

# Copyright Protection for Nonfiction or Compilations of Facts in the USA

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## Keywords

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## Table of Contents

Introduction .....	3
Overview .....	4
Feist .....	8
U.S. Supreme Court .....	10
applying law to facts of Feist .....	11
general remarks in Feist .....	12
Key Publications v. Chinatown Today .....	14
commentators .....	15
my opinion .....	16
1. thin copyright .....	16
2. ended protection for author's labor .....	17
3. constitutional basis .....	17
4. bigger issues than telephone directories .....	18
5. maps .....	18
6. mathematical tables .....	19
Copyright Does Not Protect Facts .....	20
A. U.S. Constitution .....	21
tangential remarks on purpose of copyright .....	22
B. statute .....	22
C. judicial opinions .....	23
U.S. Supreme Court .....	23
Early Cases (1913-1960) .....	26
Greenbie v. Noble (1957) .....	30
U.S. Courts of Appeals (1980-present) .....	31

Hoehling (1980) .....	31
Iowa State Univ. (1980) .....	33
Miller (1981) .....	33
Harper & Row (1983) .....	34
Eckes (1984) .....	34
Financial Information (1986) .....	36
Worth (1987) .....	36
Sega v. Accolade (1992) .....	37
Sparaco (2002) .....	37
NY Mercantile Exch. (2007) .....	39
other Courts of Appeals cases .....	40
D. commentators on protection for facts .....	40
why some facts should be protected by copyright .....	42
denigration of facts/ideas .....	45
Copyright Protects “Labor”? .....	46
cases after Feist .....	51
Toksvig .....	53
criticism of Toksvig .....	54
labor irrelevant to copyright .....	59
morality .....	60
Recognition of Unfair Competition .....	62
Cases Before 1918 .....	62
International News Service .....	64
Jeweler’s Circular and progeny .....	67
Feist ends protection for “sweat of the brow” .....	69
opinion of the Copyright Office .....	73
Modern State Law of Unfair Competition .....	73
California .....	73
New York .....	74
Texas .....	75
Preemption by Copyright .....	76
Independent Creation Is Neither Infringement Nor Unfair .....	79
Novelty Not Required .....	82
Copyright for Photographs .....	84
history of copyrighting photographs .....	84
photograph of public-domain artistic work .....	86

copy of copyrighted work .....	87
skill, merit, quality not relevant to copyright .....	87
Valuation of Writing .....	89
Reviving Unfair Competition .....	90
fair use can help protect research .....	93
pagination not copyrightable .....	94
Conclusion .....	94
Bibliography .....	96

## Introduction

In 1991, the U.S. Supreme Court in *Feist* either killed or seriously maimed copyright protection for compilations (i.e., collections) of facts. This result is serious problem for:

- authors and publishers of maps,
- authors and publishers of books in mathematics, science, and engineering,
- authors and publishers of nonfiction history books,
- proprietary publishers of judicial opinions or statutes, *and*
- authors and webmasters of *all* online databases.

The authors of such compilations of facts expend labor and money to not only collect facts, but also to check those facts. Currently, it is uncertain how much legal protection an author has in preventing copying of facts that the author collected and checked. As our economy evolves from sales of manufactured goods to sales of information, law will need to develop new protections for collections for facts in online databases. Ironically, suitable “new protections” were developed before the year 1923, but were discarded in 1991 by the justices of the U.S. Supreme Court in *Feist*.

### disclaimer

This essay contains a critical review of the judicial opinion in *Feist* and its subsequent effect on copyright owners, authors, and publishers. In particular, I caution the reader that I challenge some accepted dogma in copyright law, and I advocate some unconventional views that are *not* accepted in mainstream copyright law in the USA. This is a provocative essay that advocates changes in the law, and is *not* legal advice on which readers should rely. 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> .

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*. Because part of the audience for this essay is nonlawyers, I have included longer quotations from court cases than typical writing for attorneys.

## Overview

Since the early 1800s, judicial opinions in the USA have repeatedly said that copyright protects *labor* of authors. Below, beginning at page 46, I argue that copyright rewards the *intellectual labor* that is necessary for producing an original work of authorship. By the late 1800s, it was already well established that both copyright law and the evolving common law tort of unfair competition protected the author's investment of **labor, skill, and expense** — a trilogy that is repeated in most of the unfair competition cases after the 1920s.

Before 1991, copying of a copyrighted compilation of facts *was* a civil wrong, under either (1) copyright infringement or (2) the tort of unfair competition for misappropriation of the labor, skill, or expense of a business competitor. The conventional wisdom is that this tort of unfair competition was established by the U.S. Supreme Court in *International News Service v. Associated Press*, 248 U.S. 215, 236 (1918) and extended by the Second Circuit in *Jeweler's Circular Publishing Co. v. Keystone Publishing Co.*, 281 F. 83, 88 (2d Cir. 1922). While *Jeweler's Circular* was the first case to use the phrase “industrious collection” of facts, it was *not* the first case to sanction a business competitor who copied a compilation of facts. Below, beginning at page 62, I trace the history of the tort of unfair competition for misappropriation, and show that such cases first began in the 1800s.

The “industrious collection” cases were overruled by *Feist Publications, Inc. v. Rural Telephone Service Co., Inc.*, 499 U.S. 340 (1991). Below, beginning at page 8, I review the *Feist* case and then explain why — in my opinion — *Feist* is a gross error. For businesses and authors who are aware of *Feist*, the rules of law in that case will discourage creation of new compilations of facts. The rules of law in *Feist* may allow competitors to unfairly copy an author's laborious factual compilation.

In a landmark article published in 1981, Prof. Denicola wrote

Copyright law has always dealt more comfortably with the novelist, painter, or composer, than with the historian, reporter, or compiler. Indeed the very vocabulary of copyright is ill suited to analyzing property rights in works of nonfiction.<sup>1</sup> .... Although the scholar's treatise and the compiler's list present similar issues, copyright law has often chosen

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<sup>1</sup> This sentence quoted in *Eckes v. Card Prices Update*, 736 F.2d 859, 862 (2d Cir. 1984).

to ignore the similarities. While the compiler is often rewarded<sup>2</sup> for his industriousness with at least a limited monopoly over the resulting collection of data[,] the writer of a treatise or biography is not; his facts are usually free for the taking.

Robert C. Denicola, "Copyright in Collections of Facts: A Theory for the Protection of Nonfiction Literary Works," 81 COLUMBIA LAW REVIEW 516, 516 (1981).

In landmark papers, Prof. Gorman<sup>3</sup> and Prof. Ginsburg<sup>4</sup> recognized that there were *two* distinct categories of works involved in copyright infringement cases, which Ginsburg calls "high authorship" and "low authorship".<sup>5</sup> The following explanation is my elaboration of their ideas:

1. **high-authorship** works display the individual personality of the author, through expression of emotion, imagination, and artistic creativity. Examples include poetry, fiction, narrative histories, and musical compositions. Copyright in high-authorship works protects the author's personality, as revealed through his/her expression.
2. **low-authorship** works generally do not display the personality of the author; are often rich in ideas, facts, and/or useful information; and often have significant commercial value. Examples include the white pages in telephone directories, compilations of facts, maps, translations (as copyrighted by the translator, but not showing the personality of the translator), reference books, and computer databases. Copyright in low-authorship works protects the author's investment of labor, skill, and expenses.

My reading of copyright cases suggests that judges in the USA extended copyright protection to both high- and low-authorship works,<sup>6</sup> until approximately the year 1980. In the high-authorship works, judges held that the *expression* of the author was protected by copyright. In the low-authorship works, judges held that the labor, skill, and expense of the author were protected by copyright, at least in the cases of verbatim copying by a business competitor, including another author or publisher. As recognized by Prof. Ginsburg, courts in the 1980s began to adopt a

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<sup>2</sup> But not rewarded after *Feist*, ten years after Prof. Denicola's article.

<sup>3</sup> The ideas that "fact works ... do not reflect the personality of the author" and that copyright for these works "protects ... effort, time, expense, ... skill" is traceable to Robert A. Gorman, "Copyright Protection for the Collection and Representation of Facts," 76 HARVARD LAW REVIEW 1569, 1570 (June 1963).

<sup>4</sup> Jane C. Ginsburg, "Creation and Commercial Value: Copyright Protection of Works of Information," 90 COLUMBIA LAW REVIEW 1865, 1873-1893, and especially at 1866 and 1870 (Nov 1990); Jane C. Ginsburg, "No 'Sweat'? Copyright and Other Protection of Works of Information After *Feist v. Rural Telephone*," 92 COLUMBIA LAW REVIEW 338, 340 (March 1992).

<sup>5</sup> Subsequent authors have adopted her nomenclature. See, e.g., Paul J. Heald, "The Vices of Originality," 1991 SUPREME COURT REVIEW 143, 150, n. 31 (1991); David E. Shipley, "Thin But Not Anorexic: Copyright Protection for Compilations and Other Fact Works," 15 JOURNAL OF INTELLECTUAL PROPERTY LAW 91, 92, n. 5 (Fall 2007).

<sup>6</sup> Judges extended protection with the exception of historical or biographical works, in which facts were usually held to be in the public domain.

“unitary concept of copyright” that applied concepts appropriate to high-authorship works to *all* works, thereby discriminating against low-authorship works.<sup>7</sup> Prof. Ginsburg is correct when she says: “The inhospitability of the personality concept of copyright to fact protection creates uncertain and inconsistent adjudication of claims involving low authorship works.”<sup>8</sup>

Research papers or books in mathematics, science, engineering, or medicine — as well as nonfiction works in general — have characteristics of *both* high-authorship *and* low-authorship works. The text itself is a high-authorship work, except for the facts and ideas in the text. However, graphs, tables of numbers, compilations of facts, etc. are low authorship. As a scientist and engineer during the 1970s and 1980s, I read many papers and books in physics and electrical engineering. *Some* of those technical works show a hint of the author’s personality, in both the content, word choice, and style of writing.<sup>9</sup> The existence of technical papers and books in which some of the author’s personality leaked into a publication does *not* invalidate Prof. Ginsburg’s criteria.

As judges began to declare that *facts* were not copyrightable, the law evolved into a weaker, or nonexistent, copyright for nonfiction works. My sketch of the history, beginning at page 23 below, shows that the first declarations that facts are not copyrightable occurred in the year 1913, and the U.S. Supreme Court first declared that facts were not copyrightable in 1985. In 1991, the U.S. Supreme Court’s decision in *Feist* had three major holdings

1. pushed compilations of facts into a second-class, “thin” copyright<sup>10</sup> (and denied copyright protection to compilations of facts that were arranged in “obvious” ways);
2. ended any copyright protection for labor, skill, and expense of the author; and
3. declared that the criteria of originality and creativity were based in the U.S. Constitution, thus scuttling any future attempt by Congress to protect low-authorship works against copying.

After *Feist* in 1991, the only copyright protection for compilations of facts was for the selection, coordination, or nonobvious arrangement of those facts.<sup>11</sup>

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<sup>7</sup> Jane C. Ginsburg, “Creation and Commercial Value: Copyright Protection of Works of Information,” 90 COLUMBIA LAW REVIEW 1865 at 1867, 1893 (Nov 1990).

<sup>8</sup> *Ibid.* at 1937.

<sup>9</sup> It is the same with articles in law reviews — even when the subject greatly interests me, many lawyers write in a verbose style that I find soporific. But, even if the style is dull, verbose, plodding, or soporific, the article can still contain important facts and ideas.

<sup>10</sup> *Feist Publications, Inc. v. Rural Telephone Service Co.*, 499 U.S. 340, 349 (1991) (“This inevitably means that the copyright in a factual compilation is thin.”).

<sup>11</sup> See, e.g., 17 U.S.C. §§ 101, 103(b) (enacted 1976).

When *Feist* denied copyrightability to compilations of facts in obvious ways and also denied copyright protection for the labor, skill, and expense of the first author, *Feist* also killed off the tort of unfair competition associated with such compilations, including computer databases. The Copyright Act of 1976, 17 U.S.C. § 301(a), contains a preemption of state law by federal law. If federal copyright law will not punish copying of a compilation of facts, then no state law can punish such copying. Alternatively, if a work is in the public domain (*unprotected* by copyright), then state law can not punish the copying of it. See the cases cited below, beginning at page 76.

I first became aware of this problem when I read and considered *Matthew Bender & Co., Inc. v. West Pub. Co.*, 42 USPQ2d 1930 (S.D.N.Y. 1997), *aff'd*, 158 F.3d 674 (2dCir. 1998), *cert. den. sub nom. West v. HyperLaw*, 526 U.S. 1154 (1999) — a case in which West Publishing now has little legal protection to prevent wholesale copying by competitors. It is blatantly unfair that West's competitors can freely copy features that West spent labor, skill, and expense to create. My comments on the *Matthew Bender* case — along with the interesting history of why law (e.g., statutes, judicial opinions, and government regulations) is *not* protected by copyright in the USA, despite the fact that most of the law in the USA is published by for-profit corporations — is contained in my earlier essay at <http://www.rbs2.com/cgovt.pdf>. I emphasize that *Matthew Bender v. West* is only one example of the damage caused by *Feist*.

I prefer a strictly chronological approach, with the oldest cases first, so the reader can see the historical evolution of the law. However, in an essay on a broad topic like this one, there are many issues (e.g., why facts not protected, protection of author's labor, unfair competition, independent creation, novelty, etc.) and to include all of these issues in *one* chronological arrangement would be really disorganized and difficult to follow. But, by breaking the essay into one section for each issue, one case might be mentioned in more than one section, which is a different kind of disorganization. I hope my frequent references to pages in this essay where the reader can find the remainder of the case solves this disorganization. The above overview also gives some organization, by showing the relationship between the different issues.

### ***Feist***

Feist wanted to publish a wide-area telephone book for northwest Kansas, containing listings copied from the white pages issued by each of the local telephone companies in that area and also containing Feist's own (and profitable) Yellow Pages. Feist attempted to license the white pages of the telephone book of eleven local telephone companies in Kansas. Only Rural Telephone Service Co., a small telephone company in Kansas with 4700 subscribers, refused to license to Feist. Feist then copied 1309 telephone numbers from the white pages published by Rural.<sup>12</sup> Rural sued Feist for copyright infringement. This case is reported at *Rural Telephone Service Co., Inc. v. Feist Publications, Inc.*, 663 F.Supp. 214 (D.Kan. 1987), *aff'd without opinion*, 916 F.2d 718 (10th Cir. 1990), *rev'd*, 499 U.S. 340 (U.S. 1991), *on remand*, 24 U.S.P.Q.2d 1312 (D.Kan. 1992) (denying Feist's motion for attorneys fees).

Incidentally, Rural was *required* by a Kansas state regulation to provide a telephone book to its subscribers,<sup>13</sup> which *might* make the white pages a public-domain document.<sup>14</sup>

This case had significant anti-trust issues, in that Rural has a monopoly on local land-line telephone service, and it attempted to extend that monopoly to sales of advertising in Yellow Pages of its telephone books.<sup>15</sup> These antitrust issues raised in Feist's counterclaim were discussed in a separate string of judicial opinions: *Rural Telephone Service Co., Inc. v. Feist Publications, Inc.*, 737 F.Supp. 610 (D.Kan. 1990) (awarding Feist damages of \$99,000 and ordering Rural to license its white pages to Feist at a "reasonable rate", and ordering Rural to reimburse Feist's attorneys fees), *reconsideration denied*, 1990 WL 113904 (D.Kan. 1990), *rev'd*, 957 F.2d 765 (10th Cir. 1992) (denying all of Feist's antitrust counterclaims), *cert. den.*, 506 U.S. 984 (1992).

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<sup>12</sup> These facts are from *Feist*, 663 F.Supp at 217 and especially 499 U.S. at 342-344.

<sup>13</sup> *Feist*, 499 U.S. at 342.

<sup>14</sup> The Supreme Court notes that Rural's selection of names was a result of a Kansas regulation. *Feist*, 499 U.S. at 363.

<sup>15</sup> *Feist*, 737 F.Supp. at 622 (Kan. 1990) (Rural had an unlawful purpose: "to extend its monopoly in telephone service to a monopoly in yellow pages advertising."), *Feist*, 499 U.S. at 343.



A novel claim for Rural's misuse of copyright was rejected by the trial court.<sup>16</sup> The claim for copyright misuse was certainly mooted when the U.S. Supreme Court invalidated Rural's copyright. *If* the Supreme Court had upheld Rural's copyright, then the refusal of Rural to license its copyright to Feist could be a relevant consideration in the infringement litigation.

The trial court held that Rural had a valid copyright in its white pages:

The issue of whether telephone directories are copyrightable is well-settled. Courts have consistently held that telephone directories are copyrightable. *Hutchinson Telephone Co. v. Fronteer Directory Co.*, 770 F.2d 128 (8th Cir. 1985); *Southern Bell Telephone & Telegraph Co. v. Associated Telephone Directory Publishers*, 756 F.2d 801 (11th Cir. 1985); *Leon v. Pacific Telephone & Telegraph Co.*, 91 F.2d 484 (9th Cir. 1937); *Central Telephone Co. of Virginia v. Johnson Publishing Co.*, 526 F.Supp. 838 (D.Colo. 1981); *Southwestern Bell Telephone Co. v. Nationwide Independent Directory Service, Inc.*, 371 F.Supp. 900 (W.D.Ark. 1974); *Southern Bell Telephone & Telegraph Co. v. Donnelly*, 35 F.Supp. 425 (S.D.Fla. 1940); *Cincinnati and Suburban Bell Telephone Co. v. Brown*, 44 F.2d 631 (S.D. Ohio 1930); *Hartford Printing Co. v. Hartford Directory & Publishing Co.*, 146 F. 332 (D.Conn. 1906). The court does not find the defendant's arguments to the contrary, which are based on Professor Nimmer's comments in NIMMER ON COPYRIGHT (1986), persuasive. See Denicola, Copyright in Collections of Facts: A Theory for the Protection of Nonfiction Literary Works, 81 COLUM.L.REV. 516, 527-535 (1981). The court holds that the white pages of a telephone directory constitute original work of authorship and are, therefore, copyrightable under either the provisions of 17 U.S.C. § 102 or § 103. *Hutchinson Telephone Co. v. Fronteer Directory Co.*, supra, at 131-32. Accordingly, we find that the plaintiff has demonstrated a valid copyright for its 1982-1983 telephone directory.

*Feist*, 663 F.Supp at 218.

Indeed, citing four U.S. Court of Appeals cases back to the year 1937 shows that it was well settled law in 1990 that white pages of telephone directories were copyrightable, despite the fact that some commentators disagreed with those cases. Clearly, Feist believed the white pages were copyrightable, because they tried to license the right to copy from the telephone companies.

One of the co-owners of Feist Publications had admitted during a deposition that they copied Rural's directory. Furthermore, Rural had inserted fictitious listings in its white pages, in order to detect copying. Feist copied four of these fictitious listings, which the trial court held was additional proof of copying. *Feist*, 663 F. Supp. at 218-219. It was no surprise that the trial court granted Rural's motion for summary judgment on the issue of copyright infringement.

In the remainder of this essay, when I refer to *Feist*, I refer to the U.S. Supreme Court opinion in *Feist*, and not the trial court's opinion.

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<sup>16</sup> *Feist*, 663 F.Supp. at 219-220.

## U.S. Supreme Court

The U.S. Supreme Court held that Rural's white pages were *not* copyrightable. The Supreme Court first discussed copyright law and announced its conclusions about the requirements of creativity and originality:

The sine qua non of copyright is originality. To qualify for copyright protection, a work must be original to the author. See Harper & Row, *supra*, at 547-549, 105 S.Ct., at 2223-2224. 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).

Originality is a constitutional requirement. ....

In *The Trade-Mark Cases*, the Court addressed the constitutional scope of "writings." For a particular work to be classified "under the head of writings of authors," the Court determined, "originality is required." 100 U.S., at 94. The Court explained that originality requires independent creation plus a modicum of creativity: "[W]hile the word *writings* may be liberally construed, as it has been, to include original designs for engraving, prints, &c., it is only such as are *original*, and are founded in the creative powers of the mind. The writings which are to be protected are *the fruits of intellectual labor*, embodied in the form of books, prints, engravings, and the like." *Ibid.* (emphasis in original).

*Feist Publications, Inc. v. Rural Telephone Service Co.*, 499 U.S. at 345-346.

Ironically, when the Supreme Court, later in this opinion in *Feist*, was overruling cases in lower courts about "sweat of the brow" labor, the justices seem to have ignored this quotation about "fruits of intellectual labor". Or maybe the Court approved of the idea that copyright law rewards intellectual labor, provided that the intellectual labor involves originality and creativity, unlike the mechanical labor required to produce the white pages in a telephone directory.

The U.S. Supreme Court again said the originality was necessary for copyright:

As one pair of commentators succinctly puts it: "The originality requirement is constitutionally mandated for all works." Patterson & Joyce, *Monopolizing the Law: The Scope of Copyright Protection for Law Reports and Statutory Compilations*, 36 UCLA L.REV. 719, 763, n. 155 (1989) (emphasis in original) (hereinafter Patterson & Joyce). Accord, *id.*, at 759-760, and n. 140; Nimmer § 1.06[A] ("[O]riginality is a statutory as well as a constitutional requirement"); *id.*, § 1.08[C][1] ("[A] modicum of intellectual labor ... clearly constitutes an essential constitutional element").

*Feist*, 499 U.S. at 347.

In case the reader missed it, the Court reiterates the constitutional basis for its holding about originality and creativity:

As we have explained, originality is a constitutionally mandated prerequisite for copyright protection.

*Feist*, 499 U.S. at 351.

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.

*Feist*, 499 U.S. at 362.

As a constitutional matter, copyright protects only those constituent elements of a work that possess more than a de minimis quantum of creativity.

*Feist*, 499 U.S. at 363.

The part of *Feist* that overrules protection for “sweat of the brow” is quoted below, beginning at page 69.

applying law to facts of *Feist*

The Court then applies this law to the facts of the case, and evaporates Rural’s copyright on the white pages of its directory:

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. The standard of originality is low, but it does exist. ....

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.

Rural’s selection of listings could not be more obvious:<sup>17</sup> 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.

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<sup>17</sup> The Court 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).

We note in passing that the selection featured in Rural's white pages may also fail the originality requirement for another reason. Feist points out that Rural did not truly "select" to publish the names and telephone numbers of its subscribers; rather, it was required to do so by the Kansas Corporation Commission as part of its monopoly franchise. See 737 F.Supp., at 612. Accordingly, one could plausibly conclude that this selection was dictated by state law, not by Rural.

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. .... 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.

In the final paragraph of *Feist*, the Court says:

This decision should not be construed as demeaning Rural's efforts in compiling its directory, but rather as making clear that copyright rewards originality, not effort. *Feist*, 499 U.S. at 364.

The Court's sentence is strange, because the Court in *Feist* clearly said that "originality" meant independent creation (*not* copying),<sup>18</sup> but it is undisputed that Rural created their directory without any copying. In fact, parts of Rural's directory were not only original, but also novel. Perhaps the Court should have said copyright rewards creativity, not effort.

Despite what the court said about "not ... demeaning Rural's efforts", I can not imagine anything more demeaning to a plaintiff in a copyright infringement case than not only invalidating their copyright, but also allowing business competitors to freely copy the plaintiff's work. This result feels wrong to me.

#### general remarks in *Feist*

Speaking generally about copyrights on compilations of facts, the U.S. Supreme Court tossed some hope to authors of compilations:

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. Nimmer §§ 2.11[D], 3.03; Denicola 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

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<sup>18</sup> *Feist*, 499 U.S. at 345, 349.

selection or arrangement. See *Harper & Row*, 471 U.S., at 547, 105 S.Ct., at 2223. Accord, Nimmer § 3.03.

*Feist*, 499 U.S. at 348.

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.

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

But, in a terse sentence telling us that copyright on a compilation of facts is “thin”, the Court pulls hope away from authors of compilation of facts:

This inevitably means that the copyright in a factual compilation is thin.<sup>19</sup>

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.

*Feist*, 499 U.S. at 349.

So now authors of compilations of facts have a “thin” copyright — a second-class copyright, while authors of fictional works have a first-class copyright. Almost admitting that this result is unfair to authors of compilation of facts, the Court explains its view that the U.S. Constitution requires this unfair result:

It may seem unfair that much of the fruit of the compiler's labor may be used by others without compensation. As Justice Brennan has correctly observed, however, this is not “some unforeseen byproduct of a statutory scheme.” *Harper & Row*, 471 U.S., at 589, 105 S.Ct., at 2245 (dissenting opinion).<sup>20</sup> It is, rather, “the essence of copyright,” *ibid.*, and a constitutional requirement. The primary objective of copyright is not to reward the labor of authors, but “[t]o promote the Progress of Science and useful Arts.” Art. I, § 8, cl. 8. Accord, *Twentieth Century Music Corp. v. Aiken*, 422 U.S. 151, 156, 95 S.Ct. 2040, 2044, 45 L.Ed.2d 84 (1975). To this end, copyright assures authors the right to their original expression, but encourages others to build freely upon the ideas and information conveyed by a work. *Harper & Row*, supra, 471 U.S., at 556-557, 105 S.Ct., at 2228-2229. This principle, known as the idea/expression or fact/expression dichotomy, applies to all works of authorship. As applied to a factual compilation, assuming the absence of original written expression, only the compiler's selection and arrangement may be protected; the raw facts

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<sup>19</sup> Note by Standler: This use of the word *thin* was apparently copied by Justice O'Connor from Robert A. Gorman, “Fact or Fancy: The Implications for Copyright,” 29 JOURNAL OF THE COPYRIGHT SOCIETY OF THE USA 560 at 567, 570-571, 573, 575, 583, 598 (1982). Elsewhere in *Feist*, Justice O'Connor cites this article, so she was aware of it.

<sup>20</sup> Note that Justice Brennan was discussing fair use, but *Feist* is concerned with copyrightability. Further, a dissenting opinion is not credible authority, unless the Court wants to overrule its previous rule and adopt the dissent's rule, which is *not* what happens in *Feist*. The majority opinion in *Harper & Row* remains good law. Still further, Justice Brennan's dissent in *Harper & Row* ignores the constitutional requirement to promote Progress by encouraging and rewarding authors through copyright.

may be copied at will. This result is neither unfair nor unfortunate. It is the means by which copyright advances the progress of science and art.

*Feist*, 499 U.S. at 349-350.

Why would any for-profit publisher publish maps or other compilations of facts, knowing pirates can legally copy facts? The labor, skill, and expense in collecting and checking the facts is more expensive to an author and publisher than the arrangement of those facts. The Court needs to be more clear in its explanation of why Progress<sup>21</sup> is promoted by allowing piracy that discourages commercial publication of compilation of facts.<sup>22</sup>

### *Key Publications v. Chinatown Today*

Courts after *Feist* have generally held that directories are not copyrightable. But, in one case in New York City, the judge apparently decided that he wanted to agree with the trial judge that a directory of businesses published for the Chinese-American community was protected by copyright. The appellate judge wrote:

The format of the Key Directory is common to most classified directories, and particular categories have, of course, been used in other classified directories, e.g., “ACCOUNTANTS,” “BRIDAL SHOPS,” and “SHOE STORES.” Nevertheless, some of the categories are of particular interest to the Chinese-American community and not common to yellow pages, e.g., “BEAN CURD & BEAN SPROUT SHOPS.” And there is no evidence that the arrangement and designation of categories was copied from, or is substantially similar to, another directory. The lack of novelty is, as noted, not a bar to copyright protection.

Moreover, the individual categories chosen are irrelevant to our inquiry. Rather, we are concerned with whether the arrangement of the Key Directory, viewed in the aggregate, is original. We believe it is. The arrangement is in no sense mechanical, but involved creativity on the part of Ms. Wang in deciding which categories to include and under what name. Cf. *Feist*, 111 S.Ct. at 1297 (finding that “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.”). This task entailed the de minimis thought needed to withstand the originality requirement.

*Key Publications, Inc. v. Chinatown Today Pub. Enterprises*, 945 F.2d 509, 514 (2dCir. 1991).

The judge seized on the entry for shops supplying “bean curds and bean sprouts” as an example of the nonobvious, nonroutine selection of shops in the directory that made the directory copyrightable. From the viewpoint of European cuisine, the judge was correct. *But*, from the viewpoint of Chinese cuisine, bean sprouts are expected, routine, and obvious, thus — applying

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<sup>21</sup> I upper-case the *P* to indicate that I am quoting from the U.S. Constitution’s copyright clause. The authors of the Constitution followed the German (i.e., Saxon in Anglo-Saxon) tradition by upper-casing the first letter in nouns. See the discussion of the Constitution at page 21, below.

<sup>22</sup> 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, 341, 350 (March 1992) (“However, *Feist* neglects another ... constitutional goal: to provide incentives to the creation of works, so that knowledge will progress.” “Remarkably, *Feist* grossly neglects copyright’s incentive role.”).

the standards of *Feist* — the arrangement and selection of facts was *not* creative enough to be copyrightable. This kind of cultural consideration is likely prohibited under the holding of *Bleistein*.<sup>23</sup>

I am afraid that this nonsense in *Key Publications* is just one of many examples of erroneous reasoning following *Feist*.

commentators

Professor Kreiss of the University of Dayton Law School was so “astounded” by *Feist* that he convened a symposium to discuss issues raised by *Feist*. In his introduction to the symposium, he criticized

... the Court’s constitutionalization of copyright law. The Court held that the Constitution required a minimum amount of originality or creativity for a work to be eligible for copyright protection.

I suspect that most copyright scholars and practicing attorneys were as astounded as I was at this surprising new development in copyright law. It was surprising for a number of reasons. First, it was surprising simply because it is so unusual. I can think of no previous copyright cases which have been decided on constitutional grounds, and in fact there may have been no such cases.

Second, it is surprising since it was unnecessary. If the Court wanted to hold that a minimum amount of originality is required before a work can have copyright protection, it could certainly have done so on statutory grounds almost as easily as it did on constitutional grounds. The statutory language in § 102 providing that copyright protection subsists “in original works of authorship” should easily have been interpreted to require some threshold level of originality. ....

And third, it is surprising since it has taken the Court 200 years to tell us that the words “author” and “writings” in the Constitution contain a requirement of originality in order to have copyright protection. If the text of the Constitution were as clear as the Court seems to claim in the *Feist* opinion, surely an earlier Court would have told us so.

Robert A. Kreiss, “Copyright Symposium Part I,” 17 UNIVERSITY OF DAYTON LAW REVIEW 323, 328-329 (Winter 1992).

I agree with Professor Raskind when he says:

If, as the Court reiterated, facts as such are not protectable and the labor, sweat, or industry in collecting them are invalid grounds of copyright protection, then a revised rationale must be provided to support the protection clearly given to compilations by the statute.

Leo J. Raskind, “Assessing the Impact of *Feist*,” 17 UNIVERSITY OF DAYTON LAW REVIEW 331, 332 (Winter 1992). Professor Raskind was concerned that *Feist* would cause less protection for “directories, maps, data bases, computer software programs, and kindred fact works.”<sup>24</sup>

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<sup>23</sup> *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239 (1903) (prohibiting judges from considering artistic merit of copyrighted item).

