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Copyright and Compilations of Facts: *Feist Publications v. Rural Telephone Service, Co.*

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COPYRIGHT AND COMPILATIONS OF FACTS: *FEIST PUBLICATIONS V. RURAL TELEPHONE SERVICE, CO.*

SUMMARY

The Supreme Court's recent decision in the *Feist Publications* case has significant implications for the future copyright protection of intellectual property. In its determination of whether the white pages of a telephone directory were subject to copyright protection, the Court examined the criteria for copyright protection for compilations of facts. The Court determined that in order to be protected by copyright, there must be some degree of *originality* present in the compilation. Originality was examined by the Court within the context of the constitutional implications, statutory requirements, and caselaw. In the course of its analysis, the Court dismissed the long held "sweat of the brow" or industrious collection theory which sometimes substituted the labors of the compiler for the requirement of originality. In applying this standard of originality to the issue in question, the Court determined that the white pages of a telephone directory were not protected by copyright because they were mere facts and did not possess the necessary original selection, arrangement, or other original features.

The implications of this decision may be far reaching for a variety of industries in the United States which are involved with factual compilations. A few such businesses would involve mailing lists, membership lists, and other types of lists of names and addresses. Other professions possibly impacted by the decision are various compilers/transcribers of historical research and family genealogical research. Data-base producers and the software industry have demonstrated great concern regarding the long-term implications of this decision on their products. Certain computer programs might be deemed to be factual compilations without the requisite degree of originality necessary for copyright protection. Without being subject to copyright protection, they may enter the public domain and hence be available for the use of all. Such impact may have several results. Although the owners of those works which were no longer subject to copyright protection might experience injury, other persons who were able to use these works would benefit from the availability of the works. Conversely, the inability to receive and/or maintain copyright protection for such compilations may serve as a disincentive for future intellectual developments. While the Supreme Court has provided some guidelines for the copyright protection of factual compilations, future court decisions will probably provide specific limits of copyright protection for certain compilations.

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INTRODUCTION AND BACKGROUND

The United States Supreme Court recently examined copyright law within the context of compilations of facts in the *Feist Publications* case.[1] In this case the Court determined that the white pages of a telephone directory were not entitled to copyright protection. This decision upheld the statutory requirement that mere facts are not subject to copyright protection, and that compilations of facts are copyrightable only if they are selected, coordinated, or arranged in some *original* way. This report examines the facts and the judicial determinations underlying the *Feist* case and the potentially far reaching implications of this decision within the context of intellectual property.[2] Although the *Feist* case dealt with small businesses--a regional telephone company and a regional telephone directory publisher--and involved a modest amount of monetary infringement claims, the impact of the case on the future of the copyright of compilation of facts may be very significant. Some commentators have viewed the case as having a major impact on database creators, publishers, and the public, in that it appears to limit the extent of copyright protection for certain compilations.[3]

The facts of the *Feist* case were straightforward and were not in dispute. Rural Telephone was a certified public utility serving several communities in northwest Kansas. Rural produced a directory of its customers which contained about 7,700 listings. It earned advertising revenue from selling space in its yellow pages which were published as part of its directory. Feist Publications was a publishing company, *not* a telephone company, which specialized in producing geographic area-wide telephone directories. The Feist directories covered a large geographic area of the state of Kansas--areas serviced by eleven different independent telephone companies--and the directories comprised about

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1 *Feist Publications, Inc. v. Rural Telephone Service Company, Inc.*, 59 U.S.L.W. 4251 (U.S. Mar. 26, 1991) *reversing* 916 F.2d 718 (10th Cir. 1990).

2 For the purpose of this report, intellectual property is a concept which is considered to embody those property rights which result from the physical manifestation of original thought. Intellectual property is generally considered to be that property which is able to be protected by patents, trademarks, or copyrights.

3 LEGAL TIMES, April 22, 1991, 27.

47,000 listings. Rural refused to license[4] its listings because it wished to maintain competitive advantages in seeking yellow page advertising. Despite Rural's refusal to allow the use of its directory listings, Feist used at least 1,300 of Rural's telephone listings in creating Feist's own directory.

