

Copyright for Compilations in the USA

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Keywords

arranged, arrangement, combined, compilation, compiled, coordinated, copyright, facts, preexisting, selected, selection

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Introduction

When one registers a copyright on a “literary work”¹ at the U.S. Copyright Office in the Library of Congress, the application form under “limitation of claim” in May 2013 requires the applicant to specify “new material included in copyright” from a list that contains:

text
editing
artwork
compilation
photographs
computer program
other: _____

In the previous years with applications on printed forms, the Copyright Office included “compilation of terms or data” as one of four choices for “type of authorship in this work” on Short Form TX.

The topic of this essay is what is legally protected in a “compilation”. The word “compilation” in copyright law is short for “compilation of facts” or “compilations of preexisting material”. Examples of compilation of facts are the white pages in a telephone book, or a book of mathematical tables and formulae. Examples of compilations of preexisting material is an anthology of poems, or a law casebook that is mostly quotations from judicial opinions.

My earlier essay on this subject, Copyright Protection for Nonfiction or Compilations of Facts in the USA, <http://www.rbs2.com/cfact.pdf> (Feb 2009), covered this topic from a different point of view, more concerned with the history of judges holding that facts were not copyrightable; the history of judicial protection of labor, skill, and expense of authors; and my criticism of the landmark U.S. Supreme Court case on this subject, *Feist*.

disclaimer

This essay presents general information about an interesting topic in law, but is *not* legal advice for your specific problem. See my disclaimer at <http://www.rbs2.com/disclaim.htm> . From reading e-mail sent to me by readers of my essays since 1998, I am aware that readers often use my essays as a source of free legal advice on their personal problem. Such use is *not* appropriate, for reasons given at <http://www.rbs2.com/advice.htm> .

¹ In copyright law, a “literary work” is anything that communicates with letters and numbers, and includes both fictional text, poetry, nonfiction text, and computer programs. Most books and periodicals are literary works. See 17 U.S.C. § 101.

I list the cases in chronological order in this essay, so the reader can easily follow the historical development of a national phenomenon. If I were writing a legal brief, then I would use the conventional citation order given in the *Bluebook*.

Overview

Copyright on compilations before 1978

Copyright protection of compilations (e.g., selection, arrangement, or combination of pre-existing material) has a long history:

- *Emerson v. Davies*, 8 F.Cas. 615, 619 (C.C.Mass. 1845) (Story, J.) (“In truth, every author of a book has a copy-right in the **plan, arrangement and combination**² of his materials, and in his mode of illustrating his subject, if it be new and original in its substance. He, who constructs by a new plan, and arrangement, and combination of old materials, in a book designed for instruction, either of the young, or the old, has a title to a copy-right,....”);
- *Story v. Holcombe*, 23 F.Cas. 171, 175 (C.C.Ohio 1847) (infringement of Judge Story’s COMMENTARIES ON EQUITY JURISPRUDENCE: “So far as citations are made in the COMMENTARIES, Mr. Holcombe had a right to go to the original works, and copy from them; but he could not avail himself of the labor of Judge Story, by copying the extracts as **compiled**³ by him.”);
- *Greene v. Bishop*, 10 F.Cas. 1128, 1134 (C.C.Mass. 1858) (“Speaking of the question under consideration, [Mr. Curtis, in his valuable work on COPYRIGHT,] says, in effect, that the author of a book, who takes existing materials from sources common to all writers, and **arranges and combines** them in a new form, and gives them an application unknown before, is protected in the exclusive enjoyment of what he has thus collected and produced, for the reason that he has exercised selection, arrangement, and combination, and thereby has produced something that is new and valuable. Curtis, COPYRIGHT pp. 179, 180; *Gray v. Russell* [Case No. 5,728]; *Emerson v. Davies* [Id. 4,436]; *Lewis v. Fullarton*, 2 Beav. 6; *Story v. Holcombe* [Case No. 13,497].”);
- *Lawrence v. Dana*, 15 F.Cas. 26, 61 (C.C.Mass. 1869) (“New materials are certainly the proper objects of copyright; and old materials, when subsequently **collected, arranged, and combined** in a new and original form, are equally so: and in either case, the plan, arrangement, and combination of the materials are as fully protected by the copyright as the materials embodied in the plan, arrangement, and combination.” At page 44: “The defence of ‘a fair use’ is not tenable in this case. The use made far exceeds anything which the law of copyright has ever been held to allow. As already shown, Dana did not merely use Lawrence's work as a storehouse of facts, but he reproduced Lawrence's **selection, combination, and arrangement.**”);

² Boldface by Standler in this and following quotations.

³ This is one of the earliest uses of the word “compiled” in the context of copyright. The earliest use of “compiled” seems to be *Blunt v. Patten*, 3 F.Cas. 763, 765 (C.C.S.D.N.Y. 1828).

- *Banks v. McDivitt*, 2 F.Cas. 759, 760 (C.C.N.Y. 1875) (“The rights and duties of compilers of books which are not original in their character, but are **compilations of facts**⁴ from common and universal sources of information, of which books, directories, maps, guide books, road books, statistical tables and digests are the most familiar examples, are well settled. No compiler of such a book has a monopoly of the subject of which the book treats. Any other person is permitted to enter that department of literature and make a similar book. But, the subsequent investigator must investigate for himself, from the original sources which are open to all. He cannot use the labors of a previous compiler, *animo furandi*, and save his own time by copying the results of the previous compiler's study, although the same results could have been attained by independent labor. The compiler of a digest, a road book, a directory, or a map can search and survey for himself in the fields which all laborers are permitted to occupy, but cannot adopt as his own the products of another's toil.”);
- *List Pub. Co. v. Keller*, 30 F. 772, 773 (S.D.N.Y. 1887) (“When the selection is made, each compiler must of necessity reproduce the same names and addresses, so far as the selections coincide, and must arrange them in alphabetical order. The law of copyright only requires the subsequent compiler to do for himself that which the first compiler has done.”). Quoted in *Jeweler's Circular Pub. Co. v. Keystone Pub. Co.*, 281 F. 83, 92 (2dCir. 1922).
- *Belford, Clarke & Co. v. Scribner*, 144 U.S. 488, 490 (1892) (Plaintiff alleged “material were selected and arranged with great care and labor”.);
- *American Trotting Register Association v. Gocher*, 70 F. 237, 237-238 (C.C.Ohio 1895) (“A mere **compilation of facts** is protected by the copyright law, as well as original matter showing invention. There are numerous cases which hold that any compilation or any table of statistics which are the result of the author's industry, and which are gathered at his expense, cannot be bodily used by an infringer. Although the same facts could be gathered by the infringer, he must do so at his own expense, and as the result of his own industry.”);
- *Edwards & Deutsch Lithographing Co. v. Boorman*, 15 F.2d 35, 36 (7thCir. 1926) (“The materials used are all old and in the public domain, but the **selection, the ordering and arrangement**, are new and useful, and copyrightable.”), *cert. denied*, 273 U.S. 738 (1926);
- *Universal Pictures Co. v. Harold Lloyd Corp.*, 162 F.2d 354, 363 (9thCir. 1947) (“... we find no evidence that they had ever previously appeared in like **combination, arrangement or form**. The originality was displayed in taking commonplace material and acts and making them into a new combination and novel arrangement which is protectable by copyright. [citing *Edwards & Deutsch Lithographing Co. v. Boorman*, 15 F.2d 35, 36 (7thCir. 1926)]”);
- *Gelles-Widmer Co. v. Milton Bradley Co.*, 313 F.2d 143, 147 (7thCir. 1963) (“What the District Court found to be infringed was the **selection, arrangements and combinations** contained in plaintiff's copyrighted sets. These were more than mere compilations.”), *cert. den.*, 373 U.S. 913 (1963);

⁴ Boldface by Standler. This appears to be the first use of “compilation of facts” in a judicial opinion involving copyright.

