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## **Copyright in Factual Compilations: U.S. Supreme Court Decides the *Feist* Case<sup>†</sup>**

### *Introduction: the Decision*

The Supreme Court of the United States does not often decide questions basic to all copyright systems. Its handful of decisions over the last decade have largely concerned peculiarly American copyright provisions and doctrines, such as "fair use," the "writer for hire," and "renewal rights." In *Feist Publications, Inc. v. Rural Telephone Service Company, Inc.*,<sup>1</sup> the Supreme Court did face a question of universal concern: should copyright protect "facts" brought together in a compilation?

The plaintiff in the *Feist* case, the Rural Telephone Service Company, had a legally granted monopoly for providing telephone services to several communities. It had compiled names of its subscribers, along with their locations and telephone numbers, ordered these listings alphabetically and by categories of businesses, and provided the resulting telephone directory to its subscribers. The defendant, Feist Publications, Inc., copied most of these listings in its own alphabetical telephone directory, which covered a larger geographical area. Rural Telephone sued for copyright infringement with success through the Court of Appeals,<sup>2</sup> whose judgment the Supreme Court reversed.

The question of whether to extend copyright to "facts" is not new. The American commentators and courts tended to consider it in light of the clause in the Constitution of the United States which authorizes copyright legislation.<sup>3</sup> They understood this clause to be based on the premise that copyright law should provide economic incentives for socially beneficial intellectual endeavors. The commentators have accordingly engaged in somewhat

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<sup>1</sup> 111 Sup. Ct. 1282 (1991) [499 U.S. 340 (1991)].

<sup>2</sup> Unpublished opinion, 916 F. 2d 718 (10th Cir. 1990), *aff'g* 663 F. Supp. 214 (D. Kan. 1987).

<sup>3</sup> U.S. Constitution, art. I, para. 8, cl. 8.

speculative economic analyses attempting to measure the social benefit or danger of extending copyright to "facts."<sup>4</sup> Some have argued that copyright should extend to "facts" – if these are compiled with the "sweat of the brow," [**> p. 803**] that is, skill and labor – to encourage making information more publicly accessible. Others have responded that copyright should only cover "original" creations to avoid any monopoly restricting the productive use of raw data.

The Supreme Court, in its *Feist* decision, has now settled this debate for the purposes of deciding cases. To start, the Court interpreted the American Constitution as including a requirement of "originality" for copyright. Further, the Court emphasized that, when the Copyright Act of the United States was fully revised in 1976, the legislators expressly applied this requirement of originality to compilations. Finally, it ruled, a factual compilation cannot be protected merely because it displays some "sweat of the brow," for example, in bringing together large numbers of facts, if it lacks the requisite originality. The Court interpreted such "originality" under the Constitution to include what Professor Melville Nimmer, for purposes of clarity, had distinguished as a "modicum of creativity."<sup>5</sup> It should also be recalled that, in the 1976 revision, the term of copyright was lengthened in the United States to meet the Berne norm of life plus fifty years. In requiring originality as it did, the Court avoided the risks of extending this longer American copyright to non-creative works.<sup>6</sup>

### *A Comparative Framework of Analysis*

The *Feist* case prompted the Supreme Court to trace a line beyond which copyright protection is not permissible. In construing the requirement of "originality" as including "creativity," the Court brought American law into line with most copyright laws, which do not usually protect works generated by skill and labor alone.

Copyright in the British tradition now represents the most significant exception to this consensus,<sup>7</sup> but the law of the European Community has been applied to limit the exercise of

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<sup>4</sup> See J. GINSBURG, "Creation and Commercial Value: Copyright Protection for Works of Information," 90 Columbia L. Rev. 1865, 1912 (1990) ("...justification [of incentive argument] lacks empirical demonstration, but so do economic arguments premised on the undesirability of copyright protection.").

