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A SELECTIVE VIEW OF HISTORY: *FEIST PUBLICATIONS, INC. V. RURAL TELEPHONE SERVICE CO.**

Information is an omnipresent and valuable commodity in modern society.¹ In today's information age, the production and dissemination of information is reaching unprecedented proportions, accounting for a growing percentage of United States wealth and productivity.² As a result, the number of people dependent upon the production, trade and use of information is also increasing.³ An expansion of information-based products and services has come concomitant with the information explosion.⁴ Factual compilations—the arrangement and coordination of factual data into useful, practical, service-oriented information packages—compose a subset of this growing information industry.⁵ Consequently, issues concerning the availability of legal protection for such compilations frequently arise.⁶

* The author gratefully acknowledges the guidance of Professor Alfred C. Yen in developing this Note topic.

¹ Michael Klipper & Meredith Senter, Jr., *Supreme Court Rules Thick Books Thinly Protected*, CONN. L. TRIB., Apr. 29, 1991, at 19.

² U.S. CONGRESS OFFICE OF TECHNOLOGY ASSESSMENT, INTELLECTUAL PROPERTY RIGHTS IN AN AGE OF ELECTRONICS AND INFORMATION 158 (1987) [hereinafter OTA REPORT]. Research conducted by the Congressional Office of Technology Assessment and the President's Commission on Industrial Competitiveness has identified the information industry as a "crucial element in the U.S. economy and its overall international competitiveness." OTA REPORT, *supra*, at 225. According to the commission's report, information and information-based products serve as a vital source of revenue, employment and economic growth in the United States. *See id.* Computer database vendors generated over \$6.5 billion in sales each year. U.S. CONGRESS OFFICE OF TECHNOLOGY ASSESSMENT, COMPUTER SOFTWARE & INTELLECTUAL PROPERTY—BACKGROUND PAPER 6 n.12 (1990). In addition, sales of on-line computer services reached \$9 billion in 1990. Philip H. Miller, Note, *Life After Feist: Facts, the First Amendment, and the Copyright Status of Automated Databases*, 60 FORDHAM L. REV. 507, 520 (1991) (citing CHRIS ELWELL, ONLINE SERVICES: 1990 REVIEW, TRENDS & FORECAST 20 (1991)).

³ OTA REPORT, *supra* note 2, at 158.

⁴ *Id.* Examples of various information-based products and fact-finding services abound, ranging from simple directories and mailing lists, to automated book-locator systems and geographic information systems. *See* Alfred C. Yen, *The Legacy of Feist: Consequences of the Weak Connection Between Copyright and the Economics of Public Goods*, 52 OHIO ST. L.J. 1343, 1369 nn.121–22 (1991). Of particular significance is the proliferation of on-line services and computerized databases serving as information sources. *See* Miller, *supra* note 2, at 517–18.

⁵ *See* Klipper & Senter, *supra* note 1, at 19. Some common examples of compilations include: telephone directories, judicial decision reporters, restaurant guides, real-estate listings, bibliographies, membership lists, credit-rating databases and stock price quotations. *Id.*

⁶ Miller, *supra* note 2, at 509, 517, 521; *see also* William Patry, *Copyright in Compilations of Facts (or Why the "White Pages" Are Not Copyrightable)*, COMM. & L., Dec. 1990, at 37, 39.

According to commentators, the copyrightability of factual compilations has long been legally problematic.⁷ For nearly one hundred years of United States copyright history, a division existed in the federal circuits concerning the copyrightability of factual compilations.⁸ One position, taken by the Seventh, Eighth and Tenth Circuits, protected a compiled work based on the industry or labor invested in the work.⁹ Termed the "sweat theory" or the

⁷ See, e.g., Beryl R. Jones, *Factual Compilations and the Second Circuit*, 52 BROOK. L. REV. 679, 688 (1986) (courts and commentators unable to develop a uniform theory or methodology for protecting factual compilations); Yen, *supra* note 4, at 1343 (application of copyright protection to factual compilations is confused area of copyright law). Numerous articles have been written about the problems concerning the copyrightability of factual compilations. See, e.g., Robert C. Denicola, *Copyright in Collections of Facts: A Theory for the Protection of Nonfiction Literary Works*, 81 COLUM. L. REV. 516 (1981); Jane C. Ginsburg, *Creation and Commercial Value: Copyright Protection of Works of Information*, 90 COLUM. L. REV. 1865 (1990); Robert A. Gorman, *Copyright Protection for the Collection and Representation of Facts*, 76 HARV. L. REV. 1569 (1963); Jones, *supra*; William Patry, *Copyright in Collections of Facts: A Reply*, COMM. & L., Oct. 1984, at 11; Brian A. Dahl, Note, *Originality and Creativity in Reporter Pagination: A Contradiction in Terms?*, 74 IOWA L. REV. 713 (1989); Michael J. Haungs, Note, *Copyright of Factual Compilations: Public Policy and the First Amendment*, 23 COLUM. J.L. & SOC. PROBS. 347 (1990).

In addition, the recent United States Supreme Court decision, *Feist Publications, Inc. v. Rural Telephone Service Co.*—about which this Note is written—has sparked the publication of several recent articles about the copyrightability of factual compilations. See, e.g., Jane C. Ginsburg, *No "Sweat"? Copyright and Other Protection of Works of Information After Feist v. Rural Telephone*, 92 COLUM. L. REV. 338 (1992); Miller, *supra* note 2; Patry, *supra* note 6; Shira Perlmutter, *The Scope of Copyright in Telephone Directories: Keeping Listing Information in the Public Domain*, 38 J. COPYRIGHT SOC'Y 1 (1990); Yen, *supra* note 4.

⁸ Patry, *supra* note 6, at 39; Haungs, *supra* note 7, at 348. Several cases have held that an author's investment of skill and labor is enough to warrant copyright protection in a factual compilation. See, e.g., *Illinois Bell Tel. Co. v. Haines & Co.*, 905 F.2d 1081, 1086 (7th Cir. 1990); *West Publishing Co. v. Mead Data Cent.*, 799 F.2d 1219, 1228 (8th Cir. 1986), *cert. denied*, 479 U.S. 1070 (1987); *Hutchinson Tel. Co. v. Fronteer Directory Co.*, 770 F.2d 128, 131-32 (8th Cir. 1985); *Schroeder v. William Morrow & Co.*, 566 F.2d 3, 5 (7th Cir. 1977); *Jeweler's Circular Publishing Co. v. Keystone Publishing Co.*, 281 F. 83, 88 (2d Cir.), *cert. denied*, 259 U.S. 581 (1922); *Rural Tel. Serv. Co. v. Feist Publications, Inc.*, 633 F. Supp. 214, 218 (D. Kan. 1987), *aff'd*, 916 F.2d 718 (10th Cir. 1990), *rev'd sub nom.* *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 111 S. Ct. 1282 (1991).

In contrast, other cases have held that an author's investment of labor is insufficient to warrant copyright protection in a factual compilation and only those works demonstrating creativity in the selection and arrangement of facts deserve protection. See, e.g., *Harper House, Inc. v. Thomas Nelson, Inc.*, 889 F.2d 197, 205 (9th Cir. 1989); *Worth v. Selchow & Righter Co.*, 827 F.2d 569, 572-73 (9th Cir. 1987), *cert. denied*, 485 U.S. 977 (1988); *Financial Info., Inc. v. Moody's Investors Serv., Inc.*, 808 F.2d 204, 207-08 (2d Cir. 1986), *cert. denied*, 484 U.S. 820 (1987); *Southwestern Bell Tel. & Tel. Co. v. Associated Tel. Directory Publishers*, 756 F.2d 801, 813 (11th Cir. 1985); *Eckes v. Card Prices Update*, 736 F.2d 859, 863 (2d Cir. 1984); *Miller v. Universal City Studios, Inc.*, 650 F.2d 1365, 1369 (5th Cir. 1981).

⁹ See, e.g., *Illinois Bell*, 905 F.2d at 1086 (directory compiled by telephone company from internally maintained records independently created is adequately original and second compiler may not use facts in compilation unless facts are obtained independently by second

"sweat of the brow" approach by commentators,¹⁰ this theory protects any fact-based work resulting from the exertion of meaningful industry or significant labor expended in the process of garnering the facts composing the work.¹¹ In contrast, the Second, Fifth, Ninth and Eleventh Circuits extend protection to factual compilations by virtue of a work's creativity.¹² Termed the "creative selection" approach by one commentator,¹³ this theory of copyright awards protection only to those works exhibiting a modicum of creativity in the selection and arrangement of the facts composing the work.¹⁴

On March 27, 1991, in *Feist Publications, Inc. v. Rural Telephone Service Co.*, the United States Supreme Court confronted and resolved the long-standing split among the circuits concerning the copyrightability of factual compilations by holding that the white pages of a telephone directory are not copyrightable.¹⁵ In *Feist*, the plaintiff filed suit in federal district court in Kansas, alleging copyright infringement of its local telephone directory's white pages.¹⁶

compiler); *Hutchinson*, 770 F.2d at 131-32 (where telephone company's comprehensive alphabetical telephone directory is assembled from data internally maintained, directory is independently created and sufficiently original); *Rural*, 663 F. Supp. at 218, *aff'd*, 916 F.2d 718 (10th Cir. 1990) *rev'd sub nom.* *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 111 S. Ct. 1282 (1991) (white pages of telephone directory constitute original authorship and therefore are copyrightable).