- *Schroeder v. William Morrow & Co.*, 566 F.2d 3, 5-6 (7thCir. 1977) (summarizing law under Copyright Act of 1909 and finding infringement in copying list of addresses);
- *U.S. v. Hamilton*, 583 F.2d 448, 451 (9thCir. 1978) (“When a work displays a significant element of compilation, that element is protectible [sic] even though the individual components of the work may not be, for originality may be found in taking the commonplace and making it into a new combination or arrangement. [citing four cases]”).

The Copyright Act of 1909 explicitly recognized that compilations were copyrightable:

The application for registration shall specify to which of the following classes the work in which copyright is claimed belongs:

- (a) Books, including composite and cyclopaedic works, directories, gazetteers, and other compilations;
- (b)

17 U.S.C. § 5 (enacted 1909, repealed 1976), quoted in *Mazer v. Stein*, 347 U.S. 201, 211, n.19 (1954).

The Copyright Act of 1909 explicitly stated that a compilation would *not* affect any copyright in the preexisting material:

That compilations or abridgements [sic], adaptations, arrangements, dramatizations, translations, or other versions of works in the public domain, or of copyrighted works when produced with the consent of the proprietor of the copyright in such works, or works republished with new matter, shall be regarded as new works subject to copyright under the provisions of this Act; but the publication of any such new works shall not affect the force or validity of any subsisting copyright upon the matter employed or any part thereof, or be construed to imply an exclusive right to such use of the original works, or to secure or extend copyright in such original works.

17 U.S.C. § 6 (enacted 1909, repealed effective 1978). Quoted from *West Pub. Co. v. Edward Thompson Co.*, 176 F. 833, 837 (2dCir. 1910). Sometime around the year 1940, the former §6 became §7, as a new section was inserted. See, e.g., *Markham v. A. E. Borden Co.*, 206 F.2d 199, 201, n.2 (1stCir. 1953) (quoting new 17 U.S.C. §7).

Copyright Act of 1976

The definition section of the Copyright Act of 1976 defines “compilation”:

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. The term “compilation” includes collective works.

17 U.S.C § 101 (current May 2013).

My search of all federal cases in Westlaw for the query

(select! /s coordinat! /s arrang!) /p compil!

shows that the first case to use these three words was in a quotation from § 101. *Quinto v. Legal Times of Washington, Inc.*, 506 F.Supp. 554, 559 (D.D.C. 1981). The Copyright Act of 1976

created new law by including “coordinated”,⁵ instead of codifying prior judicial decisions that used either “selected”, “arranged” or “combined”.

The Copyright Act of 1976 made explicit that copyright on a compilation covers only expression — including selection, coordination, or arrangement of preexisting material — that was contributed by the author.

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.

17 U.S.C. § 103(b) (current May 2013).

Judicial decisions under 1976 Act

As is well known to lawyers specializing in copyright, the U.S. Supreme Court destroyed much of previously existing legal protection for compilations of facts in *Feist Publications, Inc. v. Rural Telephone Service Co.*, 499 U.S. 340 (1991). My previous essay on this subject, Copyright Protection for Nonfiction or Compilations of Facts in the USA, <http://www.rbs2.com/cfact.pdf> (Feb 2009), traces the history of the common law rule that copyright does *not* protect facts; traces the history of the tort of misappropriation of “labor, skill, and expense” of authors; and criticizes the Supreme Court’s opinion in *Feist*.

If facts are not copyrightable, then collecting a large number of facts is also not copyrightable. So what exactly does “compilation of facts” protect? The pre-*Feist* case law says that compilations protect the labor, skill, and expense of authors in collecting, selecting, arranging, or combining facts. After *Feist*, compilations seem to protect the creative expression of an author in presenting facts.

Prior to *Feist* there were two kinds of torts that could be used to compensate a copyright owner for copying: (1) copyright infringement made copying/paraphrasing of expression unlawful, and (2) the tort of unfair competition for misappropriation protected the author’s “labor, skill, and expense” in producing a compilation of facts. Copyright infringement is mainstream copyright law. The tort of unfair competition comes from landmark judicial decisions in *International News Service v. Associated Press*, 248 U.S. 215 (1918) and *Jeweler’s Circular Publishing Co. v. Keystone Publishing Co.*, 281 Fed. 83 (2dCir. 1922), *cert. denied*, 259 U.S. 581 (1922), although one can find earlier cases.

⁵ My search of all federal cases in Westlaw for the query
(coordinat!) /p (compil! copyright) & da(bef 1980)
shows the stem “coordinat” was *not* used in copyright cases before the Copyright Act of 1976. I wonder if someone in Congress confused “combined” (which *was* used by judges in compilation cases) with “coordinated”.

However, the continuing viability of *International News* has been severely limited by *National Basketball Ass'n v. Motorola, Inc.*, 105 F.3d 841, 845 (2dCir. 1997). And *Jeweler's Circular* was explicitly overruled by the Supreme Court in *Feist Publications, Inc. v. Rural Telephone Service Co.*, 499 U.S. 340, 352-353 (1991).

Feist

The definition section of the Copyright Act of 1976 defines “compilation”:

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. The term “compilation” includes collective works.

17 U.S.C § 101 (current May 2013).

In *Feist*, 499 U.S. 340, the U.S. Supreme Court explained this statutory definition:

The purpose of the statutory definition is to emphasize that collections of facts are not copyrightable *per se*. It conveys this message through its tripartite structure, as emphasized above by the italics. The statute identifies three distinct elements and requires each to be met for a work to qualify as a copyrightable compilation:

- (1) the collection and assembly of pre-existing material, facts, or data;
- (2) the selection, coordination, or arrangement of those materials; and
- (3) the creation, by virtue of the particular selection, coordination, or arrangement, of an “original” work of authorship.

....

At first glance, the first requirement does not seem to tell us much. It merely describes what one normally thinks of as a compilation—a collection of pre-existing material, facts, or data. What makes it significant is that it is not the sole requirement. It is not enough for copyright purposes that an author collects and assembles facts. To satisfy the statutory definition, the work must get over two additional hurdles. In this way, the plain language indicates that not every collection of facts receives copyright protection. Otherwise, there would be a period after “data.”

