Feist*, that West's arrangement is itself insufficiently original to support copyright. West's system for case reporters consists of separations by geographic region, jurisdiction, and court with a largely chronological internal structure. In light of post-*Feist* holdings discounting originality in geographic and chronological arrangements, its arrangements are as commonplace as the garden-variety, alphabetic arrangement of the *Feist* directory.[77] Rather than elaborating on the

copying and infringement issues in order to avoid the originality question, the Second Circuit should have addressed the originality claim head on. Originality, not copying, has been at the center of the controversy since *Feist* and it would certainly have made more sense for the court to determine whether West's arrangement was protected by copyright at all before tackling the inherently more complex questions of copying and infringement. Had it done so, the court might have contributed to a final denouement for the pagination tale, instead of merely setting the stage for the next episode.

IV. Conclusion

{49} While the results reached in the *Bender* cases are consistent with the Supreme Court's holdings in *Feist*, the court's treatment of the originality standard for compilations begs for clarification. West's request for rehearing en banc was denied, but a petition for certiorari to the Supreme Court is expected.[78] The Supreme Court ought to take the opportunity to resolve the dispute between the Second and Eighth Circuits and clarify the appropriate interpretation of the originality standard as applied to case reporters and other legal compilations. The correct interpretation should exclude pagination and editorial corrections from the scope of copyright protection and lay to rest West's claims to protection through reference to an arrangement which is itself unoriginal. It should not entangle the courts unnecessarily in debates over the definition of "copies" in the electronic age, particularly when those arguments are raised to protect stakeholders in fading technologies at the expense of market competition in new technologies.

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[**] **NOTE:** All endnote citations in this article follow the conventions appropriate to the edition of THE BLUEBOOK: A UNIFORM SYSTEM OF CITATION that was in effect at the time of publication. When citing to this article, please use the format required by the Seventeenth Edition of THE BLUEBOOK, provided below for your convenience.

Deborah Tussey, The Creative as Enemy of the True: The Meaning of Originality in the Matthew Bender Cases, 5 RICH. J.L. & TECH. 10, (Spring 1999), *at* http://www.richmond.edu/jolt/v5i3/tussey.html.

[1] 33 U.S. (8 Pet.) 591 (1834) (holding that no reporter could copyright the texts of Supreme Court opinions).

[2] See THE BLUEBOOK: A UNIFORM SYSTEM OF CITATION (16th Ed. 1996), rule 10.3.1, at 61-62.

[3] 799 F.2d. 1219 (8th Cir. 1986). At the time, the Lexis-Nexis service was operated by Mead Data Central, a subsidiary of Mead Corp. MDC was subsequently sold to Reed Elsevier, an Anglo-Dutch Corporation, which currently owns it. West Publishing Co. is now owned by the Thomson Corporation.

[4] 158 F.3d 674 (2d Cir. 1998) (hereinafter referred to as the text case) and 158 F.3d 693 (2d Cir. 1998) (hereinafter referred to as the pagination case).

[5] I have addressed the doctrinal, economic and policy considerations supporting this assertion in Owning the Law: Intellectual Property Rights in Primary Law, 9 FORDHAM INTELL. PROP., MEDIA & ENT. L. J.173.

[6] Compilations are works "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." Derivative works are based upon one or more preexisting works, such as a translation, musical arrangement, dramatization, fictionalization, motion picture version, sound recording, art reproduction, abridgment, condensation or any other form in which a work may be recast, transformed, or adapted. A work consisting of editorial revisions, annotations, elaborations, or other modifications which, as a whole, represent an original work of authorship, is a 'derivative work.' 17 U.S.C. ' 101 (emphasis added).

[7] The term "value-added" includes features such as annotations and headnotes, which summarize or comment on the underlying texts, as well as digests, indices, search engines, hypertext links and other access tools which provide access to related data.

[8] See discussion infra Part III.

[9] See 17 U.S.C. ' 103(b).

[10] See 17 U.S.C. ' 102.

[11] See 1 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT ' 5.06(C) (1978).