¹⁰ See, e.g., Patry, *supra* note 6, at 42; Yen, *supra* note 4, at 1344. This approach is also called the "industrious collection" standard. See Haungs, *supra* note 7, at 348.

¹¹ See *Schroeder*, 566 F.2d at 5 ("industrious collection" enough to sustain copyright protection in gardening services directory). Consequently, under this theory other compilers must start from scratch and may not copy from the competing work. See *United Tel. Co. of Missouri v. Johnson Publishing Co.*, 671 F. Supp. 1514, 1522 (W.D. Mo. 1987), *aff'd*, 855 F.2d 604 (8th Cir. 1988) (competing compiler cannot benefit from plaintiff's copyrighted work).

¹² See, e.g., *Harper House, Inc. v. Thomas Nelson, Inc.*, 889 F.2d 197, 205 (9th Cir. 1989) (unique selection, format and combination of forms and information sufficient to warrant protection of daily organizer format); *Financial Info., Inc. v. Moody's Investors Serv., Inc.*, 808 F.2d 204, 207-08 (2d Cir. 1986), *cert. denied*, 484 U.S. 820 (1987) (rudimentary procedure for collecting and filling in information on bond cards insufficient creative selection and arrangement to warrant copyright protection); *Southern Bell Tel. & Tel. Co. v. Associated Tel. Directory Publishers*, 756 F.2d 801, 813 (11th Cir. 1985) (copying of facts and underlying selection of telephone directory that was sufficiently arranged to meet originality threshold constitutes infringement); *Miller v. Universal City Studios, Inc.*, 650 F.2d 1365, 1372 (5th Cir. 1981) (labor of research by an author not copyrightable).

¹³ See Yen, *supra* note 4, at 1344. This approach is also called the "originality standard." See Haungs, *supra* note 7, at 348.

¹⁴ See *Eckes v. Card Prices Update*, 736 F.2d 859, 863 (2d Cir. 1984). Under this theory, courts afforded no protection to a work compiled strictly of facts, despite the likelihood or showing that substantial effort accompanied the collection of facts composing the work. See *Moody's Investors*, 808 F.2d at 207-08.

¹⁵ 111 S. Ct. 1282, 1297 (1991).

¹⁶ *Id.* at 1287.

The unanimous Supreme Court rejected the sweat theory of copyright protection and used the creative selection and arrangement approach to refuse copyright protection to the white pages listings.¹⁷ *Feist* is therefore the Supreme Court's first pronouncement on the status of factual compilations under federal copyright law.¹⁸

In *Feist*, the Supreme Court's decision to deny copyright protection to the telephone directory involved the Court's interpretation of the "originality" standard in copyright law.¹⁹ According to the Court, this standard requires that a work granted copyright protection be independently created by the author and reach some minimal level of creativity.²⁰ The *Feist* Court's opinion, written by Justice O'Connor, states that originality, as a prerequisite to copyright protection, is mandated by the Copyright Clause of the United States Constitution, Article I, Section 8, Clause 8.²¹

This Note examines the "originality" standard of copyright protection in the context of *Feist* and explores the basis for and implications of the Court's assertion that originality is constitutionally mandated.²² Section I traces the historical development of the originality requirement in copyright law.²³ Section II reviews the basis for the *Feist* holding and discusses the Court's emphasis on the originality standard.²⁴ Section III analyzes the validity of the Court's insistence that originality is constitutionally mandated.²⁵ This section also discusses the possible impact that the Court's constitutional grounding of originality may have on the future generation and protection of factual compilations.²⁶

¹⁷ *Id.* at 1290-96. For a means/end analysis of the *Feist* Court's application of the creative selection and arrangement approach, see Yen, *supra* note 4.

¹⁸ See *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 111 S. Ct. 1282, 1287 (1991); Patry, *supra* note 6, at 40. As Patry notes, the Court has on two occasions mentioned compilations in dictum. Patry, *supra* note 6, at 40-41. In both instances the Court did not rule out the possibility that directories could be protected. See *Harper & Row, Publications, Inc. v. Nation Enter.*, 471 U.S. 539, 547 (1985); *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 250 (1903).

¹⁹ See 111 S. Ct. at 1287-88.

²⁰ *Id.* at 1287.

²¹ *Id.* at 1288. "Originality is a constitutional requirement." *Id.* at 1288. "As a constitutional matter, copyright protects only those constituent elements of a work that possess more than a *de minimis* quantum of creativity." *Id.* at 1297.

²² See *infra* notes 135-54 and accompanying text for a discussion of the originality requirement in the context of *Feist*.

²³ See *infra* notes 27-116 and accompanying text.

²⁴ See *infra* notes 117-54 and accompanying text.

²⁵ See *infra* notes 155-71 and accompanying text.

²⁶ See *infra* notes 172-95 and accompanying text.

I. THE HISTORICAL DEVELOPMENT OF ORIGINALITY IN COPYRIGHT LAW

One of the more elusive requirements of copyright protection, particularly when applied to factual compilations, is that a work be original.²⁷ The originality requirement is contained in section 102(a) of the 1976 Copyright Act, which provides that copyright protection extends only to "original works of authorship."²⁸ The originality requirement in the statute expressly extends to compilations.²⁹ This explicit statutory mandate of originality is unique to the 1976 Act.³⁰ Although none of the earlier copyright acts contained an express statutory mandate of originality, historically, originality in some form has been a prerequisite of copyright protection.³¹

A. *The Independent Creation Concept of Originality*

For the first century of United States copyright history, beginning with the first Copyright Act of 1790,³² originality was synonymous with independent creation.³³ Courts generally awarded protection to works resulting from the independent labor and skill of the author.³⁴ Under the independent creation interpretation, anything short of actual copying met the originality standard, regardless of how formulaic the work may have been.³⁵ The United States Supreme Court rationalized this independent creation interpreta-

²⁷ Dahl, *supra* note 7, at 713 (originality requirement "perhaps the most unclear requirement" in copyright law); Dale P. Olson, *Copyright Originality*, 48 MO. L. REV. 29, 31 (1983) (judicially developed doctrine relating to the originality requirement "uncertain and confused").

²⁸ 17 U.S.C. § 102(a) (1988).

²⁹ 17 U.S.C. § 103 (1988). By definition, a compilation "as a whole" must constitute "an original work of authorship." *Id.* § 101.

³⁰ Dahl, *supra* note 7, at 716 & n.29. The English Statute of Anne protected "any Book or Books." 8 Anne, ch. 19 (1710). The 1790 Act protected any "map, chart, book or books." Act of May 31, 1790, ch. 15, 1 Stat. 124 (repealed 1909). The 1909 Act failed to mention originality and limited copyright protection to "all writings of an author." 17 U.S.C. § 4 (1947) (originally enacted as Act of March 4, 1909, ch. 320, § 4, 35 Stat. 1075-88) (repealed 1978). The drafters of the 1976 Act deliberately left the phrase "original works of authorship" undefined and intended to incorporate without change the standard of originality established by the courts under the 1909 statute. H.R. REP. NO. 1476, 94th Cong., 2d Sess. 51 (1976); S. REP. NO. 473, 94th Cong., 1st Sess. 50 (1975).

³¹ Olson, *supra* note 27, at 31, 35 (originality long and consistently required for copyright protection).

³² Act of May 31, 1790, ch. 15, 1 Stat. 124 (repealed 1909).

³³ See Ginsburg, *supra* note 7, at 1874; Olson, *supra* note 27, at 35-37.

³⁴ See Ginsburg, *supra* note 7, at 1874; Olson, *supra* note 27, at 35-37.

