

## MATTHEW BENDER V. WEST PUBLISHING

By Peter Thottam

The parameters governing copyright privileges in legal publishing changed substantially with the 1997 case *Matthew Bender & Co. v. West Publishing Co.*<sup>1</sup> The *Bender* court determined the extent of West Publishing Company's (West) copyright monopoly on its case reporters. In doing so, the decision builds directly on recent Supreme Court jurisprudence<sup>2</sup> and scholarly commentary<sup>3</sup> regarding the Copyright Act. By rejecting West's derivative work<sup>4</sup> and compilation claims,<sup>5</sup> *Bender* departs from the reasoning of two comparable decisions in which West prevailed in the Eighth Circuit.<sup>6</sup> *Bender* potentially heralds an end to legal publishers' abilities to assert copyright protection for trivial editorial changes.<sup>7</sup> Perhaps the ruling will provide impetus to create new legal publishing paradigms, involving uniform citation standards and Internet compatibility that would greatly enhance public access to the law.

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1. 42 U.S.P.Q.2d 1930 (S.D.N.Y. 1997).

2. See *Feist Publications, Inc. v. Rural Tel. Serv. Co., Inc.*, 499 U.S. 340 (1991).

3. See, e.g., L. Ray Patterson & Craig Joyce, *Monopolizing the Law: The Scope of Copyright Protection for Law Reports and Statutory Compilations*, 36 UCLA L. REV. 719, 787-88; Jane C. Ginsburg, *No 'Sweat'? Copyright and Other Protection of Works of Information after Feist v. Rural Telephone*, 92 COLUM. L.REV. 338 (1992) (providing two overviews of the legal background to, and the copyright implications of, *Feist*).

4. Section 101 of the Copyright Act defines a derivative work as a "work consisting of editorial revisions, annotations, elaborations, or other modifications which, as a whole, represent an original work of authorship." 17 U.S.C. § 101 (1994).

5. Section 101 defines a "compilation" 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. The term "compilation" includes collective works. *Id.*

6. See *West Publishing Co. v. Mead Data Central, Inc.*, 799 F.2d 1219 (8th Cir. 1986), *cert. denied*, 479 U.S. 1070 (1987); *Oasis Publishing Co. Inc. v. West Publishing Co.*, 924 F. Supp. 918 (D. Minn. 1996).

7. One example of such arguably trivial editorial changes is West's star-pagination system. See generally *Matthew Bender & Co., Inc. v. West Publishing Co.*, 24 Media L. Rep. 2432 (S.D.N.Y. 1996).

## I. CASE SUMMARY

### A. Factual Background

West Publishing has long had a de facto monopoly on print, CD-ROM, and on-line databases for court opinions.<sup>8</sup> As a result, it has been able to set monopoly prices for access to the content of these databases.<sup>9</sup> By creating uniform page citation references, West's publications have been especially useful to lawyers and judges. West's "Star-Pagination" system keys text, regardless of the format, to the page on which it would appear in the printed volume. West argues that there is a level of skill and labor involved that justifies copyright.<sup>10</sup> In the face of opposition from other legal publishers who contend West's edits and page breaks add no copyrightable expression, West continues to claim a copyright on the selection, coordination, and arrangement of its reporters, in addition to the editorial enhancements it provides.<sup>11</sup>

Matthew Bender & Company (Matthew Bender) is a rival publisher of legal materials. In recent years, Matthew Bender prepared for publication in CD-ROM format<sup>12</sup> 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.<sup>13</sup> In these recent publications, Matthew Bender inserted information about parallel pages in West's volumes where the text may also be found.<sup>14</sup> More specifically, Matthew Bender pro-

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8. See generally Patterson & Joyce, *supra* note 3.

9. See *id.*

10. See generally *Alfred Bell & Co. v. Catalda Fine Arts, Inc.*, 191 F.2d 99 (2d Cir. 1951) (holding that transfer from one medium to another can support a copyright claim when the transfer involves a high level of artistic skill and effort). However, to the extent that cases like *Bell* base their findings of copyrightability on the amount of skill or labor invested by the artist, these decisions are clearly qualified, if not overruled, by the Supreme Court's recent decision in *Feist* which held that labor could not substitute for originality. See *Feist Publications, Inc. v. Rural Tel. Serv. Co., Inc.*, 499 U.S. 340, 353-56 (1991); see also *L. Batlin & Son, Inc. v. Snyder*, 536 F.2d 486, 510 (2d Cir.), *cert. denied*, 429 U.S. 857 (1976).

11. Such editorial enhancements include West's synopses, headnotes, and key numbers.

12. See Matthew Bender, Inc., *Bookstore* (visited Dec. 2, 1997) <[http://www.bender.com/bender/open/Webdriver?Mival=index\\_bookstore](http://www.bender.com/bender/open/Webdriver?Mival=index_bookstore)>.

13. See Matthew Bender, Inc., *About Us* (visited Dec. 2, 1997) <<http://www.bender.com/bender/open/Webdriver?Mival=abtframe>>.