<sup>5</sup> 1 M. NIMMER & D. NIMMER, "Nimmer on Copyright," Sec. 2.01[B] (1990) ("It is of only semantic significance whether originality is defined as embodying such creativity or whether such creativity is regarded as a necessary adjunct to originality. However, a greater clarity of expression is perhaps achieved by regarding originality and creativity as separate elements.").

<sup>6</sup> See J.H. REICHMAN, "Goldstein on Copyright Law: A Realist's Approach to a Technological Age," 43 Stanford L. Rev. 943, 951-952 (1991).

<sup>7</sup> Compare WM. CORNISH, "United Kingdom," Secs. 2[1][b], 2[2][a][i], and 2[3], in P. GELLER (ed.), "International Copyright Law and Practice" (1991) ("commercial skill" suffices for copyright in compilations) with P. GELLER, "International Copyright: An Introduction." Sec. 2[3][c], in *Id.* ("consensus" on standards of protection).

such copyright in a case which paralleled the *Feist* case in many regards. Plaintiffs – the I.T.P., B.B.C., and R.T.E., representing television broadcasters with dominant market positions – asserted copyright in their listings of television programs, while the defendant Magill T.V. Guide published all their listings in a more comprehensive [**> p. 804**] compilation. The E.C. Court of First Instance<sup>8</sup> has now found it impermissible for plaintiffs to strengthen their market positions by exercising their copyrights to preclude defendant's use of the listings. While this ruling only addresses anticompetitive practices, it raises the question: may copyright standards be adjusted to preclude their facilitating such practices?

Some words of caution are in order before more closely comparing the *Feist* decision with legal developments in other jurisdictions. If it is clear that the notions of "originality" and "creativity" most often refer to more than rote or mechanical efforts, it is not clear what more they imply. To begin to draw any comparison between American and other copyright standards in this regard, it will prove necessary to analyze how these notions are applied within the framework of the distinction between "ideas" or "facts," on the one hand, and "expression" or "form," on the other.<sup>9</sup> The Court, in its *Feist* decision, unfortunately confuses its own analysis on point by asking whether "facts" themselves can be "original" and, as such, protected by copyright. The Berne Convention similarly lacks rigor in Article 2(8) of the Paris Act, which declares that the "news of the day" need not be protected by copyright.<sup>10</sup> In truth, courts in any copyright system only deal with the *expressions* of facts, of news of the day, of raw data, etc. They therefore can only determine whether such expressions, not mere facts or like data, are *original* or not.

To facilitate comparison, it might be useful to read the *Feist* decision as if the term "expression of" always qualified the term "facts." In cases in which only one or a limited number of means are available to express a given content, copyright systems tend to apply comparable rules. In such cases, American copyright law applies a "rule of merger": the "expression" is said to "merge" with the "idea," "theme," "fact," etc., that it purports to communicate, and it is not protected. Other systems draw rules from the premise that, where too few expressive options exist for the author, there is insufficient room for creative choice

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<sup>8</sup> Judgment, Second Chamber, 10 July 1991 (concerning Cases T-70/89, T-69/89, and T-76/89) *aff'g* Commission Decision, 21 December 1988, O.J. L78/43, 21 March 1989, (envisages licenses of the listings). Note that, in the *Feist* case, pending the Supreme Court decision, the trial court found that the plaintiffs had asserted copyright with anticompetitive intent. *Rural Telephone Service Co. v. Feist Publications, Inc.*, 737 F. Supp. 610, 622 (D. Kan. 1990).

<sup>9</sup> Compare H. DESBOIS, "Le droit d'auteur en France" 11-15, 22 (3d ed. 1978) ("idea" distinguished from "form of expression") with E. ULMER, "Urheber- und Verlagsrecht" 119-125 (3d ed. 1980) (critique of the distinction: expressive "texture" of a work, not just its form, is susceptible of protection).