The third requirement is also illuminating. It emphasizes that a compilation, like any other work, is copyrightable only if it satisfies the originality requirement (“an original work of authorship”). Although § 102 states plainly that the originality requirement applies to all works, the point was emphasized with regard to compilations to ensure that courts would not repeat the mistake of the “sweat of the brow” courts by concluding that fact-based works are treated differently and measured by some other standard. As Congress explained it, the goal was to “make plain that the criteria of copyrightable subject matter stated in section 102 apply with full force to works ... containing preexisting material.” H.R.Rep., at 57; S.Rep., at 55, U.S.CODE CONG. & ADMIN.NEWS 1976, p. 5670.

The key to the statutory definition is the second requirement. It instructs courts that, in determining whether a fact-based work is an original work of authorship, they should focus on the manner in which the collected facts have been selected, coordinated, and arranged. This is a straightforward application of the originality requirement. Facts are never original, so the compilation author can claim originality, if at all, only in the way the facts are presented. To

that end, the statute dictates that the principal focus should be on whether the selection, coordination, and arrangement are sufficiently original to merit protection.⁶

Not every selection, coordination, or arrangement will pass muster. This is plain from the statute. It states that, to merit protection, the facts must be selected, coordinated, or arranged “in such a way” as to render the work as a whole original. This implies that some “ways” will trigger copyright, but that others will not. See Patry [Copyright in Compilations of Facts (or Why the “White Pages” Are Not Copyrightable), 12 *COMMERCE & LAW* 37 (Dec. 1990) at page] 57, and n. 76.

Feist, 499 U.S. at 357-358.

originality requirement

The Supreme Court discussed the originality requirement in several paragraphs in the opinion:

The key to resolving the tension lies in understanding why facts are not copyrightable. The sine qua non of copyright is originality. To qualify for copyright protection, a work must be original to the author. See *Harper & Row*, [471 U.S. 539] at 547-549, 105 S.Ct., at 2223-2224 [(1985)]. Original, as the term is used in copyright, means only that the work was independently created by the author (as opposed to copied from other works), and that it possesses at least some minimal degree of creativity. 1 M. Nimmer & D. Nimmer, *COPYRIGHT* §§ 2.01[A], [B] (1990) (hereinafter Nimmer). To be sure, the requisite level of creativity is extremely low; even a slight amount will suffice. The vast majority of works make the grade quite easily, as they possess some creative spark, “no matter how crude, humble or obvious” it might be. *Id.*, § 1.08 [C] [1]. Originality does not signify novelty; a work may be original even though it closely resembles other works so long as the similarity is fortuitous, not the result of copying. To illustrate, assume that two poets, each ignorant of the other, compose identical poems. Neither work is novel, yet both are original and, hence, copyrightable. See *Sheldon v. Metro-Goldwyn Pictures Corp.*, 81 F.2d 49, 54 (CA2 1936).

Feist, 499 U.S. at 345-346.

As discussed earlier, however, the originality requirement is not particularly stringent. A compiler may settle upon a selection or arrangement that others have used; novelty is not required. Originality requires only that the author make the selection or arrangement independently (i.e., without copying that selection or arrangement from another work), and that it display some minimal level of creativity. Presumably, the vast majority of compilations will pass this test, but not all will. There remains a narrow category of works in which the creative spark is utterly lacking or so trivial as to be virtually nonexistent.

Feist, 499 U.S. at 358-359.

In summary, the 1976 revisions to the Copyright Act leave no doubt that originality, not “sweat of the brow,” is the touchstone of copyright protection in directories and other fact-based works. Nor is there any doubt that the same was true under the 1909 Act. The 1976 revisions were a direct response to the Copyright Office’s concern that many lower courts had misconstrued this basic principle, and Congress emphasized repeatedly that the purpose of the revisions was to clarify, not change, existing law. The revisions explain with painstaking

⁶ Note by Standler: This sentence about “principal focus” was quoted and applied in *Universal Furniture Intern., Inc. v. Collezione Europa USA, Inc.*, 618 F.3d 417, 430 (4th Cir. 2010).

clarity that copyright requires originality, § 102(a); that facts are never original,⁷ § 102(b); that the copyright in a compilation does not extend to the facts it contains, § 103(b); and that a compilation is copyrightable only to the extent that it features an original selection, coordination, or arrangement, § 101.

Feist, 499 U.S. at 359-360.

The consequence of the statutory requirement of originality is that copyright protection for compilations of facts is “thin”.

.... The same is true of all facts — scientific, historical, biographical, and news of the day. “[T]hey may not be copyrighted and are part of the public domain available to every person.” *Miller [v. Universal City Studios, Inc.]*, 650 F.2d 1365 (5th Cir. 1981) at 1369.

Factual compilations, on the other hand, may possess the requisite originality. 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 laws. [Melville and David] Nimmer [COPYRIGHT (1990)] §§ 2.11[D], 3.03; Denicola [Copyright in Collections of Facts: A Theory for the Protection of Nonfiction Literary Works, 81 COLUM.L.REV. 516 (1981) at page] 523, n. 38. Thus, even a directory that contains absolutely no protectible written expression, only facts, meets the constitutional minimum for copyright protection if it features an original selection or arrangement. See *Harper & Row*, 471 U.S. [539] at 547, 105 S.Ct., at 2223 [(1985)]. Accord, Nimmer § 3.03.

This protection is subject to an important limitation. The mere fact that a work is copyrighted does not mean that every element of the work may be protected. Originality remains the *sine qua non* of copyright; accordingly, copyright protection may extend only to those components of a work that are original to the author. Patterson & Joyce, [Monopolizing the Law, 36 UCLA Law Review 719 (1989) at pages] 800-802; Ginsburg, Creation and Commercial Value: Copyright Protection of Works of Information, 90 COLUM.L.REV. 1865, 1868, and n. 12 (1990) (hereinafter Ginsburg). Thus, if the compilation author clothes facts with an original collocation of words, he or she may be able to claim a copyright in this written expression. Others may copy the underlying facts from the publication, but not the precise words used to present them. In *Harper & Row*, for example, we explained that President Ford could not prevent others from copying bare historical facts from his autobiography, see 471 U.S., at 556-557, 105 S.Ct., at 2228-2229, but that he could prevent others from copying his “subjective descriptions and portraits of public figures.” *Id.*, at 563, 105 S.Ct., at 2232. Where the compilation author adds no written expression but rather lets the facts speak for themselves, the expressive element is more elusive. The only conceivable expression is the manner in which the compiler has selected and arranged the facts. Thus, if the selection and arrangement are original, these elements of the work are eligible for copyright protection. See Patry, Copyright in Compilations of Facts (or Why the “White Pages” Are Not Copyrightable), 12 COM. & LAW 37, 64 (Dec. 1990) (hereinafter Patry). No matter how original the format, however, the facts themselves do not become original through association. See Patterson & Joyce 776.

⁷ Note by Standler: The noncopyrightability of facts is federal common law. Note that 17 U.S.C. § 102(b) does *not* mention “facts”.