[12] See Wheaton v. Peters, 33 U.S. (8 Pet.) 591 (1834) (holding that no reporter could own a copyright in the basic text of opinions issued by the Supreme Court); Banks v. Manchester, 128 U.S. 244, 253 (1888) (extending the principle to state court opinions); Callaghan v. Myers, 128 U.S. 617 (1888) (confirming that judicial opinions could not be copyrighted, but held that no public policy precluded the reporter from obtaining a copyright covering those parts of the volume which were the results of his "intellectual labor@). The Callaghan opinion included dicta (at 661, 662) to the effect that pagination was included in the protectable matter. The Second Circuit subsequently addressed the issue of "star pagination" directly in Banks Law Publishing Co. v. Lawyer's Cooperative Publishing Co., 169 F. 386, 391 (2d Cir. 1909), appeal dismissed per stipulation, 223 U.S. 738 (1911), holding that "the arrangement of reported cases in sequence, their paging and distribution into volumes, are not features of such importance as to entitle the reporter to copyright protection of such details." Similar principles were extended to statutory compilations in Davidson v. Wheelock, 27 F. 61 (D. Minn. 1866) and Howell v. Miller, 91 F. 129, 137 (6th Cir. 1898).

[13] See generally Jane C. Ginsburg, Creation and Commercial Value: Copyright Protection of Works of Information, 90 COLUM. L. REV. 1865 (1990) (discussing the industrious collection cases). Leading cases in this line were Leon v. Pacific Telephone and Telegraph Co., 91 F.2d 484 (9th Cir. 1937) and Jeweler's Circular Publishing Co. v. Keystone Publishing Co., 281 F. 83 (2d Cir. 1922). For a legal information case of this school (involving digests and encyclopedias rather than case reports), see West Publishing Co. v. Edward Thompson Co., 176 F. 833 (2d Cir. 1910).

[14] Star pagination is the practice of inserting page number references to parallel reporters indicating the location of certain text in the parallel publication. Star pagination is used in print, as well as electronic publications. West's Supreme Court Reporter star paginates to the United States Reports, for example.

[15] See West Publishing Co. v. Mead Data Central, Inc., 616 F. Supp. 1571 (D. Minn. 1985).

[16] 128 U.S. 617 (1888). The Eighth Circuit distinguished the opinion in Banks Law Publishing, 169 F. at 387-88, on the grounds that the Banks holding denying copyright to pagination rested on the plaintiff's position as an official reporter. In the Bender pagination case, the Second Circuit panel made the same distinction. See Matthew Bender (pagination case), 158 F. 3d. 693, 700, n. 12 (2d Cir. 1988).

[17] See West Publishing, 799 F.2d at 1223-1226.

[18] See id. at 1227, 1228. The case cited by the court was Hutchinson Telephone Co. v. Fronteer Directory Co., 770 F. 2d 128 (8th Cir. 1985) (holding a white pages telephone directory sufficiently original to support copyright).

[19] West claimed copyright in statutory section numbers in Illinois and Texas. See L. Ray Patterson & Craig Joyce, Monopolizing the Law: The Scope of Copyright Protection for Law Reports and Statutory Compilations, 36 U.C.L.A. L. REV. 719, 725, n.16. (1989). For other law review articles commenting on West Publishing prior to Feist, see William L. Anderson, Copyright Protection for Citations to a Law Reporter: West Publishing Co. v. Mead Data Central, Inc., 71 MINN. L. REV. 991 (1987); Brian A. Dahl, Originality and Creativity in Reporter Pagination: A Contradiction in Terms?, 74 IOWA L. REV. 713 (1989); Cary E. Donham, Copyright, Compilations and Public Policy: Lingering Issues after the West Publishing-Mead Data Central Settlement, 64 CHI.-KENT L. REV. 375 (1988).

[20] 499 U.S. 340 (1991).

[21] See, e.g., Hutchinson Telephone Co. v. Fronteer Directory Co., 770 F.2d 128 (8th Cir. 1985).

[22] Feist, 499 U.S. at 346.

[23] See id. at 351 et seq.