<sup>10</sup> Cf. H. DESBOIS, A. FRANÇON, & A. KEREVER, "Les conventions internationales du droit d'auteur et des droits voisins," para. 146 (1976) (rationale for "news of the day" exclusion – to allow media freedom in reporting – clearer in the Brussels Act where it was not associated with scope of protection).

to play a role in generating a protected work. Both the rule of merger and these comparable rules avoid withdrawing from the public domain indispensable building-blocks for creating copyright-protected [**> p. 805**] works.<sup>11</sup> These rules thus limit the monopolization of indispensable means of communicating information and, at the same time, the chances of anticompetitive abuses of copyright. Such rules also give effect to the often-tacit presumption that, if an expression is only one of just a few alternatives, it is not likely to be original. The fact, however, that an expression is virtually the only one available, while precluding protection for the expression, does not assure that it is unoriginal.<sup>12</sup> Nor does the fact that it is one of a range of possible expressions assure that it is sufficiently creative to qualify for protection. Further judicial inquiry may be needed to determine whether that basic requirement is fully satisfied.

The Supreme Court observed, in its *Feist* decision, "that the copyright in a factual compilation is thin."<sup>13</sup> It must be kept in mind, in trying to understand this cryptic phrase, that copyright as such does not have anything to do with the facts expressed in a compilation, but can only be "thin" at some level of expression. In effect, the rule of merger can apply to a compilation at two levels of expression: first, to what might be analogized to "vocabulary"; second, to what might be analogized to "syntax." On the first level, if the elements brought together in a compilation were each expressed by recourse to a more or less indispensable vocabulary – for example, in words, graphic images, or other signs for which no or few alternative signs existed – then the rule of merger would remove these elements, as thus expressed, from the scope of copyright. On the second level, if the elements were compiled according to a more or less standard syntax – that is, if they were selected and ordered by virtue of criteria and structures for which no or few other options were available – then the compilation, as thus selected and ordered, would not be protected.<sup>14</sup>

### *Focusing Copyright Standards on Factual Works*

When the Supreme Court treated the telephone listings at issue in the *Feist* case as "facts," it virtually skipped over the level of "vocabulary." Considered as "expressions," the listings would still have fallen outside the scope of protection under the rule of merger for lack of choice in expressing them. Most notably, in the directory, there was only one correct spelling of each name, one correct location for each subscriber, and one correct number for

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<sup>11</sup> *But see* I. CHERPILLOD, "L'objet du droit d'auteur" 145 *et seq.* (1985) (German doctrine of *freie Benutzung* implements the same policy).

<sup>12</sup> *But see* ULMER, *supra* note 9, at 133 (no personal origination without room for creative choice).

<sup>13</sup> *Feist*, *supra* note 1, 111 Sup. Ct. at 1289.

<sup>14</sup> *See also* S. PERLMUTTER, "The Scope of Copyright in Telephone Directories: Keeping Listing Information in the Public Domain," 38 J. Copr. Soc'y 1, 12-17 (1990) (more specific analysis of the expressive texture of telephone directories).

[> p. 806] each telephone. A recent French case<sup>15</sup> indicates how similar considerations can result in precluding protection in other systems: a professor, who had researched and written a work on Cajun culture with admitted "sweat of the brow," charged a prize-winning novelist with copyright infringement. The professor alleged, among other things, that the novelist had drawn his "original" spellings of Cajun words from his compilation of this unwritten dialect. The French trial court held these spellings to be unprotected given that "transcription... obeys strict and necessary rules."<sup>16</sup> Few, if any, alternative formulations could have intelligibly conveyed Cajun pronunciation.