Rural asserted that its directory was copyrighted property and sued Feist for copyright infringement in the District Court for the District of Kansas.[5] Rural based its argument on the premise that Feist, in creating its own directory, could not use information contained in Rural's white pages. Rural argued that Feist was required to conduct a door-to-door or a telephone survey to discover the information that Rural had previously compiled. Feist argued that these efforts were economically impractical and unnecessary since the information copied from Rural's white pages was beyond the scope of copyright protection. The District Court granted summary judgment to Rural, upon the basis of the theory that courts had previously held that telephone directories and their factual listings are copyrightable.[6] On appeal, the Court of Appeals for the Tenth Circuit in an unpublished opinion affirmed the decision of the district court.[7] Feist appealed the decision to the Supreme Court[8] and the Court reviewed the lower court decisions on whether the copyright in Rural's directory in effect protected the names, towns, and telephone numbers which Feist copied. The Supreme Court reversed the previous holding and determined that the factual compilation of materials in telephone directory white pages was not subject to copyright protection.[9]

AMERICAN COPYRIGHT LAW AND COMPILATIONS OF FACTS

The concept of compilation within the context of copyright is specifically defined by the copyright statute which was most recently updated at the time of the general copyright law revision in 1976.[10]

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[4] "License" within this context means to permit another person to use an individual's property. In this case, Feist wanted to use (lease or rent) Rural's telephone directory listings for use in Feist's own directory.

[5] 663 F.Supp. 214 (D.Kan. 1987).

[6] *Id.* at 218.

[7] 916 F.2d 718 (10th Cir. 1990).

[8] *Cert. granted*, No. 89-1909, 59 U.S.L.W. 3243 (Oct. 1, 1990).

[9] The Supreme Court's reasoning underlying its decision is discussed *infra*.

[10] Pub. L. 94-553, Title I, § 101, Oct. 19, 1976, 90 Stat. 2545. Codified at 17 U.S.C. §§ 101, 103 (1988).

> "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."[11]

This definition of compilation has been subject to extensive judicial scrutiny and appears to indicate that the selection, coordination, or arrangement of preexisting materials represents the original work of authorship. However, the concept of what precisely constitutes "an original work of authorship" has not been *specifically* determined by the statute and has been subject to judicial determinations. A recent judicial interpretation of this definition was the case involving the West Publishing Company's key numbering system. This system is a self-index which uses Arabic numbering and page numbering.[12] The court determined that although the Arabic numbering system could not be copyrighted, the page numbering in West's National Reporter System publications was the key to the self-index by which West's arrangement was accessed, and was subject to copyright protection.[13] Thus, "taken as a whole," this numbering/indexing system was subject to protection within the context of the statutory definition of compilation. An extensive body of caselaw has developed which explores and defines the statutory parameters of the concept of compilation.[14]

Additional statutory guidance concerning the precise limits of copyrightable compilations is contained in Section 103 of the copyright statute.

> **§ 103. Subject matter of copyright: Compilations and derivative works**
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> (a) The subject matter of copyright as specified by section 102 includes compilations and derivative works, but protection for a work employing preexisting material in which copyright subsists does not extend to any part of the work in which such material has been used unlawfully.

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[11] 17 U.S.C. § 101 (1988).

[12] *West Pub. Co. v. Mead Data Cent., Inc.*, 616 F.Supp. 1571 (D.C. Minn. 1985), *aff'd*, 799 F.2d 1219 (8th Cir. 1986), *cert. denied*, 479 U.S. 1070 (1986).

[13] While the *West* decision was a very significant case in the development of the caselaw underlying the theory of copyrightable compilations, a somewhat different decision might be reached today as a result of the *Feist* ruling. The *West* decision was based in part on the "industrious collection" theory which was discredited by the Supreme Court in *Feist*.

[14] *See* Ginsburg, *Creation and Commercial Value: Copyright Protection of Works of Information*, 90 COLUM. L. REV. 1865, 1895-1901 (1990).

> (b) The copyright in a compilation or derivative work extends only to the material contributed by the author of such work, as distinguished from the preexisting material employed in the work, and does not imply any exclusive right in the preexisting material. The copyright in such work is independent of, and does not affect or enlarge the scope, duration, ownership, or subsistence of, any copyright protection in the preexisting material.[15]

The distinctions between a compilation and a derivative work should be noted. A derivative work incorporates already existing materials or works which are independently capable of copyright protection.[16] A compilation incorporates preexisting materials or data which may or may not be independently capable of being protected by copyright.[17]

Section 103 seems to indicate that only the author's contribution to the compilation is subject to copyright protection. Hence, it would appear that the compiler must contribute something new and original to the preexisting material so as to be able to qualify for copyright protection. The legislative history of this section provides some insight into Congress' intent concerning the copyright treatment of compilations. "A 'compilation' results from a process of selecting, bringing together, organizing, and arranging previously existing material of all kinds, regardless of whether the individual items in the material have been or ever could have been subject to copyright."[18] Thus, it seems clear that for a compilation to be subject to copyright protection, there must be some process involving *original* selection, collection, organization, and arrangement of materials which can be identified.

