FEIST, FACTS, AND FUNCTIONS: HISTORICAL PERSPECTIVE†

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Introduction

The 1990s brought significant developments in the field of information technology. These in turn stimulated the creation of a new global market for electronic information services and products, a market that is occupied substantially by electronic databases. The emergence of these new technological developments challenged many branches of the law, including intellectual property law. A particularly prominent part of this debate is how the law should address the protection of electronic databases.

The debate over database protection in the United States can be traced back to the Supreme Court's seminal decision in *Feist Publications, Inc. v. Rural Telephone Service Co*.[1] In *Feist*, the Court found white pages telephone directories to be non-copyrightable. The Court held that the touchstone for copyright protection is creative originality, and that this requirement is constitutionally mandated. The Court's decision also clarified that its holding "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."[2] *Feist* thus ended the tradition in some courts of providing copyright protection

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1. 499 U.S. 340 (1991).

2. *Id.* at 349.

based on the labor invested in creating the work and declared the death of the "sweat of the brow" and "industrious collection" doctrines.

The debate gained additional prominence due to a number of worldwide initiatives that extended protection to databases and considered the provision of a much more extensive legal protection for databases. Notably, the *Agreement on Trade Related Aspects of Intellectual Property Rights* ("TRIPs Agreement")[3] introduced minimum standards regarding copyright protection for databases, and the ongoing discussion in the World Intellectual Property Organization ("WIPO") considered the provision of broader intellectual property rights in databases than does the United States under *Feist*.[4] Furthermore, the European Union's Directive on the Legal Protection for Databases ("Database Directive"), adopted in 1996, constituted the most comprehensive attempt to provide protection to databases. It granted a 15-year, renewable, *sui generis* right to prevent the extraction and utilization of raw data in a database.

The adoption of the Database Directive, especially the reciprocity provision that conditions protection of non-EU databases upon reciprocal provision of comparable protection in non-EU jurisdictions, has sparked an ongoing debate over bills drafted in the U.S. Congress to address the legal protection of databases.

In particular, a number of legal scholars have voiced their opinions on the question of how Congress should react to the Supreme Court's holding in *Feist* and the EU's subsequent enactment of the Database Directive. Most of this scholarship, however, has simply accepted the argument, advanced by some segments of the database industry and others, that *Feist* creates a problem, that this problem is exacerbated by the EU's Database Directive, and that this problem needs to be solved.[5] Much of the scholarly discussion has also been dedicated to criticizing the United State's proposed bills because of the risks they supposedly pose to the database industry in general and to specific groups such as

3. Agreement on Trade-Related Aspects of Intellectual Property Rights, Apr. 15, 1994, 33 I.L.M. 81 (1994) [hereinafter TRIPs Agreement].

4. *Basic Proposal for the Substantive Provisions of the Treaty on Intellectual Property in Respect of Databases,* WIPO Doc. CRNR/DC/6 (Aug. 30, 1996).

5. *See, e.g., Database and Collections of Information Misappropriation Act of 2003: Joint Hearing on H.R. 3261 Before the Subcomm. On Courts, the Internet, and Intellectual Prop. of the House Comm. on the Judiciary and the Subcomm. on Commerce, Trade, and Consumer Prot. of the House Comm. on Energy and Commerce*, 108th Cong. 27 (2003) [hereinafter H.R. 3261 Hearing] (statement of David Carson, General Counsel, Copyright Office of the U.S., Library of Cong.).

the scientific and educational communities in particular.[6] The academic debate has, therefore, also focused on suggesting new and improved forms of protection that Congress could enact.[7]

Despite the extensive discussion on the subject of legal protection for databases, the questionable bases for the assumptions underlying the debate are routinely overlooked. One major issue that has been ignored is the historical dimension of the debate. This Article provides a historical analysis of the protection of databases under modern intellectual property law. Specifically, it addresses the popular claim, often raised by proponents of legislation advocating broader database ownership rights, that the United States Supreme Court's decision in *Feist* brought about a dramatic change in the legal landscape. According to this argument, *Feist* disturbed the status quo and overturned legal protections based on the industrious collection doctrine, which governed copyright law for two hundred years. Under this long-standing doctrine, database producers had reasonably believed that their databases were entitled to copyright protection. Advocates of legislative action providing broader database ownership rights contend that the legal system flourished under the sweat-of-brow regime, and that Congress should therefore "restore" what the *Feist* decision changed.[8]

Opponents of such restrictive legislation, by contrast, argue that the industrious collection doctrine was never the prevailing approach for the protection of databases. They argue that the legal landscape prior to

6. *See, e.g.*, The Role of Scientific and Technical Data and Information in the Public Domain: Proceedings Of a Symposium (Julie M. Esanu & Paul F. Uhlir eds., 2003).

7. *See* Jane C. Ginsburg, *No "Sweat"? Copyright and Other Protection of Works of Information after* Feist v. Rural Telephone, 92 Colum. L. Rev. 338 (1992) (suggesting a federal anticopying statute with collective licensing); J.H. Reichman & Pamela Samuelson, *Intellectual Property Rights in Data?*, 50 Vand. L. Rev. 51 (1997) (suggesting a modified liability approach).

8. *See H.R. 3261 Hearing*, *supra* note 5, at 27 (statement of David Carson, General Counsel, Copyright Office of the U.S. Library of Congress) (urging "restoration of the general level of protection provided in the past under copyright 'sweat of the brow' theories"); *Collections of Information Antipiracy Act: Hearing on H.R. 354 Before the Subcomm. on Courts and Intellectual Prop. of the House Comm. on the Judiciary*, 106th Cong. 157 (1999) [hereinafter H.R. 354 Hearing] (statement of Marilyn Winokur, Executive Vice President, Micromedex, Inc. on behalf of the Coalition Against Database Piracy) (asking to maintain "the traditional balance between the respective interests of the owners and users of informational products"); *Collections of Information Antipiracy Act; Trade Dress Protection Act; and Continued Oversight of Internet Domain Name Protection: Hearing on H.R. 2652 and H.R 3163 Before the Subcomm. on Courts and Intellectual Prop. of the House Comm. on the Judiciary*, 105th Cong. 128 (1998) [hereinafter H.R. 2652 and H.R. 3163 Hearing] (statement of Jane C. Ginsburg, Columbia University School of Law) (seeking to "restore the *status quo ante-Feist*").

Feist reflected an information policy that consistently supported unfettered access to factual information[9] and that it would be a mistake to overturn two hundred years of legal tradition by passing legislation that suddenly restricts access to fact-based works.

A historical analysis of database protection from the inception of U.S. copyright law until *Feist* reveals that at various times, however, what was perceived to be the copyrightable element of a work ranged along a continuum between creativity and originality at one end and industriousness and labor at the other. In other words, judicial thought in the United States has swung back and forth like a pendulum, alternating between a focus on investment of labor and a focus on creativity as the proper basis for copyright. The following historical analysis clearly indicates that the arguments on both sides of the debate over potential legislative action are inaccurate, and that prior to *Feist* the legal landscape was very complex in its treatment of information-based works.

In order to assess these arguments, it is important to thoroughly examine the treatment of works of facts in general and compilations in particular over time. Relying primarily on the seminal work of Professor Jane C. Ginsburg,[10] this Article begins with an overview of the emergence of the industrious collection doctrine and concludes with an examination of the legal landscape of the industrious collection doctrine under the 1976 Copyright Act. This analysis clearly illustrates the complex and rich legal landscape in the years preceding *Feist* and points to a general uneasiness and confusion about the doctrine. Moreover, it shows that most courts in their decisions were preparing the ground for an eventual repudiation of the doctrine. This analysis also supports the argument that U.S. policy on fact-based intellectual property has consistently fostered unrestricted access to the factual content contained in these works. Such access is based on an appreciation that unrestricted access is necessary to stimulate innovation, support the educational process, and "promote the Progress of Science and useful Arts."[11]

9. *See H.R. 354 Hearing*, *supra* note 8, at 127 (statement of James G. Neal, Dean, University Libraries, John Hopkins University) ("H.R. 354 would overturn our 200 years of information policy in this country which has consistently supported unfettered access to factual information."); *H.R. 2652 and H.R. 3163 Hearing*, *supra* note 8, at 151 (testimony of Jonathan Band, Partner, Morrison & Foerster LLP, General Counsel of the Online Banking Association) ("In fact, sweat of the brow was never the prevailing approach for the protection of databases.").

10. Jane C. Ginsburg, *Creation and Commercial Value: Copyright Protection of Works of Information*, 90 Colum. L. Rev. 1865 (1990).

11. U.S. Const. art. I, § 8, cl. 8.

The historical evidence thus demonstrates that neither those who advocate strong legislative protection of databases nor those who oppose it are entirely correct in their characterization of the last two hundred years of copyright jurisprudence in the United States. Contrary to what the proponents of protective legislation would claim, the industrious collection doctrine has not consistently been the governing legal regime in the U.S. for the past two hundred years, particularly after passage of the 1976 Copyright Act. By the same token, the claims of the opponents of such legislation are also incorrect since the industrious collection doctrine was, at least for a certain period of time, a significant, if not the prevailing, doctrine governing copyright protection. Accordingly, the Supreme Court's decision in *Feist* could not have worked a sea change in copyright jurisprudence in either direction, but rather is more accurately described as merely ending the movement of that jurisprudence along the continuum between authorship based purely on labor and authorship based purely on creativity, finding the latter approach as the only possible basis for copyrightability.

I. The Emergence of the Industrious Collection Doctrine

In 1789, the Framers of the Constitution empowered Congress to "promote the Progress of Science . . . by securing for limited Times to Authors . . . the exclusive Right to their respective Writings. . . ."[12] The Framers appear primarily to have intended to promote learning, with secondary concerns of protecting authors and providing them with incentives and expanding the range of ideas and information within the public domain.[13] However, because no extensive history of the Copyright and Patent Clause exists, difficulties abound in determining exactly what types of works the Framers intended copyright to cover. On its face, the Copyright Clause says nothing about originality as a prerequisite for legal protection, however the text of the Clause implies such a requirement. By granting exclusive rights only to "authors," the clause implies that originality is the essence of the right to protection. Moreover, the Clause's reference to "progress" suggests that a work entitled to copyright protection must contain more than merely trivial originality. Nevertheless, the terms of the Clause are so general that it offers little

12. *Id.*

13. L. Ray Patterson & Craig Joyce, *Monopolizing the Law: The Scope of Copyright Protection for Law Reports and Statutory Compilations*, 36 UCLA L. Rev. 719, 783 (1989).

help in determining the minimum original contribution necessary to create a copyrightable work from facts and data.