Courts easily shift levels from "vocabulary" to "syntax" in considering historical works. In its *Feist* decision, the Supreme Court gave little thought to the issues that such a shift might entail. Perhaps as a result, it left intact the much-criticized precedent of *Hoehling v. Universal City Studios, Inc.*<sup>17</sup> In that case, historical material from a book, including the "essential plot," was allegedly used in a motion picture. The court in *Hoehling* excused this use, relying on the older judicial language: "[t]here cannot be any such thing as copyright in the order of presentation of the facts."<sup>18</sup> This formula is misleading, however, since "the order of presentation" of any set of facts is itself expression which must, to start, be examined under the rule of merger. Instead, the court in *Hoehling* failed to ask whether the claimant's "essential plot" was one of the few available forms of expression for ordering the facts in question. If it had been, arguably it would not have been protected under the rule of merger. Otherwise, its creativity might have allowed for protection.<sup>19</sup>

The Supreme Court indeed dealt with "syntax" summarily in considering the *Feist* compilation. The Court found no creative choice in the alphabetical ordering of the compiled listings. It treated this ordering as "so commonplace that it has come to be expected as a matter of course" and "practically inevitable."<sup>20</sup> Given users' habits in consulting directories, ease of finding information would seem to have dictated using the alphabet as a key to sequencing the listings. Nor did the Court find any creativity in the selection of the "name, town, and telephone number" of each of claimant's subscribers, all these items being required by the law giving the claimant its telephone [> p. 807] monopoly. The *Feist* decision accordingly provides incomplete guidance in more difficult cases: for example, in *Kregos v.*

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<sup>15</sup> *Griole c. Herman et Editions Grasset*, Trib. grande instance, Paris, 1ère ch., January 15, 1991, 1991/37 Cahiers du droit d'auteur 12.

<sup>16</sup> *Id.* at 15.

<sup>17</sup> 618 F. 2d 972 (1980).

<sup>18</sup> *Id.* at 978, quoting Hand, J., in *Myers v. Mail & Express Co.*, 36 Copyright Office Bulletin 478, 479 (S.D.N.Y. 1919).

<sup>19</sup> See also 2 P. GOLDSTEIN, "Copyright: Principles, Law and Practice," Sec. 8.4.1.4 (1990) (critique of *Hoehling* decision for failure to consider that history is as susceptible of originality as fiction).

<sup>20</sup> *Feist*, *supra* note 1, 111 Sup. Ct. at 1296-1297.

*Associated Press*,<sup>21</sup> the Second Circuit Court of Appeal could not fully agree on how to apply the *Feist* precedent. In the *Kregos* case, there was some minimal, though not obviously creative, selection in compiling baseball statistics.

In particular, dealing with a simple factual compilation, the *Feist* decision left the rule of merger ambiguous in its application to more complex factual works. To start, the rule does not indicate how to specify the relevant "idea," "theme," "fact," etc., for which an element of a work might be denied protection because it is found to be one of very few possible "expressions." Judge Sweet, dissenting in the *Kregos* decision,<sup>22</sup> disagreed with his colleagues on the question: how generally or specifically should the "ideas" guiding the selection of factual categories be formulated before deciding whether or not they could only be "expressed" by presenting certain "facts" in the work at issue? There was some confusion in the majority *Kregos* opinion between the general purpose of bringing together certain baseball statistics – namely, to help readers to predict the outcome of baseball games – and the specific ideas underlying the expressive texture of the work.<sup>23</sup>

Recall that the Supreme Court, in its *Feist* decision, spoke of "thin" copyright. The court in the *Kregos* case gives some meaning to this phrase in dealing with another ambiguity in the rule of merger. That is, while the rule of merger clearly precludes protection where no creative choice is possible, it does not compel that result in cases where some, but not many possibly creative choices are available. The *Kregos* court suggested that, if the plaintiff had chosen but one configuration of data as expression where not very many other configurations would have been appropriate, the court could only find infringement where the defendant virtually duplicated that set, not if it used a closely similar set.<sup>24</sup> In such close cases, perhaps with some regard for the rationale justifying the rule of merger, trial courts tend to limit copyright protection to remedies against slavish imitation, thus acting as if they were granting relief for unfair competition.<sup>25</sup> [**> p. 808**]

### *Impact on Related Fields of Law*

It should be recalled that section 301 of the federal Copyright Act in the United States precludes an action in unfair competition under state law for merely copying any expression

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<sup>21</sup> 19 U.S.P.Q. 2d 1161 (2d Cir. 1991).

