No. 98-1500

In The

Supreme Court of the United States

October Term, 1998

WEST PUBLISHING CO. and
WEST PUBLISHING CORPORATION,

Petitioners,

v.

MATTHEW BENDER & COMPANY, INC.
and HYPERLAW, INC.,

Respondents.

**On Petition For Writ Of Certiorari
To The United States Court Of Appeals
For The Second Circuit**

BRIEF IN OPPOSITION

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STATEMENT OF THE CASE

On June 21, 1996, at an evidentiary hearing before the District Court (Martin, J.) on West's motion to dismiss HyperLaw's complaint, HyperLaw demonstrated its case law product, showing that its Second Quarter 1996 CD-ROM contained over 36,000 appellate opinions, of which *only* approximately 22,000 were also published by West – 14,000 were not published by West. Thus, it was shown at that hearing that for any given time period covered by HyperLaw's product, HyperLaw reports approximately 63% more decisions than are published by West in the Supreme Court Reporter and the Federal Reporter.

Despite West's grandiose pronouncements about how important these issues are, in the end they are quite simple. HyperLaw seeks to add to its product cross references to page numbers in West's reporters. West simply does not want HyperLaw or anyone to do so. (Of course, West's copyrights on its digests and key number aides remains unaffected by the judgment herein.)

Thus, this case is not, as West suggests, a "brink of a new millennium" case. It is a simple and obvious application of *Feist Publications, Inc. v. Rural Telephone Service Co.*, 499 U.S. 340, 111 S. Ct. 1282, 113 L. Ed. 2d 358 (1991). West seeks to make cross referencing to page numbers in a copyrighted compilations a protected right.

The Second Circuit's ruling does not give a "free pass" to infringers of copyrighted compilations. On the contrary, this case (and the companion case on text) are not really about compilations, they are about the copying of and reference to the text of an opinion written by a *federal judge*. The two cases taken together are simply

attempts by West to expropriate public documents by either the insertion of minuscule and rote changes or by stopping cross references to those cases.[1] This is the exact issue that Congress addressed when it re-wrote the Copyright Act in 1976.[2] H.R. Rep. No. 94-1476, 94th Cong., 2d

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[1] It is important to remember that the Trial Court made a factual finding with regard to West's intent: "[T]he underlying equities here lie with allowing use of star pagination . . . What West is attempting to do by trying to inhibit star pagination is to create a monopoly over reported court decisions." *Summary Judgment Decision* at 36.

[2] In 1976, Congress revised the Copyright Act. Section 105 states, "Copyright protection under this title is not available for any work of the United States Government." Congress also included § 403, to ensure that § 105 would have meaning when works of the federal government were re-published by private publishers. Section 403 states,

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

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 U.C.L.A. Law Rev. 1232.

West misstates the facts of the case[3] and the facts regarding a so called "split of authority" between the

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> 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.

[3] Despite West's self-serving statements to the contrary, there is indeed a dispute that West's ordering of reported cases in its Reporter volumes represents an original and copyrighted arrangement. HyperLaw disputed this West assertion both in the District Court and in the Court of Appeals. Both Courts assumed a copyrightable arrangement, *arguendo,* without deciding the issue. Moreover, as HyperLaw demonstrated to the District Court below, and never disputed by West during the hearing, HyperLaw's CD-ROM product is *incapable of displaying West's arrangement.* (West tries to lump HyperLaw's product

Second and Eighth Circuits. The Eighth Circuit's decision was implicitly overruled by this Court in *Feist Publications, Inc. v. Rural Telephone Service Co., supra.* The alleged "split" is between this post-*Feist* decision and a decision which was either implicitly overruled, or so affected by *Feist* that its reasoning is no longer a valid benchmark for a discussion of the issues. There have been no other cases in any other Circuit in the post-*Feist* era which would inform this Court with regard to the opposing views on this issue.