³⁵ Ginsburg, *supra* note 7, at 1874; Olson, *supra* note 27, at 37.

tion by inferring "originality" from the word "authors" in the Copyright Clause of the United States Constitution.³⁶ As interpreted by the Court, an "author" signified an originator, or one to whom a work owed its *origin*.³⁷ Originality in a work, therefore, merely required that the work *originate* as a product of labor expended by the person claiming authorship.³⁸

Thus, early case law in the United States, as decided under the 1790 Act, stressed the necessity that a protected work be independently created, originating from the author's investment of labor.³⁹ This rewarding of independent creation in United States copyright cases mirrored English copyright decisions.⁴⁰ The similarities between American and English copyright decisions, authors note, resulted from the fact that early American copyright concepts were outgrowths of the English system of copyright.⁴¹ The English system of copyright was embodied in the Statute of Anne, titled "An Act for the Encouragement of Learning, by vesting the Copies of printed Books in the Authors or Purchasers of such Copies during the Times therein mentioned."⁴² The Statute of Anne was designed, as its title suggests, to advance knowledge and learning.⁴³ Similarly,

³⁶ Dahl, *supra* note 7, at 716. The Copyright Clause—Article I, Section 8, Clause 8 of the United States Constitution—empowers Congress "[t]o 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. CONST. art. I, § 8, cl. 8.

³⁷ See *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 57–58 (1884) (author in constitutional sense is originator).

³⁸ See *id.*

³⁹ See, e.g., *Gray v. Russell*, 10 F. Cas. 1035, 1037–38 (C.C.D. Mass. 1839) (No. 5728) (second compiler of Latin Grammar book may not borrow public domain text from first compiler and must use own skill and labor to independently create second compilation). See also Ginsburg, *supra* note 7, at 1873–74 (suggesting that the judicial focus on labor invested in the work, as opposed to the inspiration, until the mid-nineteenth century was largely a function of the predominance of highly useful informational works (i.e., maps, arithmetic and grammar primers, calendars and law books) during the period). Cf. *Clayton v. Stone*, 5 F. Cas. 999, 1003 (C.C.S.D.N.Y. 1829) (No. 2872) (copyright protection of newspaper denied because copyright not intended for encouragement of mere industry, unconnected with learning and the sciences).

⁴⁰ See, e.g., *Matthewson v. Stockdale*, 33 Eng. Rep. 103, 105–06 (Ch. 1806) (upholding copyright protection for plaintiff's East India calendar on the basis of the labor invested in the work).

⁴¹ See LYMAN RAY PATTERSON, *COPYRIGHT IN HISTORICAL PERSPECTIVE* 180 (1968) (all ideas about American copyright originated in the English copyright tradition); Dahl, *supra* note 7, at 714 (Copyright Act of 1790 codified English system of copyright).

⁴² 8 Anne, ch. 19 (1710).

⁴³ See Ginsburg, *supra* note 7, at 1873 (English Statute of Anne characterized copyright as a device to promote the advancement of knowledge). The preamble of the Statute of Anne states that the act is designed to fulfill the dual purposes of discouraging piracy and encouraging "learned Men to compose and write useful Books." 8 Anne, ch. 19 (1710).

both the Copyright Clause in the United States Constitution and the Copyright Act of 1790 were designed to promote the advancement of knowledge.⁴⁴ Consequently, a large number of early American and English copyright cases involved the protection of informational works.⁴⁵

Two prominent cases, *Gray v. Russell* and *Emerson v. Davies*, illustrate early United States courts' willingness to award protection to independently created informational works.⁴⁶ In the 1839 case of *Gray v. Russell*, the Circuit Court of the District of Massachusetts held that original annotations accompanying public domain text were copyrightable subject matter.⁴⁷ In *Gray*, the plaintiff, Benjamin Gould, had prepared notes in an edition of *Adam's Latin Grammar*.⁴⁸ Gould alleged that a second publisher of a competing edition of *Adam's Latin Grammar* infringed upon Gould's copyright by copying the annotations into the competing edition of Latin text.⁴⁹ The second publisher defended on the basis that Gould held an invalid copyright in his annotations because the notes were merely collected from various other editions of the book.⁵⁰ The defendant argued that such a collection of public domain materials was insufficiently original to warrant copyright protection.⁵¹ In an opinion by Justice Story, the *Gray* court held that the annotations were entitled to copyright protection.⁵²

In upholding the validity of Gould's copyright, the *Gray* court established the independent labor standard of originality.⁵³ Under this standard, the *Gray* court awarded protection to Gould's work

⁴⁴ See Ginsburg, *supra* note 7, at 1873 (underlying legislative policy of United States Constitution and 1790 Act was promotion of knowledge); PATTERSON, *supra* note 41, at 193 (prominent idea in the minds of Constitutional framers seems to have been learning); EATON S. DRONE, A TREATISE ON THE LAW OF PROPERTY IN INTELLECTUAL PRODUCTIONS IN GREAT BRITAIN AND THE UNITED STATES 198-99 (1879) (goal of the law of copyright is the promotion of learning and useful knowledge).

⁴⁵ Ginsburg, *supra* note 7, at 1873 & n.28 (citing AUGUSTINE BIRRELL, SEVEN LECTURES ON THE LAW AND HISTORY OF COPYRIGHT IN BOOKS 170-71 (1899)). For a comprehensive listing of early English and American cases protecting directories and other informational works, see DRONE, *supra* note 44, at 153 & nn.1-17.

⁴⁶ 10 F. Cas. 1035, 1037-38 (C.C.D. Mass. 1839) (No. 5728) (original annotations accompanying public domain text copyrightable subject matter); 8 F. Cas. 615, 620-21 (C.C.D. Mass. 1845) (No. 4436) (mathematics book copyrightable).

⁴⁷ 10 F. Cas. at 1037-38.

⁴⁸ See *id.* at 1037.

⁴⁹ See *id.*

⁵⁰ See *id.*

⁵¹ See *id.*

⁵² *Id.* at 1037-38.

⁵³ *Id.* at 1038. See also Olson, *supra* note 27, at 36-37.

by virtue of the independent skill and labor invested by the author.⁵⁴ The court rejected the defendant's contention that because public domain materials are available to everyone, compilations of such information are necessarily unprotectable.⁵⁵ The *Gray* court stated, to the contrary, that if such materials have been accumulated and combined by the labor of one compiler, a second compiler may not borrow the information and thereby profit from the industry, talents or skill of the first compiler.⁵⁶

Similarly, in the 1845 case of *Emerson v. Davies*, the Circuit Court of the District of Massachusetts held that a second compiler of a mathematics book must independently recreate the compilation of materials in order to avoid infringement of the first compiler's copyright.⁵⁷ As in *Gray*, the *Emerson* court stated that a work merits protection by virtue of the author's labor and skill.⁵⁸ Substantial copying that resulted in piracy of copyrighted subject matter was thus prohibited, according to the *Emerson* court.⁵⁹

Gray and *Emerson* therefore established a standard of originality requiring merely that a protected work be independently created.⁶⁰ In awarding copyright protection, the two cases focused on the skill or labor invested by the author in the works.⁶¹ Under this standard of originality, courts of this period frequently recognized copyright protection in directories and other types of compilations.⁶²

In addition to the case law supporting the independent creation concept of originality, secondary sources from the period also

⁵⁴ 10 F. Cas. at 1038.

⁵⁵ See *id.* at 1037-38.

⁵⁶ *Id.* at 1038.

⁵⁷ 8 F. Cas. 615, 620-21 (C.C.D. Mass. 1845) (No. 4436).

⁵⁸ See *id.* at 619-20. The court quoted language from *Gray*, noting, by analogy, that a second map maker does not infringe upon a first map maker's copyright if the second map maker independently makes a map of the same territory using his own skill, labor or expense. *Id.* at 619.

⁵⁹ *Id.* at 619.

⁶⁰ Olson, *supra* note 27, at 36.

⁶¹ *Gray*, 10 F. Cas. at 1037-38; *Emerson*, 8 F. Cas. at 619.