14. For more information, see HyperLaw, Inc., *Transcript Granting Summary Judgment* (visited Feb. 2, 1998) <<http://www.hyperlaw.com/benchtr2.htm>> (transcript of Judge Martin's granting summary judgment on Nov. 22, 1996 to competing publisher Matthew Bender & Co. and partial summary judgment to HyperLaw, Inc. with respect to

vided the West volume and page number for the first page of each case. Bender also included the West page numbers in the same position where page breaks would occur in West's publications.<sup>15</sup> In essence, Matthew Bender provided West's star-pagination to its own volumes, claiming that West was not entitled to copyright protection on its pagination references. Bender sued for a declaratory judgment on the issue of West's copyright interest in its pagination.<sup>16</sup> While other issues were presented in the collateral actions of *Bender*, they were distinct from the pagination issue and Bender's defense against allegations of copyright infringement.

In *Bender*, HyperLaw, Inc. (HyperLaw)<sup>17</sup> joined, as an intervenor-plaintiff, Matthew Bender's original action against West and sought an injunction against West in order to obtain access to West's court privileges.<sup>18</sup> In particular, HyperLaw sought access to federal judiciary corrections and modifications made available to West.<sup>19</sup> HyperLaw, Matthew Bender, and other vendors could not avail themselves of these corrections. HyperLaw argued that this created a huge competitive disadvantage.<sup>20</sup> In its complaint, HyperLaw sought permission to copy the information it argued was not subject to West's copyright: any corrections, amendments, attorney names, parallel citations, West citation formats, opinion text not provided to HyperLaw by the courts, and the interior pagination from volumes of West's *Supreme Court Reporter* and the *Federal Reporter*.<sup>21</sup> In

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both companies' desire to cross-reference West's page numbers in their CD-ROM case law collections).

15. *See id.*

16. *See* June M. Besek, RECENT DEVELOPMENTS IN COPYRIGHT LAW, 521-22 (1997).

17. HyperLaw was incorporated in 1991 as an electronic publisher of substantive information for the legal profession. The company's primary publication medium is CD-ROM which uses full-text retrieval, hypertext, and image retrieval technologies. HyperLaw has explicitly stated that it intends eventually to offer West type data on the Internet. *See* HyperLaw, Inc., *HyperLaw, Inc.* (visited Dec. 2, 1997) <<http://www.hyperlaw.com/index.htm#about>>. It publicly stated that it might ultimately scan up to 75% (not including headnotes) of West cases into its system. *See* Matthew Bender & Co., Inc. v. West Publishing Co., 42 U.S.P.Q.2d 1930, 1931 (S.D.N.Y. 1997). In February 1992, HyperLaw broke new ground in the legal publishing industry by issuing a CD-ROM of United States Supreme Court Opinions, *Supreme Court on Disc*<sup>TM</sup>. In July 1993, HyperLaw released the first CD-ROM of United States Court of Appeals opinions, *Federal Appeals on Disc*<sup>TM</sup>. In so doing, HyperLaw hoped to join the ranks of companies like Lexis-Nexis in eroding the monopoly that West holds over much of the legal publishing industry.

18. *See Bender*, 42 U.S.P.Q.2d at 1931.

19. *Id.*

20. *Id.*

21. *Id.*

response to HyperLaw's complaint, West brought counterclaims of copyright infringement and alleged its copyrights as affirmative defenses.<sup>22</sup>

## B. The Case

On May 22, 1997, a New York federal district court considered HyperLaw's contention as to whether the changes West makes to an opinion, either singly or in combination, represent a sufficient creative effort to warrant copyright protection.<sup>23</sup> The court said no, holding that competing legal publishers could digitally scan cases found in West legal publications and subsequently issue those cases in their own publications.<sup>24</sup> The holding implies West's copyright protection for case editorial changes is in fact limited to headnotes, key numbers, and a limited amount of other added material.

The decision—though momentous in its import for copyright privileges for legal publishers—was not unexpected. Earlier, in response to the original action that Matthew Bender brought, Judge Martin had granted a summary judgment motion denying copyright protection for West's star-pagination system.<sup>25</sup> In his more recent opinion, Judge Martin developed the logic of the November opinion which had focused on Matthew Bender's star pagination concerns. Judge Martin affirmed HyperLaw's declaratory request thereby allowing it to copy case reports from West's volumes in the *Supreme Court Reporter* and *Federal Reporter Series*.<sup>26</sup> West has appealed both of Judge Martin's decisions.<sup>27</sup> In the interim, however, the exclusion from copyright of the numbering system known as "star pagination" puts West's system of book and page number tracking into the public domain. In conjunction with Judge Martin's more recent ruling in *Bender*, this is arguably the correct result under existing copyright law and under the logic of important public policy goals. These goals include public access to the law and the creation of greater competition in legal publishing.

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22. See HyperLaw, Inc., *HyperLaw v. West Publishing Company* (visited Dec. 2, 1997) <<http://www.hyperlaw.com/hlvwest.htm>>.

23. See *id.*

24. See *id.*

25. See HyperLaw, Inc., *Transcript Granting Summary Judgment*, *supra* note 14.

26. *Bender*, 42 U.S.P.Q.2d at 1933-34.

