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# Warren Publishing, Inc. v. Microdos Data Corp.: Continuing the Stable Uncertainty of Copyright in Factual Compilations

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## NOTES

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### WARREN PUBLISHING, INC. v. MICRODOS DATA CORP.: CONTINUING THE STABLE UNCERTAINTY OF COPYRIGHT IN FACTUAL COMPILATIONS

#### I. INTRODUCTION

In 1991, the Supreme Court proclaimed in the opening line of its unanimous decision in *Feist Publications, Inc. v. Rural Telephone Service Co. (Feist)*,<sup>1</sup> "This case requires us to clarify the extent of copyright protection available to telephone directory white pages."<sup>2</sup> Simultaneous with this declaration was a collective cheer from a then-grateful intellectual property community that had previously faced unclear standards relating to copyrightability. Although the Court was dealing specifically with telephone white pages, those in the intellectual property field knew that the rules declared in *Feist* would be applicable to one of the most confusing and controversial aspects of copyright law: compilations.<sup>3</sup>

However, the stability and clarity that the Court seemed to promise was short-lived. Soon after *Feist*, a series of cases started to pop up throughout the federal circuit landscape that seemed especially suited to be run through the *Feist* boilerplate: questions of copyrightability were supposed to be fed into one end, and the new standards were to produce consistent and predictable conclusions. The opposite occurred. Different circuits got different cases with similar facts, but the "fool-proof" *Feist* test produced different results. By 1993, the collective cheers of the intellectual property community had turned back to

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1 499 U.S. 340 (1991).

2 *Id.* at 342.

3 The *Feist* standards are set out in detail in Part IV. In general, the Court proclaimed that works that exceed a low threshold of originality (creativity in selecting or arranging facts) would qualify for copyrightability. See *id.* at 345-48.

the familiar moans of uncertainty. The continued division and uncertainty regarding copyrightability continues and has led to the problem of entrepreneurs' works being unprotected from competitors. *Warren Publishing, Inc. v. Microdos Data Corp.* ("Warren")<sup>4</sup> is a recent case that offers a good opportunity to explore the problems compilers face due to unclear copyright standards.

Copyright is a broad and complex area of law within an even broader and more complex intellectual property area. This Note seeks to explore a limited issue in copyright law primarily in the context of one case, *Warren*. This limited issue is what constitutes the proper interpretation and application of the rules governing copyrightability of factual compilations set out in *Feist* and whether the Eleventh Circuit properly decided the case in light of the Supreme Court's declarations. Therefore, Part II of this Note will explain *Warren*, as it is a case that provides a real world scenario which reveals the current state of copyright law as it applies to compilations. Next, Part III will attempt to explain copyright in general: from where the protection originates, how one obtains a copyright, and what it protects. After Part III thoroughly explains the basics of copyright, Part IV focuses exclusively on compilations and the Supreme Court's *Feist* decision, and it also explains how the Court erred by not providing the compilation community with clear standards relating to copyrightability. Part V will refocus on *Warren* in light of *Feist* and explain how the Eleventh Circuit misapplied the standards set out in *Feist*. Additionally, Part VI will analyze how the Eleventh Circuit's misapplication of *Feist* has led to inevitable splits between federal circuit courts, and subsequently, compilers face not only the unclear *Feist* standards but also variations among different courts in applying those standards. Finally, Part VII attempts to provide some answers to the current confusion in copyright-compilation law. Although many complicated solutions have been proposed, the simplest and most effective idea would be to continue to build upon present copyright law rather than abandon the current federal framework in favor of state law alternatives. The current legal scheme provides a solid foundation upon which the courts or Congress can further clarify and simplify the standards for achieving copyright in factual compilations.

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4 115 F.3d 1509 (11th Cir. 1997).

## II. *WARREN PUBLISHING, INC. v. MICRODOS DATA CORP.*: A BACKDROP FOR ANALYSIS

Because this Note focuses on compilation-related copyright issues primarily in the context of *Warren*, it is important to introduce the factual background and holding of the case at the outset. Warren Publishing, Inc. (Warren) has researched and published information regarding different aspects of the cable television industry since 1948.<sup>5</sup> The product of such work, and the subject of the litigation, was its annual directory called the Television and Cable Factbook (Factbook). Although the Factbook consists of two volumes, the controversy of the case pertained to only one volume, the Cable and Services volume. This volume is further divided into two sections: Directory of Cable Systems and Group Ownership of Cable Systems in the United States.<sup>6</sup>

As the cable television industry boomed, and continues to boom, cable franchises were established, sold, shrunk, and merged, affecting not only ownership structures but also the scope of geographic service areas. Warren took note of this fast-paced, quickly changing industry and saw a growing need in the industry for comprehensive information on the current state of cable systems nationwide. Warren then selected the information it believed would be the most useful to compile. Warren chose information such as the names, addresses, and telephone numbers of the cable system operators, the number of subscribers, the channels offered, and the price of services for the Directory of Cable Systems section. In addition, Warren included listings of individuals or entities which owned two or more systems or franchises for the Group Ownership of Cable Systems in the United States section.<sup>7</sup>

Next, Warren researched and compiled the names of every community in each of the states in the country that had any cable television services. Then, within each state, Warren identified each "cable system" according to its new definition of the term: "an entity composed as one or more communities that are offered the same service by the same cable system owner at the same prices."<sup>8</sup> From this smaller universe of cable systems, Warren now had a workable framework to arrange all communities within a state into its cable systems. For cable systems that only served one community (Single System Operations or SSOs), the name of that one community naturally became

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5 See *id.* at 1512.

6 See *id.* at 1511-13.

7 See *id.*

8 *Id.* at 1521 (Godbold, J., dissenting).

a listing in the Factbook. But, to cut down on the repetition that would result from listing operators which serve more than one community (Multiple Service Operators or MSOs), Warren came up with the idea of determining a "Principal" community under which it would list information regarding a particular cable system.<sup>9</sup> Warren decided to list all other "nonprincipal" communities within an alphabetical system but also to include a cross-reference to the proper principal geographical community listing, at which the user of the directory could find needed information regarding a cable system.

Microdos Data Corp. (Microdos), the defendant in the case, also publishes information about the cable television industry. The difference is that Microdos does not issue its information in directory form as does Warren, but rather on computer software. This software is called the Cable Access program.<sup>10</sup> Like Warren's Factbook, Cable Access is broken into sections—computer language and databases. Only two of such databases are pertinent to this Note: the System Database, which includes information on the various cable systems divided by state and city, and an MSO Database, which provides information on multiple systems operators in the same locales covered by the System Database.<sup>11</sup>

The crux of the litigation concerned Warren's 1988 Factbook. Warren filed suit against Microdos, claiming that Microdos' System Database and MSO Database infringed its 1988 registered copyright covering that year's edition of the Factbook. Although discussed more thoroughly below, it is important to understand that Warren was not claiming an infringement of the entire Factbook, but rather that the "method of presentation of facts under the principal community headings, with cross-references to the other communities served by that MSO, [was] entitled to copyright protection"<sup>12</sup> and was infringed by Microdos. Specifically, Warren claimed that Microdos infringed its copyright by using Warren's communities covered/principal community system and Warren's data fields and data field entries. The District Court for the Northern District of Georgia ruled that the data fields and data field entries were not copyrightable, but that the principal community format by which Warren selected and arranged its information was copyrightable, and held that the copyright was infringed by Microdos. As a result of its decision, the district court

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9 See *id.* at 1512-14.

10 See *id.* at 1512.

11 See *id.*

12 *Id.* at 1513 n.4.

granted Warren's request for a permanent injunction against Microdos' selling of the Cable Access program.<sup>13</sup>

On appeal, the Eleventh Circuit affirmed the decision of the court below, but the decision was subsequently vacated to be heard by an en banc panel of the Circuit. The Eleventh Circuit, en banc, reversed the injunction issued by the district court. The Eleventh Circuit agreed with the district court that Warren's data fields and data field entries were uncopyrightable, but also went further and ruled that the principal community arrangement was not "sufficiently creative and original to be entitled to copyright protection."<sup>14</sup>

### III. COPYRIGHT FOR DUMMIES<sup>15</sup>

The legal copyright issues in *Warren* apply specifically to a small component of copyright law: compilations.<sup>16</sup> But before analyzing *Warren* in light of the standards for compilations set out by the Supreme Court in *Feist*, an overview of copyright law is appropriate. The following background material is pursued because I hope this Note will aid and interest not only skilled and knowledgeable readers, but also those who may just be starting to research or develop an interest in copyright. This is not to say the current Part will not be helpful to those with a substantial background in this material. Many misconceptions exist about copyright; it is a quickly developing and changing area of law that leads to misunderstandings by scholars, and more importantly, to the entrepreneurs who benefit from using copyright law to protect their works. Last, I develop a working history of copyright law here because it would be presumptuous, and also misleading to any reader of this Note, to enter an analysis of these copyright issues without indicating the "from the beginning" approach I have taken in learning and writing about copyright.

