97-7430

IN THE UNITED STATES COURT OF APPEALS
FOR THE SECOND CIRCUIT

No. 97-7430

MATTHEW BENDER & COMPANY, INC.,

Plaintiff-Appellee,

HYPERLAW, INC.,

Intervenor-Plaintiff, Appellee,

v.

WEST PUBLISHING CO.; WEST PUBLISHING CORPORATION

Defendants-Appellants.

ON APPEAL FROM THE UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF NEW YORK

BRIEF FOR AMICUS CURIAE UNITED STATES OF AMERICA
IN SUPPORT OF APPELLEES

JOEL I. KLEIN
Assistant Attorney General

LAWRENCE R. FULLERTON
Deputy Assistant Attorney General

ROBERT B. NICHOLSON
DAVID SEIDMAN
Attorneys

U.S. Department of Justice
950 Pennsylvania Ave. NW
Washington, DC 20530
(202) 514-4510

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STATEMENT OF INTEREST OF THE UNITED STATES

The United States, which filed an amicus brief below, has a substantial interest in the resolution of this appeal. It has numerous responsibilities related to the proper administration of the intellectual property laws, as well as primary responsibility for enforcing the antitrust laws, which establish a national policy favoring economic competition. Accordingly, the United States has an interest in properly maintaining the "delicate equilibrium," Computer Associates International v. Altai, Inc., 982 F.2d 693, 696 (2d Cir. 1992), Congress established through the copyright law between protecting private ownership of

expression as an incentive for creativity and enabling the free use of basic building blocks for future creativity. See Twentieth Century Music Corp. v. Aiken, 422 U.S. 151, 156 (1975).

Moreover, the United States, together with seven states, filed an antitrust suit challenging the acquisition of West Publishing Co. by The Thomson Corp. The consent decree settling that suit requires Thomson to license to other law publishers the right to star paginate to West's National Reporter System. United States v. The Thomson Corp., No. 96-1415, 1997 WL 226233, at *7 (D.D.C. March 7, 1997). The briefs of the United States as amicus curiae in this matter and in Oasis Publishing Co., Inc. v. West Publishing Co., No. 96-2887 (8th Cir. argued March 10, 1997), emphasize that the terms of the settlement do not imply that the United States believes star pagination requires a license, see Thomson Corp., 1997 WL 226233, at *1.

STATEMENT OF ISSUES

The United States will address only the following issue:[1]

> Whether star pagination to a compilation of reported cases, without more, copies the arrangement of that compilation or otherwise infringes any copyright interest in that arrangement.

STATEMENT OF THE CASE

1. West Publishing Company ("West") publishes the well-known National Reporter System, which includes case reports of federal

[1]Our amicus brief below addressed only this issue, West addresses it here, and we believe the issue is dispositive.

and state courts in the United States. In particular, it is "the only entity to publish decisions of the United States Courts of Appeals and United States District Courts in comprehensive book form," Matthew Bender & Company v. West Publishing Co., No. 94 Civ. 0589, 1995 WL 702389, at *1 (S.D.N.Y. Nov. 28, 1995), in the familiar Federal Reporter and Federal Supplement series and other series. West also "publishes the opinions of New York state courts," id., in several series of volumes. It claims copyright in all of these volumes.

Matthew Bender & Company ("Bender"), another legal publisher, prepared a work in Compact Disk-Read Only Memory (CD-ROM) format (the "New York product") which includes, among other things, the opinions of this Court, the four United States district courts within New York, and various New York state courts. For opinions appearing both in its New York product and West's volumes, Bender inserted into its text information indicating where the equivalent text may be found in West's volumes. Bender provides the number of the West volume and page where each such case begins and inserts West page numbers in its text where page breaks occur in West's publication of these opinions. In other words, Bender star-paginated to West's volumes. Matthew Bender & Company v. West Publishing Co., Nos. 94 Civ. 0589, 95 Civ. 4496, 1996 WL 223917, at *3 & n.2 (S.D.N.Y. May 2, 1996).

2. Bender sued West for a declaratory judgment that "West does not possess a federal statutory copyright in the pagination in West's federal reporters or West's New York reporters," and that

"Bender does not and will not infringe any copyright of West's by its current and intended copying of the pagination from West's federal reporters and West's New York reporters." Second Supplemental Complaint 9, Appendix 487. HyperLaw, Inc. ("HyperLaw"), another publisher of judicial decisions on CD-ROM, subsequently intervened as plaintiff, seeking a similar declaratory judgment.[2]

West contended in district court, as it does here, that its selection and arrangement of decisions in its published volumes was entitled to copyright protection and that star paginating another compilation of decisions on CD-ROM to a substantial portion of a West volume copied the arrangement of that volume and therefore infringed West's copyright.

On cross motions for summary judgment, the district court, after a hearing, granted summary judgment for Bender and partial summary judgment for HyperLaw.