<sup>24</sup> Leo J. Raskind, 17 UNIVERSITY OF DAYTON LAW REVIEW 331 at 331 (1992).

Prof. Heald makes a heretical suggestion that some facts should be protected by copyright, in order to encourage the publication of factual works:

... many other [i.e., other than telephone books] sorts of valuable low authorship works may require the carrot of the copyright monopoly. Protecting labor and sweat requires the protection of facts and information to a certain degree. The best way to protect the research and labor of Ms. Toksvig<sup>25</sup> may be to protect some biographic material that is entirely factual. Sometimes the only way to stimulate investments in labor and research may be to provide limited protection to the facts and information thereby produced.

Paul J. Heald, "The Vices of Originality," 1991 SUPREME COURT REVIEW 143, 159 (1991).

I believe that Prof. Heald's bold suggestion makes more sense than the holdings of the Supreme Court in *Feist*.

#### my opinion

The U.S. Supreme Court's decision in *Feist* had three major holdings

1. pushed compilations of facts into a second-class, "thin" copyright (and denied copyright protection to compilations of facts that were arranged in "obvious" ways);
2. ended any copyright protection for labor, skill, and expense of the author; and
3. declared that the criteria of originality and creativity were based in the U.S. Constitution, thus scuttling any future attempt by Congress to protect low-authorship works against copying.

As explained below, each of these holdings was a mistake.

#### 1. thin copyright

The U.S. Supreme Court invalidated Rural's copyright because Rural's arrangement of facts was obvious, thereby lacking minimal creativity required for copyright protection. The Court also mentions repeatedly that originality and creativity are constitutional requirements. 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 copyrightability 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.

*Feist* declared that copyright protection for compilations of facts in creative ways is "thin", which gives copyrights on compilations of facts a second-class status. This holding in *Feist* comes from applying high-authorship standards of creativity and nonobviousness to *all* works, including low-authorship works. The error in such a unitary standard was carefully explained by Prof. Ginsburg (see page 5, above) about four months before *Feist*, and Justice O'Connor cited

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<sup>25</sup> Toksvig is discussed below, beginning at page 53.



Prof. Ginsburg's article four times in *Feist*, but Justice O'Connor appears not to have understood what Prof. Ginsburg clearly explained.

## 2. ended protection for author's labor

Because the trial court had cited a string of decisions upholding copyright for white pages of telephone directories, the U.S. Supreme Court overruled this string of decisions, specifically declaring there was no legal protection for Rural's "sweat of the brow" labor in compiling the facts in its white pages.<sup>26</sup> While this holding in *Feist* agrees with conventional copyright law, this holding prevents any attempt to amend copyright law to include protection of low-authorship works, as suggested by Prof. Ginsburg.

This holding in *Feist* apparently overrules a long history of remarks by judges that copyright either protects or rewards intellectual labor by authors (see the list of citations, beginning at page 46, below) and I do not want to see such remarks overruled.

Furthermore, *Feist* did *not* distinguish between uncreative mechanical labor (e.g., collection and arrangement of telephone numbers in a directory) and creative, intellectual labor (e.g., writing a scholarly essay, collecting and verifying scientific data, etc.).

## 3. constitutional basis

In my opinion, *Feist* was surely wrong to declare that the criterion of originality was constitutionally based,<sup>27</sup> thereby scuttling any future effort by the U.S. Congress to prevent copying of compilations of fact.<sup>28</sup> There is nothing in the U.S. Constitution that says, or even hints, that the labor, skill, and expense of authors are unworthy of legal protection. This mistake in *Feist* created an unnecessarily nasty preemption problem, which is discussed below, beginning at page 76.

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<sup>26</sup> *Feist*, 499 U.S. at 352-353. Quoted below, beginning at page 69.

<sup>27</sup> *Feist*, 499 U.S. at 346-349, 351, 362-363. At 346: "Originality is a constitutional requirement."

<sup>28</sup> Paul J. Heald, "The Vices of Originality," 1991 SUPREME COURT REVIEW 143, 155 (1991) ("In handcuffing Congress with a version of the originality requirement that absolutely forbids protection based on the value of an author's research or labor, the Court clearly rejected the 'sweat of the brow'/'industrious collection' rationale for protection: [quoting *Feist*]."). See also Heald at 159, 177.

Jane C. Ginsburg, "No 'Sweat'? Copyright and Other Protection of Works of Information After *Feist v. Rural Telephone*," 92 COLUMBIA LAW REVIEW 338 (March 1992).

#### 4. bigger issues than telephone directories

Personally, I am uncertain whether the Court was correct in its decision about copyrightability of listings of telephone numbers. I'm not really concerned about copyrighting white pages in telephone books<sup>29</sup> — I am much more concerned about copyrighting the following compilations of facts:

- research papers and reference books in mathematics, science, engineering;
- nonfiction history books;
- commentaries about law (including lists of citations to unfamiliar sources);
- online databases; and
- maps.

If we need to copyright white pages of telephone books so that we can also copyright these other compilations of facts, then I favor copyrighting white pages.

#### 5. maps

There is no doubt that Congress intended copyright to protect maps. The first copyright statute, enacted in the year 1790, mentions maps as one of three items that copyright protects.<sup>30</sup> The current copyright statute, the Copyright Act of 1976, also mentions maps as copyrightable.<sup>31</sup>

I suggest that the justices *should* have worried about how their opinion in *Feist* would affect copyrights of maps, amongst other classes of valuable works that have long been protected by copyright. This concern about copyright of maps was articulately expressed by Gorman<sup>32</sup> in

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<sup>29</sup> Telephone books will continue to be printed, even if there is no copyright for such books, because state utility commission regulations *require* telephone companies to print and distribute such books. Telephone books are a special case where the potential reward from copyright is not necessary to motivate production.

<sup>30</sup> 1 STATUTES-AT-LARGE 124 (1790). This statute protected: “maps, charts, and books”. Because a “chart” is a nautical map, maps of land and sea were actually two of the three items protected by copyright.

<sup>31</sup> 17 U.S.C. § 101 (in definition of “pictorial, graphic, and sculptural works”, again in definition of “work of visual art”, again in definition of “work made for hire”).

<sup>32</sup> Robert A. Gorman, “Copyright Protection for the Collection and Representation of Facts,” 76 HARVARD LAW REVIEW 1569, 1570-1574 (June 1963).

1963, 28 years before *Feist*. Subsequent authors<sup>33</sup> have also written about the lack of protection for maps.

In light of *Feist*, how can a court find a valid copyright in a map? As noted by previous commentators, the information shown on a typical map is all factual, which are *unprotected* by copyright, even *if* the facts are novel (i.e., not shown on any previous map). The symbols used on a map are mostly standard or conventional, for ease of reading the map, so there is little creativity used in drawing the map. The information on a map is displayed in an *uncreative* way, in a scale drawing on east-west, north-south axes. Worse, if the map maker draws a picture of a sea monster in the ocean to the east of Boston, copyright law gives more protection to the drawing of the fictional monster than to the accurate map. I don't know why drawing a sea monster on a map supports the constitutional policy of promoting Progress in knowledge, but I do know that judges now respect copyright in artistic drawings more than copyright in maps. This result shows the absurd state of copyright law after *Feist*, which urgently needs change by Congress.

## 6. mathematical tables

In a case eighty years ago, involving copyright of interest tables for use by bankers, a judge on the Seventh Circuit looked at a publication issued by the U.S. Copyright Office and then held that interest tables were copyrightable:

Copyright Bulletin No. 15, defining what may be copyrighted under the term 'books,' says: "The term 'book,' as used in the law, includes tabulated forms of information, frequently called charges, tables of figures showing the results of mathematical computation, such as logarithmic tables, interest, cost and wage tables."

*Edwards & Deutsch Lithographing Co. v. Boorman*, 15 F.2d 35, 36 (7thCir. 1926), *cert. den.*, 273 U.S. 738 (1926). This appears to be the only reported instance of a court deciding the copyrightability of mathematical tables. It is disappointing that the judge did not apply the criteria in the copyright statute to plaintiff's book. But I have learnt that most judges — like most lawyers — went through college taking the absolute minimum of classes in mathematics and physics, and they react to a mathematics book the way a vampire reacts to seeing a silver cross. <grin> That's probably why this judge quoted a document written by a government bureaucrat and then quickly decided the case.

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<sup>33</sup> See, e.g., Leo J. Raskind, "The Continuing Process of Refining and Adapting Copyright Principles," 14 COLUMBIA VLA JOURNAL OF LAW & THE ARTS 125, 131-140 (1990).; Paul J. Heald, "The Vices of Originality," 1991 SUPREME COURT REVIEW 143, 150, 163 (1991); David B. Wolf, "Is There Any Copyright Protection for Maps after *Feist*?", 39 JOURNAL OF THE COPYRIGHT SOCIETY OF THE U.S.A. 224 (Spring 1992); Dennis S. Karjala, "Copyright and Misappropriation," 17 UNIV. OF DAYTON LAW REVIEW 885 at 889, 895, 909-915 (Spring 1992).

With the introduction of handheld calculators in the mid-1970s and the widespread use of desktop computers since the 1980s, mathematical tables are less useful than previously. Nonetheless, old tables are still useful to those of us who write numerical algorithms for computers, to verify our work.

So how would a judge decide copyrightability of a book containing mathematical tables after *Feist*? Well, the tables are arranged in a standard way, just like names in the white pages of a telephone directory. And the values in the tables are *facts*, just like names and telephone numbers. So I expect that a judge, following *Feist*, would now declare that mathematical tables are *not* copyrightable. In the days before electronic computers, it took an immense amount of arithmetical computations on mechanical machines to generate even a small table of logarithms or trigonometric functions, but *Feist* refused to protect the author's labor.

### Copyright Does *Not* Protect Facts

It is easy to find absolute statements in modern treatises on copyright law, and in modern judicial opinions, that copyright does *not* protect facts. Such statements are typically asserted as an absolute rule, with *neither* explanation *nor* justification. It seems presumptuous, and almost iconoclastic, for an attorney to ask *why* copyright law does not protect facts. Nonetheless, it is essential that one understand *why* copyright does not protect facts, before we can understand the nature of copyright protection for compilations of facts. So this is an important question, even if legislators and judges have been unable to supply a clear answer.

Some copyright lawyers and judges apparently use *ideas* and *facts* as synonyms. I see a distinction:

- A. *ideas* refer to theories, hypotheses, and abstractions, which are products of an author's mind
- B. *facts* include measurements, calculations, observations, information, and other descriptions of reality.

## A. U.S. Constitution

As every intellectual property lawyer in the USA knows, the foundation for patents and copyrights is tersely mentioned in the U.S. Constitution that “Congress shall have [the] Power”:

To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries;

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

The first thing is to delete the words that apply to granting patents to inventors:

To promote the Progress of Science . . . , by securing for limited Times to Authors . . . the exclusive Right to their . . . Writings.

U.S. Constitution, Article I, § 8, clause 8, as redacted to focus only on copyright.

*Eldred v. Ashcroft*, 537 U.S. 186, 192-193, 123 S.Ct. 769, 774 (2003).

The second thing is to recognize that language has shifted in the more than 200 years since the U.S. Constitution was written. The word *science* in the 1700s would be *knowledge* in the modern English language.<sup>34</sup> The etymology of the word *science* is from the Latin *scientia*, which means “to know”.

Reading the Constitution, one sees that there are three constitutional conditions on copyright law:

1. the purpose of copyright law is to “promote the Progress” of knowledge, which is a public policy rationale;
2. copyright can *not* be perpetual, but can only be for “limited times”; and
3. copyright owners have an “exclusive right” to copy and publish their writings.

The duration of copyrights is currently specified in 17 U.S.C. § 302; the exclusive rights of copyright owners are currently specified in 17 U.S.C. § 106.

The Constitution grants Congress the power to issue copyrights, but (except for the prohibition against perpetual copyright) the Constitution explicitly provides no limits for the scope or conditions of copyright law. The silence in the Constitution about details makes the Constitution useless as a source of law about originality as a condition for copyright, or whether copyright protects ideas or facts. Actually, the silence in the Constitution about details is the result of a good design, because it gives Congress and the courts flexibility in making copyright relevant to current needs of authors and society.

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<sup>34</sup> See, e.g., Jane C. Ginsburg, “Creation and Commercial Value: Copyright Protection of Works of Information,” 90 COLUMBIA LAW REVIEW 1865, 1876 (Nov 1990); *In re Comiskey*, 554 F.3d 967, 976, n. 9 (Fed.Cir. 2009) (en banc) (“The Supreme Court has concluded that the references to ‘Science’ (i.e., knowledge generally) and ‘Writings’ creates the right to copyright protection .... See *Graham v. John Deere*, 383 U.S. 1, 5 (1966)”).

In passing, let me note that there are several ways that modern copyright law has departed from the literal words of the constitution. One way is that we now allow artistic works, photographs, and sound recordings to be copyrighted, although they are *not* Writings. Another way is that we now allow an employer, under the “work made for hire” doctrine, to register and own a copyright, although the employer is *not* an Author. I have no complaint about these changes, I am simply noting their existence, as evidence of the flexible interpretation of the Constitution given by the U.S. Supreme Court.

#### tangential remarks on purpose of copyright

Having mentioned the Constitution, permit me to go off on a tangent and remark about public policy interpretations. There are two extreme ways to “promote the Progress” of knowledge:

1. **no copyright:** All published writing is in the public domain from the instant it is published, where the writing can be freely copied. This way promotes Progress by maximizing the use of previously published works.
2. **strong copyright:** Having strong copyright protection maximizes financial reward to authors and publishers, and thereby promotes Progress by encouraging creation and publication of new works.

Aside from economic reasons and public policy reasons, I see a very strong moral or ethical argument against no copyright. In a regime of no copyright, it would be legally acceptable for business competitors to pirate a previous author’s labor, skill, and expense. Plagiarism would also be acceptable. Such results are repugnantly unfair to authors of original works.

The two extreme ways in the previous paragraph can be brought closer together, merely by shortening the duration of copyright protection.

There is another rationale for copyright, which rationale is rarely mentioned by judges in the USA. Writings are the personal property of the author. For tangible property (e.g., an automobile), theft deprives the owner of the use of that property, and the crime of larceny and the tort of conversion are available to the rightful owner of that property. But for intellectual property (e.g., copyright on written work), copying does *not* deprive the owner of the use, but may deprive the owner of license fees.

#### B. statute

Copyright law in the USA is statutory, so we turn to the Copyright Act of 1976, which very clearly excludes some types of information from the protection of copyright law:

In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.

17 U.S.C. § 102(b), 90 STATUTES-AT-LARGE at 2545 (enacted 1976, still current Jan 2009).

If copyright law in the USA does not include protection for facts, then why are *facts* omitted from the list in 17 U.S.C. § 102(b)? Is the statute badly written, with this glaring omission?

As explained below, the U.S. Supreme Court first said that copyright does *not* protect facts in 1985, about nine years *after* the Copyright Act of 1976 was enacted.

The legislative history<sup>35</sup> is unhelpful, but does reiterate that copyright only protects original expression, and does not protect the content of nonfictional works.

### C. judicial opinions U.S. Supreme Court

At the heart of the matter, facts can not be copyrighted because judges in the early 1900s said that facts can not be copyrighted. Later judges have given one of two different reasons for this holding:

1. facts should be in the public domain, available for copying by any subsequent author, perhaps because judges believed that facts were part of a common heritage that was freely available to everyone.
2. facts can be discovered or collected, but *not* created<sup>36</sup> (i.e., facts are *not* authored<sup>37</sup>), and copyright only protects expression that was created by authors.

I criticize both of these reasons, beginning at page 42, below. (Incidentally, I have traced the history of the American legal rule that copyright does not protect ideas in a separate essay at <http://www.rbs2.com/cidea.pdf>.)

An 1884 opinion of the U.S. Supreme Court defined author:

An author in that sense is 'he to whom anything owes its origin; originator; maker; one who completes a work of science or literature.' Worcester.

*Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 57-58 (U.S. 1884).

Worcester is the author of a then famous dictionary. This opinion in *Burrow-Giles* did not mention copyright for either ideas or facts.

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<sup>35</sup> U.S. House of Representatives Report Nr. 94-1476 at pages 56-57, reprinted in 1976 U.S. CODE CONGRESSIONAL AND ADMINISTRATIVE NEWS at 5670.

<sup>36</sup> As shown by judicial opinions that are quoted below, this reason was first suggested by Prof. Melville Nimmer in his treatise on copyright law.

<sup>37</sup> Forgive me for using the noun *author* as a verb, but the word *Author* is mentioned in the U.S. Constitution and the word *author* is central to copyright law.

In 1918, the U.S. Supreme Court held that the expression in newspapers could be copyrighted as a literary work, however the facts in the news were not copyrightable:

But the news element — the information respecting current events contained in the literary production — is not the creation of the writer, but is a report of matters that ordinarily are *publici juris*;<sup>38</sup> it is the history of the day. It is not to be supposed that the framers of the Constitution, when they empowered Congress “to promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries” (Const. art. 1, § 8, par. 8), intended to confer upon one who might happen to be the first to report a historic event the exclusive right for any period to spread the knowledge of it.

*International News Service v. Associated Press*, 248 U.S. 215, 234 (1918).

More about this case is found below, beginning at page 64.

In 1985, the U.S. Supreme Court clearly said — apparently for the first time by the Supreme Court — that copyrights do not protect facts:

In addition, no author may copyright facts or ideas. § 102. The copyright is limited to those aspects of the work — termed “expression” — that display the stamp of the author's originality.

*Harper & Row Publishers, Inc. v. Nation Enterprises*, 471 U.S. 539, 547 (U.S. 1985).

This quotation implies that Congress made a mistake in not including *facts* in 17 U.S.C. § 102(b).

In the more than twenty years after *Harper & Row*, the U.S. Congress never bothered to amend § 102(b) to also exclude facts from copyright protection.

The U.S. Supreme Court in *Harper & Row* also said:

The Second Circuit noted, correctly, that copyright's idea/expression dichotomy “strike[s] a definitional balance between the First Amendment and the Copyright Act by permitting free communication of facts while still protecting an author's expression.” [*Harper & Row Publishers, Inc. v. Nation Enterprises*,] 723 F.2d, at 203. No author may copyright his ideas or the facts he narrates. 17 U.S.C. § 102(b). See, e.g., *New York Times Co. v. United States*, 403 U.S. 713, 726, n. , 91 S.Ct. 2140, 2147, n. , 29 L.Ed.2d 822 (1971) (BRENNAN, J., concurring) (Copyright laws are not restrictions on freedom of speech as copyright protects only form of expression and not the ideas expressed); 1 Nimmer § 1.10[B][2]. As this Court long ago observed: “[T]he news element — the information respecting current events contained in the literary production — is not the creation of the writer, but is a report of matters that ordinarily are *publici juris*; it is the history of the day.” *International News Service v. Associated Press*, 248 U.S. 215, 234, 39 S.Ct. 68, 71, 63 L.Ed. 211 (1918).

*Harper & Row*, 471 U.S. at 556.

Incidentally, because the U.S. Supreme Court did not clearly exclude facts from copyright protection until *Harper & Row* in 1985, it is understandable why judges before 1985 might use copyright law to protect the labor, skill, and expense in collecting, verifying, selecting, and arranging those facts.

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<sup>38</sup> *Publici juris* literally means “of public right”. The Court should have said that news is in the public domain, belonging to everyone.



In 1991, the U.S. Supreme Court emphasized that facts were not copyrightable:

The most fundamental axiom of copyright law is that '[n]o author may copyright his ideas or the facts he narrates.' *Harper & Row, Publishers, Inc. v. Nation Enterprises*, 471 U.S. 539, 556, 105 S.Ct. 2218, 2228, 85 L.Ed.2d 588 (1985).

*Feist Publications, Inc. v. Rural Telephone Service Co.*, 499 U.S. 340, 344-345 (1991).

The Court in *Feist* explained:

It is this bedrock principle of copyright that mandates the law's seemingly disparate treatment of facts and factual compilations. "No one may claim originality as to facts." NIMMER ON COPYRIGHT § 2.11[A], p. 2-157. This is because facts do not owe their origin to an act of authorship. 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. To borrow from *Burrow-Giles*, one who discovers a fact is not its "maker" or "originator." 111 U.S., at 58, 4 S.Ct., at 281. "The discoverer merely finds and records." NIMMER § 2.03[E]. Census takers, for example, do not "create" the population figures that emerge from their efforts; in a sense, they copy these figures from the world around them. Denicola, Copyright in Collections of Facts: A Theory for the Protection of Nonfiction Literary Works, 81 COLUM.L.REV. 516, 525 (1981) (hereinafter Denicola). Census data therefore do not trigger copyright because these data are not "original" in the constitutional sense. NIMMER § 2.03[E]. 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*, supra,<sup>39</sup> at 1369.

*Feist Publications, Inc. v. Rural Telephone Service Co.*, 499 U.S. 340, 347-348 (1991).

The Court declared in *Feist*:

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.

*Feist Publications, Inc. v. Rural Telephone Service Co.*, 499 U.S. 340, 350-351 (1991).

The U.S. Supreme Court in *Feist* tersely remarked on the absence of *facts* from the list in 17 U.S.C. § 102(b):

Section 102(b) is universally understood to prohibit any copyright in facts. *Harper & Row*, supra, at 547, 556, 105 S.Ct., at 2223, 2228. Accord, Nimmer § 2.03[E] (equating facts with "discoveries"). As with § 102(a), Congress emphasized that § 102(b) did not change the law, but merely clarified it:

"Section 102(b) in no way enlarges or contracts the scope of copyright protection under the present law. Its purpose is to restate ... that the basic dichotomy between expression and idea remains unchanged."

H.R.Rep., at 57; S.Rep., at 54, U.S.CODE CONG. & ADMIN.NEWS 1976, p. 5670.

*Feist Publications, Inc. v. Rural Telephone Service Co.*, 499 U.S. 340, 356 (1991).

If facts are really "universally understood" as included in § 102(b), then Congress should amend this section to make the statute agree with the U.S. Supreme Court's decisions in copyright law.

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<sup>39</sup> The reference is to *Miller v. Universal City Studios, Inc.*, 650 F.2d 1365, 1369 (5th Cir. 1981), which is quoted below at page 33.

Justice O'Connor in *Feist* was apparently making an attempt to patch a defect in the copyright statute, because dictionaries do **not** list *discoveries* as a synonym for *facts*.

Three years after *Feist*, the U.S. Supreme Court wrote:

The exclusion of facts and ideas from copyright protection serves that goal as well. See [17 U.S.C.] § 102(b) (“In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery ...”); *Feist Publications, Inc. v. Rural Telephone Service Co.*, 499 U.S. 340, 359, 111 S.Ct. 1282, 1294, 113 L.Ed.2d 358 (1991) (“[F]acts contained in existing works may be freely copied”); *Harper & Row, Publishers, Inc. v. Nation Enterprises*, 471 U.S. 539, 547, 105 S.Ct. 2218, 2223, 85 L.Ed.2d 588 (1985) (copyright owner's rights exclude facts and ideas, and fair use).

*Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 575, n.5 (U.S. 1994).

This quotation implies that Congress made a mistake in not including *facts* in 17 U.S.C. § 102(b).

### Early Cases (1913-1960)

By looking at opinions of lower federal courts, one can get a sense of the history of judges declaring there is no copyright on *facts*. In my searches of Westlaw, the earliest expression that facts are not copyrightable seem to be in two opinions of the U.S. District Court in New York City in the year 1913, but these early opinions fail to explain *why* facts are in the public domain.

In the year 1913, Judge Hough in the U.S. District Court in New York City wrote:

Of course, a statement of fact may be protected by copyright against any piracy of the form of statement, because such form may, and often does, display literary effort of merit. But there can be no piracy of the facts, because facts are public property.

*Davies v. Bowes*, 209 F. 53, 55-56 (S.D.N.Y. 1913), *aff'd on different grounds*, 219 F. 178

(2dCir. 1914). This holding was cited with approval in *Collins v. Metro-Goldwyn Pictures Corp.*, 106 F.2d 83, 86 (2dCir. 1939). The absence of a citation to authority in *Davies* may be excused because it was the first case to hold facts are not copyrightable.

In 1913, Judge Manton in the U.S. District Court in New York City wrote:

A poem consists of words, expressing conceptions of words or lines of thoughts; but copyright in the poem gives no monopoly in the separate words, or in the ideas, conception, or facts expressed or described by the words. A copyright extends only to the arrangement of the words. A copyright does not give a monopoly in any incident in a play. Other authors have a right to exploit the facts, experiences, field of thought, and general ideas, provided they do not substantially copy a concrete form, ....

*Eichel v. Marcin*, 241 F. 404, 408-409 (S.D.N.Y. 1913).

Watch out for loaded words like *monopoly*. Even if copyright did protect facts and ideas, a second author could always independently create those facts and ideas and thus avoid the alleged monopoly. Independent creation is a complete defense to copyright infringement, as explained on page 79.

In 1914, a judge in a U.S. District Court in Pennsylvania wrote in dictum:

When a copyrighted book is published and sold, however, something is necessarily given to the purchaser and acquired by the general public. One thing acquired is the fact that the author has expressed certain thoughts. This is a fact in literature of which any one is free to avail himself as he is of any fact made public.

*Ginn & Co v. Apollo Pub Co.*, 215 F. 772, 778 (D.Pa. 1914).

In a 1917 case involving news reporting, defendant claimed that facts were not property, but the U.S. Court of Appeals in New York City rejected that defense:

With the existence of a truth, with physical facts per se, neither plaintiff nor defendant is concerned; for them facts in that absolute sense are but as ore in a mountain or fish in the sea — valueless unless and until by labor mined or caught for use. Nor are facts, even after ascertainment, news, unless they have that indefinable quality of interest, which attracts public attention. Neither is news always synonymous with facts, in the sense of verity; indeed, much news ultimately proves fictitious, yet it is excellent news notwithstanding. The word means no more (laying aside hoaxing and intentional falsehood) than apparently authentic reports of current events of interest.

When one copies a statement from a bulletin, he cannot assert himself to be possessed of any certain fact other than that of his own appropriation. The only fact he knows is that the bulletin maker made an assertion; but he has taken the news, because that is what the bulletin proclaimed, if its maker was skillful in his business.

Whether there is or can be any property in facts per se, any more than there is in ideas or mental concepts, is a metaphysical query that can be laid aside; for there is no doubt, either on reason or authority, that there is a property right in news capable of and entitled to legal protection. [citations omitted]

*Associated Press v. International News Service*, 245 F. 244, 248 (2dCir. 1917).

INS appealed to the U.S. Supreme Court, which then created the tort of unfair competition for misappropriation. See the discussion later in this essay, beginning at page 64.

*The New York Tribune* sued *The Chicago Herald* for copyright infringement of an article published in 1917. The trial court gave a judgment for plaintiff and the U.S. Court of Appeals in Chicago affirmed in a 1921 decision:

It is true that news as such is not the subject of copyright, and so far as concerns the copyright law, whereon alone this action is based, if the *Herald* publication were only a statement of the news which the copyrighted article disclosed, generally speaking, the action would not lie. But in so far as the Edwards article [in the *New York Tribune*] involves authorship and literary quality and style, apart from the bare recital of the facts or statement of news, it is protected by the copyright law. That the entire copyrighted article involves in its production authorship as generally understood, and manifests literary quality and style in striking degree, is impressively apparent from its perusal. While the appropriated portions comprise in perhaps larger degree the salient facts than do the deductions, descriptions, and comments with which the other parts of the copyrighted article more largely deal, they are nevertheless not wholly or strictly confined to recital of mere facts.

*Chicago Record-Herald Co. v. Tribune Ass'n*, 275 F. 797, 798-799 (7thCir. 1921).

The Court in Chicago cited no authority for its statement that news was not copyrightable, in fact the Court cites neither statute nor case anywhere in its opinion!

In 1921, Judge Learned Hand wrote the opinion of the trial court in the *Jeweler's Circular* case:

Any directory is a compilation, without opportunity for variety in the statement of the facts recorded. All are free to repeat those facts, just because they are facts. .... Yet in some way subsequent compilers must be allowed to state the same facts, and the question became what independent work they must do to acquire the requisite knowledge. Every one concedes that a second compiler may check back his independent work they must compilation, but there has been some dispute whether he may use the original compilation after simply verifying its statements, or whether he must disregard the assistance of the original, except in subsequent verification. I do not find it necessary to determine that question in this case, ....

*Jeweler's Circular Pub. Co. v. Keystone Pub. Co.*, 274 F. 932, 935 (S.D.N.Y. 1921) (Learned Hand, J.), *aff'd*, 281 Fed. 83 (2d Cir. 1922), *cert. denied*, 259 U.S. 581 (1922). On appeal, the U.S. Court of Appeals created the "industrious collection" doctrine that was later overruled by the U.S. Supreme Court in *Feist*. See the discussion later in this essay, beginning at page 67.

In 1931, Judge Goddard of the U.S. District Court in New York City wrote:

Also, for instance, no one has an exclusive right to an idea or statement of the law — that a mere idea or fact may not be copyrighted, but that the manner of expressing or illustrating the idea or fact may be protected by copyright.

*Nichols v. Universal Pictures Corporation*, 34 F.2d 145, 147 (S.D.N.Y. 1929), *aff'd*, 45 F.2d 119 (2d Cir. 1930), *cert. den.*, 282 U.S. 902 (U.S. 1931).

In 1937, a federal trial court in New York City wrote:

As courts have repeatedly said, ideas as such are not copyrightable. *Dymow v. Bolton* (C.C.A.2) 11 F.(2d) 690, 691. This is also true of the supposed facts of history which necessarily must be dealt with in a similar manner by all historians.

*Caruthers v. R.K.O. Radio Pictures*, 20 F.Supp. 906, 907 (S.D.N.Y. 1937).

In 1938, the U.S. Court of Appeals in New York City decided a copyright infringement case involving two history textbooks. Plaintiff noticed that errors in his work were copied into defendant's book.

But that only served to show use of the plaintiff's book and not necessarily that what they wrote infringed the copyright, for historical facts are not copyrightable per se nor are errors in fact. The plaintiff's book was designed to convey information to the reader. The defendant authors were as free to read it as anyone else and to acquire from it such information as they could. They could, indeed, with equal right obtain such misinformation as it contained, for the copyright gave no monopoly of the contents of the book. *Arnstein v. Edward B. Marks Music Corp.*, 2 Cir., 82 F.2d 275. And so far as plaintiff's copyright is concerned, they could use whatever of either character they gleaned from the book in their own writing provided they did not copy any substantial part of the copyrighted work but created something distinctly their own.

*Oxford Book Co. v. College Entrance Book Co.*, 98 F.2d 688, 691 (2d Cir. 1938).

In 1939, the U.S. Court of Appeals in New York City decided a copyright case involving a movie that allegedly infringed a book on the same subject.