JUDICIAL DIVERGENCE

Over the years, the federal circuits developed two distinct interpretations regarding the copyrightability of the compilations of facts.[19] Some courts not only provided copyright protection to the contribution of the author, but *also* extended copyright protection to the underlying or preexisting work, whether or not such underlying work was independently protectable under copyright law.[20] In essence, this group of cases held that public domain material

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15 17 U.S.C. § 103 (1988).

16 Henn, COPYRIGHT PRIMER 45-46 (1979).

17 For further discussion on the distinctions between these concepts, see, Nimmer, NIMMER ON COPYRIGHT § 3.02 (1990)(cited to afterward as "Nimmer").

18 H. Rep. No. 1476, 94th Cong., 2d Sess. 57 (1976).

19 Nimmer at § 304.

20 *Id.*

contained in such a work could be copied freely if the person copying goes directly to the original source(s), but the copier could not copy directly from the copyrighted compilation. It appears that these cases were based upon the rationale that an individual should not benefit from the labor of another in the collecting, researching, or other arranging of facts in the public domain. However, other courts strictly applied the "originality" standard in order to uphold copyright protection for compilations and this second theory emerged.[21]

Generally speaking, these two schools became known as the 1) "sweat of the brow" or industrious collection standard and 2) the originality standard. Concisely stated, the industrious collection standard involves copyright protection on factual compilations on the basis of the effort devoted to their creation. This theory does not strictly require the originality standards and concentrates on the labors--sometimes arduous--of the compiler. In contrast to this industrious collection standard is the originality standard which specifically looks to the originality and the judgment of the compiler and does not consider the amount of labor or effort that was expended on the compilation in determining the copyrightability of the compilation.

"Sweat of the Brow" or Industrious Collection Theory

This theory takes into account the amount of labor expended in the creation of a compilation, rather than the novelty or originality of compiler contributions.[22] This theory began in the early nineteenth century when most data were manually gathered and the protection offered under copyright law was less definite.[23] The foundations of this theory rest on the inequity of allowing one to benefit from the fruits of another's labors. The underpinning of this theory apparently originated with a 1922 decision which is relevant in consideration of the *Feist* case.

> The man who goes through the streets of a town and puts down the name of each of the inhabitants, with their occupations and their street numbers, acquires materials of which he is the author. He produces by his labor a meritorious composition, in which he may

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[21] *Id.*

[22] Note, *Copyright of Factual Compilations: Public Policy and the First Amendment*, 23 COLUM. J. OF LAW AND SOCIAL PROBLEMS 347, 351-352 (1990)(cited to afterward as "Note").

[23] Patry, *Copyright in Compilations of Facts (or Why the "White Pages" Are Not Copyrightable)*, 12 COMMUNICATIONS AND THE LAW 42 (Dec. 1990)(cited to afterwards as "Patry"). This article explores the extensive legal history underlying the development of the "sweat of the brow" theory and was cited extensively by Justice O'Connor in the *Feist* opinion.

> obtain a copyright, and thus obtain the exclusive right of multiplying copies of his work.[24]

This precept of the industrious collection theory has been continued through the years, even after the 1976 copyright law revision which made "originality" a statutory requirement for copyrightability.[25] This industrious collection concept seems to reward the endeavors of the compiler, whether or not the work meets the statutory criteria for copyrightability or not, and whether or not the compilation represents an "original work of authorship."[26]

While this theory appears to be in opposition to the meaning of the statute, it was the basis for many decisions, including the lower court decision in the *Feist* case. In a trenchant commentary written in 1990 about the questionable practice of the judicial application of the industrious collection theory to the ability to copyright compilations of fact, the policy planning advisor of the Copyright Office made the following observations about this application.