After the Constitution was ratified, Congress quickly enacted the Copyright Act of 1790 to provide limited periods of protection for original works of authorship such as books, maps, and charts. Under this statute, compilations were considered to be "books,"[14] and, indeed, compilations constitute one of the oldest forms of authorship protected under U.S. law.[15] As Professor Ginsburg writes, the works at issue in early copyright disputes were most often highly useful, informational works such as calendars, maps, law books, and arithmetic and grammar primers.[16] The overwhelming presence of informational works reflects, in Professor Ginsburg's opinion, an important legislative policy of encouraging fact-based works underlying English and American law.[17]

Professor Ginsburg also has identified the development of two discrete bases on which the concept of authorship has been founded: investment of labor and investment of individuality.[18] She argues that "[p]erhaps because of the predominance of informational subject matter, the concept of authorship and the basis for copyright protection underlying judicial decisions until the mid-nineteenth century seemed to focus on the labor, rather than the inspiration, invested in the work."[19] Professor Ginsburg also examined the idea that later in the nineteenth century "courts and commentators began to offer . . . a different rationale for copyright coverage," stating that these authorities viewed authorship as not purely the product of labor, but rather as the "emanation of an author's personality."[20] The author's subjective judgment in arranging data, rather than her diligence in collecting it, was held to be the protectable essence of the work. Thus, a work was protectable because it incorporated something of its creator's unique individuality.[21]

14. Copyright Act of May 31, 1790, ch. 15, 1 Stat. 124, *reprinted in* Copyright Enactments of the United States 1783-1906 at 32 (Thorvald Solberg ed., 1906) [hereinafter Act of May 31, 1790].

15. *See*, *e.g.*, Kilty v. Green, 4 H. & McH. 345 (Md. 1799).

16. *See* Ginsburg, *supra* note 10, at 1873. *See also* Jane C. Ginsburg, *A Tale of Two Copyrights: Literary Property in Revolutionary France and America*, 64 Tul. L. Rev. 991, 998–1005 (1990).

17. Ginsburg, *supra* note 10, at 1873.

18. *Id.* at 1873–93.

19. *Id.* at 1873–74.

20. *Id.* at 1874.

21. *Id. See, e.g.,* Bleistein v. Donaldson Lithographing *Co.*, 188 U.S. 239, 250 (1903) (Holmes, J.); Jeffreys v. Boosey, 4 H.L.C. 815, 866–81, 10 Eng. Rep. 681, 702–07 (1854) (Erle, L.J.); Ginsburg, *supra* note 10, at 1874.

Nonetheless, this conclusion does not suggest that courts required that the work possess high levels of the requisite "subjectivity."[22] "Sufficient original authorship" could be found "because each author is a distinct individual and inevitably stamps some part of herself upon the work."[23] Moreover, as Professor Ginsburg remarked, "this shift in copyright philosophy toward a more subjective view of authorship" did not in fact suddenly "spur abandonment of the prior labor-oriented approach. Instead, the two views continued to coexist."[24] Consequently, throughout the nineteenth and into the twentieth century, the concept of original authorship embraced investment of *both* labor and originality.

A. *Labor as a Basis for Authorship*

As Professor Ginsburg has explained, many English and American copyright decisions in the eighteenth and early to mid nineteenth centuries characterized copyrightable authorship in terms of the labor invested in the work.[25] This analysis was adopted in the 1806 decision *Matthewson v. Stockdale*,[26] in which the court held that the plaintiff's East India calendar was a protectable work because of the "considerable expence and labour" involved in creating the work. [27]

In the United States, many courts followed the English precedent.[28]As Professor Ginsburg shows, when "[c]ombined with the United States constitutional and legislative goals to 'promote the Progress of Science' and learning, the labor concept of copyrightability appears to furnish ample rationale for protecting all kinds of informational works, from narratives to catalogues."[29] Inquiry into the personal or subjective

22. *Id.*

23. *Id. See also Jeffreys,* 4 H.L.C. at 869; Jewelers' Circular Publ'g Co. v. Keystone Publ'g Co., 274 F. 932, 934 (S.D.N.Y. 1921) (Hand, J.), *aff'd,* 281 F. 83 (2d Cir. 1922).

24. Ginsburg, *supra* note 10, at 1873–74. *See, e.g.,* Alfred Bell & Co. v. Catalda Fine Arts, Inc., 191 F.2d 99, 102–03 (2d Cir. 1951). *Cf.* L. Batlin & Son v. Snyder, 536 F.2d 486, 489 (2d Cir. 1976) (en banc).

25. *See* Ginsburg, *supra* note 10, at 1873–74.

26. 12 Ves. Jun. 270, 33 Eng. Rep. 103 (Ch. 1806).

27. *Id.* at 105–06. *Accord* Lewis v. Fullarton, 2 Beav. 6, 8, 48 Eng. Rep. 1080 (Rolls Ct. 1839). *See also* Kelly v. Morris, L.R. 1 Eq. 697, 701 (1866). *Accord* Morris v. Ashbee, L.R. 7 Eq. 34, 40 (1868). Subsequent English decisions adopted the rule laid down in *Kelly v. Morris*. *See, e.g.*, Hogg v. Scott, L.R. 18 Eq. 444, 458 (1874); Morris v. Wright, L.R. 5 Ch. App. 279 (1870); Scott v. Stanford, L.R. 3 Eq. 718 (1867).

28. *See, e.g.,* Emerson v. Davies, 8 F. Cas. 615, 619 (C.C.D. Mass. 1845) (No. 4,436); List Public Co. v. Keller, 30 F. 772, 772-73 (C.C.S.D.N.Y. 1887). *See also* Ginsburg, *supra* note 10, at 1875.

29. Ginsburg, *supra* note 10, at 1876.

character of the author's investment in his work seemed to have been irrelevant.[30]

A regime of exclusive ownership rights in information itself seems to have been consistent with the early principles of copyright protection in the United States. Professor Ginsburg argues, however, that such a conclusion is somewhat misleading. Even during that period of jurisprudence, a copyright did not necessarily grant such expansive rights.[31] Indeed, the scope of early copyright protection in informational works was narrow; it extended to the precise contribution of the first author,[32] but it generally did not prevent competitors from duplicating the actual information in the copyrighted work as long as they themselves acquired that same information directly from the primary sources.[33] In this way, copyright protection under early court decisions operated in much the same manner as the unfair competition tort of misappropriation currently operates.[34]

B. *Individuality as a Basis for Authorship*

While the late eighteenth and early nineteenth century Anglo-American courts tended to view original authorship as a function of labor, authors tended to characterize their work as an expression of their personality.[35] Only later did the courts also finally begin to recognize individual author personality as a basis for copyright protection.[36] In an 1854 House of Lords decision, one Lord proclaimed:

> The order of each man's words is as singular as his countenance, and although if two authors composed originally with the same

30. *See* Act of May 31, 1790, at 32 (reflecting this principle by providing protection for any "map, chart, book or books," the first two categories of which are rather information-laden and labor-intensive works).

31. Ginsburg, *supra* note 10, at 1876–77.

32. *Id.* at 1877–81. *See, e.g.*, English Cases: Cary v. Kearsley, 4 Esp. 168, 170–71, 170 Eng. Rep. 679, 680 (K.B. 1802) (Lord Ellenborough); U.S. cases: *Webb v. Powers*, 29 F. Cas. 511, 517 (C.C.D. Mass. 1847) (No. 17,323).

33. *See* Ginsburg, *supra* note 10, at 1876–81. *See, e.g*., Hogg v. Kirby, 8 Ves. Jun. 215, 222, 32 Eng. Rep. 336, 339 (Ch. 1803).

34. Ginsburg, *supra* note 10, at 1876–81. The classic misappropriation decision is *International News Service v. Associated Press,* 248 U.S. 215 (1918) [hereinafter *INS*], in which the Supreme Court announced a federal common law "quasi-property" right against misappropriation of commercial value. *Id.* at 239–40.

35. Ginsburg, *supra* note 10, at 1881. *See, e.g.,* George Colman, "The Gentleman" No. 6 (1775), *in* 1 Prose On Several Occasions (1787).

36. *See* Ginsburg, *supra* note 10, at 1882–84.

> order of words, each would have a property therein, still the probability of such an occurrence is less than that there should be two countenances that could not be discriminated.[37]

While neither the United States Constitution nor the copyright laws prior to 1976 expressly required originality, American courts in the later half of the nineteenth century began to infer such a requirement from the Constitution's textual reference to granting protection to "authors." Because the term "author" means "beginner," "first mover," "creator" or "originator,"[38] the Constitution's grant of protection to "authors" necessarily requires originality; if a work lacks originality, it is not the creation of an "author."[39]

Eventually, the U.S. Supreme Court also inferred from the Copyright Clause a requirement that a work be original in order to be copyrighted, noting that the Framers of the Constitution understood "the nature of copyright and the objects to which it was commonly applied, for copyright, as the exclusive right of a man to the production of his own genius or intellect, existed in England at that time."[40] Ultimately, the case law eliminated any doubt that the prevailing prerequisite for copyright protection, regardless of the type of work at issue, is originality.[41] As the following discussion shows, however, the case law also applied a more specific threshold standard below which originality will not be found.

In the seminal case *Burrow-Giles Lithographic Co. v. Sarony*[42] the Court justified a more expansive construction of the term "writings" by noting that the first federal copyright statute protected maps, charts and books, none of which are literally "writings."[43] Because those who drafted this first copyright statute were the same authors who drafted the Constitution, the Court concluded that the Framers of the Constitution must have intended a broader and less literal definition of the term "writings."[44] The Court therefore interpreted the term "authors" in the

37. Jeffreys v. Boosey, 4 H.L.C. 815, 869, 10 Eng. Rep. 681, 703 (1854) (Erle, L.J.).

38. *See* Burrow-Giles Lithographic Co. v. Sarony, 111 U.S. 53, 58 (1884); *see also* 1 Melville B. Nimmer & David Nimmer, Nimmer On Copyright § 1.06[A] (2004) .

39. *See* 1 Nimmer & Nimmer, *supra* note 38, § 2.01; Reiss v. Nat'l Quotation Bureau, Inc., 276 F. 717, 719 (S.D.N.Y. 1921).

40. *Burrow-Giles*, 111 U.S. at 58.

41. L. Batlin & Son, Inc. v. Snyder, 536 F.2d 486, 489–90 (2d Cir. 1976); 1 Nimmer & Nimmer, *supra* note 38, § 2.01.

42. 111 U.S. at 53.

43. *Id.* at 56–57.

44. *Id.* at 57.

Copyright Clause to include anyone "to whom anything owed its origin," such that the term "writings . . . meant the literary productions of those authors, and Congress very properly has declared these to include all forms of writing, printing, engraving, etching, etc., by which the ideas in the mind of the author are given visible expression."[45] Accordingly, the original photographer who was the plaintiff in this case qualified as an "author" who could be protected under the Copyright Clause.

