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Thin Copyrights

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I. INTRODUCTION

While the requirement of originality is characterized as both the “sine qua non”\(^1\) and the “touchstone of copyright protection,”\(^2\) the originality required to vest protection in the commercially significant area of fact collection, such as the database industry, was decided by the United States Supreme Court only recently in *Feist Publications v. Rural Telephone Service Co.*\(^3\) The decision of the Supreme Court both to reject the test which permitted copyright protection for works which were the result of industrious effort and to require some modicum of creative effort places in doubt the availability of copyright protection for not only traditional compilations, such as the white pages directory

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involved in *Feist*, but also for more complex databases. Thus, the Court's ruling in *Feist* may result in the evolution of a "thin" copyright which affords only minimal protection.

II. THE REQUIREMENT OF ORIGINALITY

A. Introduction

Before copyright protection is granted, a work must contain sufficient originality to comply with the constitutional requirements for such protection: "[The Congress shall have Power] To 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." Because this provision was deliberated in secret and adopted without debate, the comment of James Madison in *The Federalist Papers* is the best statement of the public policy interest which motivated giving Congress the power to grant patents and copyrights:

The utility of this power will scarcely be questioned. The copyright of authors has been solemnly adjudged in Great Britain to be a right at common law. The right to useful inventions, seems with equal reason to belong to the inventors. The public good fully coincides in both cases, with the claims of individuals.

A century and a half later, the Supreme Court stated the economic philosophy behind the empowerment of protection for copyrights and patents:

4. From a copyright perspective, databases are treated as compilations and receive copyright protection to the extent that the originality requirements for compilations are met. See Copyright Office Circular 65, Copyright Registration for Automated Databases, reprinted in 1 Copyright L. Rep. (CCH) ¶ 15,054 (1992).

5. U.S. Const. art. I, § 8, cl. 8.

The economic philosophy behind the clause empowering Congress to grant patents and copyrights is the conviction that encouragement of individual effort by personal gain is the best way to advance public welfare through the talents of authors and inventors in "Science and useful Arts." Sacrificial days devoted to such creative activities deserve rewards commensurate with the services rendered.7

The standard of originality evolved through an extended series of cases, beginning with Justice Story's articulation of the originality requirement in Gray v. Russell.8 This doctrine was more fully developed by the Supreme Court in Burrow-Giles Lithographic Co. v. Sarony,9 dealing with copyright in a photograph, and in Bleistein v. Donaldson Lithographing Co.,10 dealing with copyright in a circus poster. These two decisions dramatically broadened the availability of copyright protection and provided a framework by which the constitutional dimensions of the originality requirement continued to develop in works exhibiting an individual mark of authorship in their creation.11

Finally, the constitutional provision authorizing patent and copyright protection has compelled a federally granted protection for both patents and copyrights which is necessarily national in scope.12 Thus,
the Constitution restricts the states' right to limit access to materials which the federal scheme has left unprotected.13

B. The Extent of Copyright Protection Under the Copyright Act of 1976

Copyright protection, under the Copyright Act of 1976,14 extends from the time of a work's creation.15 Copyright grants a series of exclusive rights16 which are delineated in section 106 of the Act.17 An infringement action, to enforce rights granted under the statute and to recover damages, requires that a work be original and that the action be brought by the owner of the particular right being enforced.18

In turn, infringement occurs when a copyrighted work is used in one of the five ways prohibited by the statute.19 The exclusive rights granted to the copyright owner which may not be infringed upon by another are the rights: (1) to reproduce the work, (2) to prepare derivative works from the copyrighted work, (3) to distribute the copyrighted work, (4) to perform the work, and (5) to display the work publicly.