> Although this [statutory] definition is the sole source of rights for compilations, one surprising point that fairly leaps out from even a cursory review of the case law and the commentary is the failure to consider, much less analyze, the text of the statute. . . .In place of analysis, one typically finds string cites, as in the lower court decisions in *Feist*. Even recent opinions rely on pre-1976 Act cases without regard to the current statutory definition, the radical changes in the technology of creating compilations, and the rejection of these early cases by sister circuits. . . .[27]

The Tenth Circuit, which made the decision in the *Feist* case, and the Seventh and Eighth Circuits continued the application of the industrious collection theory over the years.[28] However, this theory has been specifically rejected by the Second, Fifth, Ninth, and Eleventh Circuits.[29] Instead, the Second, Fifth, Ninth, and Eleventh Circuits adopted a standard based primarily on originality which is discussed below.

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[24] *Jewelers' Circular Pub. Co. v. Keystone Pub. Co.*, 281 F. 83, 88 (2d Cir.), *cert. denied*, 259 U.S. 581 (1922).

[25] *See, e.g., Rockford Map Pub. Co. v. Directory Service Co. of Colorado, Ind.*, 768 F.2d 145, 149 (7th Cir. 1985), *cert. denied*, 474 U.S. 1061 (1986).

[26] *See* 17 U.S.C. § 101 (1988).

[27] Patry at 49-50.

[28] *Id.* at 67-68. (Citations to those cases decided under the industrious collection theory). *See also* Nimmer at § 3.04.

[29] *Id.*

Professor Nimmer adopted the view that a similar legal end result from the application of the industrious collection theory could be obtained from the application of the theories of unfair competition and relevant state unfair trade competition statutes.[30] Nimmer was critical of the "distortion" of copyright law to achieve these ends.[31] Other commentators shared this opinion.[32]

Another factor that commentators raised in criticizing the industrious collection theory was that it failed to consider the dramatic changes in data and information collection, storage, retrieval, and other factors.[33] It appears that the cornerstone cases upon which this theory was based were decided long before the development of the computer and other sophisticated information retrieving systems. Thus, a great deal of human effort and energy were probably expended in the compilation of information in the older cases which based their decisions upon the industrious collection theory.

The Originality Standard Theory

The originality standard theory relies upon the specific statutory criteria for the copyright of compilations. Under this theory, the foremost determinative factor is whether the compilation is an "original work of authorship." This theory seems to be based upon a strict reading of the statute and a disregard for the amount of effort that the compiler may have invested in the compilation. The courts have examined the originality of judgment exercised in selecting and arranging material in a compilation.[34] As previously noted, the courts in the Second, Fifth, Ninth, and Eleventh Circuits have followed the originality standard theory, determining that copyright in compilations is based upon originality rather than labor.[35] This position was in opposition to the industrious collection theory which was embraced by the Seventh, Eighth, and Tenth Circuits and which was based in part upon the efforts of the compiler.

While the industrious collection theory seemed to mandate that the compiler must begin his/her research with little or no borrowing from earlier researchers, the originality standard appears to permit more borrowing from prior researchers. Thus, it appears that under this line of reasoning, compilers may borrow, adapt, or otherwise utilize existing materials. Thus, while compilers exercise unique expression in the arrangement of their compilations,

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30 Nimmer at § 3.04.

31 *Id.*

32 Patry at 62-63.

33 *Id.* at 61.

34 Note at 355.

35 *Id.*

they may utilize basic facts derived from other copyrighted compilations. This theory seems to follow the rationale expressed in a recent case: "to grant copyright protection based merely on the 'sweat of the author's brow' would risk putting large areas of factual research materials off limits and threaten the public's unrestrained access to information."[36]

Prior to the Supreme Court's decision in the *Feist* case, various commentators were evaluating the competing theories of the copyright of compilations. Generally speaking, commentators urged the application of the originality standard[37] which the Supreme Court ultimately accepted, rejecting the industrious collection theory.

THE SUPREME COURT'S RATIONALE IN THE *FEIST* DECISION

At the time that the Supreme Court agreed to review the decision in the *Feist* case, there was a clear division in the federal circuits concerning the scope of copyright in compilations. The two competing theories--the industrious collection theory and the originality standard were two competing legal theories with very different applications of American copyright law to compilations of facts. In analyzing the case, the Court had to determine the correct legal standard to be applied in determining the copyrightability and the possible infringement arising from compilations of fact. These areas--involving compilations and their possible infringement--were becoming increasingly important in the area of intellectual property.