Burrow-Giles imparts two important lessons. First, in order to be copyrightable, a given subject matter must owe its origin to a particular identifiable author.[46] Second, the Court held that despite the general rule that pre-existing objects do not satisfy the "origination by the author" requirement, a particular selection and arrangement of such pre-existing items *can* qualify as copyrightable subject matter if that selection or arrangement is the author's original conception.[47]

Once the *Burrow-Giles* Court established "originality" as a prerequisite for copyright protection, lower courts were required to distinguish original from unoriginal works, which they did by defining original works as works that display some artistic merit.[48] Such decisions were perfectly consistent with the *Burrow-Giles'* Court's language. As the *Burrow-Giles* Court noted, the "ordinary production of a photograph" by itself would not have been copyrightable, suggesting that genuinely creative works are distinct from merely "ordinary" works.[49]

Nineteen years after *Burrow-Giles*, the Court substantially, but not completely, withdrew its requirement of artistic merit as a prerequisite for copyright. In *Bleistein v. Donaldson Lithographic Co.*, Justice Oliver Wendell Holmes wrote an opinion rejecting artistic merit as a prerequisite for copyright, and also adopted a "copyright-as-personality" approach.[50] Justice Holmes explained that the source of an author's protection under copyright law lies in the author's investment of unique individuality into his work. Copyrightable originality thus requires only some minimal level of unique expression by the author, some irreducible

45. *Id.* at 58.
46. *Id.* at 58.
47. *Id.* at 59.
48. *See, e.g.*, J.L. Mott Iron Works v. Clow, 82 F. 316, 318 (7th Cir. 1897).
49. *Burrow-Giles*, 111 U.S. at 59.
50. 188 U.S. 239 (1903). *See also* Courier Lithographing Co. v. Donaldson Lithographing Co., 104 F. 993 (6th Cir. 1900).

quantum that most people cannot define, but which they can nevertheless recognize when they see it.[51]

Holmes' interpretation also built upon another early Supreme Court interpretation of originality. In *United States v. Steffens*[52] the Court concluded that the Trade-Mark Act was unconstitutional because trademarks come into being only through extended periods of use, not from spontaneous creativity or design.[53] Because the establishment of a trademark relies only on the "priority of appropriation" and displays "no fancy or imagination, no genius, no laborious thought," trademarks do not meet the originality requirement of the Copyright Clause.[54] Thus, in *Steffens*, as in *Bleistein*, a key criterion for copyright protection is the individual author's personality or creative thoughts as embodied in his work.

The Supreme Court offered yet further insight into what constitutes originality in *Baker v. Selden*.[55] Denying copyright protection to a book providing an arrangement and explanation of a bookkeeping system, the Court noted that copyright is supposed to be "for the encouragement of learning," not merely for the "encouragement of industry or labor unconnected to the advancement of learning and the sciences."[56] The Court also emphasized that originality does not require novelty, but rather only independent creation.[57] Moreover, material drawn from the public domain will support a copyright if put together as a "distinguishable" or "substantial" variation of preexisting material.[58] Thus, the Court did not require that the author create something never done before. Instead, creativity required some expression or product that was the result of more than mere labor.[59] "All that is needed to satisfy both the Constitution and

51. 188 U.S. at 250. *See also* Alfred Bell & Co. v. Catalda Fine Arts, Inc., 191 F.2d 99 (2d Cir. 1951); Alfred C. Yen, *Restoring the Natural Law: Copyright as Labor and Possession*, 51 Ohio St. L.J. 517, 522, 537 (1990).

52. 100 U.S. 82 (1879).

53. *Id.* at 94.

54. *Id.*

55. 101 U.S. 99 (1879). *See also* Benjamin Kaplan, An Unhurried View of Copyright 64 (1967).

56. *Baker*, 101 U.S. at 105.

57. *Id.* at 102. *See also* Roth Greeting Cards v. United Card Co., 429 F.2d 1106, 1110 (9th Cir. 1970); Wihtol v. Wells, 231 F.2d 550, 553 (7th Cir. 1956); Alfred Bell & Co. v. Catalda Fine Arts, Inc., 191 F.2d 99, 102 (2d Cir. 1951); Merritt Forbes Co. v. Newman Inv. Sec. Inc., 604 F. Supp. 943, 951 (S.D.N.Y. 1985).

58. Gerlach-Barklow Co. v. Morris & Bendien, Inc., 23 F.2d 159, 161 (2d Cir. 1927).

59. *Baker*, 101 U.S. at 105.

the statute is that the 'author' contributed something more than a 'merely trivial' variation, something recognizably 'his own.' "[60]

As for the scope of protection under the "copyright as personality" approach, former Justice Kaplan has suggested that the introduction of the personality rationale led both to a greater disapproval of compositions heavily dependent on predecessors' works and to an increasing intolerance of copying in the nineteenth century.[61] This development led to an expansion in the scope of copyright protection over an increasing range of activities.[62] Examination of the first hundred years of United States copyright laws from 1790 to 1891 reveals movement from "rights simply in 'printing, reprinting, publishing and vending' to the additional rights of 'completing, copying, executing, finishing, and vending . . . and in the case of a dramatic composition, of publicly performing . . . [a]nd authors may reserve the right to dramatize or to translate their own works.' "[63]

II. The Industrious Collection Doctrine

A. *The Emergence of the Industrious Collection Doctrine Under the Copyright Act of 1909*

It was only after the Copyright Act of 1909 ("1909 Act") was enacted that the industrious collection doctrine truly made its first appearance in American copyright jurisprudence. The 1909 Act allowed putative authors to register their works for copyright protection. Under section 5 of the Act, the application for such protection had to identify their work from among certain specific categories. One of those categories was "directories."[64] Although the 1909 Act did not say that all categories of works listed in Section 5 were automatically copyrightable, some courts nevertheless inferred that directories must be copyrightable and that no further showing was required in order to benefit from

60. *Alfred Bell*, 191 F.2d at 102–03 (citing Chamberlin v. Uris Sales Corp., 150 F.2d 512, 513 (2d Cir. 1945)).

61. Kaplan, *supra* note 55, at 22–25.

62. Ginsburg, *supra* note 10, at 1885.

63. *Id.*

64. 1909 Copyright Act, Pub. L. No. 349, 35 Stat. 1075 (1909) (previously codified at 17 U.S.C. §§ 1–216) (repealed 1976) [hereinafter the 1909 Act].

protection.[65] Thus was born the "industrious collection" doctrine, otherwise known as the "sweat of the brow" doctrine in American law.[66]

The first expression of the industrious collection doctrine in American jurisprudence can be traced back to the 1921 Second Circuit decision in *Jeweler's Circular Publishing Co. v. Keystone Publishing Co.*, in which the court upheld the copyright of a trade directory containing various jewelers' addresses and trademark illustrations, which were themselves unoriginal and non-copyrightable.[67] Stating that the "law is now well established" regarding copyright protection of directories,[68] the court concluded that the right to copyright a book depends on nothing "more than industrious collection."[69] Thus, although the directory lacked original thought and creativity, took no particular insight to produce, and evidenced no original form, according to the court:

> [T]he man who goes through the streets of a town and puts down the names of each of the inhabitants, with their occupations and street numbers, acquires material of which he is the author. He produces by his labor a meritorious composition, in which he may obtain a copyright. . . .[70]

Accordingly, with this decision the court moved the concept of originality, with its focus on individuality and the creative process, to the background and placed renewed emphasis on labor as a basis for copyrighting compilations.

Furthermore, like its eighteenth and nineteenth century predecessors, the industrious collection doctrine also extended copyright protection to the original author's investment in collecting the facts contained in the compilation, thereby providing protection that goes beyond simply the

65. However, the legislative history of the 1909 Act might be interpreted as requiring creativity:

> As thus interpreted, the word 'writings' would to-day in popular parlance be more nearly represented by the word 'works'; and this the bill adopts; referring back, however, to the word 'writings' by way of safe anchorage, but regarding this as including 'all forms of record in which the thought of an author may be recorded and from which it may be read or reproduced.'

S. Rep. No. 59-6187, at 4 (1907).

66. *See supra* Part I.A.

67. 281 F. 83 (2d Cir 1922). *See also* Donald v. Zack Meyer's TV Sales & Serv., 426 F.2d 1027 (5th Cir. 1970); Markham v. A.E. Borden Co., 206 F.2d 199 (1st Cir. 1953).

68. *Jeweler's Circular Pub. Co.*, 281 F. at 85.

69. *Id.* at 88.

70. *Id.*

original selection and arrangement the compiler contributed. In addition, under the industrious collection doctrine, the only defense to infringement was independent creation. A subsequent compiler was "not entitled to take one word of information previously published," but had to "independently [work] out the matter for himself. . . ."[71]

Although the doctrine therefore lacked justification under copyright theory, it was serviceable when most compilation related copyright litigation at that time dealt with old-fashioned databases such as telephone directories. Later courts seized upon the doctrine to deal with situations in which a compiler would make a substantial contribution of labor in collecting factual data only to have someone else freely reap the benefit.[72] In applying copyright protection in this manner, courts were probably trying to decrease the risk of a market failure in situations in which people spent large amounts of time and money compiling data. The abundance of cases that dealt with *Jeweler's*-type factual scenarios suggests that old-fashioned database piracy was probably a significant problem in the pre-digital era.[73] As shown elsewhere, unlike electronic database producers, old-fashioned database producers did not have the same non-legal tools and features at their disposal to overcome such a risk.[74] All they could do was offer data and organize it in a manner that best served users and hope that the courts would step in to protect them when necessary.

1. The Prohibition on Exclusive Ownership in Facts and Fact-Based Materials Under the Copyright Act of 1909 and the Emergence of a New Emphasis on the Public Domain

Despite the swing of copyright jurisprudence back toward the investment of labor end of the copyright continuum after the 1909 Act, an important, albeit often overlooked, piece in the historical puzzle is the

71. *Id.* at 89.

72. Robert C. Denicola, *Copyright in Collections of Facts: A Theory for the Protection of Nonfiction Literary Works,* 81 Colum. L. Rev. 516, 530 (1981). *See also Patry*, *supra* note 38; Harper & Row, Publishers, Inc. v. Nation Enters., 471 U.S. 539, 589 (1985) (Brennan, J., dissenting).

73. *See* Symposium, *Bioinformatics and Intellectual Property Law, April 27, 2001—Boston, Massachusetts, Data Protection Statutes and Bioinformatics Databases*, 8 B.U.J. Sci. & Tech. L. 171, 172 (2002). *See also* Sarah Lum, Note, *Copyright Protection for Factual Compilations—Reviving the Misappropriation Doctrine*, 56 Fordham L. Rev. 933, 952 (1988).

74. Miriam Bitton, *A New Outlook on the Economic Dimension of the Database Protection Debate*, 47 IDEA 93 (2006)

treatment of factual works under the 1909 Act and the emergence of a new emphasis on the public domain. The prevailing approach under the 1909 Act, even in those courts adhering strictly to the industrious collection doctrine, was that facts and other indispensable materials are non-copyrightable. Evidence of the prevalence of these values can be found in copyright doctrines developed by the courts, most notably the idea/expression dichotomy, the fact/expression dichotomy, and the merger doctrine.