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13 See *id.* at 1512-14.

14 *Id.* at 1520. Later in this Part of the Note, the statutory requirements of copyright are further examined. As will be shown, creativity and originality are central themes to modern copyright analysis.

15 The title of this section, "Copyright for Dummies," is not intended to indicate that this Part is a remedial overview. I hope only to play off a currently popular title of other comprehensive guides to various subjects: *DOS for Dummies*, *Basketball for Dummies*, etc.

16 In general, compilations can be thought of as fact-based works such as lists, directories, etc. that are helpful as a reference to their users. In Part IV of this Note, I examine compilations more extensively, including their statutory definition and treatment.

### A. *Where Does Copyright Come From?*

#### 1. The Pre-American Origin<sup>17</sup>

The history of modern copyright originated pursuant to the introduction of the printing press in England in 1476. Historians disagree whether copyright developed in response to the printing press in order to further the philosophy that one should be able to protect and benefit from the product of one's own labor, or as a way for the Church to censor the publication and distribution of literature made so much easier by the printing press.<sup>18</sup> Regardless, it is undisputed that by the mid-1500s, England's monarch, in accordance with the wishes of the Church, declared that criminal sanctions would be imposed on anyone publishing without the required license and approval from official government and Church censors. England feared that widespread publication would allow heretics and political dissidents to influence others, and the "Crown's solution to the problem was a system of regulations designed to control this 'dangerous' art."<sup>19</sup> As time would go on, these religious and government functions of copyrights would change dramatically.

Close to two centuries later, the shift from the theory of copyright as a tool of the Church and government to being an author's tool to protect her works became clearly evident. The Statute of Anne, passed by Parliament in 1710, embodied this shift in philosophy. The language of the Statute is instructive:

Whereas Printers, Booksellers, and Other Persons have of late frequently taken the Liberty of Printing, Reprinting, and Publishing, or causing to be Printed, Reprinted, and Published Books, and other Writings, without the Consent of the Authors or Proprietors of such Books and Writings, to their very great Detriment, and too often to the Ruin of them and their families; for Preventing therefore such [injustices] for the future, and for the Encouragement of Learned Men to Compose and Write useful Books; [those who cre-

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17 Although it may seem excessive to start an introduction to copyright law by starting with a historical reference point of over 500 years ago, such historical examination is helpful to grasping the evolution of copyright in the United States. This brief overview of pre-American copyright history will aid the reader in learning the context in which American legislators and courts have approached copyright dilemmas.

18 For a thorough history of the development of copyright in England, see generally C.B. MACPHERSON, *THE POLITICAL THEORY OF POSSESSIVE INDIVIDUALISM* (1962); L.R. PATTERSON, *COPYRIGHT IN HISTORICAL PERSPECTIVE* (1968).

19 CRAIG JOYCE ET AL., *COPYRIGHT LAW* 6 (2d ed. 1991).

ate works or have rights to such works] shall have the sole right and Liberty of Printing such Book. . . .<sup>20</sup>

This statute is not only seen as the embodiment of the philosophy that copyrights are needed to protect *authors*, but also the declaration that crediting authors and protecting their works promotes further valuable creativity and education from which society will benefit. Historians also credit the Statute of Anne as the foundation from which the United States, and many other countries, modeled their copyright laws.<sup>21</sup>

## 2. The Early Evolution of Copyright in America

The importance of copyright to American legal and economic development is best exemplified by its prevalence in early American history. As with most of this country's laws, Britain's influence was obvious in early American case law, and original copyright laws promulgated by the new states following the Revolution. Although the states' statutes differed from one another in several ways, all of them reflected the general purpose and spirit of the Statute of Anne: to protect authors' works and promote creative works that benefit the economy and public education. The Framers of the United States Constitution believed that because commerce was already growing at a fast rate, and expected to grow even faster, a uniform copyright law was a fundamental issue that should be addressed in the new Constitution so as to alleviate the inconsistencies between the states' laws. The Framers reflected this concern by protecting authors and inventors explicitly in Article I: "Congress shall have Power . . . To Promote the Progress of Science and Useful Arts, by Securing for Limited Times to Authors and Inventors the Exclusive Right to their Respective Writings and Discoveries."<sup>22</sup> Although the word "copyright" is not expressly mentioned in the Constitution, Congress soon used the concept of copyrights (as well as patents) as the tool by which it would secure writings and discoveries.

By 1790, in accordance with the power granted to Congress by the above-quoted Article I provision, Congress had passed the first federal copyright law. The importation of the Statute of Anne was

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20 Statute of Anne, 8 Anne C. 19 (1710) (Eng.), *reprinted in* JOYCE ET AL., *supra* note 19, at 7.

21 ROBERT E. LEE, A COPYRIGHT GUIDE FOR AUTHORS 14–16 (1995).

22 U.S. CONST. art. I, § 8, cl. 8. Although the concept of "authorship" is not highly debated or examined in this Comment, it is important to understand that "author" is used throughout this Comment "in the Constitutional sense to encompass all creators of copyrighted works." LEE, *supra* note 21, at xvii.



evident, as the first American copyright law contained similar language and terms, such as length of protection, filing and publishing requirements, and the requirement that the government retain a copy of the publication.<sup>23</sup> This original statute remained in effect for the following 119 years, until it became generally believed that the 1790 Act was not keeping pace with the changing economic needs of the country.<sup>24</sup>

In response to the perceived weaknesses of the 1790 Act, Congress passed the Copyright Act of 1909.<sup>25</sup> The main and most important difference between the 1909 Act and the 1790 Act, not to mention the subject of most criticism of the 1909 Act, was its focus on "publication"—making the work available to the public. Unlike the prior Act, the 1909 Act conferred copyright protection on a work upon the moment of its publication, not when the title of the work had been registered as required under the 1790 Act.<sup>26</sup> The 1909 Act, while trying to lessen some of the burdens of the prior law, created confusion because it proclaimed unclear standards and practices by making the "published" versus "unpublished" works distinction. The only works covered by the Act, and thereby governed by federal law, were "published" works. If a work was "unpublished," the different states' statutes, as well as common law, governed the standards and methods for authors seeking protection of newly created works. To further complicate the matter, even if a work qualified as "published," the Act was extremely rigid, full of notice, registration, and forfeiture provisions.<sup>27</sup> Although hoped to be a solution to the outdated 1790 Act, the 1909 Act resulted in heightened confusion, especially in the authorship community, and thereby detracted from the purpose of "[p]romot[ing] the Progress of . . . [the] Useful Arts,"<sup>28</sup> intended by the Framers.<sup>29</sup>

The confusing and extremely formal nature of the 1909 Act was not only ill-received by authors and inventors in this country, but also by international lawmakers concerned with intellectual property, who strongly disfavored Congress' early 1900s attempt at updating Ameri-

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23 See Act of May 31, 1790.

24 See JOYCE ET AL., *supra* note 19, at 10–20.

25 Copyright Act of 1909, ch. 320, 35 Stat. 1075 (1909) (codified as amended in scattered sections of title 17 of the United States Code).

26 See *id.* § 10 (1909 Act).

27 See *id.* §§ 1–15.

28 U.S. CONST., art. I, § 8, cl. 8.

29 For a comprehensive view of copyright law during the period when the 1909 Act was in effect, see generally 2 STUDIES ON COPYRIGHT (Copyright Society of the U.S.A. ed., Arthur Fisher Memorial ed. 1963).

can copyright law. In 1886, representatives of countries throughout the world concluded the first treaty regarding the treatment of copyrights in an international capacity, the Berne Convention for the Protection of Literary and Artistic Works (Berne Convention).<sup>30</sup> Most developed countries quickly adopted the resolutions made by the Berne Convention.<sup>31</sup> But the 1909 Act's formalism was in direct contrast with the low threshold standards and flexibility embraced by the Convention. As a result, the United States was forbidden membership in the Berne Convention and became the "black sheep" of the international copyright community.

### 3. The Foundation of the Current State of the Law: The 1976 Act<sup>32</sup>

The negative fallout from the 1909 Act soon became obvious. Many revisions were quickly introduced to deal with the unworkable aspects of the Act. Nevertheless, it was not until 1976 that real change occurred. The Copyright Act of 1976,<sup>33</sup> the modern-day statute, is seen as one of the most significant and fundamental revampings of an area of law in American legal history.<sup>34</sup> "The former system was abolished because it was 'anachronistic, uncertain, impractical, and highly complicated,'" and the new Act was expected to "'generally improve the operation of copyright law and would be more effective in carrying out the basic constitutional aims of uniformity and the promotion of writing and scholarship.'"<sup>35</sup>

Unlike the 1909 Act that conferred copyright protection upon "publication," the 1976 Act confers protection upon "fixation"—upon

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30 Generally, the Berne Convention was a response to Western European authors who were bothered by the protection, or lack thereof, of their works when those works crossed international borders. The Berne Convention sought to satisfy the nervous authors by creating multilateral standards and securities for authors whose works will be sold internationally. See ROBERT A. GORMAN & JANE C. GINSBURG, *COPYRIGHT FOR THE NINETIES* 873-75 (4th ed. 1993).