The Supreme Court's decision in *Feist* is significant in several aspects. First, it represents the Court's first review of the theory of compilations as provided by the revised copyright law and the Court provided some definitive guidelines for the copyrightability of compilations. Second, the Court's decision was unanimous, indicating that the Court was positive and undivided in reaching this somewhat restrictive interpretation of copyright law. Third, related to this restrictive interpretation and the Court's unanimous decision is the belief that the Court may be less protective of copyright coverage in general in the future. Such a belief that the Court may be less protective of copyright has been of serious concern to the computer industry, publishers, and other merchants of intellectual property.[38] They seem to fear that their potentially exclusive property rights in copyright in their factual compilations may be jeopardized by this decision.

In a lengthy opinion, Justice O'Connor wrote a sweeping and analytical examination of the copyright concepts underlying the protection of compilations,

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[36] *Financial Information, Inc. v. Moody's Investors Service, Inc.*, 808 F.2d 204, 207 (2d Cir. 1986), *cert. denied*, 484 U.S. 820 (1987).

[37] *See* Patry at 64-65.

[38] NEW YORK TIMES, Mar. 28, 1991, at D1.

specifically within the context of copyright protection available to telephone directory white pages. The Court's review of the case enables it to determine whether the copyright in Rural's directory protects the names, towns, and telephone numbers copied by Feist. The Court first turned to two long held concepts under American copyright which have an underlying tension: facts are not copyrightable; but, generally, compilations of facts are copyrightable.[39] Citing back to a prior decision, the Court reaffirmed that no author can copyright his ideas or narrative facts.[40] *Originality* was deemed to be the key factor for the copyright of facts; hence, some degree of originality must be added to facts to be able to achieve copyright for compilations.[41] The Court traced the constitutional, statutory, and caselaw development of the originality requirement.[42] This distinction between the copyright treatment of mere facts and compilations of facts was stated by the court.

> It is this bedrock principle of copyright that mandates the law's seeming disparate treatment of facts and factual compilations....This is because facts do not owe their origin to an act of authority. The distinction is one between creation and discovery: the first person to find and report a particular fact has not created the fact; he or she has merely discovered its existence.[43]

Originality was considered by the Court within the context of the Constitution. The Court considered the source of congressional power to provide copyright laws in Article I, § 8, cl. 8 of the Constitution. This clause authorizes Congress to "secur[e] for limited Times to Authors. . . .the exclusive Right to their respective Writings." In certain decisions in the late nineteenth century, the Court examined and provided definitions for the terms "writings" and "authors."[44] In these cases, the Court clearly determined that these terms "presuppose a degree of originality."[45] The Court carefully examined the concept of originality within the context of the contributions of the author. In scrutinizing originality, the Court determined that: "The writings which are to be protected are *the fruits of intellectual labor*, embodied in the form of books,

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[39] 59 U.S.L.W. 4251, 4252 (U.S. Mar. 26, 1991).

[40] *Harper & Row, Publishers,Inc. v. Nation Enterprises*, 471 U.S. 539, 556 (1985).

[41] 59 U.S.L.W. 4251, 4252.

[42] *Id.* at 4252-4253.

[43] *Id.* at 4253.

[44] *The Trade-Mark Cases*, 100 U.S. 82 (1879); and *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53 (1884).

[45] 59 U.S.L.W. 4253.

prints, engravings, and the like."[46] After reviewing the reasoning in these cases, the Court concluded that the originality requirement articulated in these cases "remains the touchstone of copyright protection today."[47] The Court emphasized the *constitutional* requirement of originality for all works.

The Court next turned to an analysis of factual compilations and under what circumstances such compilations may have the required degree of originality for copyright protection.

> The compilation author typically chooses which facts to include, in what order to place them, and how to arrange the collected data so that they may be used effectively by readers. These choices as to selection and arrangement, so long as they are made independently by the compiler and entail a minimal degree of creativity, are sufficiently original that Congress may protect such compilations through the copyright law.[48]

Indeed, the Court found that even a directory that contained no protectable written expression, just facts, could meet the constitutional minimum for copyright protection if it featured an original selection or arrangement. However, the Court made the important distinction that the fact that a work is subject to copyright does not mean that *every element* of that work is copyrighted. Thus, copyright may extend only to those parts of a work which possess the requisite element of originality. If the selection and arrangement of facts in the compilation are original, then the selection and arrangement features of the compilation are eligible for copyright protection. Despite the originality of the format, the mere facts themselves do not become "original" and hence subject to copyright protection due to the originality of the format in which they may be presented.[49]

The Court determined that the copyright in a factual compilation is "thin."[50] In spite of a valid copyright in a compilation, a subsequent compiler could utilize the underlying facts contained in a publication in the preparation of another work. Although the Court noted that the limitation of copyright protection to one's original works may have inequitable results, the Court determined that such a requirement would ultimately advance the progress of science and art, a constitutional requirement of copyrights. The Court concisely summarized the distinction between facts and factual compilations.