SUMMARY OF ARGUMENT

As the Supreme Court emphasized in Feist Publications, Inc. v. Rural Telephone Service Co., 499 U.S. 340, 349 (1990), "the copyright in a factual compilation is thin." Facts, which are not the product of the compiler's authorship, are not protected by the compilation copyright; nor is the effort involved in collecting the facts. Any copyright interest is limited to the

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[2]HyperLaw's complaint raised copyright issues going beyond star pagination. Those issues are not before the Court in this proceeding, but we assume they will be before the Court in No. 97-7780.

compiler's original contribution -- the selection and arrangement of the facts. A competing work does not infringe, even if the unprotected facts it contains are copied directly from the copyrighted work, so long as it "does not feature the same selection and arrangement." Ibid.

No one here suggests that either Bender or HyperLaw has arranged, or will arrange, the case reports on its CD-ROM in a manner substantially similar to the arrangement of cases in West's volumes. Nor does anyone suggest that the the cases will be displayed to the user as West has arranged them, unless the user takes deliberate action to produce such a display. Accordingly, neither Bender nor HyperLaw has copied West's arrangement.

West's argument that mere star pagination to West's volumes creates a copy of West's arrangement is incorrect. The statutory definition of "copies," on which West prinicipally relies, establishes no more than that if Bender or HyperLaw had copied West's arrangement, the fact that the arrangement of a CD-ROM is invisible to the naked eye would be no defense to an infringement claim. The other foundation on which West's argument rests, West Publishing Co. v. Mead Data Central, Inc., 799 F.2d 1219 (8th Cir. 1986), cert. denied, 479 U.S. 1070 (1987), does support West's argument, but Mead itself has been fatally undermined by Feist. Mead's conclusion regarding copying rests on the "sweat of the brow" theory of compilation copyright, which Feist squarely rejected.

West's theory of compilation copyright implies that virtually any index, topical or other table of contents, concordance, or other finding aid referencing a compilation would copy the compilation's arrangement, resulting in infringement where that arrangement is protected by copyright on the compilation. Such a result, unsupported by either case law or statutory language, would hinder the progress of science and art and frustrate the purpose of copyright.

ARGUMENT

I. The Copyright On A Compilation Is Thin, Protecting Only Those Components Of The Work That Are Original To The Author And Only Against Copying Of Those Components

In Feist Publications, Inc. v. Rural Telephone Service Co., 499 U.S. 340 (1990), which concerned copying from a telephone directory, the Supreme Court held that copyright protection for factual compilations extends only to the compiler's original contributions, and not to the facts themselves, despite the effort involved in compiling them. The Court recognized the tension between the principle that facts are not protected by copyright and the principle that compilations of facts[3] generally are protected. Id. at 344-45.[4] It also recognized the tension

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[3]A compilation is defined as "a work formed by the collection and assembling of preexisting materials or of data that are selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes an original work of authorship." 17 U.S.C. 101.

[4]The Copyright Act provides that "[t]he copyright in a compilation . . . extends only to the material contributed by the author of such work, as distinguished from the preexisting

(continued...)

between the means of "assur[ing] authors the right to their original expression" and the end of "encourag[ing] others to build freely upon the ideas and information conveyed by a work." Id. at 349-50. It resolved those tensions by emphasizing that "the copyright in a factual compilation is thin." The facts themselves are not protected because they are not the product of an act of authorship. Id. at 349.[5]

As the Court explained, "copyright protection may extend only to those components of a work that are original to the author," id. at 348, and originality encompasses both independent creation and "a modicum of creativity." Id. at 346. If the words expressing facts are original, they are protected; another author may copy the facts, but "not the precise words." Id. at 348. But if "the facts speak for themselves," protectible expression exists, if at all, only in "the manner in which the compiler has selected and arranged the facts," and then only the original selection and arrangement are protected. Id. at 349. Because such a copyright is thin, copying from the copyrighted work is not infringement "so long as the competing work does not feature the same selection and arrangement." Ibid.

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[4](...continued)
material employed in the work, and does not imply any exclusive right in the preexisting material. The copyright in such work is independent of, and does not affect or enlarge the scope, duration, ownership, or subsistence of, any copyright protection in the preexisting material." 17 U.S.C. 103(b).

[5]Judicial opinions are not the product of the compiler's act of authorship. Feist fully applies to compilations of judicial opinions.

This holding has economic bite even if the arrangement of a particular compilation is sufficiently original to support copyright protection. The value of a factual compilation may lie less in the compiler's selection and arrangement of the facts than in the industriousness required to compile them, and the thinness of the copyright may permit others to appropriate that value. The Court acknowledged that, at first blush, such appropriation "may seem unfair," ibid., but it explained that in reality "[t]his result is neither unfair nor unfortunate. It is the means by which copyright advances the progress of science and art." Id. at 350.[6]

Feist repudiated a body of case law that had relied on the so-called "sweat-of-the-brow" theory to provide broad copyright protection for factual compilations, thus protecting the fruits