27. Brief for U.S. Court of Appeals for the Second Circuit at 7910, n.2, *Matthew Bender & Co. v. West Publishing Co.* (S.D.N.Y. 1997) (No. 97-7910). West notes that it has "never objected to the copying, even by competitors of individual case reports, notwithstanding their copyright protection. It is only the threat of wholesale report copying by 'free-riding' competitors that compels West to assert and defend its entitlement under the Copyright Act." *Id.*

*Bender* specifically held that the changes West makes to an opinion that it publishes do not, by themselves, make the reported decision “independently copyrightable.”<sup>28</sup> Citing section 102(a) of the Copyright Act and *Feist Publications, Inc. v. Rural Telephone Service Co., Inc.*, the court emphasized that minor changes to the caption, the identification of judges, and information as to the attorneys, together with the insertion of subsequent history, were not sufficient to qualify West’s reprints as “original works of authorship.”<sup>29</sup>

West argued that the court should consider its copyright in the compilation of opinions as a whole. However, the court noted “[w]hat HyperLaw is copying is the individual reported decision and the fact that it copies one, two, or a thousand decisions does not change the fact that it is the decisions and not West’s compilation of those decisions that HyperLaw is copying.”<sup>30</sup> Because HyperLaw was not copying the order of cases used by West, the court instead judged each individual opinion as a derivative work. The court cited a number of cases holding that in order for a work to qualify as a derivative work it must be independently copyrightable with some measure of originality of authorship.<sup>31</sup>

In *Bender*, the court ruled that HyperLaw’s copying for its CD-ROM product would be non-infringing.<sup>32</sup> It held that anything HyperLaw might take from West would be devoid of *Feist*’s originality requirement. West therefore was arguably not adding much that was truly original. *Bender* effectively asserted that what West was adding to judicial opinions—opinions which were indisputably in the public domain<sup>33</sup>—were in fact trivial and mechanical changes. The court observed that West’s changes, taken separately or collectively, did not result in “a distinguishable variation” of the court opinions.<sup>34</sup> It noted that minor changes to the caption, the identification of judges, and information as to the attorneys, together with the insertion of subsequent history, are not sufficient to

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28. *Bender*, 42 U.S.P.Q.2d at 1932.

29. *Id.*

30. *Id.*

31. *Id.* at 1933 (citing *Woods v. Bourne Co.*, 60 F.3d 978, 990 (2d Cir. 1995)); see also *HyperLaw, Inc., Transcript Granting Summary Judgment*, *supra* note 14. For a definition of “derivative works,” see *supra* note 14.

32. *Bender*, 42 U.S.P.Q.2d at 1933.

33. For a discussion of Copyright Act analysis on government opinions, see *infra* notes 94 & 95.

34. See *Bender*, 42 U.S.P.Q.2d at 1934 (discussing the triviality of West’s changes and citing the holding of *Waldman Publishing Corp. v. Landoll, Inc.*, 43 F.3d 775, 782 (1994)).

insertion of subsequent history, are not sufficient to qualify West's reprints as "original works of authorship."<sup>35</sup>

Furthermore, the district court also emphasized that the *Feist* case emphatically rejected the "sweat of the brow" doctrine that some lower courts had previously adopted.<sup>36</sup> Past application of a doctrine might have enabled a court to justify copyright on the basis of labor expended by a publisher like West in collecting and cataloging its facts. *Feist* and *Bender* both acknowledge that such labor can be valuable to the public. Nonetheless, both cases stress that labor simply cannot be substituted for originality. Indeed, only factual compilations that are original—those that meet the minimal creativity standard—can be the subject of copyright.

On November 22, 1996, the same New York court took a step in the same direction by granting summary judgment as to the non-copyrightability of West's "star pagination" system.<sup>37</sup> District Court Judge Martin observed that the facts set forth in such a numeric compilation were not protected by copyright law and therefore were capable of being freely copied.<sup>38</sup> The judge emphasized copyright protection extends to compilation efforts which embody the original creation of the compiler. He stated that there would be no question that if Matthew Bender took a volume of West's *Federal Reporter*, ran it through its Xerox machine or its computer and printed it out and called it *Bender's Federal Third Reporter*, this would then violate West's copyright.<sup>39</sup> However, Judge Martin qualified this observation by emphasizing the importance of the proposition that the title and the citation to a West reported decision are

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35. 17 U.S.C. § 102(a) (1994).

36. *Bender*, 42 U.S.P.Q.2d at 1933-34; see, e.g., *Callaghan v. Myers*, 128 U.S. 617 (1888). For a discussion of *Callaghan* and other cases, see *Patterson & Joyce*, *supra* note 3, at 736-46.

37. See generally *Matthew Bender & Co., Inc. v. West Publishing Co.*, 24 Media L. Rep. 2432 (S.D.N.Y. 1996). Again, this comment defines star-pagination as the feature West offers which is used to indicate the precise word or letter in a given document with which the next page in the document's equivalent version in a separate publication begins. Its use occurs both in hard copy and on-line via WESTLAW.

38. See *id.* at 2440. Section 103(b) provides:

The copyright in a compilation or derivative work 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).