This inevitably means that the copyright in a factual compilation is thin.⁸

Notwithstanding a valid copyright, a subsequent compiler remains free to use the facts contained in another's publication to aid in preparing a competing work, so long as the competing work does not feature the same selection and arrangement. As one commentator explains it: "[N]o matter how much original authorship the work displays, the facts and ideas it exposes are free for the taking.... [T]he very same facts and ideas may be divorced from the context imposed by the author, and restated or reshuffled by second comers, even if the author was the first to discover the facts or to propose the ideas." Ginsburg [Creation and Commercial Value: Copyright Protection of Works of Information, 90 COLUMBIA LAW REVIEW 1865 (1990) at page] 1868.

Feist, 499 U.S. at 348-349. Whenever I read that "copyright on a factual compilation is thin", I recall the joke amongst scientists that a fast-food chain's hamburgers are so thin, they only have one side.

holdings in *Feist*

Feist went wrong in failing to distinguish two separate torts: (1) copyright infringement makes copying/paraphrasing of expression unlawful, and (2) the tort of unfair competition for misappropriation protects the author's "labor, skill, and expense" in producing a compilation of facts. Instead of recognizing two valid torts, *Feist* viewed the tort of unfair competition (which *Feist* calls "sweat of the brow" cases) as forbidden by copyright law.

Having driven off the road, *Feist* fails to stop, but instead lurches towards the cliff of death for compilations. *Feist* rejects copyright on the white pages of a telephone book because the names were listed in alphabetical order. According to *Feist*, alphabetical order displays no originality, and originality is the *sine qua non* of copyright. *Feist*, 499 U.S. at 362 ("... the selection and arrangement of facts cannot be so mechanical or routine as to require no creativity whatsoever.").

Feist characterized the alphabetical arrangement of names in the white pages of a telephone book as "obvious".⁹ *Feist*, 499 U.S. at 362. However, *Feist* fails to explain why the Constitutional requirement of promoting Progress of knowledge¹⁰ requires a nonobvious arrangement of facts. As I said in an earlier essay,

Would the Progress of knowledge be better promoted if Rural had arranged its telephone listings in a *nonroutine*, *nonobvious*, *unexpected* way? For example, arranged alphabetically by the third letter in the subscriber's first name — that would be *really* creative and completely novel! This sarcastic suggestion shows that the Court's criteria for protection of

⁸ Boldface by Standler.

⁹ The Court in *Feist* makes the horrible error of importing one of the standards from patent law — that to obtain protection, an invention must be nonobvious. 35 U.S.C. § 103(a). See, e.g., Jane C. Ginsburg, "No 'Sweat'? Copyright and Other Protection of Works of Information After *Feist v. Rural Telephone*," 92 COLUMBIA LAW REVIEW 338, 343-344, 348 (March 1992).

¹⁰ U.S. Constitution, Article I, § 8, clause 8 (written in Sep 1787).

compilations of facts are nonsense. There is nothing wrong with arranging facts in an expected, conventional way that is easy to use. And an author should not sacrifice copyright protection by arranging information in an expected, conventional way.

Standler, Copyright Protection for Nonfiction or Compilations of Facts in the USA, <http://www.rbs2.com/cfact.pdf> (Feb 2009).

It is difficult to believe that the U.S. Supreme Court held “obvious” ways of organizing facts — e.g., alphabetically, chronologically, numerically¹¹ — are *uncreative*, and therefore *not* original works of authorship that qualify for copyright protection. That holding was the kiss of death for copyright on the white pages in telephone books and more than the Court could imagine. Furthermore, note that the obvious ways to arrange facts will often be the easiest to understand and the most useful ways — so *Feist* killed copyright for the best ways to arrange facts, which definitely does not promote the Progress of knowledge.

What survives after *Feist* is copyright on selection of the “best” short stories, songs, photographs, etc. according to the creative criteria of some editor(s). But a compilation of *all* of the poems of a particular author is *not* copyrightable, as explained in *Silverstein*, 368 F.3d at 85 (“... all is not a selection.”), which is discussed at page 18, below. Databases of public-domain material (e.g., statutes, judicial opinions, government regulations) are also *not* protected by copyright, as explained in the *West* cases, which are discussed at page 16, below.

The full text of this horrible conclusion to *Feist*:

The question that remains is whether Rural selected, coordinated, or arranged these uncopyrightable facts in an original way. As mentioned, originality is not a stringent standard; it does not require that facts be presented in an innovative or surprising way. It is equally true, however, that **the selection and arrangement of facts cannot be so mechanical or routine as to require no creativity whatsoever.**¹² The standard of originality is low, but it does exist. See *Patterson & Joyce* 760, n. 144 (“While this requirement is sometimes characterized as modest, or a low threshold, it is not without effect”) (internal quotation marks omitted; citations omitted). As this Court has explained, the Constitution mandates some minimal degree of creativity, see *The Trade-Mark Cases*, 100 U.S., at 94; and an author who claims infringement must prove “the existence of ... intellectual production, of thought, and conception.” *Burrow-Giles*, *supra*, 111 U.S., at 59-60, 4 S.Ct., at 281-282.

The selection, coordination, and arrangement of Rural's white pages do not satisfy the minimum constitutional standards for copyright protection. As mentioned at the outset, Rural's white pages are entirely typical. Persons desiring telephone service in Rural's service area fill out an application and Rural issues them a telephone number. In preparing its white pages, Rural simply takes the data provided by its subscribers and lists it alphabetically by surname. The end product is a garden-variety white pages directory, devoid of even the slightest trace of creativity.

¹¹ See, e.g., *Key Publications, Inc. v. Chinatown Today Publishing Enters., Inc.*, 945 F.2d 509, 513-514 (2dCir. 1991); *Assessment Technologies of WI, LLC v. WIREdata, Inc.*, 350 F.3d 640, 643 (7thCir. 2003) (Posner, J.), which are quoted later in this essay.

¹² All boldface in this quotation was inserted by Standler.

Rural's selection of listings could not be more obvious: It publishes the most basic information-name, town, and telephone number-about each person who applies to it for telephone service. This is “selection” of a sort, but **it lacks the modicum of creativity necessary to transform mere selection into copyrightable expression.** Rural expended sufficient effort to make the white pages directory useful, but insufficient creativity to make it original.

....

Nor can Rural claim originality in its coordination and arrangement of facts. The white pages do nothing more than list Rural's subscribers in alphabetical order. This arrangement may, technically speaking, owe its origin to Rural; no one disputes that Rural undertook the task of alphabetizing the names itself. **But there is nothing remotely creative about arranging names alphabetically** in a white pages directory. It is an age-old practice, firmly rooted in tradition and so commonplace that it has come to be expected as a matter of course. See Brief for Information Industry Association et al. as Amici Curiae 10 (alphabetical arrangement “is universally observed in directories published by local exchange telephone companies”). **It is not only unoriginal, it is practically inevitable.** This time-honored tradition does not possess the minimal creative spark required by the Copyright Act and the Constitution.

Feist, 499 U.S. at 362-363

Strangely, the requirement of a nonobvious and creative organization is *not* consistent with what was said at two places earlier in *Feist*. In a paragraph that seems principally concerned with copyright on text (*not* compilations), the U.S. Supreme Court wrote in *Feist* that the “vast majority of works” would be copyrightable:

To be sure, the requisite level of creativity is extremely low; even a slight amount will suffice. The vast majority of works make the grade quite easily, as they possess some creative spark, “no matter how crude, humble or obvious” it might be. [M. Nimmer & D. Nimmer, COPYRIGHT] § 1.08 [C] [1].