31 Membership in the Berne Convention is so important because the twenty-five member-nations develop standards that govern the recognition and rights regarding copyrights across international borders. Membership is necessary to facilitate multilateral negotiations regarding intellectual property issues among member-nations of the Convention. See H.R. REP. NO. 100-609 (1988).

32 For an explanation of the 1976 Act, see COPYRIGHT OFFICE, *LIBRARY OF CONGRESS, GENERAL GUIDE TO THE COPYRIGHT ACT OF 1976* (1977).

33 Copyright Act of 1976, Pub. L. No. 94-553, § 101, 90 Stat. 2541 (1976) (codified as amended in scattered sections of title 17 of the United States Code).

34 See LEE, *supra* note 21, at 16-17.

35 1 NEIL BOORSTYN, *BOORSTYN ON COPYRIGHT* § 1.06 (Dvora Parker ed., 2d ed. 1994) (quoting H.R. REP. NO. 94-1476, at 129 (1976)).

being created by the author in *any* medium that can be perceived or reproduced. In addition to lessening the formalities for copyright protection in terms of fixation versus publication, the 1976 Act eliminated many of the other hindrances of the 1909 Act, such as the rigid registration requirements, automatic forfeiture if formalities were not complied with, limited categories of copyrightable works, and the short term of years for which a copyright was effective. The Act was cheered by authors and noticed by the members of the Berne Convention, but the Act still fell short of the standards required to join the Berne Union.<sup>36</sup> Congress finally took the necessary action to become a member of the Union when it passed the Berne Convention Implementation Act in 1988.<sup>37</sup> This Act eliminated the requirement of notice of copyright for authors bringing suit in the United States who obtained their copyright in another country.<sup>38</sup> In addition, the Berne Convention Implementation Act eliminated the requirement of the 1976 Act that mandated that titles of works be recorded as a prerequisite for filing a copyright infringement suit. The 1976 Act, along with the Berne Convention Implementation Act, provide the current state of the law in terms of the requirements for obtaining a copyright in the United States.

### B. *The Requirements of Copyright*

With the history of copyright laid out, it is now appropriate to discuss the basic standards for achieving copyright status.<sup>39</sup> The three basic requirements of copyrightability under the 1976 Act are "fixation," "originality," and "notice of copyright."<sup>40</sup> Since, as discussed above, the notice of copyright requirement was eliminated to gain admittance into the Berne Convention, only fixation and originality are now required, and therefore pertinent to further analysis.

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36 For a listing of the general requirements of Berne membership, see LEE, *supra* note 21, at 20.

37 Pub. L. No. 100-568, 102 Stat. 2853 (1988).

38 It should be noted that although the Berne Act first eliminated the requirement of notice of copyright for foreign copyrights, today notice is elective for everybody regardless of where the copyright is obtained.

39 This Part of this Comment will generally examine the copyright standards under the 1976 Act. For a detailed discussion of special rules pertaining to special areas of copyright, see generally M. LEAFFER, UNDERSTANDING COPYRIGHT LAW §§ 1.1-1.15 (1989); BOORSTYN, *supra* note 35, §§ 2.06-2.17.

40 17 U.S.C. §102 (1994).

## 1. Fixation

The 1976 Act quickly sets out the fundamental originality and fixation requirements:

Subject Matter of Copyright: In General

- (a) Copyright protection subsists . . . in *original works of authorship fixed* in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated.<sup>41</sup>

First, the requirement of fixation in the 1976 Act was seen as the biggest lessening of the rigidity of prior copyright laws.<sup>42</sup> It is also one of the biggest misconceptions about copyrights. Now, copyright protection of a work exists *upon creation*, not upon publication. No formal steps must be taken by the author to register or file with the Office of Copyright. Confusion exists because copyrights are often mentioned in the same regard as patents and trademarks. But, although generally grouped together, the process for receiving patents and trademarks, especially patents, is remarkably different and more complex than it is for copyrights. To receive a patent, or rather to have a patent issued, an inventor must receive a grant from the Patent and Trademark Office.<sup>43</sup> This process is extremely specialized, and applying for such protection often requires assistance of a patent lawyer. In contrast, copyright is its own area of law, not dependent or contingent on patent and trademark law.<sup>44</sup> One important point to note is that while copyright law does not require any complicated registration process to create a copyright, ownership of a valid copyright is required to make a valid case for copyright infringement,<sup>45</sup> which is often proved by showing registration with the Copyright Office. But the important thing to remember is since the codification of the fixation standard, copyright in a work can exist upon creation of the work with no further formal steps taken by the author.

The point that copyright exists upon creation cannot be stressed enough, as it is one of the most significant misconceptions regarding copyright law. Simply put, "copyright is the right of an author to con-

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41 *Id.* § 102(a) (emphasis added).

42 See LEE, *supra* note 21, at 16–19.

43 See JOYCE ET AL., *supra* note 19, at 25–26.

44 The pertinent statutory requirements for patents are contained in 35 U.S.C. §§ 101–103 (1994 & Supp. II 1996): patentable subject matter, novelty, usefulness, and nonobviousness. The requirements for trademark protection can be found in the Lanham Act, 15 U.S.C. § 1052(a), (d), & (e) (1994 & Supp. II 1996).

45 See *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 361 (1991).

trol the reproduction of his intellectual creation.”<sup>46</sup> Second, *no formal process exists to obtain a copyright* under the 1976 Act. “Copyright protection subsists from the time the work is created in fixed form; that is, *it is an incident of the process of authorship.*”<sup>47</sup> This is why the 1976 Act is thought of as so revolutionary; no official act of notice and registration with the Copyright Office is required. When an author creates a work that is “fixed” and “original,” that author has a copyright. Now, under the 1976 Act, registration and notice of a claim for copyright do not confer copyright protection. The Copyright Office does not search files to determine whether a copyright application conflicts with another copyright that has been filed with the Office. The primary function of notice and registration with the Copyright Office now is to inform the public that an author is *claiming* a copyright in a particular work. This registration may become significant because an author must have a validly registered copyright to bring an infringement suit. Further, if litigation concerns two copyrightable works, the work that was registered first will be favored over a later or nonregistered work.<sup>48</sup>

Returning to the copyright requirement of fixation, it is a relatively simple concept. The fixation requirement is satisfied upon creation of a work “in any tangible medium of expression.”<sup>49</sup> Examples of tangible media are paper, film, audio tapes, and computer memory; the range of media is, for the most part, unlimited for practical purposes. Craig Joyce’s explanation of fixation is instructive:

Under the [1976] bill it makes no difference what the form, manner, or medium of fixation may be—whether it is in words, numbers, notes, sounds, pictures, or any other graphic or symbolic indicia, whether embodied in a physical object in written, printed, photographic, sculptural, punched, magnetic, or any other stable form, and whether it is capable of perception directly or by means of any machine or device now known or later developed.<sup>50</sup>

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46 GORMAN & GINSBURG, *supra* note 30, at 13.

47 LEE, *supra* note 21, app. at 201 (emphasis added).

48 *See id.* at 202–03.

49 17 U.S.C. § 102(a) (1994).

50 JOYCE ET AL., *supra* note 19, at 38. For an interesting and modern approach to the fixation requirement, see *Midway Manufacturing Co. v. Artic International, Inc.*, 547 F. Supp. 999 (N.D. Ill. 1982) (ruling that information on the video games Pac-Man and Galaxia is sufficiently fixed to warrant copyright protection from competing video game manufacturers).

## 2. Originality

The second, and more interesting, requirement of the 1976 Act is that the work be original; an "original work of authorship."<sup>51</sup> This requirement, unlike fixation, has proven elusive to firm statutory or common law definition. Neither § 101, the definition section of the 1976 Act, nor any other part of the Act, comes close to effectively defining what constitutes an "original work of authorship." But, as aggravating as it might be, this was the intent of the legislators.<sup>52</sup> They believed that since originality was a fundamental component of the protection granted to authors in the Constitution,<sup>53</sup> the definition of "originality" has and will continue to develop through interpretative rulings by the courts.