... the series of events portrayed in the book purports to represent real occurrences which, aside from the form of expression, are not protected by the Copyright Act (17 U.S.C.A. § 1 et seq.). *International News Service v. Associated Press*, 258 U.S. 215, 234, 39 S.Ct. 68, 63 L.Ed. 211, 2 A.L.R. 293; *Davies v. Bowes, D.C.*, 209 F. 53, *affirmed on other grounds*, 2 Cir., 219 F. 178.

*Collins v. Metro-Goldwyn Pictures Corporation*, 106 F.2d 83, 86 (2dCir. 1939).

All of the early cases contain a bald assertion that facts are not copyrightable without any reasons for the assertion and without any citations to authority. Beginning in the mid-1930s, the Second Circuit did provide a few citations. Beginning in the mid-1950s, judges began to provide reasons and citations to justify the assertion that facts are not copyrightable. Of course, what really matters is not the number of citations,<sup>40</sup> but the reason(s) that justify the decision that facts are not copyrightable.

Skipping ahead to the year 1956, a U.S. District Court in California considered a copyright case involving two biographies of Wyatt Earp, the plaintiff's book and the defendant's radio program. The plaintiff shot himself in the foot by declaring in the preface to his book that it was "an accurate historical biography based on a factual account of Wyatt Earp's career and 'in no part a mythic tale.'" <sup>41</sup> By admitting that his book was factual, plaintiff deprived himself of copyright protection for the contents of his book.<sup>42</sup> The District Court dismissed plaintiff's claim, because:

That historical facts and events in themselves are in the public domain and are not entitled to copyright protection (see: *International News Service v. Associated Press*, 1918, 248 U.S. 215, 234, 39 S.Ct. 68, 63 L.Ed. 211; *Collins v. Metro-Goldwyn Pictures Corp.*, 2 Cir., 1939, 106 F.2d 83, 86; *Funkhouser v. Loew's, Inc.*, D.C.W.D.Mo. 1952, 108 F.Supp. 476, 496, *affirmed on other grounds*, 8 Cir., 1953, 208 F.2d 185, *certiorari denied*, 1954, 348 U.S. 843, 75 S.Ct. 64, 99 L.Ed. 664; *Seltzer v. Sunbrock*, D.C.S.D.Cal. 1938, 22 F.Supp. 621, 627; *Caruthers v. R.K.O. Radio Pictures*, supra, 20 F.Supp. at page 907) [.] *Lake v. Columbia Broadcasting System, Inc.*, 140 F.Supp. 707, 708-709 (S.D.Cal. 1956).

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<sup>40</sup> In a system of precedent, there are many situations in which judges simply parrot previous cases, thus propagating law that is either unfair or erroneous.

<sup>41</sup> *Lake v. Columbia Broadcasting System, Inc.*, 140 F.Supp. 707, 708 (S.D.Cal. 1956).

<sup>42</sup> John A. Taylor, "The Uncopyrightability of Historical Matter: Protecting Form Over Substance and Fiction Over Fact," 30 ASCAP COPYRIGHT LAW SYMPOSIUM 33, 44 (1983).

*Greenbie v. Noble* (1957)

A well-known<sup>43</sup> copyright case in 1957 involved a plaintiff who was the author of a biography of a famous woman in Lincoln's cabinet during the Civil War. Plaintiff alleged that defendants had sold another book on the same subject that infringed plaintiff's copyright. Both books used some of the same historical facts. A federal judge in New York City decided there was no infringement. The judge's opinion contains a number of statements about why facts are not copyrightable.

It is well settled that the facts concerning the actual life of an historic character are in the public domain and are not entitled to copyright protection. See *Toksvig v. Bruce Pub. Co.*, 7 Cir., 1950, 181 F.2d 664 (Hans Christian Andersen);<sup>44</sup> *DeAcosta v. Brown*, 2 Cir., 1944, 146 F.2d 408, *certiorari denied [sub nom.] Hearst Magazines v. DeAcosta*, 325 U.S. 862, 65 S.Ct. 1197, 89 L.Ed. 1983 (Clara Barton); *Lake v. Columbia Broadcasting System*, D.C.S.D.Cal., 1956, 140 F.Supp. 707 (Wyatt Earp). However, the fictionalizing of events and incidents in the life of an historic figure is the author's original treatment of the life of such figure and is subject to protection against appropriation by others. ....  
*Greenbie v. Noble*, 151 F.Supp. 45, 65 (S.D.N.Y. 1957).

There is no copyright of facts, news or history. *Oxford Book Co., Inc. v. College Entrance Book Co.*, 2 Cir., 1938, 98 F.2d 688; *Davies v. Bowes*, D.C.S.D.N.Y., 1913, 209 F. 53, *affirmed* 2 Cir., 1914, 219 F. 178; *Lake v. Columbia Broadcasting System, Inc.*, D.C.S.D.Cal., 1956, 140 F.Supp. 707; *Echevarria v. Warner Bros. Pictures, Inc.*, D.C.S.D.Cal., 1935, 12 F.Supp. 632. ....  
*Greenbie v. Noble*, 151 F.Supp. 45, 66 (S.D.N.Y. 1957).

When a book is designed to convey information, a reader is entitled to avail himself of the facts contained therein and may use such information, whether correct or incorrect, in his own literary work, provided that his expression and treatment is distinctly his own and not merely the result of copying from the book. *Oxford Book Co. v. College Entrance Book Co.*, 2 Cir., 1938, 98 F.2d 688. The second author may also adopt the first author's historical ideas and theories since the law of copyright only protects an author's mode of expression and not his ideas. [citations omitted] ....  
*Greenbie v. Noble*, 151 F.Supp. 45, 67 (S.D.N.Y. 1957).

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<sup>43</sup> Although *Greenbie* is a trial court opinion with no precedential value, by Jan 2009, this opinion was cited in more than 45 opinions and more than 40 articles in legal journals.

<sup>44</sup> The *Toksvig* case is discussed below, beginning at page 53.

## U.S. Courts of Appeals (1980-present)

Beginning in 1980, there were a series of opinions in the U.S. Court of Appeals that contained lengthy explanations of why facts are not copyrightable. I quote at length from these important opinions.

*Hoehling* (1980)

In 1980, the U.S. Court of Appeals in New York City wrote a decision on a case involving a novel interpretation of a historical event, the fire and crash of the Hindenburg dirigible.

A grant of copyright in a published work secures for its author a limited monopoly over the expression it contains. The copyright provides a financial incentive to those who would add to the corpus of existing knowledge by creating original works. Nevertheless, the protection afforded the copyright holder has never extended to history, be it documented fact or explanatory hypothesis. The rationale for this doctrine is that the cause of knowledge is best served when history is the common property of all, and each generation remains free to draw upon the discoveries and insights of the past. Accordingly, the scope of copyright in historical accounts is narrow indeed, embracing no more than the author's original expression of particular facts and theories already in the public domain. As the case before us illustrates, absent wholesale usurpation of another's expression, claims of copyright infringement where works of history are at issue are rarely successful.

*Hoehling v. Universal City Studios, Inc.*, 618 F.2d 972, 974 (2dCir. 1980), *cert. den.*, 449 U.S. 841 (U.S. 1980).

To avoid a chilling effect on authors who contemplate tackling an historical issue or event, broad latitude must be granted to subsequent authors who make use of historical subject matter, including theories or plots. Learned Hand counseled in *Myers v. Mail & Express Co.*, 36 C.O.Bull. 478, 479 (S.D.N.Y. 1919), “(t)here cannot be any such thing as copyright in the order of presentation of the facts, nor, indeed, in their selection.” [FN5]

FN5. This circuit has permitted extensive reliance on prior works of history. See, e. g., *Gardner v. Nizer*, 391 F.Supp. 940 (S.D.N.Y. 1975) (the story of the Rosenberg trial not copyrightable); *Fuld v. National Broadcasting Co.*, 390 F.Supp. 877 (S.D.N.Y. 1975) (“Bugsy” Siegel's life story not copyrightable); *Greenbie v. Noble*, 151 F.Supp. 45 (S.D.N.Y. 1957) (the life of Anna Carroll, a member of Lincoln's cabinet, not copyrightable). The commentators are in accord with this view. See, e. g. 1 NIMMER ON COPYRIGHT § 2.11(A) (1979); Chafee, Reflections on the Law of Copyright: I, 45 COLUM.L.REV. 503, 511 (1945).

*Hoehling v. Universal City Studios, Inc.*, 618 F.2d 972, 978 (2dCir. 1980), *cert. den.*, 449 U.S. 841 (U.S. 1980).

The same reasoning governs Hoehling's claim that a number of specific facts, ascertained through his personal research, were copied by appellees.[footnote omitted] The cases in this circuit, however, make clear that factual information is in the public domain. See, e.g.,

*Rosemont Enterprises, Inc.*, supra, 366 F.2d at 309; *Oxford Book Co.*, supra, 98 F.2d at 691. Each appellee had the right to “avail himself of the facts contained” in Hoehling's book and to “use such information, whether correct or incorrect, in his own literary work.” *Greenbie v. Noble*, 151 F.Supp. 45, 67 (S.D.N.Y. 1957). *Hoehling*, 618 F.2d at 979.

The court made clear that verbatim copying of text, including facts, would be copyright infringement.

All of Hoehling's allegations of copying, therefore, encompass material that is non-copyrightable as a matter of law, rendering summary judgment entirely appropriate. We are aware, however, that in distinguishing between themes, facts, and scenes a faire on the one hand, and copyrightable expression on the other, courts may lose sight of the forest for the trees. By factoring out similarities based on non-copyrightable elements, a court runs the risk of overlooking wholesale usurpation of a prior author's expression. A verbatim reproduction of another work, of course, even in the realm of nonfiction, is actionable as copyright infringement. See *Wainwright Securities, Inc. v. Wall Street Transcript Corp.*, 558 F.2d 91 (2d Cir. 1977), cert. denied, 434 U.S. 1014, 98 S.Ct. 730 (1978). Thus, in granting or reviewing a grant of summary judgment for defendants, courts should assure themselves that the works before them are not virtually identical. In this case, it is clear that all three authors relate the story of the Hindenburg differently. *Hoehling*, 618 F.2d at 979-980.

Jane C. Ginsburg, then a lawyer and later a professor of law at Columbia University, wrote a devastating critique of the Court of Appeals opinion in *Hoehling*:

The *Hoehling* court's approach is fundamentally flawed for at least five reasons. First, the court distorted some of the precedent upon which it purported to rely. Second, the court ignored a good deal more precedent. Third, the court's novel augmentation of the “substantial similarity” test into a “wholesale usurpation” test is unwarranted and unnecessary to the court's goal of insuring broad reference to historical theories. Fourth, the *Hoehling* approach displaces the fair use test by, at the outset, eliminating from review many of the factors traditionally relevant to that test. This result was calculated: The court intended to provide an analytical model to facilitate granting summary judgment to defendants on claims alleging infringement of historical works, thus sparing district courts the factual inquiry at full trial which the fair use test requires. Finally, and most important, the court's view of historical “expression” is profoundly misguided. [three footnotes omitted in this paragraph]

Jane C. Ginsburg, “Sabotaging and Reconstructing History: A Comment on the Scope of Copyright Protection in Works of History After *Hoehling v. Universal City Studios*,” 29 JOURNAL OF THE COPYRIGHT SOCIETY OF THE U.S.A. 647, 648 (1982). Ms. Ginsburg argued that “the court could well have decided the cases on the more conventional ground of lack of substantial similarity,” but that would have required a trial to determine facts. *Ibid.* at 651.



*Iowa State Univ. (1980)*

The ABC television network broadcast part of a film biography of a champion wrestler prepared by students at Iowa State University. ABC, like all copyright infringers, claimed fair use, but both the trial court and appellate court disagreed with the fair use. In passing, the U.S. Court of Appeals in New York City noted that facts were not protected by copyright, because of a "public interest in the free flow of information":

ABC possessed an unfettered right to use any factual information revealed in *Champion* for the purpose of enlightening its audience, see *Hoehling v. Universal City Studios, Inc.*, 618 F.2d 972, 979 (2d Cir. 1980); *Meeropol*, supra, 560 F.2d at 1070; *Wainwright Securities, Inc. v. Wall Street Transcript Corp.*, 558 F.2d 91, 95 (2d Cir. 1977), cert. denied, 434 U.S. 1014, 98 S.Ct. 730, 54 L.Ed.2d 759 (1978), but it can claim no need to "bodily appropriate" Iowa's "expression" of that information by utilizing portions of the actual film, *Hoehling*, supra, 618 F.2d at 980; *Rosemont Enterprises, Inc.*, supra, 366 F.2d at 310; *Meeropol*, supra, 560 F.2d at 1070. See generally, 1 NIMMER ON COPYRIGHT § 1.10(B); Gorman, Copyright Protection for the Collection and Representation of Facts, 76 HARV.L.REV. 1569 (1963). The public interest in the free flow of information is assured by the law's refusal to recognize a valid copyright in facts. Cf. *Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562, 569, 97 S.Ct. 2849, 2854, 53 L.Ed.2d 965 (1977) (under state statute analogous to copyright law, television newscast could report fact of performance, but could not broadcast actual event without compensating performer). The fair use doctrine is not a license for corporate theft, empowering a court to ignore a copyright whenever it determines the underlying work contains material of possible public importance.

*Iowa State University Research Foundation, Inc. v. American Broadcasting Companies, Inc.*, 621 F.2d 57, 61 (2d Cir. 1980).

*Miller (1981)*

In 1981, a U.S. Court of Appeals in Florida — in an opinion that anticipated the Supreme Court's 1991 opinion in *Feist* — said that copyright did not protect facts:

It is well settled that copyright protection extends only to an author's expression of facts and not to the facts themselves.[FN1] See, e. g., *Rosemont Enterprises, Inc. v. Random House, Inc.*, 366 F.2d 303, 309 (2d Cir. 1966), cert. denied, 385 U.S. 1009, 87 S.Ct. 714, 17 L.Ed.2d 546 (1967); *Chicago Record-Herald Co. v. Tribune Association*, 275 F. 797, 798-99 (7th Cir. 1921); *Alexander v. Haley*, 460 F.Supp. 40, 45 (S.D.N.Y. 1978); *Lake v. Columbia Broadcasting System*, 140 F.Supp. 707, 708-09 (S.D.Cal. 1956). This dichotomy between facts and their expression derives from the concept of originality which is the premise of copyright law. Under the Constitution, copyright protection may secure for a limited time to "Authors ... the exclusive Right to their respective Writings." U.S.Const. Art. I, s 8, cl. 8. An "author" is one "to whom anything owes its origin; originator; maker; one who completes a work of science or literature." *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 58, 4 S.Ct. 279, 281, 28 L.Ed. 349 (1884). Obviously, a fact does not originate with the author of a book describing the fact. Neither does it originate with one who "discovers" the fact.

“The discoverer merely finds and records. He may not claim that the facts are ‘original’ with him although there may be originality and hence authorship in the manner of reporting, i. e., the ‘expression,’ of the facts.”

1 M. Nimmer, NIMMER ON COPYRIGHT § 2.03(E), at 2-34 (1980). Thus, since facts do not owe their origin to any individual, they may not be copyrighted and are part of the public domain available to every person.

FN1. Similarly, a copyright protects only the expression of ideas and not the ideas. The idea-expression dichotomy was given express statutory recognition in the 1976 Copyright Act. Section 102(b) provides: “In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such a work.” 17 U.S.C.A. § 102(b).

*Miller v. Universal City Studios, Inc.*, 650 F.2d 1365, 1368-69 (5thCir. 1981).

Ten years later, *Miller* was cited with approval by the U.S. Supreme Court in *Feist*, which brought *Miller* into the mainstream of law.

#### *Harper & Row* (1983)

After quoting 17 U.S.C. § 102(b), the Court of Appeals tersely wrote:

One reasonable interpretation of the word “discovery” in the statute is “fact.” For example, an historian who learns in his research that a certain event occurred has discovered a fact. See 1 Nimmer on Copyright § 2.11[A], at 2-157 (1983).

*Harper & Row Publishers, Inc. v. Nation Enterprises*, 723 F.2d 195, 202, n.7 (2dCir. 1983), *rev'd on other grounds*, 471 U.S. 539 (1985). I quote the Supreme Court in this case at page 24, above.

#### *Eckes* (1984)

In 1984, the U.S. Court of Appeals in New York City heard a copyright infringement case involving a book that listed values for collectable baseball cards. Both the trial court and the appellate court agreed that the book was protected by copyright, and the appellate court held that there was infringement by defendant. The case was subsequently cited by the Second Circuit as their leading case on copyright of compilations of fact.<sup>45</sup>

Copyright law and compilations are uneasy bedfellows since “the very vocabulary of copyright law is ill suited to analyzing property rights in works of nonfiction.” Denicola, Copyright in Collections of Facts: A Theory for Protection of Nonfiction Literary Works, 81 COLUM.L.REV., 516 (1981). Indeed, while this court has recognized that the “distinction

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<sup>45</sup> *Financial Information, Inc. v. Moody's Investors Service, Inc.*, 808 F.2d 204, 207 (2dCir. 1986). *Eckes* has been cited by the Second Circuit in more than a dozen cases, including *Matthew Bender v. West Publ.*, 158 F.3d 674, 681, 689 (2dCir. 1998).

between fact and expression is not always easy to draw,” *Harper & Row Publishers, Inc.*,<sup>46</sup> supra, 723 F.2d at 203, we have been particularly restrictive in the protection of non-fiction works indicating, for example, that the fruits of another's labor in lieu of independent research obtained through the sweat of a researcher's brow, does not merit copyright protection absent, perhaps, wholesale appropriation. See *Hoehling*, supra, 618 F.2d at 979; *Rosemont Enterprises Inc. v. Random House, Inc.*, 366 F.2d 303, 310 (2d Cir. 1966), cert. denied, 385 U.S. 1009, 87 S.Ct. 714, 17 L.Ed.2d 546 (1967); See also *Miller v. Universal City Studios Inc.*, 650 F.2d 1365, 1371-72 (5th Cir. 1981); 1 M. Nimmer, NIMMER ON COPYRIGHT § 3.04, at 3-16-16.1 (1983)(criticizing notion that fruits of original research are protectible but noting that original selection of public domain materials may itself be protectible). But see, e.g., *Schroeder v. William Morrow & Co.*, 566 F.2d 3, 6 (7th Cir. 1977); *Rand McNally v. Fleet Management Systems*, [591 F.Supp. 726], 2 Copyright L.Rep. (CCH) ¶ 25,624, at 18,804-06 (N.D.Ill. December 31, 1983); *National Business Lists, Inc. v. Dunn & Bradstreet, Inc.*, 552 F.Supp. 89, 91-95 (N.D.Ill. 1982).

Nevertheless, our cases do not hold that subjective selection and arrangement of information does not merit protection. In fact, the definition of a compilation in the Act, 17 U.S.C. § 101 (“selected, coordinated, or arranged”) (emphasis added), the commentators, see, e.g., 1 M. Nimmer, supra, § 2.04[B], at 2-41-2 (“originality involved in the selection and/or arrangement of such facts” protected literary work) (footnote omitted) (emphasis added); Denicola, supra, at 530 (“originality in plaintiff's selection or choice of data”; Denicola, however, believes that the labor in compiling facts is protected) (emphasis in original), and the cases, see, e.g., *Roy Export Co. v. Columbia Broadcasting System, Inc.*, 672 F.2d 1095, 1103 (2d Cir.), cert. denied, 459 U.S. 826, 103 S.Ct. 60, 74 L.Ed.2d 63 (1982); *Dow Jones & Co. v. Board of Trade*, 546 F.Supp. 113, 116 (S.D.N.Y. 1982), suggest that selectivity in including otherwise nonprotected information can be protected expression. In *Roy Export*, supra, the plaintiff's selection of unprotected Charlie Chaplin film clips constituted a protectible original creative work. Similarly, in *Dow Jones & Co.*, supra, the court found that plaintiff's “subjective judgment and selectivity involved in determining” which stocks it would list made the list a copyrightable compilation.

We have no doubt that appellants exercised selection, creativity and judgment in choosing among the 18,000 or so different baseball cards in order to determine which were the 5,000 premium cards. Accordingly, we believe that the Guide merits protection under the copyright laws.

*Eckes v. Card Prices Update*, 736 F.2d 859, 862-863 (2d Cir. 1984). In *Eckes*, the U.S. Court of Appeals found copyright infringement by defendant.

It is unusual to see a court openly admit being “particularly restrictive in the protection of non-fiction works”, in the way that the Second Circuit did in *Eckes*. The weaker copyright protection for nonfiction works comes, of course, from courts refusal to protect facts.

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<sup>46</sup> The Court of Appeals decision in *Harper & Row* was later reversed by the U.S. Supreme Court, 471 U.S. 539 (1985), however the Supreme Court did say “... the distinction between literary form and information or ideas is often elusive in practice.” 471 U.S. at 582-583.

*Financial Information* (1986)

In 1986, the U.S. Court of Appeals in New York City reiterated that permitting copyright on facts themselves would “threaten the public’s unrestrained access to information”:

Facts may not be copyrighted. The Copyright Act of 1976 does, however, expressly provide for the protection of “compilations,” which are defined as works “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.” 17 U.S.C. § 101 (1982).

Our leading case on the copyrightability of compilations is *Eckes v. Card Prices Update*, 736 F.2d 859 (2d Cir. 1984). ....

At the outset in *Eckes*, we noted our well-established reluctance to grant copyright protection to works of non-fiction — chiefly on the ground that facts may not be copyrighted. See *id.* at 862; *Hoehling v. Universal City Studios, Inc.*, 618 F.2d 972, 979 (2d Cir.), *cert. denied*, 449 U.S. 841, 101 S.Ct. 121, 66 L.Ed.2d 49 (1980); *Rosemont Enterprises, Inc. v. Random House, Inc.*, 366 F.2d 303, 310 (2d Cir. 1966), *cert. denied*, 385 U.S. 1009, 87 S.Ct. 714, 17 L.Ed.2d 546 (1967). See also *Harper & Row Publishers, Inc. v. Nation Enterprises*, 471 U.S. 539, 105 S.Ct. 2218, 2224, 85 L.Ed.2d 588 (1985) (copyright protects only the expression of facts, not the facts themselves). We stated in *Eckes* that “we have been particularly restrictive in the protection of non-fiction works indicating, for example, that the fruits of another's labor in lieu of independent research obtained through the sweat of a researcher’s brow, does not merit copyright protection absent, perhaps, wholesale appropriation.” *Eckes*, *supra*, 736 F.2d at 862. The statute thus requires that copyrightability not be determined by the amount of effort the author expends, but rather by the nature of the final result. To grant copyright protection based merely on the “sweat of the author's brow” would risk putting large areas of factual research material off limits and threaten the public's unrestrained access to information.

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

In *Financial Information*, the judges declared their “well-established reluctance to grant copyright protection to works of non-fiction”. It’s a step backwards from “restrictive protection” in *Eckes* — or “thin” protection for compilations of facts in *Feist* five years after *Financial Information* — to “reluctance” to grant any copyright protection to nonfiction works. I am appalled at this open hostility of judges to protecting nonfiction works.

*Worth* (1987)

In 1987, two years after the U.S. Supreme Court decided *Harper & Row*, a U.S. Court of Appeals in California wrote:

It is clear, then, that the use of the factual content in *Worth*’s books does not constitute infringement. “The discovery of a fact, regardless of the quantum of labor and expense, is simply not the work of an author.” 1 M. Nimmer, *supra*, § 2.11[E], at 2-169. The verbatim repetition of certain words in order to use the nonprotectible facts is also noninfringing; the game cards' repetition of words used by *Worth* to describe places, persons, and events

constitutes “mere indispensable expression” of particular facts or ideas. See *Frybarger*, 812 F.2d at 530 (emphasis in original). If we were to hold otherwise, we would, in effect, extend copyright protection to the facts contained in Worth’s books. See *Landsberg*, 736 F.2d at 489 (noting that because of the unavoidable expression required to restate the nonprotectible ideas in plaintiff’s work, a finding of infringing similarity of expression would effectively grant a copyright in the work’s nonprotectible ideas).

*Worth v. Selchow & Righter Co.*, 827 F.2d 569, 573 (9th Cir. 1987),  
*cert. den.*, 485 U.S. 977 (1988).

*Sega v. Accolade* (1992)

The year after the U.S. Supreme Court decided *Feist*, the U.S. Court of Appeals for the Ninth Circuit explained why fictional works have stronger copyright protection than factual works:

Works of fiction receive greater protection than works that have strong factual elements, such as historical or biographical works, *Maxtone-Graham*, 803 F.2d at 1263 (citing *Rosemont Enterprises, Inc. v. Random House, Inc.*, 366 F.2d 303, 307 (2d Cir. 1966), *cert. denied*, 385 U.S. 1009, 87 S.Ct. 714, 17 L.Ed.2d 546 (1967)), or works that have strong functional elements, such as accounting textbooks, *Baker*, 101 U.S. at 104. Works that are merely compilations of fact are copyrightable, but the copyright in such a work is “thin.” *Feist Publications*, 499 U.S. at 349, 111 S.Ct. at 1289.

*Sega Enterprises Ltd. v. Accolade, Inc.*, 977 F.2d 1510, 1524 (9th Cir. 1992).

*Sparaco* (2002)

A land surveyor, Albert Sparaco, sued an engineering firm and others for using his site plan to design a building in violation of his copyright and also of a written contract. The trial court held that some defendants did not infringe plaintiff’s copyright and granted summary judgment to those defendants. *Sparaco*, 60 F.Supp.2d 247 (S.D.N.Y. 1999).

On appeal, Sparaco argued that copying “the existing physical characteristics of the site” and “proposals for physical improvements to the site” from a map was prohibited by copyright law. Judge Leval of the Second Circuit, a recognized expert on copyright law, wrote a historical review of the law:

Sparaco’s argument would have had considerable force at an earlier time in the development of the copyright law. Since the eighteenth century, the copyright statutes have explicitly named maps as falling within their protection. See, e.g., Copyright Act of May 31, 1790, ch. 15, § 1, 1 Stat. 124, 124 (1790) (repealed 1831) (providing that the “authors of any map [or] chart ... shall have the sole right and liberty of printing, reprinting, publishing and vending such map [or] chart ...”); see also 1 Patry [COPYRIGHT LAW & PRACTICE] at 247 (noting that copyright protection of maps enjoys a “venerable pedigree”). Copyright’s early protection of factual information found justification in the author’s labor or “sweat of the brow” in assembling and creating a work. In 1845, Justice Story explained that the maker of a map was protected against copying; another was free to map the same region but was not free to copy information set forth on the first map; he needed to rely on his own labor, skill, and expense to make a second independently conceived map. *Emerson v. Davies*, 8 F. Cas. 615, 619 (C.C.D.Mass. 1845); see also *Farmer v. Calvert Lithographing, Etc., Co.*, 8 F.

Cas. 1022, 1026 (No. 4,651) (C.C.E.D.Mich. 1872) (in a case alleging infringement of map of Wisconsin and parts of nearby states, noting that “no one has the right to avail himself of the enterprise, labor and expense of another in the ascertainment of those materials, and the combining and arrangement of them, and the representing them on paper”); *Blunt v. Patten*, 3 F. Cas. 763, 765 (C.C.S.D.N.Y. 1828) (No. 1580) (copyright in navigation chart is violated “when another copies from the chart of him who has secured the copyright, and thereby availing himself of his labor and skill”); see also David B. Wolf, Is There any Copyright Protection for Maps after Feist?, 39 J. COPYRIGHT SOC'Y U.S.A. 224, 227-28 (1992) (observing that historically copyright's protection of maps derived from the “sweat of the brow” doctrine — which justified protection on the grounds of “the physical effort exerted to get the raw data needed for the map”); Jane C. Ginsburg, Creation and Commercial Value: Copyright Protection of Works of Information, 90 COLUM. L.REV. 1865, 1875 (1990) (noting that American and English copyright decisions in the eighteenth and nineteenth centuries “characterized copyrightable authorship in terms of the labor invested in the work”); Robert A. Gorman, Copyright Protection for the Collection and Representation of Facts, 76 HARV. L.REV. 1569, 1572 (1963) (“It is no doubt true that most of the early cases dealing with map copyright referred to the requirement of original effort in exploring, surveying, making inquiries, and drafting the map solely on the basis of one's own investigations.”).

However, in its twentieth century development, copyright law turned away from that view. Courts began to repudiate the earlier notion that an author's labor in discovering facts justified giving the author protection against the copying of those facts. See, e.g., *Int'l News Serv. v. Associated Press*, 248 U.S. 215, 234, 39 S.Ct. 68, 63 L.Ed. 211 (1918) (denying copyright protection to factual information contained within a newspaper article). The view developed that historical, scientific, or factual information belongs in the public domain, and that allowing the first publisher to prevent others from copying such information would defeat the objectives of copyright by impeding rather than advancing the progress of knowledge. See U.S. Const. art. I, § 8, cl. 8 (assigning Congress the power “[t]o promote the Progress of Science and useful Arts ...”); see also *Hoehling v. Univ. City Studios, Inc.*, 618 F.2d 972, 979 (2d Cir. 1980) (holding that historical facts are not protected by copyright); *Miller v. Univ. City Studios, Inc.*, 650 F.2d 1365, 1372 (5th Cir. 1981) (criticizing sweat of the brow justification for copyright). In *Feist Publications, Inc. v. Rural Telephone Service Company*, 499 U.S. 340, 347-48, 111 S.Ct. 1282, 113 L.Ed.2d 358 (1991), the Supreme Court further explained that copyright protection can extend only to original authorship, and that the publication of facts, regardless how much effort was expended in discovering them, is not original authorship. The facts set forth in an author's writing were not created by an author's act of authorship, and are therefore not protected by copyright. [*Feist*] at 348, 111 S.Ct. 1282.

To the extent that the site plan sets forth the existing physical characteristics of the site, including its shape and dimensions, the grade contours, and the location of existing elements, it sets forth facts; copyright does not bar the copying of such facts. See [*Feist*] at 350-51, 111 S.Ct. 1282 (“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.”); see generally Pierre N. Leval, An Assembly of Idiots?, 34 CONN. L.REV. 1049, 1056-58 (2002).

*Sparaco v. Lawler, Matusky, Skelly, Engineers LLP*, 303 F.3d 460, 465-467 (2d Cir. 2002), cert. den., 538 U.S. 945 (2003)

*Int'l News Serv. v. Associated Press (INS)* is discussed later in this essay, beginning at page 64. Here it is only important to say that Judge Leval in *Sparaco* was wrong to characterize *INS* as “denying copyright protection”, because the plaintiff in *INS* admittedly had no copyright in its news articles. *INS* is an equity jurisprudence case, not a copyright case, and any statements in *INS* about copyright are only dicta. However, it is true that judges in the 1910s began to recognize that facts in news were not copyrightable, as the above-quoted cases in this essay show.

