

97-7910

To be argued by:
CARL J. HARTMANN, III

**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.

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ISSUES PRESENTED FOR REVIEW

1. Did the district court correctly hold that the changes made to the text of judicial opinions of federal judges by West¹ in its *Supreme Court Reporter* and *Federal Reporter Series*, do not represent a sufficient creative effort to warrant copyright protection, either singly or in combination, as elements of a derivative work, a compilation, or otherwise.

2. Did the district court correctly determine that the changes West makes to the actual text written by federal justices and judges which appear in its *Supreme Court Reporter* and *Federal Reporter Series* (excepting synopses, syllabi, headnotes and key numbers) lack the requisite creativity or originality to qualify for copyright protection--both individually and collectively?

3. Does text of judicial decisions by justices of the United States Supreme Court and judges of the Federal Courts of Appeals qualify for copyright protection, even if West has made relatively few changes to such text that are determined to be original?

4. Even if this Court determines that some or all types of changes that West makes to the text of judicial decisions may qualify for copyright protection, and the Court further determines that a copyright can exist on the actual text obtained from a governmental source, does Section 403 of the Copyright Act render all West federal case reporters published between the effective

The district court's holding and judgement do not involve the syllabi, synopses, headnotes, and key numbers within West's reporters. Those items were not before the court in this cause.

date of the Copyright Act of 1976 (January 1, 1978) and the effective date of the Berne Convention Implementation Act (March 1, 1989) uncopyrighted and in the public domain?

STANDARD OF REVIEW

The facts of this case were contested at trial.² In addition, the credibility of the witnesses was in issue. Following a two day bench trial on January 27 and 28, 1997, the district court made detailed findings of fact in its Memorandum and Order dated May 19, 1997. Pursuant to Fed. R. Civ. P. 52(a), although appellate review of review issues of law is de novo, a district court's findings of fact, whether based on oral or documentary evidence, cannot be set aside unless clearly erroneous. U.S. v. McCombs, 30 F.3d 310 (2d Cir. 1994).

STATEMENT OF THE CASE

I. The Nature of the Case

Beginning in 1992, HyperLaw attempted to copy the text of opinions written by federal courts, as published in West reporters. Initially, HyperLaw sought to copy very few cases. HyperLaw was threatened by West, in writing, if it copied any cases.

In March 1994, HyperLaw was allowed to intervene in the instant action to assert a claim for declaratory judgment regarding West's claims of copyright in the text of judicial decisions in its

² West opposed a determination of the "text" issues on summary judgment, stating that a trial was necessary because "the facts are highly contested in sworn affidavits." Summary Judgment Hearing Transcript, November 22, 1996 at 26 (A. 408).

*Supreme Court Reporter and Federal Reporter Series*³.

The gravamen of HyperLaw's complaint⁴ is that West has no copyright in the text of opinions⁵ written solely by federal judges⁶, because there can be no copyright on federal works, and because West's changes: (1) lacked originality, (2) were part of a process or mechanical system, (3) were trivial and created no distinguishable variation and (4) could simply be redacted before copying if discernable. Accordingly, HyperLaw's complaint claimed that HyperLaw was entitled to copy factual information such as the names of lawyers and the text of judicial opinions; and add them to HyperLaw's existing product.

West originally asserted copyright claims over its spelling corrections, punctuation changes, insertion of parallel citations, and the stylizing of captions, parties' names and judges' names.⁷

³ Originally, when Congress was looking into West's efforts to monopolize judicial decisions, West told Congress that this was a matter for the courts to decide. When it became clear that West was actually being challenged in Court, West began to maintain that this was a matter for legislation, not courts. See fn 37, infra.

⁴ HyperLaw's Intervenor Complaint, with Exhibits (A. 48-201)

⁵ The copyrightability of West's syllabi, synopses, headnotes, and key numbers were not before the court. HyperLaw has always stated it would redact those elements before copying.

⁶ HyperLaw also sought a declaratory judgment that West had no copyright in the first page and internal page citations to cases in its *Supreme Court Reporter and Federal Reporter Series*. That issue was decided in HyperLaw's favor, below, and is now pending before this Court in No. 97-7430.