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[6]Copyright is not the only conceivable legal regime for protecting the fruits of industrious collection. The World Intellectual Property Organization recently considered an international treaty that would provide to the "maker" of certain databases the exclusive right to extract all or a substantial part of the contents, without regard to copyrightability. See World Intellectual Property Organization, Preparatory Committee of the Proposed Diplomatic Conference (December 1996) on Certain Copyright and Neighboring Rights Questions, Proposal of the United States of America on Sui Generis Protection of Databases, CRNR/PM/7 (May 20, 1996) (discussion proposal). Legislation providing such protection was introduced in Congress. See H.R. 3531, 104th Cong. (1996). The Supreme Court long ago held that the common law of unfair competition or misappropriation protected uncopyrighted news reports, International News Service v. Associated Press, 248 U.S. 215, 239-40 (1918), although the preemption provision of the Copyright Act, 17 U.S.C. 301, limits such protection to some instances of a direct competitor's systematic appropriation of "hot" news. National Basketball Assoc. v. Motorola, Inc., 105 F.3d 841, 845, 852-53 (2d Cir. 1997). Trade secret law may also provide some protection in appropriate circumstances. See Kewanee Oil Co. v. Bicron Corp., 416 U.S. 470 (1974).

of mere industrious collection. The Court specifically rejected Leon v. Pacific Telephone & Telegraph Co., 91 F.2d 484 (9th Cir. 1937), and Jeweler's Circular Publishing Co. v. Keystone Publishing Co., 281 F. 83 (2d Cir.), cert. denied, 259 U.S. 581 (1922), because these cases "extended copyright protection in a compilation beyond selection and arrangement -- the compiler's original contributions -- to the facts themselves." 499 U.S. at 352-53. (The Court recognized that this Court had since "fully repudiated the reasoning of" Jeweler's Circular. 499 U.S. at 360, citing Financial Information, Inc. v. Moody's Investors Service, Inc., 808 F.2d 204, 207 (2d Cir. 1986), cert. denied, 484 U.S. 820 (1987); Financial Information, Inc. v. Moody's Investors Service, Inc., 751 F.2d 501, 510 (2d Cir. 1984) (Newman, J., concurring); and Hoehling v. Universal City Studios, Inc., 618 F.2d 972, 979 (2d Cir.), cert. denied, 449 U.S. 841 (1980).) The Court added that "[e]ven those scholars who believe that 'industrious collection' should be rewarded seem to recognize that this is beyond the scope of existing copyright law. See [Robert C.] Denicola[, Copyright in Collections of Facts: A Theory for the Protection of Nonfiction Literary Works, 81 Colum. L. Rev. 516,] 516 . . . 520-521, 525 [(1981)]." 499 U.S. at 360-61.[7]

[7]The Court then went on to hold that the alphabetical arrangement of a telephone book lacked the "quantum of creativity" necessary for copyright protection. 499 U.S. at 363-64. We assume, for purposes of this brief, that West's arrangement of cases does exhibit that necessary quantum of creativity.

II. Because Neither Bender Nor HyperLaw Has Arranged Opinions In A Manner That Substantially Resembles West's Arrangement, Neither Has Copied West's Arrangement

West has not suggested that either Bender or HyperLaw has produced or plans to produce CD-ROMs that in any ordinary sense "feature the same . . . arrangement," Feist, 499 U.S. at 349, of opinions as found in West's volumes.

Courts routinely analyze whether an arrangement protected by copyright has been impermissibly copied by comparing the ordering of material in the accused work with the ordering of material in the allegedly infringed compilation. See, e.g., Lipton v Nature Co., 71 F.3d 464, 470, 472 (2d Cir. 1995) (plaintiff's arrangement of terms of venery protectible; defendant's arrangement of 72 of these terms is "so strikingly similar as to preclude an inference of independent creation" when 20 of first 25 terms are duplicated and listed in same order, and in four other places four or more terms appear in the same order);[8] Schiller & Schmidt, Inc. v. Nordisco Corp., 969 F.2d 410, 414 (7th Cir. 1992) (office supply catalog not infringed as compilation when it was not contended that defendant copied "the order of products or other typical features of a compilation"); Key Publications v. Chinatown Today Publishing Enterprises, Inc., 945 F.2d 509, 515 (2d Cir. 1991) (no infringement of protectible

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[8]West's discussion of Lipton, Brief for Defendants-Appellants ("Br.") 18, mistakenly suggests that the infringing articles merely communicated the arrangement of Lipton's book. In fact, the infringer arranged the content of those articles, the terms of venery, as Lipton arranged the same items in his book.

arrangement of categories in business directory where facial examination reveals great dissimilarity between arrangement in copyrighted directory and in allegedly infringing directory); Worth v. Selchow & Righter Co., 827 F.2d 569, 573 (9th Cir. 1987) (alphabetical arrangement of factual entries in trivia encyclopedia not copied when trivia game organizes factual entries by subject matter and by random arrangement on game card), cert. denied, 485 U.S. 977 (1988). Substantial similarity, short of exact identity of arrangement, suffices for infringement, United Telephone Co. of Mo. v. Johnson Publishing Co., 855 F.2d 604, 608 (8th Cir. 1988), so a compilation copyright is thin but not anorexic, Key Publications, 945 F.2d at 514.