⁶² See, e.g., *Drury v. Ewing*, 7 F. Cas. 1113, 1116 (C.C.S.D. Ohio 1862) (upheld copyright in a chart for cutting women's dress patterns and boy's coat and jacket patterns); *Lawrence v. Cupples*, 15 F. Cas. 25, 25 (C.C.D. Mass. 1825) (upheld copyright in monthly chart containing, in tabular form, the alphabetical listing of the names and addresses of debtors and creditors). In addition, deposit records of works registered for federal copyright protection under the 1790 Copyright Act reveals a predominance of information and instructional works. See Ginsburg, *supra* note 7, at 1873 n.28 (citing FEDERAL COPYRIGHT RECORDS 1790-1800 xxii (J. Gilreath ed., 1987)). See also DRONE, *supra* note 44, at 153 & nn.1-17 for a comprehensive listing of the cases protecting directories and other informational works.

equated originality with labor or skill.⁶³ As one contemporary commentator, George Ticknor Curtis, stated in his 1847 treatise, originality is:

[s]omething [the author] must show to have been produced by himself; whether it be purely original thought or principle . . . or a collection, the result of his industry and skill. . . . He must show something which the law can fix upon as the *product of his and not another's labors*.⁶⁴

Another well-known commentator, Eaton S. Drone, similarly stated in his 1879 treatise that "the true test of originality is whether the production is the result of *independent labor or of copying*."⁶⁵ According to Drone, nearly all products resulting from independent literary labor were worthy of protection if the author demonstrated something material and valuable that was not copied from another but was something he produced by himself.⁶⁶ Under Drone's standard, multiple productions of the same kind could be protected if the individuals producing the works invested labor in that for which they claimed protection.⁶⁷

During this period, Drone expressly considered protecting directories and other informational works similar to the white pages denied protection in *Feist*.⁶⁸ In his treatise on copyright, Drone used directories several times to illustrate his points about originality and as examples of copyrightable subject matter.⁶⁹ In one instance Drone stated: "The compilation may consist of common facts and information which the compiler himself has reduced to writing, as in the case of a catalogue or a directory. . . ." ⁷⁰ Moreover, Drone noted the constitutional policy of promoting knowledge, stating that the important inquiry is not to determine whether a production has literary or scientific merit, but rather whether the work may be viewed as a "material addition" to the pool of useful knowledge and information.⁷¹ Thus, for the first century of United States copyright

⁶³ See GEORGE TICKNOR CURTIS, A TREATISE ON THE LAW OF COPYRIGHT 171 (1847); DRONE, *supra* note 44, at 208.

⁶⁴ CURTIS, *supra* note 63, at 169; 171.

⁶⁵ DRONE, *supra* note 44, at 208 (emphasis added).

⁶⁶ *Id.* at 199.

⁶⁷ *Id.* at 206.

⁶⁸ See *id.* at 153, 206, 207, 209.

⁶⁹ *Id.*

⁷⁰ *Id.* at 153. Drone also states that courts recognized directories, calendars, catalogues of names, compilations of statistics, tables of figures and collections of legal forms as copyrightable subject matter, despite their lack of literary qualities. *Id.* at 209.

⁷¹ *Id.* at 210.

law, courts and commentators viewed originality as meaning independent creation.⁷²

*B. Dichotomy of Originality: Independent Creation and Creativity*⁷³

In the mid-to-late nineteenth century, courts and commentators altered their standard of originality and offered a new rationale for copyright protection.⁷⁴ These authorities injected the additional notion of creativity into the originality standard.⁷⁵ As opposed to the independent labor standard, this new test of a work's originality required an additional infusion of the author's personality into the subject matter before the material merited copyright protection.⁷⁶ Consequently, originality came to mean that a work not only be independently produced, but also contain some modicum of creativity.⁷⁷ The United States Supreme Court read this creativity component of originality into the word "writings" in the Copyright Clause.⁷⁸

The earliest case espousing the dual concept of originality is the 1879 case of *United States v. Steffens*—also known as the *Trade-Mark Cases*—in which the United States Supreme Court held that federal trademark statutes grounded in the Copyright Clause were unconstitutional.⁷⁹ The issue in the *Trade-Mark Cases* was whether

⁷² CURTIS, *supra* note 63, at 171; DRONE, *supra* note 44, at 208; Emerson v. Davies, 8 F. Cas. 615, 619 (C.C.D. Mass. 1845) (No. 4436); Gray v. Russell, 10 F. Cas. 1035, 1037-38 (C.C.D. Mass. 1839) (No. 5728).

⁷³ This article hereafter speaks of "originality" as encompassing the dual concepts of independent creation and creativity. See Ginsburg, *supra* note 7, at 1867 n.9. Some authorities divide the two terms, defining "originality" to mean independent creation and "authorship" to signify some modicum of creativity. See, e.g., Patry, *supra* note 7, at 19.

⁷⁴ See Ginsburg, *supra* note 7, at 1881.

⁷⁵ See Dahl, *supra* note 7, at 716.

⁷⁶ Ginsburg, *supra* note 7, at 1867. Ginsburg terms this approach the "copyright as personality" approach. *Id.* at 1882.

⁷⁷ Patry, *supra* note 7, at 18-19.

⁷⁸ See *The Trade-Mark Cases*, 100 U.S. 82, 94 (1879). See also *supra* note 36 for the text of the Copyright Clause of the United States Constitution.

⁷⁹ 100 U.S. 82, 99 (1879). A trademark is any word, name, symbol, or device used by a manufacturer or merchant to identify his or her goods. 15 U.S.C. § 1127 (1988). Trademarks originated as devices to facilitate the identification of a merchant's product and to prevent mistake, deception and confusion with respect to the product's origin. ARTHUR R. MILLER & MICHAEL H. DAVIS, *INTELLECTUAL PROPERTY: PATENTS, TRADEMARKS, & COPYRIGHT IN A NUTSHELL* § 11.1 (1990). In response to the increasing complexity of state trademark common law, Congress attempted to federalize trademark legislation in the late nineteenth century. *The Trade-Mark Cases*, 100 U.S. at 92. The first trademark laws enacted by Congress were the Act of July 8, 1870, §§ 77-84, 16 Stat. 198, and the Act of Aug. 14, 1876, §§ 1-8, 19 Stat. 141. See *id.* It was these federal statutes that the *Trade-Mark Cases* Court declared

the congressional trademark acts were within the authority granted Congress by the United States Constitution.⁸⁰ In the *Trade-Mark Cases*, the Court reversed three criminal prosecutions for violations of federal trademark legislation.⁸¹ Although the case focused on whether federal trademark statutes were properly grounded in the United States Constitution, the Court's reasoning discussed the Copyright Clause.⁸²

In searching for a constitutional basis for the federal trademark legislation, the *Trade-Mark Cases* Court examined the Copyright Clause of the Constitution.⁸³ In its examination of the Copyright Clause, the *Trade-Mark Cases* Court rejected the argument that federal trademark legislation could be authorized by the words "writings of authors" in the Copyright Clause.⁸⁴ The Court noted that it rejected the argument because the objects of trademark, unlike writings, do not require originality.⁸⁵ The Court asserted that "writings," in the context of the Copyright Clause, must be original and founded in the creative powers of the mind.⁸⁶ According to the Court, writings worthy of copyright protection were "*the fruits of intellectual labor, embodied in the form of books, prints, engravings, and the like.*"⁸⁷

unconstitutional. *Id.* According to the *Trade-Mark Cases* Court, Congress had no power to regulate purely state matters such as trademark rights. *Id.* at 96. In response to the *Trade-Mark Cases*, Congress passed statutes in 1881 and 1905 solely addressing interstate use of trademarks. MILLER & DAVIS, *supra*, § 11.1. In 1946, Congress passed the most current trademark legislation, the Lanham Act. 15 U.S.C. §§ 1051-1127 (1988). The Lanham Act provides for both the federal registration of trademarks and federal court protection against infringement. *Id.* §§ 1055, 1114.

⁸⁰ 100 U.S. at 91-92.

⁸¹ *Id.* at 99. Two indictments were in the southern district of New York, and one was in the southern district of Ohio. *Id.* at 91.

⁸² *Id.* at 93-94. According to the Court, because the property in trademark is a residual power of the states, the power of Congress to legislate on the subject must be grounded in the Constitution. *Id.* at 93.

⁸³ *Id.* at 93-94. The Court also examined the Commerce Clause—Article 1, Section 8, Clause 3 of the Constitution. *Id.* at 94-99.

⁸⁴ *Id.*

⁸⁵ *Id.* at 94. Generally, a trademark is the adoption of a mark already in existence as the distinctive symbol of a product's manufacturer. *Id.* At common law, trademark rights arose from regular usage of the mark and did not depend upon novelty, invention or discovery. *Id.* Thus, trademark rights are acquired solely through priority of use. *Id.*

⁸⁶ *Id.* The Court stated: "[W]hile the word *writings* may be liberally construed, as it has been, to include *original* designs for engravings, prints, &c., it is only such as are original, and are founded in the creative powers of the mind." *Id.* To the contrary, trademark protection, according to the Court, did not depend upon any work of the brain, but merely required that the claimant first appropriate the symbol. *Id.*

⁸⁷ *Id.*

Thus, through the word "writings" as used in the Copyright Clause, the *Trade-Mark Cases* Court infused the originality standard of copyright with a required level of creativity.⁸⁸ The Court did not, however, specify its reasons for asserting that the constitution mandates a level of creativity as a prerequisite to copyright protection.⁸⁹ The Court read this requirement into the word "writings" in the Copyright Clause.⁹⁰ Moreover, the Court did not explicitly establish the parameters of copyrightable subject matter under the creativity standard.⁹¹ Rather, through its use of the language "and the like" in describing those works deserving of protection, the *Trade-Mark Cases* Court left open the question of which works satisfy the creativity requirement of copyright.⁹² Nonetheless, subsequent courts and commentators have interpreted the *Trade-Mark Cases* as establishing a constitutional grounding for the creativity aspect of the originality requirement for copyright protection.⁹³ Thus, the *Trade-Mark Cases* form the basis for the view that creativity is constitutionally mandated.⁹⁴

Shortly after the *Trade-Mark Cases*, the United States Supreme Court again interpreted the word "writings" in the Copyright Clause.⁹⁵ In the 1884 case of *Burrow-Giles Lithographic Co. v. Sarony*, the Court held that photographs are copyrightable within the meaning of the word "writings" in the Copyright Clause.⁹⁶ *Burrow-Giles* involved the copyrightability of a photograph of Oscar Wilde, taken by the plaintiff.⁹⁷ In *Burrow-Giles*, the plaintiff sued the defendant for copyright infringement of the photograph after the defendant reproduced the photograph without permission.⁹⁸ While admitting to copying the photograph, the defendant, Sarony, argued that the plaintiff's photograph was not a "writing" within the meaning of

⁸⁸ *Id.* See also *Higgins v. Keuffel*, 140 U.S. 428, 431 (1891) (quoting language from the *Trade-Mark Cases* about the scope of "writings" as used in the Copyright Clause to deny copyright protection to a label).