⁷ West maintained below that its typographical, spelling, punctuation, and other corrections to judicial text warranted copyright protection as an "editorial enhancement." Apparently recognizing the specious nature of such a position, West has
(continued...)

West now seems to have abandoned many of those claims.

In August 1994 West moved to dismiss HyperLaw's complaint, arguing: (1) HyperLaw had failed to establish a reasonable apprehension of litigation, and (2) HyperLaw lacked the immediate ability to produce the infringing product. West's motion was preceded by extensive discovery--and the district court even, thereafter, allowed West supplemental discovery⁸ and briefing.

On June 21, 1996 Judge Martin held an evidentiary hearing on West's motion to dismiss for lack of justiciability. In its briefs, West had argued that HyperLaw had no product and was unable to create one. At the hearing, the court and West were provided with HyperLaw's existing CD-ROM product, which was fully functional and contained working examples of the simple modifications necessary to make the enhancements to the product.⁹ The district court viewed a step-by-step demonstration, considered statistical and other documentary evidence, and heard extensive testimony by HyperLaw.¹⁰ What the district court did not hear was any

(...continued)

dropped that argument on appeal.

⁸ As part of extensive discovery prior to the June 1996 hearing, West not only deposed all of HyperLaw's employees, it deposed HyperLaw's president for four days. West was also given each successive release of HyperLaw's product over several years.

⁹ This CD-ROM demonstrated how the product would be produced, its contents, its look and feel, and how it would function. The additional matter obtained from West reporters was inserted in the manner and by the means HyperLaw consistently stated it would use.

¹⁰ HyperLaw's president also demonstrated and testified regarding a product which had been ready for sale before West's threats. HyperLaw had requested permission to use for reference the text of just a few hundred redacted cases from West. That request, to use
(continued...)

contradictory evidence from West--not one witness¹¹ and not one document. West's current re-hash of its earlier failed argument--that HyperLaw's product lacked definition--is similarly contradicted by the record.)¹²

On August 2, 1996, the trial court entered its Memorandum Opinion and Order regarding justiciability--denying West's motion to dismiss, finding that, "HyperLaw intended and was able to add the West features listed in the complaint to its CD-ROM product at the time that it filed the complaint. . . .HyperLaw has also demonstrated that it has the ability to insert the West features immediately in its CD-ROM product¹³. . ." Mem. Op.1 at 2 (A. 378). Accordingly, the court concluded that "HyperLaw ha[d] met its

¹⁰ (...continued)
relatively few cases, was met with West's initial threats.

¹¹ West's only witness, James Schatz, testified regarding HyperLaw's "apprehension," but the court rejected the substance of his testimony. Rather, the court accepted Alan Sugarman's (HyperLaw's president) testimony on the matter. West produced no other witnesses. Memorandum Opinion dated August 2, 1996 (hereafter "Mem. Op.1") at fn. 3(A. 381).

¹² West couples its latest attempt with it's incredible assertion that this case should be deemed moot. After more than 3 years of fierce litigation, West hopes to escape the inevitable loss of its legal monopoly by saying that it never objected to copying, even by its competitors, of less than "wholesale copying." (See, West Brief at fn 2.) This is pure fiction. HyperLaw's disputes with West began when West refused permission for HyperLaw to copy just the judicial text of a few hundred cases for an earlier product. (See HyperLaw's Complaint and the Exhibits thereto. A. 48-201)

¹³ The trial court correctly found that HyperLaw was not proposing some new or significantly changed product. All that was being proposed was to add a simply defined set of additional material to a product which had been in production on a quarterly basis for years. HyperLaw repeatedly and consistently described which material it would collect, how it would be collected, and how it would be added to the existing product.

burden of proving justiciability by a preponderance of the evidence" Id. at 5 (A.381), and denied West's motion to dismiss.

