

97-7430

To be argued by:

PAUL J. RUSKIN

**United States Court of Appeals
FOR THE SECOND CIRCUIT**

MATTHEW BENDER & COMPANY, INC.,

Plaintiff-Appellee,

HYPERLAW, INC.

Intervenor-Plaintiff-Appellee,

- against -

WEST PUBLISHING CO.; WEST PUBLISHING CORPORATION,

Defendants-Appellants.

**ON APPEAL FROM THE UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF NEW YORK**

BRIEF FOR INTERVENOR-PLAINTIFF-APPELLEE

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CORPORATE DISCLOSURE STATEMENT

Pursuant to Federal Rules of Appellate Procedure 26.1, intervenor-plaintiff-appellee HyperLaw, Inc. states that it has no parent companies, subsidiaries, or affiliates.

TABLE OF CONTENTS

TABLE OF CASES v

TABLE OF STATUTES AND OTHER AUTHORITIES vii

ISSUES PRESENTED FOR REVIEW 1

STATEMENT OF THE CASE 1

FACTS 6

SUMMARY OF ARGUMENT 11

ARGUMENT 13

 I. THE DISTRICT COURT CORRECTLY DETERMINED THAT WEST'S
 PAGINATION IN ITS SUPREME COURT REPORTER AND
 FEDERAL REPORTER SERIES DOES NOT EMBODY ANY
 ORIGINAL CREATION OF WEST. 13

 A. Under Feist Only Original Elements of a
 Compilation Are Protectible by Copyright.
 13

 B. West's Pagination in its Supreme Court
 and Federal Reporter Series Are
 Uncopyrightable Facts.
 16

 II. EVEN IF THIS COURT DETERMINES THAT STAR PAGINATION
 IS AN EXPRESSION OF WEST'S SELECTION AND
 ARRANGEMENT, SUCH SELECTION AND ARRANGEMENT OF
 CASES IN ITS SUPREME COURT REPORTER AND FEDERAL
 REPORTER SERIES LACKS SUFFICIENT ORIGINALITY TO
 WARRANT COMPILATION COPYRIGHT PROTECTION. 21

 A. West's selection in its Supreme Court
 Reporter 21

 B. West's arrangement in its Supreme Court Reporter
 21

 C. West's selection in its Federal Reporter
 Series 25

 D. West's arrangement in its Federal
 Reporter Series 28

III.	EVEN IF THIS COURT DETERMINES THAT WEST'S SELECTION AND ARRANGEMENT OF CASES IN ITS SUPREME COURT REPORTER AND FEDERAL REPORTER SERIES HAVE SUFFICIENT ORIGINALITY TO WARRANT COMPILATION COPYRIGHT PROTECTION, HYPERLAW'S INTENDED USE OF FIRST PAGE CITATION AND STAR PAGINATION TO WEST'S REPORTERS DOES NOT CONSTITUTE COPYING OF WEST'S SELECTION AND ARRANGEMENT.	31
	A. Because a West Competitor May Use the First Page Citation, Internal Pagination Discloses No Further Information about the West Selection and Arrangement	31
	1. West Has Conceded That its First Page Citations are in the Public Domain	32
	2. First Page Citations Reflect All Selection and All Arrangement	35
	B. HyperLaw's Product Does Not Copy West's Selection or Arrangement	36
	C. HyperLaw's Product Does Not Display West's Selection or Arrangement	36
IV.	EVEN IF THIS COURT DETERMINES THAT HYPERLAW'S INTENDED CROSS REFERENCE TO THE FIRST PAGE CITATION AND STAR (INTERNAL) PAGINATION IN WEST'S REPORTERS CONSTITUTES COPYING OF WEST'S SELECTION AND ARRANGEMENT, AND THAT SUCH SELECTION AND ARRANGEMENT HAS SUFFICIENT ORIGINALITY TO WARRANT COMPILATION COPYRIGHT PROTECTION, HYPERLAW'S INTENDED USE OF FIRST PAGE CITATION AND STAR PAGINATION TO WEST'S REPORTERS IS A FAIR USE.	37
	A. Purpose And Character Of The Use	37
	B. Nature Of The Work	38
	C. Amount And Substantiality Of The Portion Used In Relation To The Copyrightable Work As A Whole	39
	D. Effect Of The Use On Potential Market For Copyrighted Work	39
	E. Section 403 of the Copyright Act as Expressing Congressional Intent	41
	F. Public Interest	45

G. Balancing The Factors Favors HyperLaw	48
CONCLUSION	49

TABLE OF CASES

American Dental Association v. Delta Dental Plans Association, 1996 U.S. Dist. LEXIS 5809 (N.D. Ill. 1996)	26, 27
American Geophysical Union v. Texaco Inc., 60 F.3d 913 (2d Cir. 1994), cert. dismissed, 116 S. Ct. 592 (1995)	38
BellSouth Advertising & Publishing Corporation v. Donnelley Information Publishing, Inc., 999 F.2d 1436 (11th Cir. 1993)	30
Building Officials & Code Adm'rs Int'l, Inc. v. Code Technology. Inc., 628 F.2d 730 (1st Cir. 1980)	45, 46
Campbell v. Acuff-Rose Music. Inc., 510 U.S. 569, 114 S. Ct. 1164 (1994)	37-39, 48
CCC Information Services, Inc. v. MacClean Hunter Market Reports, Inc., 44 F.3d 61 (2d Cir. 1994)	18, 19, 46
Consumer's Union of United States, Inc. v. General Signal Corp., 724 F.2d 1044 (2d Cir. 1983), cert. denied, 469 U.S. 823, 105 S. Ct. 100 (1984)	38
Feist Publications v. Rural Telephone Service Co., 499 U.S. 340 (1991)	14, 15
Folio Impressions, Inc. v. Byer California, 752 F. Supp. 583 (S.D.N.Y. 1990)	14
Harper & Row, Publishers, Inc. v. Nation Enterprises, 471 U.S. 539 (1985)	16, 44
In the Matter of U.S. et al. v. Thomson Company and West Publishing Company (Docket No. 96-1415, March 5, 1997)	5, 47
Kregos v. Associated Press, 937 F.2d 700 (2d Cir. 1991)	19
Lipton v. The Nature Company, 71 F.3d 464 (2d Cir. 1995)	21-25
Lowenschuss v. West Publishing Co., 402 F. Supp. 1212 (E.D. Pa. 1975), aff'd, 542 F.2d 180 (3d Cir. 1976)	45
Morrissett v. Procter & Gamble Company, 379 F.2d 675 (1st Cir. 1967)	16

New Era Publications, Int'l, ApS v. Henry Hold & Co., 873 F.2d 576 (2d Cir. 1989)	44, 45
Sony Corp. v. Universal City Studios, Inc. , 104 S. Ct. 774 (1984)	44
Stewart v. Abend, 495 U.S. 207, 110 S. Ct. 1750, 109 L. Ed. 2d 184 (1990)	14
Unigard Security Insur. Co. v. Lakewood Eng' & Mfg. Corp., 982 F.2d 363 (9th Cir. 1992)	40
Weissmann v. Freeman, 868 F. 2d 1313 (2d Cir. 1989)	44
West Publishing Co. v. Mead Data Central, Inc., 799 F.2d 1219 (8th Cir. 1986)	16
Wright v. Warner Books. Inc., 953 F.2d 731 (2d Cir. 1991)	48
Yukiyo Ltd. v. Watanabe, No. 97-115 (Fed. Cir. April 15, 1997)	47

TABLE OF STATUTES AND OTHER AUTHORITIES

17 U.S.C. § 101	14
17 U.S.C. § 102	13
17 U.S.C. § 103	13, 14
17 U.S.C. § 105	14, 41
17 U.S.C. § 107	37
17 U.S.C. § 403	41-43
17 U.S.C. § 405	42, 43
3 Nimmer on Copyright § 13.05[A][2]	38
Arthur R. Miller, Copyright Protection for Computer-Generated Works: Is Anything New Since Contu?, 106 Harv. L. Rev. at 1040 (fn 284)	16
Berne Convention Implementation Act of 1988, Public Law 100-568, 102 Stat. 2853 (1988)	43
Copyright Act of 1976, 17 U.S.C. § 101, et seq.	13
Fed. R. App. P., Rule 28(b)(2)	1
H.R. Rep. No. 94-1476, 94th Cong. , 2d Sess. 145 (1976); S. Rep. No. 94-473, 94th Cong., 1st Sess. 128 (1975)	42
Hearings on H.R. 4426, Serial No. 105 (May 14, 1992)	10, 35
Levine and Squires, "Notice, deposit and registration: The importance of being formal" 24 U.C.L.A. Law Rev. 1232	42
Lynn I. Miller, Fair Use' Biographies and Unpublished Works: Life After H.R. 4412, 40 J. Copr. Soc'y 349, 398-99 (1993)	45
Martha Dragich, "Will The Federal Courts of Appeals Perish if They Publish, 44 The American University Law Review 757 (1995)	7, 26
William F. Patry, The Fair Use Privilege in Copyright Law at 363 (1985)	44

ISSUES PRESENTED FOR REVIEW

Intervenor-Plaintiff-Appellee HyperLaw, Inc. ("HyperLaw") states that Defendant-Appellants West Publishing Company and West Publishing Corporation ("West") make improper assumptions and assertions, pursuant to Fed. R. App. P., Rule 28(b)(2), in Appellants' Statement of Issues Presented for Review. HyperLaw asserts that the correct statement of the issues presented for review is:

1. Did the district court err in holding that cross reference by another publisher to all page and volume numbers in a West case reporter does not constitute the copying of a protectible expression of West's selection and arrangement?

2. Did the district court err in holding that electronic cross reference to all of the pages in a West reporter does not constitute the copying of the entirety of West's selection and arrangement?