The courts have broken down originality into a two-part test: first, the work must not be copied or discovered, but rather be the author's own independently produced work, and second, the work must contain a degree of creativity. "This standard does not include requirements of novelty, ingenuity, or [a]esthetic merit . . ."<sup>54</sup> These aspects of originality are difficult to pinpoint and explain because they seem so interrelated and dependent upon each other, especially when first examining the originality requirement. The court in *American Dental Ass'n v. Delta Plans Ass'n* summarized this confusing interrelation by saying "copyrightability depends on originality, originality on creativity, and creativity on imagination."<sup>55</sup> So, creativity is used in two ways. First, applying creativity to the first requirement of originality, it simply means that the work should be the product of the author claiming the copyright. Or, in other words, the author should not claim a copied work as her own.

The second requirement of originality is that the work contain a degree of creativity, that the work be the product of the intellectual or imaginative powers of the author. This stems from the fundamental idea that certain things just are not copyrightable. The 1976 Act expressly lists some of those things which will never and should never warrant copyright protection:

In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in

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51 17 U.S.C. § 102.

52 See BOORSTYN, *supra* note 35, §§ 2.18–2.20.

53 See U.S. CONST. art. I, § 8, cl. 8.

54 Feist Publications, Inc. v. Rural Tel. Serv. Co., 499 U.S. 340, 344–345, 350–54.

55 39 U.S.P.Q.2d (BNA) 1714, at 1721 (N.D. Ill. 1996).

which it is described, explained, illustrated, or embodied in such work.<sup>56</sup>

One can add "facts" to the above statutory list. For example, an author cannot copyright that there are twelve inches in a foot, and I can not copyright my idea that copyright standards need further clarification. Such things are considered public domain,<sup>57</sup> and allowing people to copyright such would detract from, not add to, the goal of promoting useful works.

The logical question that flows from this discussion of the creativity standard is "how creative must an author be?" Happily for the aspiring author attempting to achieve the originality requirement, the threshold has been proclaimed to be low. But unhappily, and further discussed in a later section of this Note,<sup>58</sup> the inquiry into creativity is extremely fact-based, and no clear workable standard is evident. The case that is often quoted as proclaiming the standard for creativity is the already-mentioned primary focus of Part IV of this Note: *Feist Publications, Inc. v. Rural Telephone Service Co.*<sup>59</sup>

In *Feist*, the Court proclaimed that originality requires only "a modicum of creativity."<sup>60</sup> Such declaration would indicate a low creativity threshold indeed, but this standard has been the subject of much litigation and continues to be one of the sorest spots of the 1976 Act. The standard has led to authors having to create works, hoping it is sufficient to be deemed an "original work of authorship," but only to be sure upon litigating the matter when they believe someone has infringed their claimed copyright.

Since authorship is potentially so broad under § 102, courts have had to examine such investigative, fishing expedition type claims by "sculptors" of fish mannequins and koosh balls,<sup>61</sup> "composers" of video game music,<sup>62</sup> and "authors" of nontraditional works. One such nontraditional work, and the focus of the remainder of this Note, is the compilation. This limited area of copyright is exemplary of the application of the 1976 Act and is instructive of where the weaknesses of the Act exist.

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56 17 U.S.C. § 102(b).

57 The use of the term "public domain" here does not have a specialized meaning. It is simply referring to the idea that no one can "own" a fact or an idea.

58 See *infra* Part V.

59 499 U.S. 340, 345 (1991).

60 See *id.* at 1288.

61 See *OddzOn Prods., Inc. v. Oman*, 924 F.2d 326 (D.C. Cir. 1991).

62 See *Atari Games Corp. v. Oman*, 888 F.2d 878 (D.C. Cir. 1989).

IV. COMPILATIONS AND *FEIST*A. *Compilations and Their "Low Authorship" Status*

When thinking of the term "author," one may normally think of a novelist or columnist. It is important to clarify and keep in mind that the Copyright Act has an expanded meaning of the term.<sup>63</sup> While the original thoughts and stories of Charles Dickens or George Will can easily be identified as "original works of authorship" deserving of copyright protection, other works that may not "inspire the hearts of men" nonetheless deserve protection. These are works that are so valuable to education and the economy that promoting and protecting these "authors" is believed to be an equally desirable goal of copyright as the novel or magazine column. Jane Ginsburg differentiates between the former novel-type works as "high authorship" and the latter as "low authorship" works.<sup>64</sup> High authorship works include those obvious results of the creative mind and subjective thought process. These works are highly favored by the Copyright Act. Low authorship works are more utilitarian—works of information. These works are heavy on the effort side in terms of production, and lighter on the creative side. Compilations can be said to be the *sine qua non* of low authorship works under Ginsburg's definition. Nonetheless, because compilations, and other low authorship works, have such educational and commercial value, they are protected by the Copyright Act. But proving they are worthy of such protection continues to be a confusing dilemma for the authors of these works—especially with the apparent favoritism of the Act and courts for high authorship works.

Before examining this bias further, a brief explanation of compilations is appropriate. "Compilations" are expressly defined in the Act: "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."<sup>65</sup> This definition shows that compilations gain copyright protection not as a result of subjective content, but rather through an abstract methodology only described as selection, coordination, and arrangement.

The bias against copyright protection for compilations is exemplified by the simple statement made in *Feist* that "copyright in factual

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63 For an explanation of the term "author" as it relates to copyright, see *supra* text accompanying note 22

64 See Jane C. Ginsburg, *Creation and Commercial Value: Copyright Protection of Works of Information*, 90 COLUM. L. REV. 1865, 1866 (1990).

65 17 U.S.C. § 101 (1988).



compilations is thin.”<sup>66</sup> This statement is made although compilations, unlike many other types of works, receive explicit protection in the Copyright Act: “The subject matter of copyright as specified by section 102 includes compilations . . . .”<sup>67</sup> But even more important to the examination of this Note, the Act also lays out the limits of the statutory protection afforded to compilations: “The copyright in a compilation . . . extends *only* to the material contributed by the author of such work, as distinguished from the preexisting material embodied in the work, and does not imply any exclusive right in the preexisting material.”<sup>68</sup> This limitation is the codification of the long-standing principle that ideas, facts, and the like are never copyrightable. This limitation is not in contention, and there is not a court that will state otherwise. But as concrete a fact as it is, it is peculiar that courts and commentators exploring copyright issues seemingly must always so strongly reaffirm the basic notion that facts are not copyrightable.<sup>69</sup>

The fact that courts and commentators must always remind themselves and their readers that “facts are not copyrightable” exposes the true problem. The problem is focused upon a tension between the desire and need to protect factual compilations, while a fundamental premise of copyright law forbids protection of the materials which are the very essence of compilations: lists of factual information. Factual compilations, like databases, lists, and directories, are imperative to the economic well-being of many industries. Therefore, as the 1976 Act reflects, “authors” of compilations must be encouraged to create their works through protecting the products of their efforts. The importance of protecting compilations is not a controversial idea; their importance to education and economic development is not highly disputed. But this view competes highly with an opposing fundamental concept of copyright law that limits the scope of compilation protection.

The factual materials within compilations—names and numbers, etc.—are not copyrightable, which is easy enough to understand. But, what exactly is protected in a compilation is not. Because although, as noted above, copyright law now recognizes that compilations should be encouraged by protecting the product of the authors’ efforts, such recognition would indicate that hard work and research would qualify

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66 *Feist Publications, Inc.*, 499 U.S. at 349.

67 17 U.S.C. § 103(a) (1988).

68 *Id.* § 103(b) (emphasis added).

69 See generally *Feist Publications, Inc.*, 499 U.S. at 347; 1 MELLVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 3.04[B][1] (3d ed. 1985).

a resulting work for copyright. Indeed, they do not! The theory that copyright should be granted as a reward for hard work and effort and as an additional economic incentive to authors of compilations is referred to as the "industrious collection" or, more commonly, the "sweat of the brow" theory. The theory was supported by various courts<sup>70</sup> and commentators, not to mention members of the compilation authorship community, throughout the evolution of copyright law in this country. But, starting in the 1980s, courts began to abandon their support for the doctrine.<sup>71</sup> To be sure, though, the value of a compiler's labor was open to debate. That is, it was open to debate until *Feist* answered the question once and for all.

### B. *Compilations According to Feist*

The *Feist* Court proclaimed that the primary objective of copyright is not to reward the labor of authors, but "[t]o promote the Progress of Science and Useful Arts."<sup>72</sup> Most courts and commentators have viewed such proclamation as the final ringing of the death knell for the sweat of the brow doctrine.<sup>73</sup> So again, it is easy to say what the copyright protection in compilations is not: it is not a reward for industrious discovery. But, what is protected in a compilation? *Feist* is credited for exploring and developing, although inadequately, the basis for copyright protection in compilations.<sup>74</sup>

*Feist* addressed the confusing tension between protected compilations and the unprotected fact within: "Common sense tells us that 100 uncopyrightable facts do not magically change their status when

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70 See *Leon v. Pacific Tel. & Tel. Co.*, 91 F.2d 484 (9th Cir. 1937) (finding telephone directory as copyrightable work by essence of the author's efforts in compiling data); *Jeweler's Circular Publ'g Co. v. Keystone Publ'g Co.*, 281 F. 83 (2d Cir. 1922) (holding publisher of directory of firms engaged in jewelry business obtained copyright protection by means of labor in compiling information).