The change from paper to CD-ROM does not preclude such a comparison. West's arrangement of this Court's opinions in, for example, Volume 44 of the Federal Reporter, Third Series, is readily described. The first of those opinions, by Judge Cabranes in Schultz v. Williams, begins on page 50 (following two pages of caption and of material provided by West), and the text continues, presumably in precisely the sequence Judge Cabranes created, to about the middle of page 61. At that point we find the caption and the beginning of West-provided material related to CCC Information Services, Inc. v. MacLean Hunter Market Reports, Inc. Judge Leval's opinion in that case begins on page 63 and continues, presumably in precisely the sequence Judge Leval created, through roughly the middle of page 74. And so the

description of West's arrangement could continue, through to the end of the per curiam opinion in CBS, Inc. v. Liederman, around the middle of page 174. West could have arranged those opinions differently, and we do not here question that West's copyright on the volume protects that arrangement.

It is possible to copy that compilation of opinions, arranging them in a substantially similar manner, in an electronic, rather than a paper and ink, medium. Imagine a very large WordPerfect version 5.1 document file into which someone has typed Judge Cabranes's opinion in Schultz, followed by Judge Leval's opinion in CCC, and continuing in like manner all the way through the per curiam opinion in CBS, the file then stored on a CD-ROM, or some other storage medium.[9] Leaving aside other elements of infringement that would have to be proved, and ignoring defenses such as fair use, that copy might well infringe West's copyright.

But West has not alleged that Bender's or HyperLaw's existing or planned products include anything remotely similar to this hypothetical huge word processing document file. Nor has it alleged that the product is designed or functions so as to display the opinions to the reader in the West sequence -- unless the reader takes deliberate action to cause such a display. The absence of such allegations should be dispositive. If two

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[9]Whether the material is stored so that the physical representations of the typed characters are literally in the order they were typed depends on the technology of storing a sequential file on that storage medium and on such things as the operating system used. But conceptually a WordPerfect 5.1 file stores text in sequence, as any user of WordPerfect 5.1 can readily confirm.

compilations of the same material are not arranged in a sufficiently similar manner, neither can be said to copy the arrangement of the other, and therefore no claim of direct infringement can be based on the compiler's copying of arrangement. The user's action in reordering the display of opinions is no substitute for the compiler's action in creating the compilations.

III. The Statutory Definition Of "Copies" Provides No Support For West's Theory Of Copying By Star Pagination

West contends, Br. 20-25, that the Copyright Act's definition of "copies," 17 U.S.C. 101, justifies treating star-paginated compilations as copies of its arrangement of opinions, even if the opinions on the CD-ROM are arranged differently, because the user, by virtue of star-pagination, could recreate West's arrangement. The statute provides (emphasis added):

> "Copies" are material objects, other than phonorecords, in which a work is fixed by any method now known or later developed, and from which the work can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. The term "copies" includes the material object, other than a phonorecord, in which the work is first fixed.

This definition does not support West's argument. On its face, it deals with the fixation of the copyrighted work in a material object, not the fixation of a different work from which the copyrighted work may be constructed. West begs the question whether the CD-ROMs are fixations of West's work. If what is fixed in the CD-ROM is not West's work, the CD-ROM is not a copy of West's work, and subsequent perception does not make it one.

The statutory c... beginning with "and from which" was intended to establish that fixations the unaided eye cannot perceive are no less -- but no more -- copies of a work than are fixations the eye can perceive.[10] The clause does not transform one arrangement into another merely because programmed computers can sort data. We do not contend that the arrangement of data on a CD-ROM must be perceivable by the naked eye in order to be an infringing copy of West's printed arrangement. We do, however, contend that the user's discretionary ability, aided by a suitable computer program, to reorder the cases, thereby producing elsewhere[11] a copy of West's arrangment of opinions, does not mean that there is such a copy on the CD-ROM.

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[10]The clause serves "to avoid the artificial and largely unjustified distinctions, derived from cases such as White-Smith Publishing Co. v. Apollo Co., 209 U.S. 1 (1908)." S. Rep. No. 94-473, at 51 (1975); H.R. Rep. No. 94-1476, at 52 (1976), reprinted in 1976 U.S.C.C.A.N. 5659, 5665, quoted in Williams Electronics, Inc. v. Arctic Intern., Inc., 685 F.2d 870, 877 n.8 (3d Cir. 1982). White-Smith held that a piano roll version of copyrighted sheet music did not infringe because the perforations in the piano roll were not a form of notation intelligible to the ordinary human eye and thus did not copy the sheet music, 209 U.S. at 17-18, even though the position and size of the perforations correspond to the order of the notes in the copyrighted composition. Id. at 10. The Court rejected the contention that copyright protection of the day "cover[ed] all means of expression of the order of notes which produce the air or melody which the composer has invented." Id. at 11. If that were still the law, a CD-ROM could not possibly infringe the copyright on a printed book, even if the CD-ROM contained digitized images of every page in the book, arranged in the same sequence as in the book, or the hypothetical WordPerfect file discussed above.

