

## "Wither Goes Copyright Law?"

by N. Stephan Kinsella and Robert E. Rosenthal

September 04, 1997

*The Legal Intelligencer*

---

It is not a good sign when a federal judge derides your work as a "purely mechanical" application of pre-existing rules and lacking even a "modicum" of creativity. Under today's evolving copyright jurisprudence, this likely means one thing -- that your claim of copyright infringement is about to be rejected.

At least, this would be the conclusion that one would draw after examining recent copyright cases, which exhibit a trend toward an arguably looser protection of copyright. One case, involving maps and decided here in the Eastern District of Pennsylvania, will have potentially an immense effect on the cartographic industry and beyond; another stands to have a significant effect on the publication of judicial opinions.

## SWEAT OF THE BROW

It all started with a 1991 Supreme Court decision which has had serious repercussions in ensuing copyright jurisprudence. In *Feist Publications, Inc. v. Rural Telephone Serv. Comp., Inc.*, 499 U.S. 340, 111 S.Ct. 1282 (1991), the Supreme Court rejected the creatively named "sweat-of-the-brow" doctrine, thereby casting a shadow on the copyrightability of many items -- like maps -- previously protectable by copyright.

Under the sweat-of-the-brow doctrine, even works exhibiting minimal creativity, like maps and other so-called compilations or collections of facts, were entitled to a copyright as the reward for the intense labor involved in compiling such facts, which are undeniably useful to the public.

In *Feist*, however, the court squarely rejected this doctrine, holding only creativity, not intense labor, can render factual compilations copyrightable.

In particular, *Feist* held that a factual compilation is copyrightable only if it "features an original selection or arrangement of facts." This originality requires a compiler to make at least minimally creative, independent choices regarding the selection and arrangement of facts.

In the *Feist* decision, this rule was used to hold that an alphabetical listing of surnames in a telephone white pages directory is not protectable, since such a listing is "devoid of even the slightest trace of creativity," and thus lacks the requisite originality. White pages' directories are extremely useful lists of facts that require immense labor to produce, yet their production lacks the creativity necessary to imbue them with copyrightability.

## MAPS

In the recent map case, *Alexandria Drafting Co. [ADC] v. Amsterdam*, 43 USPQ2d 1247 (E.D. Pa. 1997), decided this June, the plaintiff ADC alleged that the defendant, Franklin Maps, had copied from ADC's map books in violation of ADC's copyright

violation of ADC's copyright.

Unfortunately for ADC, a reluctant Judge Robert S. Gawthrop III, concluded that he was forced by *Feist's* holding to rule in favor of Franklin, despite overwhelming evidence that Franklin copied portions of ADC's maps.

For example, ADC used approximately 200 so-called "copyright traps" in its maps -- fictitious names, streets, dead-ends and the like -- commonly used by cartographers to detect copying of the maps by competitors. Yet even though 81 of these traps were found in Franklin's maps, Gawthrop was unable to find copyright infringement.

Previously, the originality in the way the facts underlying the map were presented was far less important than the compilation of facts, due to the sweat-of-the-brow doctrine. With this doctrine's demise, however, the court's analysis had to turn to the originality present in the map.

The court examined three types of information in ADC's maps that were copied by Franklin -- copyright traps, positions of symbols and street alignments -- but was unable to find very much originality in any of these features. Copyright traps are "false facts."

However, the court, adopting the logic of a 1992 Eastern District of New York case, reasoned that if these "false" facts were interspersed among actual facts, and treated as fiction that could not be copied, this would mean that no one could ever copy actual facts without the risk of reproducing a false fact and thereby violating a copyright.

Therefore, just as facts themselves are non-copyrightable, copyright traps are non-copyrightable.

The placement of symbols fared about as well under Gawthrop's feisty scrutiny. The judge held that the positioning of symbols on a map is more of a factual determination than an expressive one, and so the placement of symbols is also not protectable by copyright.

Street alignment and subdivision alignment, too, Gawthrop found, are fundamentally factual as well, and any creativity introduced in tilting and adjusting to make it all fit is inadvertent.