On November 22, 1996, the court heard argument on motions for summary judgment regarding first page and internal citations, as well as text. The court determined that West's first page and internal citations could not be copyrighted. Although the text issue was also before the court in HyperLaw's motion for summary judgment, at oral argument West strongly maintained that a trial was necessary on text because the issue involved highly contested facts.¹⁴ Accordingly, a trial was held on January 27 and 28, 1997. Despite attempts by West's sole witness, Donna Bergsgaard, to imbue the sweat of West's brow with creativity, the lower court found that those labors resulted in changes to the judicial opinions that "are trivial indeed."¹⁵ Applying Feist Publications v. Rural Telephone Service Co., 499 U.S. 340, 111 S. Ct. 1282 (1991) and decisions of this Court, Judge Martin made factual findings regarding each of the types of changes claimed by West, as well as the totality of such changes.

In sum, each of the changes that West makes to the cases it reports are trivial and, taken separately or collectively, they do not result in "a distinguishable variation" of the opinion written by the court. Waldman Publishing Corp. v. Landoll, Inc., 43 F.3d 775, 782 (1994).

Mem. Op. at 11 (A. 504).

II. The Evidence at Trial

¹⁴ See footnote 2, supra.

¹⁵ Memorandum and Opinion (hereafter "Mem. Op.") dated May 19, 1997 at 6 (A. 499).

At trial West called a single witness, Donna Bergsgaard, the manager of West's manuscript department (Tr. at 12). In discovery, Ms. Bergsgaard had been proffered as West's primary representative to explain and justify its copyright claims. The record reveals that Ms. Bergsgaard is an attorney skillfully trained and practiced as a professional witness. For a decade she has repeatedly performed this function in trials, hearings and legislative proceedings, including the West v. Mead Data litigation in the mid-80's. However, even Ms. Bergsgaard had to concede that what West sells, and what it clearly represents that it sells, are true renditions of federal court opinions.¹⁶ She admitted that the portion of the West report which is the actual text written by a judge is, above all else, accurate. Her testimony was that West's "intent is to make a very accurate report". Tr. at 35. Changes of punctuation and spelling, or the mechanical insertion of parallel citations is not, nor has it ever been intended to be (or held out to be) "authorship"--to the contrary, these efforts are intended to "clean up" the authorship of federal judges, and to simply record "alias" citations to cases already cited by those judges.

Having conceded this dispositive point, Ms. Bergsgaard then tried backpedal, to assert that West does "quite a bit of changing, adding, modifying and deleting information from the slip opinion

¹⁶ West receives court decisions--works of the federal government--from the Court--and frequently receives them free of charge. See Plaintiff's Exhibit 23 (E 1154), a November 22, 1995 letter from the Clerk for the Fifth Circuit, stating that 7 cases requested by HyperLaw, which West received free of charge, would cost HyperLaw \$35.00. Thus HyperLaw's expense for obtaining cases West obtains for free would amount to a prohibitive amount.

[of United States Supreme Court decisions] to create [its] case report." Tr. At 15. However, the record is clear, HyperLaw is not interested in West's "case report", just the decision from the judge and other facts West obtained by copying from the court or other sources. When asked if West authors anything in the U.S. Supreme Court decisions it publishes in its *Supreme Court Reporter*, Ms. Bergsgaard responded only that,

we would be the author of expanding citations. We look at every citation that is in the opinion and we expand upon those citations. We create the caption of the case and indicate how that is going to be cited. (Emphasis added.)

Tr. at 15. When pressed further on this alleged "authorship", Ms. Bergsgaard conceded that,

we don't author [the attorneys names] but we do compile the attorney information and add information to it from other sources."

Tr. at 15-16.⁷⁷ When pressed even further for any allegedly original authorship, Ms. Bergsgaard stated that West might also "look up and add the city names." Id.

Thus, the court heard testimony that West simply copies the text of an opinion from a court (as well as dates, and the names of the attorneys and judges) and then will "physically cut up that sheet and paste the attorneys' names on another sheet." Tr. at 17. (Ms. Bergsgaard also admitted that no reader could tell which of the information West "pasted" together came from the authoring

Those sources were, "for the Supreme Court the attorneys are listed on what the court calls a docket sheet or the order list that lists all of the cases that are going to be argued before the Supreme Court on that particular day. And what we do then is use that as the basis for our attorneys' summary." Tr. at 16.

court or from some other source. The testimony revealed that even West cannot tell by just looking at a case in its *Supreme Court Reporter* whether the names have been changed since they were received from the Supreme Court. Tr. at 19.) The related city and state information is simply "looked up" in other publications, including "Bar Association journals, Bar journals and telephone directories." Id. It is indeed ironic, as Ms. Bergsgaard conceded, that up until just a few years ago this information was copied directly from the product of West's competitor, Martindale-Hubbell, exactly as HyperLaw proposes to copy it from West. Id.)