3. Did the district court err in holding that, even if such cross reference does constitute infringement, plaintiffs are entitled to a declaratory judgment that their intended use is permissible pursuant to the "fair use" doctrine?

STATEMENT OF THE CASE

This appeal concerns two separate and distinct plaintiffs, with separate and distinct products. West has attempted, throughout its brief, to blur this distinction and characterize both products as having the same characteristics. This is not the

case, and West's effort to do this is unsupported by the record below. West's erroneous Statement of the Case is illustrative:

The user of plaintiffs' products, by employing just two keys, can display all the cases from a West Reporter volume in the precise order -- case by case, page by page -- that they appear in the bound book./2

Appellants' Brief at 2, citing to "Trittipo Affidavit" ¶¶ 2-5; Exh. A. (A.1286-1287; 1290-1558). In fact, the Trittipo Affidavit was solely in opposition to Matthew Bender's motion for summary judgment. That affidavit, which pre-dated HyperLaw's motion for summary judgment, related only to Matthew Bender's distinctly different product, and did not even mention the HyperLaw product¹. More to the point, the facts in the Trittipo affidavit specifically do not apply to HyperLaw's product.

West's arguments on appeal center around the argument that a user of the Matthew Bender product can "leaf through" that product "to experience" West's case arrangements in its bound volumes. Even if this were true, it does not apply to HyperLaw. As the testimony and all evidence of record demonstrate, a user absolutely cannot "leaf through" HyperLaw's product, electronically or otherwise, "to experience" West's case arrangements in its bound volumes. West's page numbers are nothing more than cross references in HyperLaw's product.

¹ There is absolutely nothing in the record that would support West's assertion that a user of HyperLaw's product could display all the cases from a West reporter volume in the order they appear in the bound book. To the contrary, an examination of the HyperLaw product reveals that one cannot. See HyperLaw's First Supplemental Complaint (A 452 - A 476). See also Exhibit S-1 (A. 476).

As mere cross references, HyperLaw's insertion of page numbers corresponding to West reporters does not copy West's `selection'², nor does it copy West's `arrangement'³. The evidence was directly to the contrary. HyperLaw selects all United States Supreme Court opinions for inclusion in its product, and all Federal Court of Appeal opinions (both published and unpublished) that it can obtain from any source--electronic bulletin boards, the internet, or if

² West's "selection" is to print all Supreme Court decisions--and as Ms. Bergsgaard admitted at the subsequent trial on text, it prints all decisions the Circuit Courts designate under their rules.

THE COURT: Let me just ask you this: I'm not sure I understand what's going on.

With respect to the Federal Reporter, for each circuit, you published everything that they put out as an opinion, is that correct?

THE WITNESS: That gets a little bit into the selection, which we haven't talked about here, but basically the Court has issued opinions under their Court rules that you're familiar with that are precedential opinions for precedential value.

They also issue, as I mentioned before the unpubs, but there's many different orders that aren't labeled, either one, and West makes the decision as to those opinions and those orders how we're going to treat them.

THE COURT: And those are basically the rehearing denials?

THE WITNESS: There's rehearings and amendings and many different types of orders.

Trial Transcript (January 27, 28, 1997) at 238-239.

³ Although HyperLaw's product has a selection and arrangement which is different from West's reporters, HyperLaw maintains that West's bound volumes have even less arrangement than selection. Even the ethereal and totally mechanical arrangement that West contends exists in its advance volumes is completely destroyed and non-existent when those are lumped together with no rhyme or reason in the bound volumes.

necessary from West reporters⁴. Even West admits that in the Circuit Courts HyperLaw reports about 40% more cases for any given time period than does West.

HyperLaw does not arrange the cases in its product in the same order as West does in its bound reporters, nor does HyperLaw's product have the capability to allow users to display cases with the same arrangement as West presents cases in its reporters⁵. HyperLaw gathers every opinion it can, simply orders them as they come in, and places them on a CD-ROM in a manner which is randomly accessible⁶.

At the November 22, 1996 hearing on the parties' motions for summary judgment, the district court ruled for Matthew Bender and HyperLaw with regard to the pagination issues⁷. West's now attempts to assert falsely that the court somehow assumed that HyperLaw's product has "the capacity to display West's entire selection and

⁴ See e.g. HyperLaw's First Supplemental Complaint, ¶ 24 (A. 452 at A. 456)

⁵ See footnote 1, above.

⁶ As HyperLaw's product demonstrates, when a search produces a number of opinions, they are presented in the order in which were recorded on the CD-ROM. This order is approximately chronological and different from the order in West's reporters.

⁷ The issue of whether HyperLaw can copy the text of certain opinions from West reporters was subsequently tried by the parties before the district court. On January 27 and 28, 1997 the district court heard HyperLaw's claim for declaratory judgment (that West did not have copyrights in the text of decisions contained in its Supreme Court Reporter and Federal Reporter Series). Subsequently, on May 19, 1997, the court ruled in favor of HyperLaw on these issues, as well. Memorandum Opinion and Order, dated May 19, 1997. West has filed a Notice of Appeal.

arrangement of cases," Appellants' Brief at 7. This is not true⁸. West's own citation to A. 3505-3507 reveals the exact opposite to be the case.⁹

⁸ In addition to its false premises and statements, West's brief is characteristically misleading. West's continuous use of the term "wholesale" is illustrative. Its use is cleverly calculated to convey the impression that West only objects to "wholesale" use of star-pagination to its reporters, and not a less than "wholesale" use.

A review of West's actions both towards HyperLaw and elsewhere, reveals this as the trickery that it is. For example, West's initial threats to HyperLaw in 1991 did not concern "wholesale" copying from West reporters, but only HyperLaw's intended use of a very small selection of opinions. (See Exhibits 8 - 19 to HyperLaw's Complaint, A. 106--A. 202).

Another example--discussed, infra at fn 42--is West's self-serving reference (Appellant's Brief at fn 37) to the pagination licence agreement it agreed to in In the Matter of U.S. et al. v. Thomson Company and West Publishing Company (Docket No. 96-1415, March 5, 1997).

⁹ West's cite to A. 3475-3476 reveals that "for the sake of argument" the court assumed that West has compilation copyrights in entire volumes of its reporters--but the court certainly never found that West's selection and arrangement of cases is original and protectible under the Copyright Act. Nor did the court find that West's selection and arrangement of cases is an original and protectible element protected by valid copyright. Id.

FACTS¹⁰

HyperLaw, Inc.¹¹ is a CD-ROM publisher. For many years it has published a CD-ROM product containing all opinions that it is able to obtain electronically from the thirteen United States Courts of Appeals for the period from 1993 to present, and from the United States Supreme Court for the period from 1991 to present. HyperLaw adds whatever other opinions that it is able to locate by reviewing other publications (which were not electronically available for one reason or another). One way in which HyperLaw becomes aware of opinions designated as "published" by a court, but which HyperLaw was unable to obtain, is to review West's Federal Reporter. West has admitted that it uses this same method by comparing what it has collected to what Lexis-Nexis has available.¹²

¹⁰ The facts set out herein were stated in HyperLaw's Statement Pursuant to Local Rule 3(g) Regarding Facts Not in Dispute (A. 1642-A. 1664). In its Response (A. 2835-A. 2859) West admitted many of these facts. However, at the oral argument on November 22, 1996, West never objected to the factual basis for the court's grant of partial summary judgment for HyperLaw on the "pagination" issues. (West's assertion of material facts in dispute regarding the "text" issues resulted in the court's trying those disputed facts on January 27 and 28, 1997, and ultimately finding for HyperLaw on those issues, as well.)

¹¹ Alan D. Sugarman is HyperLaw's president.

¹² West has admitted that it has a Lexis account, and regularly uses that account to check to see what cases it may be "missing". Deposition of Donna Bergsgaard at 643-644 (A. 2510 at A. 2597)

A. Selection

At a June 21, 1996 evidentiary hearing before the court on West's motion to dismiss HyperLaw's complaint, HyperLaw proved that its Second Quarter 1996 CD-ROM contained over 36,000 appellate opinions for a specified period, of which only some 22,000 were also published by West. Thus, HyperLaw provided approximately 14,000 'unpublished' decisions West did not put into its reporters. The record is clear that for a comparable period of time, HyperLaw reports approximately 63% more decisions than are published by West in the Supreme Court Reporter and the Federal Reporter.

Each of the United States Courts of Appeals has a rule by which opinions are designated as citable as authority--"published" or "for publication", as described by Martha Dragich in, "Will The Federal Courts of Appeals Perish if They Publish, 44 The American University Law Review 757, 761 (1995). Such designated opinions are published in slip opinion format---in most of the courts by private contractors. (For example, at the time of the June 21, 1996 hearing, the private slip opinion printer for the First, Fifth, Eleventh, and District of Columbia Circuits was West, and the slip opinion printer for the Ninth and Fourth Circuits was a subsidiary of Thomson Publishing, which now owns West.) West's Federal Reporter reprints these "published" opinions with the addition of headnotes and syllabi---and calls these reprints "Case Reports."

All full text opinions and orders published in West's Supreme Court Reporter and Federal Reporter Series have either been

specifically designated as "published" by the court, or are orders relating to those opinions.¹³ West does not include the full text of opinions designated as "unpublished" in these reporters.

B. Arrangement¹⁴

West's arrangement in each permanent bound volume of its Federal Reporter Series is such that within a single bound volume opinions of a particular circuit may be found at three different places. For example, in Volume 71 of the Federal Reporter Third Series, groups of opinions from the Second Circuit appear beginning at 71 F.3d 58-93, 71 F.3d 464-475, and 71 F.3d 996-1073.