Feist, 499 U.S. at 345. About 13 pages later, the Court says that the “vast majority of compilations” will be copyrightable.

As discussed earlier, however, the originality requirement is not particularly stringent. A compiler may settle upon a selection or arrangement that others have used; novelty is not required. Originality requires only that the author make the selection or arrangement independently (i.e., without copying that selection or arrangement from another work), and that it display some minimal level of creativity. **Presumably, the vast majority of compilations will pass this test, but not all will.**¹³ There remains a narrow category of works in which the creative spark is utterly lacking or so trivial as to be virtually nonexistent. See generally *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251, 23 S.Ct. 298, 300, 47 L.Ed. 460 (1903) (referring to “the narrowest and most obvious limits”). Such works are incapable of sustaining a valid copyright. Nimmer [COPYRIGHT] § 2.01[B]. *Feist*, 499 U.S. at 358-359. It is difficult to reconcile rejecting copyright on obvious ways of arranging facts, while allowing copyright on the “vast majority of compilations”.

¹³ Boldface added by Standler.

Cases since *Feist*

I list below some of the major cases in the U.S. Court of Appeals since *Feist* that involve copyright on compilations.

- *Key Publications, Inc. v. Chinatown Today Publishing Enters., Inc.*, 945 F.2d 509, 513-514 (2dCir. 1991) (“In addition, the arrangement of [Plaintiff’s directory] is original within the meaning of the copyright laws. Arrangement ‘refers to the ordering or grouping of data into lists or categories that go beyond the mere mechanical grouping of data as such, for example, the alphabetical, chronological, or sequential listings of data.’ Copyright Office, Guidelines for Registration of Fact-Based Compilations 1 (Rev. Oct. 11, 1989), quoted in Patry, [Copyright in Compilations of Facts (or Why the “White Pages” are not Copyrightable), 12 COMM. & L. (Dec. 1990)] at 60.”).
- *Key Publications, Inc. v. Chinatown Today Publishing Enters., Inc.*, 945 F.2d 509, 514 (2dCir. 1991) (“While, as the Court pointed out in *Feist*, the ‘copyright in a factual compilation is thin,’ 111 S.Ct. at 1289, we do not believe it is anorexic.”). Quoted with approval in *Matthew Bender & Co., Inc. v. West Pub. Co.*, 158 F.3d 674, 688 (2dCir. 1998). My reading of cases leads me to the conclusion that “thin but not anorexic” is a slogan, *not* a statement of law.
- *Mason v. Montgomery Data, Inc.*, 967 F.2d 135, 142 (5thCir. 1992) (“Historically, most courts have treated maps solely as compilations of facts. See Wolf, [Is There any Copyright Protection for Maps after Feist ?, 39 J. COPYRIGHT SOCIETY OF THE USA 224, 226 (1992).] note 4, at 227. The Copyright Act, however, categorizes maps not as factual compilations but as ‘pictorial, graphic, and sculptural works’ — a category that includes photographs and architectural plans. 17 U.S.C. § 101”).
- *Arica Institute, Inc. v. Palmer*, 970 F.2d 1067, 1075 (2dCir. 1992) (“Our decision in *Hoehling v. Universal City Studios, Inc.*, 618 F.2d 972, 978 (1980), in which we quoted Judge Learned Hand’s statement that ‘[t]here cannot be any such thing as copyright in the order of presentation of the facts, nor, indeed, in their selection,’ is not to the contrary. Both *Hoehling* and the case it quotes, *Myers v. Mail & Express Co.*, 36 C.O.Bull. 478, 479 (S.D.N.Y. 1919), dealt with historical works containing chronological narrations of events. Since ‘the narration of history must proceed chronologically,’ *id.*, this ordering is inevitable and thus is devoid of creativity. See *Feist*, 499 U.S. at [363], 111 S.Ct. at 1297. In such circumstances[,] sequence is non-copyrightable,”).
- *BellSouth Advertising & Pub. Corp. v. Donnelley Information Pub., Inc.*, 999 F.2d 1436, 1441 (11thCir. 1993) (“The protection of copyright must inhere in a creatively original *selection* of facts to be reported and not in the creative means used to discover those facts.”).

In 1983, Kregos developed a form for compiling nine statistics on each pitcher scheduled for each day's baseball games. Kregos registered the copyright on his form. In 1989, Kregos sued the Associated Press for infringing his form. *Kregos v. Associated Press*, 731 F.Supp. 113, 114-116 (S.D.N.Y. 1990), *rev'd*, 937 F.2d 700, 702-703 (2dCir. 1991). The U.S. Court of Appeals held that the nine specified statistics showed enough selection of facts to compile to be an original work of authorship, which was protected by copyright. 937 F.2d at 704-705. The trial court then held that plaintiff's and defendant's forms were not substantially similar, so there was no infringement. *Kregos v. Associated Press*, 795 F.Supp. 1325, 1332-34 (S.D.N.Y. 1992), *aff'd*, 3 F.3d 656, 662-664 (2dCir. 1993), *cert. den.*, 510 U.S. 1112 (1994).

In 1988, the National Rifle Association compiled a three-page list of "information concerning members of the Ohio General Assembly, listing each member by name, district, home town and telephone number." The NRA alleged that Handgun Control Federation of Ohio, which "engages in lobbying activities to enact laws to restrict possession, ownership and transfer of firearms", copied the list. After citing *Feist*, the trial judge held that the NRA's list was not copyrightable because "that plaintiff's selection and arrangement of the Ohio Representatives [was] mechanical and routine." *National Rifle Ass'n v. Handgun Control Federation of Ohio*, 844 F.Supp. 1178, 1180 (N.D. Ohio 1992), *aff'd*, 15 F.3d 559 (6thCir. 1994) (ignoring copyrightability, holding fair use), *cert. den.*, 513 U.S. 815 (1994).

In 1995, the U.S. Court of Appeals for the Second Circuit reiterated what they said in *Key Publications* in 1991:

We have held that while "mechanical" arrangements, such as alphabetical or chronological order, do not display the requisite originality, any minimal level of creativity is sufficient to render an arrangement protectible. *Key [Publications v. Chinatown Today]*, 945 F.2d at 513-514 [(2dCir. 1991)] (finding arrangement of businesses in directory to be protectible where "[t]he arrangement is in no sense mechanical" and "entailed the de minimis thought needed to withstand the originality requirement"); cf. *Feist*, 499 U.S. at 363, 111 S.Ct. at 1296-97 (no copyright protection where names arranged alphabetically in white pages directory; "[t]he selection and arrangement of facts cannot be so mechanical or routine as to require no creativity whatsoever.").

Lipton v. Nature Co., 71 F.3d 464, 470 (2dCir. 1995).

