IN THE UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF NEW YORK

MATTHEW BENDER & CO., INC., Plaintiff, v. WEST PUBLISHING COMPANY, Defendant.	94 Civ. 0589 (JSM)

MEMORANDUM OF UNITED STATES OF AMERICA AS AMICUS CURIAE IN SUPPORT OF THE PROPOSITION THAT BENDER'S STAR PAGINATION TO WEST'S NATIONAL REPORTER SYSTEM DOES NOT INFRINGE ANY COPYRIGHT INTEREST WEST MAY HAVE IN THE ARRANGEMENT OF THE NATIONAL REPORTER SYSTEM VOLUMES

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The United States submits this Memorandum to express its view that Bender's star pagination to West's National Reporter System does not infringe any copyright interest West may have in the arrangement of the National Reporter System volumes. We believe that the Court will be able to reach this conclusion without deciding disputed issues of fact and that the conclusion will permit the Court to rule for Bender on the critical issue in the parties' motions for summary judgment. This Memorandum, however, was prepared before the parties served their motions and without access to those portions of the summary judgment record under protective order.

INTEREST OF THE UNITED STATES

The United States has a substantial interest in the resolution of the issue discussed in this Memorandum. It has numerous responsibilities related to the proper administration of the intellectual property laws and to advancement of the public interest. The standards for copyright protection embody a balance struck between protecting private ownership of

expression as an incentive for creativity and enabling the free use of basic building blocks for future creativity. See Twentieth Century Music Corp. v. Aiken, 422 U.S. 151, 156 (1975). The United States therefore has an interest in properly maintaining the "delicate equilibrium," Computer Associates International v. Altai, Inc., 982 F.2d 693, 696 (2d Cir. 1992), Congress established through the copyright law.

The interest of the United States in ensuring the proper preservation of that balance also reflects the fact that it has primary responsibility for enforcing the antitrust laws, which establish a national policy favoring economic competition as a means to advance the public interest. Moreover, the United States is a substantial purchaser of legal research materials of the kind at issue in this case.

Finally, the United States has recently taken actions relating to the issue discussed. On June 19, 1996, the United States, together with seven states, filed an antitrust suit challenging the acquisition of West Publishing Co. by The Thomson Corp., together with a proposed settlement of that suit. Part of that settlement requires Thomson to license to other law publishers the right to star paginate to West's National Reporter System. United States v. The Thomson Corp., No. 96-1415 (D.D.C. filed June 19, 1996), Proposed Final Judgment, 61 Fed. Reg. 35250, 35254 (July 5, 1996). In announcing the settlement, the U.S. Department of Justice stated:

> Today's settlement, with its open licensing requirement does not suggest . . . that the Department believes a license is required for use of such pagination. The Department expressly reserves the right to assert its views concerning the extent, validity, or significance of any intellectual property right claimed by the companies [West and Thomson]. The Department also said that the parties agree that the settlement shall have no impact whatsoever on any adjudication concerning such matters.

U.S. Dept. of Justice, Press Release No. 96-287, at 3-4, 1996 WL 337211 (DOJ) *2 (June 19, 1996). This Memorandum asserts those views.

STATEMENT

1. West Publishing Company ("West") publishes the well-known National Reporter System, which includes case reports of federal and state courts in the United States. In particular, it is "the only entity to publish decisions of the United States Courts of Appeals and United States District Courts in comprehensive book form," Matthew Bender & Company v. West Publishing Co., 1995 WL 702389 at *1 (S.D.N.Y.) ("Bender I"), in the familiar Federal Reporter and Federal Supplement series and other series. It also "publishes the opinions of New York state courts," id., in several series of volumes. West claims copyright in these volumes.

Matthew Bender & Company ("Bender"), another publisher of various legal materials, has prepared for publication in Compact Disk-Read Only Memory (CD-ROM) format a work (the "New York product") which includes, among other things, the text of opinions of the United States Court of Appeals for the Second Circuit, four United States district courts, and various New York state courts, all for a number of recent years.[1] Bender has inserted into the text of some of the opinions appearing in its New York product -- those also published in West's volumes -- information about the places in West's volumes where the text may also be found. Bender provides the West volume and page number where the beginning of each such case may be found; it also marks with West page numbers the places in its text where page breaks occur in West's publication of these opinions. In other words, Bender has star-paginated to West's volumes. Bender II at *3 & n.2.