71 See, e.g., *Worth v. Selchow & Righter Co.*, 827 F.2d 569 (9th Cir. 1987) (rejecting court's prior holding in *Leon* that research or labor are protectable); *Eckes v. Card Prices Update*, 736 F.2d 859 (2d Cir. 1984) (claiming examination of plaintiff's claim for copyright in compilation of baseball card prices should focus on independent creation rather on the author's labor).

72 *Feist Publications, Inc.*, 499 U.S. at 348.

73 See, e.g., *Mid Am. Title Co. v. Kirk*, 991 F.2d 417, 421 (7th Cir. 1993); Priscilla A. Walter, *Facts After Feist: A Copyright Conundrum*, 37 PRAC. LAW. 67, 68-69 (1993).

74 For a comprehensive analysis of *Feist*, see generally Robert A. Gorman, *The Feist Case: Reflections on a Pathbreaking Copyright Decision*, 18 RUTGERS COMPUTER & TECH. L.J. 731 (1992); Gerald L. Lewis, Comment, *Copyright Protection for Purely Factual Compilations under Feist Publications, Inc. v. Rural Telephone Service Co.: How Does Feist Protect Electronic Data Bases of Facts?*, 8 SANTA CLARA COMPUTER & HIGH TECH. L.J. 169, 160-86 (1992).

gathered together in one place. Yet copyright law seems to contemplate that compilations that consist exclusively of facts are potentially within its scope."<sup>75</sup> With all the significance attached to *Feist*, a more comprehensive look at the decision is now appropriate. As was noted in the Introduction to this Note, *Feist* was believed to be the clarification of the "extent of copyright protection available to telephone directory white pages,"<sup>76</sup> but more importantly, to compilations as a whole. As will be shown in the context of *Warren*, much confusion and inconsistency are still apparent in the standards for copyrightability of compilations since *Feist*, despite the Court's declaration otherwise.

### 1. The Facts of *Feist*

In *Feist*, plaintiff Rural Telephone Services Company (Rural), a public telephone service provider, published and distributed annual directories to its subscribers.<sup>77</sup> Like a normal telephone book, Rural's directory alphabetically listed the names, addresses, and phone numbers of individuals and businesses by limited geographical areas. The defendant, Feist Publications, Inc. (Feist), published telephone directories as well, but unlike Rural's directory, Feist's directories covered wide-reaching areas. For instance, the Feist directory that was the subject of litigation covered fifteen counties and contained 46,878 individual listings in contrast to Rural's 7,700 listings.<sup>78</sup> Feist obtained its information by contacting public telephone service providers, like Rural, and asking permission to use their white pages listings in its own directory. Of eleven telephone companies that Feist approached for such permission, only Rural refused. Feist used Rural's listings notwithstanding the explicit refusal.<sup>79</sup>

Rural sued Feist in the United States District Court for the District of Kansas for copyright infringement, claiming the names and telephone numbers copied by Feist were subject to Rural's copyright of such material. The district court<sup>80</sup> granted summary judgment to Rural, claiming that it was a long-standing rule that telephone white pages, such as Rural's, were worthy of copyright protection. The

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<sup>75</sup> *Feist Publications, Inc.*, 499 U.S. at 345.

<sup>76</sup> *Id.* at 342.

<sup>77</sup> *See id.*

<sup>78</sup> *See id.* at 342-43.

<sup>79</sup> Feist's unauthorized use of Rural's information was not in dispute in the case. Feist even listed four "fictitious" listings that Rural had inserted into its directory to detect copying. *See Feist Publications, Inc.*, 499 U.S. at 343-44.

<sup>80</sup> *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 663 F. Supp. 214 (D. Kan. 1987).

Court of Appeals for the Tenth Circuit affirmed.<sup>81</sup> The unanimous Supreme Court reversed. First, the Court, as discussed above, wholly rejected Rural's sweat of the brow argument, noting in conclusion: "This decision should not be construed as demeaning Rural's efforts in compiling its directories, but rather as making clear that copyright rewards originality, not effort."<sup>82</sup> Though kindly recognizing the value of effort, the Supreme Court with such a statement laid to rest the sweat of the brow doctrine. Further, and more importantly, the Court refocused its analysis on what it saw as, and what has become, the emphasis of the copyrightability of compilations: originality. *Feist*, indeed, went as far as saying that the "sine qua non of copyright is originality."<sup>83</sup>

## 2. The *Feist* Principles and the Decision's Effects

As discussed earlier in this Note,<sup>84</sup> *Feist* broke originality into two subrequirements: "that the work was independently created by the author (as opposed to copied from other works), and that it possess at least some minimal degree of creativity."<sup>85</sup> And, also as discussed previously,<sup>86</sup> creativity is not synonymous with novelty—the creativity required is slight, and "[t]he vast majority of works make the grade quite easily, as they possess some creative spark . . . ."<sup>87</sup> So, *Feist* began its analysis of originality in a methodical fashion with these premises as backdrops. First, the Court looked at the material in Rural's directory. What the Court saw were facts, which, as previously discussed, are never copyrightable. So, compilations of facts, which are copyrightable, must find their originality by different means. The Court found the means by proclaiming that the tension between noncopyrightable facts and copyrightable compilations is wholly and consistently dealt with by the Copyright Act alone. The Court turned its attention to § 103, which proclaims: "The copyright in a compilation . . . extends only to the material contributed by the author, . . . and the only material contributed by the author that can qualify a compilation as an original work of authorship are the *selection, coordination, or arrangement* of the facts employed by the author."<sup>88</sup> To break this down into simple terms, the Court embraced the foun-

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81 *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 916 F.2d 718 (10th Cir. 1990).

82 *Feist Publications, Inc.*, 499 U.S. at 364.

83 *Id.* at 345.

84 See *supra* Part IV.B.1.

85 *Feist Publications, Inc.*, 499 U.S. at 345.

86 See *supra* Part III.B.2.

87 *Feist Publications, Inc.*, 499 U.S. at 345.

88 17 U.S.C. § 103(b) (1994) (emphasis added).

dation of the Act and laid out these basic premises: just because a work is entitled to copyright protection does not mean that the entire work is entitled to such protection; only the parts that are original (fulfill the creativity requirements) to this author are protected; and facts are never original, so the only way and the only parts of a compilation that are copyrightable are the parts selected, coordinated, or arranged in a sufficiently original/creative way. And thus, the Court similarly summarized: "A factual compilation is eligible for copyright if it features an original selection or arrangement of facts, but the copyright is limited to the particular selection or arrangement."<sup>89</sup> Note that originality (a work created independently, not copied, and containing some minimal degree of creativity) must be found in the compiler's selection *or* arrangement;<sup>90</sup> there need not be originality found in each aspect of the work.

At this point, *Feist's* bell curve of helpfulness for clarifying the extent of copyright protection to compilations quickly flattens. Because, while the Court proclaimed that originality must be found in a compiler's selection or arrangement, the Court never defined what these terms meant and, more importantly, just how creative one must be in selecting or arranging material to be entitled to copyright protection. What we do know from the decision is that Rural's white pages did not qualify. The Court said that the *selection* of names and numbers of telephone subscribers was "entirely typical" of telephone books, and "there [was] nothing remotely creative about *arranging* names alphabetically in a white pages directory."<sup>91</sup> Rural's white pages did not meet the "extremely low,"<sup>92</sup> "minimal level,"<sup>93</sup> "not particularly stringent,"<sup>94</sup> "modicum"<sup>95</sup> standard of creativity. So, upon reading *Feist*, an aspiring compiler ready to devote her time, money, and talents to advancing the arts or sciences has the inconclusive guidance that she needs more creativity than the white pages but no more than . . . well, who knows, for copyright protection.

To be fair to the Court, cynicism toward, and finding weaknesses in, the *Feist* decision comes from the benefit of hindsight. Nonetheless, *Feist* caused the type of confusion that the above discussion has tried to exemplify. And as will be examined more in-depth below, the

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89 *Feist Publications, Inc.*, 499 U.S. at 350–51.

90 *Feist* combined the coordination and arrangement requirements and referred solely to selection and arrangement throughout most of its discussion.

91 *Feist Publications, Inc.*, 499 U.S. at 363 (emphasis added).

92 *Id.* at 344–45.

93 *Id.* at 358.

94 *Id.*

95 *Id.* at 346.

confusion caused by *Feist* has been reflected in a split in the federal circuit courts in decisions defining the selection and arrangement requirements. Thus, while Tracy Lea Meade points out that *Feist* ended "the seventy year split among circuits"<sup>96</sup> concerning sweat of the brow versus creative selection/arrangement theory, the Court may have created a new seventy year split by not providing further clarification in the standards of originality it proclaimed.