⁸⁹ See *The Trade-Mark Cases*, 100 U.S. at 94.

⁹⁰ *Id.*

⁹¹ See *id.*

⁹² *Id.* See *supra* note 87 and accompanying text for the *Trade-Mark Cases* Court's use of the language "and the like."

⁹³ See *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 111 S. Ct. 1282, 1288 (1991); Patry, *supra* note 7, at 18-19; Dahl, *supra* note 7, at 716 & n.36.

⁹⁴ *Feist*, 111 S. Ct. at 1288; Patry, *supra* note 7, at 19.

⁹⁵ *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 57-58 (1884).

⁹⁶ *Id.* at 58.

⁹⁷ *Id.* at 54. The photograph was titled "Oscar Wilde No. 18." *Id.*

⁹⁸ *Id.* at 54.

the Copyright Clause.⁹⁹ Therefore, Sarony argued, it was unconstitutional for Congress to confer rights of authorship on the person who took the photograph.¹⁰⁰ The Circuit Court for the Southern District of New York rejected the defendant's argument and held that the photograph was copyrightable.¹⁰¹ The United States Supreme Court affirmed the lower court's decision.¹⁰²

In *Burrow-Giles*, the Supreme Court defined both the words "authors" and "writings" as used in the Copyright Clause.¹⁰³ In determining the scope of the words "authors" and "writings," the *Burrow-Giles* Court focused on the intent of the constitutional framers.¹⁰⁴ The Court examined whether, in constructing the clause, the framers intended strictly to limit the scope of copyright protection to literary writings.¹⁰⁵ The Court determined that the framers intended an expansive interpretation of both the words "authors" and "writings."¹⁰⁶

In interpreting the word "authors," the *Burrow-Giles* Court reiterated the independent labor concept of authorship, restating the idea that an author is anyone to whom anything owes its origin.¹⁰⁷ The Court next defined the word "writings" to broadly encompass non-literary as well as literary works.¹⁰⁸ The Court justified its expansive interpretation of the word "writings" by noting that the framers of the Constitution explicitly included maps, charts, designs, and other non-literary writings under the scope of protection in the 1790 Act.¹⁰⁹ The *Burrow-Giles* Court inferred from this inclusion of maps and charts that the framers intended a non-literal interpretation of "writings."¹¹⁰ In light of this non-literal interpretation, the Court asserted that the Constitution was broad enough to encompass the copyright of photographs, provided that the pho-

⁹⁹ *Id.* at 56. Sarony argued that the plaintiff's photograph was merely the "reproduction on paper of the exact features of some natural object or of some person. . . ." *Id.*

¹⁰⁰ *See id.* at 56.

¹⁰¹ *Id.* at 55.

¹⁰² *Id.* at 61.

¹⁰³ *Id.* at 57-61.

¹⁰⁴ *Id.* at 57.

¹⁰⁵ *Id.*

¹⁰⁶ *Id.*

¹⁰⁷ *Id.* at 57-58.

¹⁰⁸ *Id.* at 58-60.

¹⁰⁹ *Id.* at 56-57.

¹¹⁰ *Id.* at 58. The Court stated: "Unless . . . photographs can be distinguished in the classification on this point from the maps, charts, designs, engravings, etchings, cuts, and other printings, it is difficult to see why Congress cannot make them the subject of copyright as well as the others." *Id.* at 57.

tographs were "representatives of original intellectual conceptions of the author."¹¹¹

According to the *Burrow-Giles* Court, the photograph of Oscar Wilde satisfied this test.¹¹² For the Court, the plaintiff's selection and arrangement of the subject, costume, draperies and lighting merited protection for the photograph.¹¹³ The Court also noted that the "ordinary production of a photograph" might not be worthy of copyright protection.¹¹⁴ The Court did not, however, extend its holding to resolve that issue.¹¹⁵ The United States Supreme Court has recently interpreted the language in *Burrow-Giles* pertaining to an author's "original intellectual conceptions" as imposing, along with the *Trade-Mark Cases*, a constitutional creativity component within the originality requirement.¹¹⁶

II. THE FEIST DECISION

On March 27, 1991, in *Feist Publications, Inc. v. Rural Telephone Service Co.*, the United States Supreme Court held that the white pages of a telephone directory are not copyrightable.¹¹⁷ The decision represents the Court's first effort to inject regularity into the copyrightability of factual compilations.¹¹⁸ In *Feist*, a certified public telephone utility, Rural Telephone Service Company ("Rural"), brought a copyright infringement action against a publisher of area-wide telephone directories, Feist Publications, Inc. ("Feist").¹¹⁹ Pursuant to a state regulation mandating that all Kansas telephone companies annually issue updated directories, Rural published a traditional telephone directory, consisting of white pages and yellow

¹¹¹ *Id.* at 58.

¹¹² *Id.* at 60.

¹¹³ *Id.*

¹¹⁴ *Id.* at 59.

¹¹⁵ *Id.*

¹¹⁶ See *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 111 S. Ct. 1282, 1288 (1991).

¹¹⁷ *Id.* at 1297.

¹¹⁸ Miller, *supra* note 2, at 507 (*Feist* Court set out to clear up long-standing confusion relating to copyrightability of factual compilations); Patry, *supra* note 6, at 39 (Supreme Court's grant of certiorari in *Feist* is vehicle for resolving issues surrounding the copyrightability of factual compilations); Yen, *supra* note 4, at 1343 (*Feist* is opportunity for Supreme Court to clarify copyrightability of factual compilations). The issues of copyrightability and infringement upon the copyrights of telephone directories naturally extend to computer databases such as mailing and membership lists, genealogies, organization charts, parts catalogs, and many other types of information-based products. Balla H. Celedonia, 'Feist v. Rural Telephone': *Is the Sky Falling for Directory Publishers?*, N.Y. L.J., Apr. 12, 1991, at 28. *Feist*, therefore, directly impacts the entire information industry. Miller, *supra* note 2, at 509.

¹¹⁹ 111 S. Ct. at 1286-87.

pages.¹²⁰ Rural obtained data for the directory from its subscribers, who, as a condition of telephone service, were required to provide their names and addresses to Rural.¹²¹

Feist extracted the listings in its area-wide directory from Rural's single area directory without obtaining Rural's consent.¹²² Further, Feist incorporated the extractions into its area-wide directory.¹²³ The United States District Court for the District of Kansas granted Rural's motion for summary judgment on the grounds that telephone directories had historically and consistently been afforded copyright protection.¹²⁴

On appeal by Feist, the United States Court of Appeals for the Tenth Circuit, in an unpublished opinion, affirmed the lower court's grant of summary judgment.¹²⁵ On appeal from that decision, the United States Supreme Court unanimously reversed and held for the defendant, Feist.¹²⁶ The *Feist* Court held that Rural's white pages were not entitled to copyright protection.¹²⁷ Consequently, the Court never reached the issue of infringement.¹²⁸

In *Feist*, the Supreme Court decided which theory of copyright protection applies to factual compilations.¹²⁹ As previously discussed, before *Feist* the lower federal courts were divided on whether to protect such compilations.¹³⁰ While courts using the "sweat of the brow" standard awarded copyright protection on the basis of the author's expenditure of labor, other circuits applied the "creative selection" approach and awarded protection only to those factual compilations exhibiting creativity in the selection and arrangement of facts.¹³¹ In *Feist*, the Court renounced the sweat of the brow theory and instead applied the creative selection and

¹²⁰ *Id.* at 1286.