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

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[1]Although West contends that a different Bender product, the "Texas product," contains "textual additions" copied from West's volumes, Matthew Bender & Company v. West Publishing Co., 1996 WL 223917 at *7 (S.D.N.Y.) ("Bender II"), it makes no such claims regarding the New York product.

reporters," and that "Bender does not and will not infringe any copyright of West's by its current and intended copying of the pagination from West's federal reporters and West's New York reporters." Second Supplemental Complaint 9. West moved to dismiss for lack of an actual controversy between the parties, and this Court denied that motion on May 2, 1996. The parties agreed to serve each other with motions for summary judgment on August 5, 1996.

West has contended that the pagination of its volumes reflects the arrangement of cases in those volumes, that the arrangement is protected by West's copyright, and that therefore star pagination to West's volumes infringes West's copyrights. See, e.g., Oasis Publishing Co. v. West Publishing Co., 924 F. Supp. 918, 922 (D. Minn. 1996) , appeal docketed, No. 96-2887 (8th Cir. July 19, 1996). These contentions lie at the core of this case.

ARGUMENT

Bender's star pagination does not infringe West's copyright interest in the arrangement of cases within the National Reporter System volumes. To reach that conclusion, this Court need not determine whether that arrangement rises to the level of originality necessary for copyright protection. Even supposing the necessary level of originality in West's arrangement, Bender does not infringe unless it copies that which is protected. And only a discredited reading of copyright law suggests that Bender copied West's arrangement of cases.

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

The Supreme Court has made clear that copyright protection for compilations like West's is thin, far thinner than some courts had previously assumed. Even if the arrangement of

West's volumes is protected by copyright, that protection extends no further than West's original contributions.

In Feist Publications, Inc. v. Rural Telephone Service Co., 499 U.S. 340 (1990), which concerned copying from a telephone directory, the Court addressed two fundamental tensions in copyright law. One is between the principle that facts are not protected by copyright and the principle that compilations of facts[2] generally are protected. Id. at 344-45.[3] The other is between the means of "assur[ing] authors the right to their original expression" and the end of "encourag[ing] others to build freely upon the ideas and information conveyed by a work." Id. at 349-50. The Court resolved those two tensions by emphasizing that "the copyright in a factual compilation is thin." The facts themselves are not protected because they are not the product of an act of authorship. Id. at 349.

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

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

[3]The Copyright Act provides that "[t]he copyright in a compilation . . . extends only to the material contributed by the author of such work, as distinguished from the preexisting material employed in the work, and does not imply any exclusive right in the preexisting material. The copyright in such work is independent of, and does not affect or enlarge the scope, duration, ownership, or subsistence of, any copyright protection in the preexisting material." 17 U.S.C. 103(b).

infringement "so long as the competing work does not feature the same selection and arrangement." Ibid.

This holding has economic bite. The value of a factual compilation may lie less in the compiler's selection and arrangement of the facts than in the industriousness required to compile them, and the thinness of the copyright may permit others to appropriate that value. As the Court observed, while, at first blush, it "may seem unfair," ibid., to permit that appropriation, "[t]his result is neither unfair nor unfortunate. It is the means by which copyright advances the progress of science and art." Id. at 350.[4]

Feist repudiated a body of case law that had used the so-called "sweat-of-the-brow" theory to provide broad copyright protection for factual compilations, thus protecting the fruits of mere industrious collection. The Court specifically rejected Leon v. Pacific Telephone & Telegraph Co., 91 F.2d 484 (9th Cir. 1937), and Jeweler's Circular Publishing Co. v. Keystone Publishing Co., 281 F. 83 (2d Cir.), cert. denied, 259 U.S. 581 (1922), precisely because these cases "extended copyright protection in a compilation beyond