Then, stretching the position even further, Ms. Bergsgaard tried to fall back to a claim of authorship and creativity in 'capitalization'.

But our capitalization is unique to West and the capitalization to us indicates to our readers what we believe the title of the case will be for citing and the capitalization here would be something that West chose to put in and how we are going to caption this case. . . .in long captions West chooses what will be in capital letters and that will be what the case is going to be.

Tr. at 20.

She also asserted West's claim of authorship in that it "characterizes" the parties because it "uses a compilation of titles". When pressed on the source of the text for these materials Ms. Bergsgaard admitted again that

[t]here is a title that appears on the [Court's] order list. There is a title that appears for the case on the syllabus that comes from the court and one that comes from the slip opinion. They are all slightly different, and we use a compilation of those titles to get the full names of the parties, as well as their position like petitioner or appellant. So it's more of a compilation

of the titling.

Tr. at 22.

Ms. Bergsgaard also admitted that West gets the docket number "from the slip copy"--prepared by the Court and sent to West. Tr. at 23. She then stated that West claims authorship in the fact that its employees "cut and paste it from the slip copy and we style it." Id.

Next, West claimed authorship in the "argued" and "decided" dates which appear in the Supreme Court slip opinion. Ms. Bergsgaard testified that although it is clear that this information appears "on the slip opinion", West is an "author" because "it is not in the exact form" as published by West. As Ms. Bergsgaard testified, authorship is claimed because "West has chosen to publish both the 'argued' and the 'decided' date and we put them in the style and the format with the abbreviations that we have chosen to use." Tr. at 24.

Amazingly, Ms. Bergsgaard testified that West even claims original authorship due to its presentation of the authoring court's own syllabus. Although Ms. Bergsgaard conceded that "[t]he syllabus is prepared by the Reporter of Decisions Office for the Supreme Court and is attached as kind of a front matter to the slip opinion", Tr. at 25, she went on to claim authorship because (she contended) West adds "the footnote to the syllabus, as you see the star from the syllabus dropping down to the footnote. That is not the way it appears in the slip copy". Ms. Bergsgaard did, however, admit that all of the language that appears in its reporter is

taken directly from the Court's syllabus.¹⁸

When asked about the case history contained at the end of the syllabus (i.e.. "916 F.2d 718, see 8/10/1980 reversed"), Ms. Bergsgaard conceded that

generally the Court Report of Decisions included that as the lower court reference. . . . [West] will add parallels to that and check that cite but generally that is coming right on the copy.

Tr. at 27.

Next, Ms. Bergsgaard testified that there is original authorship in the name of the judge delivering the opinion.

¹⁸ Ms. Bergsgaard testified as follows:

Q. So the phrase "The syllabus constitutes no part of the opinion of the court" doesn't appear on the Supreme Court version?

A. That does but you asked me whether it was verbatim.
THE COURT: What has been changed?

THE WITNESS: We have deleted a sentence and we have also added parallel citations to that cite. We expanded the citation.

Q. Except for the citation is the language there taken out of the Supreme Court docket?

A. Yes, after we have modified and added, expanded it, yes.

Q. Now, the actual syllabus itself, the text that occurs in the syllabus, are there any changes made to that by West?

A. Yes.

Q. What would that be please?

A. Well, we add the cross references. If you notice on page 1285 under the word held we have added pages 1287 to 1297 so our readers will be able to find the holding of the court, and we have done that throughout the syllabus. We also verify the syllabus for the citations and we would add any parallel citations to that as we determined to.

Q. Does West do anything else to the syllabus of the opinion?

A. No, I think that is probably all we do to it.

[Emphasis added.] Tr. at 26-27.