Furthermore, there was a growing awareness of and a new emphasis on the importance of maintaining a broad public domain of fact-based works. This analysis thus gives a broader perspective on the historical argument that the industrious collection doctrine has always been the ruling principle of copyright law and shows this assumption is not entirely valid.

a. The Fact/Expression Dichotomy

The fact/expression dichotomy and its twin, the idea/expression dichotomy, are classic doctrines of copyright law.[75] They reflect the balance that copyright law seeks to achieve between encouraging authors to create new works by protecting their original creations from unauthorized copying, while, at the same time, preserving the basic building blocks of facts and ideas for the public domain so that others may use them to create new works.[76] The 1879 Supreme Court decision in *Baker v. Selden*[77] represents the beginning of the modern fact/expression doctrine.[78] In *Baker*, the Court emphasized that, while a copyright in a bookkeeping treatise protects the author's explanation of

75. *See* Feist Publ'ns, Inc. v. Rural Tel. Serv. Co., 499 U.S. 340, 344–45 (1991) ("The most fundamental axiom of copyright law is that '[n]o author may copyright his ideas or the facts he narrates.' " (quoting Harper & Row Publishers, Inc. v. Nation Enters., 471 U.S. 539, 556 (1985))). *See also* Ginsburg, *supra* note 10, 1868.

76. *See* Robert A. Gorman, *Fact or Fancy? The Implications for Copyright*, 29 J. Copyright Soc'y U.S.A. 560, 560 (1982). *See also* Nash v. CBS, 899 F.2d 1537, 1540 (7th Cir. 1990). *See generally* 4 Nimmer & Nimmer, *supra* note 38, § 13.03[B][2], at 13–69 to 13–70.

77. 101 U.S. 99 (1879). *See* Gorman, *supra* note 76, at 560.

78. *See, e.g.*, Triangle Publ'ns, Inc. v. Sports Eye, Inc., 415 F. Supp. 682 (E.D. Penn. 1976).

his bookkeeping system, it does not protect the bookkeeping system itself.[79]

Later decisions, most notably *Nichols v. Universal Pictures Corp.*,[80] elaborated upon the doctrine and explored its difficulties as well. Judge Learned Hand, the author of the *Nichols* opinion, recognized that the major problem with the idea/expression dichotomy and, by implication, the fact/expression dichotomy, is uncertainty over where to draw the line between the idea or fact and the expression.[81]

A seminal expression of the prohibition on copyrighting facts themselves came in the 1918 Supreme Court decision, *International News Service v. Associated Press*,[82] in which the Supreme Court announced a federal common-law "quasi-property" right in the dissemination of information. At issue in that case were the news reports the Associated Press ("AP") published on the East Coast. Rival International News Service ("INS") had been copying those reports and relaying them to its Midwest and West Coast papers simultaneously or even ahead of their receipt by the AP's local counterparts. In rejecting the AP's complaint, the Court made a clear, *constitutionally* based statement regarding the non-copyrightability of factual information.[83]

This generally accepted aversion to copyrighting facts has broadly carried through to the federal circuits and district courts as well.[84]

Taking this rationale further, the *Rosemont Enterprises, Inc. v. Random House, Inc.* court, using language that would be repeated 25 years later in *Feist,*[85] vehemently rejected the view that a second-comer is absolutely precluded from saving time and effort by referring to and relying upon prior published material. It clearly rejected the industrious collection doctrine approach, stating that "[i]t is just such wasted effort that the proscription against the copyright of ideas and facts, and to a lesser extent the privilege of fair use, are designed to prevent."[86]

79. Baker v. Selden, 101 U.S. 99 (1980). *See also* 17 U.S.C. § 102(b) (2005) (incorporating *Baker*).

80. 45 F.2d 119 (2d Cir. 1930).

81. *See id.* at 121. *See also* Nash v. CBS, 899 F.2d 1537, 1540 (7th Cir. 1990); CCC Info. Servs. Inc. v. Maclean Hunter Mkt. Reports, Inc., 44 F.3d 61, 69 n.16 (2d Cir. 1994).

82. 248 U.S. 215 (1918).

83. *Id.* at 234.

84. Greenbie v. Noble, 151 F. Supp. 45 (S.D.N.Y. 1957). *See also* Lake v. Columbia Broad. Sys. Inc., 140 F. Supp. 707, 708–09 (S.D. Cal. 1956); Rosemont Enter. Inc. v. Random House, Inc., 366 F.2d 303, 307 (2d Cir. 1966).

85. Feist Publ'n, Inc. v. Rural Tel. Serv. Co., Inc., 499 U.S. 340, 354 (1991).

86. *Rosemont*, 366 F.2d at 310.

b. The Merger Doctrine

The merger doctrine is a collateral branch of the idea/expression dichotomy, although it somewhat blurs the line between idea and expression. Under the merger doctrine, first announced in *Morrissey v. Procter & Gamble Co.*,[87] a court may exclude from copyright protection expressions of ideas that can be expressed only in one way or in a very limited number of ways based on the logic that copyrighting such an expression would effectively copyright the idea as well. Although it ostensibly prohibits copyrights in what would otherwise be protectable expression, the merger doctrine, like the idea/expression dichotomy, also reflects the law's general aversion to exclusive ownership in facts.

c. The Emergence of New Emphasis on the Public Domain

As a number of other scholars have demonstrated,[88] since 1960 the United States Supreme Court has repeatedly emphasized the constitutional dimensions of the public domain, including the principle that it is the public that "owns" public domain materials and that these "ownership" rights are irrevocable. For example, in the famous *Sears/Compco*[89] decisions, the Court held that the states could not prohibit copying of unpatentable public domain materials which represent too slight an advance to be patented:

> An unpatentable article, like an article on which the patent has expired, is in the public domain and may be made and sold by whoever chooses to do so . . . .[90]

87. 379 F.2d 675 (1st Cir. 1967). *See also* Concrete Mach. Co. v. Classic Lawn Ornaments, Inc., 843 F.2d 600, 606 (1st Cir. 1988).

88. *See, e.g.,* Tyler T. Ochoa, *Origins and Meanings of the Public Domain*, 28 U. Dayton. L. Rev. 215 (2002).

89. *See* Sears, Roebuck & Co. v. Stiffel Co., 376 U.S. 225 (1964); Compco Corp. v. Day-Brite Lighting, Inc., 376 U.S. 234 (1964).

90. *Sears*, 376 U.S. at 231–32. *See also* Graham v. John Deere Co., 383 U.S. 1, 5–6 (1966); Kewanee Oil Co. v. Bicron Corp., 416 U.S. 470, 484 (1974). *But see* Goldstein v. California, 412 U.S. 546 (1973); Malla Pollack, *Unconstitutional Incontestability? The Intersection of the Intellectual Property and Commerce Clauses of the Constitution: Beyond A Critique of* Shakespeare Co. v. Silstar Corp., 18 Seattle U.L. Rev. 259, 305–20 (1995) (describing *Goldstein* as inconsistent with public domain principles).

B. *The Industrious Collection Doctrine Under the 1976 Copyright Act*

After the introduction of the industrious collection doctrine more than eighty years ago and the concomitant swing back toward investment of labor as a justification for copyright protection, the lower courts began to struggle with the very underpinnings of the industrious collection doctrine, particularly after the enactment of the 1976 Copyright Act. Under the 1976 Act, courts were divided regarding the doctrine's continued viability. Although the majority of federal courts had never embraced the industrious collection doctrine,[91] the doctrine had considerable staying power in some circuits.[92] Some courts continued to apply the doctrine, viewing it as the only viable method by which to provide meaningful protection for factual compilations. Other courts tried to avoid any direct discussion of whether factual works are indeed copyrightable, preferring instead to assume that they are, and relying instead on the fair use defense as an indirect way of allowing defendants to freely use the underlying factual material.

Some courts, however, began showing overt uneasiness with the industrious collection doctrine and its questionable underpinnings, leading to confusion and internal inconsistency in the reasoning of their decisions. Other courts went even further and explicitly repudiated the doctrine, turning their focus instead back to the creative elements of a compilation as the touchstone of copyrightability. These unsuccessful attempts to reconcile the industrious collection doctrine with modern copyright jurisprudence, laid the groundwork for an outright repudiation of the industrious collection doctrine in *Feist*.

Despite these simultaneous but divergent trends in the copyrightability of compilations, lower courts continued to hold that actual facts and other information-based materials themselves are not copyrightable. Courts interpreting the 1976 Act also continued to emphasize the importance of the public domain, pointing to its constitutional

91. *See infra* Part II.B. 3–5. *See also* Ethan L. Wood, Note, *Copyrighting the Yellow Pages: Finding Originality in Factual Compilations,* 78 Minn. L. Rev. 1319, 1322–23 (1994).

92. *See, e.g.,* Rural Tel. Serv. Co. v. Feist Publ'ns, Inc., 916 F. 2d 718 (10th Cir. 1990), *cert. granted,* 498 U.S. 808 (1990); S. Bell Tel. & Tel. Co. v. Associated Tel. Directory Publishers, 756 F.2d 801 (11th Cir. 1985); Ill. Bell Tel. Co. v. Haines & Co., 683 F. Supp. 1204 (N.D. Ill. 1988), *aff'd*, 905 F.2d 1081 (7th Cir. 1990), *vacated,* 499 U.S. 944 (1991); Hutchinson Tel. Co. v. Fronteer Directory Co. of Minn., 586 F. Supp. 911 (D. Minn. 1984), *rev'd* 770 F.2d 128 (8th Cir. 1985); Fin. Info. Inc. v. Moody's Investors Serv. Inc., 599 F. Supp. 994, 997–98 (S.D.N.Y. 1983), *rev'd*, 751 F.2d 501 (2d Cir. 1984).

underpinnings. After promulgation of the 1976 Act, however, the case law on copyrightable subject matter began to give detailed, policy-based analyses as well. Unlike the industrious collection decisions that followed in the wake of the 1909 Act, post-1976 decisions were careful to adhere to the basic goals that copyright law aims to promote.

1. Copyrights in Facts and Other Information-Based Materials, Preservation of the Public Domain, and the Policy Underlying Copyright Law

Unlike the 1909 Act, the 1976 Copyright Act included an express definition of the term "compilation," which, for the first time, drew an express statutory connection between compilations and "original works of authorship:"

> 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. . . .[93]

A separate section of the 1976 Act also clarified the scope of protection for compilations, specifying that:

> 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. . . .[94]

This definition expressly applies the originality requirement to compilations. It also compels a court to examine the nature of a compilation's "selection, coordination, or arrangement" in order to determine whether the compilation is "an original work of authorship" protectable under 35 U.S.C. § 102(a).