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[4]Copyright is not the only conceivable legal regime for protecting the fruits of industrious collection. The Delegation of the United States of America recently proposed to the World Intellectual Property Organization an international treaty that would provide to the "maker" of certain databases the exclusive right to extract all or a substantial part of the contents, without regard to copyrightability. World Intellectual Property Organization, Preparatory Committee of the Proposed Diplomatic Conference (December 1966) on Certain Copyright and Neighboring Rights Questions, Proposal of the United States of America on Sui Generis Protection of Databases, CRNR/PM/7 (May 20, 1996). Legislation providing such protection has been introduced in Congress. See H.R. 3531, 104th Cong., 2d Sess. (1996). The Supreme Court long ago held that the common law of unfair competition or misappropriation protected uncopyrighted news reports. International News Service v. Associated Press, 248 U.S. 215, 239-40 (1918), although the preemption provision of the Copyright Act, 17 U.S.C. 301, may limit such protection to the case of systematic appropriation of "hot" news, Financial Information, Inc. v. Moody's Investors Service, Inc., 808 F.2d 204, 208-09 (2d Cir. 1986), cert. denied, 484 U.S. 820 (1987). Trade secret law may also provide some protection in appropriate circumstances. See Kewanee Oil Co. v. Bicron Corp., 416 U.S. 470 (1974).

selection and arrangement -- the compiler's original contributions -- to the facts themselves." 499 U.S. at 352-53.[5]

Feist also addressed whether the alphabetical arrangement of a telephone book involved the "quantum of creativity" necessary for copyright protection. 499 U.S. at 363-64. It therefore speaks to whether West's arrangement of cases exhibits the necessary quantum of creativity to permit copyright protection. But it is not necessary to resolve that question to decide this case. It is enough that Feist makes clear that even if West's arrangement is protected by copyright, the protection resulting from that creativity does not extend beyond arrangement to protect other components of a work.

II. The Arrangement of Bender's Compilation of Cases Is Not A Copy Of The Arrangement Of West's Compilation Of Cases

No one seriously contends that Bender's CD-ROMs actually "feature the same . . . arrangement," Feist, 499 U.S. at 349, of cases as West's National Reporter System, even in the limited sense of putting one case before the other in a pattern identical, or even notably similar, to the pattern found in West's volumes, let alone in a sense encompassing the arrangement of text on pages within each case.[6] This is true whether "arrangement" refers to

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[5]Although the Court specifically rejected a 1922 opinion of the Second Circuit, it also noted that the Second Circuit had since "fully repudiated the reasoning of that decision." 499 U.S. at 360, citing Financial Information, Inc. v. Moody's Investors Service, Inc., 808 F.2d 204, 207 (2d Cir. 1986), cert. denied, 484 U.S. 820 (1987); Financial Information, Inc. v. Moody's Investors Service, Inc., 751 F.2d 501, 510 (2d Cir. 1984) (Newman, J., concurring); and Hoehling v. Universal City Studios, Inc., 618 F.2d 972, 979 (2d Cir.), cert. denied, 449 U.S. 841 (1980).

[6]In that respect, this case is unlike Callahan v. Myers, 128 U.S. 617, 660-61 (1888), where the infringing volumes of case reports substantially duplicated the paging of the infringed volumes. Cf. Banks Law Publishing Co. v. Lawyer's Co-operative Publishing Co., 169 F. 386 (2d Cir. 1909) (implying same ordering of cases but different pagination; star pagination used in allegedly infringing work; held, no infringement), appeal dismissed, 223 U.S. 738 (1911). We note that the Callahan Court, following the lower court, did not treat duplication of the paging as an independent basis for finding infringement, apparently

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the physical ordering of electronic bits of information on Bender's CD-ROMs, to the order in which the Bender computer software presents cases to the user, or to any other concept of "arrangement." Indeed, it is hard to see how there could be any such contention.