As the record shows, this case is muddled by several unique problems concerning its posture as it comes before the Court. First, there is the situation involving West's relationship, on these exact issues, with the federal judiciary (including this Court). Second, this case is complicated by justiciability concerns arising out of the undisclosed relationship between two of the putative opponents – West and Matthew Bender. (This complication arose after the recent acquisition of Matthew Bender by Reed Elsevier, the parent company of LEXIS. There is an 1988 settlement agreement between West and Mead Data, former owner of LEXIS, which apparently remains binding upon Reed Elsevier, the current owner of both LEXIS and Matthew Bender. Reed Elsevier filed an opposing amicus brief in the companion text case[4], although

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with Bender's to obscure this critical distinction.) Again, since both Courts' decisions were reached without reliance on whether or not HyperLaw's product could or could not display West's arrangement, both courts assumed it without ever deciding the fact.

[4] *West Publishing Co. v. HyperLaw, Inc.*, Docket No. 98-1500.

Matthew Bender has filed a separate action against West challenging West's text claims.) Third, Reed Elsevier and Thomson are joined together in a massive effort to overrule this and the companion text case by database protection legislation.

For all of these reasons, HyperLaw opposes the granting of a Writ of Certiorari.

REASONS FOR DENYING THE WRIT

I. THERE IS NO SPLIT IN AUTHORITY BETWEEN THE COURTS OF APPEALS FOLLOWING THIS COURT'S DECISION IN *FEIST*

In 1991, the Court decided *Feist Publications, Inc. v. Rural Telephone Service Co.*, 499 U.S. 340, 111 S. Ct. 1282, 113 L. Ed. 2d 358 (1991), and clarified the minimal constitutional requirement for copyright. In doing so, it finally disposed of any remaining application of the "sweat of the brow" doctrine. To the extent that the Eighth Circuit applied the "sweat of the brow" doctrine in *West Publishing Co. v. Mead Data Central, Inc.*, 799 F.2d 1219 (8th Cir. 1986), that case was overturned by *Feist*, and cannot serve as the basis for asserting a split in the Circuits.

In *West Publishing*, the Eighth Circuit applied the "sweat of the brow" doctrine, when it stated,

> We conclude, as did the District Court, that the arrangement West produces through this process is the result of considerable labor, talent, and judgment. As discussed above, *supra*, slip

> op. pp. 5-6, to meet intellectual-creation requirements a work need only be the product of a modicum of intellectual labor.

Id. at 1226-1227. Rather than considering the originality featured or expressed in the work itself, the *West Publishing* court considered the labor, talent and judgment expended. *Feist*, to the contrary, instructs us that it is the expressive element in which one must find originality, in order for copyrightability to exist. Moreover, *Feist* tells us that "the constitutional minimum for copyright protection [is that a work] *features* an original selection or arrangement." [Emphasis added.] *Feist*, 499 U.S. at 348.

Thus, whereas *West Publishing* rests its test for copyrightability upon a finding that the efforts of the author involved labor, talent and judgment, *Feist* rests copyrightability on the expression or features of originality in the work itself. This is what distinguishes the *Feist* view of originality from the "sweat of the brow" decision. Moreover, it is clear that the Eighth Circuit misunderstood this distinction. That court's express cite to the authority of a "sweat of the brow" phone directory case reveals its error.

> The names, addresses, and phone numbers in a telephone directory are "facts"; though isolated use of these facts is not copyright infringement, copying each and every listing is an infringement. *See Hutchinson Telephone Co. v. Fronteer Directory*, 770 F.2d 128 (8th Cir. 1985).

799 F.2d at 1228.

In addition, the Eighth Circuit applied the wrong test for infringement. In *West Publishing*, which also involved the insertion of star pagination into electronic databases

of cases, Mead Data did not feature its cases with the same selection or arrangement as West. Yet the Eighth Circuit found that the mere insertion of star pagination could constitute infringement.

> Jump cites to West volumes within a case on LEXIS are infringing because they *enable* LEXIS users *to discern* the precise location in West's arrangement of the portion of the opinion being viewed. [Emphasis added.]