The subject matter of copyright is expansive20 and covers all original works fixed in a tangible medium of expression.21 Protection,

21. See Building Officials & Code Adm. v. Code Technology, Inc., 628 F.2d 730,
however, is accorded to the original work of authorship, not to the material object in which it is contained.\textsuperscript{22}

C. Traditional Originality Standards for Copyright Protection

Historically, the standard for originality has been modest.\textsuperscript{23} This lenient requirement for copyright protection was based on a historically developed standard which was codified\textsuperscript{24} into the Copyright Act of 1976. This statutory statement of the historically developed tests requires a work to be "an original work of authorship" which is "fixed in any tangible medium of expression."\textsuperscript{25}

The standard for originality required under section 102(a) of the Act has been addressed in a number of cases and has been reasonably settled for works other than compilations.\textsuperscript{26} But, until the Supreme

\textsuperscript{734} (1st Cir. 1980) (rule of "free access" forecloses copyright in legal authorities).


Thus, in the sense of the bill, a "book" is not a work of authorship, but is a particular kind of "copy." Instead, the author may write a "literary work," which in turn can be embodied in a wide range of "copies" and "phonorecords," including books, periodicals, computer punch cards, microfilm, tape recordings, and so forth.

\textsuperscript{23} If the originality requirement is met, a work is entitled to copyright protection even if an identical work is in the public domain. See United States v. Hamilton, 583 F.2d 448, 451 n.4 (9th Cir. 1978). For a review of the historical development of the originality standard, see Olson, supra note 11.

\textsuperscript{24} 17 U.S.C. § 102 (1988). The legislative history accompanying § 102(a) states:

The phrase "original works of authorship" which is purposely left undefined, is intended to incorporate without change the standard of originality established by the courts under the present copyright statute. This standard does not include requirements of novelty, ingenuity, or aesthetic merit, and there is not intention to enlarge the standard of copyright protection to require them.


\textsuperscript{26} A notable exception was in the Seventh Circuit's opinion establishing the standard for derivative works. See Graen v. Bradford Exch., 698 F.2d 300 (7th Cir. 1983) (emphasizing the need for a significant variation between the underlying and derivative works). In other circuits, the standard for derivative works, while sometimes problematic to identify, is consistently applied. Compare Alfred Bell & Co. v. Catalda Fine Arts, Inc., 191 F.2d 99
Court's decision in *Feist Publications v. Rural Telephone Service Co.*, there was no definitive answer as to the copyrightability of compilations of facts, such as directories. The resulting ambiguity had presented particular problems in applying an originality test. Thus, different tests were developed and applied in different circuits.

The traditional "sweat of the brow" test, permitting copyright protection merely for "industrious collection," was followed by the Seventh, Eighth, and Tenth Circuits. These circuit decisions followed from an early statement of Justice Clifford in *Lawrence v.*

(2d Cir. 1951) *with L. Batlin & Son v. Snyder*, 536 F.2d 486 (2d Cir. 1976) which emphasize the originality of the derivative work in assessing copyrightability.


28. The Copyright Act of 1976 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." 17 U.S.C. § 101 (1988). However, the statute further provides that a compilation is subject to a restricted scope of protection since

copyright in a compilation . . . 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 a work is independent of, and does not affect or enlarge the scope, duration, ownership, or subsistence of, any copyright protection in the preexisting material.


29. A compilation may also exist in the assembly of text and visual elements, such as in a label. *See, e.g.*, *Drop Dead Co. v. S.C. Johnson & Son, Inc.*, 326 F.2d 87, 93 (2d Cir. 1963).

30. *See Rockford Map Publishers, Inc. v. Directory Serv. Co. of Colo.*, 768 F.2d 145, 149 (7th Cir. 1985) ("The collector may change the form of the information and so make it more accessible, or he may change the organization and so make it more understandable."); *Schroeder v. William Morrow & Co.*, 566 F.2d 3 (7th Cir. 1977); *G.R. Leonard & Co. v. Stack*, 386 F.2d 38, 39 (7th Cir. 1967); *Edwards & Deutsch Lithographing Co. v. Boorman*, 15 F.2d 35 (7th Cir.), *cert. denied*, 273 U.S. 738 (1926).