[11]No one suggests that the user of a Bender or HyperLaw CD-ROM can reorder the information on the CD-ROM itself. "RO", after all, stands for "read only."

The digital, electronic character of a compilation on CD-ROM can make it easy to resort data, and this ease explains why cases presenting the issue here are likely to arise. But easier sorting does not significantly affect the principles of copyright. Printed pages can also be reordered, with the help of a scissors if necessary. In so far as is relevant here, the law concerning paper and the law concerning CD-ROMs is the same.

In considering paper, West has used the wrong analogy. West argues (Br. 29) that

> both Bender's and HyperLaw's CD-ROMs are analogous to a huge print edition that offers, in Section I, all cases collected by the publisher in chronological order and, in Section II, West's volume-by-volume selection and arrangement of the cases. A reader's decision to turn to Section II would not make him the infringer.

West's hypothetical Section II, of course, would be infringing, because in itself it is a compilation arranged exactly like West's, precisely what is missing from the CD-ROMs at issue here. The far more precise analogy is an edition of opinions in chronological order, each beginning on a right-hand page, star-paginated to West's volumes -- that is, Section I of West's hypothetical print edition, with star pagination but no Section II. If West's theory were correct, star pagination in print would infringe, and West offers no viable support for the claim that it does.[12]

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[12]In Callahan v. Myers, 128 U.S. 617, 660-61 (1888), the infringing volumes of case reports substantially duplicated the paging of the infringed volumes, in the manner of West's hypothetical Section II. The Callahan Court, following the lower court, did not treat duplication of the paging as an independent (continued...)

IV. West's Argument That Its Arrangement Of Opinions Has Been Copied Because A User With The Aid Of A Computer Program Can Recreate That Arrangement Rests On The Discredited Sweat Of The Brow Theory

In essence, West argues that it does not matter how the opinions are actually arranged on Bender's or HyperLaw's CD-ROMs, or in the files stored on those CD-ROMs. However the texts have been ordered, reordered, shuffled, reshuffled, or scrambled, West says that Bender and HyperLaw are direct infringers because the user of the Bender or HyperLaw product could use the star pagination to create a compilation of opinions arranged as in West's volumes, or to skip from opinion to opinion in the Bender

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[12](...continued)
basis for finding infringement, apparently on the ground that arranging and paginating the cases involved inconsiderable labor and was not worthy of protection in and of itself. 128 U.S. at 662. This Court has also addressed star-paginated law books. See Banks Law Publishing Co. v. Lawyer's Co-operative Publishing Co., 169 F. 386 (2d Cir. 1909) (implying same ordering of cases but different pagination; star pagination used in allegedly infringing work; held, no infringement), appeal dismissed, 223 U.S. 738 (1911). The Eighth Circuit has read Banks as turning on the official status of the reporter whose works were copied. West Publishing Co. v. Mead Data Central, Inc., 799 F.2d 1219, 1225 (8th Cir. 1986), cert. denied, 479 U.S. 1070 (1987). That reading has been strongly criticized. See id. at 1245-47 (Oliver, J., concurring in part and dissenting in part); L. Ray Patterson & Craig Joyce, Monopolizing the Law: The Scope of Copyright Protection for Law Reports and Statutory Compilations, 36 UCLA L. Rev. 719, 740-49 (1989). Moreover, a post-Banks case in this Court, although not directly on point, casts doubt on the Eighth Circuit's reading, Eggers v. Sun Sales Corp., 263 F. 373, 375 (2d Cir. 1920) (copying from plaintiff's publication of uncopyrightable official report suggested by identity of pagination in defendant's publication, "but legally that is not of sufficient importance to constitute infringement of copyright," citing Banks).

or HyperLaw product, reading or viewing the opinions in the same order as they are found in the West volumes.[13]

We recognize, of course, that West Publishing Co. v. Mead Data Central, Inc., 799 F.2d 1219 (8th Cir. 1986), aff'g 616 F. Supp. 1571 (D. Minn. 1985), cert. denied, 479 U.S. 1070 (1987), supports West's theory. In Mead, a divided panel, ruling on a preliminary injunction, concluded that star pagination to West's volumes impermissibly copied West's arrangement of cases, even though the allegedly infringing work and West's were not similarly arranged. The Eighth Circuit is currently deciding whether it still views Mead as good law. Oasis Publishing Co., Inc. v. West Publishing Co., No. 96-2887 (8th Cir. argued March 10, 1997).[14] In our amicus brief in Oasis, we argued at length that Mead's analysis of the copying question rests on the discredited "sweat of the brow" theory of compilation copyright protection and cannot be reconciled with the subsequent Supreme Court decision in Feist.[15] We summarize that argument here.

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[13]We do not address whether the user of Bender's or HyperLaw's product actually could do those things.

[14]Just before filing this brief, we learned that the Eighth Circuit had on July 23, 1997, docketed a joint motion of the Oasis parties to dismiss the appeal. We assume this motion will prevent the court from deciding the case.