39. *Matthew Bender*, 24 Media L. Rep. at 2432.

facts.<sup>40</sup> He emphasized that these were facts that anyone was free to use. He further stressed that the West did not engage in any creative activity when deciding that the opinion of a particular judge is reported at some particular page of some particular volume of West.<sup>41</sup> He clarified the analysis by observing that West decided a group of cases should be compiled together in a certain order, and a consequence of that compilation was that the case with that title appeared at that page.<sup>42</sup> The resulting layout is a consequence of the way the compilation is put together, but that it is not any part of the aspect of the compilation that embody the original creation of the compiler.<sup>43</sup>

The insights in *Bender* regarding creative and original activity in contrast to “facts”<sup>44</sup> is particularly meaningful because legal publishing is rapidly shifting to digital forums such as CD-ROMs and the Internet—forums where fact manipulation and copying are much easier than with traditional media.

## II. DISCUSSION

### A. The Constitution and Prior Copyright Law

The primary issue before the district court in *Bender* was whether changes West made to judicial opinions, either singly or in combination, represented a sufficient creative effort to warrant copyright protection. As with any copyright case, the Copyright clause of the Constitution<sup>45</sup> and the Copyright Act<sup>46</sup> provide a starting point for analysis.<sup>47</sup> The Constitution

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40. *Id.*; see also HyperLaw, Inc., *Transcript Granting Summary Judgment*, *supra* note 14.

41. *Matthew Bender*, 24 Media L. Rep. at 2433.

42. *Id.*

43. *Id.*

44. Judge Martin also observed:

[T]he original creation of West is not in the number of lines in any case, it is not in the number of any pages of any case. The original creation may be in the way West selects cases for reporting, the cases that it puts, any headnotes that it adds to the report and similar additional material when put together with the official report that they obtain from the Court. However, where and on what particular pages the text of a court opinion appears does not embody any original creation of the compiler, and, therefore, in my view, is not entitled to protection.

HyperLaw, Inc., *Transcript Granting Summary Judgment*, *supra* note 14.

45. U.S. CONST. art. I, § 8, cl. 8. For a more complete exploration of relevant constitutional background, see Paul Heald, *The Vices of Originality*, 1991 SUP. CT. REV. 143, 168-177.

46. 17 U.S.C. §§ 101-810 (1994).

grants Congress the power to “[p]romote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writing and Discoveries.”<sup>48</sup> The Copyright Act enables this Constitutional grant of authority to Congress. A unifying goal of these subsections is to protect the original writings of authors.<sup>49</sup> This protection is meant to be exercised for the public benefit.<sup>50</sup>

For a work to be entitled to copyright protection it must be an “original work of authorship.”<sup>51</sup> Specifically, section 102(a) provides that copyright subsists “in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device.”<sup>52</sup> Sections 101<sup>53</sup> and 103<sup>54</sup> specifically pro-

47. See Robert C. Denicola, *Copyright in Collections of Facts: A Theory for the Protection of Nonfiction Literary Works*, 81 COLUM. L. REV. 516, 519 (1981). Denicola notes that because progress in science and the arts is often a process of creative accretion the Constitutional mandate embraces a tension between economic incentives to produce, which are provided through the recognition of exclusive rights, and unfettered access to creative works.

48. U.S. CONST. art. I, § 8, cl. 8.

49. Specifically, section 106 of the Copyright Act gives an owner an exclusive right to reproduce, distribute, perform, display, or license his work. *Id.* § 106. Section 201(d) further provides that an owner receives an exclusive right to produce or license the production of derivatives of his work. *Id.* § 201(d).

50. See generally *Twentieth Century Music Corp. v. Aiken*, 422 U.S. 151 (1975).

51. 17 U.S.C. § 102(a) (1994).

52. H.R. REP. NO. 94-1476, at 51 (1976) (providing that the criterion of originality does not require any “novelty”).

53. 17 U.S.C. § 101 (1994) (defining “Collective Work” and “Compilation”) provides:

Except as otherwise provided in this title, the following terms and their variant forms mean the following: ... A ‘collective work’ is a work, such as a periodical issue, anthology, or encyclopedia, in which a number of contributions, constituting separate and independent works in themselves, are assembled into a collective whole.

For a definition of “compilation” under section 101, see *supra* note 5.

54. 17 U.S.C. § 103 provides:

(a) The subject matter of copyright as specified by § 102 includes compilations and derivative works, but protection for a work employing preexisting material in which copyright subsists does not extend to any part of the work in which such material has been used unlawfully. (b) The copyright in a compilation or derivative work 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 the preexisting material.

vide that copyright protection will extend to original compilations and derivative works.

West pointed to both of these types of works to argue that it had created "original" works. First, West alleged that it should receive a copyright on all of its content because the case reports constituted derivative works.<sup>55</sup> With this right, West could prevent other parties from copying its reported cases wholesale. Second, West alleged that it should receive a copyright on its arrangement of cases as an original compilation.<sup>56</sup> West also argued that this compilation copyright should cover use of the star pagination references. The argument is that if others can tell where all the text appears in West volumes, a user can theoretically recreate an entire West Reporter without ever paying for or viewing the original.<sup>57</sup>