Likewise, section 102(b) of the 1976 Act also expressly codified the common-law concepts of the idea/expression and fact/expression dichotomies.[95] Under section 102(b), "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."[96]

93. 17 U.S.C. § 101 (2005).
94. 17 U.S.C. § 103(b) (2005).
95. *See supra* text accompanying notes 55–59.
96. 17 U.S.C. § 102(b) (2005).

Sections 102(a) and 103 also implicitly codify the fact/expression dichotomy by according copyright protection only to "original works of authorship"[97] and granting protection of compilations and derivative works "only to the material contributed by the author of such work, as distinguished from the preexisting material employed in the work." [98] The 1976 Act does not, however, resolve the ambiguities in the idea/expression doctrine that Judge Hand identified in the *Nichols* decision. Nowhere among the definitions in section 101 is there a definition of "fact" or "expression."

Furthermore, the 1976 Act's use of the phrase "original work of authorship," which replaced the phrase "all the writings of an author" in the 1909 Act, was left purposefully undefined. Much like the Copyright Clause of the Constitution, the 1976 Act provides guidance in defining originality only in very general terms. Courts were thus left to develop an understanding of "originality" in their own terms. Nevertheless, the legislative history of the 1976 Act shows that Congress intended for courts to incorporate their own standards for the necessary level of originality, as established in their interpretations of the 1909 Act.[99]

After the enactment of the 1976 Act, courts dealing with historical and other fact-based works began to take a much more policy-oriented approach to these cases, growing increasingly aware of the risks of granting exclusive rights in facts and knowledge. They show a heightened understanding of the possible chilling effects that such exclusivity could have on other authors who were trying to tackle other issues or pursue other endeavors. A few courts also began to emphasize the constitutional origins of the ideal of the public domain.

For example, in *Alexander v. Haley*, the court dealt with, *inter alia*, the defendant's alleged infringement of the plaintiff's copyright in a novel and pamphlet that were amalgams of fact and fiction derived from the somber history of slavery in the United States.[100] In determining whether there had been a taking of copyrightable elements of the work, the court agreed with the defendant that "each of the similarities asserted by the plaintiff is in one or more of several categories of attributes of written work which are not subject to the protection of the copyright

97. 17 U.S.C. § 102(a).
98. 17 U.S.C. § 103(b).
99. H.R. Rep. No. 94-1476, at 51, 54 (1976). *See also* Harper & Row, Publ'g, Inc. v. Nation Enters., 471 U.S. 539, 581 (1985) (Brennan, J., dissenting).
100. 460 F. Supp. 40 (S.D.N.Y. 1978).

laws,"[101] pointing to three such categories in particular. First, the court rejected the plaintiff's claim of infringement based on "matters of historical or contemporary fact," for "[n]o claim of copyright protection can arise from the fact that the plaintiff has written about such historical and factual items. . . ."[102] Second, the court rejected the plaintiff's claim based on material traceable to common sources or to the public domain.[103] Third, the court rejected the claim based on borrowed scenes a faire,[104] which are incidents, characters, or settings that, as a practical matter, are indispensable to the treatment of a given topic.

Similarly, the courts perceived as the leading authorities in the formulation of United States' copyright laws, such as the Second and Ninth Circuits, have permitted extensive reliance on prior works of history and emphasized that factual information must remain in the public domain.[105] For instance, in *Hoehling v. Universal City Studios, Inc.*,[106] the Second Circuit held that second comers must be allowed to rely extensively on prior works of history, thus rejecting case law in other circuits that held the results of original research are copyrightable.[107]

The Second Circuit's holding touched upon a fundamental policy underlying copyright law:

> The rationale for this doctrine is that the cause of knowledge is best served when history is the common property of all, and each generation remains free to draw upon the discoveries and insights of the past.[108]

In its 1984 decision, *Landsberg v. Scrabble Crossword Game Players, Inc.*, the Ninth Circuit followed the path set by the Second

101. *Id.* at 44.

102. *Id.* at 44–45. *See also* Sid & Marty Krofft Television Prod. Inc. v. McDonald's Corp., 562 F.2d 1157, 1163 (9th Cir. 1977); Signo Trading Int'l Ltd. v. Gordon, 535 F. Supp. 362 (N.D. Cal. 1981).

103. *Alexander*, 460 F. Supp. at 45.

104. *Id. See also* Landsberg v. Scrabble Crossword Game Players, Inc., 736 F.2d 485, 489 (9th Cir. 1984); Hoehling v. Universal City Studios, Inc., 618 F.2d 972, 979 (2d Cir. 1980).

105. *See* discussion *supra* Part II.A.1, which deals, *inter alia*, with trends in the Second Circuit before the enactment of the 1976 Act. *See also* Oxford Book Co. v. Coll. Entrance Book Co., 98 F.2d 688, 691 (2d Cir. 1938).

106. 618 F.2d 972. *See also* Miller v. Universal City Studios, Inc., 650 F.2d 1365, 1369–71 (5th Cir. 1981).

107. The Second Circuit clearly repudiated such an approach in *Rosemont Enterprises Inc. v. Random House Inc.*, 366 F.2d 303, 310 (2d Cir. 1966).

108. *Hoehling*, 618 F.2d at 974.

Circuit.[109] Because of the limited number of ways in which certain facts and factual information can be presented, the court held that protecting the public's interest in such limited modes of expression requires that the "similarity of expression may have to amount to verbatim reproduction or very close paraphrasing before a factual work will be deemed infringed."[110] Any other approach might allow the first few writers to tackle a factual topic to exhaust the limited modes of expression available to convey it.

Likewise, in the wake of the 1976 Act, the Supreme Court touched upon the essence of modern copyright law in *Harper & Row, Publishers Inc. v. Nation Enterprises*.[111] Although the Court's decision in *Harper & Row* was at face value concerned with the "fair use" defense as applied to *The Nation*'s publication of numerous extracts from President Ford's biography, the Court also took this opportunity to discuss more generally exactly what protective scope fact-based works enjoyed under copyright law. Quoting from the Court's earlier opinion in *Sony Corp. of America v. Universal City Studios, Inc.,*[112] Justice O'Connor's opinion for the Court in *Harper & Row* touched upon the underlying principle of the Copyright Clause and its application to works of fiction and non-fiction alike:

> [Copyright] is intended to motivate the creative activity of authors and inventors by the provision of a special reward, and to allow the public access to the products of their genius after the limited period of exclusive control has expired.[113]

O'Connor wrote that "no author may copyright facts or ideas,"[114] since "copyright is limited to those aspects of the work—termed 'expression'—that display the stamp of the author's originality."[115] Subsequent users are therefore free to "copy from a prior author's work those constituent elements that are not original," such as "facts, or materials in the public domain—as long as such use does not unfairly

109. 736 F.2d 485 (9th Cir. 1984). *See also* Ekern v. Sew/Fit Co., 622 F. Supp. 367, 370 (N.D. Ill. 1985); Evans v. Wallace Berrie & Co., 681 F. Supp. 813, 817 (S.D. Fla. 1988).

110. *Landsberg*, 736 F.2d at 488. *See also* Worth v. Selchow & Righter Co., 827 F.2d 569, 572 (9th Cir. 1987).

111. 471 U.S. 539 (1985).

112. 464 U.S. 417 (1984).

113. *Harper & Row*, 471 U.S. at 546 (quoting *Sony*, 464 U.S. at 429).

114. *Id.* at 547.

115. *Id.*

appropriate the author's original contributions."[116] By refusing to recognize a copyright in facts alone, the law is able to serve the public's interest in the free flow of information.[117] Consequently, although the Supreme Court did not deal directly with the viability of the industrious collection doctrine, it did plant the seeds for its later decision in *Feist.*[118]

The *Harper & Row* Court also placed the idea/expression dichotomy within its broader constitutional context, pointing out that the doctrine " 'strike[s] a definitional balance between the First Amendment and the Copyright Act by permitting free communication of facts while still protecting an author's expression.' "[119] Even Justice Brennan, in dissent, commented on why facts cannot be copyrighted. First noting the economic rationale for this rule, Justice Brennan explained that, "were an author able to prevent subsequent authors from using concepts, ideas, or facts contained in his or her work, the creative process would wither, and scholars would be forced into unproductive replication of the research of their predecessors."[120] He then looked at the broader constitutional rationale for this rule, explaining that such a limitation on copyright protections also ensures consonance with important First Amendment values.[121]

Using works of history as an example, Justice Brennan emphasized that, at its core, copyright law does not protect the most valuable aspect of factual works:

> The value this labor produces lies primarily in the information and ideas revealed, and not in the particular collocation of words through which the information and ideas are expressed.[122]

Accordingly, the impulse to compensate authors for subsequent use of the information and ideas produced by their labors is entirely understandable, for there is an "inequity [that] seems to lurk in the idea that much of the fruit of the historian's labor may be used without compensa-

116. *Id.* at 548.
117. *Id.*
118. *But see* Black's Guide, Inc. v. Mediamerica, Inc., No. C-90-0819, 1990 U.S. Dist. LEXIS 16272, at *9 (N.D. Cal. Aug. 15, 1990).
119. *Harper & Row*, 471 U.S. at 556 (quoting Harper & Row Publishers, Inc. v. Nation Enters., 723 F.2d 195, 203 (2d Cir. 1983)).
120. *Id.* at 582.
121. *Id.*
122. *Id.* at 589.

tion."[123] And yet, Justice Brennan continued, in a passage that would be adopted seven years later by the majority in *Feist*:

> This, however, is not some unforeseen byproduct of a statutory scheme intended primarily to ensure a return for works of the imagination. Congress made the affirmative choice that the copyright laws should apply in this way.[124]

2. The Decline of the Industrious Collection Doctrine

Although the industrious collection doctrine both originated in and was subsequently rejected by both the Second and Ninth Circuits,[125] the Seventh, Eighth and Tenth Circuits continued strongly to support the doctrine until the Supreme Court's decision in *Feist*.

A recent example of the doctrine at work is the Seventh Circuit decision in *Schroeder v. William Morrow & Co.,*[126] in which the court addressed the alleged copying of a gardening directory. The names and addresses in the garden directory were arranged alphabetically, requiring no original insights on the part of the compiler.[127] The court, citing the Second Circuit's now rejected application of the industrious collection doctrine in *Jeweler's Circular Publishing Co.*, found the directory warranted copyright protection. It asserted that "only industrious collection" is required since "copyright protects not the individual names and addresses but the compilation, the product of the compiler's industry,"[128] thus protecting the fruits of any substantial and independent effort, regardless of the originality or creativity involved.

123. *Id.*

124. *Id.* (quoting H.R. Rep. No. 94-1476, at 56–57 (1976)). *But see* San Francisco Arts & Athletics, Inc. v. U.S. Olympic Comm'n, 483 U.S. 522 (1987); Harper & Row Publishers, Inc. v. Nation Enters., 471 U.S. 539 (1985); Zacchini v. Scripps-Howard Broad. Co., 433 U.S. 562 (1977).