The lack of clear standards is especially relevant because after a long wait, the Court had the opportunity to aid the most important readers of its decision: the compilers themselves. As the last word from the Supreme Court on the issue, a potential compiler interested in what she needs to do to gain protection for her potential work may look to *Feist* and mistakenly begin her pursuits. With the guidance, or lack thereof, of *Feist*, this hypothetical compiler may believe she needs only to be more creative in her selection or arrangement of facts than the Rural white pages. As it stands now, this may or may not be sufficient to obtain copyright protection against an alleged "infringer." More dangerous is the fact that probability of success in such a suit may depend upon in the circuit in which a compiler files such an action. Such inconsistency was to the demise of Warren.

#### V. WARREN: THE ELEVENTH CIRCUIT'S MISCONSTRUCTION OF THE *FEIST* TEST

At this point, this Note seeks to show through discussion of *Warren* the difficulty compilers face in protecting their works under the current legal scheme. Then, the different approaches taken by various circuit courts will be examined. Finally, this Note will conclude with some basic recommendations for clarifying the standards for copyrights in compilations.

After the standards for finding originality in compilations—sufficient creativity in the selection or arrangement of facts in the compilation—were laid out, imagine the position of Warren. Warren, as stated in Part II, had published its Factbook since 1948.<sup>97</sup> Warren believed it had protected its work from competitors by creating an original cable directory and filing a copyright. All of the sudden, Microdos, a competitor, distributed a database that employed the same information in a similarly selected manner as the Factbook was arranged. How does a compiler like Warren evaluate its own position

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96 Tracy Lea Meade, *Ex-Post Feist: Applications of a Landmark Copyright Decision*, 2 J. INTEL. PROP. L. 245, at 251–52 (1994).

97 See *Warren Publ'g, Inc. v. Microdos Data Corp.*, 115 F.3d 1509, 1512–13 (11th Cir. 1997).

so as to determine its possibility of success in a potential infringement suit against a competitor like Microdos? I would suggest the obvious: the concerned compiler would look to the law, and the further interpretations of that law by the courts. And what is that law? Our concerned compiler would quickly learn, as we have, that facts themselves are not copyrightable, but there is copyright protection for the portions of the compilation which are "selected, coordinated, or arranged" in an original way.<sup>98</sup> And, the compiler would surely recognize that the foremost recognized case on the issue, *Feist*, holds that selection or arrangement fulfills the originality requirement if "it displays some minimal level of creativity."<sup>99</sup>

This discovery of the basic format of the law would lead the concerned compiler in Warren's shoes to the belief that it had a pretty good infringement claim against Microdos. One can almost hear the thought process of a compiler such as Warren. "Sure, there are a lot of facts in the Factbook which are not worthy of protection, but look at all the original selection and arrangement of those facts." After all, why should Warren not think such? Warren developed its own original working definition of a "cable system," and from that definition approached the entire realm of raw data available to it. Armed with its own definition and all the raw data it needed, Warren selected the communities by a functional/operational method, then further selected and arranged these facts according to a newly defined "Principal Community" category. How, under current law, would such a compiler believe it did not surpass the hurdle of being a unprotected mere discoverer of facts to become a protected author? Judge Godbold best describes how Warren achieved the status of author by its original selection and arrangement:

The acts of selection carried out by Warren were a stream of events, beginning with its choice of the facts it wanted and the construction of a functional methodology in which to develop and present them. The use of a geographic name for each cable system, and the choice of the names of principal communities as identifiers, and the decision on a particular name, were not isolated acts of selection like Athena springing full grown from the brow of Zeus, or a decision made by a snap of someone's fingers, or a mechanical decision from a single telephone call, or by numerous calls. They were parts of a stream of acts of selection . . . part of the overall "work of authorship."<sup>100</sup>

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98 *Feist Publications, Inc.*, 499 U.S. at 361.

99 *Id.* at 350.

100 *Warren Publ'g, Inc.*, 115 F.3d at 1527 (Godbold, J., dissenting).

Unfortunately, the en banc Eleventh Circuit did not agree with Judge Godbold's view when evaluating Warren's claim. As stated in Part II of this Note, the district court in *Warren* ruled that Warren's principal community selection was uniquely original to warrant copyrightability. The Eleventh Circuit reversed this finding on the basis of a few different rationales that are inconsistent with *Feist* and copyright law in general.<sup>101</sup>

First, and briefly, the Eleventh Circuit focused part of its attention on the use of the word "system" by the district court; the district court used "system" to describe and protect Warren's selection and arrangement for principal communities.<sup>102</sup> The 1976 Act excludes any "system" from copyright protection.<sup>103</sup> But, this point deserves little attention here because even the Eleventh Circuit shied away from this weak argument, spending little time addressing it. The word "system" in the Act is coupled with "idea, procedure, . . . concept, principle, or discovery,"<sup>104</sup> emphasizing the already discussed fundamental that facts and ideas are not copyrightable. But unlike the Act, the district court used the word "system" in a more ordinary sense, as describing Warren's whole operational system. Contrarily, the situation the Act seeks to forbid is someone trying to claim a copyright in a fact or a method of discovery of such fact. And, here "[i]t seems beyond argument that Warren does not seek copyright protection on the idea of gathering and selecting data and reporting it in a manner that responds to the perceived needs for functional data of a changeable and changing industry. Rather it seeks a copyright on its expression of that idea."<sup>105</sup>

Although the court did not address the issue of the word "system" extensively, the mere presence of such argument exemplifies how the court acted contrary to the promotional spirit of the law, by focusing attention on semantics of the lower court rather than on the possible copyrightable aspects of Warren's Factbook. The Act, and *Feist* interpreting it, even with all the loose ends it left, made clear that original-

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101 It is important to keep in mind the history of copyright laid out in Part III. Copyright statutes from the Statute of Anne up to the current laws proclaim a fundamental interest in protecting authors so as to encourage them to produce works that will aid education, economy, etc. In addition, *Feist's* emphasis on the low level of creativity required for protection supports the spirit of the evolution of the law manifested in the 1976 Act. The standards for copyrightability were intentionally lessened so as to simplify the process of achieving copyright status. See *supra* Part III.

102 See *Warren Publ'g, Inc.*, 115 F.3d at 1517.

103 See 17 U.S.C. § 102(b) (1994).

104 *Id.*

105 *Warren Publ'g, Inc.*, 115 F.3d at 1530 (Godbold, J., dissenting).



ity is the basis of copyright protection and should be the emphasis of examining courts.

An opponent of this view will easily contradict the above argument by saying that the *Warren* court did emphasize the originality, or lack thereof, in the case. But, while the court did fully examine and ultimately rejected the original selection ruling by the district court, the Eleventh Circuit again ruled contrary to the spirit of the Copyright Act and *Feist*. The court rejected the claim that Warren's selection was sufficiently original to gain copyright protection. The court claimed that Warren did not select what communities or cable systems to include in its Factbook, but rather the Federal Communications Commission (FCC) and the various cable operators themselves did.<sup>106</sup> Using the Illinois as a test state, the court compared the 724 communities the FCC listed with those listed by Warren. The court claimed that Warren made no original selection as to the communities because not only did Warren list the 724 communities listed by the FCC, but also Warren listed additional communities for a total of over 1,000 principal and nonprincipal communities listed for Illinois.<sup>107</sup> But, the court erred by dismissing the fact that Warren only listed 406 principal communities from the FCC universe, and this is the expression that the district court found sufficiently original (creative) to warrant copyrightability. Warren showed the required "exercise of judgment in choosing which facts from a given body of data to include in a compilation."<sup>108</sup> Warren took from a large universe the communities it discovered from the FCC, cable operators, and other resources, and at that point had an uncopyrightable method of discovery. But, Warren went further, exercised its judgment, and selected—according to its principal community units—the facts which it would include in the Factbook. And, as stated earlier, the selection of the principal community was an original expression not based on prior existing classifications or a mechanical system; it was a series of creative selection and arrangement decisions based on its original redefining of a cable system. Warren's Factbook represented "a fundamental change in reporting data of a changing and developing industry."<sup>109</sup>

What makes the *Warren* decision so perplexing is the way the Eleventh Circuit so heavily relied on *Feist* in reaching its decision, notwithstanding *Feist*'s contrary proclamations. *Feist*, as repeatedly

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106 See *Warren Publ'g, Inc.*, 115 F.3d at 1517–20.

107 See *id.* at 1518.

108 *Id.* at 1525 (Godbold, J. dissenting) (paraphrasing *Key Publications, Inc. v. Chinatown Today Pub. Enters.*, 945 F.2d 509, at 513 (2d Cir. 1991)).

