Wexis Sued; Legal Custom Revisited

Thomas G. Field, Jr.

When might including lawyer's work products in electronic databases harm their authors more than it benefits them or the public at large?

As widely reported, two attorneys recently filed a copyright class action against WestLaw and LexisNexis (publishers) for including attorneys' practice-related works in their databases. The complaint is available at *Scribd*, with copyright registrations for several documents written by one plaintiff attached. The other plaintiff has not registered. Together, they seek to represent all attorneys and law firms whose works have not been authorized for inclusion in publishers' databases whether registered or not. Complaint ¶¶ 11-12. They also seek damages, disgorgement of profits, and injunctive relief. *Id*. ¶ 3.

Even at this early stage, the suit garners attention as the first seeking to hold publishers liable under those circumstances. It is important, however, to appreciate that lawyers generate many kinds of practice-related works. In 2006, I endorsed Michael Pham's copyright recovery after a competitor duplicated documents used to solicit clients; *Lawyers Should Be Cautious When Copying Other Lawyers' Work* . Yet I noted that, had the court applied the correct measures of relief, Pham would have been worse off.

Inclusion of attorneys' appellate briefs in commercial databases is quite different. In 2005, Michael Whiteman found, despite the longstanding practices of such publishers, that they had gone unchallenged. *Appellate Court Briefs on the Web: Electronic Dynamos or Legal Quagmire*? 97 Law Libr. J. 467, 478-79.

I later explored the apparent dearth of protest more fully and concluded that attorneys' failure to litigate, while not dispositive, would suggest that such commercial reproduction of briefs is fair; *From Custom to Law in Copyright*, 49 Idea 125, 129-31.

Attorneys' ignorance of copyright helps explain the lack of protest. That aside, "[i]t is difficult to see how commercial database reproduction would diminish possible markets for existing briefs, much less reduce incentives to write more. Indeed, increased exposure through publication would seem to improve opportunities for further work. No attorneys alert to the last point are likely to oppose publication of entire briefs…." *Id.* at 130-31.

Reproduction of documents used to solicit clients is difficult to defend, but reproduction of court filings seems more defensible. *Id*. at 131-32. With regard to the latter, lack of originality might hinder recovery, but copyright-savvy attorneys merit legal support when they protest others' use of original pleadings to compete directly.

Yet legal database publishers do not compete directly. Although they support the work of attorneys, their activities also make competitive free riding easier. Courts seem unlikely to construe such publication as induced or contributory infringement, but the potential for competitive use should bear on the assessment of fair use and implied-in-fact licenses.

Scribd published the complaint in this case. That might constitute fair use, but unauthorized commercial publication seems less defensible than some attorneys appear to believe. *See* Ryan Davis, *Fair Use Likely To Shield Westlaw, LexisNexis In Copyright Suit*, Law 360 (Feb. 24, 2012).

Despite formidable problems, plaintiffs could prevail on the merits. With an eye to that, jurisdiction and remedies call for careful consideration. Those matters are controlled by 17 U.S.C. §§ 411(a) and 412.

Copyrights arise without registration. For domestic works, however, § 411(a) conditions pursuit of infringers on registration (or refusals to register). The Supreme Court has found, as a matter of legislative interpretation, registration unnecessary for jurisdiction. Reed-Elsevier, Inc. v. Muchnick, 130 S.Ct. 1237 (2010) (passim). But that interpretation leaves little hope for members of the putative subclass of plaintiffs who have not registered.

Members of the subclass who hold registrations prior to suit or later obtain them may not be much better off. Anyone who overcomes the § 411(a) hurdle faces another. Under § 412, authors of unpublished works who have not registered prior to infringement, as well as authors of published works who have not registered within three months of publication, are entitled to neither statutory damages nor attorney fees.

Recovery of profits and actual damages, as well as injunctive relief, is unaffected, but any party who has not already met the requirements of § 412 faces grim prospects. Let’s consider the remaining remedies.

First, as alleged in ¶ 27 of the complaint, profits could be substantial, but recovery is apt to require proof of willful infringement. Were custom to have a role, however small, in assessing willfulness, that could be difficult.

Second, actual damages do not turn on willful infringement, but they would seem exceedingly difficult to prove in the circumstances presented by this suit. Compounding

the problem, membership in the subclass of works registered and capable of litigating seems vanishingly small. Thus, should § 412 requirements not be satisfied, it is difficult to see how plaintiffs could obtain an award matching, much less exceeding, the cost of litigation.

Third, the potential for injunctive relief also seems slim. *See*, *e.g.*, New York Times Co., Inc. v. Tasini, 533 U.S. 483, 504-05 (2001), citing Campbell v. Acuff-Rose Music, Inc., 510 U.S. 569, 578, n. 10 (1994) (goals of copyright law are "not always best served by automatically granting injunctive relief").

Despite such poor prospects for success, plaintiffs may nevertheless soldier on, driven by concern about other attorneys' potential free riding. If so, they might bear in mind that an enhanced potential for plagiarism is amply offset if, as seems to be the case, publishers also facilitate identification of free riders who might otherwise escape notice. Indeed, as I once observed, in such circumstances "it is often as easy to catch pirates as it for them to *be* pirates." *Publishers' Rights and Wrongs in the Cyberage*, at note 15, J.Elec. Pub. (1999).