[24] See id. at 354-360.

[25] See 1 PAUL GOLDSTEIN, COPYRIGHT, 2.14 (1989).

[26] Feist, 499 U.S. 340, 346 (1991).

[27] Id. at 362.

[28] Id. at 359.

[29] The Second Circuit decided a particularly influential series of compilation cases. See CCC Information Services, Inc. v. Maclean Hunter Mkt. Reports, Inc., 44 F.3d 61 (2d Cir. 1994)(explaining that compilation of used car valuations protected where valuations represented editorial predictions of expected vehicle values); Key Publications, Inc. v. Chinatown Today Publishing Enterprises, Inc., 945 F.2d 509 (2d Cir. 1991)(stating that selection and arrangement of yellow pages directory for Chinese-American community met originality standard but was not infringed by competing directory which copied some of the listings but arranged them differently); Kregos v. Associated Press, 937 F. 2d 700 (2d Cir. 1991)(pitching form selection of nine performance statistics held copyrightable but arrangement found to be unoriginal); Victor Lalli Enterprises, Inc. v. Big Red Apple, Inc., 936 F. 2d 671 (2d Cir. 1991) (explaining that "lucky numbers" grid insufficiently original to obtain copyright). For cases from other courts, see, for example, Warren Publishing, Inc. v. Microdos Data Corp., 115 F.3d 1509 (11th Cir. 1997) (listing of information about cable TV systems insufficiently creative where it included the entire relevant universe of available information and was compiled by contacting cable operators for information); American Dental Assn v. Delta Dental Plans Assn, 44 U.S.P.Q. 2d 1296 (7th cir. 1997)(holding that a compilation of dental procedures is protectable); Bellsouth Adver. & Publishg Corp. v. Donnelly Info. Publishg, Inc., 999 F. 2d 1436 (11th Cir. 1993)(stating that selection of yellow pages listings by geography, closing dates for changes, subscriber status and other marketing techniques held insufficiently original); Skinder- Strauss Associates v. Massachusetts Continuing Legal Educ., Inc., 914 F. Supp. 665 (D. Mass.1995)(holding that geographic selection and arrangement of legal directory are unprotectable); Khandji v. Keystone Resorts Mgmt, Inc., 140 F.R.D. 697 (D. Colo. 1992)

(settlement brochure discovered during legal proceedings held protectable).

[30] See 1 PAUL GOLDSTEIN, COPYRIGHT, 2.14 (1989).

[31] 924 F. Supp. 918 (D. Minn. 1996).

[32] See id. at 923, 924.

[33] See id. at 925.

[34] See id. at 926

[35] See id.

[36] Oasis filed an appeal of the case in the Eighth Circuit, but the case was settled prior to issuance of an opinion. The parties filed a joint motion to dismiss, which was granted on July 30, 1997. E-mail from Chris Werner, Assistant Systems Manager, 8th Cir., to Deborah Tussey (April 14, 1998) (on file with the author). Evidently, West saw the writing on the wall after the issuance of the district court opinions in the Bender cases and wished to preserve its favorable Minnesota precedent.

[37] A second competitor, Hyperlaw, Inc., intervened in the case as to the pagination issue and also sought a declaratory judgment on the issue of copying the text of certain court opinions for purposes of its own CD-ROM product. The Justice Department filed an amicus brief on behalf of Matthew Bender on the basis of Feist. See, Government Backs Bender in Copyright Battle Over Star Pagination, COMPUTER INDUSTRY LITIGATION REPORTER, Oct. 1, 1996.