There is no originality in the placement by West of page breaks in either the Supreme Court Reporter or the Federal Reporter Series. The page breaks do not "arrange" the information in any way. To the contrary, while page breaks in a printed West Reporter advance volume may appear in the middle of hyphenated words or citations to cases, when West places the opinion on Westlaw or in the permanent volumes, it sometimes moves the page breaks to other places. (Sometimes it does not--there is no pattern to this.) Thus, West's page breaks in printed West reporters may occur at two

¹³ West "selects" absolutely all decisions of the U.S. Supreme Court, and all published decisions of the federal courts of appeals. HyperLaw selects all decisions of the U.S. Supreme Court, and all decisions (published or unpublished) of the federal courts of appeals which it can obtain.

¹⁴ There is absolutely nothing in the record below, or in the district court's November 22, 1997 decision from the bench, that would support West's assertion (Appellant's Brief at footnote 9) that the district court "apparently assumed that the HyperLaw Product. . . had the same capacity as the Bender Product to display the entire selection and arrangement of a West volume.

different places in the advance and final volumes, and perhaps at yet a third location when the decision is made available on Westlaw. See e.g. Sugarman Affidavit dated September 23, 1996 at ¶ 36 (A. 1665 at A. 1685); Sugarman Affirmation dated November 4, 1996 at ¶ 22 (A. 3125 at A. 3130).

Prior to 1994, HyperLaw's product did not include parallel citations to the first page and volume of the Federal Reporter and Supreme Court Reporter. In early 1994, HyperLaw added a table to its CD-ROM product which allowed users to cross-reference cases reported by HyperLaw with West first page citations. West has admitted that HyperLaw's table does not infringe West's purported copyrights. HyperLaw notes that anything regarding selection or arrangement that can be determined by any other first page citations in its product can be already determined from this table.

LEXIS presently uses West's first page citations without any acknowledgment or statement of license or copyright, and West points to LEXIS' use of the first page citation (without any mention of any license) as *proof to those considering alternative citation system that the first page citation may be used freely by competitors*. In its supplemental brief to the Wisconsin Supreme Court, dated April 3, 1995, West stated:

West Publishing does not object to other publishers using initial citations to its case reports--the volume number, the West reporter designation, and the first page number of the case report. It has stated that position repeatedly and--contrary to the suggestion of one of West's critics, Alan Sugarman, in his letter to the Courts--consistently in deposition testimony, in the briefs it has submitted in federal copyright cases, and

in its statements to this court on March 21. Since West has no objection to the use of initial citations to its case reporters, even by its competitors, those initial citations are effectively 'in the public domain.' [Emphasis added.]

Supplemental Brief and Appendix of West Publishing Co. at 8 (A. 760 at A. 761)

In 1992, West's former president Vance Opperman, appearing before the United States Congress, testified:

I cannot state often enough that, contrary to Mead's assertion in the case and some assertions that Thomson Corporation is now making, West did not and does not claim copyright protection for page numbers and citations per se. [Emphasis added.]

Hearings on H.R. 4426, Serial No. 105 (May 14, 1992) at 137 (A. 924 at A. 971)

C. Copyright Notice

Finally, West has filed copyright registrations for all volumes of its Supreme Court Reporter and Federal Reporter Series, applicable here. West's copyright notices, appearing in its reporters, are non-specific as to the identification, basis and

extent of its copyright claims in its case reports¹⁵.

SUMMARY OF ARGUMENT

1. The district court correctly determined that West's pagination in its Supreme Court Reporter and Federal Reporter Series does not embody any original creation by West.

2. The district court correctly found that there is no original creation by West in the number of lines on a page in a case or in the number of pages in a case; nor is there any original creation embodied in where and on what particular pages the text of court opinions appear with regard to its Supreme Court Reporter and

¹⁵ Typical copyright notices from the Supreme Court Reporter and Federal Reporter:

COPYRIGHT © 1986 WEST PUBLISHING CO.
Federal Reporter, Second Series
Vol. 800, Nos. 1-3

COPYRIGHT © 1987
By
WEST PUBLISHING CO.

Copyright is not claimed as to any part of the original work prepared by a United States Government officer or employee as part of that person's official duties.

COPYRIGHT © 1980 WEST PUBLISHING CO.
Supreme Court Reporter, Vol. 100, Nos. 14-18

COPYRIGHT © 1982
By
WEST PUBLISHING CO.

Copyright is not claimed as to any part of the original work prepared by a United States Government officer or employee as part of that person's official duties.

Federal Reporter Series.

3. Even if this Court determines that star pagination is an expression of West's selection and arrangement, such selection and arrangement of cases in the Supreme Court Reporter and Federal Reporter Series lacks sufficient originality to warrant compilation copyright protection.

4. Even if this Court determines that West's selection and arrangement of cases in its Supreme Court Reporter and Federal Reporter Series have sufficient originality to warrant compilation copyright protection, HyperLaw's intended use of first page citation and star pagination to West's reporters does not constitute copying of West's selection and arrangement.

5. Even if this Court determines that HyperLaw's intended use of first page citation and star pagination to West's reporters constitutes copying of West's selection and arrangement, and that such selection and arrangement has sufficient originality to warrant compilation copyright protection, HyperLaw's intended use of first page citation and star pagination to West's reporters is a fair use.

ARGUMENT

I. THE DISTRICT COURT CORRECTLY DETERMINED THAT WEST'S PAGINATION IN ITS SUPREME COURT REPORTER AND FEDERAL REPORTER SERIES DOES NOT EMBODY ANY ORIGINAL CREATION OF WEST.

A. Under Feist Only Original Elements of a Compilation Are Protectible by Copyright.

The Copyright Act of 1976¹⁶ ("the Act") affords copyright protection only to "original works of authorship fixed in any tangible medium of expression". 17 U.S.C. § 102¹⁷

(a) Copyright protection subsists, in accordance with this title, 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. . . .

(b) In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work. Section 103 of the Act provides that such copyright protection includes "compilations" and "derivative works"¹⁸ [Emphasis added.]

The Act does protect "compilations", however Section 103 provides that

(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

¹⁶ Codified at Title 17 of the United States Code.

¹⁷ Sec. 102. Subject matter of copyright: In general

¹⁸ Sec. 103. Subject matter of copyright: Compilations and derivative works

not affect or enlarge the scope, duration, ownership, or subsistence of, any copyright protection in the preexisting material.¹⁹ [Emphasis added.]

17 U.S.C. § 103.

Moreover, works of the federal government, including decisions authored by the judges and justices of the federal appellate courts, are not subject to copyright protection²⁰. Thus, the most protection the Act confers to the author of a compilation is protection against the copying of original compilation elements authored by the compiler²¹.

The starting point for any analysis of copyrightability is, of course, the Constitution. In Feist Publications v. Rural Telephone Service Co., 499 U.S. 340, 111 S. Ct. 1282 (1991), the Supreme

¹⁹ As defined in § 101,

A 'compilation' is 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.

²⁰ Sec. 105. Subject matter of copyright: United States Government works

²¹ This was also the case under the 1909 Act. In Stewart v. Abend, 495 U.S. 207, 110 S. Ct. 1750, 109 L. Ed. 2d 184 (1990), the Supreme Court interpreted the effect of a derivative copyright secured under § 7 of the 1909 Copyright Act.

[P]ublication of the derivative work does not mean that use of the original work in other works is precluded; and publication does not mean that a copyright in the original work shall be secured, e.g., if the work was in the public domain. . . .

495 U.S. at 231. Similarly, in Folio Impressions, Inc. v. Byer California, 752 F. Supp. 583 (S.D.N.Y. 1990) the court held that where the portion of a derivative work that was copied was already in the public domain, no infringement results.

Court reaffirmed the Constitutional sine qua non of "originality.

. . independent creation plus a modicum of creativity."

Originality is a constitutional requirement. The source of Congress' power to enact copyright laws is Article I, § 8, cl. 8, of the Constitution, which authorizes Congress to "secur[e] for limited Times to Authors . . . the exclusive Right to their respective Writings." In two decisions from the late 19th Century -- The Trade-Mark Cases, 100 U.S. 82 (1879); and Burrow-Giles Lithographic Co. v. Sarony, 111 U.S. 53 (1884) -- this Court defined the crucial terms "authors" and "writings." In so doing, the Court made it unmistakably clear that these terms presuppose a degree of originality.

* * *

. . . originality requires independent creation plus a modicum of creativity. . . . The writings which are to be protected are the fruits of intellectual labor, embodied in the form of books, prints, engravings, and the like." Ibid. (emphasis in original).

* * *

As one pair of commentators succinctly puts it^[22]: "The originality requirement is constitutionally mandated for all works." Patterson & Joyce, Monopolizing the Law: The Scope of Copyright Protection for Law Reports and Statutory Compilations, 36 UCLA L. Rev. 719, 763, n. 155 (1989) (emphasis in original) (hereinafter Patterson & Joyce). Accord id., at 759-760, and n. 140; Nimmer § 1.06[A]. . .

* * *

It is this bedrock principle of copyright that mandates the law's seemingly disparate treatment of facts and factual compilations. "No one may claim originality as to facts." Id., § 2.11[A], p. 2-157. This is because facts do not owe their origin to an act of authorship. The distinction is one between creation and discovery: the first person to find and report a particular fact has not created the fact; he or she has merely discovered its existence. To borrow from Burrow Giles, one who discovers a fact is not its "maker" or "originator." 111 U.S., at 58. "The discoverer merely finds and records." Nimmer § 2.03[E]. [Emphasis added.]

²² These two professors were quoted extensively on this point in the Feist decision. Professor Patterson participated in this matter as the expert for HyperLaw, although West disputed his expert report.

499 U.S. 346 - 347²³. Thus, it is the Constitution which mandates that the selection and arrangement in a compilation must possess originality--independent creation plus a modicum of creativity--for the compilation to be susceptible to copyright protection.