[15]West argues, Br. 30, that Mead did not "accord[] copyright protection under the 'sweat of the brow' doctrine." For purposes of this brief, we concede that the Eighth Circuit found West's arrangement to be sufficiently creative to merit copyright protection and we do not here challenge that finding. Our argument is that Mead's conclusion that the arrangement was copied rests on the discredited doctrine.

West alleged in Mead that "the LEXIS Star Pagination Feature is an appropriation of West's comprehensive arrangement of case reports in violation of the Copyright Act of 1976." 799 F.2d at 1222. The district court recognized that the arrangement of cases in the Lexis database differed significantly from the West arrangement, 616 F Supp. at 1579-80, but held that "for infringement purposes, [Mead] need not physically arrange it's [sic] opinions within its computer bank in order to reproduce West's protected arrangements." Id. at 1580. Instead, the court concluded "that [Mead] will reproduce West's copyrighted arrangement by systematically inserting the pagination of West's reporters into the LEXIS database. LEXIS users will have full computer access to West's copyrighted arrangement." 616 F. Supp. at 1580. To support this holding, the district court relied on Rand McNally & Co. v. Fleet Management Systems, Inc., 600 F. Supp. 933, 941 (N.D. Ill. 1984), in which the court held that compilation copyright rests not on the author's originality in arranging the data but instead on "protection of the compiler's efforts in collecting the data."[16]

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[16]The Rand McNally court in turn relied on Professor Denicola: "'The creativity or effort that engages the machinery of copyright, the effort that elicits judicial concern with unjust enrichment and disincentive, lies not in the arranging, but in the compiling. . . . The arrangement formulation . . . is dangerously limited. At face value the rationale indicates that the entire substance of a compilation can be pirated as long as the arrangement of data is not substantially copied.'" 600 F. Supp. at 941 (emphasis added) (quoting Robert C. Denicola, Copyright in Collections of Facts: A Theory for the Protection of Nonfiction Literary Works, 81 Colum. L. Rev. 516, 528 (1981)). See page 9 supra.

The Eighth Circuit affirmed without questioning the district court's recognition that the Lexis arrangement of cases differed significantly from West's. It asserted that Mead's proposed star pagination would infringe West's copyright in the arrangement because, in combination with another feature of Lexis, it would permit Lexis users "to view the arrangement of cases in every volume of West's National Reporter System," 799 F.2d at 1227, but it emphasized that it would have found infringement even if that had not been the case. It is enough, the Court explained, that star pagination communicates to users "the location in West's arrangement of specific portions of text," so that "consumers would no longer need to purchase West's reporters to get every aspect of West's arrangement. Since knowledge of the location of opinions and parts of opinions within West's arrangement is a large part of the reason one would purchase West's volumes, the LEXIS star pagination feature would adversely affect West's market position." Id. at 1228.

The Eighth Circuit did not explain why communicating location -- that is, describing West's arrangement -- is the same thing as copying West's arrangement. Instead, it concerned itself only with the economic consequence of the communication: the vice of unauthorized star pagination is that it permits unfair appropriation of the fruits of industrious collection. Indeed, in so ruling it relied on its own sweat-of-the-brow decision in Hutchinson Telephone Co. v. Frontier Directory Co., 770 F.2d 128

(8th Cir. 1985), 799 F.2d at 1228, which in turn relied on Leon and Jeweler's Circular, 770 F.2d at 130-31.

Feist, however, expressly rejects Leon and Jeweler's Circular, see page 9 supra, and makes clear that this appropriation is not the proper test of infringement. See page 8 supra. Impact on West's market position would properly be considered in addressing a fair use defense, see 17 U.S.C. 107(4) (fair use analysis to consider "the effect of the use upon the potential market for or value of the copyrighted work"), when protected arrangement has been copied. But under Feist it plays no role in determining whether protected arrangement has been copied.[17]

V. West's Theory Would Transform Indexes And Other Finding Aids Into Infringing Copies Of The Work Indexed And Otherwise Extend Protection Beyond What Feist Allows

As the Mead panel observed, star pagination communicates to users "the location in West's arrangement of specific portions of text." 799 F.2d at 1228. A compilation copyright, however, protects original components of the compilation against copying, but not against description. Virtually any index, topical or other table of contents, concordance, or other finding aid would communicate information about West's arrangement. But that

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[17]The Eighth Circuit's infringement analysis quoted the Senate Report on the Copyright Act of 1976, as quoted in Harper & Row Publishers, Inc. v. Nation Enterprises, 471 U.S. 539, 568 (1985): "'[A] use that supplants any part of the normal market for a copyrighted work would ordinarily be considered an infringement.'" 799 F.2d at 1228. Harper & Row, however, involved undenied verbatim copying of protected expression, 471 U.S. at 548-49; the issue was fair use.

cannot mean that all such finding aids would copy West's arrangement, even though they may describe it.