¹²¹ *Id.*

¹²² *Id.*

¹²³ *Id.* Feist extracted the listings after Rural's refusal to license its listings to Feist. *Id.* Omission of the listings within Rural's subscriber area would have resulted in a gap in Feist's area-wide directory, which serviced 11 different telephone areas in 15 counties. *Id.* Feist was successful in securing license agreements with the other 10 telephone companies. *Id.*

¹²⁴ *Rural Tel. Serv. Co. v. Feist Publications, Inc.*, 663 F. Supp. 214, 218 (D. Kan. 1987).

¹²⁵ *Feist*, 111 S. Ct. at 1287.

¹²⁶ *Id.* at 1297. While *Feist* was a unanimous decision, Justice Blackmun concurred only in the judgment and did not file a separate opinion.

¹²⁷ *Id.*

¹²⁸ *Id.*

¹²⁹ *Id.*

¹³⁰ Compare *Illinois Bell Tel. Co. v. Haines & Co.*, 905 F.2d 1081, 1086 (7th Cir. 1990) with *Harper House, Inc. v. Thomas Nelson, Inc.*, 889 F.2d 197, 205 (9th Cir. 1989).

¹³¹ See Yen, *supra* note 4, at 1344-45.

arrangement approach.¹³² Under this approach, the Court denied copyright protection to the directory.¹³³ The Court held that Rural's selection and alphabetical listing of its customers' names lacked the level of originality necessary to copyrightable material.¹³⁴

The *Feist* Court analyzed the issue of the directory's copyrightability under the two-pronged originality requirement for copyright protection.¹³⁵ The Court stated that originality in copyright requires that the work be independently created by the author and that it reach some minimal level of creativity.¹³⁶ The Court further asserted that mere facts themselves are not copyrightable, because they are not independently created by the author, but rather, are merely discovered.¹³⁷ The facts of the directory—the names, addresses and phone numbers of Rural customers—were therefore not protectable by copyright.¹³⁸

According to the *Feist* Court, to afford copyright protection to underlying facts—via the “sweat of the brow” approach—would be to extend protection beyond the creative contributions of the author.¹³⁹ Such an extension, according to the Court, fell outside the statutory and constitutional copyright limits.¹⁴⁰ The Court nonetheless conceded that Rural's directory as a whole could be copyrightable if the selection and arrangement of the facts reached the necessary level of creativity.¹⁴¹ The Court held that Rural's alphabetical arrangement of names with corresponding addresses and phone numbers did not rise to the level of creativity necessary to warrant the listings worthy of copyright protection.¹⁴²

¹³² 111 S. Ct. at 1291–95.

¹³³ *Id.* at 1296.

¹³⁴ *Id.* at 1296. The Court stated:

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

Id.

¹³⁵ *Id.* at 1287.

¹³⁶ *Id.*

¹³⁷ *Id.* at 1288 (person may not claim originality as to facts “because facts do not owe their origin to an act of authorship”).

¹³⁸ *Id.* at 1286.

¹³⁹ *Id.* at 1291.

¹⁴⁰ *See id.* at 1291–92.

¹⁴¹ *Id.* at 1289.

¹⁴² *Id.* at 1296–97. The Court called Rural's white pages “entirely typical” and “devoid of even the slightest trace of creativity.” *Id.* at 1296. The Court further stated: “there is

In the *Feist* opinion, the Court emphasized that the dichotomous originality standard is not only required by the federal copyright statute, but also is constitutionally mandated by the Copyright Clause.¹⁴³ The Court emphasized that this constitutional requirement was "unmistakably clear" and remained the "bedrock principle" of copyright law.¹⁴⁴ The Court first recited the source of Congress's power to enact copyright laws: the Copyright Clause of the United States Constitution.¹⁴⁵ The Court then traced the historical development of the originality standard directly back to the *Trade-Mark Cases* and *Burrow-Giles Lithographic Co. v. Sarony*.¹⁴⁶ The *Feist* Court stated that these cases jointly pronounced that the dual prongs of originality—*independent creation and creativity*—were constitutionally mandated.¹⁴⁷ The Court noted that the *Trade-Mark Cases* established the constitutional scope of the word "writings."¹⁴⁸ According to the *Feist* Court, the *Trade-Mark Cases* read into the word "writings" the idea that "originality requires independent creation *plus* a modicum of creativity. . . ."¹⁴⁹

Similarly, the *Feist* Court asserted that the *Burrow-Giles* Court interpreted the same dual requirement of originality into the word "authors" in the Copyright Clause.¹⁵⁰ According to the *Feist* Court, *Burrow-Giles* stressed the creative component of originality.¹⁵¹ Consequently, according to the *Feist* Court, *Burrow-Giles* established that the creativity prong of the dual originality standard was a consti-

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." *Id.* at 1297.

¹⁴³ *Id.* at 1288. Indeed, the Court expressed the holding itself in constitutional terms, stating that "[t]he selection, coordination, and arrangement of Rural's white pages do not satisfy the minimum constitutional standards for copyright protection." *Id.* at 1296.

¹⁴⁴ *Id.* at 1288. Moreover, the Court asserted the constitutional requirement of originality and creativity several times in the opinion. *Id.* at 1288 ("Originality is a constitutional requirement."), 1290 ("As we have explained, originality is a constitutionally mandated prerequisite for copyright protection."), 1296 ("As this Court has explained, the Constitution mandates some minimal degree of creativity. . . ."), 1297 ("As a constitutional matter, copyright protects only those constituent elements of a work that possess more than a *de minimis* quantum of creativity.").

¹⁴⁵ *Id.* at 1288.

¹⁴⁶ *Id.* See *supra* note 79–116 and accompanying text for a discussion of the *Trade-Mark Cases* and *Burrow-Giles*.

¹⁴⁷ *Feist*, 111 S. Ct. at 1288.

¹⁴⁸ *Id.*

¹⁴⁹ *Id.* (emphasis added).

¹⁵⁰ *Id.*

¹⁵¹ *Id.*

tutional requirement.¹⁵² Thus, the *Feist* Court drew its assertion that the dual-pronged originality standard is dictated by the Constitution from its reading of the *Trade-Mark Cases* and *Burrow-Giles*.¹⁵³ Section III of this Note examines the strength of the Court's assertion that the creativity prong of the current dual-pronged originality standard is constitutionally mandated.¹⁵⁴

III. A CONVENIENT OR ACCURATE INTERPRETATION OF HISTORY?

In tracing the historical development of the originality standard of copyright, the *Feist* Court began with the *Trade-Mark Cases*.¹⁵⁵ Consequently, the Court's interpretation of the originality standard relied on the late nineteenth-century case law.¹⁵⁶ Arguably, 1879—the year in which the *Trade-Mark Cases* were decided—is the correct starting point for copyright analysis because it is the year in which the Supreme Court first pronounced the constitutional scope of copyright protection.¹⁵⁷ Closer analysis, however, reveals that full appreciation of what was intended by the language in the *Trade-Mark Cases* and *Burrow-Giles* requires an examination of earlier case law. Such an examination exposes weaknesses in the *Feist* Court's assertion that creativity is constitutionally mandated.

A. A Selective View of Precedent

First, by beginning its historical review of originality with the *Trade-Mark Cases*, the *Feist* Court overlooked the entire first century of copyright law in this country.¹⁵⁸ Additionally, the Court ignored the English precedent upon which United States copyright law was based.¹⁵⁹ From the enactment of the Constitution until the *Trade-Mark Cases*, an entire body of case law and secondary sources existed that construed "originality" merely to require independent crea-

¹⁵² *Id.*

¹⁵³ *Id.*

¹⁵⁴ See *supra* notes 135–53 and accompanying text for a discussion of the *Feist* Court's assertion that the dual-pronged originality standard is constitutionally mandated.

¹⁵⁵ *Feist*, 111 S. Ct. at 1288.

¹⁵⁶ See *id.*

¹⁵⁷ The *Trade-Mark Cases*, 100 U.S. 82 at 94. See also *supra* notes 79–94 and accompanying text for a discussion of the *Trade-Mark Cases*.

¹⁵⁸ See *supra* notes 32–72 and accompanying text for a discussion of the first 100 years of copyright history.

¹⁵⁹ See *supra* notes 40–45 and accompanying text for a discussion of early English copyright law.

tion.¹⁶⁰ This collection of authority contemplated protecting—and actively protected—directories and other informational works on the basis of the labor invested.¹⁶¹ For the first one hundred years of copyright history, in the decades closest to the framing of the Constitution, originality simply meant independent creation. Thus, by ignoring earlier precedent and selectively beginning its historical review of copyright law in 1879, the *Feist* Court misleads the reader into thinking that it is reciting an “unmistakably clear” and well-established constitutional mandate.¹⁶² In reality, considering the complete copyright history, the *Feist* Court’s assertion of a constitutional mandate is not legally well founded.