In *L. Batlin & Son v. Snyder*,<sup>58</sup> for instance, the court found that the changes in the product, an "Uncle Sam" piggy bank, were too minor and trivial to support a derivative work copyright.<sup>59</sup> The original bank consisted of Uncle Sam, dressed in characteristic attire. A coin could be placed in Uncle Sam's extended hand, and when a lever was pressed, his arm lowered, and the coin fell into his bag while Uncle Sam's whiskers moved up and down.<sup>60</sup> The plastic reproduction in *Batlin* reduced the height of the original from eleven to nine inches and made other minor changes, many of which were not perceptible to the casual observer.<sup>61</sup> The court reasoned that mere translation from one medium to another, in this case from a cast iron piggy bank to a plastic one, were trivial variations and therefore did not warrant protection.<sup>62</sup> Most courts have similarly held that in order to be copyrightable, a derivative work must contain "some substantial, not merely trivial, originality"—a substantial variation from the original work on which the derivative work is based.<sup>63</sup> Notwithstanding decisions such as *Batlin*, other courts developed a theory that the copyright laws would protect works when the creator had spent a significant effort compiling the facts in question. These courts essentially rea-

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55. For an overview of the contravening arguments against West's position, see HyperLaw, Inc., *Brief for Amicus Curiae American Association of Legal Publishers—Second Circuit Text Appeal*, Nov. 1997 (visited Feb. 16, 1998) <<http://www.hyperlaw.com/aalpbr.htm>>.

56. *Id.*

57. See HyperLaw, Inc., *Transcript Granting Summary Judgment*, *supra* note 14.

58. 536 F.2d 486 (2d Cir.), *cert. denied*, 429 U.S. 857 (1976).

59. *Id.* at 506-10.

60. *See id.*

61. *See id.* at 503.

62. *See id.* at 506-10.

63. *Id.* at 508-09.

soned that sheer effort would amount to non-trivial changes, and would thus satisfy the originality standard.<sup>64</sup>

The Supreme Court substantially clarified the appropriate reach of copyright law for data and "fact based" compilations with its 1991 decision in *Feist*.<sup>65</sup> The Court in *Feist* first addressed the nature of the copyright protection at issue.<sup>66</sup> The Court emphasized that even where there is a copyright for compilations of this sort, the copyright will be a "thin copyright claim," leaving the facts unprotected because they were not the product of an act of authorship.<sup>67</sup>

The Court summarily rejected the minority "sweat of the brow" theory.<sup>68</sup> Rather, it held that there is a Constitutional basis for copyright protection that depends on the degree of originality, plus some measure of creativity, in the copyrighted work.<sup>69</sup> The Court explained that the presentation of facts need not be innovative or surprising, but that the selection and arrangement must not be so mechanical or routine as to require no creativity whatsoever.<sup>70</sup> The Court concluded that the names and addresses found in a telephone book were uncopyrightable facts—not original creative efforts.<sup>71</sup> The Court held that Rural Telephone's selection of facts and its arrangement of phone numbers, names, and addresses, involved no creativity and was therefore not original.<sup>72</sup>

The first case to address the issue of West's potential copyright in its reporters, *West Publishing Co. v. Mead Data Central, Inc.*,<sup>73</sup> came down before the *Feist* decision. The district court held that West did have a copyright in the works.<sup>74</sup> The court found that West's selection, coordi-

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64. See sources cited *supra* note 36.

65. 499 U.S. 340 (1991); see generally Ginsburg, *supra* note 3.

66. *Feist*, 499 U.S. at 348-49.

67. See *id.* at 349.

68. See *id.* at 353-54.

69. See *id.* at 358.

70. See *id.*

71. See *id.* at 361.

72. The requirement of a de minimis amount of originality does not imply that aesthetic or artistic elements must be present. See *Bleistein v. Donaldson Lithographic Co.*, 188 U.S. 239 (1903). However, as Justice Holmes notes in *Bleistein* "[p]ersonality always contains something unique; and it is the 'personal reaction' of the author upon his or her subject, the 'singularity' of the result produced by that interaction, which renders the work original and thus copyrightable." *Id.* at 250.

73. 799 F.2d 1219 (8th Cir. 1986), *cert. denied*, 479 U.S. 1070 (1987).

74. *Id.* Note that the court's decision was strengthened by a line of copyright cases during the 1980s which interpreted the Copyright Act as prohibiting computer software copying. See, e.g., *Apple Computer, Inc. v. Franklin Computer Corp.*, 714 F.2d 1240, 1251 (3d Cir. 1983), *cert. dismissed*, 464 U.S. 1033 (1984); *Digidyne Corp. v. Data Gen-*

nation, and arrangement of case opinions in its case reporters constituted copyrightable expression.<sup>75</sup> In particular, the court found that Mead Data was infringing on the internal page number citations in West's case compilations.<sup>76</sup> The court ascribed a degree of creative intellectual effort to West's categorizing cases by subject matter, court, and circuit.<sup>77</sup> Immediately after losing the Eighth Circuit case, Mead Data proceeded to license pagination rights from West.<sup>78</sup>

It may appear that the Eighth Circuit's holding in *Mead Data* is questionable after the Supreme Court's *Feist* decision. Nonetheless, a district court within the Eighth Circuit recently cited the *Mead Data* decision with approval. In *Oasis Publishing Co. v. West Publishing Co.*,<sup>79</sup> the court granted West's motion for partial summary judgment in a decision addressing the copyrightability of the arrangement and pagination of cases in West reporters.<sup>80</sup> Judge Magnusson held that the creativity standard was minimal and that the internal pagination included in West's reporters was part of the overall arrangement of cases.<sup>81</sup> It was therefore protected by copyright. The court consequently found that the plaintiff's intended plan to incorporate cases and pagination from the West reporters into its CD-ROM legal reporters would violate West's copyright.<sup>82</sup>