<sup>22</sup> *Id.* at 1169-1174.

<sup>23</sup> *Id.* at 1165-1167. This confusion is current in U.S. copyright law. *See, e.g., Whelan Associates, Inc. v. Jaslow Dental Laboratory, Inc.*, 797 F. 1222, 1238-1240 (3rd Cir. 1986) (purpose of a computer program is its "idea" for rule of merger). This confusion appears in, but is not justified by, the differential treatment of computer programs and "useful articles" in U.S. copyright law. *See* J.H. REICHMAN, "Design Protection and the New Technologies: The United States Experience in a Transnational Perspective (Part One)," 30 *Industrial Property* 220, 221 (1991).

<sup>24</sup> *Kregos*, *supra* note 21, 19 U.S.P.Q. 2d at 1168-1169.

<sup>25</sup> *See* REICHMAN, *supra* note 6, at 969-970; Perlmutter, *supra* note 14, at 2-3.

that falls within the scope of federal copyright but does not meet its standards of protection. Under the reading of *Feist* proposed here, this section 301 would also apply to suits for copying the literal expression of facts, however brought together in a compilation: absent any independent element of unfair competition, only copyright, more or less "thin," would be available. Analogous problems could be encountered in other legal systems which also require some independent element, such as risk of confusion, before allowing a suit for unfair competition to protect what copyright or like rights cover, but do not protect.<sup>26</sup>

After the *Feist* decision, enterprises marketing database services in the United States have the dubious solace of knowing where they stand on one point: American copyright will not protect the raw data that these enterprises gather and make publicly available, no matter how great their investment. The *Feist* decision at the same time leaves open the question of knowing to what extent copyright protects databases, not by virtue of their component data, but rather insofar as computer programs determine access to information on computer screens or print-outs. To start inquiry into this question, it is necessary to analyze to what extent computer programs, audiovisual displays, or texts constitute the relevant expression of databases.<sup>27</sup>

The *Feist* decision might well prompt debate on *sui generis* rights in data. Some countries already protect large sets of data with rights that do not last as long as copyright.<sup>28</sup> It would be a mistake, however, to think that, by instituting such data rights, a jurisdiction could avoid questions of protectibility perhaps as difficult as those which beset copyright. For example, how large would a set of data have to be before it were protected, and how much of the data in a set would have to be used before infringement would be found? Also, at least in some cases, data rights might raise the question: should such rights be exclusive or, to avoid anticompetitive practices, subject to legal licenses?<sup>29</sup>

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<sup>26</sup> See, e.g., Federal Supreme Court decision of November 14, 1985, I ZR 68/83, 18 IIC 418, 423-424 (1987) – *Bob Dylan* (absent any independent element, suit for unfair competition not allowed for copying live performances otherwise protectible by German neighboring rights). Note that laws might vary in how easily they allow courts to distinguish an "independent" element of unfair competition among the facts of a case involving copying.

<sup>27</sup> See, e.g., *Digital Communications Associates, Inc. v. Softklone Distributing Corp.*, 659 F. Supp. 449, 455-456 (N.D. Ga. 1987) ("... copyright protection of a computer program does not extend to screen displays generated by the program").

<sup>28</sup> See, e.g., G. KARNELL, "Sweden," Secs. 2[1][b], 2[3] *in fine*, 3[2][a], and 3[3][a], in P. GELLER (ed.), "International Copyright Law," *supra* note 7 ("catalogue rule" protects – for ten years after publication – large sets of data of Swedish origin not qualifying for copyright).

<sup>29</sup> See GINSBURG, *supra* note 4, at 1925-1927.