Id. at 1227. As West invites this Court to do here, the Eighth Circuit found infringement from mere enabling of users to discern – contrary to the instructions of *Feist* and *Sony Corp. of Amer. v. Universal City Studios, Inc.*, 464 U.S. 417, 104 S. Ct. 774, 78 L. Ed. 2d 574 (1984). *Feist* expressed the rule that,

> Notwithstanding a valid copyright, a subsequent compiler remains free to use the facts contained in another's publication to aid in preparing a competing work, *so long as the competing work does not feature the same selection and arrangement.* [Emphasis added.]

499 U.S. at 349.

West correctly points out that a myriad of legal scholars, analyzing the effect of *Feist* on *West Publishing* have determined that *West Publishing* was overruled by *Feist*.[5] Indeed, in *Feist* the Court cited with approval,

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[5] Indeed, West's own counsel, Arthur Miller, was one such scholar – until he was retained by West to argue this appeal before the Second Circuit and in this Petition. *See* Arthur R. Miller, Copyright Protection for Computer-Generated Works: Is Anything New Since Contu?, 106 Harv. L. Rev. at 1040 (fn. 284)

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), which severely criticized West Publishing. West appears to have been reluctant to revisit this issue in the Eighth Circuit since *Feist*. *Oasis Publishing Co., Inc. v. West Publishing Co.*, 924 F. Supp. 918 (D. Minn. 1996) was on appeal to the Eighth Circuit, fully briefed, argued and *sub judice*. At the 11th hour, West settled that case, the appeal was dismissed, and the Eighth Circuit was prevented from revisiting *West Publishing Co.*

West argues that the existence of a split in authority between the Circuits is evidenced by the Second Circuit's statement that, "We differ with the Eighth Circuit's opinion in *West Publishing Co. v. Mead Data Central, Inc.*" *Matthew Bender & Company, Inc. v. West Publishing Co.*, 158 F.3d 693, 707 (2d Cir. 1998). This is pure deception – all one has to do is continue reading to see that West is simply being "clever". West intentionally omits that *the Second Circuit explained that its difference with the Eighth Circuit was based on Feist.*

> At bottom, *West Publishing Co.* rests upon the now defunct "sweat of the brow" doctrine. . . . Thus, the Eighth Circuit in *West Publishing Co.* erroneously protected West's industrious collection rather than its original creation. Because *Feist* undermines the reasoning of West Publishing Co., *see United States v. Thomson Corp.*, 949

("*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.")

F. Supp. 907, 926 (D.D.C. 1996) we decline to follow it.

There is presently no split in authority between the Circuits regarding this issue. Either *Feist* overruled *West Publishing*, as the Second Circuit found, or *Feist's* clarification of the minimum constitutional requirement for copyrightability has yet to be applied by any other Circuit in such a "pagination case" – so that no "split" currently exists.

II. THE COURT SHOULD NOT USE THIS CASE TO RESOLVE ISSUES REGARDING THE COPYRIGHTABILITY OF COMPILATIONS OF FEDERAL JUDICIAL DECISIONS, BECAUSE OF WEST'S IMPROPER ATTEMPTS TO INFLUENCE THE FEDERAL JUDICIARY, INCLUDING JUSTICES OF THE SUPREME COURT.

In 1995, HyperLaw's counsel wrote a series of letters to United States District Judge Preska, the initial judge below, with regard to West's attempts to influence that and other courts on the issues presented here. That correspondence culminated in a letter to Judge Preska dated March 8, 1995, which Judge Preska responded to (and included) in a Memorandum and Order dated March 15, 1995. *Matthew Bender & Company, Inc. v. West Publishing Company*, 1995 U.S. Dist. LEXIS 3280 (S.D. N.Y. 1995).[6] Judge Preska recused herself thereafter.