Similarly, Gawthrop held that the alignment of subdivisions to adjacent geographical features lacked originality. The only copied feature that the court found to be original was a single list of street names; the court held that this copying was not sufficiently substantial to constitute infringement.

In the end, Franklin won the case, but one wonders whether its victory is a Pyrrhic one; for Franklin, too, will find it difficult to prevent others from copying its own maps.

## REPORTED OPINIONS

West Publishing can probably sympathize with ADC. West has previously been involved in litigation over whether West's internal pagination is copyrightable. *See West Publishing Co. v. Mead Data Central, Inc.* 799 F.2d 1219 (8th Cir. 1986), cert. denied, 479 U.S. 1070, 107 S.Ct. 962

128 F.2d 1217 (5th Cir. 1938), cert. denied, 477 U.S. 1070, 107 S.Ct. 502 (1987); *Oasis Publishing Company, Inc. v. West Publishing Co.* 924 F.Supp. 918 (D.Minn. 1996); see also *United States of America v. Thomson Corp.* 1997 U.S. Dist. LEXIS 2790 (D. D.C., March 7, 1997).

In West's latest court battle, *Matthew Bender & Company, Inc. v. West Publishing Co.* Judge John S. Martin decided that West cannot prevent others from copying and republishing opinions published by West.

In this case the plaintiff Hyperlaw, a publisher of CD-ROM products, admitted to scanning in the title and texts of cases directly from West's published case reports. Hyperlaw does not, however, scan in West's headnotes or the key numbers West inserts in the opinions.

Applying the *Feist* rules on originality, the court found that the changes West makes to an opinion that it publishes do not render the reported decision copyrightable, since the changes introduced by West are too trivial to have the requisite originality.

For example, the court held that changes to the case title, such as capitalizing certain names and abbreviating others, do not involve creative activity, but are "simply a mechanical application of pre-existing rules of citation." The case name is a fact, and West's modifications were not found to be significant or creative enough.

Other facts added by West, such as the docket number and date argued and decided, are also not protectable, even though West must make an effort to obtain this information. Since the demise of sweat-of-the-brow, West's effort is irrelevant. It is only rewarded for creativity, not hard work.

Other information gathered and added by West, such as the names of attorneys involved, subsequent case history (such as "rehearing denied"), and parallel citations, are similarly unprotectable, according to Martin.

As for corrections, additions and other editing of the text, Martin seemed to reluctantly rule that, "While West clearly expends considerable time and money on this effort and performs a valuable service to the bench and the bar, there is no element of creativity or originality involved in these corrections."

## CONCLUSION

Both the *ADC* and *West Publishing* cases have been appealed, and it is possible that the Courts of Appeals will conclude that material the district courts deemed too trivial to warrant protection actually contains the low level of originality required by *Feist*.

However, barring such a result and any legislation reinstating the sweat-of-the-brow doctrine and overturning *Feist*, it appears that "uncreative" but hard-working fact-compilers will find it difficult to have their sweat remunerated.

As Gawthrop recognized in *ADC*, "in according maps but a thin layers of protection, there is a potential disincentive for publishers to undertake the expensive process of compiling the facts, and making these very useful mans available to the public. But under *Feist* and its progeny, that appears

maps available to the public. But under *Feist* and its progeny, that appears today to be the law."

In the short term, publishers may seek to protect compilations by entering into contracts with purchasers. For example, maps may appear with shrink-wrap licenses similar to those provided with computer software, or, more to the point, telephone directories on CD-ROM.

As for possible remedial legislation, the Clinton administration proposed in its first term legislation to create a new type of intellectual property protection for electronic databases. There may be new proposals to expand such legislation to cover compilations distributed in printed form.

Until then, publishers may need more than a modicum of creativity to protect compilations and other fact-intensive works.

*Robert E. Rosenthal, a partner in the [Philadelphia](#) office, practices in the areas of domestic and international trademarks, patents and trade secrets and related transactional issues.*

*This article originally appeared in [The Legal Intelligencer](#) and is republished here with permission from [law.com](#).*