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46 *Id.*, citing 100 U.S., at 94 (emphasis in original).

47 59 U.S.L.W. 4253.

48 *Id.*

49 *Id.*

50 *Id.*

> This, then, resolves the doctrinal tension: Copyright treats facts and factual compilations in a wholly consistent manner. Facts, whether alone or as part of a compilation, are not original and therefore may not be copyrighted. A factual compilation is eligible for copyright if it features an original selection or arrangement of facts, but the copyright is limited to the particular selection or arrangement. In no event may copyright extend to the facts themselves.[51]

In reviewing the development of caselaw dealing with compilations, the Court determined that the courts which had advanced the "sweat of the brow" theory "misunderstood the statute."[52] The Court discussed the numerous flaws underlying this doctrine, "the most glaring being that it extended copyright protection in a compilation beyond selection and arrangement--the compiler's original contributions--to the facts themselves."[53] In criticizing the courts that followed this doctrine, the Court concluded that they ignored the fundamental principle of copyright law, that no one can copyright facts or ideas. The Court next analyzed the statutory definition of compilation and its application to various works. The Court specifically noted that there is a "narrow category of works in which the creative spark is utterly lacking or so trivial as to be virtually nonexistent."[54] Such works are not subject to copyright protection.

The Court next turned to analyze the copyrightability of the white pages of a telephone directory. The Court found that a key question for its resolution was whether Rural selected, coordinated, or arranged these uncopyrightable facts--names and addresses--in an original way.[55] After considering the white pages and their selection, coordination, and arrangement, the Court concluded that they did not satisfy the minimum constitutional standard for copyright protection. It determined that the white pages were "entirely typical" and that Rural's "end product is a garden variety white page directory, devoid of even the slightest trace of creativity."[56] As Rural's white pages lacked the originality requirement, Feist's use of the listing did not constitute infringement. Although the Court made clear that it was not disparaging Rural's compilation efforts, rather, it made clear that *copyright rewards originality, not effort.* [57] The

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51 *Id.* at 4254.

52 *Id.*

53 *Id.*

54 *Id.* at 4256.

55 *Id.* at 4257.

56 *Id.*

57 *Id.* (emphasis added).

Court did not specifically address the issue of whether Rural's yellow pages were copyrightable as a compilation.[58]

IMPACT OF THE *FEIST* DECISION

It appears that the impact of the *Feist* decision may be far reaching in a number of legal and policy areas in the realm of intellectual property. Some of these areas are considered below.

The copyrights of some subject compilations may well be impacted by the *Feist* decision. Some compilations which may be considered within the *Feist* copyright context include mailing lists, subscription lists, and membership lists.[59] If the *Feist* rationale is applied to these compilations, it appears that the deciding factor in their ability to be subject to copyright is the amount of *originality* that they may possess. In addition, only the original elements of these compilations are covered by copyright and the basic facts--i.e., names and addresses are probably not protected by copyright since the *Feist* decision. This decision may have considerable impact for those businesses, charities, organizations, and publications which make extensive use of mailing lists.

Another area of research which the *Feist* decision will probably impact is historical research. Typically, researchers decipher early American public records which may involve laborious efforts and then the researchers copyright and sell their research. Since it seems unlikely that copyright protection will now be given to such works--these efforts may have been protected under the now-repudiated industrious collection theory--it will be interesting to observe whether this decision will impact the amount of historical research works which are undertaken. Another area similar to the research and publication of governmental records is the compilation of family records or genealogies. Again, the standards of originality would be applied to these compilations to determine whether or not the arrangement or other feature of the works might merit copyright protection. It seems unlikely that simple lists of individuals' names would merit copyright protection in light of *Feist*.

Commentators have considered that the *Feist* decision could impact mechanical parts catalogs and other types of catalogs.[60] Clearly, the decision

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[58] Although arguments favoring and opposing the copyrightability of yellow pages can be made, it seems likely that the yellow pages are subject to copyright protection. It could be argued that the "originality" requirement would be met with: 1) the determination of the various subject index terms under which to group the customer listings; 2) original art work; and 3) the selection and arrangement of advertisements. It seems likely that these factors would represent sufficient "originality" to be worthy of copyright protection.