Courts routinely analyze whether an arrangement protected by copyright has been impermissibly copied by looking at the two works and comparing the ordering of material in the accused work with the ordering of material in the allegedly infringed compilation. See, e.g., Lipton v. The Nature Co., 71 F.3d 464, 470, 472 (2d Cir. 1995) (plaintiff's arrangement of terms of venery protectible; defendant's arrangement of 72 of these terms is "so strikingly similar . . . as to preclude an inference of independent creation" when 24 of first 25 terms are listed in same order, and in four other places four or more terms appear in the same order); Schiller & Schmidt, Inc. v. Nordisco Corp., 969 F.2d 410, 414 (7th Cir. 1992) (office supply catalog not infringed as compilation when plaintiff did not contend that defendant copied "the order of products or other typical features of a compilation"); Key Publications, Inc. v. Chinatown Today Publishing Enterprises, Inc., 945 F.2d 509, 515 (2d Cir. 1991) (no infringement when arrangement of categories in business directory is protectible, but facial examination reveals great dissimilarity between arrangement in copyrighted directory and in allegedly infringing directory); Worth v. Selchow & Righter Co., 827 F.2d 569, 573 (9th Cir. 1987) (alphabetical arrangement of factual entries in trivia

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[6](...continued)
on the ground that arranging and paginating the cases involved inconsiderable labor and was not worthy of protection in and of itself. 128 U.S. at 662. The Eighth Circuit has read Banks as turning on the official status of the reporter whose works were copied. West Publishing Co. v. Mead Data Central, Inc., 799 F.2d 1219, 1225 (8th Cir. 1986) ("Mead"), cert. denied, 479 U.S. 1070 (1987). That reading has been strongly criticized, id. at 1245-47 (Oliver, J., concurring in part and dissenting in part); L. Ray Patterson & Craig Joyce, Monopolizing the Law: The Scope of Copyright Protection for Law Reports and Statutory Compilations, 36 UCLA L. Rev. 719, 740-49 (1989), and a post-Banks case in the Second Circuit casts doubt on the Eighth Circuit's reading, Eggers v. Sun Sales Corp., 263 F. 373, 375 (2d Cir. 1920) (copying from plaintiff's publication of uncopyrightable official report suggested by identity of pagination in defendant's publication, "but legally that is not of sufficient importance to constitute infringement of copyright," citing Banks), but our argument does not turn on the correct reading of Banks.

encyclopedia not copied when trivia game organizes factual entries by subject matter and by random arrangement on game card).

Infringement does not require exact identity of arrangement, but only substantial similarity between the protectible components of the copyrighted work and the corresponding components of the allegedly infringing work. Key Publications, 945 F.2d at 514. Nevertheless, a comparison may show some similarity of arrangement without suggesting copying. Some similarity of arrangement may result not from copying, but instead from common influences. Thus, for example, if Bender arranges cases in strict chronological order, while West's arrangement relies in part on chronology, there will be some similarity of arrangement. But that level of similarity does not "preclude an inference of independent creation," Lipton, 71 F.3d at 472, by Bender of its arrangement of cases, or even suggest that Bender has copied West's arrangement of cases, for it would suggest only the common influence of chronology.

A comparison of Bender's New York product and West's volumes in this case should be enough to decide the question of infringement of arrangement in Bender's favor. Our examination of Bender's product did not leave us confident that we understood the physical arrangement of the cases on the CD-ROM itself, unobservable by the naked eye. However, the computer program that allows the user to search for and read these cases did not present them to us in an order that closely matched the West ordering of cases. Thus, the Bender "table of contents" for the decisions of the United States Court of Appeals for the Second Circuit appeared to present all those decisions in strict chronological order (with the order of cases decided the same day following no principle we could discern). West can hardly tell the Court that it simply arranges cases chronologically. West has only recently explained to another federal district court its extensive departures from a chronological order, thus persuading that court that the arrangement is sufficiently creative to merit copyright

protection. See Oasis, 924 F. Supp. at 924.[7] Some cases also in West's volumes appeared in the Bender table of contents in the same order as they appear in West's volumes (although generally separated by other cases in the Bender table of contents), while others appeared in an order that differed from West's. The Bender and West arrangements are clearly different. Nothing suggests that Bender's arrangement is a copy of West's arrangement.

III. Bender's Star Pagination May Describe, But It Does Not Copy, West's Arrangement Of Cases

West relies on West Publishing Co. v. Mead Data Central, Inc., 799 F.2d 1219 (8th Cir. 1986) ("Mead"), cert. denied, 479 U.S. 1070 (1987), in order to argue that star pagination impermissibly copies West's arrangements despite clearly differing arrangement in the allegedly infringing work. In Mead, a divided panel of the Eighth Circuit, ruling before Feist, concluded that a product that star paginated to West's volumes impermissibly copied West's arrangement of cases. In effect, Mead holds that star pagination, without more, is sufficient copying of the arrangement to infringe.[8] West had alleged that "the LEXIS Star Pagination Feature is an appropriation of West's comprehensive arrangement of case reports in violation of the Copyright Act of 1976." 799 F.2d at 1222. The district court granted a preliminary injunction and the Eighth Circuit affirmed.