Few cases address infringement by indexing, but the meager case law suggests indexing does not copy the arrangement of the indexed work. In New York Times Co. v. Roxbury Data Interface, Inc., 434 F. Supp. 217 (D.N.J. 1977), the district court denied a preliminary injunction against publication of a personal name index to the New York Times Index (which in turn indexes the New York Times). Although the court determined the likelihood of success in light of fair use factors, it also noted that the "personal name index differs substantially from the Times Index, in form, arrangement, and function," id. at 226 (emphasis added), even though it communicated the locations in the Times Index at which particular personal names could be found. The court greeted with incredulity the plaintiff's argument "that a copyrighted work cannot be indexed without permission of the holders of the copyright to the original work." Id. at 224-25. See also Kipling v. G.P. Putnam's Sons, 120 F. 631, 635 (2d Cir. 1903) (defendants "were at liberty to make and publish an index" of copyrighted material).

West suggests that the combination of the detailed information provided by star pagination with the text of the case reports renders the CD-ROM's in question copies of the West arrangement. Br. at 29 n.19.[18] Of course, a star-paginated CD-

[18]West reads Roxbury Data Interface to support such a contention, noting that "the court held that although an index (continued...)

ROM collection of case reports might have a more substantial economic impact on West than other types of finding aids, because users might substitute it for West's product. Under Feist, however, the economic impact on the demand for West's compilation cannot substitute for the copying of West's arrangement as the basis for a finding of infringement. Nor can the possibility that a third party might use the star pagination information to copy West's arrangement create direct infringement.[19] Neither the star pagination itself nor the combination of star pagination with a compilation of unprotected case reports, arranged in a different manner than West's reports, creates a copy of West's arrangement.

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[18](...continued)
alone was likely to be non-infringing, the copyright holder probably would have 'a strong claim to infringement' if correlated, indexed data were included in the product." Br. at 29 n.19. But the court noted that the correlation data, the numbers identifying the location where particular names appeared in the New York Times rather than in the Times Index, "constitute[] the substance of plaintiffs' copyrights." 434 F. Supp. at 220. And in saying that the copying of these facts, id. at 221, might support a claim of infringement, the court cited the now-discredited Leon. Id. at 220. Both West and the Roxbury court would impermissibly protect industrious collection.

[19]Although users' actions may lead to vicarious liability for infringement or liability for contributory infringement under certain circumstances, neither can be found if the party alleged to be liable lacks the right to control the conduct of the individual who actually performs the infringement, Sony Corp. v. Universal City Studios, Inc., 464 U.S. 417, 437 (1984), and the work has substantial noninfringing uses, id. at 442. Neither form of liability can be established here. West does not contend otherwise. Its discussion of Sony, Br. 27-28, makes clear that West is arguing neither vicarious liability nor contributory infringement. It is arguing that an infringing copy exists on the CD-ROM, so there is direct, non-vicarious liability.

West's overbroad arguments and inappropriate analogies have sweeping implications for the communication of information both printed and electronic. Consider West's hypothetical literary scholar who published a "non-chronological arrangement of some 1000 brief public domain literary works written over several centuries," Br. 24, which, so arranged, told a coherent story. West's analysis implies that it would be infringement to publish a book containing those 1000 literary works, together with 1000 others, all in chronological order, if the book also contained an appendix noting that West's scholar had published an edition in which Number 23 came first, followed by Number 75, and so forth. The user, after all, could cut out the stories and rearrange them in that order.[20] But West provides no support for the proposition that such a publication would infringe.

Similarly, the copyright on a volume of Shakespeare's sonnets arranged in order of the editor's judgment of esthetic merit would, we assume, protect that original arrangement. Another editor could, without infringing the copyright, copy the sonnets from that volume and publish them in a different arrangement. But we understand West to say that it would be infringement for the editor of the second volume to include an appendix that merely tells the reader the order in which the sonnets appear in the first volume. And if two prior compilers had each published

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[20]To be sure, it would be far easier to recreate West's scholar's arrangement from a CD-ROM than from a printed book (even one in looseleaf format). But the ease with which the user can rearrange the materials in a compilation has no bearing on whether the compilation is a copy of another compilation.

the sonnets in order of their separate, and different, estimates of esthetic merit, under West's analysis it would apparently infringe the copyrights on both prior volumes for a third compiler to publish the sonnets in still a different order while including two appendices, each telling the reader the order in which one of the prior volumes had published the sonnets.[21] Again, there is no support for West's view.

Or consider West's National Reporter Blue Book, which provides tables indicating the location in West's volumes of opinions also found at particular locations in official reporters, thus allowing those with only official citations to find opinions in West's volumes.[22] One could, with the help of the Blue Book, rearrange the cases in an official reporter to match their arrangement in West's volumes. As we understand West's argument, only West may publish such tables without risking infringement liability for copying West's volumes of case reports, a proposition that simply cannot be right.[23]

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[21]West may respond that describing the arrangements in appendices would be fair use. Whether it would be fair use presents a difficult question, perhaps impossible to resolve on the incomplete facts of our hypothetical. A brighter-line test than fair use is both preferable and readily available: one compilation does not copy the arrangement of another if the arrangements of the two are not substantially similar.