The Second Circuit affirmed the trial court’s decision about the copyright claims about the “existing factual information about the site”, 303 F.3d at 467, but reversed the trial court’s summary judgment about the proposed plan for changes to the site, 303 F.3d at 468-469. On remand, the trial court granted summary judgment on all remaining claims, *Sparaco*, 313 F.Supp.2d 247 (S.D.N.Y. 2004), because plaintiff had settled his contract claim and received \$ 7000 in compensation, so he could not receive compensation again from a copyright claim.

*NY Mercantile Exch. (2007)*

In 2007, a U.S. Court of Appeals wrote a summary of why copyright does not protect facts:

In contrast, “facts do not owe their origin to an act of authorship. 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.” *Feist*, 499 U.S. at 347, 111 S.Ct. 1282. “[A]ll facts-scientific, historical biographical, and news of the day ... may not be copyrighted and are part of the public domain available to every person.” *Id.* at 348, 111 S.Ct. 1282 (internal quotation marks omitted). As Professor Nimmer explains in his leading copyright treatise:

The “discoverer” of a scientific fact as to the nature of the physical world, an historical fact, a contemporary news event, or any other “fact,” may not claim to be the “author” of that fact .... The discoverer merely finds and records. He may not claim that the facts are “original” with him, although there may be originality and hence, authorship in the manner of reporting, i.e., the “expression,” of the facts. As copyright may only be conferred upon “authors,” it follows that ... discoveries as facts per se may not be the subject of copyright.

1-2 Melville B. Nimmer & David Nimmer, *NIMMER ON COPYRIGHT* § 2.03[E] (2006) (“Nimmer”) (internal footnote call numbers omitted). [Plaintiff] concedes, and indeed it is “universally understood,” that if a settlement price is a fact, it cannot be copyrighted. *Feist*, 499 U.S. at 344, 111 S.Ct. 1282.

*New York Mercantile Exchange, Inc. v. Intercontinental Exchange, Inc.*, 497 F.3d 109, 114 (2dCir. 2007).

## other Courts of Appeals cases

There are other opinions of the U.S. Courts of Appeals that recognize that facts are not copyrightable, of which the following cases are particularly notable:

- *Applied Innovations, Inc. v. Regents of the University of Minnesota*, 876 F.2d 626, 636 (8th Cir. 1989) (“Copyright protection does not extend to ideas or facts in published works.”);
- *Warren Pub., Inc. v. Microdos Data Corp.*, 115 F.3d 1509 (11th Cir. 1997) (en banc).

## D. commentators on protection for facts

I searched an online copy of a classic treatise on copyright law, written by Eaton S. Drone and published in 1879. Despite the 824 page length of this book, there was no mention of copyright of facts. The only mention of copyright of ideas is one footnote.<sup>47</sup> This lack of mention suggests to me that the concern about copyright of ideas or facts came sometime after 1879.

I searched an online copy of another classic treatise on copyright law, written by Arthur W. Weil and published in 1917. Despite the 985 page length of this book, there were only a few terse mentions of copyright of either *idea(s)* or *facts*. Weil cites only the U.S. Supreme Court case, *Kalem v. Harper Bros.*, 222 U.S. 55, for the proposition that there is no copyright for ideas.<sup>48</sup> Later, Weil says, without any reasons and without any citation to authority:

There can be no copyright in ideas, as such, but only in their mode of expression. Ideas themselves, from their very nature, have been deemed free.  
Arthur W. Weil, *AMERICAN COPYRIGHT LAW*, p. 189, § 497 (1917). Weil cites two cases in the United States for the proposition that there is no copyright for facts.<sup>49</sup> These terse statements and few citations by Weil suggest to me that no copyright protection for ideas or facts was a recent development in 1917 and not yet well established, although Weil seems to accept the rule.

In my reading in a law library in preparation for writing this essay, I found an article about the origin of the doctrine that copyright does not protect ideas. Mr. Collins<sup>50</sup> said the doctrine comes from copyright law permitting *unauthorized* translations, abridgements, or other derivative works during the 1800s. The Copyright Act of 1909 changed the law, so that unauthorized derivative

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<sup>47</sup> Eaton S. Drone, *A TREATISE ON THE LAW OF PROPERTY IN INTELLECTUAL PRODUCTIONS*, at p. 427, n. 1 (1879).

<sup>48</sup> Arthur W. Weil, *AMERICAN COPYRIGHT LAW*, pp. 66-67, n. 44, §§ 155-156 (1917).

<sup>49</sup> Weil, *op. cit.*, at p. 193, n.7, § 508 (*Tribune Co. of Chicago v. Associated Press*, 116 F. 126); p. 314, n. 97, § 797 (*Davies v. Boes*, 209 F. 53).

<sup>50</sup> Charles B. Collins, “Some Obsolescent Doctrines of the Law of Copyright,” 1 *SOUTHERN CALIFORNIA LAW REVIEW* 127 (Jan 1928).



works afterwards were infringements of copyrights. Collins argued that copyright law should protect ideas. It seems to me that even if uncopyrightability of ideas was used in the 1800s to justify unauthorized derivative works, the doctrine of uncopyrightability of ideas might continue to be valid for other reasons, such as making ideas part of the public domain.

In a landmark article published in 1963, a young lawyer, who was later a professor of law, recognized that the rule that copyright does not protect facts would seriously limited copyrights in maps, reports of news, directories, advertisements, and photographs. His concerns became reality 28 years later in the U.S. Supreme Court decision in *Feist*.

At the outset, however, it must be recognized that the law of copyright, which avowedly protects expression only, may not be the ideal vehicle for the protection of facts works, the value of which is generally attributed to the labor they embody rather than their mode of expression. Where it is clear that it is labor, effort, and expense that is sought to be protected, the most apt body of protective principles might be found in that branch of the law of unfair competition dealing with misappropriation.

Robert A. Gorman, "Copyright Protection for the Collection and Representation of Facts," 76 HARVARD LAW REVIEW 1569, 1571 (June 1963). On pages 1577, 1581, 1583, and 1588, Gorman repeats that facts can *not* be copyrighted, because they are in the public domain. He traced the origin of this legal rule to cases involving publications of news by journalists and nonfiction history.

In addition to the brief quotations from Nimmer in the above-cited judicial opinions, NIMMER ON COPYRIGHT says:

No one may claim originality as to facts. Facts may be discovered, but they are not created by an act of authorship. One who discovers an otherwise unknown fact may well have performed a socially useful function, but the discovery as such does not render him an "author" in either the constitutional or statutory sense.

Melville B. Nimmer, NIMMER ON COPYRIGHT, § 2.11 [A] (1983).

This quotation from Nimmer was quoted with approval in

*Warren Pub., Inc. v. Microdos Data Corp.*, 115 F.3d 1509, 1524 (11thCir. 1997) (en banc);

*Thompson v. Looney's Tavern Productions, Inc.*, 204 Fed.Appx. 844, 849 (11thCir. 2006);

*Houts v. Universal City Studios, Inc.*, 603 F.Supp. 26, 28 (D.C.Cal. 1984);

*Peckarsky v. American Broadcasting Co., Inc.*, 603 F.Supp. 688, 694, n.11 (D.C.D.C. 1984).

Professor Raskind characterized the distinction between discovering facts and creating facts as "strained" and "contrary to the philosopher's characterization of the scientific method," and "empty of analytical content for copyright purposes."<sup>51</sup>

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<sup>51</sup> Leo J. Raskind, "Assessing the Impact of *Feist*," 17 UNIVERSITY OF DAYTON LAW REVIEW 331, 336 (Winter 1992).

### why some facts should be protected by copyright

Above, beginning at page 23, I mentioned that some judges have said that facts are not created. The judges are wrong in the context of:

1. making mathematical calculations<sup>52</sup>
2. doing a scientific experiment in a laboratory
3. a mapmaker who either surveys land or who analyses aerial/satellite photographs *creates* facts, but a mapmaker who copies from an earlier map does *not* create facts.

In at least these three situations, people create facts (i.e., knowledge) that did not previously exist. However, anyone (e.g., a journalist, biographer, historian) who collects information that was personally observed by someone else is *not* engaged in creating facts. This distinction between (a) creating facts and (b) reporting facts observed by others can be used to maintain the common law of not protecting facts in either news reports or biographies.

While it may seem obvious that facts in current events should *not* be protected by copyright, not all facts are easy to report. An investigative journalist might work for months on one story, and then report facts that were hidden from the public. I don't know any simple way to distinguish such laborious investigative journalism from simple reporting of a public event, such as an automobile wreck or a speech by a politician.

If a historian or archeologist digs at a historical site, sifts through the dirt, and finds, for example, cartridge cases and bullets from a battle, then that person is creating facts about items and their location. If the historian or archeologist removes the items from the site, no one else will be able to make these discoveries, giving the original historian or archeologist a de facto monopoly on discoveries, without any application of copyright law or unfair competition law. This example shows that monopolies often occur in spite of judicial public policy to keep ideas and facts free. Another example of a de facto monopoly is when an astronomer observes an event that only occurs once, such as the explosion of a supernova — subsequent astronomers can not go back in time and independently observe the phenomenon. Inadequate financial support for scholarly research places additional restraints on the ability of scholars to independently verify discoveries and facts. These practical considerations show that it is an illusion for judges to pretend that *all* facts are in the public domain, free for investigation by anyone.

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<sup>52</sup> For example, Milton Abramowitz and Irene A. Stegun, HANDBOOK OF MATHEMATICAL FUNCTIONS, 1046 pp., U.S. National Bureau of Standards (1964) is full of facts that were created as the result of laborious computations.

While it is sometimes true that an author does not create facts,<sup>53</sup> that conclusion misses the point. In exchange for public display or publication of a newly discovered fact, society should reward the discoverer for a limited time, by analogy with patent and copyright law, if not by application of copyright law. Conventional copyright law, with its dogma that facts are not copyrightable, ignores the importance of discovering and revealing facts, so that society can use those facts. If the discoverer of a fact keeps the fact a secret, Progress is *not* promoted. And if the rewards of copyright law do not apply to discoverers of facts, there may be fewer discoveries of facts and fewer collections of facts, so Progress is *not* promoted.

The discussion by judges and legal commentators about facts being in the public domain *assumes* that the facts are already publicly available, so that the facts can be used. But someone had to spend the labor, skill, and expense to discover or create the fact, verify it, and be the first to publish the fact. And that someone ought to be rewarded by copyright law. Furthermore, copyright law should reward not only publication of novel facts, but also publication of useful collections of facts, especially when the author of the collection spent effort to independently verify the facts.

Many judges (see, e.g., *Rosemont*, at page 54 below, and *Hoehling*, at page 31 above) have remarked on the desirability of freely allowing subsequent authors to copy facts that were previously published. But it is *not* Progress to merely copy old facts, because copying facts adds nothing to our knowledge.<sup>54</sup> But it could be Progress to make an independent investigation into facts, and perhaps either uncover facts that were overlooked by previous researchers or find errors<sup>55</sup> in old so-called facts. I think a better public policy would require authors to independently collect and verify facts, instead of blindly copy facts.

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<sup>53</sup> A scientist doing an experiment or making a calculation *does* create facts, but a journalist does *not* create the facts in his/her report.

<sup>54</sup> Roy V. Jackson, “‘Fact Works’: Copyrightability and Infringement,” 45 JOURNAL OF THE PATENT OFFICE SOCIETY 833, 842 (Dec 1963) (“... for only by independently carrying out another abstracting process can the second author possibly create a work that is different, and therefore that is of additional value to society.”); Jane C. Ginsburg, “Sabotaging and Reconstructing History: A Comment on the Scope of Copyright Protection in Works of History After *Hoehling v. Universal City Studios*,” 29 JOURNAL OF THE COPYRIGHT SOCIETY OF THE U.S.A. 647, 661 (1982) (“A second author who simply repeats ..., without contributing anything new, has done nothing more for the progress of knowledge than has the first propounder. There is therefore little social interest in completely unrestricted access to copying of historical interpretations, be they true or false. [footnote omitted]”).

<sup>55</sup> Dennis S. Karjala, “Copyright and Misappropriation,” 17 UNIV. OF DAYTON LAW REVIEW 885, 911, n. 89 (Spring 1992).

Any concern about creating a monopoly on facts is relieved by explicitly recognizing a fair use of a few facts. More than forty years ago, Prof. Gorman recognized that copyright protection should extend to what is now called low-authorship works (e.g., maps, compilations of facts, etc.):

A much fairer method of securing the same object [facts are in the public domain] would be to grant copyright as in other areas [i.e., high-authorship works] of the law, but to adopt a very narrow standard of infringement. That way, others will be permitted to make free and fair use of the copyrighted materials, but the mapmaker will be protected against those who would purposely pirate his efforts as a means to competitive gain. ....

... the grant of a monopoly on the compiler's particular chart or table does not bar others from making the same calculations; it merely prevents others from copying directly. The monopoly is therefore of little prejudice to the public interest.

Robert A. Gorman, "Copyright Protection for the Collection and Representation of Facts," 76 HARVARD LAW REVIEW 1569, 1575 (June 1963).

Furthermore, having copyright protection for low-authorship works might encourage the publication of novel facts, instead of an author keeping them secret, to exploit privately.

I believe that the doctrine of fair use — plus the doctrine that independent creation is *never* infringement, as explained at page 79 below — is ample protection against creating a monopoly on facts. Prof. Ginsburg has suggested an additional protection in the form of a compulsory license for the use of facts.<sup>56</sup> I prefer to invalidate the copyright on facts if the copyright owner attempts to misuse the copyright, instead of having a compulsory license at some artificial rate that interferes with the free market, and also probably fails to adequately reward the author for his/her labor, skill, and expense.

Because the rule that copyright does *not* protect facts is approximately ninety years old, most specialists in copyright law are comfortable with that rule, because they have never used a different rule, and because the rule does not affect copyright for fictional works. Nonetheless, the rule — in my opinion — was a mistake, and continues to cause problems.

If we return to the U.S. Constitution's foundation for copyright law, the purpose of copyright is to promote Progress in knowledge. It is difficult for me to see how copyright for fictional works promotes knowledge — fictional works are of cultural significance, while only nonfiction works contribute to knowledge. In this way, I see potential in the Constitution for giving fictional works a second-class copyright, and a first-class copyright to nonfictional works. But I don't want to see a second-class copyright for any work that has value to our society, whether cultural or knowledge. But this analysis shows that there is no basis in the Constitution to give nonfiction works a second-class copyright.

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<sup>56</sup> Jane C. Ginsburg, "Creation and Commercial Value: Copyright Protection of Works of Information," 90 COLUMBIA LAW REVIEW 1865, 1924-1936 (Nov 1990).

## denigration of facts/ideas

A judge tersely discussed the history of copyright law in the USA from 1790 to 1902:

Little by little copyright has been extended to the literature of commerce, so that it now includes books that the old guild of authors would have disdained; catalogues, mathematical tables, statistics, designs, guide-books, directories, and other works of similar character. *National Telegraph News Co. v. Western Union Telegraph Co.*, 119 Fed. 294, 297 (7thCir. 1902). Quoted in *Leon v. Pacific Telephone & Telegraph Co.*, 91 F.2d 484, 486 (9thCir. 1937) (N.B., *Leon* was overruled on other grounds by *Feist*); and *Oxford University Press, NY v. U S.*, 33 C.C.P.A. 11, 18, 1945 WL 4002 (Cust. & Pat.App. 1945).

This shows the reaction of humanists to scholarly works in applied mathematics, such as mathematical tables. Such factual works are “disdained” by humanists and compared to vulgar commercial catalogues, instead of being recognized as a genuine intellectual achievement.

It seems that copyright law was written by humanities graduates, who were mostly interested in protecting poetry, fictional writing, and drama. I say this because there is strong protection for such fictional works, and weak — or nonexistent — protection for original writing in areas of mathematics, science, engineering, and even production of maps. Because humanities graduates do not read — and can not understand — technical publications in mathematics, science, or engineering, they do not realize the importance of protecting innovation in those areas.<sup>57</sup>

The first copyright statute was enacted in 1790. At that time, there were few scholarly, professional publications being written in the USA. A quick search of major law journals and scientific journals shows that many of these old journals began publication around the year 1890, when copyright law in the USA was already one hundred years old.<sup>58</sup> This is a historical reason for why the needs of mathematics, science, and engineering were neglected by copyright law.

Because most legislators in the U.S. Congress, as well as most federal judges, were educated in the humanities — *neither* mathematics, science, *nor* engineering — they never thought about protecting nonfiction works. Similarly, most mathematicians, scientists, or engineers were *unaware* of, or *unconcerned* about, defects in copyright law, so they did not complain in a way that would motivate Congress to change the statute. So the weaker protection for nonfiction works continued from the 1910s to the current time.

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<sup>57</sup> See, e.g., Charles P. Snow, *THE TWO CULTURES*, Cambridge University Press (1959).

<sup>58</sup> *SCIENCE*, the journal of the American Association for the Advancement of Science, began publication in 1880. *PHYSICAL REVIEW*, now a major journal for physicists, began publication in 1893. *HARVARD LAW REVIEW* began publication in 1887, and the *YALE LAW JOURNAL* began in 1891. The American Institute of Electrical Engineers (which merged into the IEEE in 1963) began publication of its *TRANSACTIONS* in 1884.

## Copyright Protects "Labor"?

What does copyright protect? The answer is simple: copyright protects "original works of authorship." 17 U.S.C. § 102(a). "The sine qua non of copyright is originality." *Feist Publications, Inc. v. Rural Telephone Service Co., Inc.*, 499 U.S. 340, 345 (1991).

So how does an author write an original work? Anyone familiar with the art and process of writing knows that authors need to have skill (in order to produce something that someone would want to copy) and authors need to expend intellectual labor. There is a long line of judicial opinions in the USA, going back to the year 1828, that say that copyright protects *labor*. I think the judges should have said was that copyright rewards the *intellectual labor* that is necessary for producing an original work of authorship. This intellectual labor itself is economically valuable, when it produces a copyrightable work for which either:

1. the author's employer will pay the author a salary,
2. a commercial publisher will agree not only to publish the work but also to pay royalties to the author,
3. the government or a nonprofit corporation will give a grant or contract to the author (or to the author's employer) to enable the creation of the work, or
4. people who read the work refer other people to the work, increasing the reputation of the original author.

Here is a list of some significant cases that explicitly stated that copyright protected or rewarded either labor or effort. I have included most of the U.S. Supreme Court opinions that mention the words *copyright* and either *labor* or *effort* in the same sentence, plus some of the opinions in the U.S. Courts of Appeal. I have included a few quotations from federal trial courts before the year 1900, to show the earliest history.

- *Blunt v. Patten*, 3 F.Cas. 762, 763 (C.C.N.Y. 1828) (Map maker had a valid copyright as "a proper reward for his labor provided by law, and ... the plaintiff ... had a right to the results of his labors and surveys.");
- *Shaw v. Cooper*, 32 U.S. 292, 302-303 (U.S. 1833) ("The statute of Massachusetts securing copyrights (before the federal Union) begins with a preamble, declaring that 'no property is more peculiarly a man's own, than that which is produced by the labor of his mind.' 1 Dane's Abr. 527.");

- *Folsom v. Marsh*, 9 F.Cas. 342, 345 (C.C.Mass. 1841) (Story, J.)<sup>59</sup> (“There must be real, substantial condensation of the materials, and intellectual labor and judgment bestowed thereon; and not merely the facile use of the scissors; or extracts of the essential parts, constituting the chief value of the original work.” At 347: “It would be a strange thing to say, that a compilation involving so much expense, and so much labor to the editor, in collecting and arranging the materials, might be pirated and republished by another bookseller, perhaps to the ruin of the original publisher and editor.”);
- *Emerson v. Davies*, 8 F.Cas. 615, 619 (C.C.Mass. 1845) (Story, J.) (“A man has a right to a copyright in a translation upon which he has bestowed his time and labor. .... A man has a right to the copy-right of a map of a state or country, which he has surveyed or caused to be compiled from existing materials, at his own expense, or skill, or labor,<sup>60</sup> or money. .... He, in short, who by his own skill, judgment and labor, writes a new work, and does not merely copy that of another, is entitled to a copy-right therein; if the variations are not merely formal and shadowy, from existing works.”);
- *Atwill v. Ferrett*, 2 F.Cas. 195, 197-198 (C.C.N.Y. 1846) (“... to constitute one an author, he must, by his own intellectual labor applied to the materials of his composition, produce an arrangement or compilation new in itself.”);
- *Farmer v. Calvert Lithographing, Engraving & Map Pub. Co.*, 8 F.Cas. 1022, 1026 (C.C.Mich. 1872) (“But no one has the right to avail himself of the enterprise, labor and expense of another in the ascertainment of those materials, and the combining and arrangement of them, and the representing them on paper.”)<sup>61</sup>;
- *Lawrence v. Cupples*, 15 F.Cas. 25, 25 (C.C.Mass. 1875) (“... the author, by his copyright, only protects himself from a piracy of his own labors by a copy from his publication, but cannot exclude others from publishing similar maps or charts from their own surveys, or similar directories or catalogues, the result of their own labors and compilations, without copying the copyrighted publication or availing themselves of the labors of the author or compiler.”);
- *Schuberth v. Shaw*, 21 F.Cas. 738, 739 (C.C.Pa. 1879) (“The maker of an abridgement, translation, dramatization, digest, index or concordance of a work of which he is not the author, may obtain a copyright for the product of his labor, thought and skill.”);

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<sup>59</sup> Joseph Story was a justice of the U.S. Supreme Court who wrote some famous opinions on copyright law while “riding circuit” (i.e., being a temporary judge in a U.S. Circuit Court). While a justice of the U.S. Supreme Court, he wrote famous books on constitutional law, conflict of laws, and equity jurisprudence.

<sup>60</sup> This appears to be the first case to mention the trilogy of items that judges have repeatedly said are protected by copyright: labor, skill, and expense. This same trilogy was later also included in the unfair competition cases.

<sup>61</sup> Quoted, but rejected, in *Sparaco v. Lawler, Matusky, Skelly, Engineers LLP*, 303 F.3d 460, 466 (2dCir. 2002) (Plaintiff’s “argument would have had considerable force at an earlier time in the development of the copyright law.”).

- *In re Trade-Mark Cases*, 100 U.S. 82, 94 (U.S. 1879) (“And while the word writings may be liberally construed, as it has been, to include original designs for engravings, prints, etc., it is only such as are original, and are founded in the creative powers of the mind. The writings which are to be protected are the fruits of intellectual labor, embodied in the form of books, prints, engravings, and the like.”)<sup>62</sup>;
- *Banks v. Manchester*, 128 U.S. 244, 253 (U.S. 1888) (“The question is one of public policy, and there has always been a judicial consensus, from the time of the decision in the case of *Wheaton v. Peters*, 8 Pet. 591, that no copyright could, under the statutes passed by congress, be secured in the products of the labor done by judicial officers in the discharge of their judicial duties.”);
- *Callaghan v. Myers*, 128 U.S. 617, 647 (U.S. 1888) (Author can have a copyright “which will cover the matter which is the result of his intellectual labor.”);
- *Higgins v. Keuffel*, 140 U.S. 428, 431 (U.S. 1891) (“This provision [the copyright clause in the U.S. Constitution] evidently has reference only to such writings and discoveries as are the result of intellectual labor.”);
- *Simms v. Stanton*, 75 F. 6, 9-10 (C.C.Cal. 1896) (“In other words, if such use is made of a previous work as to substantially diminish its value, or the labors of the original author are, to a material degree, appropriated by another, such use or appropriation is then deemed sufficient in point of law to support a suit for infringement of copyright. [cites four cases and a legal encyclopedia]”);
- *Mead [Callaghan & Co.] v. West Pub. Co.*, 80 F. 380, 387 (C.C.Minn. 1896) (“There is no doubt that the authors in these or similar cases are entitled to copyright to preserve to themselves the benefits resulting from their labors.”);
- *J.L. Mott Iron Works v. Clow*, 82 F. 316, 318 (7thCir. 1897) (“That only such writings and discoveries are included as are the result of intellectual labor; that the term ‘writings’ may be liberally construed to include designs for engraving and prints that are original, and are founded in the creative powers of the mind, — the fruits of intellectual labor; that prints upon a single sheet might be considered a book, if it otherwise met the spirit of the constitutional provision; that, to be entitled to a copyright, the article must have, by and of itself, some value as a composition, at least to the extent of serving some purpose other than as a mere advertisement or designation of the subject to which it is attached.”);
- *Howell v. Miller*, 91 F. 129, 138 (6thCir. 1898) (“Upon like grounds we are of opinion that Howell was entitled to have copyrighted his volumes of Annotated Statutes, and that such copyright covers all in his books that may fairly be deemed the result of his labors.”);

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<sup>62</sup> Quoted with approval in *Feist*, 499 U.S. at 346.



- *International News Service v. Associated Press*, 248 U.S. 215, 239 (U.S. 1918) (“... defendant ... is taking material that has been acquired by complainant as the result of organization and the expenditure of labor, skill, and money, and which is salable by complainant for money, and that defendant in appropriating it and selling it as its own is endeavoring to reap where it has not sown ....”);
- *Fox Film Corp. v. Doyal*, 286 U.S. 123, 127 (U.S. 1932) (“The sole interest of the United States and the primary object in conferring the monopoly lie in the general benefits derived by the public from the labors of authors.”)<sup>63</sup>;
- *Echevarria v. Warner Bros. Pictures*, 12 F.Supp. 632, 634 (D.C.Cal. 1935) (“The right which the copyright law protects differs in no respect from any other form of personal property in the protection which the common law throws about it. Its basis is the right to every one to the fruit of his labor. These principles are adverted to merely for the purpose of emphasizing the foundation upon which the law of copyright is based.”);
- *Amsterdam v. Triangle Publications*, 93 F.Supp. 79, 82 (D.Pa. 1950) (“However, the presentation of information available to everybody, such as is found on maps, is protected only when the publisher of the map in question obtains originally some of that information by the sweat of his own brow. Almost anybody could combine the information from several maps onto one map, but not everybody can go out and get that information originally and then transcribe it into a map.”), *aff’d*, 189 F.2d 104, 106 (3dCir 1951) (“We find ourselves in complete accord with the views thus expressed by Judge Bard.”);
- *Mazer v. Stein*, 347 U.S. 201, 219 (U.S. 1954) (“The economic philosophy behind the clause empowering Congress to grant patents and copyrights is the conviction that encouragement of individual effort by personal gain is the best way to advance public welfare through the talents of authors and inventors in ‘Science and useful Arts.’ Sacrificial days devoted to such creative activities deserve rewards commensurate with the services rendered.”)<sup>64</sup>;
- *Benny v. Loew's Inc.*, 239 F.2d 532, 536 (9thCir. 1956) (“... it is generally held that if he appropriate the fruits of another's labors, without alteration, and without independent research, he violates the rights of the copyright owner.”), *aff’d by an equally divided court sub nom., Columbia Broadcasting System, Inc. v. Loew's Inc.*, 356 U.S. 43 (1958).

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<sup>63</sup> Quoted with approval in: *U.S. v. Paramount Pictures*, 334 U.S. 131, 158 (U.S. 1948); *Twentieth Century Music Corp. v. Aiken*, 422 U.S. 151, 156 (U.S. 1975); *Sony Corp. of America v. Universal City Studios, Inc.*, 464 U.S. 417, 429, 432 (U.S. 1984).

<sup>64</sup> Quoted with approval in *Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562, 576 (U.S. 1977); *Harper & Row, Publishers, Inc. v. Nation Enterprises*, 471 U.S. 539, 558 (U.S. 1985); *New York Times Co., Inc. v. Tasini*, 533 U.S. 483, 495, n.3 (U.S. 2001); *Eldred v. Ashcroft*, 537 U.S. 186, 212, n. 18, 214 (U.S. 2003).

- *Orgel v. Clark Boardman Co.*, 301 F.2d 119, 120 (2dCir. 1962) (“Appropriation of the fruits of another's labor and skill in order to publish a rival work without the expenditure of the time and effort required for independently arrived at results is copyright infringement. [citing *West Publishing Co. v. Edward Thompson Co.*, 176 F. 833, 838 (2dCir. 1910)]”),<sup>65</sup> *cert. denied*, 371 U.S. 817 (1962);
- *Donald v. Zack Meyer's T.V. Sales & Serv.*, 426 F.2d 1027, 1029 (5th Cir. 1970) (“Thus a work may be protected by copyright even though it is based on a prior copyrighted work or something already in the public domain if the author, through his skill and effort, has contributed a distinguishable variation from the older works. [citations omitted]”), *cert. denied*, 400 U.S. 992 (1971);
- *Twentieth Century Music Corp. v. Aiken*, 422 U.S. 151, 156 (U.S. 1975) (“The immediate effect of our copyright law is to secure a fair return for an ‘author's’ creative labor. But the ultimate aim is, by this incentive, to stimulate artistic creativity for the general public good.”)<sup>66</sup>;
- *Rohauer v. Killiam Shows, Inc.*, 551 F.2d 484, 487 (2dCir. 1977) (“Doubtless aware, even in those simpler days, that new versions of copyrighted works might involve a degree of intellectual effort and expense quite as great as or considerably greater than the contribution of the author of the underlying work, Congress provided that derivative works ....”);
- *Wainwright Securities, Inc. v. Wall St. Transcript Corp.*, 558 F.2d 91, 96 (2dCir. 1977) (“... [defendant] appropriated almost verbatim the most creative and original aspects of the reports, the financial analyses and predictions, which represent a substantial investment of time, money and labor.”);
- *Sony Corp. of America v. Universal City Studios, Inc.*, 464 U.S. 417, 450 (U.S. 1984) (“The purpose of copyright is to create incentives for creative effort.”).
- *Apple Barrel Productions, Inc. v. Beard*, 730 F.2d 384, 388 (5thCir. 1984) (Just as with any song or dance submitted alone, a collection of non-copyrightable material may qualify for protection if original skill and labor is expended in creating the work.)<sup>67</sup>;
- *Harper & Row v. Nation Enterprises*, 471 U.S. 539, 556-557 (U.S. 1985) (“... copyright assures those who write and publish factual narratives ... that they may at least enjoy the right to market the original expression contained therein as just compensation for their investment. Cf. *Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562, 575, 97 S.Ct. 2849, 2857, 53 L.Ed.2d 965 (1977)”).

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<sup>65</sup> Quoted in *Schroeder v. William Morrow & Co.*, 566 F.2d 3, 6 (7thCir. 1977); *Marcus v. Rowley*, 695 F.2d 1171, 1176, n.7 (9thCir. 1983).

<sup>66</sup> Quoted with approval in *Harper & Row, Publishers, Inc. v. Nation Enterprises*, 471 U.S. 539, 546, 558 (U.S. 1985).

<sup>67</sup> Quoted with approval in *M. Kramer Mfg. Co., Inc. v. Andrews*, 783 F.2d 421, 438 (4thCir. 1986).