125. The Ninth Circuit originally embraced the industrious collection doctrine as a basis for copyright protection in *Leon v. Pacific Telephone & Telegraph Co.,* 91 F.2d 484 (9th Cir. 1937) (citing *Jeweler's Circular Publishing Co. v. Keystone Publishing*, 281 F. 83 (2d Cir. 1922)).

126. 566 F.2d 3 (7th Cir. 1977). Prior to *Schroeder* the Seventh Circuit had already adopted the industrious collection doctrine in a few cases. *See, e.g.*, G.R. Leonard & Co. v. Stack, 386 F.2d 38 (7th Cir. 1967); Adventures in Good Eating, Inc. v. Best Places to Eat, Inc., 131 F.2d 809, 812–13 (7th Cir. 1942).

127. *Schroeder*, 566 F.2d at 6.

128. *Id.* at 5. *Accord* Feist Publ'ns, Inc. v. Rural Tel. Serv. Co., 916 F.2d 718 (10th Cir. 1990), *rev'd*, 499 U.S. 340 (1991); Illinois Bell Tel. Co. v. Haines & Co., 905 F.2d 1081 (7th Cir. 1990), *vacated*, 111 S. Ct. 1408 (1991); Hutchinson Tel. Co. v. Fronteer Directory Co. of Minn., Inc., 770 F.2d 128 (8th Cir. 1985).

Another relatively recent example of the industrious collection doctrine is the Eighth Circuit's decision in *United Telephone Co. of Missouri v. Johnson Publishing Co*.[129] The defendant had updated its own independent directory by verifying new listings obtained from the local telephone company's directory. The court found that by comparing its directory to and obtaining new subscriber listings from the telephone company's directory, the defendant had created a second work of substantial similarity to the telephone company's directory, thereby infringing the telephone company's legitimately asserted copyright in its directory.[130]

In addition to this line of cases overtly applying the industrious collection doctrine, there is a second line of cases that purported to require originality as a prerequisite for copyright protection, but, in practice, simply measured originality as a function of industry. For example, the Eighth Circuit's 1986 decision in *West Publishing Co. v. Mead Data Central, Inc.* revolved around Mead Data's proposal to cite page numbers from West Publishing's legal reporters in Mead Data's computerized LEXIS reports of the same opinions.[131]

The Eighth Circuit affirmed the lower court's grant of a preliminary injunction against Mead Data.[132] At first, the court correctly pointed out that an arrangement of preexisting materials may receive copyright protection and that "in each case the arrangement must be evaluated in light of the originality and intellectual-creation standards" of prior case law.[133] The court seemed to lose this standard, however, for although West Publishing had arranged the cases in a purely mechanical fashion with no original insight or creativity, the court stated that "a work need only be the product of a modicum of intellectual labor" to be protectable, a test that West's reporters easily met.[134] In response to the argument that this essentially granted copyright protection to page numbers, the court rejoined that "protection for the numbers is not sought for their own sake. It is sought, rather, because access to these particular numbers . . . would give users of LEXIS a large part of what West has spent so much labor

129. 855 F.2d 604 (8th Cir. 1988).
130. *Id.* at 608–09.
131. 799 F.2d 1219, 1222 (8th Cir. 1986)("*Mead*"). *See also* Oasis Publishing Co. v. West Publishing Co., 924 F. Supp. 918 (D. Minn. 1996).
132. *Mead*, 799 F.2d at 1222.
133. *Id.* at 1225.
134. *Id.* at 1227.

and industry in compiling,"[135] thus overlooking the lack of originality in the arrangement of page numbers.[136]

As discussed below, however, many other courts decisions, and ultimately *Feist* itself, not only rejected the premise of the "industrious collection" doctrine but also required an affirmative showing that the allegedly infringed material demonstrates originality of authorship.[137]

3. The Fair Use Defense as a Shield Against Exclusive Ownership of Facts

A few courts have tried to avoid the question of database protection in general and the industrious collection doctrine in particular. Instead, they simply assumed that the work at issue was entitled to copyright protection and tried to resolve the disputes indirectly via the fair use defense as a means of "freeing" factual information. These courts, however, went to such extraordinary lengths as to stretch the defense beyond its limits.

The fair use defense is a limitation on the copyright owner's exclusive rights. Section 107 of the 1976 Act[138] provides that "the fair use of a copyrighted work . . . for purposes such as criticism, comment, news reporting, teaching . . ., scholarship, or research is not an infringement of copyright." It also provides that "[i]n determining whether the use made in any particular case is a fair use the factors to be considered shall include—(1) the purpose and character of the use, including whether such use is for a commercial nature or is for nonprofit educational purposes; (2) the nature of the copyrighted work; (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and (4) the effect of the use upon the potential market for or value of the copyrighted work."

The case of *New York Times Co. v. Roxbury Data Interface*[139] serves as a good example of this trend. The court dealt with whether a copyrighted work may be indexed by an outsider without the permission of the copyright holder. The plaintiff's newspaper, *The New York Times*,

135. *Id.*

136. *But see id.* at 1248 (Oliver, J., concurring in part and dissenting in part); *see also* Toro Co. v. R & R Prods. Co., 787 F.2d 1208, 1213 (8th Cir. 1986); Eggers v. Sun Sales Corp., 263 F. 373 (2d Cir. 1920); Banks Law Publ'g Co. v. Lawyers' Co-op. Publ'g Co., 169 F. 386 (2d Cir. 1909), *appeal dismissed*, 223 U.S. 738 (1911).

137. *See infra* Part II.B.5.

138. 17 U.S.C. § 107 (2005).

139. N.Y. Times Co. v. Roxbury Data Interface, Inc., 434 F. Supp. 217 (D.N.J. 1977) ("*Roxbury*").

published its own annual indices of citations to names and other data in newspaper issues from that year.[140] Finding plaintiff's indices inadequate, the defendants published their own index to those indices but collated the citations over several years.[141] The court refused to grant a preliminary injunction, despite the defendant's confession to copying names directly from the plaintiff's directory.[142]

Because the defendant did not appropriate the corresponding citations to pages and columns, the court held that the defendant's index likely either was not an infringement or was excused under the doctrine of fair use.[143]

Although the court thus focused upon the expression inherent in the author's final product, it recognized that copyrightable expression goes beyond the mere superficial arrangement or ordering of the data.[144] Although correlations drawn between facts may still be criticized as lacking the required creativity, the scope of protection afforded by this broadened view of what is copyrightable in a compilation of facts is still significantly more than that afforded under an unadulterated application of the originality requirement. Even under a pure application of the industrious collection doctrine, the court's attempt to distinguish between different forms of data is, at best, baseless. In terms of solely the labor invested or saved, copying only the names gathered by the plaintiffs is not in any meaningful way very different from copying the entire work. In both situations the defendant was simply free-riding on the labor already invested by the plaintiff. Something else must therefore have motivated the court's analysis—most likely the court's disinterest in dealing with the uneasy question of copyrightability of compilations.

The court's application of the four "fair use" factors in this case is particularly revealing. In a typical fair-use analysis, a court will look first at whether the alleged fair use is commercial or non-commercial. In *Roxbury*, however, the court looked first at the purpose and character of the use, identifying at least two main motives that the defendants had in copying from the plaintiff's indices: (1) to make money, and (2) to facilitate public access to useful information in the plaintiff's newspapers.[145]

140. *Id.* at 218.
141. *Id.* at 219.
142. *Id.* at 222.
143. *Id.* at 226–27.
144. Fin. Info., Inc. v. Moody's Investors Serv., Inc., 808 F.2d 204, 208 n.3 (2d Cir. 1986).
145. *Roxbury*, 434 F. Supp. at 221.

Although the court was undoubtedly correct in finding that the defendant's index would serve the public interest, this hardly seems significant since an alleged infringing work usually serves the public interest in at least some manner. Perhaps for this very reason, the typical "fair use" analysis does not begin by looking at the public interest. Instead, public interest is typically a factor reserved for the threshold question of whether the plaintiff's work is in fact protected by copyright, and not whether the defendant's work infringes that protection. Such a public interest analysis could have led the court to conclude that the plaintiff's work was factual and useful rather than creative in nature and thus was non-copyrightable material. Nevertheless, in struggling to protect the free flow of facts, the court in *Roxbury* went to extraordinary lengths to emphasize the defendant's contribution to the public interest: "save researchers a considerable amount of time and, thus, facilitate the public interest in the dissemination of information." [146]

Only as the second step in its fair use analysis did the court finally consider the nature of the plaintiffs' copyrighted work. The court found that the Times indices were basically a collection of facts, and "[s]ince the Times Index is a work more of diligence than of originality or inventiveness, defendants have greater license to use portions of the Times Index under the fair use doctrine."[147] Such explorations of a work's factual or creative nature should be conducted during the threshold copyrightability analysis. Classifying the work as one "more of diligence than of originality" suggests that, in the court's eyes, it does not deserve copyright protection.

As the third step in its fair use analysis, the court considered whether the amount and substance of the copied parts in relation to the copyrighted work as a whole were reasonable in light of the defendant's purpose in copying the plaintiff's work. Here the court emphasized again that the protected element in the plaintiff's work is the correlation of names to page citations, an element that the defendants had not copied.[148] The court thereby distinguished other directory cases that had employed the industrious collection doctrine, stressing that these other cases involved defendants who had copied the essence of the plaintiff's work in its en-

146. *Id.*
147. *Id.*
148. *Id.* at 222.

tirety as a new and virtually identical directory in direct competition with the plaintiff's directory.[149]

The court also noted the extent to which producing the defendant's index required copying the names directly from the Times Index, and that for all practical purposes, defendants could not have published their index without such direct copying.[150] The plaintiff, however, correctly pointed out that the defendant could have obtained the same information directly from the newspaper issues, as had the compilers of the Times Index.[151] Had the court been loyal to the industrious collection doctrine, it would not have allowed the defendants such leeway because the Times Index required a significant expenditure of time and effort. The court, however, did not take this path, holding that such an argument could be successful only upon copying of both the personal names and their correlated citations.[152]

It is unclear, however, why the defendants would have had to appropriate both the names and their correlative citations under the industrious collection doctrine. Even the court itself acknowledged that its distinction between taking the names alone and taking both names and citations was "not determinative" to its "fair use" analysis, but simply "must be noted."[153]

Interestingly, the court seems to suggest in a footnote that, regardless of the amount or substance of the material copied, what the defendants copied was not the true, copyrightable essence of the plaintiffs' work. The court essentially divided compilations into two categories, factual compilations and subjective compilations, hinting that the latter category merited greater protection than the former.[154] The former is mechanical compilation of facts while the latter is the product of the compiler's judgment and discretion in choosing which entries to include. Content selected on inevitably objective criteria for automatic inclusion in a compilation should remain in the public domain, for there are very few ways to create such compilations.