## B. The Policy Conflict

At the heart of assessing West's copyright claims are two fundamental public policy questions: (1) should copyright law stretch far enough to protect a publisher who expends enormous effort creating a valuable database out of a set of facts that are already in the public domain?; and (2) should we seek to promote the dissemination of complete access to legal opinions—notwithstanding the adverse effect this has on the profits of publishers like West? This comment argues that the answer to the first question, rooted in the most recent body of legal jurisprudence on copy-

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eral Corp., 734 F.2d 1336 (9th Cir. 1984); *Autoskill, Inc. v. National Educational Support Systems Inc.*, 793 F. Supp. 1557 (9th Cir. 1992).

75. See *Mead Data*, 799 F.2d. at 1222.

76. See *id.*

77. See *id.*

78. See *Patterson & Joyce*, *supra* note 3, at 722.

79. 924 F. Supp. 918, 928-31 (8th Cir. 1996).

80. See *id.* at 931.

81. See *id.* at 921-25.

82. *Id.* at 926-27. The plaintiff, Oasis Publishing Co., Inc., a publisher of CD-ROM legal materials, intended to publish CD-ROM-based reports of Florida court decisions incorporating certain features of two West reporters: (1) the *Southern Reporter* and (2) the *Florida Cases*. West held a certificate of copyright registration for the *Southern Reporter*, but not for *Florida Cases*. *Id.*

right standards, is no. The second question, however, is a more nuanced issue. Further, the potential answers to the problem have grown exponentially with the advent of new technology such as the Internet.

In arguing that the copyright law question should be resolved in its favor, West contends that the *Bender* court was imposing a standard that demanded significantly more than *Feist*'s "modicum" of originality<sup>83</sup> and far more than the distinguishable "non-trivial" variation required by derivative-work copyright protection. West further attempts to distinguish its work from what was at issue in *Feist* by arguing that its compilation of legal opinions required it to make certain "judgments."<sup>84</sup> These judgments, according to West, consisted of genuinely creative assessments of readability, clarity, completeness, availability of sources, and other subjective considerations related to making the reports more useful.<sup>85</sup> West contends that its "original" contributions, wholly apart from syllabi, headnotes, and key numbers, which unquestionably receive a copyright, include: (1) substantial updating, revision, and expansion of the citations in opinions, and the additions of new citations, based on innumerable independent editorial judgments; (2) West's addition to opinions, on a selective basis, of new material, created and/or compiled by West employees, reflecting subsequent case developments; (3) the addition to opinions of West-compiled reports of selected attorney related data—much of which contains no information whatsoever concerning attorneys; and (4) revision editing and reorganization of the procedural data in opinions (captions,

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83. See *Feist Publications, Inc. v. Rural Tel. Serv. Co., Inc.*, 499 U.S. 340, 346 (1991).

84. [T]he *Feist* court found that the alphabetized list followed an "age-old practice," one "so commonplace" as to be "practically inevitable." Indeed, the copyright claimant in *Feist* had no real choice how to arrange a white page directory, particularly given that state law prescribed the selection of data, and, in any event, only a few basic decisions were involved. In this case, West makes dozens of multi-part, variable judgments, and there is no evidence that any of West's choices are commonplace, "practically inevitable," dictated by law, or that they follow any external guidelines. On the contrary, the evidence of other publishers' practices confirms the originality and independence of West's choices.

Brief for U.S. Court of Appeals for the Second Circuit at 4 n.35, *Matthew Bender & Co. v. West Publishing Co.* (S.D.N.Y. 1997) (No. 97-7910).

85. Of course, West advances this reasoning in part because *Feist* holds that editorial elements that are "devoid of even the slightest trace" of originality will fail to qualify as being copyrightable. *Feist*, 499 U.S. at 362.

court lines, date, disposition lines, etc.) to render them more readable and useful.<sup>86</sup>

The logic of West's response is somewhat specious. In its appellate brief, West's key rationale in support of its position is that the district court's analysis ignored "material dispositive evidence of West's originality—including case examples as well as hundreds of pages of memoranda reflecting West's ongoing, highly original editorial judgments in deciding how to revise and expand Opinions."<sup>87</sup> West's arguments do not meet the "originality" standard clearly laid out by Supreme Court jurisprudence and case law. Stretching the copyright laws far enough to cover West's editorial changes would be disingenuous. Under section 102, West's minor changes are probably insufficient to meet the originality requirement.<sup>88</sup>

Nonetheless, two other courts have upheld West's copyright claims to the editorial changes challenged in *Bender*.<sup>89</sup> Perhaps their decisions are rooted in part by an examination of the second policy objective identified above: that we should strive to maximize public access to the law and legal decisions. Arguably these courts may recognize that West has historically provided a tremendous service to the legal community by providing compilations that have made opinions accessible in a way they never would have been otherwise. West may not have been able to perform this service if it had not had a monopoly on its work. Thus the grant of copyright to West for editorial changes and compilation efforts may actually have increased access.