- *Weissmann v. Freeman*, 868 F.2d 1313, 1324 (2dCir. 1989) (“Dr. Freeman stood to gain recognition among his peers in the profession and authorship credit with his attempted use of Weissmann’s article; he did so without paying the usual price that accompanies scientific research and writing, that is to say, by the sweat of his brow. Particularly in an academic setting, profit is ill-measured in dollars. Instead, what is valuable is recognition because it so often influences professional advancement and academic tenure.”);
- *Stewart v. Abend*, 495 U.S. 207, 218 (U.S. 1990) (“See Bricker, *Renewal and Extension of Copyright*, 29 S.CAL.L.REV. 23, 27 (1955) (‘The renewal term of copyright is the law’s second chance to the author and his family to profit from his mental labors.’)”);

cases after *Feist*

- *New Kids on the Block v. News Am. Publishing*, 971 F.2d 302, 307 n. 6 (9th Cir. 1992) (“The copyright holder has a property interest in preventing others from reaping the fruits of his labor, not in preventing the authors and thinkers of the future from making use of, or building upon, his advances.”)<sup>68</sup>;
- *National Rifle Ass'n of America v. Handgun Control Federation of Ohio*, 15 F.3d 559, 561 (6thCir. 1994) (“Copyrights provide an incentive for the creation of works by protecting the owner’s use of his or her intellectual creation, allowing creators to reap the material rewards of their efforts.”);
- *American Geophysical Union v. Texaco Inc.*, 60 F.3d 913, 927 (2dCir. 1994) (“The publishers in turn incur the costs and labor of producing and marketing authors’ articles, driven by the prospect of capturing the economic value stemming from the copyrights in the original works, which the authors have transferred to them.”);
- *New York Times Co., Inc. v. Tasini*, 533 U.S. 483, 495, n.3 (2001) (“Congress’ adjustment of the author/publisher balance is a permissible expression of the ‘economic philosophy behind the [Copyright Clause],’ i.e., ‘the conviction that encouragement of individual effort [motivated] by personal gain is the best way to advance public welfare.’ *Harper & Row, Publishers, Inc. v. Nation Enterprises*, 471 U.S. 539, 558, 105 S.Ct. 2218, 85 L.Ed.2d 588 (1985) (quoting *Mazer v. Stein*, 347 U.S. 201, 219, 74 S.Ct. 460, 98 L.Ed. 630 (1954)).”);
- *Eldred v. Ashcroft*, 537 U.S. 186, 212, n. 18 (U.S. 2003) (“Rewarding authors for their creative labor and ‘promot[ing] ... Progress’ are thus complementary; as James Madison observed, in copyright ‘[t]he public good fully coincides ... with the claims of individuals.’ THE FEDERALIST No. 43, p. 272 (C. Rossiter ed. 1961).”);
- *Brilliance Audio, Inc. v. Hights Cross Communications, Inc.*, 474 F.3d 365, 373 (6thCir. 2007) (“The limited monopoly created by copyright law is needed to promote the creation of new works and ensure that the creator is properly compensated for this effort.”).

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<sup>68</sup> Quoted with approval in *Atari Games Corp. v. Nintendo of America Inc.*, 975 F.2d 832, 843 (Fed.Cir. 1992).

This long line of cases, which continues after the U.S. Supreme Court decision in *Feist*, shows that copyright does reward the fruits of intellectual labor. More than ten U.S. Supreme Court opinions mention protecting an author's labor, and *Feist* ignored that rich history of the desirability of protecting an author's labor in order to promote Progress. Nonetheless, the plain reading of the U.S. Supreme Court's opinion in *Feist* is that opinion killed copyright protection for labor, skill, and expense of authors:

*Feist* teaches that substantial effort alone cannot confer copyright status on an otherwise uncopyrightable work.

*Computer Associates Intern., Inc. v. Altai, Inc.*, 982 F.2d 693, 711 (2dCir. 1992).

In 2006, U.S. Court of Appeals in Alabama quoted a trial court in New York City:

“Notwithstanding that enormous effort and great expense may have been required to discover factual information, it may, nonetheless, be freely taken from the original writer's copyrighted work and republished at will without need of permission or payment. [*Rosemont*, 366 F.2d at 309-310.]” *Craft v. Kobler*, 667 F.Supp. 120, 123 (S.D.N.Y. 1987).

*Thompson v. Looney's Tavern Productions, Inc.*, 204 Fed.Appx. 844, 849 (11thCir. 2006).

In 2008, a U.S. Court of Appeals in Utah wrote:

... we do not for a moment seek to downplay the considerable amount of time, effort, and skill that went into making Meshwerks' digital wire-frame models. But, in assessing the originality of a work for which copyright protection is sought, we look only at the final product, not the process, and the fact that intensive, skillful, and even creative labor is invested in the process of creating a product does not guarantee its copyrightability. See *Feist*, 499 U.S. at 359-60, 111 S.Ct. 1282; Howard B. Abrams, LAW OF COPYRIGHT § 2:8 (“Even if the *process* is both expensive and intricate, an exact or near-exact duplicate of an original should not qualify for copyright.”) (emphasis added); ....

*Meshwerks, Inc. v. Toyota Motor Sales U.S.A., Inc.*, 528 F.3d 1258, 1268 (10thCir. 2008).

On reflection, it seems that judges — who were *not* experts in copyright law — confused (1) copyright, which protects original expression, and (2) unfair competition, which remedies unjust enrichment of a defendant who merely copies, thereby exploiting the labor and skill of the plaintiff. In many cases, these two distinct legal theories overlap, so a correct *result* can be obtained on either theory.

*Toksvig*

One of the major cases to involve the issue of an author's effort involved an author, Toksvig, who wrote a biography of Hans Christian Andersen, the author of famous books for children. Toksvig spent *three years* doing research for his book, including traveling to Denmark to read original letters of Andersen in the Danish language and interviewing people who knew Andersen.<sup>69</sup> The defendant-author, Hubbard, who was ignorant of the Danish language, spent less than a year writing her book, and simply copied two dozen passages from Toksvig's book. Toksvig sued the publisher and author of the second book for copyright infringement. The trial court awarded both \$1000 damages plus \$500 in attorney's fees to Toksvig and the U.S. Court of Appeals affirmed. The trial court's opinion is not in Westlaw. The defendants did not appeal to the U.S. Supreme Court.

The defendants, like most copyright infringers, argued — amongst other defenses — that their copying from Toksvig's book was fair use. The U.S. Court of Appeals rejected that alleged defense:

The question is not whether Hubbard could have obtained the same information by going to the same sources, but rather did she go to the same sources and do her own independent research? In other words, the test is whether the one charged with the infringement has made an independent production, or made a substantial and unfair use of the complainant's work. *Nutt v. National Institute, Inc.*, 2 Cir., 31 F.2d 236, 237.

From this record it is clear that Hubbard obtained much value from the use in her work of many of the original concepts and ideas of plaintiff as to Andersen and his relationship with other persons as expressed in plaintiff's book, and since Hubbard could not read Danish, the use of the specific passages enabled her to finish her book in less than one-third the time that it took plaintiff. In this situation we cannot hold that the use made by Hubbard of plaintiff's book was a fair use and not an infringement. *Toksvig v. Bruce Publishing Co.*, 181 F.2d 664, 667 (7thCir. 1950).

Note that *Toksvig* never said that historical facts were protected by copyright,<sup>70</sup> although later commentators and judges seem to believe that *Toksvig* protected facts. My reading of *Toksvig* is that Hubbard copied too much valuable text from Toksvig.<sup>71</sup> Similarly, *Toksvig* never explicitly says that labor of the original author is protected by copyright law, although one sentence quoted

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<sup>69</sup> The facts of this case are from *Toksvig*, 181 F.2d 664, 666 (7thCir. 1950).

<sup>70</sup> I searched for the word *fact* in the online text of *Toksvig* in Westlaw.

<sup>71</sup> Robert A. Gorman, "Fact or Fancy: The Implications for Copyright," 29 Journal of the Copyright Society of the USA 560, 589, n. 85 (1982) ("The *Toksvig* decision ... ought best be understood to hold, as its language clearly states, that the defendant there had infringed by copying too much from too many of the Andersen letters in the plaintiff's copyrighted English translation."). When Gorman calls protecting efforts in research and translation "unsound", I disagree with Gorman, although I admit that such protection is not authorized by the copyright statute.

above implies such protection. Conventional copyright law prohibits copying that is in excess of fair use, and judges are free to use any relevant information in determining fair use.

Despite my admiration for *Toksvig*, which incidentally also upholds the strong moral lesson we would expect from a children's story, I recognize that this case *may* be outside the mainstream of copyright law in the USA. But, to the extent that *Toksvig* is out of the mainstream, it is — in my opinion — because of defects in copyright law, not because the judges in *Toksvig* made an error. The result in *Toksvig* is fair and just, and the reasoning is sound.

#### criticism of *Toksvig*

The following cases in the U.S. Courts of Appeal have discussed *Toksvig*.

In 1966, the U.S. Court of Appeals in New York City criticized *Toksvig*:

... the [trial] court asserted in sweeping language that an author is not entitled to utilize the fruits of another's labor in lieu of independent research and relying on *Toksvig v. Bruce Publishing Co.*, 181 F.2d 664 (7th Cir. 1950), stated that such activity could not be considered a fair use. Moreover, the court assigned the 'apparent lack of independent research' as an additional reason for refusing to honor defendant's fair use claim. With this conclusion we disagree as a matter of law.

In *Toksvig v. Bruce Publishing Co.*, *supra*, the Seventh Circuit affirmed the grant of an injunction, in favor of an author who had written a careful biography of Hans Christian Andersen based on exhaustive research into Danish sources, against the publication of a subsequent biography of Andersen by an author who due to his inability to speak or read Danish had not independently examined the Danish sources and who had copied twenty-four specific passages of the first author's book. While the decision can be considered to rest on the ground that substantial and material copying was demonstrated, see Nimmer, COPYRIGHT at 133n. 576 (1964), the court went on to say that the use of plaintiff's book was not a fair use for the reason that reliance on the English translations of the Danish sources enabled the defendant to complete her book in much less time than it took plaintiff. *Id.* at 667. We, however, cannot subscribe to the view that an author is absolutely precluded from saving time and effort by referring to and relying upon prior published material. Cf. *Oxford Book Co. v. College Entrance Book Co.*, 98 F.2d 688 (2d Cir. 1938). It is just such wasted effort that the proscription against the copyright of ideas and facts, and to a lesser extent the privilege of fair use, are designed to prevent. See Gorman, Copyright Protection for the Collection and Representation of Facts, 76 HARV.L.REV. 1569, 1584 (1963) (criticizing *Toksvig v. Bruce Publishing Co.*, *supra*).

*Rosemont Enterprises, Inc. v. Random House, Inc.*, 366 F.2d 303, 310 (2d Cir. 1966), *cert. den.*, 385 U.S. 1009 (1967).

The opinion in *Rosemont* will certainly appeal to lazy authors who want to copy facts from an earlier source, instead of doing an independent investigation. The court in *Rosemont* denigrates independent research into facts as "wasted effort". But does *Rosemont* really promote the Progress<sup>72</sup> of knowledge? It's *not* Progress to merely copy old facts, because copying facts adds

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<sup>72</sup> See the U.S. Constitution, discussed at page 21, above.

nothing to our knowledge. But it could be Progress to make an independent investigation into facts, and perhaps either uncover facts that were overlooked by previous researchers or find errors in old so-called facts. I think a better public policy would require authors to independently collect and verify facts, instead of blindly copy facts. However, *Rosemont* takes the view that copying is easier, and that is “Progress”. The U.S. Supreme Court in *Feist* quoted with approval the remark in *Rosemont* about independent research being “wasted effort”. *Feist*, 499 U.S. at 354.

However, in the paragraph immediately following the above-quoted paragraph, *Rosemont* forbids “extensive verbatim copying or paraphrasing” and says:

The point simply is that ‘the second historian or second directory publisher cannot bodily appropriate the research of his predecessor.’ *Huie v. National Broadcasting Co.*, 184 F.Supp. 198, 200 (S.D.N.Y. 1960).

*Rosemont Enterprises, Inc. v. Random House, Inc.*, 366 F.2d 303, 310 (2dCir. 1966).

Incidentally, the real reason for the decision in *Rosemont* might be the court’s disapproval of Howard Hughes’ attempts to suppress an unauthorized biography of him.<sup>73</sup>

In 1977, a U.S. Court of Appeals in California found nothing objectionable in *Toksvig*:

Similarly, the facts about a historical figure are available to all to use. But if the expression of those facts in a biography is substantially copied infringement will be found. See, e. g., *Toksvig v. Bruce Publishing Co.*, 181 F.2d 664 (7 Cir. 1950); *Marvin Worth Productions v. Superior Films Corp.*, 319 F.Supp. 1269 (S.D.N.Y. 1970); *Holdredge v. Knight Publishing Corp.*, 214 F.Supp. 921 (C.D.Cal. 1963).

*Sid & Marty Krofft Television Productions, Inc. v. McDonald Corp.*, 562 F.2d 1157, 1170 (9thCir. 1977).

In 1980, the U.S. Court of Appeals in New York City said their earlier opinion in *Rosemont* had “repudiated” *Toksvig*:

The same reasoning governs Hoehling's claim that a number of specific facts, ascertained through his personal research, were copied by appellees.[footnote omitted] The cases in this circuit, however, make clear that factual information is in the public domain. See, e. g., *Rosemont Enterprises, Inc.*, supra, 366 F.2d at 309; *Oxford Book Co.*, supra, 98 F.2d at 691. Each appellee had the right to “avail himself of the facts contained” in Hoehling's book and to “use such information, whether correct or incorrect, in his own literary work.” *Greenbie v. Noble*, 151 F.Supp. 45, 67 (S.D.N.Y. 1957). Accordingly, there is little consolation in relying on cases in other circuits holding that the fruits of original research are copyrightable. See, e.g., *Toksvig v. Bruce Publications Corp.*, 181 F.2d 664, 667 (7th Cir. 1950); *Miller v. Universal City Studios, Inc.*, 460 F.Supp. 984 (S.D.Fla. 1978). Indeed, this circuit has clearly repudiated *Toksvig* and its progeny. In *Rosemont Enterprises, Inc.*, supra, 366 F.2d at 310, we refused to “subscribe to the view that an author is absolutely precluded from saving time and effort by referring to and relying upon prior published material. . . . It is just such wasted effort that the proscription against the copyright of ideas and facts . . . are designed to prevent.” Accord, 1 NIMMER ON COPYRIGHT § 2.11 (1979).

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<sup>73</sup> Christopher Hill, “Copyright Protection for Historical Research: A Defense of the Minority View,” 31 ASCAP COPYRIGHT LAW SYMPOSIUM 45, 48, n. 12 (1984).

*Hoehling v. Universal City Studios, Inc.*, 618 F.2d 972, 979 (2dCir. 1980), *cert. den.*, 449 U.S. 841 (U.S. 1980).

I am not sure to which cases the progeny in “*Toksvig* and its progeny” refers.<sup>74</sup> Aside from *Toksvig* itself, the Second Circuit in *Hoehling* only cites one other case, *Miller*, which is a District Court opinion that was reversed after the opinion in *Hoehling* was written. While *Toksvig* seems to suggest that copyright protects labor of authors in their research, *Toksvig* reached its result because the second author copied too much valuable text from *Toksvig*’s book, instead of doing her own, original scholarly investigation.

As an example of the kind of law that would really protect the labor, skill, and expense of authors, consider a now rejected<sup>75</sup> view of a U.S. District Court in Florida:

The law is clear that research can be copyrightable. *Toksvig v. Bruce Publishing Co.*, 181 F.2d 664 (7th Cir. 1950); *Leon v. Pacific Telephone & Telegraph Co.*, 91 F.2d 484, 486 (9th Cir. 1937); *H. C. Wainwright & Co. v. Wall Street Transcript Corp.*, 418 F.Supp. 620, 623 (S.D.N.Y. 1976); *Southwestern Bell Telephone Co. v. Nationwide Independent Directory Service, Inc.*, 371 F.Supp. 900, 905 (W.D.Ark. 1974); *Huie v. National Broadcasting Co.*, 184 F.Supp. 198, 200 (S.D.N.Y. 1960); but see *Rosemont Enterprises, Inc. v. Random House, Inc.*, 366 F.2d 303, 309-310 (2nd Cir. 1966).<sup>76</sup>

The court views the labor and expense of the research involved in the obtaining of those uncopyrightable facts to be intellectually distinct from those facts and more similar to the expression of the facts than to the facts themselves. The Second Circuit said that the distinction in copyright between the expression of an idea and the idea is an attempt “to reconcile two competing interests: rewarding an individual’s ingenuity and effort while at the same time permitting the nation to benefit from further improvements or progress resulting from others’ use of the same subject matter.” *Reyher v. Children’s Television Workshop*, 533 F.2d 87, 90 (2nd Cir. 1976).

Obviously the same competing principles have resulted in the development of the distinction between the expression of a fact and the fact. As it is necessary to reward the effort and ingenuity involved in giving expression to a fact, it is necessary also, if we are to expect individuals to labor on our behalf, to reward the effort and ingenuity involved in obtaining knowledge of the fact. It further appears to the court that other individuals are not deprived of the opportunity of obtaining knowledge of facts by one individual’s copyright of his research of those facts and that therefore the nation may still benefit from further improvements or progress resulting from other individuals’ use of those facts. Judge Learned Hand said it best:

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<sup>74</sup> The “progeny” in this context suggests that judges are applying *Toksvig* like some kind of insidious disease, and an epidemic is spreading. The truth is that the few U.S. Courts of Appeal decisions that cite *Toksvig* have been critical of its holding. And the issue of copying plaintiff’s laborious research is surprisingly rare in copyright infringement litigation.

<sup>75</sup> This District Court opinion was not only reversed on appeal, but the general concept of protecting the labor of authors was definitely killed by the U.S. Supreme Court decision in *Feist*.

<sup>76</sup> Two of these cases cited by the District Court — *Leon* and *Southwestern Bell* — were telephone directory cases that were later overruled by the U.S. Supreme Court in *Feist*.



Any subsequent person is, of course, free to use all works in the public domain as sources for his compositions. .... But there is no reason in justice or law why he should not be compelled to resort to the earlier works themselves, or why he should be free to use the composition of another, who himself has not borrowed. If he claims the rights of the public, let him use them; he picks the brains of the copyright owner as much, whether his original composition be old or new. The defendant's concern lest the public should be shut off from the use of works in the public domain is therefore illusory; no one suggests it. That domain is open to all who tread it; not to those who invade the closes of others, however similar.

*Fred Fisher, Inc. v. Dillingham*, 298 F. 145, 150 (S.D.N.Y. 1924).

To this court it doesn't square with reason or common sense to believe that Gene Miller [plaintiff] would have undertaken the research involved in writing of 83 HOURS TILL DAWN (or to cite another more famous example, that Truman Capote would have undertaken the research required to write IN COLD BLOOD) if the author thought that upon completion of the book a movie producer or television network could simply come along and take the profits of the books and his research from him. In the age of television "docudrama" to hold other than research is copyrightable is to violate the spirit of the copyright law and to provide to those persons and corporations lacking in requisite diligence and ingenuity a license to steal.

*Miller v. Universal City Studios, Inc.*, 460 F.Supp. 984, 987-988 (D.Fla. 1978), *rev'd*, 650 F.2d 1365, 1370-1372 (5thCir. 1981).

In reversing the District Court in *Miller*, a U.S. Court of Appeals in Florida wrote:

Although most circuits apparently have not addressed the question, the idea that historical research is copyrightable was expressly rejected by the Second Circuit in the more soundly reasoned case of *Rosemont Enterprises, Inc. v. Random House, Inc.*, 366 F.2d 303 (2d Cir. 1966), *cert. denied*, 385 U.S. 1009, 87 S.Ct. 714, 17 L.Ed.2d 546 (1967). .... We find the approach taken by the Second Circuit in *Hoehling* and *Rosemont* to be more consistent with the purpose and intended scope of protection under the copyright law than that implied by *Toksvig*.

*Miller v. Universal City Studios, Inc.*, 650 F.2d 1365, 1370-1371 (5thCir. 1981).

In 1988, *Toksvig* was cited extensively in another case in the Seventh Circuit, where the original *Toksvig* case was heard. The trial court wrote:

In *Toksvig v. Bruce Publishing*, 181 F.2d 664 (7th Cir. 1950), the plaintiff wrote a biography of Hans Christian Anderson and relied exclusively upon Danish language sources in her research. Sometime later, the defendant authored another Anderson biography, although she utilized only English language sources including plaintiff's book. In fact, the defendant lifted 24 passages from plaintiff's book. The Seventh Circuit rejected the defendant's argument that, because the facts of Anderson's life are in the public domain, plaintiff's biography was not copyrightable. The precise reasoning behind the *Toksvig* decision is unclear. In its opinion, the court emphasized that plaintiff was the first to translate the Danish sources and that translations are generally copyrightable. Yet, the translation of factual material cannot make the facts themselves copyrightable. Moreover, the *Toksvig* court focused<sup>77</sup> upon the substantial research plaintiff conducted in preparing her book, relative to that undertaken by the defendant. Contrary to Nash's contention, though, the *Toksvig* court never explicitly held

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<sup>77</sup> Only in the *one* sentence quoted above.

that research itself is copyrightable. Regardless of the precise reasoning employed by the court, *Toksvig*, at a minimum, stands for the proposition that works of historical nonfiction can be copyrightable.

....

In sum, *Toksvig* and *Eisenschiml* do not clearly articulate the extent to which works of historical nonfiction are copyrightable. The Supreme Court has recognized this unclear area of copyright law: “[I]n the realm of factual narrative, the law is currently unsettled regarding the ways in which uncopyrightable elements combine with the author's contributions to form protected expression.” *Harper and Row Publishers v. Nation Enterprises*, 471 U.S. 539, 105 S.Ct. 2218, 2224, 85 L.Ed.2d 588 (1985). Fortunately, we need not define in this case the limits of protected expression in the area of historical nonfiction. We believe that the holding in *Toksvig* and the above-quoted language in *Eisenschiml* show that interpretative theories contained in historical nonfiction are susceptible to copyright. [FN4]

FN4. The defendants frequently cite *Hoehling v. Universal City Studios*, 618 F.2d 972 (2d Cir. 1980), which held that the plaintiff author's theory concerning the destruction of the Hindenburg blimp was not copyrightable. This case is not binding authority in this circuit. The *Hoehling* court “repudiated” *Toksvig*, 618 F.2d at 979, but *Toksvig* has not been overturned by the Seventh Circuit.

*Nash v. CBS, Inc.*, 691 F.Supp. 140, 142-143 (N.D.Ill. 1988).

On appeal, Judge Easterbrook of the Seventh Circuit affirmed the trial court's decision in *Nash*, and defended the Circuit's earlier decision in *Toksvig*:

As our opinion in *Toksvig* shows, we are not willing to say that “anything goes” as long as the first work is about history. *Toksvig* held that the author of a biography of Hans Christian Andersen infringed the copyright of the author of an earlier biography by using portions of Andersen's letters as well as some of the themes and structure. *Hoehling* rejected *Toksvig*, see 618 F.2d at 979, concluding that “[k]nowledge is expanded ... by granting new authors of historical works a relatively free hand to build upon the work of their predecessors.” *Id.* at 980 (footnote omitted). With respect for our colleagues of the east, we think this goes to the extreme of looking at incentives only ex post. The authors in *Hoehling* and *Toksvig* spent years tracking down leads. If all of their work, right down to their words, may be used without compensation, there will be too few original investigations, and facts will not be available on which to build.

In *Toksvig* the first author, who knew Danish, spent three years learning about Andersen's life; the second author, who knew no Danish, wrote her biography in less than a year by copying out of the first book scenes and letters that the original author discovered or translated. Reducing the return on such effort, by allowing unhindered use, would make the initial leg-work less attractive and so less frequent. Copyright law does not protect hard work (divorced from expression), and hard work is not an essential ingredient of copyrightable expression (see *Rockford Map*<sup>78</sup>); to the extent *Toksvig* confuses work or ideas with expression, it has been justly criticized. *Rosemont Enterprises, Inc. v. Random House, Inc.*, 366 F.2d 303, 310 (2d Cir. 1966); *Miller v. Universal City Studios*, 650 F.2d at 1371; William F. Patry, *THE FAIR USE PRIVILEGE IN COPYRIGHT LAW* 65-70 (1985). See also

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<sup>78</sup> See page 59, below.

*Eisenschiml v. Fawcett Publications, Inc.*, 246 F.2d 598, 604 (7th Cir. 1957) (recognizing both that any two treatments of the same historical subject will be similar because the facts limit the author's freedom, and that a scholar is entitled to use a predecessor's work). We need not revisit *Toksvig* on its own facts to know that it is a mistake to hitch up at either pole of the continuum between granting the first author a right to forbid all similar treatments of history and granting the second author a right to use anything he pleases of the first's work. Cf. *New Era Publications v. Henry Holt & Co.*, 873 F.2d 576 (2d Cir.), *rehearing en banc denied*, 884 F.2d 659 (1989).

*Nash v. CBS, Inc.*, 899 F.2d 1537, 1542 (7th Cir. 1990).

Finally, Nimmer's treatise on copyright law says ironically:

[*Feist*] has sung the swan song for *Toksvig*, a case that has been long derided in any event as a judicial ugly duckling.

Melville B. Nimmer and David Nimmer, NIMMER ON COPYRIGHT, § 2.11 [E].

When *Feist* overruled copyright protection for "sweat of the brow", the U.S. Supreme Court would probably also reject the remark in *Toksvig* about Hubbard writing her book in 1/3 the time of *Toksvig*. But that does *not* imply that Hubbard could legally copy 24 valuable passages from *Toksvig*'s book.

#### labor irrelevant to copyright

Despite what these numerous judges and justices have *said* about copyright protecting or rewarding labor, the truth is that the amount of labor is irrelevant to the existence of a copyright.

A U.S. District Court held that Rockford Map held a valid copyright on its maps and awarded Rockford \$250 statutory damages for infringement by a competing map publisher, Directory Service, plus an injunction prohibiting Directory from publishing copies of Rockford's maps, and ordered Directory to pay \$22,000 in attorney's fees to Rockford. Judge Easterbrook of the U.S. Court of Appeals wrote a good description of why effort or labor is irrelevant to copyright law.

The copyright laws are designed to give people incentives to produce new works. See *Harper & Row, Publishers, Inc. v. Nation Enterprises*, 471 U.S. 539, 105 S.Ct. 2218, 2223-24, 85 L.Ed.2d 588 (1985); *Sony Corp. v. Universal City Studios, Inc.*, 464 U.S. 417, 104 S.Ct. 774, 782, 807, 78 L.Ed.2d 574 (1984). They allow people to collect the reward for their contributions. If the incremental contribution is small, so too is the reward, but a subjective assessment of the importance of the contribution has nothing to do with the existence of copyright.

Directory Service maintains that Rockford Map produced its plat maps with so little effort that the result may not be copyrighted. The court remarked in *Schroeder v. William Morrow & Co.*, 566 F.2d 3, 5 (7th Cir. 1977), that "only 'industrious collection,' not originality in the sense of novelty, is required."<sup>79</sup> The expenditure of 14 hours to update the maps of Ford County, or even 45 to start from scratch, is not very "industrious," Directory Service tells us.

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<sup>79</sup> The U.S. Supreme Court in *Feist* rejected the "industrious collection" cases. Furthermore, "novelty" is *not* a requirement for a copyright, see page 82, below.

The copyright laws protect the work, not the amount of effort expended. A person who produces a short new work or makes a small improvement in a few hours gets a copyright for that contribution fully as effective as that on a novel written as a life's work. Perhaps the smaller the effort the smaller the contribution; if so, the copyright simply bestows fewer rights. Others can expend the same effort to the same end. Copyright covers, after all, only the incremental contribution and not the underlying information. *Mazer v. Stein*, 347 U.S. 201, 74 S.Ct. 460, 98 L.Ed.2d 630 (1954).

The input of time is irrelevant. A photograph may be copyrighted, although it is the work of an instant and its significance may be accidental. *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 4 S.Ct. 279, 28 L.Ed. 349 (1884); *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 23 S.Ct. 298, 47 L.Ed. 460 (1903); *Time, Inc. v. Bernard Geis Assoc.*, 293 F.Supp. 130 (S.D.N.Y. 1968) (Zapruder film of Kennedy assassination). In 14 hours Mozart could write a piano concerto, J.S. Bach a cantata, or Dickens a week's installment of *Bleak House*. The Laffer Curve, an economic graph prominent in political debates, appeared on the back of a napkin after dinner, the work of a minute. All of these are copyrightable.[FN2] Dickens did not need to complete *Bleak House* before receiving a copyright; every chapter — indeed every sentence<sup>80</sup> — could be protected standing alone. Rockford Map updates and republishes maps on more than 140 counties every year. If it put out one large book with every map, even Directory Service would concede that the book was based on a great deal of “industry.” Rockford Map, like Dickens, loses none of its rights by publishing copyrightable matter in smaller units.

[FN2.] In principle. Mozart's work is in the public domain and anyway was work for hire. The Archbishop of Salzburg probably held the rights. There were no copyright laws in seventeenth-century Germany, and Bach had no way to protect his rights. Dickens was at the mercy of his publishers. Only Laffer's napkin, and not the idea represented by the graph, may be copyrighted. But the principle's the thing.

*Rockford Map Publishers, Inc. v. Directory Service Co.*, 768 F.2d 145, 148-149 (7thCir. 1985) (Easterbrook, J.), *cert. den.*, 474 U.S. 1061 (1986).

#### morality

I don't want to sound like a preacher, but diligent work is a moral virtue for many of us. It is morally repugnant for another person to profit by merely copying a first author's diligent work, thereby diverting both profits and fame from the first author.

In both criminal law and civil law (especially equity), the law has a strong moral basis. In torts, the general duty of care is to do what a reasonable man would do, which involves morality. Society *expects* law to follow moral principles, instead of law being blind to either immoral or unfair practices.

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<sup>80</sup> This is hyperbole. It would be unusual to pay to register the copyright on one sentence, when an entire chapter, or an entire book, could be registered for the same fee.

Prof. Gorman indirectly recognized this moral basis in his 1982 article:

It is a natural judicial instinct to invoke one or more of these theories [i.e., unfair competition, unjust enrichment, breach of a fiduciary or confidential relationship, etc.] to protect plaintiff's time-consuming efforts in generating ideas or in gathering facts, when it appears that the defendant has conducted itself in a less than scrupulous manner.

Robert A. Gorman, "Fact or Fancy: The Implications for Copyright," 29 JOURNAL OF THE COPYRIGHT SOCIETY OF THE USA 560, 598-599 (1982). But Prof. Gorman goes on to argue that the need to disseminate ideas and facts is a countervailing public policy. I agree with Prof. Gorman when he says "it is natural judicial instinct", because I believe such instinct come from morality and ethics. There is no need for an attorney or judge to apologize for introducing considerations of morality or ethics in legal briefs and judicial opinions, because morality and ethics are the basis for deciding fair play.