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[6] Attached to Judge Preska's decision, as it is published by LEXIS, are a series of major newspaper articles and West's responses thereto. Included are articles from the Minneapolis Star Tribune of March 5 and 6, 1995 which uncovered documents proving that even while its matters were before

There are many allegations of record regarding West's attempts to influence members of the judiciary who are hearing cases in which it is a party – including the instant case. HyperLaw sought a writ of mandamus on this matter from the Second Circuit, but was never allowed to conduct discovery with regard to West's improper attempts at influencing the federal judiciary. Although HyperLaw's petition for a writ of mandamus was denied, Judge Preska removed herself from the case shortly thereafter. Since it was denied discovery in this area, HyperLaw cannot now confirm or definitively state that any member of the federal judiciary was, in fact, improperly influenced – but it remains an issue for which preliminary proceedings before this Court may be appropriate, in order to resolve possible conflicts.

The Star Tribune articles mentioned sitting and former Justices of the Supreme Court as recipients of West trips and gifts in the same time frame as matters of interest to West were before the Court. While it may not be improper for a federal judge to accept such travel and gifts from West, it was certainly unseemly for West to give them, and a serious error not to so inform the courts sitting on its live controversies. The articles also mention an appeal before the Fifth Circuit in which West was a party while also awarding its Devitt Award to a member of the panel hearing the appeal. West failed to disclose

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courts, West gave federal judges, including Supreme Court Justices, lavish trips and gifts. The articles included references to the failure by federal judges to properly report such gifts – and detailed an extensive effort by West to effect decisions on its copyright issues.

that situation. (In a parallel antitrust proceeding related to the acquisition of West by Thomson and involving the impact of the merger upon the market for authors seeking publication of legal treatises, *United States v. Thomson Corp.*, 949 F. Supp. 907 (D.D.C. 1996), a federal district judge recused himself only after HyperLaw wrote, inquiring as to the publishing contracts between the judge and Thomson. The judge then disclosed that he had publishing contracts with West, as well.)

It is impossible to tell whether there are similar concerns in the instant Petition – and West cannot be trusted, based on its record, to inform the Court and the parties in this regard. Because this case is not in a posture which would allow determination of the substantive issues without such distractions, the Court should exercise its discretion and decline to issue a Writ of Certiorari.

III. THE RELATIONSHIP BETWEEN THE CURRENT OWNER OF MATTHEW BENDER & COMPANY AND WEST SUGGESTS THE POSSIBLE ABSENCE OF AN ACTUAL CASE OR CONTROVERSY BETWEEN MATTHEW BENDER AND WEST (THOMSON).

When this case was before the District Court, Matthew Bender & Co. was owned by Times Mirror. After West appealed this case to the Second Circuit, Matthew Bender was sold to Reed Elsevier. Previously, Reed Elsevier had acquired LEXIS from Mead Data Central, Inc. It is beyond dispute that there exists a contractual relationship between LEXIS (Reed Elsevier) and West (Thomson) which affects the ability of Reed Elsevier to

challenge West copyright claims. This relationship suggests that the instant Petition may not involve an actual case or controversy between West and Matthew Bender.

In 1988, following the Eighth Circuit's decision in *West Publishing Co. v. Mead Data Central, Inc., supra,* and following a trial in the district court but before judgment, West and Mead Data entered into a confidential settlement agreement disposing of the litigation issues between them. (According to the district court docket in *West Publishing,* there were actually two agreements – one concerning case law and the other concerning statutes). These agreements have since controlled the relationship between West and LEXIS (and the companies that own them) relating to citations and perhaps text. That settlement agreement was sealed and allegedly (but actually not) placed into the district court's record (District of Minnesota).

In the instant case, both HyperLaw and Matthew Bender, prior to its acquisition by Reed Elsevier (which, as a successor, has become a party to such agreement), attempted to discover the contents of that confidential agreement during discovery in the District Court, but that discovery was denied by Judge Preska before she recused herself. On information and belief, those two agreements and subsequent amendments thereto provide, *inter alia,* for West to grant a star pagination license to LEXIS (Mead Data and its successors), and restrict how or whether LEXIS (Mead Data) may contest any of West's assertions of pagination copyright claims.