B. West's Pagination in its Supreme Court and Federal Reporter Series Are Uncopyrightable Facts.

Facts are not themselves copyrightable. Harper & Row, Publishers, Inc. v. Nation Enterprises, 471 U.S. 539 (1985). Even minor modifications to the expression of facts cannot be afforded copyright protection, given the very limited number of ways of expressing them. Morrissey v. Procter & Gamble Company, 379 F.2d 675 (1st Cir. 1967).

The district court held that West's pagination in its reporters was "fact"--not expression of facts (or a hybrid expression of selection and arrangement) as West would have this Court accept. The district court found that this pagination, the location of mechanical page breaks, expresses nothing more than the number of lines on each page. This lacks originality:

As I indicated at the outset of this argument, with the quote from Judge Leval in CCC, that the facts set forth in the compilation are not protected and may be freely copied, the protection extends only to those

²³ Many courts and scholars have posited that Feist effectively overturned the Eighth Circuit's decision in West Publishing Co. v. Mead Data Central, Inc., 799 F.2d 1219 (8th Cir. 1986). See e.g. Arthur R. Miller, Copyright Protection for Computer-Generated Works: Is Anything New Since Contu?, 106 Harv. L. Rev. at 1040 (fn 284) ("Feist raises questions concerning the continued viability of such cases as West Publishing Co. v. Mead Data Central, Inc. . . . which held that star pagination was copyrightable.")

aspects of the compilation that embody the original creation of the compiler.

Here, the 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.

Summary Judgment Decision at 34-35.

In so holding, the district court recognized that pagination is simply a mechanical process-text begins and ends on any particular page based upon the amount of text in non-copyrightable, judicial opinions²⁴. (Indeed, these breaks can appear in different places for the same case in West's advance sheet, final volume and on Westlaw.) If there is any originality in the length of an opinion, and how many pages it takes to print it, that originality owes its authorship to the judges and justices who wrote the opinions--and the simple random fit of words on a page. There simply is no originality in re-numbering the pages of a judicial

²⁴ Although West had previously argued that the location of the page breaks involves creativity, that argument has fallen from its own weight, and West has apparently abandoned it in its appeal. The facts adduced in discovery aptly demonstrated that page break insertions are done by automatic computer programs. It now appears that these computer programs are less than state-of-the-art, even for such mechanical systems--West has conceded that page breaks may occur within citations or within hyphenated words, and that when West places the opinion on Westlaw, it moves the page break to the end of the word. So, one wonders which of these break points is copyrighted by West.

It suffices to say that the page breaks are not only mechanical, but that the computer program which West uses reflects no special considerations. It is simply the computerized version of a human typesetter. Words break at odd places, citations are mangled, critical terms are not kept together, and very odd results are apparent throughout. In short this is nothing more than one of hundreds of generic, old style typesetting programs, and which certainly has no "creativity".

opinion sequentially, as a mechanical function of breaking the text as it flows onto successive the pages.

What West does is simply the logical consequence of placing a series of cases into a single volume. This is nothing more than a numbering system that is as old and commonplace as any in recorded history.

Since there is no creativity in the method of numbering and no content in the numbers, West's argument devolves into an attempt to persuade this Court that its pagination is not merely pagination-- it is somehow the "metaphysical" equivalent of West's selection and arrangement.

Even following West's silly contentions, it is axiomatic that if selection and arrangement is the expression of West's `idea' (of which cases to publish and how to order them) pagination is the idea itself--in which case the merger doctrine would defeat West's copyright.

In CCC Information Services, Inc. v. MacClean Hunter Market Reports, Inc., 44 F.3d 61, 68 (2d Cir. 1994), this Court reaffirmed the merger doctrine in this very context:

It is also well established that, in order to protect the immunity of ideas from private ownership, when the expression is essential to the statement of the idea, the expression also will be unprotected, so as to insure free public access to the discussion of the idea. See Kregos, 937 F.2d at 705; Herbert Rosenthal Jewelry Corp. v. Kalpakian, 446 F.2d 738, 742 (9th Cir. 1971) ("When the 'idea' and its 'expression' are . . . inseparable, copying the 'expression' will not be barred, since protecting the 'expression' in such circumstances would confer a monopoly of the 'idea' upon the copyright owner free of the conditions and limitations imposed by the patent law.") [Emphasis added.]

Writing for the court, Judge Leval applied Kregos v. Associated Press, 937 F.2d 700 (2d Cir. 1991), stating,

Kregos, thus, makes a policy judgment as between two evils. Unbridled application of the merger doctrine would undo the protection the copyright law intends to accord to compilations. Complete failure to apply it, however, would result in granting protection to useful ideas. . . .Kregos adopts a middle ground. In cases of wholesale takings of compilations, a selective application of the merger doctrine, withholding its application as to soft ideas infused with taste and opinion, will carry out the statutory policy to protect innovative compilations without impairing the policy that requires public access to ideas of a more important and useful kind. n25

n25 See Herbert Rosenthal Jewelry Corp. v. Kalpakian, 446 F.2d 738, 742 (9th Cir. 1971) ("The guiding consideration in drawing the line is the preservation of the balance between competition and protection reflected in the patent and copyright laws. What is basically at stake is the extent of the copyright owner's monopoly -- from how large an area of activity did Congress intend to allow the copyright owner to exclude others?"); Kern River Gas Transmission Co. v. Coastal Corp., 899 F.2d 1458, 1464 (5th Cir.) cert. denied, 498 U.S. 952, 112 L. Ed. 2d 336, 111 S. Ct. 374 (1990) ("To extend protection . . . would be to grant Kern River a monopoly of the idea for locating a proposed pipeline in the chosen corridor, a foreclosure of competition that Congress could not have intended to sanction through copyright law . . .") [Emphasis added.]

Id. at 72. While the court found copyrightability in CCC, it did so because

the valuations copied by CCC from the Red Book are not ideas of the first, building-block, category described in Kregos, but are rather in the category of approximative statements of opinion by the Red Book editors. To the extent that protection of the Red Book would impair free circulation of any ideas, these are ideas of the weaker category, infused with opinion; the valuations explain nothing, and describe no method, process or procedure. Maclean Hunter makes no attempt, for example, to monopolize the basis of its economic forecasting or the factors that it weighs; the Red Book's entries are no

more than the predictions of Red Book editors of used car values for six weeks on a rough regional basis. As noted above, Red Book specifies in its introduction that "you, the subscriber, must be the final judge of the actual value of a particular vehicle. Any guide book is a supplement to and not a substitute for expertise in the complex field of used vehicle valuation." This language is remarkably similar to our observation in Kregos, that the author "has been content to select categories of data that he obviously believes have some predictive power, but has left it to all sports page readers to make their own judgments as to the likely outcomes from the sets of data he has selected."

* * *

Because the ideas contained in the Red Book are of the weaker, suggestion-opinion category, a withholding of the merger doctrine would not seriously impair the policy of the copyright law that seeks to preserve free public access to ideas. If the public's access to Red Book's valuations is slightly limited by enforcement of its copyright against CCC's wholesale copying, this will not inflict injury on the opportunity for public debate, nor restrict access to the kind of idea that illuminates our understanding of the phenomena that surround us or of useful processes to solve our problems. [Emphasis added.]

Id. at 72-73²⁵.

West proposes that this Court adopt an absurd principle. For the Court to adopt West's position, it would be effectively declaring that all cross references from a larger set of things to a smaller collection of those things are infringements. Cross-referencing would no longer be deemed a pointer to the location (a fact) of content in another work--it would be deemed the content of that work, itself.

²⁵ To the contrary, here, any impairment of the public's access to the opinions of the federal judiciary or to federal law generally will most certainly inflict injury on the opportunity for public debate, and restrict access to public illumination and understanding of the phenomena that is federal case law. Any balancing test, therefore, must weigh heavily against granting West a monopolistic copyright in the law.

II. EVEN IF THIS COURT DETERMINES THAT STAR PAGINATION IS AN EXPRESSION OF WEST'S SELECTION AND ARRANGEMENT, SUCH SELECTION AND ARRANGEMENT OF CASES IN ITS SUPREME COURT REPORTER AND FEDERAL REPORTER SERIES LACKS SUFFICIENT ORIGINALITY TO WARRANT COMPILATION COPYRIGHT PROTECTION.

A. West's selection in its Supreme Court Reporter

It is undisputed that West's selection of cases for inclusion into its Supreme Court Reporter is far from original. West simply includes all decisions of the United States Supreme Court. West admits that one cannot find a single decision in West's Supreme Court Reporter which is not a United States Supreme Court decision, nor can one find a single United States Supreme Court decision which is not included (unless by a West mistake) in West's Supreme Court Reporter. In fact, it is West that copies selection--the public domain selection by the Supreme Court of cases. Thus, West cannot claim originality in its selection of Supreme Court cases in its reporter, and any claim that its pagination is an expression of its selection, must fail--since its selection is not a copyrightable element. See e.g. Sugarman Affirmation dated November 4, 1996 at ¶ 27 et seq. (A. 3125 at A. 3132 et seq.)

B. West's arrangement in its Supreme Court Reporter

Mechanistic arrangements have been held to lack sufficient creativity to warrant copyright protection. The author must employ some modicum of creativity in arranging the particular selected works. In Lipton v. The Nature Company, 71 F.3d 464 (2d Cir.

1995), this Court restated the Feist definition of the term "original":

'Original, as the term is used in copyright, means only that the work was independently created by the author . . . and that it possesses at least some minimal degree of creativity.' Feist, 499 U.S. at 345

Id. at 470. The court applied this definition to Lipton's selection and arrangement in his compilation of terms of ventry²⁶. First the court found originality in Lipton's selection, holding that, "[i]n compiling his work, Lipton assembled terms from various fifteenth century texts and manuscripts. These terms were selected from numerous variations of hundreds of available terms."

Id. Thus, the Court found originality in Lipton's arrangement because there was no material dispute that, "the arrangement was

²⁶ The distinctions between the originality in Lipton's selection and West's lack of originality are obvious: The entire project that Lipton engaged upon was creative, imaginative and original in its conception ab initio. West simply copies the cases the Court decides.