31. *See Hutchinson Tel. Co. v. Frontier Directory Co. of Minn.*, 770 F.2d 128 (8th Cir. 1985); *see also West Publishing Co. v. Mead Data Cent.*, Inc., 799 F.2d 1219 (8th Cir. 1986), *cert. denied*, 479 U.S. 1070 (1987) (holding that the pagination and arrangement of cases within the National Reporter System were subject to copyright protection).

Copyright may justly be claimed by an author of a book who has taken existing materials from sources common to all writers, and arranged and combined them in a new form, and given them an application unknown before, for the reason that, in so doing, he has exercised skill and discretion in making these selection, arrangements, and combinations, and, having presented something that is new and useful, he is entitled to the exclusive enjoyment of his improvement, as provided in the copyright act.

Although it was clearly recognized that facts alone were not subject to copyright protection, a collection of facts based on industrious effort was deemed to be subject to copyright protection. As the court stated in National Business Lists v. Dun & Bradstreet, Inc.:

This court respectfully suggests that the directory cases, rather than being a breed apart, are the most striking illustrations in copyright law that the misappropriation doctrine most commonly associated with International News Serv. v. Associated Press, has there long found a house, if not a home. Compilations, being more the product of diligent application and less the result of intellectual creativity than possibly any other form of protectable work, are at one end of a spectrum extending to art, poetry and music. Diligent application has, through copyright, been accorded a measure of protection because that is the only protection which is meaningful.
Even under the "sweat of the brow" test, a significant exception to the subject matter of copyright excludes protection for blank forms. \(^{39}\) Although a form in which an explanation accompanies the form may qualify for protection, \(^{40}\) a form used only for recording information is precluded from receiving copyright protection. \(^{41}\)

However, the "sweat of the brow" test was far from uniformly accepted, and the Second, \(^{42}\) Fourth, \(^{43}\) Fifth, \(^{44}\) Ninth, \(^{45}\) and Eleventh \(^{46}\) Circuits developed originality tests requiring an element which represents a "modicum of selection, coordination or arrangement" \(^{47}\) on the compiler's part which may be represented by the exclusion of certain facts; however, these tests did not permit copyright merely for industrious collection. The Second Circuit summarized the objection to allowing copyright protection for merely collecting facts in its leading case of Financial Information, Inc. v. Moody's Investors Service,
which found such an approach inconsistent with the essential requirements of copyright law that protection not be determined by the amount of effort the author expends, but rather by the nature of the final result. To grant copyright protection based merely on the "sweat of the author's brow" would risk putting large areas of factual research material off limits and threaten the public's unrestrained access to information.  

D. Traditional Test for Copyright Infringement

American copyright law has long protected directories as a type of compilation. Even white pages, which are merely alphabetical arrangements, were protectible before *Feist* in those circuits which applied the "industrious collection" test which rewarded labor or investment and did not impose a creativity test. Indeed, the Eighth Circuit held page arrangements of a law reporter likewise subject to copyright protection. Protection for these works was accorded under the rubric of protecting compilations. Further, copyright protection is available for any component of a work that, standing alone, embodies sufficient originality.

The corollary of the originality standard is the test for determining whether a copyright on a compilation has been infringed. An infringement action ordinarily requires the plaintiff to own a valid copyright

49. Id. at 207.
50. In *Jeweler's Circular Pub. Co. v. Keystone Pub. Co.*, 281 F. 83 (2d Cir. 1922), the court emphasized the labor-intensive nature of creating a directory by stating: "The man who goes through the streets of a town and puts down the names of each of the inhabitants, with their occupations and their street number, acquires material of which he is the author. He produces by his labor a meritorious composition, in which he may obtain a copyright . . . ." Id. at 88.
and to show that the work has been copied in a manner which intrudes upon the exclusive rights granted in the Copyright Act of 1976. An expansive view of this doctrine was applied in Schroeder v. William Morrow & Co. where infringement was found even though the court acknowledged that the individual facts copied were in the public domain and not copyrightable: "Another is entitled to make his own compilation of the same names and addresses using information in the public domain, but he is not entitled merely to copy the copyright list."56