Fourth and last, the court considered the effect of the defendants' name index on the potential market for the Times Index, which the court

149. *Id.* at 222–23.
150. *Id.* at 223.
151. *Id.*
152. *Id.*
153. *Id.*
154. *Id.* at 222 n.2.

found to be slight.[155] The defendants' index was useless without the corresponding Times Index volume because only the Times indices themselves cited the actual articles.[156] The defendants' index therefore did not compete directly with the plaintiffs' indices.[157]

Even more revealing is the court's response to the argument that the defendants' index deprived the plaintiffs of their right to exploit their copyrights.[158] The court viewed this argument as stating that a copyrighted work cannot be indexed without permission from the copyright holder in much the same way that filmmakers cannot make a movie from a copyrighted play or novel. The court rejected this analogy, first because the defendants had not copied the essence of plaintiffs' work, the correlation of names and other data with page cites.[159] As discussed above, however, this explanation would fail under the industrious collection doctrine. Second, the court rejected the analogy because the defendants' index had a different function and format.[160] However, this fact is irrelevant under the industrious collection doctrine if the defendants drew significantly and extensively from the plaintiffs' copyrighted materials. Third, the court cited the fact that the Times Indices themselves contained nothing comparable to the defendants' index,[161] yet another factor that would have been irrelevant under a pure industrious collection analysis.[162]

4. Questioning the Underpinnings of the Industrious Collection Doctrine

Some courts at both the appellate court and district court level started to explicitly doubt the foundation of the industrious collection doctrine. These courts included some that had previously applied the doctrine, such as the Seventh Circuit. The discussion that follows provides an illustration of such uneasiness at its peak, showing how courts voiced their concerns regarding the consistency of the industrious collection doctrine with copyright doctrine while at the same time "excusing"

155. *Id.* at 223.
156. *Id.*
157. *Id.* at 224.
158. *Id.*
159. *Id.* at 224–25.
160. *Id.* at 225.
161. *Id.* at 225.
162. *See, e.g.,* Dow Jones & Co. v. Bd. of Trade, 546 F. Supp. 113, 120 (S.D.N.Y. 1982); Nat'l Bus. Lists, Inc. v. Dun & Bradstreet, Inc., 552 F. Supp. 89 (N.D. Ill. 1982).

in economic terms their continued adherence to the doctrine as the only meaningful means of supporting compilation creators. These courts' decisions thus reflect confusion and internal inconsistency in their reasoning and final resolutions. In their own way, however, these cases prepared the ground for *Feist*'s later repudiation of the doctrine.

A good example is found in a 1982 district court decision, *National Business Lists, Inc. v. Dun & Bradstreet, Inc.*[163] The court started by describing the copyright protection of compilations as "a doctrine in search of conceptual underpinnings,"[164] and a "troublesome legal issue because it involves consideration of competing interests within the confines of a statutory scheme better suited to other literary works."[165] Describing the compiler's contribution to knowledge as the collection of information, the court expressed concerns about the compilation industry and the possible undermining of the economic incentives to create such works.[166] The court admitted, however, that such economic concerns nevertheless do not explain why courts fall back on copyright law when other legal doctrines, such as the misappropriation doctrine, can accomplish the same ends.[167]

The court went even further, pointing to the questionable constitutionality of protecting factual compilations.[168] Its grave doubts notwithstanding, however, the court followed the industrious collection doctrine, providing a two-fold explanation for its decision. First, it noted that "there appears to remain a lingering recognition that '[t]he second historian or second directory publisher cannot bodily appropriate the research of his predecessor.' "[169] Second, it adverted to the fact that "the directory cases, rather than being a breed apart, are the most striking illustrations in copyright law that the misappropriation doctrine . . . . has there long found a house if not a home."[170]

163. 552 F. Supp. 89.
164. *Id.* at 93.
165. *Id.* at 91.
166. *Id.* at 92; *See also* Black's Guide, Inc. v. Mediamerica, Inc., No. C-90-0819, 1990 U.S. Dist. LEXIS 16272, at *8 (N.D. Cal. Aug. 15, 1990).
167. *Nat'l Bus. Lists*, 552 F. Supp. at 95. *See also id.* at 92; Fin. Info. Inc. v. Moody's Investors Serv. Inc., 599 F. Supp. 994, 999 (S.D.N.Y. 1983), *rev'd*, 751 F.2d 501 (2d Cir. 1984). *But see* Denicola, *supra* note 72, at 530.
168. *Nat'l Bus. Lists*, 552 F. Supp. at 93.
169. *Id.* at 95 (quoting Huie v. Nat'l Broad. Co., 184 F. Supp. 198 (S.D.N.Y. 1960).
170. *Id.* (citation omitted)

In another case, *Rand McNally & Co. v. Fleet Management Systems, Inc.*,[171] the court found a roadway mileage guide non-copyrightable as a compilation, and expressed its uneasiness with the industrious collection doctrine. This decision is unusual in a few respects. On the one hand, the court accepted the long-established idea that "[c]ompilations of facts, however, have 'long rested securely within the scope of copyright.' "[172] Nevertheless, relying on *National Business List*,[173] the court also acknowledged that "the rationale behind protecting such compilations, however, is unclear."[174] On the other hand, despite its recognition that "another justification for protecting compilations of facts relies on the compiler's 'subjective judgment and selectivity in choosing items to a list,' "[175] the court asserted that factual compilations may still be protected by copyright by simple virtue of being the "result of some level of compiler effort and industry."[176]

Soon thereafter, the Seventh Circuit's 1985 decision in *Rockford Map Publishers, Inc. v. Directory Service Co. of Colorado*[177] declared that "copyright laws protect the work, not the amount of effort expended,"[178] thus de-emphasizing labor and finding originality only in creative arrangements. The defendant, relying on the industrious collection doctrine affirmed in *Schroeder*, argued that because the plaintiff had spent little time preparing its maps, its efforts were "not very 'industrious' " and its product was thus not copyrightable.[179] Rejecting this argument, the court emphasized that the amount of time invested is irrelevant.[180] Though the court appeared to reject the industrious collection doctrine as a basis for protection, the court actually made no explicit judgment as to whether labor, in and of itself, is protectable. Rather, the court simply re-interpreted *Jeweler's* and *Schroeder*, two classic industrious collection cases, as hinging on whether the compiler produced a

171. 591 F. Supp. 726 (N.D. Ill. 1983).
172. *Id.* at 731.
173. *See supra* text accompanying notes 163–170.
174. Rand McNally & Co. v. Fleet Mgmt. Sys., Inc., 591 F. Supp. 726, 731 (D.C. Ill. 1983).
175. *Id.* at 732 n.4.
176. *Id.* at 733.
177. 768 F.2d 145 (7th Cir. 1985).
178. *Id.* at 148.
179. *Id.*
180. *Id.*

"new" or original arrangement, not on whether the compiler had invested a significant amount of time and effort.[181]

Rockford Map created confusion within the Seventh Circuit probably because it studiously avoided adopting the industrious collection doctrine while at the same time borrowing heavily from classical industrious collection cases such as *Jeweler's*.[182]

In light of the court's ruling in *Rockford Map,* the defendant in *Rand McNally I* brought a motion for reconsideration.[183] The court conceded that after *Rockford Map*, its previous reliance on the level of effort involved in compiling data was erroneous.[184] Instead, the proper analysis is whether the compilation as a whole evinced originality in its arrangement of facts.[185]

The *Rand McNally III* court expressed its uneasiness with the industrious collection doctrine, calling the law on factual compilation copyrights a "tangled web"[186] and admitting that it presents "intellectual difficulties in determining where protectable copying of facts ends and unlawful copying of the compilation begins."[187] As to the continued viability of the industrious collection doctrine, however, it concluded that *Schroeder*[188] remained solid law in the Seventh Circuit,[189] and rejected the proposition that *Rockford Map* moved away from concentrating on labor expended to concentrating on originality.[190] Trying to reconcile *Rockford Map*'s confusing pronouncements,[191] the *Rand McNally III* court tried to draw formalistic distinctions between infringing mapmakers and infringing compilers.[192] Ignoring the conflicting case law and the 1976 Act's express requirement that compilations constitute

181. *Id. But see* Black's Guide, Inc. v. Mediamerica, Inc., No. C-90-0819, 1990 U.S. Dist. LEXIS 16272, at *8 (N.D. Cal. Aug. 15, 1990); Nat'l Bus. Lists, Inc. v. Dun & Bradstreet, Inc., 552 F. Supp. 89, 97 (N.D. Ill. 1982).

182. *See Rockford Map Publishers,* 768 F.2d at 148-49.

183. Rand McNally & Co. v. Fleet Mgmt. Sys., Inc., 634 F. Supp. 604–05 (N.D. Ill. 1986) ("Rand McNally III").

184. *Id.* at 606.

185. *Id.* at 606–07.

186. *Id.* at 608.

187. *Id.*

188. Schroeder v. William Morrow & Co., 566 F.2d 3 (7th Cir. 1977).

189. *Rand McNally III*, 634 F. Supp. at 608.

190. *Id.*

191. *See supra* text accompanying notes 181–182.

192. *Rand McNally III*, 634 F. Supp. at 608. *See also* Clark Equip. Co. v. Lift Parts Mfg. Co., 32 Copyright L. Rep. (CCH) P 20, 528, 530 (N.D. Ill. 1986); Ill. Bell Tel. Co. v. Haines & Co., 683 F. Supp. 1204, 1207–10 (N.D. Ill. 1988) (adopting *Rand McNally III*'s holding), *aff'd*, 905 F.2d 1081 (7th Cir. 1990).

original works of authorship, the *Rand McNally III* court instead relied exclusively on the industrious collection doctrine as the basis for protection.

The Eleventh Circuit showed its own discomfort with the industrious collection doctrine in *Southern Bell Telephone & Telegraph Co. v. Associated Telephone Directory Publishers*.[193] There, the court found the Atlanta Yellow Pages to be a copyrightable work of original authorship because of its subjective selection, organization, and arrangement of preexisting materials. Although the court discounted the substantial line of cases relying on the industrious collection doctrine, it misinterpreted the originality requirement since the arrangement and selection of data in a typical Yellow Pages directory is mechanical and conventional, not original, and although laborious, does not reflect the compiler's personality. Moreover, notwithstanding its apparent rejection of the industrious collection doctrine, the court expressly refused to reject the notion that "the principle characterized as the 'sweat of the brow' theory is to apply in a determination of originality under the act."[194] The court opined that originality should "be tested by the nature of the selection and arrangement of the preexisting material in the compilation"[195] and that "protection of original research of information in the public domain is better afforded under an unfair competition theory."[196]

5. Repudiation of the Industrious Collection Doctrine and the Minimum Level of Originality Necessary for Copyright Protection of Compilations

After the 1976 Act was implemented, most courts rejected the industrious collection doctrine,[197] requiring instead that compilations contain sufficient creativity in their "select[ion], coordinate[ion] or arrange[ment]" as to render them "original works of authorship" entitled to copyright protection.[198] The line, however, between mere labor produc-

193. 756 F. 2d 801 (11th Cir. 1985).
194. *Id.* at 809 n.9.
195. *Id.*
196. *Id. See also* Bellsouth Adver. & Publ'g Corp. v. Donnelley Info. Publ'g Inc., 719 F. Supp. 1551, 1557 (S.D. Fla. 1988).
197. *See, e.g.*, Worth v. Selchow & Righter Co., 827 F. 2d 569, 572–73 (9th Cir. 1987); Fin. Info. Inc. v. Moody's Investors Serv. Inc., 808 F. 2d 204, 207 (2d Cir. 1986); Eckes v. Card Prices Update, 736 F.2d 859, 862 (2d Cir. 1984).
198. 17 U.S.C. § 101 (2005).

ing little or no originality and "intellectual labor" producing original and newly created material can be very fine.