HyperLaw also has reason to believe that these agreements apply to related entities of the parties – and provide that all terms of the agreement would survive the

sale or transfer of LEXIS or West to other entities, and be binding on their successors and assigns and companies owned or controlled by their successors and assigns. HyperLaw was denied discovery with regard to those facts, and neither West, Mead Data, LEXIS, Thomson, Reed Elsevier, or now Matthew Bender has voluntarily disclosed those facts, as they should – other than to make reference to the existence and amendment of them.

The existence of other circumstances support HyperLaw's beliefs. Reed Elsevier filed an amicus curiae brief in support of West's position in the related text appeal to the Second Circuit (*Matthew Bender & Company, Inc. v. West Publishing Co.*, 158 F.3d 674 (2d Cir. 1998)). In that same appeal, Matthew Bender originally agreed with HyperLaw that it would file an amicus curiae brief supporting HyperLaw's position, and had actually shown drafts of that brief to HyperLaw. But contemporaneously, Matthew Bender's then owner, Times Mirror, was in the process of selling Matthew Bender to Reed Elsevier (which had already submitted its opposing amicus brief). On the eve of the due date of its amicus brief, Matthew Bender informed HyperLaw that it would not be filing it. Thereafter Matthew Bender disclosed that it had been sold to Reed Elsevier.[7] The obvious question raised by

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[7] Additionally, Matthew Bender had filed a motion for attorneys fees in the District Court in December 1996, seeking over one million dollars for its successful prosecution of its pagination copyright declaratory judgment against West. After the Second Circuit's decision affirming that judgment, and after Matthew Bender had been acquired by Reed Elsevier, West and Matthew Bender notified the District Court that they had settled the matter of Matthew Bender's attorneys fees, and Matthew Bender was withdrawing its motion. Neither Matthew Bender

Reed Elsevier's acquisition of Matthew Bender is whether Matthew Bender must now modify its position on the copyrightability of pagination as a consequence of its new owner being a party to a settlement agreement that resolved these same issues as between West and LEXIS (Matthew Bender's now sister company). In light of these and other circumstantial facts, there is certainly an inference that West and Matthew Bender have reached at least a partial resolution of the issues in the instant Petition, without disclosing it to the Court or the courts below.

Decisions of this Court over its history have firmly established the rule that federal courts will not entertain friendly suits, or those which are feigned or collusive in nature. *Flast v. Cohen*, 392 U.S. 83, 88 S. Ct. 1942, 20 L. Ed. 2d 947 (1968); *Chicago & Grand Trunk R. Co. v. Wellman*, 143 U.S. 339 (1892); *United States v. Johnson*, 319 U.S. 302 (1943). It is unlikely that the parties will voluntarily provide a copy of their original agreement (with the subsequent amendments) and related agreements to this Court. But the circumstantial evidence does beg for further explanation and disclosure by West and Matthew Bender[8] before the Court considers granting the Writ. In any event, in light of the unclear relationship between West and Matthew Bender, (and in light of the fact that

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nor West provided the District Court or HyperLaw with the terms of that settlement or the consideration for Matthew Bender to withdraw a motion for over one million dollars in attorneys fees, and neither would even tell HyperLaw if the settlement included any cash payment at all.

[8] HyperLaw has entered into no settlement agreements with West or Matthew Bender, or any of its parent or related companies. Accordingly, this is not a friendly or collusive suit as between HyperLaw and the other parties.

their parents have obtained an almost complete monopoly in the industry) this Petition would not present the best case for the Court's consideration of the important copyright issues decided below.

CONCLUSION

For the foregoing reasons, HyperLaw respectfully requests that a Writ of Certiorari to the United States Court of Appeals for the Second Circuit be denied.

Respectfully submitted,

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