Conceding that this information was also listed on the slip opinion, Ms. Bergsgaard claimed authorship because "[West] do[es] style it" into [West's] own style with abbreviations and the capitalization. Tr. at 28. She described the following, literal "cut and paste".

In the listing in the Supreme Court they have their judges listed in a couple of different places. It is [West's] style to indicate that the Chief Judge is a capital C period, capital J period always listed first, and the other judges have the abbreviation JJ after them. The way that West does this is that they receive a document from the court and they physically cut it out and they paste it onto their own copy sheet.

Tr. at 28-29. West does not add names of judges or take any judges names out. Tr. at 29.

Many of West's expansive assertions of authorship, fiercely asserted below, have not appeared in its brief to this Court. Still, West continues to claim its authorship because it,

checks every citation. . .and [has] added or chosen to add in and expand the court cite with parallel citations to the Supreme Court Reporter and the Lawyers Co-op Edition."

Tr. at 30-31. Thus, West's remaining claim of originality is predicated on Ms. Bergsgaard's testimony that West: (1) receives and inserts official corrections from the Court (see Plaintiff's Exhibit 39 (E. 1164)), checks statute citations and changes them, or calls the court and notifies them of a possibly needed correction. Tr. at 31, and (2) "[a]lternative citations would be something where the court had used a slip opinion number and [West] would have deleted that and added in a citation of a case. So there might be an alternative cite [replaced by West]." Tr. at 31.

It may be that the judge has a volume and a page number doesn't go at all with the title and we read both opinions and it's clear to us that the court is missing a line. Maybe the court intended to cite both cases. And then we would contact the court out of a matter of professional courtesy.

Tr. at 34-35.

First, West maintains that it, not the judge, authors these 'changes'. Ms. Bergsgaard testified that when West calls the Court in such a situation, the Court sometimes tells West that it is okay to make the change, but there are also times when Courts tell West not to make the change. Tr. at 35. Ms. Bergsgaard could not "recall a situation" where West nevertheless made the change. For, as she testified, "[West's] intent is to make a very accurate report." Id. West argues that this is not a case of the judge making a change--rather it is West, as an author, making the change; and solely as a "professional courtesy" West informs the court of West's original authorship.

Second, as to parallel citations to Supreme Court cases, Ms. Bergsgaard (a lawyer who has headed this department at West for many years²⁹) when asked by the court, at 31-32, if such parallel citation of Supreme Court cases "is that [which is] also called for in the uniform system of citations that are generally used lawyers, those two parallel cites?", Ms. Bergsgaard responded, "In the blue book, your Honor, I don't know." She testified that it was creative because West "chose" to use the same citation form used by everyone.

Tr. at 12 and 39.

West's most absurd claim is that it is an "author" of parallel citations because "when the court is referring to a particular point at 471 U.S. at 556, West would insert where that same text can be found in the Supreme Court Reporter." Tr. at 32. As part of this "original" editorial decision, Ms. Bergsgaard testified that West systematically removes the Court's citations to its competitor's product--unless that is the "only source or LEXIS is referring to something that there was no other parallel cite." Tr. at 34.

Finally, West claims authorship in "situations where there are dissents that come in on separate slip opinions which we then combined with the opinion, and the reverse happens in the Supreme Court where we choose to publish them separately if they go to two or more cases. . . .So there is combination of putting the 'concurrs' and 'dissents' together." Tr. at 36.²⁰ Although "it's fairly rare. . .there are occasionally rehearings in the Supreme Court and we would add information as a file line. . .that information would come on the order list from the court."

Nonetheless, Ms. Bergsgaard admitted (Tr. at 38) that it does nothing different to the text of concurrences and dissents.

Q. . . .You said that you might reorder where concurrences or dissents came. Did you say that?

THE COURT: She said they might where they have dissent or concurrence that applies in two cases.

Q. If that occurs, do you ever change the text the concurrence or the dissent?

A. I am not sure I understand what text means.

THE COURT: You do the same type of thing you do to any opinion, I take it.

THE WITNESS: Yes.

THE COURT: But nothing more or less.

THE WITNESS: That is correct.