The questions of fundamental justice underlying these concerns cut both ways. On one hand, it would seem "fundamentally unfair to allow HyperLaw to take advantage of the substantial time and expense West has invested in its reporters by engaging in wide-ranging copying of the opinions published by West."<sup>90</sup> However, "on the other hand, the opinions published by West are written, not by West, but by federal judges and it seems unfair to say that West can preclude anyone from copying what is basically a government document."<sup>91</sup> One root problem is that of timing:

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86. Brief for U.S. Court of Appeals for the Second Circuit at 4, *Matthew Bender & Co. v. West Publishing Co.* (S.D.N.Y. 1997) (No. 97-7910).

87. *Id.*

88. For an overview of the originality deficiency in West's editorial changes, see *Matthew Bender & Co. v. West Publishing Co.*, 42 U.S.P.Q.2d 1930, 1932-35 (S.D.N.Y. 1997).

89. See *West Publishing Co. v. Mead Data Central, Inc.*, 799 F.2d 1219 (8th Cir. 1986), *cert. denied*, 479 U.S. 1070 (1987); *Oasis Publishing Co., Inc. v. West Publishing Co.*, 924 F. Supp. 918 (D. Minn. 1996).

90. *Bender*, 42 U.S.P.Q.2d at 1932-35.

91. *Id.*

for up to three years after the initial release of an opinion by the Supreme Court, there simply is no standardized judicial citation format acceptable for use in court documents and legal publications.<sup>92</sup> One or more private citation formats are generally required by federal courts. Further, the preferred citation is to West's *Supreme Court Reporter*.

The copyright laws arguably support the grant of monopolies in some cases with a long-term goal of increased access.<sup>93</sup> But in the case of government-produced works, the Copyright Act specifically reaffirms the importance of removing the government's monopoly on the information. In the 1976 Copyright Act, Congress codified its long-standing rule that government-issued law<sup>94</sup> is not copyrightable.<sup>95</sup> Matthew Bender and HyperLaw contend that publishers of statutes and judicial decisions do not create original "works of authorship." They maintain such publishers manufacture books. Accordingly, they argue a legal publisher could be a copyright owner only as an employer under the work for hire doctrine<sup>96</sup> or as an assignee of the author.<sup>97</sup> Under a works for hire logic, because state judges are employees of the United States rather than West, West cannot legally gain original copyright to their opinions. Furthermore, because judges are not authors for copyright purposes,<sup>98</sup> they have no copyright to assign to West.<sup>99</sup>

Finally Congress arguably included the notice provisions of sections 401-403<sup>100</sup> of the Copyright Act to ensure that section 105 of the Copy-

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92. This is true with the exceptions of private citations of the *Supreme Court Reporter*, *United States Reports*, *Lawyers Edition*, and *U.S. Law Week*.

93. See generally *Wheaton v. Peters*, 33 U.S. (8 Pet.) 591 (1834).

94. Section 101 defines a "work of the United States Government" as a "work prepared by an officer or employee of the United States Government as part of that person's official duties." 17 U.S.C. § 101 (1994).

95. Section 105 of the Copyright Act provides that copyright protection is not available "for any work of the United States Government, but the United States Government is not precluded from receiving and holding copyrights transferred to it by assignment, bequest, or otherwise." *Id.* This rule dates back to *Wheaton*, the Supreme Court's first copyright case, where the Court held that law—whatever form its publication takes—is not an original work of authorship.

96. *Id.* § 201(b).

97. *Id.* § 201(d).

98. See *Banks v. Manchester*, 128 U.S. 244, 253 (1888) ("Judges ... can themselves have no ... proprietorship, as against the public at large, in the fruits of their judicial labors ....").

99. For a comparative discussion of the *Wheaton* and *Banks* cases, see Patterson & Joyce, *supra* note 3, at 734.

100. For more information, see HyperLaw, Inc., *Intervenor-Plaintiff HyperLaw, Inc.'s Trial Brief Challenge to West Text Copyright Claims - March 4, 1997* (visited Dec.

right Act would have meaning when works of the federal government were re-published by private publishers.<sup>101</sup> HyperLaw contends that failure to meet this requirement is an omission of the notice statement called for in the provisions of section 403. There should be no great mystery regarding why section 403 was enacted—to prevent what West sought to preserve—that is, expropriating governmental works by vague and ill-defined variations.<sup>102</sup>

### III. TOWARD A UNIFORM CITATION STANDARD AND THE DIGITAL FUTURE OF CASE REPORTING

West Publishing and its Canadian parent, Thompson Corporation, have already filed a Brief on Appeal in the United States Court of Appeals for the Second Circuit.<sup>103</sup> However rapid technological change—especially as reflected in inexpensive and rapid distribution possibilities via the Internet's dynamic new “push” and “pull”<sup>104</sup> search capabilities in conjunction with its evolving hyperlink tools—may offer alternatives that could preempt the need for a Supreme Court adjudication of the current circuit split.