109 *Id.* at 1524 (Godbold, J., dissenting).

stated, supports a *low threshold* standard for achieving originality needed in selection or arrangement. But, as we know, the standard is not nonexistent: "The standard of originality is low, but it does exist."<sup>110</sup> After evaluating white pages that listed all telephone subscribers in alphabetical order, as virtually all white pages do, the Court concluded that Rural's selection and arrangement was of the limited type that was not sufficiently creative to warrant copyrightability. "Given that some works must fail [the test], we cannot imagine a more likely candidate."<sup>111</sup> By holding against Warren, the Eleventh Circuit put the Factbook in the same limited category of insufficiently creative works as the telephone white pages published by Rural. The court made this comparison despite Warren's admittedly innovative definition of a cable system and Warren's principal community selection and arrangement. The *Warren* dissent pinpointed the weakness of the court's holding when it concluded: "Warren's selection of data is original, creative and useful. To suggest it is the only conceivable useful way [like Rural's white pages] is astonishing."<sup>112</sup>

In the Eleventh Circuit's defense, many of the interpretive questions would not exist if *Feist* had further clarified the standards for originality in selection, coordination, or arrangement. But, even with unclear standards, *Feist* clearly calls for a low standard and does not support the heightened standard the Eleventh Circuit applies to such cases.<sup>113</sup> The spirit of *Feist* supports seeking protection of authors; the *Feist* Court sought to protect Rural, but after analysis decided it simply was not possible. In contrast, the Eleventh Circuit raised the originality hurdle set by *Feist* and sought not to find the means of protecting Rural; rather, the court ignored the Factbook's showings of originality, especially compared to the Rural white pages.

## VI. DIFFERENT RESULTS IN DIFFERENT PLACES: A TRUE DANGER

Although *Warren* contradicts the spirit of the Copyright Act and *Feist* by creating too high of a standard for originality, the most dangerous result of the decision is that it perpetuates the weakest aspect of *Feist* by failing to clarify the requisite level of originality for compilers basing expressive decisions on the case. Like *Feist*, *Warren* leaves us

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110 *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 362 (1991).

111 *Id.* at 364.

112 *Warren Publ'g, Inc.*, 115 F.3d at 1530 (Godbold, J., dissenting).

113 For another Eleventh Circuit decision that applies a heightened standard to the originality requirement for compilations, see *Bellsouth Advertising & Publishing Corp. v. Donnelley Information Publishing, Inc.*, 999 F.2d 1436 (1993) (holding that yellow pages publisher's selection, arrangement, or coordination of information related to Miami area businesses was not sufficiently original to warrant copyrightability).

with the knowledge that the particular work in controversy does not make the grade, but that is all. What does make the grade and the steps necessary are left unclear. All we know is that the standard seems high in the Eleventh Circuit. By dictating a strict standard for originality in contrast to the spirit of *Feist*, the Eleventh Circuit set the stage for inconsistencies throughout the various circuits. And, to be sure, this has been the result.

The split in the circuits regarding the standards for originality in compilations is extensively written upon, so this discussion is intentionally left as brief as possible. The most striking contrast among the circuits is between the Eleventh and Second Circuits.<sup>114</sup> In 1991, the Second Circuit decided *Key Publications v. Chinatown Today Publishing Enterprises, Inc.*<sup>115</sup> In *Key Publications*, the court found originality in a yellow pages directory created specifically to serve the Chinese community in New York City. The court, newly faced with the standards proclaimed in *Feist*, recognized that the standard for originality was low. Accordingly, the court said that Key's *arrangement* of businesses into listings that corresponded with Chinese interests and tastes and Key's *selection* of businesses relevant to the Chinese population made those sections sufficiently original to warrant copyrightability.<sup>116</sup> This low threshold approach taken by the Second Circuit shows how differently the Second and Eleventh Circuits view the standards set out in *Feist*; while the Eleventh Circuit raises the originality mark, the Second Circuit reads and applies *Feist* by looking at its clear language: the standard for originality is low and should be easily attainable. The division between different courts does not stop with these two circuits; the division is evident throughout the country. The approach taken by the Eleventh Circuit is similarly seen in the Seventh Circuit,<sup>117</sup> while courts in the Fifth,<sup>118</sup> Fourth,<sup>119</sup> and Second<sup>120</sup> Circuits have embraced the low threshold view.

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114 For a comprehensive and informative view of the contrasting views of the Second and Eleventh Circuits, see Ethan L. Wood, Note, *Copyrighting the Yellow Pages: Finding Originality in Factual Compilations*, 78 MINN. L. REV. 1319, 1332-34 (1994).

115 945 F.2d 509 (2d Cir. 1991).

116 See *id.* at 514-15.

117 See, e.g., *Mid Am. Title Co. v. Kirk*, 59 F.3d 719 (7th Cir. 1995) (finding title insurer's selection of facts to be included in title commitment insufficiently original to warrant copyrightability).

118 See, e.g., *Engineering Dynamics, Inc. v. Structural Software, Inc.*, 46 F.3d 408 (5th Cir. 1995) (holding that "input" and "output" formats of plaintiff's computer program contained sufficient original selection and arrangement to qualify as copyrightable work).

119 See, e.g., *Montgomery County Ass'n of Realtors v. Realty Photo Master Corp.*, No. 95-2488, 1996 WL 412584, at \*1 (4th Cir. July 24, 1996) (affirming that plaintiff

The divisions between the courts can have negative implications on those planning to create compilations. The amount of protection an author receives may depend on which jurisdiction that author is located. An unaware compiler in Georgia, like Warren, may not be protected, while if in New York, like Key, she would be. With a federal law, like the Copyright Act, such drastic discrepancies based on location should not result. At the very least, the protection provided to authors and the standards they face should be uniform throughout the country. Because *Feist* did not clarify, as it set out to do, the standards for originality in selection, coordination, or arrangement necessary for copyright protection, uniformity is indeed lacking: Warren's unique selection and arrangement is deemed insufficient, while Key's similar facts resulted in a decision affirming copyrightability.

## VII. WHAT IS TO BE DONE?

### A. *Unclear, High Standards of Originality at Whose Expense?*

As can be seen by the general theme of this Note, I believe the law, and more importantly, the courts' interpretation of the law in regards to copyrightability of factual compilations, is dangerously unclear. It is dangerous because as much as this topic offers material to be debated, researched, and written upon by academics, the academics who engage in such debate are not the people suffering. Rather, the actual compilers themselves are the victims of the uncertainty, and people are overlooking this point. I would imagine that an entrepreneur would be more satisfied with a clear standard to work with in developing a copyrightable work than with the knowledge that her misfortune offered me the opportunity to write a law review Note on the topic. For this reason, it is important to find a solution to the current problems within copyright law as it applies to compilations. People must work within the system, and their future success may depend on the state of the law. Compilers likely do not care much about the legal intrigue or the scholarly debate; they will not find solace in such symposiums, lectures, or writings. Their solace can only be found in decisive legislative and judicial action.

One need not search the databases too thoroughly to find scholarly articles answering the present question, "What ought to be done?"

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realtor's directory of property listings was copyrightable and was infringed by defendant's computerized listing of such properties).

120 See, e.g., *CCC Info. Servs., Inc. v. Maclean Hunter Mkt. Reports, Inc.*, 44 F.3d 61 (2d Cir. 1994) (holding that publisher's vehicle valuation compilation was sufficiently original under *Feist* because, although publisher's compilation was modest, *Feist* requires only a low level of creativity).

But, the following suggestions differ from the current trend of examining solutions to the copyright confusion, and these suggestions are comparatively simpler than others. While some are looking for protection in alternatives to the Copyright Law in state law licensing agreements, contracts, or amendments to the Uniform Commercial Code,<sup>121</sup> the problems can be solved by working within the federal copyright law regime. Requiring authors to find and use an alternative because the law intended to protect their rights is not doing its job is defeating to an area of the law that has developed over a 500 year span. Remember the Statute of Anne and the subsequent debates that led to the 1976 Act. Remember the struggle to gain acceptance to the Berne Convention. All of these efforts reflect the fundamental concept that a lessening of the burden to obtain copyright protection is a goal of copyright law. To abandon the progress made on developing a uniform law in favor of alternatives is premature.

*B. It's Broken—Not Dead—Let's Fix It!*

The easiest way to aid the compiling community is a re-examination of *Feist*. The focus of this Note, *Warren*, provided the Court with an opportunity to expand upon its ruling in *Feist*. Unfortunately, during the course of writing this Note, the Court rejected *Warren*'s petition for appeal. Nonetheless, *Feist* needs to be re-examined. Others agree that the case that was supposed to provide a workable framework for such issues has created, not answered, questions.