[38] See Matthew Bender & Co. v. West Publishing Co. (the pagination case), 41 U.S.P.Q. 2d 1321 (S.D. N.Y. 1996) at 1330. The Oasis and Bender courts both reached the issue of fair use, but again reached conflicting results. The Oasis court found that the commercial nature of the intended use, Oasis' purpose to compete directly with West, and the completeness of the copying of West's arrangement (again by reference from pagination) weighed against fair use notwithstanding the relatively uncreative nature of the work. The court rejected Oasis' argument that transference to a different medium was "transformative" and, in the absence of transformation, presumed market harm to West. Consequently, fair use would not protect Oasis's use of West's pagination. See Oasis, 924 F. Supp. at 926-929.
The Bender court held that, even if pagination could be copyrighted, use of star pagination by a competitor was fair use. The court found that "the underlying equities" counterbalanced the obviously commercial nature of the use. The purpose, while commercial, was nonetheless "worthwhile," the taken portions did not reflect any intellectual effort by West and were not substantial in relation to the whole, and use of star pagination would not necessarily impact the market for printed books. See Matthew Bender, 41 U.S.P.Q. 2d at 1330.

[39] See Matthew Bender & Co. v. West Publishing Co., 42 U.S.P.Q.2d 1930 (S.D.N.Y. 1997).

[40] Hyperlaw did not plan to scan West's headnotes or key numbers, but admitted that it might ultimately scan up to 75% of West's case texts into its system. See id. at 1932.

[41] See id. See also Woods v. Bourne Co., 60 F.3d 978 (2d Cir. 1995) and L. Batlin & Son, Inc. v. Snyder, 536 F.2d 486 (2d Cir. 1976) (en banc) (establishing the derivative works standard in the Second Circuit).

[42] See Matthew Bender, 42 U.S.P.Q. at 1934-1935. The editorial changes considered by the court included addition or correction of case names, docket numbers, dates, attorney and judge names, subsequent case histories, modifications of earlier opinions, spelling and grammatical errors and parallel citations.

[43] See id. at 1935.

[44] See Matthew Bender & Co. v. West Publishing Co. (pagination case), 158 F.3d 693, 699-700 (2d Cir. 1998).

[45] See id. at 701.

[46] See id. at 702-706.

[47] See id. at 702.

[48] See id. at 706.

[49] Id. at 708.

[50] See id. at 708-711.

[51] See Matthew Bender & Co. v. West Publishing Co. (text case), 158 F. 3d 674, 681 (2d Cir. 1998).

[52] See id. at 680.

[53] See id. at 681-683.

[54] See id. at 684-687.

[55] See id. at 683-689 and n.12.

[56] See id. at 689.

[57] This recurring argument should be laid to rest. A strong case could be made that anyone entering the print case reporter business would necessarily make precisely the choices West makes, both as to arrangement and editorial revision, because they are inherently obvious and practical. Even if one credits West with the original inspiration for such choices, its editorial policies were established well over a century ago and have been followed by rote since. The lifeline on this particular inspiration has certainly expired by now under any theory of copyright, much as trademarks become generic once the public adapts them to refer to all products of a certain type.

[58] See 17 U.S.C. 101.

[59] The House Report on the 1976 Copyright Act observes that: "There is necessarily some overlapping between the two, but they basically represent different concepts. A 'compilation' results from a process of selecting, bringing together, organizing, and arranging previously existing materials of all kinds, regardless of whether the individual items in the material have been or even could have been subject to copyright. A 'derivative work', on the other hand, requires a process of recasting, transforming, or adapting 'one or more preexisting works'; the 'preexisting work' must come within the general subject matter of copyright set forth in section 102, regardless of whether it is or was ever copyrighted." H.R. Rep. No. 94-1476, at 57(1994).

[60] 1 Nimmer, supra note 11, at 3.03.

[61] Matthew Bender & Co. V. West Publishing Co. (text case), 158 F.3d 674, 687 (2d Cir. 1998).

[62] See Matthew Bender & Co. v. Kluwer Law Book Publishers, 672 F. Supp 107 (S.D.N.Y. 1987); Toro Co. v. R & R Products Co., 787 F.2d 1208 (8th Cir.1986); Morrissey v. Procter & Gamble, 379 F.2d 675

(1st Cir. 1967).

[63] See 4 Nimmer, supra note 11, at 13.03(B)(3).