[59] Patry at 40.

[60] *Id.*

has altered the copyright perspectives of telephone directories and may impact management practices in the future for both the telephone companies and the companies that publish telephone directories. Virtually any business or intellectual practice which involves factual compilations is impacted by the *Feist* decision and the stringent requirement that originality must be present in order for a compilation to receive copyright protection.

The current copyright status of compilations of facts has been of considerable interest to the computer software industry. Computer software[61] is primarily composed of instructional lists or series of information and/or commands which could be considered compilations of facts. Some software programs can be compared to building blocks with advanced programs and commands building onto other primary programs and commands.[62] Through the development of software caselaw, the question has arisen as to whether the basic component parts of the programs--such as very basic computer commands--were subject to copyright protection. Following an examination of software case law,[63] it appears that the most complete judicial determination of whether component parts--individual commands--of computer software are subject to copyright protection is in the 1990 *Lotus* case.[64] In examining the particular components of the program, the district court determined that even though some of the command functions were very obvious, the program as a whole was subject to protection. "The fact that some of these specific command terms are quite obvious or merge with the idea of such a particular command term does not preclude copyrightability for the command structure taken as a whole."[65] The court concluded that in determining whether software was subject to copyright was to ". . .identify those elements that are copyrightable, and then determine whether those elements, *considered as a whole,* have been impermissibly copied."[66] The *Lotus* court's "whole" approach was in part adapted from prior caselaw involving video games and the fact that individual components of the game might not be copyrightable, but that taken as a whole,

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[61] For the purposes of this report, computer software is used with the same meaning as the concept of computer programs.

[62] CRS-Report 91-281, Computer Software and Copyright Law 15-17.

[63] *See* M. Goldberg, COPYRIGHT PROTECTION FOR COMPUTER SOFTWARE: A SUMMARY OF AUTHORITIES WITH AN EMPHASIS ON CURRENT JUDICIAL DEVELOPMENTS 1-139 (1990).

[64] *Lotus Development Corp. v. Paperback Software Intern.*, 740 F.Supp. 37 (D.Minn. 1990).

[65] *Id.* at 67.

[66] *Id.* (emphasis in original).

the game was subject to copyright protection.[67] In a somewhat differing position, commentators have sometimes argued that the unauthorized adaptation or the borrowing of certain component parts of a software program might be considered to be "fair use"[68] of that program.[69]

It may be considered that the *Feist* decision may have some impact on the primary component elements of computer software. Thus, if the *Lotus* case had been decided after *Feist*, somewhat different conclusions might have been reached. In evaluating the component parts of software in light of the *Feist* originality requirement, it could be argued that most software is based upon series of basic commands and instructions which individually may not possess the requisite originality to obtain copyright protection. Although the *Lotus* court took the approach that the program was to be "taken as a whole," this rationale may not be applicable with the originality requirement mandated by *Feist.* Hence, it could be argued that certain basic component parts of a software program which do not possess the requisite originality may not be subject to copyright protection.[70]

As the Supreme Court has never examined copyright issues within the context of computer software, the *Feist* case could be of significance in a future software decision by the Court. At a recent Office of Technology Assessment Workshop, experts in copyright law and computer software considered the possibility that the Court, in its initial examination of copyright issues and computer software--in the wake of *Feist*--could construe the copyright in computer software very narrowly and hence, provide limited protection for software.[71] Such an analysis could consider the elements of the computer program to be compilations of facts. The copyright experts considered that the Court would consider issues of originality and application of the *Feist* principles to software. If the *Feist* rationale is used in a future software copyright analysis, a nexus would have to be made between lists of names and addresses in a telephone directory and the sets of commands or instructions composing

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[67] *Atari Games Corp. v. Oman*, 888 F.2d 878 (D.C. Cir. 1989).

[68] 17 U.S.C. § 107 (1988).

[69] 1 Sherman, Sandison, & Gruen, Computer Software Protection Law § 204.2(b)(2)(1990).

[70] It can be concluded that certain software such as spellcheck or spreadsheets contains copyrightable elements. However, it is unclear whether *all* of the instructions and commands in these programs would be covered by copyright in light of *Feist.* It could be argued that certain rudimentary commands or foundation elements--upon which the more complex programs are based--are compilations of facts.