The Seventh Circuit later affirmed its holding in Schroeder in a case where the defendant’s map had been researched from the plaintiff’s copyrighted map rather than by reviewing original property deeds in the recorder’s office. Failure to perform that step of developing the underlying facts independently constituted infringement, even when the copied facts were used to create a different map.57

III. THIN COPYRIGHTS

A. Feist Publications v. Rural Telephone Service Co.

Against this backdrop, the Supreme Court’s review of the law involving simple alphabetical compilations arose in Feist Publications

55. 566 F.2d 3 (7th Cir. 1977).
56. Id. at 5-6.
58. THE REPORT OF THE UNITED STATES NATIONAL COMMISSION ON NEW TECHNOLOGICAL USES OF COPYRIGHTED WORKS [hereinafter CONTU] which was established by Congress during the copyright revision process which resulted in the Copyright Act of 1976, stated:

The use of one item retrieved from such a work—be it an address, a chemical formula or a citation to an article—would not under reasonable circumstances merit the attention of the copyright proprietor. Nor would it conceivably constitute infringement of copyright. The retrieval and reduplication of any substantial portion of a database, whether or not the individual data are in the public domain, would likely constitute a duplication of the copyrighted element of the database and would be infringement.

In this case the district court held that a publisher who created an area directory from the telephone company’s alphabetical white pages containing names, towns, and telephone numbers infringed on the telephone company’s copyright. The Tenth Circuit affirmed in an unpublished opinion. The United States Supreme Court reversed the holding below that simple, alphabetical white pages were copyrightable; accordingly, the second publisher’s use of the directory could not constitute copyright infringement.

The Court’s decision in *Feist* includes not only a specific holding which disqualifies the most mechanically organized works from copyright protection, but also the unequivocal rejection of the so-called “sweat of the brow” or “industrious collection” doctrine. This doctrine had allowed copyright protection for works based merely upon investment of labor or money in compiling a work without requiring the originality inherent in creative labor. Under *Feist*, however, originality, albeit of a minimal kind, is now required before a work may become subject to copyright protection.

An undeniable tension exists between the propositions that facts are not copyrightable and that compilations of facts generally are copyrightable. Many compilations consist of nothing but raw data—i.e., wholly factual information not accompanied by any original written expression. On what basis may one claim copyright in such a work? Common sense tells us that the status of 100 uncopyrightable facts does not magically change when gathered together in one place. Yet copyright law seems to contemplate that compilations that consist exclusively of facts are potentially within its scope:

The key to resolving the tension lies in understanding why facts are not copyrightable. The *sine qua non* of copyright is originality. To qualify for copyright protection, a work must be original to the author. Original, as the term is used in copyright, means only that the work was independently

created by the author (as opposed to copied from other works), and that it possesses at least some minimal degree of creativity. To be sure, the requisite level of creativity is extremely low; even a slight amount will suffice. The vast majority of works make the grade quite easily, as they possess some creative spark, "no matter how crude, humble or obvious" it might be.62

From this analysis, the Court emphasizes the long established premise that originality is a constitutional requirement that dictates different results in terms of copyright protection between facts and factual compilations. Facts are unprotectible because facts do not owe their origin to an act of authorship. The distinction is one between creation and discovery: the first person to find and report a particular fact has not created the fact: he or she has merely discovered its existence.63

Accordingly, facts of every variety—"scientific, historical, biographical, and news of the day"64—are unprotectible and in the public domain. Thus, as the Court recognizes in Feist:

This inevitably means that the copyright in a factual compilation is thin. Notwithstanding a valid copyright, a subsequent compiler remains free to use the facts contained in another's publication to aid in preparing a competing work, so long as the competing work does not feature the same selection and arrangement . . . .