In 1996, the U.S. Court of Appeals for the Seventh Circuit wrote in a copyright infringement case involving two competing cookbooks:

The creative energies that an author may independently devote to the arrangement or compilation of facts may warrant copyright protection for that particular compilation. See *Feist*, 499 U.S. at 348, 111 S.Ct. at 1289; *Harper & Row*, 471 U.S. at 547, 105 S.Ct. at 2224 (citing *Schroeder v. William Morrow & Co.*, 566 F.2d 3, 5 (7thCir. 1977)). This also extends to the compilation of preexisting materials that is the work product of others. See *West Publishing Co. v. Mead Data Central, Inc.*, 799 F.2d 1219, 1223-24 (8thCir. 1986), *cert. denied*, 479 U.S. 1070, 107 S.Ct. 962, 93 L.Ed.2d 1010 (1987). There is no dilution of the originality requirement, for a compilation's originality flows from the efforts of

“industrious collection” by its author. *Schroeder*, 566 F.2d at 5 (citing *Jeweler’s Circular Publishing Co. v. Keystone Publishing Co.*, 281 F. 83, 87-88 (2dCir.), *cert. denied*, 259 U.S. 581, 42 S.Ct. 464, 66 L.Ed. 1074 (1922)).

The recipes involved in this case comprise the lists of required ingredients and the directions for combining them to achieve the final products. The recipes contain no expressive elaboration upon either of these functional components, as opposed to recipes that might spice up functional directives by weaving in creative narrative. We do not express any opinion whether recipes are or are not per se amenable to copyright protection, for it would be inappropriate to do so. The prerequisites for copyright protection necessitate case-specific inquiries, and the doctrine is not suited to broadly generalized prescriptive rules.

The identification of ingredients necessary for the preparation of each dish is a statement of facts. There is no expressive element in each listing; in other words, the author who wrote down the ingredients for “Curried Turkey and Peanut Salad” was not giving literary expression to his individual creative labors. Instead, he was writing down an idea, namely, the ingredients necessary to the preparation of a particular dish. “[N]o author may copyright facts or ideas. The copyright is limited to those aspects of the work—termed ‘expression’—that display the stamp of the author’s originality.” *Harper & Row*, 471 U.S. at 547, 105 S.Ct. at 2223. We do not view the functional listing of ingredients as original within the meaning of the Copyright Act.

Publications Intern., Ltd. v. Meredith Corp., 88 F.3d 473, 480 (7thCir. 1996). The first paragraph of this quotation contains an embarrassing number of pieces of no longer good law. The phrase “creative energies” in the first sentence sounds remarkably similar to “sweat of the brow” that was wiped away in *Feist*, 499 U.S. at 352-354. See also “... copyright rewards originality, not effort.” *Feist*, 499 U.S. at 364. *West Publishing* is probably no longer good law after *Feist*, as explained in *Matthew Bender & Co., Inc. v. West Pub. Co.*, 158 F.3d 693, 708 (2dCir. 1998). And *Jeweler’s Circular* was explicitly overruled in *Feist*, 499 U.S. at 352, 359-360. With such bad legal research, the first paragraph in the above quotation is not believable.

- *Nihon Keizai Shimbun, Inc. v. Comline Business Data, Inc.*, 166 F.3d 65, 70 (2dCir. 1999) (“Compilations of facts, however, may be protected by copyright because they can display originality in their selection, arrangement or presentation of facts. See [*Feist*, 499 U.S.] at 348. Descriptions of facts afford even more room for originality.”).
- *Alcatel USA, Inc. v. DGI Technologies, Inc.*, 166 F.3d 772, 786 (5thCir. 1999) (“A compilation of facts is not entitled to copyright protection unless the compilation itself possesses some degree of originality. [footnote cites *Feist*, 499 U.S. at 348.]”).

In 2002, the Second Circuit discussed the history of copyright protection of maps. Before 1980, a mapmaker was required to do his own research, instead of copy facts from preexisting maps. After 1980 — and certainly after *Feist* in 1991 — facts were in the public domain and could be legally copied. *Sparaco v. Lawler, Matusky, Skelly, Engineers LLP*, 303 F.3d 460, 466-467 (2dCir. 2002) (Leval, J.).

In 2003, Judge Posner of the U.S. Court of Appeals in Chicago wrote Plaintiff's computer program was copyrightable because:

... this structure is not so obvious or inevitable as to lack the minimal originality required, *Key Publications, Inc. v. Chinatown Today Publishing Enterprises, Inc.*, 945 F.2d 509, 513-14 (2dCir. 1991), as it would if the compilation program simply listed data in alphabetical or numerical order. *Feist Publications, Inc. v. Rural Telephone Service Co.*, supra, 499 U.S. at 362-64. The obvious orderings, the lexical and the numeric, have long been in the public domain, and what is in the public domain cannot be appropriated by claiming copyright. Alternatively, if there is only one way in which to express an idea—for example, alphabetical order for the names in a phone book—then form and idea merge, and in that case since an idea cannot be copyrighted the copying of the form is not an infringement. *Ets-Hokin v. Skyy Spirits, Inc.*, 225 F.3d 1068, 1082 (9thCir. 2000); *Kregos v. Associated Press*, 937 F.2d 700, 705-07 (2dCir. 1991). That is not the situation here.

Assessment Technologies of WI, LLC v. WIREdata, Inc., 350 F.3d 640, 643 (7thCir. 2003) (Posner, J.).

In a 2005 case in Kentucky, defendant published a catalog containing hand-drawn sketches from photographs in a competitor's catalog. The court held that diagrams of automobile transmissions were not copyrightable material. *ATC Distribution Group, Inc. v. Whatever It Takes Transmissions & Parts, Inc.*, 402 F.3d 700, 712-713 (6thCir. 2005).

West Publishing Co.

West Publishing Co. is the major publisher of statutes and judicial opinions in the USA. Since the 1980s, West has spent enormous amounts of money in converting more than 18 million pages of printed books to computer-searchable full text, called Westlaw. The question for West — and other owners of databases — is how to protect their labor, skill, and expense in creating their database from copying by competitors.

There can be no copyright on statutes, judicial opinions, and government regulations, because this text is public domain material, as explained in my essay, No Copyright for Law in the USA, <http://www.rbs2.com/cgovt.pdf> (Jan 2009). That essay also discusses the litigation involving Westlaw and comments on the holdings of the cases.

Because the text of judicial opinions is public domain (i.e., the text is *not* copyrightable), a publisher of judicial opinions can only assert copyright as a compilation. *Bender v. West*, 158 F.3d 674, 679 (2dCir. 1998); *Bender v. West*, 158 F.3d 693, 698 (2dCir. 1998).

In 1986, the U.S. Court of Appeals in Minnesota held that the pagination of West's printed volumes was protected by copyright. *West Pub. Co. v. Mead Data Cent., Inc.*, 616 F.Supp. 1571 (D.Minn. 1985), *aff'd*, 799 F.2d 1219 (8thCir. 1986), *cert. den.*, 479 U.S. 1070 (1987). In the short term, this judicial opinion resulted in many courts introducing public-domain citations, which used paragraph numbers instead of West's page numbers.

The U.S. Supreme Court decision in *Feist* probably invalidated the 1986 victory for West for two reasons: (1) pagination is an uncreative, obvious process that is now automatically determined by computer software and (2) there is no longer any legal protection for labor, skill, and expense of authors and publishers after *Feist* extinguished the "sweat of the brow" cases.