In a case discussed below, beginning at page 64, the U.S. Court of Appeals showed its moral revulsion at defendant's conduct:

But, laying aside the right of property as the ultimate foundation of suit, the business method of selling, in competition with plaintiff and its members, something falsely represented as gathered by defendant otherwise than from bulletins and early editions, is unfair, because it is parasitic and untrue. It is immoral, and that is usually unfair to some one. [footnote omitted] *Associated Press v. International News Service*, 245 F. 244, 252 (2dCir. 1917).

This kind of expression is repeated often in unfair competition cases in which the plaintiff wins.<sup>81</sup> What really drives these unfair competition torts is the gut feeling that the defendant has unfairly pirated the plaintiff's labor, skill, and expense. The intellectual analysis and rules of law are invoked later to express the judge's moral revulsion at defendant's conduct.

The long list of cases, beginning at page 46 above, shows judges in copyright cases felt the *need* to protect labor, skill, and expense of an author. Because copyright law is statutory, and because the statutes did not mention protection of "labor, skill, and expense", one could say that these judges were technically wrong. However, I think the copyright statutes were — and still are — incomplete, in that the statutes do not recognize the need to protect an author's labor, skill, and expense. Instead, the protection for an author's labor, skill, and expense became part of a separate tort of unfair competition, as explained in the next section of this essay. However, after the U.S. Supreme Court's decision in *Feist*, the continued viability of the unfair competition tort is in doubt.

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<sup>81</sup> In a case involving unauthorized preparation of a derivative work that copied some of plaintiff's text, a judge wrote: "This was not legitimate coverage of a news event; instead it was, and there is no other way to describe it, chiseling for personal profit." *Wainwright Securities, Inc. v. Wall St. Transcript Corp.*, 558 F.2d 91, 96-97 (2dCir. 1977).

## Recognition of Unfair Competition

Some of the cases during 1841-1918, cited above beginning at page 46, mention that copyright infringement prevents the infringer from appropriating the fruits of the labor or skill of the first author. Such cases hint at the subsequent development of the tort of unfair competition.

### Cases Before 1918

Early in the history of copyright law in the USA, judges recognized it was unfair to allow a second author to copy text from a first author, because the second author simply pirated text or misappropriated the labor, skill, and expense of the first author. For example, Judge Story wrote:

It is certainly not necessary, to constitute an invasion of copyright, that the whole of a work should be copied, or even a large portion of it, in form or in substance. If so much is taken, that the value of the original is sensibly diminished, or the labors of the original author are substantially to an injurious extent appropriated by another, that is sufficient, in point of law, to constitute a piracy pro tanto. The entirety of the copyright is the property of the author; and it is no defence, that another person has appropriated a part, and not the whole, of any property.

*Folsom v. Marsh*, 9 F.Cas. 342, 348 (C.C.Mass. 1841) (Story, J.).

Quoted with approval, but sometimes without crediting Judge Story, in:

- *Universal Pictures Co. v. Harold Lloyd Corp.*, 162 F.2d 354, 361 (9thCir. 1947);
- *Wihtol v. Crow*, 309 F.2d 777, 780 (6thCir. 1962);
- *Sid & Marty Krofft Television Productions, Inc. v. McDonald's Corp.*, 562 F.2d 1157, 1169, n.13 (9thCir. 1977);
- *Diamond v. Am-Law Pub. Corp.*, 745 F.2d 142, 147 (2dCir. 1984);
- *Murray Hill Publications, Inc. v. ABC Communications, Inc.*, 264 F.3d 622, 633 (6thCir. 2001);
- *Newton v. Diamond*, 388 F.3d 1189, 1195 (9thCir. 2004).

Four years later, Judge Story specifically mentioned “skill, labor and expense”:

A man has a right to the copy-right of a map of a state or country, which he has surveyed or caused to be compiled from existing materials, at his own expense, or skill, or labor, or money. Another man may publish another map of the same state or country, by using the like means or materials, and the like skill, labor and expense. But then he has no right to publish a map taken substantially and designedly from the map of the other person, without any such exercise of skill, or labor, or expense. If he copies substantially from the map of the other, it is downright piracy; ....

*Emerson v. Davies*, 8 F.Cas. 615, 619 (C.C.Mass. 1845) (Story, J.).

An author has as much right in his plan, and in his arrangements, and in the combination of his materials, as he has in his thoughts, sentiments, opinions, and in his modes of expressing them. The former as well as the latter may be more useful or less useful than those of another author; but that, although it may diminish or increase the relative values of their works in the market, is no ground to entitle either to appropriate to himself the labor or skill of the other, as embodied in his own work.

*Emerson v. Davies*, 8 F.Cas. at 620.

So that, I think, it may be laid down as the clear result of the authorities in cases of this nature, that the true test of piracy or not is to ascertain whether the defendant has, in fact, used the plan, arrangements, and illustrations of the plaintiff, as the model of his own book, with colorable alternations and variations only to disguise the use thereof; or whether his work is the result of his own labor, skill, and use of common materials and common sources of knowledge, open to all men, and the resemblances are either accidental or arising from the nature of the subject. In other words, whether the defendant's book is, quoad hoc, a servile or evasive imitation of the plaintiff's work, or a bona fide original compilation from other common or independent sources.

*Emerson v. Davies*, 8 F.Cas. at 624.

In a case involving two publishers of law books, the U.S. Circuit Court of Appeals in 1897 summarized the facts and conclusions:

Nearly 6,000 cases published in complainant's pamphlets, with syllabi and footnotes protected by copyright, were digested by persons in the employ of defendant, who repeatedly and systematically made an unfair use of the copyrighted work, in order to save themselves the time and labor of original investigation. These unfair users endeavored, so far as practicable, to conceal the fact that such unfair use had been made; sometimes successfully, sometimes not; and in consequence it is not practicable now to determine, without evidence which they do not offer, in which cases an unfair use had been successfully concealed and in which no unfair use was in fact made. In such a condition of affairs, where by the misconduct of defendant's employees a part of complainant's copyrighted work has been appropriated by defendant, and so mingled with original matter contained in its publication that no one except its own employees who did the wrong can segregate the pirated from the original matter, and they do not make such segregation, the whole work, or so much of it as is tainted by the workmanship of the unfair users, should be enjoined and accounted for.

*West Pub. Co. v. Lawyers' Co-operative Pub. Co.*, 79 F. 756, 772-773 (2dCir. 1897).

While most reported unfair competition cases were brought in federal courts, I have found a few early cases in state courts. A New York State court in 1907 granted a preliminary injunction prohibiting defendant from selling a cheaper edition of a book that was copied from a book published by plaintiff, in what was one of the earliest unfair competition cases in state court.

... this is the very reason why a court of equity interferes — to prevent a fraudulent and unfair competition by one manufacturer appropriating the skill and labor of another manufacturer in designing and manufacturing merchandise, so that one can reproduce the articles better designed and manufactured by avoiding the expense involved in the designing and preparation of the article undersell his competitor.

*E.P. Dutton & Co. v. Cupples*, 102 N.Y.S. 309, 313 (N.Y.A.D. 1907) (Ingraham, J., concurring).

After the Copyright Act of 1976, federal courts would have exclusive jurisdiction of such a case, because it is essentially a copyright infringement case.

A case in federal trial court in 1912 granted plaintiff's request for a temporary injunction against a competitor who had copied plaintiff's player piano rolls:

He cannot avail himself of the skill and labor of the original manufacturer of the perforated roll or record by copying or duplicating the same, but must resort to the copyrighted composition or sheet music, and not pirate the work of a competitor who has made an original perforated roll.

*Aeolian Co. v. Royal Music Roll Co.*, 196 F. 926, 927 (W.D.N.Y. 1912).

Quoted in: *Duchess Music Corp. v. Stern*, 458 F.2d 1305, 1310 (9thCir. 1972);

*Jondora Music Pub. Co. v. Melody Recordings, Inc.*, 506 F.2d 392, 394 (3dCir. 1974);

*Heilman v. Levi*, 391 F.Supp. 1106, 1110 (D.Wis. 1975);

*GAI Audio of New York, Inc. v. Columbia Broadcasting System*, 340 A.2d 736, 745 (Md.App. 1975).

### *International News Service*

A famous case in 1917-1918 involved two competitors in the distribution of news to newspapers, the Associated Press (AP) and International News Service (INS). The member newspapers of AP collected facts on current events and wrote news stories for publication in member newspapers, just as they do today. INS obtained AP dispatches, rewrote them, and then INS sent them to its member newspapers for publication. INS obtained the AP dispatches in three ways: (1) bribing employees of newspapers that were members of AP, (2) obtaining news from AP-member newspapers prior to publication and distribution to the public (in violation of the contract between AP and member newspapers), and (3) copying from bulletin boards in AP-member newspapers. Agents of INS on the east coast of the USA were able to obtain AP news and telegraph it to INS newspapers on the west coast, so that the west coast INS newspapers sometimes published the news from AP before the west coast AP newspapers.

The trial court issued a preliminary injunction against INS for the first two ways of obtaining AP dispatches. *Associated Press v. International News Service*, 240 F. 983 (S.D.N.Y. 1917).

Three months later, the U.S. Court of Appeals affirmed the preliminary injunction, but remanded to the trial court "with directions to issue injunction against any bodily taking of the words or substance of plaintiff's news, until its commercial value as news has, in the opinion of the District Court, passed away." *Associated Press v. International News Service*, 245 F. 244, 253 (2dCir. 1917).

The U.S. Supreme Court affirmed. *International News Service v. Associated Press*, 248 U.S. 215 (1918).



Note that this is *not* a copyright case. The Copyright Act of 1909, in effect at the time of this case, required both registration of the copyright with the Library of Congress and notice of copyright on all published copies. AP complied with neither of those conditions for copyright.<sup>82</sup> Also there was some question of whether the facts in news are copyrightable. The U.S. Court of Appeals said: "... copyright does not cover statements of fact, but merely their literary dress or form." and "... plaintiff's property in news is not literary at all, that it is not capable of copyright ...." 245 F. at 250. One interpretation of *INS* is that this case created a common-law tort similar to copyright infringement, to protect the investment of labor, skill, and expense by AP, who wrote the news dispatches.

The Supreme Court held that this was an unfair competition case, a matter of equity jurisprudence.

We need spend no time, however, upon the general question of property in news matter at common law, or the application of the copyright act, since it seems to us the case must turn upon the question of unfair competition in business. And, in our opinion, this does not depend upon any general right of property analogous to the common-law right of the proprietor of an unpublished work to prevent its publication without his consent; nor is it foreclosed by showing that the benefits of the copyright act have been waived. We are dealing here not with restrictions upon publication but with the very facilities and processes of publication. The peculiar value of news is in the spreading of it while it is fresh; and it is evident that a valuable property interest in the news, as news, cannot be maintained by keeping it secret. Besides, except for matters improperly disclosed, or published in breach of trust or confidence, or in violation of law, none of which is involved in this branch of the case, the news of current events may be regarded as common property. What we are concerned with is the business of making it known to the world, in which both parties to the present suit are engaged. That business consists in maintaining a prompt, sure, steady, and reliable service designed to place the daily events of the world at the breakfast table of the millions at a price that, while of trifling moment to each reader, is sufficient in the aggregate to afford compensation for the cost of gathering and distributing it, with the added profit so necessary as an incentive to effective action in the commercial world. The service thus performed for newspaper readers is not only innocent but extremely useful in itself, and indubitably constitutes a legitimate business. The parties are competitors in this field; and, on fundamental principles, applicable here as elsewhere, when the rights or privileges of the one are liable to conflict with those of the other, each party is under a duty so to conduct its own business as not unnecessarily or unfairly to injure that of the other. [citations omitted]

*INS*, 248 U.S. at 234-236.

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<sup>82</sup> The Supreme Court noted: "Complainant's news matter is not copyrighted." 248 U.S. at 233.

The Supreme Court recognized that AP had expended labor, skill, and expense — the classic trilogy.

Not only do the acquisition and transmission of news require elaborate organization and a large expenditure of money, skill, and effort; not only has it an exchange value to the gatherer, dependent chiefly upon its novelty and freshness, the regularity of the service, its reputed reliability and thoroughness, and its adaptability to the public needs; but also, as is evident, the news has an exchange value to one who can misappropriate it.

*INS*, 248 U.S. at 238.

The right of the purchaser of a single newspaper to spread knowledge of its contents gratuitously, for any legitimate purpose not unreasonably interfering with complainant's right to make merchandise of it, may be admitted; but to transmit that news for commercial use, in competition with complainant — which is what [INS] has done and seeks to justify — is a very different matter. In doing this [INS], by its very act, admits that it is taking material that has been acquired by complainant as the result of organization and the expenditure of **labor, skill, and money**,<sup>83</sup> and which is salable by complainant for money, and that [INS] in appropriating it and selling it as its own is **endeavoring to reap where it has not sown**,<sup>84</sup> and by disposing of it to newspapers that are competitors of complainant's members is appropriating to itself the harvest of those who have sown. Stripped of all disguises, the process amounts to an unauthorized interference with the normal operation of complainant's legitimate business precisely at the point where the profit is to be reaped, in order to divert a material portion of the profit from those who have earned it to those who have not; with special advantage to [INS] in the competition because of the fact that it is not burdened with any part of the expense of gathering the news. The transaction speaks for itself and a court of equity ought not to hesitate long in characterizing it as unfair competition in business.

*INS*, 248 U.S. at 239-240.

Incidentally, the Supreme Court comes close to recognizing that AP had a moral right to have its work attributed to it:

The habitual failure to give credit to complainant for that which is taken is significant. Indeed, the entire system of appropriating complainant's news and transmitting it as a commercial product to [INS's] clients and patrons amounts to a false representation to them and to their newspaper readers that the news transmitted is the result of defendant's own investigation in the field. But these elements, although accentuating the wrong, are not the essence of it. It is something more than the advantage of celebrity of which complainant is being deprived.

*INS*, 248 U.S. at 242.

Because *INS* involves an injunction against copying, prohibiting copying is one of the exclusive rights in copyright law, and federal copyright law preempts state law, some courts have held that *INS* is no longer good law. See page 76, below. However, one can also find cases that hold that *INS* remains good law.

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<sup>83</sup> Boldface added by Standler.

<sup>84</sup> Boldface added by Standler.

There is also the observation that *INS* was decided as a matter of federal common law, which was later abolished by the U.S. Supreme Court in *Erie*.<sup>85</sup> This technicality need not bother us, because state courts and state legislatures still have the freedom to copy the reasoning and words from *INS* into state law.

In 1997, the Second Circuit severely limited *INS* to particular facts:

We hold that the surviving “hot-news” *INS*-like claim is limited to cases where:

- (i) a plaintiff generates or gathers information at a cost;
  - (ii) the information is time-sensitive;
  - (iii) a defendant's use of the information constitutes free riding on the plaintiff's efforts;
  - (iv) the defendant is in direct competition with a product or service offered by the plaintiffs;
- and
- (v) the ability of other parties to free-ride on the efforts of the plaintiff or others would so reduce the incentive to produce the product or service that its existence or quality would be substantially threatened.

*National Basketball Ass'n v. Motorola, Inc.*, 105 F.3d 841, 845 (2dCir. 1997).

While a U.S. Court of Appeals can *not* overrule a U.S. Supreme Court decision, the Court of Appeals for the Second Circuit came close to overruling the Supreme Court, by holding that the Supreme Court's decision in *INS* only applies to future cases with nearly identical facts.

Therefore, the result of *INS* is no longer available in the Second Circuit to protect compilation of facts, unless those facts are “hot news”.

#### *Jeweler's Circular* and progeny

A famous paragraph of *Jeweler's Circular* says:

The right to copyright a book upon which one has expended labor in its preparation does not depend upon whether the materials which he has collected consist or not of matters which are *publici juris*,<sup>86</sup> or whether such materials show literary skill or originality, either in thought or in language, or anything more than industrious collection. The man who goes through the streets of a town and puts down the names of each of the inhabitants, with their occupations and their street number, acquires material of which he is the author. He produces by his labor a meritorious composition, in which he may obtain a copyright, and thus obtain the exclusive right of multiplying copies of his work.

*Jeweler's Circular Publishing Co. v. Keystone Publishing Co.*, 281 Fed. 83, 88 (2d Cir. 1922), *cert. denied*, 259 U.S. 581 (1922). Quoted with approval in:

- *Yale University Press v. Row, Peterson & Co.*, 40 F.2d 290, 291-292 (S.D.N.Y. 1930);
- *Leon v. Pacific Tel. & Tel. Co.*, 91 F.2d 484, 486 (9thCir. 1937);

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<sup>85</sup> The reference, as all lawyers in the USA know, is to *Erie Railroad v. Tompkins*, 304 U.S. 64 (1938).

<sup>86</sup> *Publici juris* literally means “of public right”. The judge should have said that news is in the public domain, belonging to everyone. The judge also should have cited to *INS*, 248 U.S. at 234.

- *Southwestern Bell Telephone Co. v. Nationwide Independent Directory Service, Inc.*, 371 F.Supp. 900, 905 (W.D.Ark. 1974);
- *Southern Bell Tel. and Tel. Co. v. Associated Telephone*, 756 F.2d 801, 809 (11thCir. 1985);
- *Hutchinson Telephone Co. v. Fronteer Directory Co.*, 770 F.2d 128, 131 (8thCir. 1985).

Note that *Jeweler's Circular* and *Leon* were explicitly overruled by *Feist*.

In addition to the five cases cited above, *Jeweler's Circular* is also cited (but without quoting the paragraph) in the following three cases:

- *College Entrance Book Co v. Amsco Book Co.*, 119 F.2d 874, 876 (2dCir. 1941) (“Both plaintiff's and defendant's books met exactly the same demand on the same market, and defendant's copying was unquestionably to avoid the trouble or expense of independent work. This is an unfair use.”);
- *Meredith Corp. v. Harper & Row, Publishers, Inc.*, 378 F.Supp. 686 (S.D.N.Y. 1974), *aff'd*, 500 F.2d 1221 (2dCir. 1974) (per curiam);
- *Financial Information, Inc. v. Moody's Investors Service, Inc.*, 751 F.2d 501, 505 (2dCir. 1984) (“*Jeweler's Circular* ... stated the rule” that “compilations of ... facts traditionally have been [copyrighted].”), *cert. denied*, 484 U.S. 820 (1987).

The U.S. Court of Appeals in *Jeweler's Circular* was wrong when it rejected “originality” as a condition of copyright, and substituted physical labor (i.e., “industrious collection” of facts). One could envision someone who laboriously retypes a public-domain document (e.g., a statute or judicial opinion) and posts it at a website, but that person could *not* have a valid copyright on such a document, despite his/her physical labor in retyping the document. (To prevent misunderstanding, if someone quotes from a public-domain document and then adds some original text, that someone can have a valid copyright on his/her original text.)

However, as recognized by Prof. Denicola,<sup>87</sup> *Jeweler's Circular* was right to recognize that original collection of data is authorship, in the context of preparing a compilation of facts. I prefer to rephrase Denicola slightly to make *selection* of data be authorship, partly to align with words in 17 U.S.C. § 101 (“compilation”), and partly because data *collection* is sometimes an *unintellectual* task requiring only mechanical rule-following behavior. Selection involves judgment, including resolving contradictions or conflicting facts, and including evaluating credibility.

A famous copyright case in the U.S. Court of Appeals in California in 1956 said:

The so-called doctrine of fair use of copyrighted material appears in cases in federal courts having to do with compilations, listings, digests, and the like, and is concerned with the use made of prior compilations, listings, and digests. In certain of these cases, it is held that a writer may be guided by earlier copyrighted works, may consult original authorities, and may use those which he considers applicable in support of his own original text; but even in such cases, **it is generally held that if he appropriate the fruits of another's labors, without**

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<sup>87</sup> Robert C. Denicola, “Copyright in Collections of Facts: A Theory for the Protection of Nonfiction Literary Works,” 81 COLUMBIA LAW REVIEW 516 at 530, 538, 542 (1981).

**alteration, and without independent research, he violates the rights of the copyright owner.**<sup>88</sup> In these instances, as has been said, there are certain to be considerable resemblances, ‘just as there must be between the work of two persons compiling a directory, or a dictionary, or a guide for railroad trains, or for automobile trips. In such cases the question is whether the writer has availed himself of the earlier writer's work without doing any independent work himself.’ *Chautauqua School of Nursing v. National School of Nursing*, 2 Cir., 238 F. 151, 153. See also cases digested in 18 F.Dig., Copyrights, Section 55.

*Benny v. Loew's Inc.*, 239 F.2d 532, 536 (9thCir. 1956), *aff'd* by an equally divided court *sub nom.*, *Columbia Broadcasting System, Inc. v. Loew's Inc.*, 356 U.S. 43 (1958).

Some copyright cases have erroneously included elements from the tort of unfair competition (e.g., included an author's labor or effort). While such an error may have helped the court reach a fairer result, the error contaminates copyright law with extraneous elements. In my reading of copyright cases, the most egregious error of this kind occurred in a case involving copyright of pagination in West's reporters,<sup>89</sup> in which the judges not only muddled the law but also reached the wrong result.

#### *Feist* ends protection for “sweat of the brow”

The first use of the phrase “sweat of the brow” in a copyright case in federal court is in *Amsterdam v. Triangle Publications*, 93 F.Supp. 79, 82 (D.Pa. 1950) (Bard, J.) (“However, the presentation of information available to everybody, such as is found on maps, is protected [by copyright] only when the publisher of the map in question obtains originally some of that information by the sweat of his own brow.”), *aff'd*, 189 F.2d 104, 106 (3dCir. 1951) (“[quoting court below] We find ourselves in complete accord with the views thus expressed by Judge Bard. We think there is no doubt that in order for a map to be copyrightable its preparation must involve a modicum of creative work.”). Quoted in *Donald v. Zack Meyer's T. V. Sales and Service*, 426 F.2d 1027, 1031 (5thCir. 1970). Ironically, “sweat of the brow” initially was an indication of a “modicum of creative [original] work” by an author, as opposed to mere copying — which is in agreement with *Feist*.

In two landmark cases in 1984, the Second Circuit picked up the theme of “sweat of the brow” in *Eckes v. Card Prices Update*, 736 F.2d 859, 862 (2dCir. 1984) (“sweat of a researcher's brow”); *Financial Information, Inc. v. Moody's Investors Service, Inc.*, 751 F.2d 501, 506 (2dCir. 1984) (citing NIMMER ON COPYRIGHT). Nimmer, as well as *Eckes* and *Financial Information*, seems to use “sweat of the brow” to mean labor of an author.

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<sup>88</sup> Boldface added by Standler.

<sup>89</sup> *West Publ. 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).

In *Feist*, the U.S. Supreme Court overruled *Jeweler's Circular* and its progeny, because those cases substituted “sweat of the brow” labor for the proper requirements of originality and at least some minimal creativity. The relevant part of the U.S. Supreme Court opinion in *Feist* says:

But some courts misunderstood the statute. See, e.g., *Leon v. Pacific Telephone & Telegraph Co.*, 91 F.2d 484 (CA9 1937); *Jeweler's Circular Publishing Co. v. Keystone Publishing Co.*, 281 F. 83 (CA2 1922). ....

Making matters worse, these courts developed a new theory to justify the protection of factual compilations. Known alternatively as “sweat of the brow” or “industrious collection,” the underlying notion was that copyright was a reward for the hard work that went into compiling facts. The classic formulation of the doctrine appeared in *Jeweler's Circular Publishing Co.*, 281 F., at 88:

“The right to copyright a book upon which one has expended labor in its preparation does not depend upon whether the materials which he has collected consist or not of matters which are *publici juris*, or whether such materials show literary skill *or originality*, either in thought or in language, or anything more than industrious collection. The man who goes through the streets of a town and puts down the names of each of the inhabitants, with their occupations and their street number, acquires material of which he is the author” (emphasis added).

The “sweat of the brow” doctrine had numerous flaws, 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. Under the doctrine, the only defense to infringement was independent creation. A subsequent compiler was “not entitled to take one word of information previously published,” but rather had to “independently wor[k] out the matter for himself, so as to arrive at the same result from the same common sources of information.” *Id.*, at 88-89 (internal quotation marks omitted). “Sweat of the brow” courts thereby eschewed the most fundamental axiom of copyright law — that no one may copyright facts or ideas. See *Miller v. Universal City Studios, Inc.*, 650 F.2d [1365] at 1372 [(5thCir. 1981)] (criticizing “sweat of the brow” courts because “ensur[ing] that later writers obtain the facts independently ... is precisely the scope of protection given ... copyrighted matter, and the law is clear that facts are not entitled to such protection”).

Decisions of this Court applying the 1909 Act make clear that the statute did not permit the “sweat of the brow” approach. The best example is *International News Service v. Associated Press*, 248 U.S. 215, 39 S.Ct. 68, 63 L.Ed. 211 (1918). In that decision, the Court stated unambiguously that the 1909 Act conferred copyright protection only on those elements of a work that were original to the author. ....

*Feist Publications, Inc. v. Rural Telephone Service Co.*, 499 U.S. 340, 352-353 (1991).

The U.S. Supreme Court in *Feist* said that even the Second Circuit, which had created *Jeweler's Circular*, had “repudiated” the holding in that case:

Additionally, the Second Circuit, which almost 70 years ago issued the classic formulation of the “sweat of the brow” doctrine in *Jeweler's Circular Publishing Co.*, has now fully repudiated the reasoning of that decision. See, e.g., *Financial Information, Inc. v. Moody's Investors Service, Inc.*, 808 F.2d 204, 207 (CA2 1986), *cert. denied*, 484 U.S. 820, 108 S.Ct. 79, 98 L.Ed.2d 42 (1987); *Financial Information, Inc. v. Moody's Investors Service, Inc.*,

751 F.2d 501, 510 (CA2 1984) (Newman, J., concurring); *Hoehling v. Universal City Studios, Inc.*, 618 F.2d 972, 979 (CA2 1980) [*cert. den.*, 449 U.S. 841 (1980)]. *Feist*, 499 U.S. at 360. However, notice that *Financial Information*, 808 F.2d 204 does **not** cite *Jeweler's Circular*, which makes it difficult to “repudiate” that decision. And notice that *Hoehling* does **not** cite *Jeweler's Circular* and also does **not** mention “sweat of the brow”. Further, it would be improper for one three-judge panel in the Second Circuit to overrule (i.e., “repudiate”) a precedent in the Second Circuit — only an *en banc* opinion in the Second Circuit or the U.S. Supreme Court can overrule *Jeweler's Circular*. What the Second Circuit did “repudiate” was one case from the Seventh Circuit. *Hoehling v. Universal City Studios*, 618 F.2d 972, 979 (2dCir. 1980) (“Indeed, this circuit has clearly repudiated *Toksvig* and its progeny.”). I discussed *Toksvig* and the Second Circuit’s criticism of it beginning at page 53, above.

It’s instructive to look at what the Second Circuit has actually said about *Jeweler's Circular*. Although *not* cited in *Feist* in the Second Circuit cases that allegedly repudiate *Jeweler's Circular*, the Second Circuit began their criticism of protecting labor of authors in *Rosemont Enterprises, Inc. v. Random House, Inc.*, 366 F.2d 303, 310 (2dCir. 1966) (“We, however, cannot subscribe to the view that an author is absolutely precluded from saving time and effort by referring to and relying upon prior published material. [citation omitted] It is just such wasted effort that the proscription against the copyright of ideas and facts, and to a lesser extent the privilege of fair use, are designed to prevent.”). However, *Rosemont* mentions neither *Jeweler's Circular* nor “sweat of the brow”.

In 1984, Judge Jon O. Newman wrote a concurring opinion that said:

The fact that some language in early cases, see *Jeweler's Circular Publishing Co. v. Keystone Publishing Co.*, 281 F. 83, 87 (2d Cir.), ... have supported a view that copyright protection should be extended solely because of laborious effort is no reason for us to disregard the statutory criteria that Congress articulated in 1976 when it enacted the current statute. The “sweat of the brow” rationale is no substitute for meeting one of those statutory criteria. *Financial Information, Inc. v. Moody's Investors Service, Inc.*, 751 F.2d 501, 510 (2dCir. 1984) (Newman, J., concurring). This is apparently the first time in the Second Circuit that a judge recognized that an author’s labor alone was not enough to confer copyright. Note that *Jeweler's Circular* was decided under the Copyright Act of 1909, which statute did not specifically require a copyrighted work be “original”, and at a time before judges reached a consensus that facts were excluded from copyrightable material.

In 1986, when *Financial Information* was back for a second appeal, Judge Lumbard of the Second Circuit wrote:

At the outset in *Eckes*, [736 F.2d 859]<sup>90</sup> we noted our well-established reluctance to grant copyright protection to works of non-fiction—chiefly on the ground that facts may not be copyrighted. See *id.* at 862; *Hoehling v. Universal City Studios, Inc.*, 618 F.2d 972, 979 (2dCir.), *cert. denied*, 449 U.S. 841, 101 S.Ct. 121, 66 L.Ed.2d 49 (1980); *Rosemont*

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<sup>90</sup> See page 34, above.

*Enterprises, Inc. v. Random House, Inc.*, 366 F.2d 303, 310 (2dCir. 1966), *cert. denied*, 385 U.S. 1009, 87 S.Ct. 714, 17 L.Ed.2d 546 (1967). See also *Harper & Row Publishers, Inc. v. Nation Enterprises*, 471 U.S. 539, 105 S.Ct. 2218, 2224, 85 L.Ed.2d 588 (1985) (copyright protects only the expression of facts, not the facts themselves). We stated in *Eckes* that “we have been particularly restrictive in the protection of non-fiction works indicating, for example, that the fruits of another’s labor in lieu of independent research obtained through the sweat of a researcher’s brow, does not merit copyright protection absent, perhaps, wholesale appropriation.” *Eckes*, *supra*, 736 F.2d at 862. The statute thus requires that copyrightability not be determined by the amount of effort the author expends, but rather by the nature of the final result. To grant copyright protection based merely on the “sweat of the author’s brow” would risk putting large areas of factual research material off limits and threaten the public’s unrestrained access to information.

*Financial Information, Inc. v. Moody’s Investors Service, Inc.*, 808 F.2d 204, 207 (2dCir. 1986), *cert. denied*, 484 U.S. 820 (1987). This opinion does not cite *Jeweler’s Circular*. The last sentence of this quotation is hyperbole, because people could always independently create new factual compilations, which would be entitled to copyright, as explained at page 79, below. A new work infringes copyright on a previous work *only* if the new work contains material that was *copied* from the previous work. Allowing copying does not encourage authors to produce new works and promote Progress, as required by the U.S. Constitution (see page 21, above).

Further, in all of this repudiation of “sweat of the brow”, no one notices that a work could be *both* an “original work of authorship” *and* involve an author’s labor, skill, and expense in research and preparation of the work. And no one notices that misappropriation of an author’s labor, skill, and expense is a separate tort from copyright infringement.

About three months after *Feist*, the Second Circuit again rejected the “sweat of the brow” test in *Jeweler’s Circular*. *Victor Lalli Enterprises, Inc. v. Big Red Apple, Inc.*, 936 F.2d 671, 673-674 (2dCir. 1991).