[Emphasis added.] Tr. at 36. As Mr. Sugarman testified, HyperLaw had not originally specified it would copy these lines (and can redact them as easily as it does the headnotes), but it did state that it would copy anything that was not the original authorship of West, and both discovery and trial testimony have revealed that these lines, too, are nothing but facts obtained from courts.

The same methods and practices West uses in *Supreme Court Reporter* are used for *Federal Reporter*--with very few real differences. First, West admits that with respect to the *Federal Reporter*, for each circuit West publishes everything that courts put out as opinions.²¹ See also Plaintiff's Exhibit 27 (E. 1156), a letter from West Publishing's Managing Editor to a Professor at the University of Maryland School of Law, stating that:

We rely completely on the determination of the United States Courts of Appeals as to which of their opinions are to be published. That is to say we publish only

²¹ This was in response to a court inquiry (Tr. at 238-239):

THE COURT: Let me just ask you this: I'm 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 unpubs, but there's many different orders that aren't labeled, either one, and West makes the decision as to 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. [Emphasis added.]

those opinions which they, pursuant to their various publication plans, select for publication. Over the years we have always followed the wishes of the Courts as to publication. [Emphasis added.]

Moreover, although West attempts to describe its minor changes as authorship, arrangement or compilation, Ms. Bergsgaard admitted that such changes are made pursuant to a "style that we have set up has been existence for more than the 20 years that [she has] been there." Tr. at 65.²²

As was the case in the Supreme Court Reporter, for names, court, docket numbers, date lines and attorney names West merely cuts information out of other text and pastes it into West's text.²³

²² Ms. Bergsgaard testified,

Q. And when you say it's been in effect for 20 years, so West always does it that way and they always follow that basic rule, is that correct?

A. Well, I wouldn't characterize it that way. We make editorial judgments as to the best format for a particular case report and we want to be consistent and we will consistently organize the material in the order that our editors deem is most usable to our readers.

Q. I understand that, ma'am. I guess what I am asking is you just said for 20 years you have been putting it in the same place. I guess what I am asking is, is that pursuant to some sort of an internal style manual or a rule or a system that you use?

A. That is the style that our editorial department has set up and determined that that was the most or the best location for people to locate the attorneys is right after the editorial work.

Q. That has been in place, as far as you know, for at least 20 years?

A. Yes.

[Emphasis added.] Tr. at 66. See also Tr. at 77-78.

²³ Ms. Bergsgaard testified:

Q. For the information we talked about, the names of the parties, the name of the court and the date lines, is
(continued...)

With regard to the names of the parties in *Federal Reporter* these minor changes are made based on a set formula. "West would receive the slip opinion and we would again characterize the parties. . . . [West doesn't] cap the first name or his title. . . . In some instances if the title is very long [West] may shorten it with an 'et al.'" Tr. at 47. Ms. Bergsgaard thought that she recalled "one case where [West] put the titles into an appendix or put them into a footnote" because there were "many, many titles." Id. "In some instances [West] will delete duplicate names from a title." Id. In any case, West gets the names of the parties from "the slip opinions. . . from the court," (Tr. at 48) although in some circuits, such as the District of Columbia Circuit, West "happens to be the slip printer" (Id.) and creates that slip opinion for the court.

West is also the slip printer in the Fifth and Eleventh

(...continued)

the way that West does this is they take the copy from court, cut it up and actually paste it onto their documents?

A. Yes, we do rearrange it. We take it from --

THE COURT: But it is a cut-and-paste job?

THE WITNESS: That part of it is. The reorganization is a cut-and-paste job, yes, your Honor.

Tr. at 55.

Q. . . . I am asking is material physically cut out of the document you get from the court and pasted down?

A. We do. We have to merge it so it is in the that we have determined editorially where we want it to be placed.

THE COURT: The question is is that done by cutting and pasting?

THE WITNESS: Yes, it is.

Tr. at 68-69.

Circuits, and there, "[West does] style the caption according to the West style and that becomes part of contract."²⁴ Id.²⁵ Moreover, at the bottom of the Fifth and Eleventh Circuit slip opinions from the courts (but printed by West), a copyright notice states that West claims a copyright in the syllabi and the headnotes but not in the names of the parties or parallel citations. Tr. at 49.²⁶ See also West's examination of Alan Sugarman on this issue.