The U.S. Court of Appeals in New York City wrote in 1998:

At bottom, *West Publishing Co. [v. Mead Data Central]*, 616 F.Supp. 1571 (D.Minn. 1985), *aff'd*, 799 F.2d 1219 (8thCir. 1986), *cert. den.*, 479 U.S. 1070 (1987)] rests upon the now defunct "sweat of the brow" doctrine. That court found that LEXIS had infringed West's copyright simply because it supplanted much of the need for West's case reporters through wholesale appropriation of West's page numbers. In reaching this conclusion, the court (i) noted that LEXIS's appropriation would deprive West of a large part of what it "[had] spent so much labor and industry in compiling," *West Publ'g Co.*, 799 F.2d at 1227, and (ii) cited *Hutchinson Telephone v. Fronteer Directory Co.*, 770 F.2d 128 (8thCir. 1985), see *West Publ'g Co.*, 799 F.2d at 1228, which in turn relied on *Leon v. Pacific Telephone & Telegraph Co.*, 91 F.2d 484 (9thCir. 1937), and *Jeweler's Circular Pub Co v. Keystone Pub Co*, 281 F. 83 (C.C.A.Cir. 1922) — classic "sweat of the brow" cases that were overruled in *Feist*. Thus, the Eighth Circuit in *West Publishing Co.* erroneously protected West's industrious collection rather than its original creation. Because *Feist* undermines the reasoning of *West Publishing Co.*, see *United States v. Thomson Corp.*, 949 F.Supp. 907, 926 (D.D.C. 1996), we decline to follow it.

Matthew Bender & Co., Inc. v. West Pub. Co., 158 F.3d 693, 708 (2dCir. 1998), *cert. den.*, 526 U.S. 1154 (1999).

West has prepared a synopsis and key notes of each holding in published judicial opinions, but such material is probably not copyrightable, because it is a paraphrase of the preexisting public-domain text of the opinion, and because any competent attorney would identify (i.e., select) the same holdings. West has checked the citations and added parallel citations, but that is a mechanical, uncreative process that is *not* copyrightable. *Bender v. West*, 158 F.3d 674, 685-688 (2dCir. 1998). West has added names of attorneys who argued the case, but those names are facts that are uncopyrightable and the selection process is *uncreative*. *Bender v. West*, 158 F.3d 674, 684 (2dCir. 1998). The U.S. Court of Appeals in New York City — after *Feist* — also held that pagination was not copyrightable. *Bender v. West*, 158 F.3d 693, 699, 706-708 (2dCir. 1998).

The U.S. Court of Appeals in New York City wrote in 1998:

West's editorial work entails considerable scholarly labor and care, and is of distinct usefulness to legal practitioners. Unfortunately for West, however, creativity in the task of creating a useful case report can only proceed in a narrow groove. Doubtless, that is because for West or any other editor of judicial opinions for legal research, faithfulness to the public-domain original is the dominant editorial value, so that the creative is the enemy of the true. *Matthew Bender & Co., Inc. v. West Pub. Co.*, 158 F.3d 674, 688 (2dCir. 1998), *cert den. sub nom. West Pub. Co. v. HyperLaw, Inc.*, 526 U.S. 1154 (1999). "The creative is the enemy of the true" is the essence of the problem with copyrighting nonfiction compilations.

The *West Publishing* cases in the Second Circuit in 1998 should serve two purposes. First, that long-recognized copyright on compilations was critical for protecting computer databases, a new technology. Second, to remind us that the U.S. Supreme Court in *Feist* had removed most of the legal protection from copyright on compilations of facts.

So the question for West — and for authors and publishers of other databases — is how to protect compilations of public-domain text, or compilations of facts, from copying by competitors? The easiest answer would be to overrule *Feist* and resume protecting the labor, skill, and expense of authors and publishers under "sweat of the brow" torts.

Silverstein, (2dCir 2004, SDNY 2007)

In 1993-94, Silverstein spent "more than a year combing back issues of periodicals, including *Vanity Fair*, *The New Yorker*, and *Life*, Silverstein identified 122 uncollected poems" by Dorothy Parker that had never been published in book format. *Silverstein v. Penguin Putnam, Inc.*, 368 F.3d 77, 79 (2dCir. 2004), *cert. den.*, 543 U.S. 1039 (2004).

Silverstein offered his collection to Penguin in 1994, but Penguin wanted to combine Silverstein's collection with Parker's poems that had been previously published in book format. Silverstein declined and his collection was published in 1996 by Scribner under the title *Not Much Fun*. In 1999, Penguin published a complete version of all of Parker's poems under the title *Complete Poems*. The Penguin edition included the 122 collected by Silverstein, but without asking Silverstein for his permission.¹⁴

¹⁴ *Silverstein v. Penguin Putnam, Inc.*, 522 F.Supp.2d 579, 598 (S.D.N.Y. 2007) ("Penguin claims to have never asked permission from Silverstein to publish the poems from *Not Much Fun* in *Complete Poems* because everyone involved in the publication of *Complete Poems* reasoned that the poems belonged to Parker, not Silverstein.").

The U.S. Court of Appeals recognized the blatant copying:

However, Penguin concedes that the editor who prepared that section photocopied *Not Much Fun*, cut the poems apart with scissors, and pasted them into the Penguin manuscript chronologically. *Complete Poems* does not reference or acknowledge Silverstein or *Not Much Fun*.

Silverstein v. Penguin Putnam, Inc., 368 F.3d 77, 79 (2dCir. 2004).

See also the description of the photocopying and cut-and-paste in the trial court's opinions.

Silverstein v. Penguin Putnam, Inc., Not Reported in F.Supp.2d, 2003 WL 1797848 at *6 (S.D.N.Y. 2003) ("Here copying has been admitted by defendant.") and 522 F.Supp.2d 579, 597 (S.D.N.Y. 2007).¹⁵ Ironically, Penguin offered to pay Silverstein \$2000 for his collection of Parker's poems in 1994, but Penguin paid Silverstein nothing to copy his collection in 1999.

The U.S. Court of Appeals summarized the history of this complicated case:

Silverstein brought suit in the United States District Court for the Southern District of New York in 2001, alleging that Penguin (i) infringed his copyright under the Copyright Act of 1976, 17 U.S.C. § 101 et seq.; (ii) engaged in "reverse passing off" in violation of section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a); and (iii) engaged in immoral trade practices and unfair competition in violation of New York law. Judge Keenan granted Silverstein's motion for summary judgment and permanently enjoined Penguin from further sales or distribution of *Complete Poems*. The court found that *Not Much Fun* was entitled to copyright protection because Silverstein's selection of the poems evinced the level of creativity needed to render it an original work of authorship. He focused on the subjective judgment used by Silverstein in selecting and characterizing the chosen works as poems, "relying on his own taste, judgment, and informed decision-making." *Silverstein*, 2003 WL 1797848, at *4, 2003 U.S. Dist. LEXIS 5487, at *12. The court found that Penguin infringed Silverstein's copyright by copying and pasting his protected selection into *Complete Poems*. *Id.* at *6-*7, 2003 U.S. Dist. LEXIS 5487, at *18-*21.