About six months after *Feist*, the Second Circuit wrote:

Twenty-five years ago we abandoned the “sweat of the brow” doctrine, which rewarded compilers for their efforts in collecting facts with a de facto copyright to those facts. *Rosemont Enters., Inc. v. Random House, Inc.*, 366 F.2d 303, 309-10 (2dCir. 1966) (rejecting the view that “an author is absolutely precluded from saving time and effort by referring to and relying upon prior published material”), *cert. denied*, 385 U.S. 1009, 87 S.Ct. 714, 17 L.Ed.2d 546 (1967); ....

*Key Publications, Inc. v. Chinatown Today*, 945 F.2d 509, 516 (2dCir. 1991).

About seven years after *Feist*, the Second Circuit simply accepted *Feist* as the law. *Matthew Bender & Co., Inc. v. West Publishing Co.*, 158 F.3d 693, 699, 708 (2dCir. 1998) (Recognizing that the U.S. Supreme Court in *Feist* rejected “sweat of the brow”.), *cert. den.*, 526 U.S. 1154 (1999).



### opinion of the Copyright Office

The U.S. Copyright Office has called for creation of a statute to restore protection to compilations of fact under “sweat of the brow” theories that existed prior to *Feist*:

Accordingly, the Register [of Copyrights in the 105th and 106th Congresses]<sup>91</sup> recommended the restoration of the general level of protection provided in the past under copyright “sweat of the brow” theories, but under a suitable constitutional power, with flexibility built in for uses in the public interest in a manner similar to the function played by fair use in copyright law. Such balanced legislation could optimize the availability of reliable information to the public.

In the intervening years, nothing has occurred to change the views of the Copyright Office. We continue to believe that balanced legislation should be enacted that would provide appropriate levels of protection for producers of databases, without unnecessarily impeding the free flow of knowledge and information.

Statement of David O. Carson before the Subcommittee on Courts, the Internet, and Intellectual Property; Committee on the Judiciary, and the Subcommittee on Commerce, Trade and Consumer Protection Committee on Energy and Commerce of the United States House of Representatives. <http://www.copyright.gov/docs/regstat092303.html> (23 Sep 2003).

Unfortunately, the cure for *Feist* is not as simple as enacting a new statute. *Feist* repeatedly declared that the requirement of creativity was a constitutional requirement, which means that any attempt to protect *uncreative* arrangements of facts will be unconstitutional. See the citations at the end of the section on preemption, which begins at page 76 below.

### **Modern State Law of Unfair Competition**

#### California

In 1951, an intermediate appellate court in California recognized what was effectively unfair competition:

Defendants took material acquired by plaintiff as the result of organization and the expenditure of labor, skill and money and appropriating it without expense on their part, offered it to their subscribers as their own, diverting customers from plaintiff to themselves.

*McCord Co. v. Plotnick*, 239 P.2d 32, 34 (Cal.App. 1951).

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<sup>91</sup> i.e., in the years 1997 to 2000.

## New York

In 1950, a trial court in New York state wrote:

The New York courts have applied the rule in the *International News Service* case in such a wide variety of circumstances as to leave no doubt of their recognition that the effort to profit from the labor, skill, expenditures, name and reputation of others which appears in this case constitutes unfair competition which will be enjoined, see, e. g., [citing four cases].

*Metropolitan Opera Association, Inc. v. Wagner-Nichols Recorder Corp.*, 101 N.Y.S.2d 483, 492-493 (Sup.Ct. 1950), *aff'd per curiam*, 107 N.Y.S.2d 795 (N.Y.A.D. 1951).

The elements of misappropriation in New York state was enunciated in 1959 by the highest court in that state:

Moreover, in 1918 the Supreme Court of the United States refused to limit relief from unfair competition to cases of 'palming off' in *International News Service v. Associated Press*, 1918, 248 U.S. 215, 39 S.Ct. 68, 63 L.Ed. 211, where defendant news gathering service was pirating news gathered and reported by plaintiff to eastern newspapers and then transmitting it, as its own product, to western newspapers in time for publication in the west. The Supreme Court commenting that defendant is 'endeavoring to reap where it has not sown', 248 U.S. 239, 39 S.Ct. 72, held that plaintiff had property rights in the freshly gathered news which might not be misappropriated by defendant. The principle that one may not misappropriate the results of the skill, expenditures and labors of a competitor has since often been implemented in our courts. See, e. g., *Madison Square Garden Corp. v. Universal Pictures Co.*, 1st Dept., 1938, 255 App.Div. 459, 7 N.Y.S.2d 845; *Mutual Broadcasting System v. Muzak Corp.*, 1941, 177 Misc. 489, 30 N.Y.S.2d 419; *Dior v. Milton*, 1956, 9 Misc.2d 425, 155 N.Y.S.2d 443, affirmed 2 A.D.2d 878, 156 N.Y.S.2d 996; *De Jur-Amsco Corp. v. Janrus Camera*, 1956, 16 Misc.2d 772, 155 N.Y.S.2d 123. Our court has recognized that approach in *Germanow v. Standard Unbreakable Watch Crystals*, 1940, 283 N.Y. 1, 18, 27 N.E.2d 212, 219, and in *Fisher v. Star Co.*, 1921, (231 N.Y. 414, 428, 132 N.E. 133, 137, supra).

The growth of the protection against such 'parasitism' reflects the requirement that the courts and the law keep pace with the mushrooming increases in business complexity and the concomitant opportunities afforded thereby for chicanery. ....

*Electrolux Corp. v. Val-Worth, Inc.*, 161 N.E.2d 197, 203-204 (N.Y. 1959).

Two cases in the U.S. Court of Appeals in New York:

- *Flexitized, Inc. v. National Flexitized Corp.*, 335 F.2d 774, 781 (2dCir. 1964) ("... relief has been granted in New York in a wide variety of situations to insure that 'one may not misappropriate the results of the skill, expenditures and labors of a competitor, ....' *Electrolux Corp. v. Val-Worth, Inc.*, ... 161 N.E.2d 197, 203 (N.Y. 1959).);
- *Saratoga Vichy Spring Co., Inc. v. Lehman*, 625 F.2d 1037, 1044 (2dCir. 1980) ("The essence of an unfair competition claim under New York law is that the defendant has misappropriated the labors and expenditures of another. [citing four cases] Central to this notion is some element of bad faith.").

A U.S. District Court summarized New York state unfair competition law in 2003:

Under New York law, “the gravamen of a claim of unfair competition is the bad faith misappropriation of a commercial advantage belonging to another by infringement or dilution of a trademark or trade name or by exploitation of proprietary information or trade secrets.” *Eagle Comtronics, Inc. v. Pico Products, Inc.*, 256 A.D.2d 1202, 1203, 682 N.Y.S.2d 505, 506 (4th Dep’t 1998). The essence of an unfair competition claim is that one may not misappropriate the results of the labor, skills and expenditures of another, *LinkCo., Inc. v. Fujitsu Ltd.*, 230 F.Supp.2d 492, 500 (S.D.N.Y. 2002); the tort functions to protect “property rights of value ... from any form of commercial immorality.” *Metro. Opera Ass’n v. Wagner-Nichols Recorder Corp.*, 199 Misc. 786, 101 N.Y.S.2d 483, 492 (Sup.Ct. 1950) (emphasis added), *aff’d*, 279 A.D. 632, 107 N.Y.S.2d 795 (1st Dep’t 1951) (per curiam). New York courts broadly construe this tort: “[t]he incalculable variety of illegal practices denominated as unfair competition is proportionate to the unlimited ingenuity that overreaching entrepreneurs and trade pirates put to use.” *Electrolux Corp. v. Val-Worth, Inc.*, 6 N.Y.2d 556, 558, 190 N.Y.S.2d 977, 161 N.E.2d 197 (1959) (internal quotation marks and citations omitted); *Demetriades v. Kaufmann*, 698 F.Supp. 521, 525 (S.D.N.Y. 1988) (finding that the confines of the “adaptable and capricious tort of unfair competition ... are marked only by the conscience, justice and equity of common-law judges”) (internal quotation marks and citation omitted).

*Norbrook Laboratories, Ltd. v. Hanford Mfg.*, 297 F.Supp.2d 463, 491 (N.D.N.Y. 2003).

Quoted in *Innoviant Pharmacy, Inc. v. Morganstern*, 390 F.Supp.2d 179, 194 (N.D.N.Y. 2005).

- *Hall v. Bed Bath & Beyond, Inc.*, 705 F.3d 1357, 1370 (Fed.Cir. 2013) (Defendants “exploited a commercial advantage which belongs exclusively to Plaintiff” held to be bad faith under New York law.).

#### Texas

*Gilmore v. Sammons*, 269 S.W. 861, 863 (Tex.Civ.App. 1925) (Agreeing with *International News Service v. Associated Press*, 248 U. S. 215). Cited in *Alcatel USA, Inc. v. DGI Technologies, Inc.*, 166 F.3d 772, 788, n.59 (5thCir. 1999) (At 789: “Thus, under circumstances in which a work has been granted copyright protection — such as the circumstances that are before us in the instant case — the time, labor, skill, and money expended by the author in creating the work are necessarily contemplated in that copyright.” Held misappropriation pre-empted by Copyright Act of 1976.).

The elements of misappropriation in Texas were copied from a law review article that was cited by a judge in U.S. District Court in 1979 and later quoted with approval by a Texas state appellate court in 1993:

In its typical formulation, the doctrine of misappropriation is said to require proof of three elements:

“(i) the creation of plaintiff’s product through extensive time, labor, skill and money,

(ii) the defendant's use of that product in competition with the plaintiff, thereby gaining a special advantage in that competition (i.e., a 'free ride') because defendant is burdened with little or none of the expense incurred by the plaintiff, and  
 (iii) commercial damage to the plaintiff.”

Dannay, *The Sears-Compco Doctrine Today: Trademarks and Unfair Competition*, 67 TRADEMARK REVIEW 132 (1976).

*Synercom Technology, Inc. v. University Computing*, 474 F.Supp. 37, 39 (N.D.Tex. 1979) (Higginbotham, J.). Quoted with approval in *U.S. Sporting Prods., Inc. v. Johnny Steward Game Calls, Inc.*, 865 S.W.2d 214, 218 (Tex.App. 1993, writ denied); *Dresser-Rand Co. v. Virtual Automation Inc.*, 361 F.3d 831, 839 (5thCir. 2004).

### Preemption by Copyright

Two U.S. Supreme Court cases<sup>92</sup> in 1964, and also 17 U.S.C. § 301 (enacted 1976), mention that states are preempted from granting intellectual property protection to inventions and text that are public domain under federal law. As this essay show, *facts* are part of the public domain.

The legislative history of the Copyright Act of 1976 says:

“Misappropriation” is not necessarily synonymous with copyright infringement, and thus a cause of action labeled as “misappropriation” is not preempted if it is in fact based neither on a right within the general scope of copyright as specified by section 106 nor on a right equivalent thereto. For example, state law should have the flexibility to afford a remedy (under traditional principles of equity) against a consistent pattern of unauthorized appropriation by a competitor of the facts (i.e., not the literary expression) constituting “hot” news, whether in the traditional mold of *International News Service v. Associated Press*, 248 U.S. 215 (1918), or in the newer form of data updates from scientific, business, or financial data bases.

House of Representatives Report Nr. 94–1476 at 132, reprinted in 1976 U.S.CODE CONGRESSIONAL & ADMINISTRATIVE NEWS 5659, 5748. Quoted in *National Basketball Ass'n v. Motorola, Inc.*, 105 F.3d 841, 850 (2dCir. 1997).

Here is a terse list of some important cases that consider preemption of state law that mention either *International News*, *Jeweler's Circular*, or misappropriation:

- Moreover, the leading case affording a remedy for mere copying, *International News Serv. v. Associated Press*, 1918, 248 U.S. 215, 39 S.Ct. 68, 63 L.Ed. 211, is no longer authoritative for a least two reasons: [footnote omitted] it was decided as a matter of general federal law before the decision in *Erie R. R. v. Tompkins*, 1938, 304 U.S. 64, 58 S.Ct. 817, 82 L.Ed. 1188; and, as it prohibited the copying of published written matter that had not been copyrighted (indeed, as news it could not be copyrighted, 248 U.S. at 234, 39 S.Ct. 68, 63 L.Ed. 211), it has clearly been overruled by the Supreme Court's recent decisions in *Sears, Roebuck & Co. v. Stiffel Co.*, 1964, 376 U.S. 225, 84 S.Ct. 784, 11 L.Ed.2d 661, and *Compco Corp. v. Day-Brite Lighting, Inc.*, 1964, 376 U.S. 234, 84 S.Ct. 779, 11 L.Ed.2d 669. While this normally would not prevent the state

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<sup>92</sup> *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225 (1964); *Compco Corp. v. Day-Brite Lighting, Inc.*, 376 U.S. 234 (1964).

court from adopting the reasoning of *INS* in fashioning a rule of state law, we think it important to consider the scope of state power in this area in view of *Sears* and *Compro*. *Columbia Broadcasting System, Inc. v. DeCosta*, 377 F.2d 315, 318-319 (1stCir. 1967);<sup>93</sup>

In 1980, the Second Circuit wrote:

- Finally, we affirm Judge Metzner's rejection of Hoehling's claims based on the common law of "unfair competition." Where, as here, historical facts, themes, and research have been deliberately exempted from the scope of copyright protection to vindicate the overriding goal of encouraging contributions to recorded knowledge, the states are preempted from removing such material from the public domain. See, e. g., *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225, 83 S.Ct. 1868, 10 L.Ed.2d 1050 (1964); *Compro Corp. v. Day-Brite Lighting, Inc.*, 376 U.S. 234, 84 S.Ct. 779, 11 L.Ed.2d 669 (1964). "To forbid copying" in this case, "would interfere with the federal policy . . . of allowing free access to copy whatever the federal patent and copyright laws leave in the public domain." *Id.* at 237, 84 S.Ct. at 782.  
*Hoehling v. Universal City Studios*, 618 F.2d 972, 980 (2dCir. 1980);

See also, e.g.,

- *Financial Information, Inc. v. Moody's Investors Service*, 808 F.2d 204, 208 (2dCir. 1986) ("We have held that 'state law claims that rely on the misappropriation branch of unfair competition are preempted.' *Warner Bros., Inc. v. American Broadcasting Companies, Inc.*, 720 F.2d 231, 247 (2dCir. 1983).");
- *National Basketball Ass'n v. Motorola, Inc.*, 105 F.3d 841, 847-853 (2dCir. 1997) (Rejecting misappropriation claim as preempted by copyright statutes. But at 845: "Based on legislative history of the 1976 amendments, it is generally agreed that a 'hot-news' *INS*-like claim survives preemption." See also at 850.);
- *Fairway Constructors, Inc. v. Ahern*, 970 P.2d 954 (Ariz.App. 1998) (Claim preempted. Does not cite *Feist*.);
- *Alcatel USA, Inc. v. DGI Technologies, Inc.*, 166 F.3d 772, 785-789 (5thCir. 1999) (misappropriation claim preempted by copyright statutes.);
- *LinkCo, Inc. v. Fujitsu Ltd.*, 230 F.Supp.2d 492, 500 (S.D.N.Y. 2002) ("The central principle underlying a claim for unfair competition under New York law is that one may not misappropriate the results of the labor, skill, and expenditures of another." Does not mention *Feist*.);
- *Dresser-Rand Co. v. Virtual Automation Inc.*, 361 F.3d 831, 839 (5thCir. 2004) (Does not mention *Feist*.);
- *Stromback v. New Line Cinema*, 384 F.3d 283, 300-302 (6thCir. 2004) (misappropriation claim by copyright statutes.);

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<sup>93</sup> With all due respect to the First Circuit, it is *not* clear that the U.S. Supreme Court overruled *International News* in 1964. Neither of these 1964 decisions cited *International News*.

- *ITC Ltd. v. Punchgini, Inc.*, 880 N.E.2d 852, 858 (N.Y. 2007) (“After the United States Supreme Court sanctioned the misappropriation theory of unfair competition in *International News Service v. Associated Press*, 248 U.S. 215, 39 S.Ct. 68, 63 L.Ed. 211 (1918), ‘[t]he principle that one may not misappropriate the results of the skill, expenditures and labors of a competitor has ... often been implemented in [New York] courts’ [citations omitted]” Does not mention *Feist*.);
- *X17, Inc. v. Lavandeira*, 563 F.Supp.2d 1102 (C.D.Cal. 2007) (Claim not preempted Does not cite *Feist*.);
- *Barclays Capital Inc. v. Theflyonthewall.com, Inc.*, 650 F.3d 876 (2dCir. 2011).

When *Feist* denied copyrightability to compilations of facts in obvious ways and also denied copyright protection for the labor, skill, and expense of the first author, *Feist* also killed off the tort of unfair competition associated with such compilations, including computer databases. The Copyright Act of 1976 contains a preemption of state law by federal law. If federal copyright law will not punish copying of a compilation of facts, then no state law can punish such copying. Alternatively, if a work is in the public domain (*unprotected* by copyright), then state law can not punish the copying of it.

Worse, *Feist*, declared that its criterion for copyrightability had a constitutional basis, which will scuttle any future attempt by Congress to amend the copyright statute to allow protection for low-authorship works. If Congress were to use its interstate commerce clause powers to protect low-authorship works, then there would be a conflict between the copyright clause in the U.S. Constitution and the interstate commerce clause in the U.S. Constitution. Because protection against copying low-authorship works appears closer to copyright than to interstate commerce, I expect the copyright clause (as interpreted by the Supreme Court in *Feist*) to dominate, and the statute to be declared unconstitutional. This constitutional problem has been articulately discussed by Heald,<sup>94</sup> Ginsburg,<sup>95</sup> Raskind,<sup>96</sup> and Patry,<sup>97</sup> and I have nothing to add to their analysis of the problem.

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<sup>94</sup> Paul J. Heald, “The Vices of Originality,” 1991 SUPREME COURT REVIEW 143 (1991).

<sup>95</sup> Jane C. Ginsburg, “No ‘Sweat’? Copyright and Other Protection of Works of Information After *Feist v. Rural Telephone*,” 92 COLUMBIA LAW REVIEW 338 (March 1992).

<sup>96</sup> Leo J. Raskind, “Assessing the Impact of *Feist*,” 17 UNIVERSITY OF DAYTON LAW REVIEW 331 (Winter 1992).

<sup>97</sup> William Patry, “The Enumerated Powers Doctrine and Intellectual Property: An Imminent Constitutional Collision,” 67 GEORGE WASHINGTON LAW REVIEW 359 (Jan 1999).

## Independent Creation Is *Neither Infringement Nor Unfair*

Under copyright law, a competitor is free to expend labor and expense to *independently* compile and check facts, because there is no monopoly on facts or ideas,<sup>98</sup> and also because independent creation is necessary to be *original* under the copyright law. In independent creation, nothing is taken from the first author, so there is *neither* copyright infringement, misappropriation, *nor* unfair competition. The U.S. Supreme Court tersely said:

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)

*Feist Publications, Inc. v. Rural Telephone Service Co.*, 499 U.S. 340, 345 (U.S. 1991).

For at least one hundred years, lower federal courts have declared that independent creation is *not* copyright infringement. In 1903 the U.S. Court of Appeals in New York City wrote a public policy justification for allowing subsequent authors to make an “independent examination” of sources cited by previous authors:

It is well known that Motley produced his great work after years of patient research among the original archives preserved at The Hague and other European capitals and that he brought to light and translated documents which had lain dormant for centuries. The data thus collected enabled him to tread an almost undiscovered path of history. But can it be contended that a subsequent historian of the Netherlands would be debarred from consulting the same sources of information because he was guided to them by a list made up from Motley's footnotes? It is thought not. The literature of the law as it exists to-day is the result of evolution. Each author has had the benefit of all that preceded him and has thus been able to add something to the common fund intended to lighten the labors of the profession. It would be a serious blow to jurisprudence were the rule enunciated that the author of a law book is precluded from taking a list of authorities cited by a previous writer on the same subject and making an independent examination of them. Individuals might profit but the development of legal science would be hampered by such a rule, — a rule not of advancement but of retrogression

*Edward Thompson Co. v. American Law Book Co.*, 122 F. 922, 925 (2dCir. 1903).

Furthermore, see, e.g.,

- *Dun v. Lumbermen's Credit Ass'n*, 144 F. 83, 84 (7thCir. 1906) (“Appellees claim that they used the Dun book only to check names to see if there were any persons concerning whom they had not already obtained information by independent investigation, and to compare Dun ratings in about one case in a hundred with their latest information which indicated a marked change from former ratings; and that in every instance the material in their publication was

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<sup>98</sup> *Ideas* are excluded from copyright protection by 17 U.S.C. § 102(b). *Facts* are excluded from copyright protection by the U.S. Supreme Court: *Feist Publications, Inc. v. Rural Telephone Service Co.*, 499 U.S. 340, 344-345 (1991) (“The most fundamental axiom of copyright law is that ‘[n]o author may copyright his ideas or the facts he narrates.’ *Harper & Row, Publishers, Inc. v. Nation Enterprises*, 471 U.S. 539, 556 ... (1985).”).

obtained by their own labors in independent investigation. If such was the case, the use was fair. DRONE ON COPYRIGHT, p. 396; *Edward Thompson Co. v. American Law Book Co.*, 122 Fed. 922, 59 C.C.A. 148, 62 L.R.A. 607; *Dun v. International Mercantile Agency* (C.C.) 127 Fed. 173.”), *aff’d*, 209 U.S. 20 (U.S. 1908);

- *Fred Fisher, Inc., v. Dillingham*, 298 F. 145, 147 (S.D.N.Y. 1924) (“... the law imposes no prohibition upon those who, without copying, independently arrive at the precise combination of words or notes which have been copyrighted.”) (Learned Hand, J.);
- *Yale University Press v. Peterson*, 40 F.2d 290, 292 (S.D.N.Y. 1930) (“Weil in the LAW OF COPYRIGHT says, § 629, at page 234:  
As long as the author of the second work has not copied his predecessor's work, as distinguished from copying their common material, his predecessor cannot complain because the former has achieved the same, or an essentially similar, result. He cannot complain even though his work, by indicating the common sources, has facilitated, or led to, consultation of those by his successor. The scope of copyright in such works, which is discussed elsewhere, is then limited so as simply to prevent a subsequent laborer in the same vineyard from seeking to save time or trouble by copying his predecessor's work.”);
- *Alfred Bell & Co. v. Catalda Fine Arts*, 191 F.2d 99, 103 (2dCir. 1951) (“So we have held that ‘independent reproduction of a copyrighted \* \* \* work is not infringement’ .... [citing *Arnstein v. Edward B. Marks Music Corp.*, 2 Cir., 82 F.2d 275; *Ricker v. General Electric Co.*, 2 Cir., 162 F.2d 141, 142.] .... The ‘author’ is entitled to a copyright if he independently contrived a work completely identical with what went before; similarly, although he obtains a valid copyright, he has no right to prevent another from publishing a work identical with his, if not copied from his.”);
- *G. R. Leonard & Co. v. Stack*, 386 F.2d 38, 39 (7thCir. 1967) (“It is recognized that a compiler of a directory or the like may make a fair use of an existing compilation serving the same purpose if he first makes an honest, independent canvass; he merely compares and checks his own compilation with that of the copyrighted publication; and publishes the result after verifying the additional items derived from the copyrighted publication. *Dun v. Lumbermen's Credit Ass'n*, 7 Cir., 144 F. 83; Amdur, COPYRIGHT LAW AND PRACTICE (1936), p. 786”);<sup>99</sup>
- *Wainwright Securities, Inc. v. Wall St. Transcript Corp.*, 558 F.2d 91, 96 (2dCir. 1977) (“Unlike traditional news coverage, moreover, [defendant] did not provide independent analysis or research; it did not solicit comments on the same topics from other financial analysts; and it did not include any criticism, praise, or other reactions by industry officials or investors.” Instead, defendant copied from plaintiff’s work.);
- *Rockford Map Publishers, Inc. v. Directory Service Co. of Colorado Inc.*, 768 F.2d 145, 149 (7thCir. 1985) (“All concede, as Learned Hand said in *Jewelers' Circular*, supra, 274 F. at 935, that ‘a second compiler may check back his independent work upon the original compilation.’ The right to ‘check back’ does not imply a right to start with the copyrighted

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<sup>99</sup> Cited in *Schroeder v. William Morrow & Co.*, 566 F.2d 3, 6 (7thCir. 1977).



work. Everyone must do the same basic work, the same ‘industrious collection.’ ”), *cert. denied*, 474 U.S. 1061 (1986);<sup>100</sup>

- *Whelan Associates, Inc. v. Jaslow Dental Laboratory, Inc.*, 797 F.2d 1222, 1227, n.7 (3rd Cir. 1986) (“17 U.S.C. § 106 (1982), which prescribes copyright holders’ exclusive rights, forbids the copying of copyrighted works. The independent creation of even identical works is therefore not a copyright infringement, and independent creation is a complete defense to a claim of copyright infringement. See also *Fred Fisher, Inc. v. Dillingham*, 298 F. 145, 147 (S.D.N.Y. 1924) (L. Hand, J.) (“the law imposes no prohibition upon those who, without copying, independently arrive at the precise combination of words or notes which have been copyrighted.”).”);
- *Baltimore Orioles, Inc. v. Major League Baseball Players Ass’n*, 805 F.2d 663, 668 and n.6 (7th Cir. 1986) (“The requirement of originality actually subsumes two separate conditions, i.e., the work must possess an independent origin and a minimal amount of creativity. [citations omitted] It is important to distinguish among three separate concepts — originality, creativity, and novelty. A work is original if it is the independent creation of its author.”);
- *Keeler Brass Co. v. Continental Brass Co.*, 862 F.2d 1063, 1065 (4th Cir. 1988) (“... courts have generally accepted circumstantial evidence to create a presumption of copying. To raise this presumption, the plaintiff must show that the alleged copier had access to the material and that the original material and the alleged copy are substantially similar. [citation omitted] The defendant then must produce evidence to rebut the presumption of copying made by the showing of access and substantial similarity. For example, the defendant may rebut the presumption with evidence of independent creation. See, e.g., *Original Appalachian Artworks, Inc. v. Toy Loft, Inc.*, 684 F.2d 821, 829 (11th Cir. 1982)”);
- *Waldman Pub. Corp. v. Landoll, Inc.*, 43 F.3d 775, 782 (2d Cir. 1994) (“Even if a work is completely identical to a prior work, it may be considered original if it is not copied from the prior work but is rather the product of an independent effort by the author.”).

Notice that independent creation of a database neatly avoids the problem of wrongfully copying a competitor’s work, thus pirating the original creator’s labor, skill, and expense. Independent creation avoids *both* the copyright infringement problem *and* the unfair competition (misappropriation) problem. And independent creation — unlike mere copying — makes it possible that an independently created work will be in some sense “better” than pre-existing works, thus benefitting society with improved expression of facts and ideas.

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<sup>100</sup> Cited in *Illinois Bell Telephone Co. v. Haines and Co., Inc.*, 905 F.2d 1081, 1086 (7th Cir. 1990), *vacated in light of Feist*, 499 U.S. 944 (1991). The citation to *Jeweler’s Circular* in *Rockford Map* shows that unfair competition and copyright law are connected in many judges’ minds.

## Novelty Not Required

As explained in the previous section of this essay, copyright only requires independent creation. It is well-settled law that copyright does *not* require novelty. The rejection of novelty as a requirement for copyright is another way of saying that independent creation is acceptable for copyright.

The U.S. Supreme Court has said:

- *Baker v. Selden*, 101 U.S. 99, 102 (U.S. 1879) (“The copyright of the book, if not pirated from other works, would be valid without regard to the novelty, or want of novelty, of its subject-matter. The novelty of the art or thing described or explained has nothing to do with the validity of the copyright. To give to the author of the book an exclusive property in the art described therein, when no examination of its novelty has ever been officially made, would be a surprise and a fraud upon the public. That is the province of letters-patent, not of copyright. The claim to an invention or discovery of an art or manufacture must be subjected to the examination of the Patent Office before an exclusive right therein can be obtained; and it can only be secured by a patent from the government.”);
- *Mazer v. Stein*, 347 U.S. 201, 218 (U.S. 1954) (“The copyright protects originality rather than novelty or invention ....”);
- *Feist*, 499 U.S. 340, 345 (U.S. 1991) (“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.”);

The U.S. Courts of Appeals since the year 1970 have said (*not* including quotations from the above-cited U.S. Supreme Court cases):

- *Roth Greeting Cards v. United Card Co.*, 429 F.2d 1106, 1109 (9th Cir. 1970) (“But the originality necessary to support a copyright merely calls for independent creation, not novelty. *Alfred Bell & Co., Ltd. v. Catalda Fine Arts, Inc.*, 191 F.2d 99, 102 (2d Cir. 1951). Cf. *Baker v. Selden*, 101 U.S. 99, 102-103, 25 L.Ed. 841 (1879).”);
- *Runge v. Lee*, 441 F.2d 579, 581 (9th Cir. 1971) (“The standard of ‘novelty’ urged by appellants is applicable to patents, but not copyrights. The copyright standard is one of ‘originality’: ....”), *cert. den.*, 404 U.S. 887 (U.S. 1971);
- *Puddu v. Buonamici Statuary, Inc.*, 450 F.2d 401, 402 (2d Cir. 1971) (Friendly, C.J.) (“Originality sufficient for copyright protection exists if the ‘author’ has introduced any element of novelty as contrasted with the material previously known to him.”);
- *L. Batlin & Son, Inc. v. Snyder*, 536 F.2d 486, 490 (2d Cir. 1976) (“Originality is, however, distinguished from novelty; there must be independent creation, but it need not be invention in the sense of striking uniqueness, ingeniousness, or novelty, since the Constitution differentiates ‘authors’ and their ‘writings’ from ‘inventors’ and their ‘discoveries.’ *Alfred Bell & Co. v. Catalda Fine Arts, Inc.*, supra, 191 F.2d at 100; *Runge v. Lee*, 441 F.2d 579, 581 (9th Cir.), *cert. denied*, 404 U.S. 887, 92 S.Ct. 197, 30 L.Ed.2d 169 (1971). Originality

means that the work owes its creation to the author and this in turn means that the work must not consist of actual copying. *Alfred Bell & Co. v. Catalda Fine Arts, Inc.*, supra, 191 F.2d at 102-03; *Sheldon v. Metro-Goldwyn Pictures Corp.*, 81 F.2d 49, 54 (2d Cir. 1936), *aff'd*, 309 U.S. 390, 60 S.Ct. 681, 84 L.Ed. 825 (1940).”);

- *Apple Computer, Inc. v. Franklin Computer Corp.*, 714 F.2d 1240, 1253 (3rd Cir. 1983) (“As we stated in *Franklin Mint Corp. v. National Wildlife Art Exchange, Inc.*, 575 F.2d 62, 64 (3d Cir.), *cert. denied*, 439 U.S. 880, 99 S.Ct. 217, 58 L.Ed.2d 193 (1978), ‘Unlike a patent, a copyright protects originality rather than novelty or invention.’ ”);
- *M. Kramer Mfg. Co., Inc. v. Andrews*, 783 F.2d 421, 433-434 (4th Cir. 1986) (“The legislative history, however, demonstrates that Congress purposely omitted any such definition because it accepted the standards as ‘established [for originality] by the courts under the present copyright law [i.e., the Act of 1909],’ though it did explain in that connection that ‘[t]his standard [did] not include requirements of novelty, ingenuity, or esthetic merit’ and added that ‘there [was] no intention to enlarge the standard of copyright protection to require them.’ ”);
- *Cohen v. Paramount Pictures Corp.*, 845 F.2d 851, 854 (9th Cir. 1988) (“The essence of a copyright protection is the protection of originality rather than novelty or invention.” *Jondora Music Publishing Co. v. Melody Recordings, Inc.*, 506 F.2d 392, 395 (3d Cir.), *cert. denied*, 421 U.S. 1012, 95 S.Ct. 2417, 44 L.Ed.2d 680 (1975).”);
- *Gaste v. Kaiserman*, 863 F.2d 1061, 1066 (2d Cir. 1988) (“It is well established that the originality requirement for obtaining a copyright is an extremely low threshold, unlike the novelty requirement for securing a patent.”);
- *Key Publications, Inc. v. Chinatown Today Pub. Enterprises*, 945 F.2d 509, 513-514 (2d Cir. 1991) (“Moreover, for purposes of copyright, originality is not synonymous with novelty. .... The lack of novelty is, as noted, not a bar to copyright protection.”);
- *Boisson v. Banian, Ltd.*, 273 F.3d 262, 270-271 (2d Cir. 2001) (“Absent evidence of copying, an author is entitled to copyright protection for an independently produced original work despite its identical nature to a prior work, because it is independent creation, and not novelty that is required. See 1 *Nimmer & Nimmer*, supra, § 2.01[A], at 2-9; see also *Feist Publ'ns*, 499 U.S. at 345, 111 S.Ct. 1282 (explaining that a work is ‘original’ for the purposes of copyright law so long as it was ‘independently created’). Judge Jerome Frank said that an ‘“author” is entitled to a copyright if he independently contrived a work completely identical with what went before.’ *Alfred Bell & Co. v. Catalda Fine Arts, Inc.*, 191 F.2d 99, 103 (2d Cir. 1951).”);
- *Jada Toys, Inc. v. Mattel, Inc.*, 518 F.3d 628, 636 (9th Cir. 2008) (“The protected elements of a work are those elements which are ‘original,’ which is to say they are the product of ‘independent creation, not novelty.’ *Roth Greeting Cards v. United Card Co.*, 429 F.2d 1106, 1109 (9th Cir. 1970) (citations omitted).”).