[22]As West explains in the context of Supreme Court opinions, "In these tables is shown a page of the United States Reports where each case begins, arranged in numerical order. Opposite this are given the volume and page of the Supreme Court Reporter where a case is found." National Reporter Blue Book 1709 (1938).

[23]That such tables do not refer to the interior pagination of cases is irrelevant. Because, we may safely assume, West has

(continued...)

Indeed, if copyright protection for the arrangement of a compilation can rest on creative choice of a principle of arrangement (even if that principle can be mechanically applied),[24] West's theory of what constitutes the copying of arrangement would sometimes mean that it would be infringement (but for fair use considerations) to take what West calls "preexisting facts" from one source and publish them in a different ordering. The result would be precisely the protection of facts that Feist rejected.

This problem arises in the following hypothetical situation: Suppose a firm obtains from the 1990 Census of the United States

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[23](...continued)
not reordered the words and paragraphs of the opinions found in the official reports, sequencing by the first pages will put the interior pages into the proper order.

It is also not significant that such tables do not include the text of the opinions. Either identification of the location of opinions in West's volumes copies the arrangement of West's volumes or it does not. If it is not infringement (leaving aside fair use considerations) to publish the tables themselves, it should similarly not be infringement of West's compilations to publish the tables as an appendix to a reprint of the United States Reports.

[24]Post-Feist case law does not resolve whether the arrangement of a compilation is protected by copyright if that arrangement is pursuant to a mechanically applied criterion, but the choice of that criterion is creative. Feist, however, implies that such an arrangement is protected. Alphabetical ordering is mechanical in application, yet the Supreme Court, in holding that the alphabetical ordering of a telephone directory was not protected, thought it necessary consider the creativity involved in choosing alphabetical ordering, explaining that the choice of alphabetical ordering for a telephone directory "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 [and therefore] does not possess the minimal creative spark required by the Copyright Act." 499 U.S. at 363.

data concerning every county in the United States and publishes a compilation of those data listing the counties in descending order of one of the included data elements, the proportion of the population consisting of males of ages 18 through 40. Suppose further that this arrangement, which may interest those marketing products to adult males, meets the Feist test of originality and is protected by the firm's copyright on the compilation. Under Feist, another firm may copy all the data from the first firm's compilation, while arranging its own compilation alphabetically by state and county. It may do so even though the arrangement of the first compilation is protected by copyright, the data themselves are not, and the second compilation does not "feature the same . . . arrangement," Feist, 499 U.S. at 349, as the first. But the second compilation contains all the information a user needs to recreate the arrangement of the first, and so under West's interpretation of the copying of an arrangement, creation of the second compilation would infringe the copyright on the first.[25] West's position therefore may protect the facts themselves in circumstances where Feist would leave them unprotected.

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Advances in technology have made it easy to re-sort and retrieve information at high speed. We have seen, in on-line

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[25]To avoid infringing under West's principle, the publisher of the second compilation would have to omit the data concerning the proportion of the population consisting of males of ages 18 through 40, even though Feist would allow copying those data.

computer searchable databases and in CD-ROM products, new ways of working with the raw materials of legal research -- case reports, statutes, and other materials that once appeared only in print form. Neither we nor this Court can predict what new technological developments next year or in the next decade will further revolutionize the practice of law and make the substance of law more readily available to all. By making clear the limited scope of copyright protection for factual compilations, Feist cleared the way for these creative developments. Protecting in addition the effort required to produce a compilation would no doubt benefit the owners of many compilation copyrights, but this was apparent to the Supreme Court when it decided Feist. West's plea for copyright protection for the sweat of its brow comes too late.

CONCLUSION

The judgment of the district court should affirmed.

Respectfully submitted.

JOEL I. KLEIN
Assistant Attorney General

LAWRENCE R. FULLERTON
Deputy Assistant Attorney General

ROBERT B. NICHOLSON
DAVID SEIDMAN
Attorneys

U.S. Department of Justice
950 Pennsylvania Ave. NW
Washington, DC 20530
(202) 514-4510

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CERTIFICATE OF SERVICE

I certify that, on this 25th day of July, 1997, I caused two copies of the foregoing BRIEF FOR AMICUS CURIAE UNITED STATES OF AMERICA IN SUPPORT OF APPELLEES to be served by Federal Express on:

Elliot Brown, Esq.
Irell & Manella
1800 Avenue of the Stars, Suite 800
Los Angeles, CA 90067-4276

Counsel for Matthew Bender & Co., Inc.

Paul J. Ruskin, Esq.
Law Offices of Paul J. Ruskin
72-08 243rd Street
Douglaston, NY 11363

Counsel for HyperLaw, Inc.

James F. Rittinger, Esq.
Satterlee Stephens Burke & Burke LLP
230 Park Avenue
New York, NY 10169-0079

Counsel for West Publishing Co. and West Publishing Corp.

David Seidman