The district court also granted summary judgment for Silverstein on the Lanham Act claim, finding that Penguin's failure to credit Silverstein in *Complete Poems* was a willful false designation. *Id.* at *7-*8, 2003 U.S. Dist. LEXIS 5487, at *22-*24. Finally, the court found that Silverstein's state law claims were not preempted by federal copyright law, and it granted summary judgment for him on those claims as well. *Id.* at *8, 2003 U.S. Dist. LEXIS 5487, at *25.

Silverstein v. Penguin Putnam, Inc., 368 F.3d 77, 79-80 (2dCir. 2004).

The U.S. Court of Appeals vacated the injunction, and reversed the summary judgment. The court noted "Mrs. Parker herself created the category of uncollected Parker poems by collecting fewer than all her poems in her lifetime; so that principle of selection owes nothing to Silverstein." 368 F.3d at 80. The U.S. Court of Appeals concluded "... all is not a selection." 368 F.3d at 85. This doomed Silverstein's alleged copyright on his compilation of Parker's poems.

¹⁵ *Silverstein v. Penguin Putnam, Inc.*, Not Reported in F.Supp.2d, 2008 WL 678559 at *3, n.1 (S.D.N.Y. 2008) (During denial of Penguin's motion for attorney's fees, the trial judge said that if Silverstein had a valid copyright, then "his claim that Penguin infringed his copyright was very strong. At trial, Penguin's agents admitted that they photocopied the pages of *Not Much Fun* and rearranged them to produce a chapter in *Complete Poems*.").

Silverstein also claimed copyright in some six hundred edits, but the U.S. Court of Appeals held Silverstein was estopped from this claim:

Not Much Fun contains no ‘Note on the Text’ or other advice to the reader that changes were made in punctuation, titling, or formatting, let alone what those changes were. The introduction and dust jacket both imply that the works appear as originally published by Mrs. Parker. A reasonable reader would conclude that Silverstein was reproducing Mrs. Parker’s own work. Silverstein cannot now claim that Penguin infringed his selection by copying textual alterations of which he gave no notice.

Silverstein, 368 F.3d at 83.

The U.S. Court of Appeals remanded for further findings of fact on “whether Silverstein exercised creativity in selecting the works for his compilation.” 368 F.3d at 83.

On remand, the District Court dismissed Silverstein’s complaint, finding that Silverstein exercised no creativity in his selection of unpublished poems of Parker. “Furthermore, Silverstein’s decision that certain works were or were not authored by Parker was based on historical evidence and not creative judgment.” *Silverstein v. Penguin Putnam, Inc.*, 522 F.Supp.2d 579, 582 (S.D.N.Y. 2007). “... Silverstein proudly represented *Not Much Fun* as compiling all, and not simply a selection, of Parker’s uncollected poems.” 522 F.Supp.2d at 595.

Silverstein’s Lanham Act claim was precluded by a recent U.S. Supreme Court decision in *Dastar*.¹⁶ *Silverstein*, 522 F.Supp.2d at 601-602. Moreover, because the poems were written by Parker, and correctly attributed to Parker by Penguin, it is difficult to see how Penguin plagiarized from Silverstein. It is true that Silverstein made many editorial changes, but the Second Circuit held that Silverstein was estopped from asserting editorial changes as a basis for copyright, and the same estoppel should apply to failure to credit Silverstein for his concealed editorial work.

Finally, the District Court held all of Silverstein’s state law claims for unfair and immoral trade practices and unfair competition were preempted by the Copyright Act. *Silverstein*, 522 F.Supp.2d at 608-609. Interestingly, the District Court’s opinion in 2007 is a complete reversal of its opinion in 2003.

This result in the copyright claim is compelled by *Feist*, but it nonetheless is an outrageous injustice to Silverstein to have a competitor usurp his diligent work. Silverstein spent more than a year of his life to collect poems, but he earned nothing from Penguin’s commercial exploitation of his work. This is what happens when “sweat of the brow” cases have been overruled.

¹⁶ For my criticism of *Dastar*, see Plagiarism in Colleges in USA, <http://www.rbs2.com/plag.pdf> 89 pp., (April 2012).

There is an analogous problem in finding copyright protection for editors who make scholarly new editions of public domain works (e.g., music of J.S. Bach), which I described in my essay, *Copyright for New Editions of Public Domain Music in the USA*, <http://www.rbs2.com/cmusic2.pdf> (Oct 2009).

Harney (1stCir. 2013)

The U.S. Court of Appeals in Boston summarized the facts of a case in 2013:

On a sunny April day in 2007, freelancer Donald Harney snapped a photograph (“the Photo”) of a blond girl in a pink coat riding piggyback on her father's shoulders as they emerged from a Palm Sunday service in the Beacon Hill section of Boston. Just over a year later, the pair in the Photo became a national media sensation. The father, soon-to-be revealed as a German citizen who had assumed the name Clark Rockefeller, had abducted his daughter during a parental visit and was being sought by law enforcement authorities. Harney's father-daughter photo was used in an FBI “Wanted” poster, and the image was widely distributed in the media as the abduction saga unfolded.[footnote omitted] Appellee Sony Pictures Television, Inc. (“Sony”) later produced a made-for-television movie based on Gerhartsreiter's identity deception. Sony depicted the Photo in that movie using an image that was similar in pose and composition to Harney's original, but different in a number of details. *Harney v. Sony Pictures Television, Inc.*, 704 F.3d 173, 176 (1stCir. 2013).

The trial court granted defendant's motion for summary judgment. *Harney v. Sony Pictures Television, Inc.*, Not Reported in F.Supp.2d, 2011 WL 1811656 (D.Mass. 2011). The U.S. Court of Appeals affirmed, and noted in passing:

Alternatively, subject matter that the photographer did not create could be viewed as “facts” that, like ideas, are not entitled to copyright protection. A photograph that consists of public-domain subject matter may thus be protected from copying because it involves creative expression, but with the protection limited to the work's original elements. *Harney v. Sony Pictures Television, Inc.*, 704 F.3d 173, 181-182 (1st Cir. 2013) (citing *Feist*).

This may be a landmark holding that weakens copyright protection for photographs of nature (e.g., sunset), buildings, landscapes, etc. each of which are essentially a reproduction of facts.

Conclusion

My essay at <http://www.rbs2.com/cfact.pdf> criticizes the U.S. Supreme Court's opinion in *Feist* and gives many reasons why the opinion is wrong. *Feist* was correct to require the selection and arrangement of a copyrightable compilation be original (i.e., independently created, *not* copied). *Feist* was wrong to require the selection and arrangement of a copyrightable compilation be creative.

After *Feist*, compilations of facts seem to protect the creative expression of an author in presenting facts. That is too narrow to adequately protect *all* compilations of facts, such as expression of those facts in "obvious" or uncreative ways.

This document is at **www.rbs2.com/ccompile.pdf**

My most recent search for court cases on this topic was in May 2013
first posted 16 May, revised 16 May 2013

return to my subhomepage on copyright law at <http://www.rbs2.com/icopyr.htm>