Mead rests on the discredited "sweat-of-the-brow" theory of compilation copyright and cannot be reconciled with Feist. As we show below, to follow the Mead analysis is to

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[7]As explained in Oasis, 924 F. Supp. at 924, West's arrangement of Florida cases in the Southern Reporter in general first separates cases by court level, then places the "fully headnoted opinions and jacketed memoranda" (arranged chronologically), before "sheet memoranda," which in turn precede "table dispositions" (arranged alphabetically); West also makes exceptions to these general principles. Purely chronological ordering for a single court level would not separate by type of disposition, would not arrange some dispositions alphabetically, and would not make exceptions.

[8]In the recent Oasis decision, the district court in Minnesota followed the court of appeals for its circuit. 924 F. Supp. at 925-26.

eviscerate Feist, with substantial, and undesirable, consequences for the progress of science and art in the modern technological era. This Circuit has not followed Mead, and this Court should not do so now.

The Mead district court recognized that the arrangement of cases in the Lexis database differed significantly from the West arrangement. Faced with the argument that the Lexis "star pagination will not infringe West's arrangement because its random generated arrangement is entirely different from West's arrangement . . .[and] star pagination will not bring the arrangements closer together," West Publishing Co. v. Mead Data Central, Inc., 616 F. Supp. 1571,1579-80 (D. Minn. 1985), aff'd, 799 F.2d 1219 (8th Cir. 1986), cert. denied, 479 U.S. 1070 (1987), the district court held that "for infringement purposes, [Mead] need not physically arrange it's [sic] opinions within its computer bank in order to reproduce West's protected arrangements." 616 F. Supp. at 1580. That is, it did not matter that Mead's work did not "feature the same . . . arrangement," Feist, 499 U.S. at 349, as West's. As support for this pre-Feist holding, the court relied (616 F. Supp. at 1580) on Rand McNally & Co. v. Fleet Management Systems, Inc., 600 F. Supp. 933, 941 (N.D. Ill. 1984): "'[D]atabases are simply automated compilations -- collections of information capable of being retrieved in various forms by an appropriate search program[.] . . . [I]t is often senseless to seek in them a specific fixed arrangement of data.'"[9]

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[9]Rand McNally quoted those words from Professor Denicola. Rand McNally also supported its denigration of arrangement as the basis of protection for factual compilation by citing National Business Lists v. Dun & Bradstreet, Inc., 552 F. Supp. 89 (N.D. Ill. 1982), which expresses the view that because computers store information "without arrangement . . .[,] an emphasis upon arrangement and form in compilation protection becomes even more meaningless than in the past." 552 F. Supp. at 97.

If it were true that data in an electronic database necessarily lacked arrangement, it would seem to follow that an electronic database simply could not infringe the copyright-protected interest in the arrangement of a compilation. Under Feist, the impossibility of copying the arrangement does not allow one to prove infringement without proof of copying. We doubt that it is true, however, since data lacking any arrangement at all would be difficult to use.

Rand McNally, however, rests entirely on the theory Feist rejected: "the basis for compilation protection is the protection of the compiler's efforts in collecting the data." 600 F. Supp. at 941. While the Feist Court thought selection and arrangement were the only protectible elements in the typical factual compilation, the Rand McNally court saw little significance to arrangement, relying on Professor Denicola: "'The creativity or effort that engages the machinery of copyright, the effort that elicits judicial concern with unjust enrichment and disincentive, lies not in the arranging, but in the compiling. . . . The arrangement formulation . . . is dangerously limited. At face value the rationale indicates that the entire substance of a compilation can be pirated as long as the arrangement of data is not substantially copied.'" 600 F. Supp. at 941 (emphasis added) (quoting Robert C. Denicola, Copyright in Collections of Facts: A Theory for the Protection of Nonfiction Literary Works, 81 Colum. L. Rev. 516, 528 (1981)). However limited, the "arrangement" formulation is the Supreme Court's. Specifically referring to the very same article by Professor Denicola, the Feist Court wrote, "[e]ven those scholars who believe that 'industrious collection' should be rewarded seem to recognize that this is beyond the scope of existing copyright law." 499 U.S. at 360.