The basic problem with the industrious collection doctrine was that it failed to incorporate the concept of originality.[199] Courts that rejected the industrious collection doctrine, however, began to draw the line between "intellectual labor" and mere unoriginal labor according to the fundamental principles underlying copyright law. These courts understood that facts do not owe their origin to the author who simply describes them. They also recognized that originality is not only a constitutionally mandated requirement but also a requirement that serves the important function of balancing the public's interest in stimulating creative activity against the public's need for unrestricted access to information by allowing subsequent authors to build upon and add to prior knowledge without unnecessary duplication of effort. These courts therefore established a minimum threshold of originality to deny copyright protection to fact compilations that failed to exhibit some level of subjective arrangement, thoughtful selection, or creativity.

The 1978 Ninth Circuit decision in *United States v. Hamilton*[200] provided the first explicit rejection of the industrious collection doctrine. A Third Circuit decision from the 1950s had held that only those portions of a map that were recorded by direct observation of the geography described could be copyrighted.[201] The *Hamilton* court, however, found this rule theoretically unsound and instead made clear that only originality is the basis for a copyright.[202]

The *Hamilton* court further cited early cases recognizing that " '(t)he elements of the copyright (in a map) consist in the selection, arrangement, and presentation of the component parts.' "[203]

Explicit and direct rejection of the industrious collection doctrine also appeared in the Fifth Circuit's *Miller v. Universal City Studios, Inc.*[204] decision, in which the court held that research itself is merely an alterna-

199. *See, e.g.*, 1 Nimmer & Nimmer, *supra* note 38, § 3.04.

200. 583 F.2d 448 (9th Cir. 1978).

201. Amsterdam v. Triangle Publ'ns, 93 F. Supp. 79, 82 (E.D. Pa. 1950), *aff'd*, 189 F.2d 104 (3d Cir. 1951).

202. *Hamilton*, 583 F.2d 448, 451. *See also* Signo Trading Int'l Ltd. v. Gordon, 535 F. Supp. 362, 364 (N.D. Cal. 1981); Roy Export Co. v. Columbia Broad. Sys. Inc., 672 F.2d 1095, 1103 (2d Cir. 1982).

203. 583 F.2d at 452 (quoting Gen. Drafting Co. v. Andrews, 37 F.2d 54, 55 (2d Cir. 1930)). *See also* Emerson v. Davies, 8 F. Cas., 615, 619 (C.C.D. Mass. 1845) (No. 4436).

204. 650 F.2d 1365 (5th Cir. 1981). *See also* Southern Bell Tel. & Tel. Co. v. Associated Tel. Dir. Publishers, 756 F.2d 801, 809 (11th Cir. 1985).

tive form of fact compilation and therefore also non-copyrightable. In doing so, the court provided for the first time a full-blown legislative, constitutional, economic, and policy-based analysis repudiating the industrious collection doctrine. Comparing the collection of facts to the compilation of names and addresses in a directory, the circuit court concluded that copyrightability for such a work rests "on the originality of the selection and arrangement of factual material, rather than on the industriousness of the efforts to develop the information."[205]

The court started its analysis with the idea/expression dichotomy, explaining that it "derives from the concept of originality which is the premise of copyright law."[206] Originality, the court continued, is a constitutional requirement, as illustrated by the Copyright Clause's use of the word "Author."[207] Facts, however, do not meet the threshold of originality because a "fact does not originate with the author of a book describing the fact. . . . "[208]

Although the court was aware of the possibility of diminished incentives to create databases, it understood that the only question at bar was whether the copyright laws were intended to provide such protection.[209] Under the law, the only element of a compilation of facts that can be protected is the original selection and arrangement.[210] Otherwise, directories are a problematic breed that cannot be reconciled with the principle that facts are non-copyrightable; the "mere use of the information contained in a directory without a substantial copying of the format does not constitute infringement."[211] Accordingly, the *Miller* court found the Second Circuit's approach in *Hoehling* and *Rosemont* more in line with the purpose and intended scope of copyright law because it "allows a subsequent author to build upon and add to prior accomplishments without unnecessary duplication of effort."[212]

Another Second Circuit case, *Eckes v. Card Prices Update*,[213] also rejected the industrious collection doctrine. The court rested its holding squarely on the "selection, creativity, and judgment" it found in the

205. *Miller*, 650 F.2d at 1369.
206. *Id.* at 1368.
207. *Id.* (citing U.S. Const. art. I, § 8, cl. 8). *See* also Burrow-Giles Lithographic Co. v. Sarony, 111 U.S. 53, 58 (1884)).
208. *Miller*, 650 F.2d at 1368–69.
209. *Id.* at 1369.
210. *Id.* at 1368.
211. *Id.* at 1369–70.
212. *Id.* at 1371–72.
213. 736 F.2d 859 (2d Cir. 1984).

baseball card guidebook at issue in the case.[214] Although the Second Circuit found a tension between the proposition that facts alone are not copyrightable while a collection of them is, it resolved this tension by applying the rule that only original selection or creative arrangement may be protected.[215] This solution was ultimately adopted seven years later in *Feist*.[216]

The Ninth Circuit followed the steps of the Second Circuit in *Eckes* in its 1987 decision *Worth v. Selchow & Righter Co*.[217] *Worth* is notable for the minimal scope of protection it affords compilations of facts. It is also instructive because of its endorsement of the original selection or arrangement requirement[218] and its reliance on cases disavowing the industrious collection doctrine.[219] The Ninth Circuit held that the discovery of a fact, regardless of the quantum of labor and expense invested in that discovery, is simply not a copyrightable work of an "author."[220]

In addition to these court decisions, the Copyright Office's registration practices during the years that preceded *Feist* are also informative. In its report on legal protection of databases, the Copyright Office outlined its registration practices during these pre-*Feist* years.[221] One of the primary roles of the Copyright Office is to register copyright claims in works of authorship.[222] Generally, the Copyright Office has always applied an originality standard. Until the late 1980s, however, based on the industrious collection doctrine it also registered compilations including, but not limited to, telephone directories and other factual databases.[223] Such works, however, were registered under a "rule of doubt."[224] This practice obviously stemmed from the fact that the case law at the time

214. *Id.* at 863.

215. *Id.* at 862. *See also* Fin. Info., Inc. v. Moody's Investors Serv., Inc., 751 F.2d 501, 510 (2d Cir. 1984)(Newman, J., concurring); Fin. Info., Inc. v. Moody's Investors Serv., Inc., 808 F.2d 204, 207 (2d Cir. 1986).

216. 499 U.S. 340 (1991).

217. 827 F.2d 569 (9th Cir. 1987).

218. *Id.* at 573.

219. *Id.* at 572–73.

220. *Id.* at 573-4 (citing Rosemont Enters., Inc. v. Random House, Inc., 366 F.2d 303, 310 (2d Cir. 1966)). *See also* Black's Guide, Inc. v. Mediamerica, Inc., No. C-90-0819, 1990 U.S. Dist. LEXIS 16272, at *10 (N.D. Cal. Aug. 15, 1990); Cooling Sys. & Flexibles v. Stuart Radiator, 777 F.2d 485, 491 (9th Cir. 1985).

221. U.S. Copyright Office, Report on Legal Protection for Databases 29–38 (1997).

222. 17 U.S.C. §§ 410, 701(a) (2005).

223. U.S. Copyright Office, *supra* note 221, at 32.

224. *Id.* at 30, 32–33.

simultaneously upheld both the industrious collection doctrine and the 1976 Act's explicit originality standard.[225]

Beginning in 1987, however, the Copyright Office began to question the copyrightability of works where the industrious collection doctrine was the only basis for registration.[226] By 1989, it had abandoned this standard for most compilations, continuing to apply it only to works like commercial telephone, street, and business directories and parts catalogues and inventory lists that were not "clearly *de minimis*."[227] Thus, database producers had fair warning that copyright protection might not extend to the facts contained in their databases.

In light of this long, complex, and vacillating history of copyright protection of databases in the U.S., one must wonder whether the Supreme Court really did "drop a bomb"[228] when it issued its decision in *Feist*. As the discussion above shows, the legal landscape prior to *Feist* was much more complex than what has been argued on either side of the *Feist* debate. The pre-*Feist* courts' constant struggle over the industrious collection doctrine set the stage for the Supreme Court's consideration of the issue and not surprisingly the Supreme Court ultimately granted certiorari in a Tenth Circuit case that applied the industrious collection doctrine to protect a white pages telephone directory against wholesale copying.[229]

Conclusions

The current debate over the legal protection of databases has lasted for almost ten years. As this Article has shown, however, the debate has failed to identify and discuss some of the most basic and preliminary historical aspects of the issue. This Article has therefore sought to challenge these underlying assumptions by providing a fresh look at the historical dimension of the debate.

Indeed, as can be seen from the more comprehensive review provided above on the history of informational works before the Court's

225. *Id.* at 32.
226. *Id.* at 32–34.
227. *Id.* at 32, 34.
228. Denise R. Polivy, Feist *Applied: Imagination Protects, But Perspiration Persists—the Bases of Copyright Protection for Factual Compilations,* 8 Fordham Intell. Prop. Media & Ent. L.J. 773, 782 (1998).
229. Feist Publ'ns, Inc. v. Rural Tel. Serv. Co., 916 F.2d 718 (10th Cir. 1990), *cert. granted*, 498 U.S. 808 (1990), *rev'd* 499 U.S. 340 (1991).

decision in *Feist*, the law's prevailing approach has long been to support unfettered access to facts and other materials considered indispensable for academic, economic progress. In particular, the discussion showed that the "sweat of the brow" doctrine had been in constant decline under the 1976 Copyright Act even before the Court finally repudiated it in *Feist*, clearly rebutting the commonly accepted argument that the Court dropped a bomb when issuing its decision in *Feist*.

Based on this historical analysis it becomes evident that the actual decision in *Feist* did not really establish any new law that would have come as a surprise to the database industry. Instead, *Feist* simply reflected the prevailing approach of the time. Most importantly, however, *Feist* reaffirmed the originality requirement and thus guaranteed the continued unfettered access to facts and information in a new and constantly evolving information environment.