It may seem unfair that much of the fruit of the compiler's labor may be used by others without compensation . . . . [However,] [t]he primary objective of copyright is not to reward the labor of authors but "[t]o promote the Progress of Science and Useful Arts." . . . To this end, copyright assures authors the right to their original expression, but encourages others to build freely upon the ideas and information conveyed by a work. This principle, known as the idea/expression or fact/expression dichotomy, applies to all works of authorship. As applied to a factual compilation, assuming the absence of original written expression, only the compiler's selection and arrangement may be protected; the raw facts may be copied at will. This result is neither unfair nor unfortunate. It is the means by which copyright advances the progress of science and art.

62. Feist, 111 S. Ct. at 1287 (citations omitted).
63. Id. at 1288.
64. Id. at 1289; see also Miller v. Universal Studios, Inc., 650 F.2d 1365, 1372 (5th Cir. July 1981) (emphasizing that the distinction between protectible expression and unprotectible facts "cannot be maintained if research is held copyrightable.").
This, then, resolves the doctrinal tension: Copyright treats facts and factual compilations in a wholly consistent manner. Facts, whether alone or as part of a compilation, are not original and therefore may not be copyrighted. A factual compilation is eligible for copyright if it features an original selection or arrangement of facts, but the copyright is limited to the particular selection or arrangement. In no event may copyright extend to the facts themselves.65

Thus, the Court in *Feist* rejects the Supreme Court rejected the "sweat of the brow" doctrine on the premise that courts accepting the doctrine "eschewed the most fundamental axiom of copyright law—that no one may copyright facts or ideas."66 However, a genuine question remains: What is protectible under *Feist*?

The Court notes that the originality requirement is not very strict, "A compiler may settle upon a selection or arrangement that others have used; novelty is not required. Originality requires only that the author make the selection or arrangement independently (i.e., without copying that selection or arrangement from another work), and that it display some minimal level of creativity."67 Most compilations will pass this test.68

It appears that even if a work qualifies as a copyrightable compilation, it receives only limited protection.69 Thus, after *Feist*, how extensive is copyright protection for those compilations which meet the originality requirement?

B. The Status of Compilations After *Feist*

Because the rule in *Feist* is straightforward for simple, mechanical compilations and requires the identification of an organizing principle as a basis for copyright protection, many of the cases following the

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65. *Feist*, 111 S. Ct. at 1288-90 (citations omitted).
66. 111 S. Ct. at 1291.
67. Id. at 1294.
68. Id.
69. This is the point of section 103 of the Copyright Act. Accordingly, the selection and coordination of the facts reported by prospective subscribers to the telephone company did not qualify for copyright protection.
Supreme Court's decision have been predictable in their results. Several cases illustrate the application of Feist in determining the copyrightability of compilations.

In *Key Publications v. Chinatown Today Publishing Enterprises*, the Court of Appeals for the Second Circuit held, applying Feist and its own case law, that the use of factual information, taken from a yellow-page phone directory, in compiling a business directory did not constitute copyright infringement so long as the information in the second directory was arranged differently from the source directory. Accordingly, when the second publisher in assembling a compilation different from the first compilation is guided by a different selection principle, he is only appropriating factual information which is not protectible. This result is consistent not only with Feist but also with the earlier case law in the Second Circuit.

1 However, the Second Circuit emphasized that while a copyright in a factual compilation is "thin . . . we do not believe that it is anorexic." Further,

[Although the test for infringement of original works and compilations is one of "substantial similarity," the appropriate inquiry is narrowed in the case of a compilation. As noted, the components of a compilation are generally in the public domain and a finding of substantial similarity or even absolute identity as to matters in the public domain will not suffice to prove copyright infringement. What must be shown is substantial simi-

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70. 945 F.2d 509 (2d Cir. 1991).
71. The court cited its decision in *Rosemont Enters. v. Random House, Inc.*, 366 F.2d 303, 309-10 (2d Cir. 1966), cert. denied, 385 U.S. 1009 (1967) as the starting point for its rejection of the "sweat of the brow" doctrine. Infringement may still occur when the selection of facts is appropriated by a subsequent publisher if the arrangement of the facts, in addition to the uncopyrightable facts themselves, is copied, as in *Eckes v. Card Prices Update*, 735 F.2d 859 (2d Cir. 1984), where a listing of 18,000 baseball cards contained a subset of 5,000 cards identified as "premium" cards, and the second directory consisted solely of these same "premium" cards.