Nevertheless recognizing that West's case rested on the copying of the arrangement of cases, the Mead district court found, without further explanation, "that [Mead] will reproduce West's copyrighted arrangement by systematically inserting the pagination of West's reporters into the LEXIS database. LEXIS users will have full computer access to West's copyrighted arrangement." 616 F. Supp. at 1580. One must look elsewhere for the reasons why the fact that Mead systematically inserted the pagination means that Mead reproduced West's arrangement.

On appeal, the Eighth Circuit, which never questioned the district court's recognition that the Lexis arrangement of cases different significantly from the West arrangement,

attempted to explain how Lexis could copy West's arrangement while not arranging its cases as West did. The court began by asserting that Mead's proposed star pagination would infringe West's copyright in the arrangement because, in combination with another feature of Lexis, it would permit Lexis users "to view the arrangement of cases in every volume of West's National Reporter System," 799 F.2d at 1227, even if users were not likely to do so.[10] But the court added that it would find infringement even absent this capability. It is enough, the Court explained, that star pagination communicates to users "the location in West's arrangement of specific portions of text," with the result that "consumers would no longer need to purchase West's reporters to get every aspect of West's arrangement. Since knowledge of the location of opinions and parts of opinions within West's arrangement is a large part of the reason one would purchase West's volumes, the LEXIS star pagination feature would adversely affect West's market position." Id. at 1228.

Missing in the court's analysis is any explanation of how communicating location -- that is, describing West's arrangement -- amounts to copying West's arrangement. The court leapt directly from the fact of the communication to the economic consequence of that communication. Thus the vice of unauthorized star pagination, in the Eighth Circuit's eyes, is made clear. The vice is not that original expression is copied; rather, it is that unauthorized star pagination permits unfair appropriation of the fruits of industrious collection.[11]

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[10]Under appropriate circumstances, users' actions might lead to vicarious liability for infringement. But vicarious liability must rest either on the alleged vicarious infringer's right to control the conduct of the individual who actually performs the infringement, Sony Corp. v. Universal City Studios, Inc., 464 U.S. 417, 437 (1984), or on an absence of substantial noninfringing uses, id. at 442. Neither requisite has been, or could be, established with respect to either Lexis or the Bender CD-ROMs.

[11]Mead's protection of industrious collection is underscored by the court's response to the argument that star pagination does not infringe because citations to West page numbers are merely statements of fact. In rejecting the argument, the Court said, "The names,

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Feist, however, makes clear that, as a matter of copyright law, this appropriation is not unfair, and that this test is not the proper test of infringement. See page 6 supra. Assuming the copying of protected arrangement, the resulting impact on West's market position would properly be considered in addressing a fair use defense to infringement. See 17 U.S.C. 107(4) (fair use analysis to consider "the effect of the use upon the potential market for or value of the copyrighted work"). But under Feist it plays no role in a determination of whether protected arrangement has been copied.[12]

There remains the fact that star pagination communicates to users "the location in West's arrangement of specific portions of text." 799 F.2d at 1228. A compilation copyright, however, protects original components of the compilation against copying; it does not protect even original components against description. Many ways of describing West's volumes and their content other than star pagination would also communicate such information. Essentially any index, any topical or other table of contents, any concordance, or any other finding aid would do so.[13] But surely that does not mean that all such finding aids would

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[11](...continued)
addresses, and phone numbers in a telephone directory are 'facts'; though isolated use of these facts is not copyright infringement, copying each and every listing is an infringement," 799 F.2d at 1228, citing Hutchinson Telephone Co. v. Fronteer Directory Co., 770 F.2d 128 (8th Cir. 1985). Hutchinson adopts precisely the view of copyright rejected in Feist; it even relies on Leon and Jeweler's Circular, 770 F.2d at 130-31, two cases specifically rejected in Feist. See page 6 supra.