Lipton then identified and extracted individual pieces of information that he deemed to be interesting, not entire documents, from this mass of information. West simply copies entire cases decided by the Court.

the product of his creative and aesthetic judgment".²⁷ Id.
[Emphasis added.]

West does not arrange cases in its Supreme Court Reporter in anything but a simple, obvious, previously used manner--an arrangement which is reduced to a meaningless jumble when the cases are published in the bound volume. West has never, in over four years of litigation, demonstrated that its arrangement has even a modicum of creativity. Moreover, West has never shown that its arrangement expresses any creativity that is perceptible, utilized, or even understandable by its readers. Simply put, West has never even tried to argue or demonstrate that its arrangement displays originality, as required by this Court in Lipton. West's failed arguments have always been limited to the assertion that it somehow used creativity in arranging its cases. This is simply insufficient²⁸.

²⁷ The Lipton Court specifically distinguished, as lacking originality, "mechanical" arrangements where the selection is a pre-existing and unremarkable act.

We have held that while "mechanical" arrangements, such as alphabetical or chronological order, do not display the requisite originality, any minimal level of creativity is sufficient to render an arrangement protectible. Key, 945 F.2d at 514 (finding arrangement of businesses in directory to be protectible where "the arrangement is in no sense mechanical" and "entailed the de minimis thought needed to withstand the originality requirement") [Emphasis added.]

Id.

²⁸ Consider, for example, a judicial directory compilation in which the author arranges judges according to the author's view of the who is most reasoned and articulate. This might well be
(continued...)

West's representative, Donna Bergsgaard, in her Supplemental Affidavit (A. 2860-A. 2873) tried to put her best spin on a clearly non-original arrangement when she attempted to distinguish between Supreme Court opinions which, "contain a point of law" from those that, "do not contain a point of law". Id. at 2862. Of those Supreme Court opinions which do contain a point of law²⁹,

[they] are then arranged by filing date and then, within filing date, by seniority of the Justice and then by docket number. *Per curiam* opinions are placed at the end of this arrangement.

Id.

One can hardly imagine a less original arrangement. None of these sorting criteria--filing date, seniority of the Justice, or docket number--are any more original than the alphabetical sort in Feist. Date order, whether it be date of filing or date of seniority, is (if the Court will excuse the pun) as old as time.

²⁸ (...continued)
considered a creative arrangement. However, if the author does not inform the reader that this is the basis for the arrangement, to the reader the compilation might well appear to be in random order--without any creativity in the arrangement. A compilation whose asserted creative arrangement is hidden, cannot maintain a copyright in that arrangement.

Clearly, to be protectible, the creativity and originality of the arrangement must be discernable. That is the essential element of authorship--that the thing authored must be a recorded form of communication. This is fully in accord with this Court's reasoning in Lipton, where the Court required that the requisite originality be displayed. It also comports with the limitations on copyrightability set forth in § 102--which limits copyright protection to works in which the original authorship can be perceived, reproduced, or otherwise communicated.

²⁹ In essence, all opinions which are not orders and memoranda.

A docket number numerical sort, low to high, is certainly no better.

Faced with a sorting decision regarding Supreme Court opinions, it is hard to imagine that there could be more than a handful of meaning sorts. Certainly filing date is the most obvious. Then faced more than one decision filed on any particular date, it would certainly follow, given the customs of the Supreme Court regarding deference to seniority, that seniority of the authoring Justice be the sub-sort criteria. If faced with the unlikely possibility of two or more opinions authored by the same Justice and filed on the same date, the earliest docketed would be an obvious, unoriginal sub-sub-sort criteria.

Moreover, the method described by Ms. Bergsgaard lacks the creative and aesthetic judgment found in Lipton, much less the display of originality that Lipton required. It is no more than the rote application of a mechanical, rule-based process, and adds absolutely nothing original to the compilation of decision³⁰.

³⁰ Contrast Lipton, where this court noted that he arranged the terms of ventry according to their "lyrical and poetic potential." Id. at 467. Lipton's lyrical and poetic creativity and originality can, in no way be compared to the act of simply gathering, mechanically ordering, and reprinting wholesale, entire court opinions. Of course, Lipton's display of the lyrical and poetic potential of the terms of ventry was discernable to his readers. West's arrangement has no discernable meaning to users of West's reporters, and no apparent lyrical and poetic potential.

C. West's selection in its Federal Reporter Series

Similarly, West selection of cases for its Federal Reporter Series is unoriginal. Starting with the basic premise that it simply includes all opinions of federal appeals courts, West refines that criteria by publishing opinions designated by the courts "for publication", and not publishing opinions designated by courts as "not for publication". In essence, the Courts of Appeals may narrow the universal selection by designating particular opinions, "not for publication"³¹.

West has not denied this. In both her Affidavit (A. 1075-A. 1094) and Supplemental Affidavit (A. 2860-A. 2873), Ms. Bergsgaard declined to deny this selection criteria, or to enlighten the district court with another selection criteria.

In American Dental Association v. Delta Dental Plans Association, 1996 U.S. Dist. LEXIS 5809 (N.D. Ill. 1996), the court

³¹ Each of the United States Courts of Appeals has a rule by which opinions are designated as citable authority, "published" or "for publication". Dragich, Martha, "Will The Federal Courts of Appeals Perish if They Publish: 44 The American University Law Review 757, 761 (1995). Such designated opinions are published in slip opinion format--in most of the courts by private contractors. (For example, the private slip opinion printer for the First, Fifth, Eleventh, and District of Columbia Circuits is West, and the slip opinion printer for the Ninth and Fourth Circuits is a subsidiary of Thomson Publishing, which now owns West.) When a court amends an opinion, it may issue a formal order which may be disseminated widely, or it may engage in more informal processes, including communicating the changes to West without benefit of a formal order. West's Federal Reporter Series reprints these published opinions with the addition of headnotes and syllabi--and calls these reprints "case reports." In determining which opinions to publish in full text in the Supreme Court Reporter and Federal Reporter Series, West engages in virtually no selection.

analyzed a compilation for creativity and originality with regard to selection and arrangement. The court looked at what constituted the minimal creativity required.

The Copyright Office has suggested that "selection . . . may refer to the choice of less than all the data in a given body of relevant material, regardless of whether it is taken from one source or multiple sources." Copyright Office, Guidelines for Registration of Fact-Based Compilations 1 (Rev. Oct. 11, 1989). Essentially this means that creativity will not be found unless there is some real sense of choice in the decision to include or exclude material in a compilation. Thus, there is selective creativity in "choosing among the 18,000 or so different baseball cards in order to determine which were the 5,000 premium cards." Eckes, 736 F.2d at 863.

The less choice, the less creativity. The Seventh Circuit came to this conclusion in *Mid America Title Co.*, when it denied plaintiff copyright protection for the compilation of land title data. The *Mid America Title Co.* Court found that because there was a "limited universe of available data," there was "no room for creativity in determining which liens and encumbrances to include." 59 F.3d at 722. It follows from this that if a compilation includes all existing data, there is similarly no "choice." See Patry at 200 ("Where the entire universe of particular data is included, there can be no selection, and thus absent some original coordination or arrangement, there can be no copyright."). Deciding to include all 18,000 baseball cards from among 18,000 possible ones involves no creative discernment and therefore no choice. Eckes, 736 F.2d at 862-63. Emphasis added.)

Here, it is clear that West selects all decisions of the U.S. Supreme Court, and substantially all "published" decisions of the federal courts of appeals.³² HyperLaw selects all decisions of the

³² The American Dental Association court also looked at the necessary modicum of creativity in the context of a work which does not exhibit the imprimatur of its author's personality. Questioning whether, "creation by committee" is an oxymoron, the court noted that "the more participants that contribute, the less individual--and therefore the less personal--the result. Collectivism, by its very nature, necessitates dilution of the individual creative impulse." Id. West consistently maintains
(continued...)

U.S. Supreme Court, and all decisions (published or unpublished) of the federal courts of appeals which it can obtain. It is clear that neither West nor HyperLaw employs creativity or originality in their selections, and in any event, HyperLaw's selection could not possibly copy West's as it is simply the inclusion of the entire possible universe of collectible opinions.³³

D. West's arrangement in its Federal Reporter Series

West's arrangement in its Federal Reporter Series, unlike Lipton's arrangement, is both a completely mechanical and obvious ordering, as well as one which has no meaning after all of the advance volumes have been dumped, in a simple, sequential manner into a permanent volume. (Whatever arrangement claimed, in the first instance, totally disappears.) West's arrangement guidelines for its Federal Reporter Series (A. 1072) reveal that initially (in advance volumes) opinions are arranged numerically by circuit, with the U.S. Judicial Conference Committee and District of Columbia Circuit ahead of the numbered circuits, and the Federal

(...continued)

that its efforts are based on a system that is a hundred years old--the result of the efforts of untold masses yearning to select and arrange. West would be hard pressed to identify the individual personality in its selection or arrangement. To the contrary, West's purported selection and arrangement of its Federal Reporters are merely the mechanical processes determined by committee--which have devolved to an institutional reliance on the dictates of the courts and the relationship which has become the system over the past 100 years.

³³ Distinguish this undisputed fact with West's position. According to West, references in a larger collection to the same things in a smaller collection is "copying" and a copyright infringement.

Circuit after the numbered circuits³⁴. It is hard to imagine a more mechanical system or rule-based process.

However, even if this "ordering" were original--as first published in West's preliminary advance sheets, the advance sheets are then combined, out of that order, for final printing in the bound Federal Reporter Series volumes. There is a conscious decision here not to preserve that "valuable" ordering--but merely to "stack" the advance sheets. Thus, when it comes time to publish the bound final volumes, the new "originality" is to display cases in a way in which a reader would perceive an entirely different arrangement than that used in the advance sheets. This flip-flop of "arrangement systems" (both of which are completely non-obvious to the average user), is hardly the creative and aesthetic judgment found in Lipton, or even a minimal degree of creativity, as required by Feist.