In summary, novelty is *not* a requirement for copyright.

## Copyright for Photographs

When I was in law school in 1997 and taking my first class in copyright law, I read the *Feist* decision that absolutely prohibits copyright for facts, but I also knew that photographs were routinely copyrighted. These two rules of law seemed contradictory to me.

As a physicist, I know that the light coming through a camera lens is physical reality, which is a fact. A photograph of a sunset or lightning captures the image that is presented by nature that is *not* created by an author (i.e., photographer). While a photographer might plan to travel to a good place to photograph a sunset, as well as wait and select a good time to photograph a sunset, the sunset is still a natural phenomenon, created (i.e., authored) by nature. There may be a good amount of skill and technology involved in photographing lightning, especially during the daytime when there is sunlight, but the lightning is still a natural phenomena, created (i.e., authored) by nature, and the light that enters a camera lens remains a fact. The same is true of photographs of buildings and landscapes: the photograph records facts that exist at the instant the photograph was made.

Let me make clear that I am *not* arguing that photographs *should* be uncopyrightable material. I am only suggesting that applying the rule from *Feist* that facts are not copyrightable — a rule with which I strongly disagree — leads to the conclusion that photographs of nature, buildings, and other factual content are not copyrightable. Because photographs have been copyrightable in the USA since 1865 — and because photographs *should* be copyrightable — the holding about uncopyrightable facts in *Feist* is wrong.

### history of copyrighting photographs

Photographs have been copyrightable in the USA since Congress amended the Copyright statute in 1865: “Congress, proceeding upon this view, by the act of March 3, 1865 (13 STAT. 540), extended the protection of the copyright act to this new art of photography.” *Wood v. Abbott*, 30 F.Cas. 424, 425 (C.C.N.Y. 1866). Five years later, the Copyright Act of 1870, § 86, specifically included “photograph or negative thereof” as copyrightable material. 16 STATUTES AT LARGE 198, 212 (July 1870).

The rule of law about copyright of photographs was established in a U.S. Supreme Court case in the year 1884. *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53 (1884). The plaintiff, Sarony, had made a photograph of Oscar Wilde. The Court held that a photographer exercises originality and creativity in composing the photograph. That may be true for posing a subject for a portrait, but it is *not* true for a photograph of a natural phenomenon. And the photographer never creates the subject of a portrait — the appearance of a person should belong to the person, *not* to the photographer.

In *Sarony*, the U.S. Supreme Court said:

The third finding of facts says, in regard to the photograph in question, that it is a “useful, new, harmonious, characteristic, and graceful picture, and that plaintiff made the same \* \* \* entirely from his own original mental conception, to which he gave visible form by posing the said Oscar Wilde in front of the camera, selecting and arranging the costume, draperies, and other various accessories in said photograph, arranging the subject so as to present graceful outlines, arranging and disposing the light and shade, suggesting and evoking the desired expression, and from such disposition, arrangement, or representation, made entirely by plaintiff, he produced the picture in suit.” These findings, we think, show this photograph to be an original work of art, the product of plaintiff’s intellectual invention, of which plaintiff is the author, and of a class of inventions for which the constitution intended that congress should secure to him the exclusive right to use, publish, and sell, as it has done by section 4952 of the Revised Statutes.

*Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 60 (1884). Note that the Court regarded the copyrighted photograph as “an original work of art” because of the manner in which the photographer posed the subject. The remarks about “selecting and arranging the costume, draperies, and other various accessories” can not be relevant to copyrightability, because a photograph of Wilde on a street or in a lecture hall would also be copyrightable.

There is a simple explanation for how this problem arose. The U.S. Supreme Court held that photographs were copyrightable in 1884, when there was no judicial discussion about copyrightability of facts. As explained above (beginning on page 23), the first mention that facts are in the public domain was in the year 1913. The famous early cases involved facts in the context of journalists reporting news.<sup>101</sup> Later, there were cases involving copyright of facts in biographies. During the years 1980-1991, various courts in the USA made a well-settled, absolute rule of law that facts were never copyrightable, without recognizing that photographs — which are routinely copyrighted — are factual.

Also, when the U.S. Supreme Court held in 1884 that photographs were copyrightable, there was considerable labor and skill involved in making of a photograph, similar to sculpture and paintings. The photographer had to coat a glass plate with an emulsion, insert the plate into a camera, expose the plate, and then develop the image in a darkroom. I wonder if the wizardry of photography in 1884 influenced the Court’s decision to permit copyright on photographs.

In 1888, Kodak began selling cameras for their film on rolls, which allowed photographers to mail the camera containing the exposed film to a processing laboratory.<sup>102</sup> Since the late 1990s, photographs are even easier with digital cameras that automatically determine the correct exposure

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<sup>101</sup> See, e.g., *International News Service v. Associated Press*, 248 U.S. 215 (1918); *Chicago Record-Herald Co. v. Tribune Ass’n*, 275 F. 797 (7thCir. 1921).

<sup>102</sup> Remember Kodak’s famous slogan: “You press the button, we do the rest.”

and automatically focus the lens. Improvements in technology mean that photographer needs less skill to make useful photographs.

In April 2013, I made a quick search on Westlaw and found several judicial opinions that mentioned copyrightability of photographs in context of the rule that facts are *not* copyrightable. See, e.g.,

- *Ets-Hokin v. Skyy Spirits, Inc.*, 225 F.3d 1068, 1077 (9thCir. 2000) (At 1080-81, copyrighted photograph of vodka bottle does not make either bottle or its label copyrightable.); See also the appellate opinion after remand: *Ets-Hokin v. Skyy Spirits, Inc.*, 323 F.3d 763, 765-766 (9thCir. 2003);
- *Meshwerks, Inc. v. Toyota Motor Sales U.S.A., Inc.*, 528 F.3d 1258, 1264-1265 (10thCir. 2008) (“As Professor Nimmer has commented in connection with the predecessor technology of photography, ‘[a]s applied to a photograph of a pre-existing product, that bedrock principle [of originality] means that the photographer manifestly cannot claim to have originated the matter depicted therein.... The upshot is that the photographer is entitled to copyright solely based on lighting, angle, perspective, and the other ingredients that traditionally apply to that art-form.’ NIMMER ON COPYRIGHT § 3.03[C][3].”);
- *Harney v. Sony Pictures Television, Inc.*, 704 F.3d 173, 181-182 (1stCir. 2013) (At 182: “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.” At 185: “As described above, Harney created an original protectible [sic] image. His photograph may not be reproduced in its entirety without his permission unless the copier is able to prove fair use.”).

In summary, *Feist* says that facts are never copyrightable. But photographs are factual and photographs are copyrightable. This contradiction tells me that the absolute rule that facts are *never* copyrightable is too simple. An appropriate rule of law would give legal protection against copying of some kinds of facts. If *all* photographs are copyrightable, then expression of other facts personally observed by the author (e.g., scientific measurements, results of calculations) should also be copyrightable.

photograph of public-domain artistic work

The copyrightability of photographs brings me to another problem with conventional copyright law. Suppose one makes a copy of a public-domain artistic work — either a photograph or paints a picture. In this context, the copy is protected by copyright, but the original is *not* protected by copyright. As Justice Holmes of the U.S. Supreme Court famously said: “Others are free to copy the original. They are not free to copy the copy. [citations omitted]” *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 249 (1903). An artist who paints a copy is arguably engaged in some creative activity, even though she is making a copy. But someone who takes a photograph of a painting typically uses little or no creativity, especially with modern digital cameras that automatically calculate proper exposure and even focus. The law — quite properly — does *not* regard a person who operates a photocopy machine as an author. Why is a camera

different from a photocopy machine? It seems clear to me that a photograph of a public-domain artistic work should *not* be copyrightable.

Is taking a photograph of a natural phenomenon (e.g., sunset or lightning) making a copy of the natural phenomenon in the public domain (i.e., making a copy of an uncopyrightable fact)? I think the answer is yes, so such photographs should not be copyrightable, unless we change the legal rule about copyright of facts.

Someone might disagree, saying there is no danger of monopolizing the fact, since anyone is free to take a photograph of a specific natural phenomenon, and independent creation is *not* copyright infringement. But that same argument could be made in *Rosemont* and progeny about facts in biographies, where courts held that facts could not be copyrighted.

#### copy of copyrighted work

Making an unauthorized, verbatim copy of any copyrighted work — regardless of whether by using a camera, photocopy machine, digital scanner, copying a digital file, retyping text into a wordprocessing program, etc. — is copyright infringement, unless it can be justified under fair use. The key issue here is that mere copying involves *neither* originality, creativity, *nor* production of something new (i.e., a transformative<sup>103</sup> use).

#### skill, merit, quality *not* relevant to copyright

A defender of copyrightability of photographs will probably mention the skill and effort needed to produce a photograph: selection of lens focal length, selection of aperture (f-stop), selection of exposure time, selection of a type of film, selection of a chemical developer (which can depend on the strength of the solution and temperature), etc. While digital cameras avoid work with chemicals in a darkroom, one can do equivalent processing of digital images with software, e.g., Adobe Photoshop.

A camera traditionally had three adjustments: focus, lens aperture, and shutter speed. A photocopy machine has a control for exposure. Software for use by an optical scanner typically has two controls: brightness and contrast. We do not regard the making of copies with a photocopy machine or optical scanner as copyrightable, and I strongly agree with that result. So why should we regard making a permanent record of an image with a camera as copyrightable?

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<sup>103</sup> Leval, "Toward a Fair Use Standard," 103 Harv.L.Rev. 1105, 1111 (1990), accepted in *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 578-579 (1994).

In this context, note that it is well-settled law that artistic merit, literary merit, or quality of work are all *irrelevant* to copyrightability. In 1903, Justice Oliver Wendell Holmes decreed that artistic merit or literary quality was irrelevant to copyright. *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251-252 (1903). Also see, e.g.,

- *Alfred Bell & Co. v. Catalda Fine Arts*, 191 F.2d 99, 102-103 (2dCir. 1951) (“No matter how poor artistically the author’s addition, it is enough if it be his own.”);
- *Rushton v. Vitale*, 218 F.2d 434, 435 (2dCir. 1955) (“Copyright protection extends to any production of some originality and novelty, regardless of its commercial exploitation or lack of artistic merit. *Mazer v. Stein*, 347 U.S. 201; ....”);
- *Tennessee Fabricating Co. v. Moultrie Mfg. Co.*, 421 F.2d 279, 281 (5thCir. 1970) (“On the other hand, lack of artistic merit is no bar to copyright.”), *cert. denied*, 398 U.S. 928 (1970);
- *Mitchell Bros. Film Group v. Cinema Adult Theater*, 604 F.2d 852, 856-857 (5thCir. 1979) (“In our view, the absence of content restrictions on copyrightability indicates that Congress has decided that the constitutional goal of encouraging creativity would not be best served if an author had to concern himself not only with the marketability of his work but also with the judgment of government officials regarding the worth of the work. .... Denying copyright protection to works adjudged obscene by the standards of one era would frequently result in lack of copyright protection (and thus lack of financial incentive to create) [footnote omitted] for works that later generations might consider to be not only non-obscene but even of great literary merit.”), *cert. den.*, 445 U.S. 917 (1980).

In 2008, the U.S. Court of Appeals in Utah summarized the law:

In addition, the work must “possesses at least some minimal degree of creativity,” *Feist*, 499 U.S. at 345, 111 S.Ct. 1282; ..., though this is not to say that to count as containing a minimal degree of creativity a work must have aesthetic merit in the minds of judges (arguably not always the most artistically discerning lot). As the Court explained through Justice Holmes, even “a very modest grade of art has in it something irreducible, which is one man's alone. That something he may copyright...” *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 250, 23 S.Ct. 298, 47 L.Ed. 460 (1903); see also *Feist*, 499 U.S. at 345 (all that’s needed is some creative spark, “no matter how crude, humble, or obvious”).

*Meshwerks, Inc. v. Toyota Motor Sales U.S.A., Inc.*, 528 F.3d 1258, 1263 (10thCir. 2008), *cert. den.*, 555 U.S. 1138 (2009).

The well-settled law that considerations of artistic merit, literary merit, quality of work, or skill of author (i.e., photographer) are *irrelevant* to copyrightability make it more difficult to justify copyright for photographs that are nicely composed, properly exposed, etc. While there is no doubt that there is skill involved in making a good photograph, *Feist* killed any copyright protection for skill by an author, and preemption in the Copyright Act of 1976 killed unfair competition for copying.



## Valuation of Writing

As an author, it is obvious to me that the more time that I spend researching, writing, and revising an article or essay, the more valuable that work is. But, as an attorney, I understand that copyright law ignores both the number of hours of labor and the expense required to create a work. Authors value their time, while copyright law does *not* value time and expense of creation, which leads to legal results that diverge from the expectations of authors.

An alternative is to value writing according to how much someone is willing to pay for the writing. The problem with this alternative is that some groups of people who need scholarly writing can not afford to pay for what they need, for example most individual people involved in litigation need legal research and preparation of briefs, but can not afford to pay for professional services. This kind of problem occurs when practicing attorneys reject the major online legal databases like Westlaw as too expensive (meaning their clients can not afford to reimburse the attorney's expense), so the lawyer simply cites a few famous cases from a law school textbook or from a cursory reading of some treatise in a law library, which results in less effective advocacy. Incidentally, the problem of expensive proprietary legal databases like Westlaw could be neatly solved *if* the state and federal governments would simply put official versions of all of their statutes, judicial opinions, and government regulations at government websites with a good search engine.

Similarly, the results of scientific research is necessary for technological innovation that drives a modern economy, as well as other real benefits such as prevention of environmental damage or increasing health of people. Consequently, the government supplies financial support for most scientific research in the USA, recognizing the benefits of the research will be available to everyone in society, including those who are unaware of how they are benefitted by the results of scientific research. Except for a few nonprofit organizations with a narrow focus on specific medical problems, individual people are generally unwilling to donate money toward scientific research, because those people do not understand the value of such research, even though they benefit at least indirectly from some scientific research.

Scholarly writing in other areas, such as law or history, can eventually lead to changes in law that reduce injustices and improve our society. Again, individual people either are unable to afford to subsidize such scholarly research, or are unappreciative of the eventual benefits of such research. Unfortunately, governments are less interested in funding research in the humanities than research in medicine, science, or engineering. So scholarly writing in law and history tends to be a spare-time project funded by individual professors who research and write articles.

*If* there were strong copyright protection for compilations of facts — including protecting the labor and expense of collecting and checking those facts — then perhaps royalties from copyrights could reward and encourage scholarly research.

## Reviving Unfair Competition

this section is a preliminary draft

I would prefer that Congress try to legislatively overrule the U.S. Supreme Court's decision in *Feist* by amending § 102 of the Copyright Act of 1976 to explicitly recognize two different classes of original works of authorship, as proposed by Prof. Ginsburg (see page 5, above). That would bring low-authorship works into mainstream copyright law, and restore the law prior to *Feist* (and also prior to the U.S. Courts of Appeals decisions in *Hoehling* and *Miller*). When the U.S. Supreme Court reconsiders copyright law, it could defer to Congress and overrule its prior decision in *Feist* — or the Court might invalidate the new statute and retain *Feist*.

Alternatively, Congress could create a new form of intellectual property where labor, skill, and/or expense in discovering, collecting, selecting, verifying, and/or arranging useful facts is an adequate basis (without the need to be creative) for legal protection against verbatim copying. Because such a new law will look like a mutant form of copyright, I think it would be preferable first to try to include it in copyright law, before trying to create a new form of intellectual property. On the other hand, specialists in copyright law who want to keep copyright law pure (i.e., uncontaminated by unfair competition) might prefer that Congress create a new form of intellectual property to protect facts and compilation of facts, as well as protect/reward an author's investment of labor, skill, and/or expense in research.

After reading many cases, I think judges reached a fairer — or more just — result when they “contaminated” copyright law with principles from unfair competition, which motivates me to recommend expanding copyright law to include unfair competition. Expanding copyright law to include unfair competition will move into the mainstream the long line of cases (cited above, beginning at page 46) holding that copyright protects labor or effort of authors. Expanding copyright law will recognize that the natural inclination of these judges was correct.

As proposed by Prof. Ginsburg,<sup>104</sup> three basic changes need to be made in the Copyright Act of 1976. First, 17 U.S.C. § 102(a) needs to be modified to permit copyright of facts or a compilation of facts if both:

- A. the work is either publicly displayed (e.g., posted at a website) or published,<sup>105</sup> *and*
- B. either
  - 1. if there is an original selection, coordination, or arrangement of the facts<sup>106</sup>
  - or
  - 2. if the author of an original compilation of facts expended significant labor, skill, or expense in making the compilation.<sup>107</sup>

Second, § 102(b) needs a specific statement that copyright for a compilation of facts *does* protect the facts themselves, provided that those facts were independently created<sup>108</sup> by the author of the compilation.

Third, § 103 needs a specific statement that a fact is preexisting only if has been previously published.

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<sup>104</sup> Jane C. Ginsburg, "Creation and Commercial Value: Copyright Protection of Works of Information," 90 COLUMBIA LAW REVIEW 1865, 1927-1928, also nn. 231-232 (Nov 1990).

<sup>105</sup> This new requirement rewards *only* public disclosure of facts, which are then available for everyone to use.

<sup>106</sup> This is the current statute. The word *original* means that it was independently made, *not* copied.

<sup>107</sup> This is proposed new law.

<sup>108</sup> A scientist doing an experiment or making a calculation *creates* new facts. A mapmaker who either surveys land or who analyses aerial/satellite photographs *creates* facts, but a mapmaker who copies from a map does *not* create facts. Anyone (e.g., a journalist, biographer, historian) who collects information that was personally observed by someone else is *not* engaged in creating facts. This distinction between creating facts and reporting facts observed by others will incidentally maintain the common law of not protecting facts in either news reports or biographies.

Fourth, § 106 needs to be amended to prohibit verbatim copying<sup>109</sup> by either business competitors or plagiarists<sup>110</sup> of a significant number<sup>111</sup> of facts from an original compilation of facts. This should be the *only* exclusive right for owners of a copyright in facts or compilations of facts. This carries forward the proposal for a “thin” copyright by Gorman in his 1963 article, and by the Second Circuit in *Eckes* (see page 34 above).

To avoid misunderstanding, it might be good to include in the copyright statute a somewhat redundant statement:

Facts that were previously published in any public-domain document (e.g., work whose copyright has expired, any work of the federal government, statutes or judicial opinions of state governments, etc.) remain in the public domain.

Such a rule avoids the holding of Justice Oliver Wendell Holmes that one can copy an original that is in the public domain, but one can not copy the copy that is protected by copyright.<sup>112</sup>

**Fair Use:** Other people may legally use a fact in their written work only if either (1) they give credit<sup>113</sup> to the author from whom they copied the fact, or (2) they independently create or discover the fact. However, verbatim copying of a significant number of facts to publish in a work that competes with the first author is *never* fair use.

**Duration:** In order to promote the Progress of knowledge, I suggest the duration of legal protection for facts and compilations of facts should be less than for copyright of high-authorship works. For purposes of discussion, I suggest 40 years from the date of the first public display or first publication, whichever is earlier.

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<sup>109</sup> *Copying* means “to reproduce the copyrighted work in copies” 17 U.S.C. § 106(1) and “to display the copyrighted work publicly” 17 U.S.C. § 106(5).

<sup>110</sup> A plagiarist copies, or makes a close paraphrase, without giving credit to the source.

<sup>111</sup> I think defendant (D) copied a “significant number” of facts from plaintiff’s (P’s) work, if either: (1) more than 5% of the facts in P’s work were copied by D, (2) more than 5% of the facts in D’s work were copied from P, or (3) the most valuable or most significant facts in D’s work were copied from P.

<sup>112</sup> *Bleistein*, 188 U.S. 239, 249 (citing *Blunt v. Patten*, 3 Fed.Cas. 763, 764-765 (CCNY 1828)).

<sup>113</sup> By way of the customary citation that mentions both the author’s name and bibliographic information necessary to identify or find the source.

**Originality:** In order to qualify for protection, the compilation of facts should be original (i.e., information created<sup>114</sup> independently of previous sources, or historical facts collected directly from primary sources), although previous compilations of facts may be used to check for completeness of the compilation.

**Novelty:** *Perhaps* any novel facts in the work should qualify for higher protection (e.g., larger damages against copiers). The burden of proving that the fact(s) are not novel should be on the defendant, as in a patent infringement case.

But, if copyright law gives special treatment to novel facts, then the reader or defendant ought to have notice that a particular fact is novel (i.e., identified by the letter N inside a circle?). And the novel facts would need to be declared on the copyright registration form. Users who disagree that the fact is novel would sue for declaratory judgment that the fact is not novel, thus adding additional litigation expense to the cost of doing business. The more I think about giving special protection to novel facts, the less I like the idea, because it is too complicated.

#### fair use can help protect research

I want to protect laborious scholarly research, as in the *Toksvig* case. Perhaps the way, as implicitly done in *Toksvig* (see page 53 above), is to create a new fair use factor that protects laboriously collected facts from wholesale copying by a subsequent author. I suggest adding to 17 U.S.C. § 107:

(5) (a) the labor, skill, and expense of the first author<sup>115</sup> in researching and creating the first work, (b) the labor, skill, and expense of the allegedly infringing author(s) in checking or verifying facts in the first author's work, and (c) the extent to which the allegedly infringing author(s) were unjustly enriched by appropriating the labor of the author(s) of the first work. Fair use is a good place to consider protecting a first author's labor, skill, and expense, because fair use — like unjust enrichment and misappropriation of a first author's labor — is an equitable doctrine.

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<sup>114</sup> Again, a scientist who does a mathematical calculation or who performs an experiment *creates* facts. A mapmaker who either surveys land or who analyses aerial/satellite photographs *creates* facts, but a mapmaker who copies from a map does *not* create facts. Anyone (e.g., a journalist, biographer, historian) who collects information that was personally observed by someone else is *not* engaged in creating facts.

<sup>115</sup> The *first author* is the author who created plaintiff's copyrighted work.

another proposal

In October 2009, it occurred to me that the complex pre-emption in 17 U.S.C. § 301(a) could be replaced with a simple federal tort of unfair competition, where the defendant was unjustly enriched by misappropriating the fruits of the labor, skill, and expense of the plaintiff, even if plaintiff's work is uncopyrightable. I sketched that proposal in my essay at <http://www.rbs2.com/cmusic2.pdf> .

pagination not copyrightable

Finally, because there are three cases<sup>116</sup> involving copyright protection for pagination of a printed volume, two of which erroneously hold that copyright protects pagination, Congress should declare in the copyright statute — perhaps in 17 U.S.C. § 102(b) — that pagination is *not* protected by copyright. Renouncing *Feist* could cause the two pagination cases in Minnesota to have renewed vitality, which is why amending the statute is important.

## Conclusion

The rule that copyright does not protect facts originated in cases involving either news reporting or biography, in which the author reported facts observed by someone else. The principal justification offered by early judges who created or approved the rule is the horror of a monopoly on facts, which allegedly would prevent competing news stories or competing biographies. These judges ignored the long-standing rule that independent creation is *not* copyright infringement,<sup>117</sup> so any monopoly is an illusion. Furthermore, cases involving journalists and biographers are distinct from a scientist who independently observes a fact, or a scholar who laboriously collects and verifies published facts.

*Feist* clearly holds that fictional works have stronger copyright than factual works. At page 19, above, I observe: if the map maker draws a picture of a sea monster in the ocean to the east of Boston, copyright law gives more protection to the drawing of the fictional monster than to the accurate map. I don't know why drawing a sea monster on a map supports the constitutional policy of promoting Progress in knowledge. This is just one example of why *Feist* was wrongly decided.

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<sup>116</sup> *West Publ. 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); *Oasis v. West Pub.*, 924 F.Supp. 918 (D.Minn. 1996); *Matthew Bender & Co., Inc. v. West Pub. Co.*, 41 USPQ2d 1321 (S.D.N.Y. 1996), *aff'd*, 158 F.3d 693 (2dCir. 1998), *cert. den.*, 526 U.S. 1154 (1999).

<sup>117</sup> For citations to the rule allowing independent creation, see page 79, above.

Another problem with *Feist* is that photographs of nature (e.g., sunsets, clouds, lightning) or photographs of buildings/landscape are purely factual, and — as I explain beginning on page 84, above — should *not* be copyrighted, given the holding in *Feist*. However, there is a long history of permitting copyright on photographs, which suggests that *Feist* is wrong about not copyrighting facts.

As explained above, at page 42, society *should* reward someone who discovers a fact and who shares his/her discovery with the world. The long line of judicial opinions (see page 46, above) holding that copyright protects intellectual labor of authors is consistent with modern requirements that a copyrighted work be original and have a modicum of creativity. Allowing copying of facts does *not* promote the Progress of knowledge. Requiring authors to independently research and check facts may avoid past errors, and does promote the Progress of knowledge.

I believe that *Jeweler's Circular* — and its progeny, e.g., *Leon v. Pacific Telephone & Telegraph Co.*, 91 F.2d 484, 486 (9thCir. 1937); *Hutchinson Telephone Co. v. Fronteer Directory Co.*, 770 F.2d 128 (8thCir. 1985); *Illinois Bell Telephone Co. v. Haines and Co., Inc.*, 905 F.2d 1081, 1086 (7thCir. 1990), etc. — were correctly decided. But I am not really concerned about copyrighting telephone white pages. I am much more concerned about copyrighting research papers in mathematics, science, engineering; nonfiction history books; commentaries about law (including lists of citations to cases); and online databases. One might distinguish the telephone book cases (with their mechanical “sweat of the brow” labor in arranging telephone numbers alphabetically by name of subscriber) with cases on other subjects, where genuine intellectual<sup>118</sup> labor was expended in discovering or collecting, verifying, and arranging facts. However, the egalitarian culture in the USA has a long history of anti-intellectualism,<sup>119</sup> which suggests that judges are unlikely to value intellectual labor more than physical labor.

Professor Chafee of Harvard Law School famously remarked<sup>120</sup> that copyright law allows a dwarf to see farther, by standing on the shoulders of a giant — a metaphor for allowing use of ideas and facts in the first author's (the giant's) work. In that spirit, the U.S. Supreme Court in *Feist* allowed the dwarf to stomp on the toes of the giant and kick the giant in the shins.

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<sup>118</sup> By *intellectual* I mean that the people doing the discovery or collection of facts, verifying the facts, etc. have *at least* 4 years of full-time college education, and that their work is not a mere mechanical application of rules (e.g., not like arranging telephone numbers alphabetically by the name of the subscriber), but involves intellectual skill or creativity.

<sup>119</sup> See, e.g., Richard Hofstadter, *ANTI-INTELLECTUALISM IN AMERICAN LIFE* (1963).

<sup>120</sup> Zechariah Chafee, “Reflections on the Law of Copyright (Part I),” 45 *COLUMBIA LAW REVIEW* 503, 511 (July 1945).

There are two places in law where labor, skill, and expense of a creator can be used:

1. in damages for copyright infringement, in which the infringer could be ordered to reimburse the copyright owner for both (a) value of the intellectual labor<sup>121</sup> required to create the work and (b) any expenses for the creation of the work.
2. in the tort of unfair competition, to establish damages for piracy by a business competitor. To really discourage piracy, a statute might include punitive damages at three times the amount of actual damages, plus ordering a pirate to reimburse *all* of the reasonable litigation expenses of the successful plaintiff.

Publishers of nonfiction books and periodicals, and especially developers of online databases, ought to lobby Congress for statutes that will protect the investment of labor, skill, and expense in their works. Lobbying Congress now may provide the law that publishers and database developers will need in the near future to prevent unauthorized copying of their copyrighted work. I make a tentative proposal for amendments to the copyright statute, beginning at page 90 above, and in some of my other essays on copyright law.

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<sup>121</sup> The value of the labor is the product of the number of hours spent researching, writing, and revising the work and the fair-market value of the author's time in \$/hour. This valuation rewards both labor (i.e., number of hours) and skill (i.e., hourly rate).



Jane C. Ginsburg, "No 'Sweat'? Copyright and Other Protection of Works of Information After *Feist v. Rural Telephone*," 92 COLUMBIA LAW REVIEW 338 (March 1992).

Jane C. Ginsburg, "Copyright, Common Law, and *Sui Generis* Protection of Databases in the United States and Abroad," 92 UNIV. OF CINCINNATI LAW REVIEW 151 (Fall 1997). Pages 164-170 discuss the use of contracts to prevent copying.

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