In contrast, in the post-Feist case of *Vctor Lalli Enters. v. Big Red Apple, Inc.*, 936 F.2d 671 (2d Cir. 1991), infringement was alleged in compilations of numbers used in illegal gambling in New York City; the numbers, however, were ascertained based on results at area race tracks. Consistent with a rejection of the "sweat of the brow" theory, a compilation consisting entirely of public domain information was unprotectible, and since the format of the chart was a "convention" and itself unprotectible, there was no copyrightable material. Accordingly, even a mechanical reproduction of the charts did not constitute copyright infringement.
72. 945 F.2d at 514.
larity between those elements, and only those elements that provide copyrightability in the allegedly infringed compilation.

Broader protection would necessarily preclude competitors from using elements in the public domain and would impede rather than encourage originality and creativity in future compilations. Broader protection would thus thwart the underlying goals of copyright protection. This limitation is codified in section 103 of the Copyright Act, which provides that “[t]he copyright in a compilation . . . extends only to the material contributed by the author of such work, as distinguished from preexisting material.”

Consistent with that construction of *Feist*, the court found that there was no infringement since the only duplication of material was not in the subjective categories but rather in listings within a category. Since “[p]lacing listings within categories is the sort of mechanical task that does not merit copyright protection,” no infringement occurred. A similar result was reached by the Seventh Circuit in reviewing a telephone white pages directory case on remand from the Supreme Court to reevaluate on the basis of *Feist*.

But not all compilations are foreclosed from protection under the *Feist* standard, nor is that the Supreme Court’s result in developing a consistent standard for evaluating the copyrightability of compilations. In an unpublished decision, *U.S. Payphone, Inc. v. Executives Unlimited of Durham, Inc.*, the Court of Appeals for the Fourth Circuit found the requisite degree of subjective judgment necessary for converting public domain material—state tariffs governing payphones—into a copyright. That requirement was met by the demonstration contained in the record that the single page per state format used by the plaintiff was only one of many alternative formats and that hundreds of hours had been expended in synthesizing the material into a useable format.

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73. *Id.* at 515.
74. *Id.*
76. 931 F.2d 888 (4th Cir. 1991) (table).
77. *Id.* *See also* Budish v. Gordon, 781 F. Supp. 1320 (N.D. Ohio 1992) where the omission of information from a “cluttered” source resulted in a simplified presentation of material which was accorded copyright protection.
Similarly, in *Bellsouth Advertising & Publishing Corp. v. Donnellley Information Publishing* the composition of a telephone yellow pages directory was deemed distinguishable from the alphabetically arranged white pages in *Feist*. The directory was found to demonstrate sufficient creativity in its format, although not the information presented, to qualify the format for copyright protection.

These cases demonstrate both the nature of the factual evaluation of originality in compilations and the modest degree of originality required to vest copyright in a compilation. With the abandonment of the "industrious collection" doctrine, which rewarded labor rather than authorship, the Supreme Court in *Feist* has imposed requirements on compilations which emphasize the constitutionally mandated requirement of authorship. Still, the originality requirement for all works remains modest. *Feist* simply requires compilations to meet this requirement in the same manner as other works.

**IV. CONCLUSION**

*Feist Publications v. Rural Telephone Service Co.* is a major authority that did not so much abruptly depart from existing authority as refine the existing case law into a consistent approach which rejected the "sweat of the brow" test. In its holding, the Supreme Court also brought a significant element of certainty to the question of compilations of factual works while also bringing about a consistent national standard by which to measure the requirement of originality in compilations which places the emphasis, appropriately, on authorship rather than effort. The undefined dimensions in the originality doctrine are now more adequately defined in a manner that recognizes the constitutional boundaries foreclosing copyright in works which are not genuinely original, in however modest a sense.

78. 933 F.2d 952 (11th Cir. 1991).
79. Id. at 957.