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

[13]We realize, of course, that the economic significance of these finding aids differs substantially from the economic significance of star pagination of a collection of case reports. The pure finding aids no doubt do not reduce market demand for West's products. But as we have just observed, such marketplace factors go to fair use, not whether there is copying.

copy West's arrangement, even though they might be said to describe that arrangement. An index is only an index, not a copy of the book it indexes.[14]

Star pagination thus does not copy West's arrangement. To find infringement despite the absence of copying of original expression, and thus to protect its compilation from a competitor's description, West must rely on some other principle. The alternative principle on which West would rely, however, cannot be reconciled with Feist and if adopted would eviscerate Feist. Feist's thin copyright leaves facts unprotected while protecting only creative selection and arrangement. West's principle, in contrast, effectively protects facts. It has substantial implications for circumstances far beyond those of this case.

In essence, West's principle is this: Where the arrangement of a factual compilation is protected by copyright even though the facts are not, it is infringement for another to publish the facts if those facts include sufficient information to permit the protected arrangement to be recreated, even though the allegedly infringing publication does not itself recreate the protected arrangement. Indeed, if the ordering of the first compilation were based on the facts in that compilation, under West's principle it would seem to be infringement to obtain those facts from another source and publish them in an original order.[15] To escape a claim

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

[15]Some compilations are arranged in orders not based on the data found in the compilation. In Lipton, for example, the compilation was arranged according to the compiler's esthetic judgments. 71 F.3d at 470. The copyright on a volume of Shakespeare's

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that it copied the first compilation's arrangement, the second compilation would have to leave out facts found in the first compilation.[16]

A hypothetical example may clarify the implications of West's principle. Suppose a firm obtains from the 1990 Census of the United States data concerning every county in the United States and publishes a compilation of those data, listing the counties in descending order of one of the included data elements, the proportion of the population consisting of males of ages 18 through 40. Suppose further that this arrangement, which may meet the Feist test of originality and which may interest those marketing products to adult males, is protected by the firm's copyright on the compilation. Under Feist, another firm may copy all the data from the first firm's compilation, while arranging its compilation alphabetically by state and county. It may do so because even though the arrangement of the first compilation is protected by copyright, the data themselves are not, and the second compilation does not "feature the same . . . arrangement," Feist, 499 U.S. at 349, as the first. But the second compilation contains all the information a user needs to recreate the arrangement of the first, and so under West's principle, creation of the second compilation

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[15](...continued)
sonnets, all in the public domain, arranged in order of the editor's judgment of esthetic merit would, we assume, protect that original arrangement. Another editor could, without infringing the copyright, copy the sonnets from that volume and publish them in a different arrangement. But as we understand West's principle, it would be infringement were the editor of the second volume to include an appendix telling the reader the order in which the sonnets appear in the first volume.

[16]Even under Feist, there may be infringement if a creative selection of facts is copied. We do not understand the star pagination question here to raise an issue of protected selection, so we simplify the analysis by abstracting from issues of selection.

would infringe the copyright on the first.[17] West's principle therefore protects the facts themselves in many circumstances where Feist would leave them unprotected.

This case, like Mead before it, arose primarily because new technologies, new means of managing information, became available, a frequent event in the information age. We have seen, in on-line computer searchable databases and in CD-ROM products, new ways of working with the raw materials of legal research -- case reports, statutes, and other materials that once appeared only in print form. Neither we nor this Court can predict what new technological developments will next year or in the next decade further revolutionize the practice of law and make the substance of law more readily available to all. By making clear the limited scope of copyright protection for factual compilations, Feist cleared the way for these creative developments. It should be followed here.

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[17]To avoid infringing under West's principle, the publisher of the second compilation would have to omit the data concerning the proportion of the population consisting of males of ages 18 through 40, even though Feist would allow copying those data. And there would be no infringement even under West's principle if the first compilation arranged the counties in order of the first publisher's assessment of the moral worthiness of the county's population, and the second publisher listed the counties in a different order.

CONCLUSION

Star pagination to West's volumes does not in itself infringe any copyright interest West may have. The Court should therefore rule for Bender.

Respectfully submitted.

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