Moreover, pre-1879 history strongly suggests that the constitutional framers contemplated protecting directories and other informational works.¹⁶³ The bulk of the case law for the first one hundred years of copyright law in the United States—arguably based on the framers’ intent—protected directories.¹⁶⁴ Presumably, the *Trade-Mark Cases* Court and *Burrow-Giles* Court intended to interpret those cases consistent with the intent of the framers who drafted the Copyright Clause.

And yet, the *Feist* Court neither refers to the pre-1879 history nor offers any explanation of why the Supreme Court’s interpretation of the framers’ intent and the constitutional standard changed in 1879. If the *Trade-Mark Cases* Court or *Burrow-Giles* Court had offered an explanation for the new standard, the *Feist* Court’s exclusive reliance on the *Trade-Mark Cases* and *Burrow-Giles* would be more justified. The absence of any explanation, however, only deepens the confusion today. Because subsequent cases continued to build upon the empty pronouncements in the *Trade-Mark Cases* and *Burrow-Giles*, copyright law developed into an inconsistent and confusing doctrine. By relying on this lineage as a basis for its decision, the *Feist* Court resuscitated and perpetuated the confusion.

The *Feist* decision is confusing not only for its disappointing lack of explanation. It is also unclear whether the *Trade-Mark Cases*

¹⁶⁰ See *supra* notes 46–72 and accompanying text for a discussion of the independent creation standard of originality.

¹⁶¹ See *supra* notes 46–62 and accompanying text for a discussion of the case law protecting factual compilations on the basis of the labor expended in compiling the works.

¹⁶² See *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 111 S. Ct. 1282, 1288 (1991).

¹⁶³ See *supra* notes 32–72 and accompanying text for a discussion of pre-1879 copyright history.

¹⁶⁴ See *supra* notes 46–62 and accompanying text for a discussion of the case law predominating the first 100 years of copyright law.

and *Burrow-Giles* case actually support the *Feist* Court's assertion of a constitutionally mandated creativity requirement. Indeed, the *Trade-Mark Cases* concerned the constitutional validity of congressional trademark legislation, not the constitutional scope of copyright protection.¹⁶⁵ Consequently, the *Trade-Mark Cases* Court's interpretation of "writings," as used in the Copyright Clause, was merely intended as a comparison to trademark law.¹⁶⁶ The *Trade-Mark Cases* Court did not interpret "writings" to demonstrate what copyright law protected; rather, the purpose of the interpretation was to show what trademark law did not protect. This language is dictum because the *Trade-Mark Cases* Court was not required to address the constitutional scope of copyright at all.

Thus, the *Trade-Mark Cases* context suggests that the *Trade-Mark Cases* Court may not have intended to change the constitutional scope of copyright protection. The *Trade-Mark Cases* Court did not announce that it was rejecting a well-established and generally accepted copyright standard. Additionally, the *Trade-Mark Cases* Court left open the possibility that directories may be copyrightable. The *Trade-Mark Cases* Court used broad language, including "and the like," when referring to the kind of works copyright protected.¹⁶⁷ Because simple telephone directories were commonly protected during the period of the *Trade-Mark Cases* the Court may not have meant to exclude directories from its definition of protectable material.

Similarly, *Burrow-Giles* may not support the *Feist* Court's assertion that the creativity component of originality is constitutionally mandated. The focus of *Burrow-Giles* was on determining the framers' intent regarding the scope of the words "authors" and "writings" as used in the Copyright Clause.¹⁶⁸ *Burrow-Giles*, therefore, focused on whether the framers intended to confine copyright protection to literary works. Indeed, shortly after *Burrow-Giles* was decided, the United States Supreme Court cited it for the proposition that "authors" and "writings," as used in the Copyright Clause, are not confined to literary writers and their works.¹⁶⁹ Additionally, as with the *Trade-Mark Cases*, at the time of *Burrow-Giles*, case law and secondary sources suggested that the constitutional framers in-

¹⁶⁵ See *supra* notes 79-94 and accompanying text for a discussion of the *Trade-Mark Cases*.

¹⁶⁶ See *supra* notes 83-87 and accompanying text for a discussion of the *Trade-Mark Cases* Court's examination of the Copyright Clause.

¹⁶⁷ 100 U.S. at 94.

¹⁶⁸ See *supra* notes 95-116 and accompanying text for a discussion of *Burrow-Giles*.

¹⁶⁹ See *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 242 (1903).

tended to protect the kind of informational work denied protection in *Feist*.¹⁷⁰ Given this history, it is possible that in defining the word "writings," as used in the Copyright Clause, the *Burrow-Giles* Court did not intend to *exclude* directories from the scope of protection; rather, the Court merely meant to expand the scope of protectable works to *include* photographs and other non-literary writings.

B. Implications of the Feist Court's Assertion

The United States Supreme Court could have reached the conclusion that the directory in *Feist* was not protected without invoking the Constitution.¹⁷¹ Indeed, the Court had several options. First, the *Feist* Court could have held that Rural's white pages were in fact copyrightable under the sweat of the brow theory because compilation of the names and addresses in the directory required effort.¹⁷² With such a holding the Supreme Court could have determined that *Feist* did not borrow anything other than uncopyrightable facts. The Court therefore could have held that *Feist*'s borrowing did not rise to a level of actionable infringement.¹⁷³ Thus, the Court could have reached the same result without rejecting the sweat theory in its entirety.¹⁷⁴

Alternatively, the Court could have held that the white pages were not copyrightable solely as a matter of statutory law.¹⁷⁵ Such a

¹⁷⁰ See *supra* notes 32-72 and accompanying text for a discussion of the case law and secondary sources supporting the protection of informational works.

¹⁷¹ See Marci A. Hamilton, *Justice O'Connor's Opinion in Feist Publications, Inc. v. Rural Telephone Service Co.: An Uncommon Though Characteristic Approach*, 38 COPYRIGHT SOC'Y 83, 87 (1990).

¹⁷² See *supra* notes 9-11 and accompanying text for a discussion of the sweat of the brow approach to copyright protection.

¹⁷³ For an infringement analysis of the *Feist* case, see Perlmutter, *supra* note 7, at 12-18.

¹⁷⁴ Instead, the Court explicitly and completely renounced the sweat theory. See *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 111 S. Ct. 1282, 1291-94 (1991); Miller, *supra* note 2, at 515 (commenting that *Feist* signifies a "clear defeat" for the industrious collection doctrine).

¹⁷⁵ Because copyright protection is purely a creature of statute, the statutory definition of copyrightable works must guide any analysis of the copyrightability of factual compilations. Patry, *supra* note 6, at 48-49. Admittedly, the Court does conduct a statutory analysis. See *Feist*, 111 S. Ct. at 1293-94. The *Feist* Court noted statutory support for its creative selection and arrangement standard in § 101 of the 1976 Act. *Id.* at 1293. Section 101, as quoted by the Court, defines "compilation" as "a work formed by the collection and assembly of pre-existing data that are selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes an original work of authorship." *Id.* at 1293 (quoting 17 U.S.C. § 101 (1988)). According to the Court, § 101 therefore mandates, through its tripartite structure, that a compilation seeking protection contemporaneously demonstrate three separate elements: "(1) the collection and assembly of pre-existing material, facts, or data; (2) the

holding, which would not implicate the Constitution, would have enabled Congress to amend the copyright statute to provide protection for factual compilations such as white pages listings.¹⁷⁶ Under the *Feist* holding, however, an amendment to the 1976 Copyright Act protecting factual compilations would be unconstitutional.¹⁷⁷

In light of these observations, the *Feist* decision raises several important issues. The first issue concerns why the Court decided *Feist* the way it did. The second involves whether the United States Supreme Court usurped Congress's power in deciding *Feist* on both constitutional and statutory grounds. The third concerns a determination of the scope of the *Feist* holding and an examination of the possible implications on the future of factual compilations. Such an examination is important in light of our national economy's dependence on the production and dissemination of information.¹⁷⁸

It is unclear why the United States Supreme Court decided *Feist* in the manner it did. Perhaps the Court was motivated by a desire to ground its opinion in an even higher authority than itself—the Constitution of the United States. Perhaps the Court was being entirely sincere, albeit short-sighted and a little careless. Perhaps the *Feist* Court's decision to deny protection to the white pages listing of a telephone directory was really intended as a message to Congress that to protect factual compilations, Congress must amend the current copyright statute. In light of the *Feist* Court's insistence upon the constitutional origin of the originality standard, however, such an amendment would not be constitutional.