Even the advance volume arrangement is exactly the mechanical sort of arrangement, such as alphabetical or chronological, that

³⁴ In her deposition, Bergsgaard testified:

A. [BY MS. BERGSGAARD] The date order is you take the--we have the advance sheet, and we have decided that we're going to publish cases by circuit, first of all, so we take the D.C. Circuit and we take the First Circuit cases and the Second, and so on and so on. Actually, we start with the U.S. Conference and then follow it by the D.C. opinions. Then within each of those groups, we put them in chronological order by the filing date of the opinion. And then one or more advance sheets -- generally it's two; sometimes it's one advance sheet is combined to make the bound volume.

Bergsgaard Deposition at 653. (A. 2510-A. 2639, at A. 2599)

this Court and others have always held does not display the requisite originality to qualify for copyrightability. Headings in the yellow pages of phone books have far more creativity. See, BellSouth Advertising & Publishing Corporation v. Donnelley Information Publishing, Inc., 999 F.2d 1436 (11th Cir. 1993).

Moreover, grouping decisions in a similar or equivalent manner has been used by other reporters historically. A publisher arranging Federal Circuit Court decisions in a non-random manner simply has a very limited number of logical arrangements:

1. Docket Number
2. Date of filing
3. Date of Decision
4. Alphabetical
5. By circuit, district or other obvious subdivision of the whole court system
6. By Subject matter
7. By Judge
8. By Name of Counsel
9. By Docket Number
9. A combination of the foregoing.

Thus, arrangement by circuit was hardly a revelation--and if it was, it was not West's revelation. Reporting of decision by grouping according to courts within a given court district or circuit goes back at least to England--and probably well beyond that. Thus, in considering whether West's arrangement is even minimally creative, one must also consider the extremely limited number of non-trivial variations of useful arrangements, and the historical use of the same method. There are not more than a handful of ways to do it, and others have done it this way.

West has yet to be so brazen as to claim that there is some novelty or aesthetic artistry to its arrangement. It merely

embellishes an otherwise trivial arrangement with hyperbole and oversell. What is manifestly clear, however, is that West's so-called arrangement is really nothing more than a reaction to the necessity to package up printed opinions in some order, and to monitor the opinions at the publication level as each advance sheet is prepared.

III. EVEN IF THIS COURT DETERMINES THAT WEST'S SELECTION AND ARRANGEMENT OF CASES IN ITS SUPREME COURT REPORTER AND FEDERAL REPORTER SERIES HAVE SUFFICIENT ORIGINALITY TO WARRANT COMPILATION COPYRIGHT PROTECTION, HYPERLAW'S INTENDED USE OF FIRST PAGE CITATION AND STAR PAGINATION TO WEST'S REPORTERS DOES NOT CONSTITUTE COPYING OF WEST'S SELECTION AND ARRANGEMENT.

A. Because a West Competitor May Use the First Page Citation, Internal Pagination Discloses No Further Information about the West Selection and Arrangement

HyperLaw's product is a CD-ROM that includes, for the years reported, all United States Supreme Court opinions, and all or substantially all of the "published" and many unpublished opinions of federal courts of appeals--almost 40% more opinions than printed in the West Reporters for the same periods.

West has conceded that other publishers (and particularly HyperLaw) may use the first page citations to West reporters because these citations are "in the public domain"³⁵. Thus, all that

³⁵ Although West now attempts to reverse itself upon realizing the implications of its strategies, and to take the position that use of first page citation is merely fair use, it has repeatedly
(continued...)

remains for this Court to determine is whether HyperLaw may also use West's internal pagination--despite the fact that West concedes that the internal pagination reveals no additional information regarding either West's selection or arrangement.

1. West Has Conceded That its First Page Citations are in the Public Domain

West has repeatedly stated that its first page citations are in the public domain, and thus, competitors may use them in competing publications--even though such a use completely reveals West's selection and arrangement.

For generations, Shepard's has been publishing lists and tables of each and every case reported in each and every West reporter. Shepard's current CD-ROM product includes the names of cases and has the ability to link to other CD-ROMs which fully and clearly reveal West's claimed selection and arrangement.

Starting in the early 1970's, LEXIS began to use the first page citation to West case reports for the comprehensive databases that it was creating, without any license by West. See West v. Mead. Prior to 1985, West did not object to the use by LEXIS of the first-page citation, again permitting LEXIS to recreate, on-line, the purported West selection and arrangement of its case reports.³⁶ Even today, LEXIS uses the first page citations without

³⁵ (...continued)
admitted that its first page citations are in the public domain. See, supra at 10, infra at 34.

³⁶ It is interesting to note that it was not until the West v. Mead case, years after such use had been going on openly, that
(continued...)

any statement of license or West copyright, and West points to LEXIS' use of the first page citation (without any mention of any license) as proof to those considering alternative citation system that the first page citation may be used freely by competitors because it is "in the public domain". The record reflects the fact that one of West's litigation attorneys in this case, Michael A. Trittipio, stated in writing to every law librarian, attorney, public interest advocate and other person on an Internet forum involving this issue, that:

On 4/15/95, Cindy Chick wrote " that the initial page cite is not an issue (as shown by) the fact that LEXIS has been using it for years, and has never been sued by West for doing so. Nor has anyone else."

In response the same day, John Lederer wrote that he thought Ms. Chick was "missing a crucial fact when you talk of LEXIS using West cites as proof of the fact that anyone could. . . .Lexis is a licensee of West, and pays West to use its page numbers and cites. "The next day, Carl Hartmann [counsel to HyperLaw, Inc.] wrote to "point out. . . .that West does not concede its first page citations--and that the use by LEXIS is pursuant to a secret contractual agreement."

Ms. Chick was right; Messrs. Lederer and Hartmann wrong. Simple fact: Lexis uses (and has used since its inception in 1973) the "initial page cites" without any license and without being sued for doing so, and so have many other publishers.

(...continued)

West ever expressed that it considered this copying of its "selection and arrangement" to be "fair use," rather than use of something in the public domain—a thought which appears to have surfaced in West v. Mead, not as a finding of the court, but as a stipulation of the parties. Given West's silence during all the years when LEXIS used the first page citation, which fully disclosed the selection and arrangement of cases in West reporters, it is not at all surprising that West decided to so stipulate in West v. Mead, rather than litigate a losing position.

Even if this weren't clear, Mr. Lederer could have read in the West brief filed in Wisconsin: "West Publishing does not object to other publishers using initial citations to its case reports--the volume number, the West reporter designation, and the first page number of its case report . . ." (Emphasis added.)

Internet Mail from Michael A. Trittipo³⁷, (A. 2769) (Attorney Trittipo was specifically quoting from and referring the law librarians to West's filings to the Supreme Court of Wisconsin which explicitly stated that the first page citations were in the public domain.³⁸)

Additionally, West's then president, Vance Opperman, testified before Congress:

I cannot state often enough that, contrary to Mead's assertion in the case and some assertions that Thomson Corporation is

³⁷ This is the same attorney whose affidavit was filed in support of West's summary judgment papers below, and which West cites to herein.

³⁸ In its supplemental brief to the Wisconsin Supreme Court, dated April 3, 1995, West stated:

West Publishing does not object to other publishers using initial citations to its case reports--the volume number, the West reporter designation, and the first page number of the case report. It has stated that position repeatedly and--contrary to the suggestion of one of West's critics, Alan Sugarman, in his letter to the Courts--consistently in deposition testimony, in the briefs it has submitted in federal copyright cases, and in its statements to this court on March 21. Since West has no objection to the use of initial citations to its case reporters, even by its competitors, those initial citations are effectively "in the public domain." (Emphasis added.)

The purpose of this brief was to dissuade the Wisconsin Supreme Court from adopting an immediately available permanent public domain citation system. West was successful in its effort to block this proposal. A similar proposal is presently being considered by the U.S. Judicial Conference.

now making, West did not and does not claim copyright protection for page numbers and citations per se. [Emphasis added.]

Hearings on H.R. 4426, Serial No. 105 (May 14, 1992) at 137. (A. 924 at A. 971)

2. First Page Citations Reflect All Selection and All Arrangement

If a reader knows the first page citation of all decisions in a West reporter, the reader knows two things: (1) all the cases that have been "selected" by West, and (2) the sequential order of all the cases within West's reporter³⁹.

With regard to selection, West argues that because Matthew Bender's product would now allow a reader to determine whether a first page citation exists, selection is revealed. However, the selection could already be determined by reference to information which is either uncopyrightable fact, or which West previously put into the public domain. Either way, displaying West's first page citations neither displays nor reveals anything protectible.

Similarly, with regard to arrangement, West argues that because Matthew Bender's product would now allow a reader to determine on what page in a West reporter a case starts, the Matthew Bender product could allow a reader to "line 'em up" just as they are in West's reporter (as if this has some value). Again,

³⁹ Even this "rule" has an exception. If more than one case starts on a single page in a West reporter they all share the same citation, and the ordering of those cases cannot be determined by their citations alone. This, of course, happens only rarely for opinion decisions of the sort at issue here, and in any event, would partially contradict West's assertion that citations reveal arrangement.

this is not true of HyperLaw's product, but even if it was, West's arrangement is completely revealed by reference to information which is either uncopyrightable fact, or which West previously put into the public domain. It is not an argument about what is revealed--it is an argument about what can be found yet another way.

In any event, as the record reveals, it is another West argument which is totally inapplicable to HyperLaw.