[64] See Matthew Bender (text case), 158 F.3d at 688, n 12. The court's conclusion was based on Kregos v. the Associated Press, 937 F.2d 700 (2d Cir. 1991) a key post-Feist case, which involved originality and copyrightability of a pitching statistics form. However, Judge Sweet, in partial dissent in Kregos, argued that the infringement rule was not, in fact, the majority rule in the circuits overall. He suggested that the merger determination ought to be made at the copyrightability stage, in order to avoid the "not useful variety of doublespeak" in which two identical works are held not to be "substantially similar" for infringement purposes because of application of the merger doctrine.

[65] Matthew Bender (text case) 158 F.3d at 682.

[66] See Kregos, 937 F.2d at 705-707 and 711-716 for an illustration of the difficulty of defining the idea behind an expression, particularly where fact compilations are concerned. Arguably, neither the majority nor Judge Sweet, in partial dissent, correctly assessed the idea behind the pitching form.

[67] See Computer Associates International v. Altai, Inc., 982 F.2d 693 (2d Cir. 1992) (interpreting the idea/expression dichotomy in the context of software).
Courts have adapted copyright principles like merger to the largely functional "expression" of computer software with some difficulty, often focusing on the overriding importance of industry standardization in that particular context. Professor Wendy Gordon has argued that intellectual products which serve as standards, specifically West's citations, should not be subject to intellectual property rights. See Wendy J. Gordon, A Property Right in Self-Expression: Equality and Individualism in the Natural Law of Intellectual Property, 102 YALE L.J. 1533, 1595 -1601 (1993). However, it is somewhat disconcerting to find the Second Circuit importing such principles into its analysis with so little explanation of its intentions.

[68] Matthew Bender (text case), 158 F.3d at 688.

[69] See Matthew Bender & Co. v. West Publishing Co. (pagination case), 158 F. 3d 693, 700, n.12 (2d Cir. 1998). The court asserts that since it finds West's arrangement has not been copied, it can assume without deciding that West's arrangement is original and copyrightable.

[70] 209 U.S. 1 (1908). For prior cases cited by the Supreme Court, see Kennedy v. McTammany, 33 F. 584 (D. Mass. 1888) (perforated strips of paper used in organette not "copies"); Stern v. Rosey, 17 App. D.C. 562 (1901) (phonograph recording on wax cylinder not a "copy" of the musical composition but merely part of the machine).

[71] 17 U.S.C. 101.

[72] See MAI Systems Corp v. Peak Computer, Inc., 991 F.2d 511 (9th Cir. 1993).

[73] See NLFC, Inc. v. Devcom Mid-America, Inc., 45 F.3d 231 (7th Cir. 1995), cert. denied 515 U.S. 1104 (1995); Stenograph L.L.C. v. Bossard Associates, Inc., 144 F.3d 96 (C.A.D.C.1998); Marobie-Fl, Inc. v. National Ass'n of Fire and Equipment Distributors and Northwest Nexus, Inc., 983 F.Supp.1167 (N.D.Ill.1997) (all finding downloading into RAM to constitute "copying" for copyright infringement purposes.)

[74] See Matthew Bender (pagination case), 158 F.3d at 702.

[75] The House Report states: "As a basic condition of copyright protection, the bill perpetuates the existing

requirement that a work be fixed in a 'tangible medium of expression,' and adds that this medium may be one "now known or later developed" and that the fixation is sufficient if the work "can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device." This broad language is intended to avoid the artificial and largely unjustifiable distinctions, derived from cases such as White-Smith under which statutory copyrightability in certain cases has been made to depend upon the form or medium in which the work is fixed" H.R. Rep. No. 94-1476, at 52 (1994) (emphasis added).

[76] See Matthew Bender (pagination case), 158 F.3d. at 706.

[77] West did not argue that its selection of cases was infringed and the court did not address that issue, though the comprehensiveness of West's coverage in most of its reporters would seem to weigh against originality. See id at 700, n.11.

[78] Per email from Alan D. Sugarman, President and CEO of Hyperlaw, Inc., dated Feb. 26, 1999, in the author's possession. Mr. Sugarman notes that a settlement between Matthew Bender and West is rumored to have occurred, at least with respect to legal fees.

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