*Bender* provides a compelling illustration of the value of having a uniform citation standard for federal and state courts. Such a standard would

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5, 1997) <<http://www.hyperlaw.com/hltribr.htm>>. In its trial brief, HyperLaw argued that section 403 of the Copyright Act was a partial or total bar to West's claim of copyright in the text of judicial decisions. Section 403 provides:

Whenever a work is published in copies or phonorecords consisting preponderantly of one or more works of the United States Government, the notice of copyright provided by §§ 401 or 402 shall also include a statement identifying, either affirmatively or negatively, those portions of the copies or phonorecords embodying any work or works protected under this title.

17 U.S.C. § 403.

101. HyperLaw, in its motion for declaratory relief to confirm the illegitimacy of West's copyright claims for its citations, page numbering, corrections, parallel citations, names of counsel, and other factual and identifying materials, notes that West omitted from its copyright notices in its opinions any identification, either affirmatively or negatively, of those portions of its case reports embodying any work or works of the federal judiciary, or those parts of the text of judicial opinions in which West claims copyright. See HyperLaw, Inc., *Intervenor-Plaintiff HyperLaw, Inc.'s Trial Brief Challenge to West Text Copyright Claims - March 4, 1997* (visited Dec. 5, 1997) <<http://www.hyperlaw.com/hltribr.htm>>.

102. See generally Patterson & Joyce, *supra* note 3.

103. See HyperLaw, Inc., *HyperLaw, Inc.* (visited Nov. 4, 1997) <<http://www.hyperlaw.com/index.htm#abouthl>>.

104. A pure push technology puts data on one's screen or in one's computer without the individual's having to ask for it. This is contrast with the search retrieval or “pull” technology that most current search engines employ.

go a long way towards resolving the two root issues described above. First, the machinery of jurisprudence and legal writing would not rely on the continued dominance of one private provider. Furthermore, with the efficient and inexpensive presence of the Internet, the legal community will arguably no longer need to so completely rely on publishers like West. Publication of legal information in an accessible way in a medium such as the Internet will not entail the tremendous resources the process has required in the past. Consequently, that resource could ensure a large measure of public access without having to stretch copyright law beyond all reasonable bounds to achieve that end.

A number of congressional bills towards this end have already been introduced.<sup>105</sup> The attraction of these proposals, particularly given the unfolding shift in legal publishing to the Internet, is the use of standardized public domain citations. One interesting proposal was introduced by House Representative Barney Frank in 1992.<sup>106</sup> This bill advocated the denial of copyright protection to names and numbers used to identify judicial opinions and statutes.<sup>107</sup> Supporters of the bill stressed the desirability of inexpensive public access to legal materials. Opponents responded that, in the long run, passage of the resolution would likely diminish incentives for private publishers to produce compilations of legal materials, particularly materials with smaller markets. The bill never made it past the Judiciary Committee.

On August 6, 1996, the American Bar Association's House of Delegates passed a motion to recommend a universal citation system.<sup>108</sup> The Association urged courts to adopt a universal citation system using sequential decision numbers for each year and internal paragraph numbers within a court decision.<sup>109</sup> Courts would assign numbers in any given decision when slip opinions were made publicly available by the court, via print publications or digital mediums such as CD-ROMs or the Internet. The report also recommended maintaining parallel citations to commonly used print sources.

This type of advocacy of a federally mandated citation system echoes the root policy concerns underlying *Bender*. The system would be equally

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105. See HyperLaw, Inc., *Citation Reform* (visited Nov. 24, 1997) <<http://www.hyperlaw.com/hlreport.htm>>.

106. See Joel Silvermith, *Universal Citation* (visited Mar. 8, 1998) <<http://www.collegehill.com/ilp-news/silversmith.html>> (discussing H.R. 4426).

107. *Id.*

108. See American Bar Association, *Official Citation Resolutions* (visited Nov. 26, 1997) <<http://www.ABANET.ORG/citation>>.

109. *Id.*

adaptable to print and electronic case reports. Accordingly, it has the advantage of medium neutrality. This would set up a system in contrast to West's past luxury of exclusive rights vis-a-vis its monopoly clout as copyright holder. That clout was a significant barrier to entry for firms like Matthew Bender and HyperLaw. The law should not forestall such competitors from duplicating the efforts of compiling unoriginal data that is already in the public domain. Such efforts are intrinsic to the working and accessibility of our country's state<sup>110</sup> or federal legal systems in an economy increasingly characterized by digital commerce. These and the public policy concerns reflected in the Copyright Act's sections 103 and 105 further support the district court's opinion in *Bender*.

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110. See HyperLaw, Inc., *Brief For Amicus Curiae American Association Of Legal Publishers—Second Circuit Text Appeal*, Nov. 1997 (visited Feb. 17, 1998) <<http://www.hyperlaw.com/aalpbr.htm>>. Allowing legal publishers copyright privileges to state law creates other problems:

Although state judicial opinions are not the subject of this litigation, this Court may take judicial notice of West's claim for copyright of the opinions of state judges. ... A ruling for West in this case will serve as precedent for West's claim of copyright for state law. But in our federal system, states are sovereign entities ... [a]nd the sovereign that makes law has a duty to provide the public with access to that law. Thus, adopting West's argument, federal copyright for law that vests control of access to the law in a private publisher means two things: 1) The federal government has abdicated a sovereign duty and, in doing so, 2) the federal government has invaded the sovereignty of state governments. Section 105 prevents the first, section 103 prevents the second.

*Id.* (citations omitted).