B. HyperLaw's Product Does Not Copy West's Selection or Arrangement

HyperLaw has no idea what West's theory on appeal might be with regard to how HyperLaw's product "copies" West's selection or arrangement beyond what is discernable from material West has put into the public domain--as West addresses only Matthew Bender's CD-ROM. HyperLaw's selection and arrangement does not copy West's and it cannot be used (as West claims Matthew Bender's product can) to mechanically display all cases in a West volume in the order they appear there.

C. HyperLaw's Product Does Not Display West's Selection or Arrangement

Again, HyperLaw has no idea what West's theory on appeal might be with regard to how HyperLaw's product "displays" West's selection or arrangement--as West addresses only Matthew Bender's CD-ROM. HyperLaw's product does not display West's selection or arrangement, and it cannot be used (as West claims Matthew Bender's can) to "reveal" the selection or arrangement.

IV. EVEN IF THIS COURT DETERMINES THAT HYPERLAW'S INTENDED CROSS REFERENCE TO THE FIRST PAGE CITATION AND STAR (INTERNAL) PAGINATION IN WEST'S REPORTERS CONSTITUTES COPYING OF WEST'S SELECTION AND ARRANGEMENT, AND THAT SUCH SELECTION AND ARRANGEMENT HAS SUFFICIENT ORIGINALITY TO WARRANT COMPILATION COPYRIGHT PROTECTION, HYPERLAW'S INTENDED USE OF FIRST PAGE CITATION AND STAR PAGINATION TO WEST'S REPORTERS IS A FAIR USE.

The district court also determined that HyperLaw's intended use of star pagination constituted fair use. Observing that "the underlying equities here lie with allowing use of star pagination," Summary Judgment Decision at 36 (A. 3474 at A. 3509), the court continued, "What West is attempting to do by trying to inhibit star pagination is to create a monopoly over reported court decisions. That, in my view, is not an equitable activity and therefore should play some role in the analysis of whether or not there is fair use here." Id.

In its decision from the bench, the court proceeded to discuss the four factors listed in the Copyright Act which are to be weighed in a fair use analysis. See 17 U.S.C. § 107.

A. Purpose And Character Of The Use

The first factor inquires into the purpose of HyperLaw's usage. Although the HyperLaw CD-ROM product is admittedly for sale commercially, the Supreme Court has recently clarified that that circumstance alone is less significant than any "transformative" feature that the product may offer. Campbell v. Acuff-Rose Music, Inc., 510 U.S. 569, 114 S. Ct. 1164, 1171 (1994) ("the more transformative the new work, the less will be the significance of

other factors, like commercialism, that may weigh against a finding of fair use"). "Transformation" in turn refers to whether the CD-ROM "adds something new, with a further purpose or different character" than West's copyrighted reporters. Id. See also American Geophysical Union v. Texaco Inc., 60 F.3d 913, 923 (2d Cir. 1994), cert. dismissed, 116 S. Ct. 592 (1995) (citing Campbell). Given its "hyperLinks" to related cases, word concordance, Boolean searching ability with visual results display on requests, customized features such as paragraph level searching, and expansion to all cases rather than just the published ones (almost 40% more coverage), the CD-ROM offers a host of features transformative of West's volumes.

B. Nature Of The Work

The second factor looks at the nature of the copyrighted work. Unpublished and creative work are given the broadest protection under this factor, published and less imaginative works the least. See Campbell at 1175, citing 3 Nimmer on Copyright § 13.05[A][2]. Given that West's reporters are published compilations of all of the published, wholly unprotected judicial opinions, and the only claim West makes to pagination is that it can display selection and arrangement, they require the widest possible fair use construction. See Consumer's Union of United States, Inc. v. General Signal Corp., 724 F.2d 1044, 1049 (2d Cir. 1983), cert. denied, 469 U.S. 823, 105 S. Ct. 100 (1984). ("Since the risk of restraining the free flow of information is more significant with

informational work, the scope of permissible fair use is greater.") This factor massively favors HyperLaw.

C. Amount And Substantiality Of The Portion Used In Relation To The Copyrightable Work As A Whole

The third factor asks whether "the amount and substantiality of the portion used in relation to the copyrighted work as a whole" is "reasonable in relation to the purpose of the copying." Campbell at 1175. HyperLaw has "used" or referred to only that information which is necessary to allow a user of HyperLaw's product to cite to government works, in the form of judicial decisions, to the place in West's reporters where they appear.

HyperLaw does not use or copy any textual material that is the original authorship of West. HyperLaw is not using West's pagination so that it may display West's selection or arrangement. Indeed, the HyperLaw product does not permit a user to do that. The only use HyperLaw's product makes of West's pagination is simply to indicate where public domain text may be found in West's reporters--so that parties and attorneys may indicate those locations in their briefs. It is simple cross-reference.

D. Effect Of The Use On Potential Market For Copyrighted Work

The advertisements in which West promotes its products, and in fact all West statements about its product, defines its market as being one driven by its cross-referencing system and key numbers. West stresses that it sells not decisions, but rather case reports. HyperLaw does not do this. There is no external cross-referencing,

there are no topics, or syllabi (unless the courts provide them). One cannot get into or out of West's Digests from HyperLaw's product. In short, HyperLaw's product does not compete in the same market or supply the same services as West's reporters.

West has steadfastly refused to produce any discovery regarding the potential market factor--including its license agreement with Lexis. Given West's strategic choice to conceal the details of its only important license, HyperLaw has been precluded from developing any meaningful record on this issue. Basic equity therefore precludes West from arguing that the evidence on this fourth factor favors its position. See e.g. Unigard Security Insur. Co. v. Lakewood Eng' & Mfg. Corp., 982 F.2d 363, 367-69 (9th Cir. 1992) (holding that the district court's decision to exclude plaintiff's expert testimony regarding a boat that was destroyed by plaintiff was within the court's "inherent power" even though plaintiff had not violated any court order and no finding of bad faith had been made).

E. Section 403 of the Copyright Act as Expressing Congressional Intent

In 1976, Congress passed a major revision to the Copyright Act. Section 105 of the Act states that, "Copyright protection under this title is not available for any work of the United States Government." Congress also included Section 403 in the Act, to ensure that § 105 would have meaning when works of the federal government were re-published by private publishers. As set forth in the 1976 Act, § 403 stated:

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 sections 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. [Emphasis added.]

West omits from its copyright notices, 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. A typical copyright notice from a West reporter reveals this:

Copyright © 1986 West Publishing Co.
Federal Reporter, Second Series
Vol. 800. Nos. 1-3
Copyright © 1987
By
West Publishing Co.

Copyright is not claimed as to any part of the original work prepared by a United States Government officer or employee as part of that persons's official duties.

Failure to meet this requirement of § 403 was to be treated as an omission of the notice, subject to the provisions of § 405⁴⁰. Nor is there any great mystery regarding why § 403 was enacted--to stop exactly what West has tried to do--expropriate governmental works by vaguely identified, minuscule variations. The House

⁴⁰ Although § 405, in the 1976 Act, contained saving provisions to avoid forfeitures of copyrights under certain conditions-- here, the applicable provision might have applied to West, if West had complied with § 403 within five years of publication of each volume. It did not.

Judiciary Committee Report No. 94-1476 contains a discussion of § 403:

Section 403. Notice for Publications Incorporating United States Works

Section 403 is aimed at a publishing practice that, while technically justified under the present law, has been the object of considerable criticism. In cases where a Government work is published or republished commercially, it has frequently been the practice to add some "new matter" in the form of an introduction, editing, illustrations, etc., and to include a general copyright notice in the name of the commercial publisher. [which] suggests to the public that the bulk of the work is [not] uncopyrightable and therefore free for use.

To make the notice meaningful rather than misleading, section 403 requires that, when the copies or phonorecords consist "preponderantly of one or more works of the United States Government," the copyright notice (if any) identify those parts of the work in which copyright is claimed. A failure to meet this requirement would be treated as an omission of the notice, subject to the provisions of section 405.

H.R. Rep. No. 94-1476, 94th Cong. , 2d Sess. 145 (1976); S. Rep. No. 94-473, 94th Cong., 1st Sess. 128 (1975) . See also Levine and Squires, "Notice, deposit and registration: The importance of being formal" 24 UCLA Law Rev. 1232.

To prevent that predatory business practice, Congress in 1976 provided a penalty for those who, like defendant West, reprinted U.S. government works in such a manner as to claim false proprietorship therein: forfeiture of copyright protection⁴¹. Id.

⁴¹ In 1988, in order to comply with the Berne Convention, Congress passed the Berne Convention Implementation Act of 1988, Public Law 100-568, 102 Stat. 2853 (1988), which became effective March 1, 1989. As a consequence, § 403 was amended to read:

Sections 401(d) and 402(d) shall not apply to a work published in copies or phonorecords consisting predominantly of one or more works of the United States Government unless the notice of copyright appearing on the published copies or phonorecords to which a

(continued...)

("[F]ailure to meet the requirement would be treated as an omission of notice.") Accordingly, West's failure to meet the requirements of § 403 must be treated as an omission of the copyright notice, subject to § 405.

Thus, for the purpose of evaluating the fair use issue the Court should consider, as an additional factor, West's failure to comply with § 403. While the Court does not, in this appeal, have to reach the ultimate issue of whether West has any copyrights in volumes of federal case law during the period between the effective date of the 1976 Act and the effective date of the Berne Convention Implementation Act, the Court should consider West's non-compliance with § 403 as another factor in a fair use analysis.