Obviously, *Feist* will require that much of the law touching copyright in fact works be rewritten. Eventually, this may bring some clarity into a field which is now in substantial disarray. That disarray is more than a problem of aesthetics. It generates confusion about the extent of the protection available for some of the most important information products now being generated and marketed . . . .<sup>122</sup>

A reexamination of *Feist*, in order to create clear standards for the compilation community, is key to helping those who need it most. Compiler-authors need more guidance in how original their selection, coordination, or arrangement need be, especially when it is easy for even the compilers themselves to notice the obvious "thinness" of their copyright claim. Authors know facts are not copyrightable, but compilations are. How they reach the threshold between unprotected

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121 See Stephen P. Tarolli, Comment, *The Future of Information Commerce Under Contemporary Contract and Copyright Principles*, 46 AM. U. L. REV. 1639, 1656-63 (1997).

122 JOYCE ET AL., *supra* note 19, at 215.

facts and copyrightable expression of such facts is what needs to be defined. Even if it is the high threshold imposed by the Eleventh Circuit and others, authors would be better off knowing now than being defeated later.

It must be reemphasized that a high threshold, clear standard is a solution with benefits; however, a low threshold, clear standard is more desirable than none. The evolving spirit of the copyright law is clear: "To Promote the Progress of Science and Useful Arts."<sup>123</sup> A low threshold better helps achieve this spirit. A commentator correctly pointed out that, while supporting *Feist's* repudiation of the sweat of the brow doctrine, "the Court established that the primary goal of copyright is to distribute information to the public. Benefits for authors are secondary."<sup>124</sup> While this statement may be true, it would be wholly incorrect to say that the two goals are mutually exclusive; rather, the goals are dependent. By protecting and benefiting authors, the copyright laws seek to encourage works promoting the progress of science, the arts, and the economy. What I am referring to, and a subject highly debated, is the incentive character of copyright. A lower threshold for originality would create better incentives for aspiring entrepreneurs who, by knowing that they will be able to protect their works, will create more and, in turn, will aid reaching the primary goal of promoting useful works.

Some commentators say that the lack of copyright protection does not affect the incentive to create fact-based works. Professor Joseph Bauer of the Notre Dame Law School has been kind enough to share with me a series of correspondences by academics throughout the country discussing such incentive questions on an intellectual property e-mail listserve. Some of these participants question the incentive-creating power of copyright law, claiming that no economic literature exists to support the contention that current law creates a disincentive to produce factual works. Further, some of the commentators point out that academics always have incentives to create—tenure, prestige, etc.—regardless of copyright protection. While it is true that it is difficult to find such economic empirical data supporting the incentive argument, the intellectual property community's reaction to *Feist* shows that the ones most affected by the unclear laws and high standards are worried about where such proclamations leave them. Soon after *Feist*, "the representatives of industries which might be adversely affected by such an outcome were swarming the halls of Con-

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123 U.S. CONST. art. I, § 8, cl. 8.

124 Meade, *supra* note 96 at 272.

gress in search of relief.”<sup>125</sup> The representatives’ actions following *Feist* indicate that they, the ones really affected by the decision, were concerned about their future economic position.

Second, even if there is no economic data to prove that strict copyright standards create disincentives to produce fact-based works, such empirical data should not be needed. Regardless of the true impact, the history of copyright shows that the laws were highly motivated by a desire to create incentives for authors. It is truly against the spirit of copyright law to say that, because there is no proof that the law makes a difference, we should not worry about it. Plus, we again must remember the compilers themselves. The authors of factual works are not generally academics driven by desires for tenure and prestige, but rather they are entrepreneurs driven by the desire to create, manufacture, and realize a profit. Such economic goals, and the overall economic benefit that ensues, is best met with a compatible copyright regime that provides clear, easy to reach standards of copyrightability. People are not born to write useful factual compilations. For a creative mind that is also driven by profit, the options are limitless. Why would such a person have equal incentive to create a factual compilation in such a unclear, highly stringent context when so many other clear, lucrative options exist? They will not! This is simply human nature. Staying true to the incentive-type goals of copyright law, by creating a low threshold for originality in factual compilations, will best serve the parallel goals of promoting and protecting such creator while promoting and protecting the creation itself.

Finally, the methods to reaffirm copyright law’s allegiance to creating incentives can be reached in simple fashion. In re-examining *Feist*, the Court or Congress should embrace the low threshold approach taken by the Second Circuit. As repeatedly stressed, a low threshold is consistent with both the 1976 Act and *Feist*. The problem is that neither clearly expresses a hard-line standard dictating such an idea. Such lack of clarity has produced the split between the courts throughout the country that currently exists. A reexamination of *Feist* should build upon the existing framework, but also focus on declaring clear workable guidelines to aid potential authors. Answering the question, “How creative must I, the author, be?” should be the sole goal of further judicial or legislative pronouncements.

In July 1998, Senator Rod Grams introduced legislation that would amend the Copyright Act to protect collections of information,

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125 JOYCE ET AL., *supra* note 19, at 213–14.

like Warren's Factbook.<sup>126</sup> The Collections of Information Antipiracy Act (Antipiracy Act), as the bill is named, states:

Any person who extracts, or uses in commerce, all or a substantial part, measured either quantitatively or qualitatively, of a collection of information gathered, organized, or maintained by another person through the investment of substantial monetary or other resources, so as to cause harm to the actual or potential market of that other person, . . . for a product or service that incorporates that collection of information and is offered or intended to be offered for sale or otherwise in commerce by that other person, . . . shall be liable to that person . . . .<sup>127</sup>

This amendment would drastically alter the Copyright Act by, for the first time, recognizing and protecting an author's effort, the time and money a compiler invested in her creation. In effect, this amendment would validate the sweat of the brow doctrine and turn the *Feist* decision upside-down. In fact, the Antipiracy Act cites *Feist* as a major reason why such an amendment is necessary, and parallels my concerns, stated above, that the current copyright regime fails to protect the ones who matter: the compilers. The Antipiracy Act states:

[T]he United States benefits from having ready access to reliable, up-to-date collections of information concerning all the endeavors of mankind; . . . advances in digital technology render information products increasingly vulnerable to database piracy . . . ; current Federal and State laws, including laws governing copyright, and misappropriation, do not adequately protect investments against this free riding; as a result of the [*Feist*] decision . . . , and certain decisions of the inferior courts of the United States, the copyright law affords members of the United States business community, both individuals and entities who create and distribute compilations of data, little or no protection against piracy; . . .<sup>128</sup>

The Antipiracy Act is the type of legislative action that compilers need in order to be encouraged to create. Further, this type of legislation is what we, the compilation users, need so that we will have continued access to collections of information. While the Collections of Information Antipiracy Act may face criticism for proposing to extend copyright protection to the facts themselves, processes, systems, and effort—aspects traditionally not adequate to achieve copyright status

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126 S. 2291, 105th Cong. (1998). The Antipiracy Act defines "Collection Of Information" as "information that has been collected and has been organized for the purpose of bringing discrete information together in one place or through one source so that users may access them." *Id.* § 3.

127 *Id.*

128 *Id.* § 2.



for a work—the Act reaffirms an allegiance to promoting useful works by offering authors incentive to create. Because the Supreme Court passed on the chance to clarify *Feist* when it refused to review the *Warren* decision, the introduction of the Antipiracy Act represents Congress' status as the only body capable of extending protection to compilers. Let's hope Congress, unlike the Court, does not pass up the opportunity.<sup>129</sup>

## VII. CONCLUSION

The weary intellectual property community hoped that *Feist* would provide a quick fix. Such hope died quickly after the decision was delivered. The long evolution of copyright law has shown that the courts and Congress have had to try an idea, see how it works, and make the proper adjustments; now is the time for such an examination and adjustment. But, *Feist* should not be the last word on the issue. Warren suffered from the present unclearness of the standards of copyrightability. It further suffered from bringing suit in a circuit that maintains a strict view of the originality requirements. *Feist* and the general spirit of copyright law show that achieving copyrightability should not be a complicated matter; it, more importantly, should not be a difficult status to achieve. By pronouncing a low threshold and clear standards for the originality requirements for selection, coordination, or arrangement in factual compilations, the Court or Congress has the ability to build upon and promote the evolving jurisprudence of copyright law. It is time to recommit to the incentive-creating spirit of copyright and give reason for a long-lasting cheer from a sure-to-be-grateful intellectual property community.

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129 On November 3, 1998, I spoke with Lian Chao Han, who is the Legislative Counsel for Senator Rod Grams, the author of the Antipiracy Act. Mr. Han informed me that the bill got stuck in conference after consideration by the Judiciary Committee. Mr. Han also stated that Senator Orrin Hatch has promised to reintroduce a version of the legislation next session. So, again, we will have to wait and see if Congress acts to clarify the protection offered to factual compilers. Telephone Interview with Lian Chao Han, Legislative Counsel for Senator Rod Grams (Nov. 3, 1998).

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