Regardless of why *Feist* was decided in the manner it was, that *Feist* was decided on constitutional as well as statutory grounds raises a second issue: whether the Supreme Court encroached upon Congress's power in declaring the creativity prong of originality a con-

selection, coordination, or arrangement of those materials; and (3) the creation, by virtue of the particular selection, coordination, or arrangement, of an 'original' work of authorship." *Feist*, 111 S. Ct. at 1293. For a full discussion of why Rural's white pages are not copyrightable strictly as a statutory matter, see Patry, *supra* note 6, at 57-61.

¹⁷⁶ Legislative history of the 1976 Act anticipates future Congresses' desire to protect areas of existing subject matter that the 1976 Act does not protect. H.R. REP. NO. 1476, *supra* note 30, at 52; S. REP. NO. 473, *supra* note 30, at 51.

¹⁷⁷ See Miller, *supra* note 2, at 534-35 (commenting that *Feist*'s Constitutional grounding of originality constitutes a "formidable roadblock" against future legislative efforts to provide thicker protection to databases and factual compilations).

¹⁷⁸ See OTA REPORT, *supra* note 2, at 9-11. See also *supra* notes 1-6 and accompanying text for a discussion of the importance of information in today's society.

stitutional mandate. As previously noted, Justice O'Connor engaged in a pervasive constitutional analysis in the *Feist* decision.¹⁷⁹ This constitutional analysis is unnecessary because the same outcome may be reached from statutory analysis.¹⁸⁰ Consequently, *Feist* creates separation of powers tension.

According to one theory of constitutional interpretation, the United States Supreme Court should allow legislatures and elected executives, whenever possible, to police themselves.¹⁸¹ This approach to judicial review, termed the "Bickellian approach" by Guido Calabresi, notes that the Supreme Court should allow Congress to pass or amend legislation to reach the result Congress intends—particularly when no fundamental right is at stake.¹⁸² Indeed, the right to retain copyright protection for a telephone directory may not implicate any fundamental constitutional right.¹⁸³

Thus, under the Bickellian approach to judicial review, the *Feist* Court is justified in holding Rural's copyright invalid on statutory grounds. The *Feist* Court, however, overstepped its judicial boundaries in implying that Congress cannot amend federal copyright legislation to protect directories and other informational works. Of course, such a conclusion assumes that the *Feist* Court actually intended to limit Congress's ability to amend the federal copyright statute. Future congressional attempts to modify the originality standard of copyright protection in the copyright statute may clarify this issue.

Absent an amendment to the federal copyright statute, the future of factual compilations is largely dependent upon the scope of the *Feist* holding. Although the scope of *Feist* remains to be seen as future courts interpret the decision, it is useful to consider some of the possible interpretations. If read in isolation and related solely to telephone directories, the *Feist* decision may have minimal implications on the future of the production of factual compilations. After all, the *Feist* decision is justifiable based on the policy that the

¹⁷⁹ See *supra* note 143–54 and accompanying text for a discussion of Justice O'Connor's constitutional analysis. Justice O'Connor engaged in constitutional analysis even though the Court did not grant certiorari to address a constitutional issue. Hamilton, *supra* note 171, at 87.

¹⁸⁰ See *supra* note 176 for a discussion of the outcome of *Feist* under statutory analysis.

¹⁸¹ See Guido Calabresi, *Supreme Court 1990, Term—Foreword: Antidiscrimination and Constitutional Accountability (What the Bork-Brennan Debate Ignores)*, 105 HARV. L. REV. 80, 103–06 (1991).

¹⁸² *Id.* at 106 & n.76.

¹⁸³ Hamilton, *supra* note 171, at 90.

goal of copyright is to promote knowledge and learning.¹⁸⁴ In the case of telephone directories, there probably is no need to worry about generating incentives for production. For example, Rural was required by law to publish the names, addresses and phone numbers of its customers. In light of this pre-existing incentive, the additional incentive of copyright protection may be unnecessary.¹⁸⁵

On the other hand, if *Feist* is read to extend to other informational works, a concern for incentives may be warranted.¹⁸⁶ Because a creator's potential to reap rewards increases with the amount of protection a work receives, allowing the extensive use of facts from directories other than white pages will necessarily reduce the incentive for authors to create such directories. Consequently, the American public may suffer from a decrease in the amount of informational works produced after the *Feist* decision.

Nonetheless, it is important to note that there are public interests served by denying copyright protection to factual compilations. The public may benefit from greater access to factual information because it can be copied and reproduced freely. In turn, freer access to information may motivate authors to create new works building upon the unprotected information.¹⁸⁷

It is also important to note that other types of informational works may still be protected even after *Feist*. *Feist* does not completely rule out the possibility of copyright protection for factual compilations.¹⁸⁸ Under *Feist*, a compilation will receive protection if it is arranged in such a way as to meet the creativity prong of the Court's test.¹⁸⁹ The parameters of creativity, however, are not clear.¹⁹⁰ Thus, which compilations will be protected by copyright law depends largely on future courts' interpretations of *Feist*.¹⁹¹

¹⁸⁴ See *supra* notes 43-44 and accompanying text for a discussion of the goals of copyright law.

¹⁸⁵ See Perlmuter, *supra* note 7, at 18.

¹⁸⁶ See Yen, *supra* note 4, at 1374-75.

¹⁸⁷ See Perlmuter, *supra* note 7, at 20.

¹⁸⁸ See *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 111 S. Ct. 1282, 1294 (1991).

¹⁸⁹ *Id.* Indeed, the *Feist* Court admits that the creativity requirement is not stringent and that the "vast majority" of compilations will meet the standard. *Id.* According to the Court, copyright protection is unavailable only for a small category of works "in which the creative spark is utterly lacking or so trivial as to be virtually nonexistent." *Id.*

¹⁹⁰ Perhaps the Court will be very lenient with its creativity requirement. After all, the alphabetical arrangement of names is historically one of the more trite methods of arranging facts.

¹⁹¹ At the time of this writing, seven reported cases have interpreted *Feist*. *Victor Lalli Enter., Inc. v. Big Red Apple, Inc.*, 936 F.2d 671, 673 (2d Cir. 1991) (copyright protection unavailable for the gathering, verification and rearrangement of factual material on charts

IV. CONCLUSION

In *Feist Publications, Inc. v. Rural Telephone Service Co.*, the United States Supreme Court asserts that the dual-pronged originality standard is constitutionally mandated.¹⁹² The *Feist* Court's rhetoric suggests that such a requirement has always existed and that the *Feist* decision naturally stems from an uncontroversial and well-established constitutional principle. Upon closer examination, however, it is evident that this is not the case. By selectively choosing precedent, the Court overlooks the existence of a long tradition of law interpreting originality to require only independent creation.

Consequently, the *Feist* Court asks the reader to believe that society has no choice but to cope with a constitutionally mandated dual-pronged originality requirement. In a society brimming over with non-creative informational works, such a message is disheartening. At the same time, the Court fails to fully account for its reasoning. The danger in the Court's approach is clear: mandating originality as a constitutional standard may preclude Congress from protecting a growing body of informational works, which in turn may discourage authors from producing them without copyright protection. Even greater still is the danger resulting from a Court that continues to build upon precedent without ever stopping to ask why.

JENNIFER R. DOWD

containing winning numbers in illegal gambling operations); *Kregos v. Associated Press*, 937 F.2d 700, 704-05 (2d Cir. 1991) (copyright claim valid and summary judgment inappropriate for publisher of baseball pitching form because the possibility exists that, as a matter of law, the selection and arrangement of nine items of information about pitchers' past performances rises to minimum level of creativity under *Feist*); *Folio Impressions, Inc. v. Byer California*, 937 F.2d 759, 764-65 (2d Cir. 1991) (copyright protection available for pattern of roses placed in straight lines, facing various directions, because sufficiently creative to warrant protection under *Feist* originality standard); *Sem-Torq, Inc. v. K Mart Corp.*, 936 F.2d 851, 855 (6th Cir. 1991) (copyright protection unavailable for set of five double-sided signs where entire set cannot stand as independent work apart from its components); *Illinois Bell Tel. Co. v. Haines & Co.*, 932 F.2d 610, 611 (7th Cir. 1991) (copyright protection unavailable for telephone company's white pages); *Bellsouth Advertising & Publishing Corp. v. Donnelley Infor. Publishing, Inc.*, 933 F.2d 952, 958 (11th Cir. 1991) (copyright protection available for formatting of yellow pages into a convenient, unique organization of business listings and advertisements); *Project Dev. Group, Inc. v. O.H. Materials Corp.*, 766 F. Supp. 1348, 1354 (W.D. Pa. 1991) (copyright protection unavailable to components of bid proposal where no originality in selection or arrangement of facts contained in subcontractor's estimates of scope of work, price and quantities supplied to contractor).

¹⁹² 111 S. Ct. at 1288. See also *supra* notes 143-54 and accompanying text for a discussion of the Court's assertion that the dual-pronged originality requirement is constitutionally mandated.