[71] Office of Technology Assessment, *Workshop on the Present Copyright/Patent/Trade Secret System of Protection* (June 20, 1991).

computer software. Parallels might be able to be drawn between the listings in a telephone directory and lists of commands in a computer program.

In the software industry, much revenue is generated through the licensing and cross-licensing of existing software to competitors and the determination that some portions of this software might not be protected by copyright could create considerable market dislocations, adjustments, and readjustments within the software industry.[72] At the present time, it is uncertain just how much software might be construed to be compilations of facts without the necessary "originality" element. It appears that at the current time, no court cases have been determined on the specific basis of computer software as a compilation of facts. However, such an argument could be the basis for a defense to software copyright infringement. Likewise, the argument could be raised that the use of component parts of a software program would be the "fair use" of the program.[73]

Some databases which contain factual information without original analysis may be construed not to be subject to copyright protection in view of the *Feist* decision. Such a database might include lists of facts which are accessible by electronic technology, but without original arrangements or other original features. However, the issues may be more complex in databases which include factual information, as well as particular arrangements of facts and analysis. In these instances, it would appear likely that the original arrangement and the analysis comments would probably be subject to copyright protection, but that the body of factual information would not be subject to protection. The *Feist* decision would appear to place some databases--those based primarily on facts--in the public domain.

On the other hand, if software, certain databases containing factual information, and other intellectual property did enter the public domain as a result of the *Feist* decision, it could be argued that such a process was not necessarily a detrimental result. Many persons within the software community have often advocated a "liberation of software" or a freeing of certain key software programs, or elements of such programs. It could be theorized that through channeling software into the public domain, greater software development and innovation could result.[74] In opposition to this position is the argument of some software producers and innovators that without stringent

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[72] It is beyond the scope of this report to examine specific software programs to determine what rudimentary portions could be subject construed to be "compilations of facts" and hence, perhaps not subject to copyright protection. Judicial determinations may have to be made to determine what programs or what portions of programs contain the requisite originality in light of the *Feist* decision.

[73] *See* note 69.

[74] However, such arguments are speculative and analysis of such a position is beyond the scope of this report.

copyright protection, there will be insufficient incentive to continue producing and developing innovative computer software. Thus, there clearly are two views upon the application of the *Feist* standards to computer software.

A copyright specialist at Duke University Law School observed that the *Feist* decision could be revolutionary for the information industry with the dual effect of allowing access to more information, but also diminishing the economic value of certain data bases and other mechanical tools.[75] Other concerns have been raised concerning various other data base systems.[76]

The long term impact of the *Feist* decision on intellectual property is not possible to accurately predict at this time. However, the *Feist* decision does indicate a retreat from broad copyright protection to a standard that embraces the statutory "originality" requirement for compilations. The application of such a standard may have an impact on many industries in the United States which may be adverse to some, but beneficial to others.

CONCLUSION

The recent decision of the Supreme Court in the *Feist Publications* case has broad implications for the copyright protection of intellectual property. In determining whether the white pages of a telephone directory were subject to copyright protection, the Court examined the criteria for copyright protection for compilations of facts. In order to be protected by copyright, the Court determined that there must be a degree of originality present in the compilation. The Court dismissed the long held "sweat of the brow" or industrious collection theory which sometimes substituted the labors of the compiler for the requirement of originality. In applying the originality standard to the issue in question, the Court determined that the white pages of a telephone directory were not protected by copyright in that they were mere facts and did not possess any original selection, arrangement, or other original feature.

The implications of this decision may be far reaching for a variety of industries in the United States which are involved with compilations. A few such businesses would involve mailing lists, membership lists, and other types of lists of names and addresses. Other professions possibly impacted by the decision are various compilers/transcribers of historical research and family and genealogical research. Database producers and the software industry have shown great concern regarding the long-term implications of this decision on their products. Certain computer programs may be deemed to be compilations of facts without the requisite degree of originality for copyright protection. Without being subject to copyright protection, they may enter the public domain and hence be available for the use of all. Such impact may have several results. While those whose works are no longer subject to copyright protection may

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[75] NEW YORK TIMES, Mar. 28, 1991, at D6.

[76] WASHINGTON POST, Mar. 28, 1991, at B11-12.

experience injury, others persons who are able to use the works may benefit from the availability of the works. While the Supreme Court has provided guidelines for the copyright protection of factual compilations, future court decisions will probably provide the specific limits of copyright protection for certain compilations.

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