The fair use doctrine also requires courts "to apply an 'equitable rule of reason' analysis to particular claims of infringement." Sony Corp. v. Universal City Studios, Inc., 104 S. Ct. 774, 792 (1984); see also Harper & Row, Publishers, Inc. v. Nation Enters., 105 S. Ct. 2218, 2226 (1985) (emphasizing the "equitable nature" of the fair use doctrine). Accordingly, it is appropriate to look beyond the four statutory factors enumerated in 17 U.S.C. § 107 to equitable factors bearing on the public interests served by copyright law. See, e.g., Weissmann v. Freeman, 868 F. 2d 1313, 1323 (2d Cir. 1989) ("Analysis begins not

⁴¹ (...continued)
defendant in the copyright infringement suit had access includes a statement identifying, either affirmatively or negatively, those portions of the copies or phonorecords embodying any work or works protected under this title. [Emphasis added.]

by elevating the statutory guides into inflexible rules, but with a review of the underlying equities."); New Era Publications, Int'l, ApS v. Henry Hold & Co., 873 F.2d 576, 588 (2d Cir. 1989) (Oakes, C.J., concurring) (emphasizing that the four statutory factors are non-exclusive), see also William F. Patry, The Fair Use Privilege in Copyright Law at 363 (1985) ("Courts are not, however, limited to the four enumerated factors, and a number of courts have considered additional factors where relevant."). Here, Congress specifically condemned, as inequitable, West's practice of commingling minor editorial revisions with public domain judicial documents without apprising the reader of where one ends and the other begins. Congress furthermore specifically invited courts to redress this inequitable conduct in the context of infringement actions. This consideration serves as a powerful "fifth factor" favoring a broad construction of the fair use defense in the case at bar to permit HyperLaw's intended copying from West's reporters.

F. Public Interest

Congress has directed that the four statutory factors not be considered exhaustive; other considerations serving the public interest must also inform the fair use analysis. See e.g. New Era Publications Int'l' Aps v. Henry Holt & Co., 873 F.2d 576, 588 (2d Cir. 1989), (Oakes, Chief Judge, concurring), cert. denied, 493 U.S. 1094, 110 S. Ct. 1168 (1990); Lynn I. Miller, Fair Use' Biographies and Unpublished Works: Life After H.R. 4412, 40 J. Copr. Soc'y 349, 398-99 (1993) (factor of promoting significant

social benefit). The overwhelming public interest favors efficient, accurate and universal access to the law of the land. See Banks v. Manchester, 128 U.S. at 253 ("the authentic exposition [of the law], binding every citizen, is free for publication to all"). Access to the corrected opinions, corrected by courts is essential, as the "principles of stare decisis would be fatally undermined were it otherwise." Lowenschuss v. West Publishing Co., 402 F. Supp. 1212, 1216 (E.D. Pa. 1975), aff'd, 542 F.2d 180 (3d Cir. 1976).⁴²

⁴² The reasoning of Building Officials & Code Adm'rs Int'l, Inc. v. Code Technology, Inc., 628 F.2d 730 (1st Cir. 1980), is also applicable here. In that case, a private organization, BOCA, developed a model building code; it thereafter encouraged the State of Massachusetts to enact that code into law. Because BOCA's intellectual property had, with its own consent, become governing law, the court reversed the trial court's entry of a preliminary injunction and held that BOCA failed to establish a likelihood of success on the merits on the issue of whether copying would constitute copyright infringement. Id. at 736.

In a recent case, the Second Circuit declined to follow Building Officials to place in the public domain a compilation of valuations of used cars that had been adopted as an alternative valuation standard in the insurance statutes or regulations of several states. See CCC Info. Servs., Inc. v. Maclean Hunter Marlet Reports Inc., 44 F.3d 61, 74 (2d Cir. 1994), cert. denied, 116 S. Ct. 72 (1995) ("We are not prepared to hold that a state's reference to a copyrighted work as a legal standard for valuation results in loss of the copyright."). CCC is readily distinguishable from the facts at bar. As with the plaintiffs in Building Officials, but unlike the copyright holder in CCC, West has encouraged the bench and bar to elevate citation of West's reporters as the official standard and thus, through its own actions, has caused it to become a necessary incident of legal practice. In addition, Building Officials involved a copyrightable composition consisting of a model code that was intended to serve as a governing standard. The different result in CCC reflects the circumstance that the work at issue there was created to serve commercial purposes quite apart from embodying the law. As between those two paradigms, the facts at bar are far closer to those of Building Officials: West's works exist

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It cannot be seriously disputed that when one cites to a federal court of appeals or federal district court decision, the cite to West's reporter is required. There are no "official" citations, and no other general accepted citation system. Many courts and individual judges require the West citation in filed papers. In any event, failure to include West citations clearly renders a party's papers unusable by a court. Thus, a user who wishes to use a product of a West competitor cannot do so unless that product provides the user with the West citations and star pagination. The hardship and financial cost to the bar, and ultimately to clients who must bear the cost, is clear. With citation and pagination barriers to new entrants into the legal publishing market, West can maintain its virtual monopoly and keep prices artificially inflated⁴³.

(...continued)

solely to set forth the law; the citation system based on West's compilation has value solely as a system to find the law.

⁴³ West blatantly misleads the Court, Appellants' Brief at fn 37, when it represents that:

Furthermore, any claim that enforcement of West's copyright interest will result in hardship to the bar is also undermined by the fact that, pursuant to the Final Judgment of the United States District Court for the District of Columbia in In the Matter of U.S. et al. v. Thomson Company and West Publishing Company (Docket No. 96-1415), West has agreed to make star pagination subject to a compulsory license in perpetuity.

West conveniently neglects to mention that this license agreement is cumbersome, not self-effectuating, and specifically limited to selections and an arrangement that West determines to be independently selected by the licensee, thus allowing West to

(continued...)

⁴³ (...continued)
deny a license to anyone it determines to be "wholesale" copiers.

"1.03. "Licensee Case Reports" shall mean Licensee's reports of judicial decisions that are selected for reporting by Licensee in [Licensee Product(s)/Service(s)] and coordinated and arranged by Licensee within [Licensee Product(s)/Service(s)]."

License Agreement Form, In the Matter of U.S. et al. v. Thomson Company and West Publishing Company (Docket No. 96-1415), http://www.usdoj.gov/atr/cases/Thomson/thomson.htm//tw_l_agr.wpd.

Moreover, as even the Department of Justice agreed, "Nothing in the consent decree attempts to define the 'commercial reasonableness' of the rates." In the Matter of U.S. et al. v. Thomson Company and West Publishing Company, (Plaintiffs' Reply To HyperLaw, Inc.'s Amicus Curiae Brief, at 16-17, http://www.usdoj.gov/atr/cases/Thomson/thomson.htm/tw_r_brf.wpd)

It is even more outrageous for West to maintain that somehow there is no hardship to the bar. It appears that even a party only wishing to file a CD-ROM hypertext brief with a court will be required to enter into this license agreement with West, and even then it appears that the license will extend only to the court and parties (apparently the licence will not extend to members of the press, public, or a competing publisher seeking a copy of the contents of a federal court file.

This was the situation, as reflected in a recent order of the Federal Circuit in Yukiyo Ltd. v. Watanabe, No. 97-115 (Fed. Cir. April 15, 1997):

The CD-ROM brief filed in this case contains an electronic copy of Yukiyo's paper brief that, like the paper brief, includes citations to relevant law and matters contained in the record. Viewed page for page, the CD-ROM brief mirrors the paper filing. In addition to the conventional citations contained in both types of briefs, the CD-ROM brief also includes hyperlinks within the text of the brief that connect to hypertext, i.e., to the text of the items that are referenced. The hypertext consists of published cases, statutes, rules, and items that are normally contained in the joint appendix, such as trial transcripts, district court orders, and jury instructions. A videotape that was in evidence in the district court is also included in the hypertext. Before including the published cases in the CD-ROM brief, Yukiyo states that it obtained a license from West Publishing Company that covers any material

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G. Balancing The Factors Favors HyperLaw

All factors but one weigh decisively in HyperLaw's favor and that factor has been excluded from consideration by West's own strategic election. "Because this is not a mechanical determination, a party need not 'shut-out' her opponent on the . . . factor totally to prevail." Wright v. Warner Books, Inc., 953 F.2d 731, 740 (2d Cir. 1991) (affirming holding of fair use on summary judgment, notwithstanding that one factor favored copyright owner). "Nor may the four statutory factors be treated in isolation, one from another. All are to be explored, and the results weighed together, in light of the purposes of copyright." Campbell, 114 S. Ct. at 1170-71. Under the circumstances here presented, HyperLaw should prevail on the issue of the fair use doctrine.

CONCLUSION

For the foregoing reasons, the Court should find that:

1. The district court correctly determined that West's pagination in its Supreme Court Reporter and Federal Reporter Series does not embody any original creation of West;
2. The district court correctly found that there is no original creation by West in the number of lines on a page in a

⁴³

(...continued)
the West version of the cases may contain that may be subject to copyright protection. According to Yukiyo, the license it obtained extends to Watanabe and the court. [Emphasis added.]

case, in the number of pages in a case, nor is there any original creation embodied in where and on what particular pages the text of court opinions appear, with regard to its Supreme Court Reporter and Federal Reporter Series;

3. Even if this Court determines that star pagination is an expression of West's selection and arrangement, such selection and arrangement of cases in its Supreme Court Reporter and Federal Reporter Series lacks sufficient originality to warrant compilation copyright protection;


4. Even if this Court determines that West's selection and arrangement of cases in its Supreme Court Reporter and Federal Reporter Series have sufficient originality to warrant compilation copyright protection, HyperLaw's intended use of first page citation and star pagination to West's reporters does not constitute copying of West's selection and arrangement.

5. Even if this Court determines that HyperLaw's intended use of first page citation and star pagination to West's reporters constitutes copying of West's selection and arrangement, and that such selection and arrangement has sufficient originality to warrant compilation copyright protection, HyperLaw's intended use of first page citation and star pagination to West's reporters is a fair use.

Dated: Douglaston, New York
July 11, 1997

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CERTIFICATE OF SERVICE

I hereby certify that on July 14, 1997 I served 2 copies of this BRIEF FOR INTERVENOR-PLAINTIFF-APPELLEE HyperLaw, by first class mail, upon:

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