Q. In your many years of litigation and your review of all the dead copy, were you ever able to identify one caption that was identical as it came from the court and as it was published by West?

MR. HARTMANN: Objection.

Q. Can you identify one?

A. The Fifth Circuit and the Eleventh Circuit captions are identical.

Tr. at 132.

As was the case with *Supreme Court Reporter*, for its *Federal*

²⁴ West's counsel's examination of Ms. Bergsgaard on its authorship in *Federal Reporter* cases was expressly limited and qualified to exclude the Fifth and Eleventh Circuits from her answers. Thus, all of Ms. Bergsgaard's testimony regarding the treatment West gives to opinions of Courts of Appeals are subject to that limitation, and none of her answers should be applied in those circuits. In the absence of any testimony at all on these circuits, they must be treated as conceded.

²⁵ See Tr. at 49.

THE COURT: Let's get to the bottom line. Does the caption that appears in the Fifth Circuit cases slip opinions, is that the exact same that you find in Fed. 3d?

THE WITNESS: Yes, it would, your Honor.

Q. How about the Eleventh Circuit?

A. The same is true for the Eleventh Circuit is treated like the Fifth Circuit, yes. (Emphasis added.)

²⁶ Although West apparently claims to be the "author" of the "running head", it admits that this is used as a part of the citation, Tr. at 55-57.

Reporter Series West also obtains, "the docket number. . .from the court documents," (Tr. at 50) although West is quick to point out that "it generally is not located in the exact position where West has chosen to organize it." Id. If West ever discovered an error in a docket number on a document, [West] would call the court to check about the change. Tr. at 51.

West also believes that it is the author of its version of the docket number based on minor changes to the presentation of the docket number.

[West's] style is always to include the capital 'NO' period. And the other thing [West] will do there is. . .combine docket numbers. If there is a large case that maybe has ten different docket numbers, we will combine those and put dash through there to show a combination, a consolidation, or [West] may expand the number if the court has truncated it.

Tr. at 51-52.

Similarly, "[t]he court line comes from the slip opinion. They generally identify the court." Tr. at 52. Again, although West contends that it "has chosen to have its own court line language for each of the circuits and each of the courts that reports", Id., this is a mechanical system, and in at least the Fifth and Eleventh Circuits West uses the exact language the courts use. Id. (Ms. Bergsgaard repeatedly testified about things West had "chosen" to do--but examination of all of West's 'choices' reveal that they were invariably to make its formatting exactly the same as authoring courts.²⁷) Even Ms. Bergsgaard, West's authority,

²⁷ See e.g. Tr. at 244-245, where Ms. Bergsgaard describes, using an example selected and introduced into evidence by West, how West (continued...)

was unable to determine whether West's 'choice' matched the courts' styles without resort to the "dead copy". Tr. at 53-54. "Sometimes the court line is at the top of case, sometimes it is after captions, sometimes it's after attorneys. It can be all over the place. . . [West] always take[s] out the extraneous language [and] put[s] it into our style." Tr. at 53.

West even claims to author the "date lines" and the "appeal line". "Some circuits include both dates on the slip opinion.

(...continued)
determines its "combines", and upon examination, West's actual practice was revealed.

Q. Who incorporated the amendments for the purpose of publication?

A. We incorporated those into our case report.

Q. So, that would you take a look back at what the Ninth Circuit did?

A. The Ninth Circuit when they do their slip opinions, they always do the order and they do republish the entire order with their corrections.

Q. So, it was the Ninth Circuit that did that?

A. In -- and they republish their -- they reprinted their slip opinion.

Q. So, it was the Ninth Circuit that did that?

A. West chooses how it's going to do this. And the Ninth Circuit reprint all of their orders that way. Sometimes we will incorporate them in this instance like in this instance and other times we will not.

Q. The editor's note that says, amends incorporated for the purpose of publication, states that, but the Ninth Circuit did exactly that in its publication, is that correct?

A. Well, we added the editor's note to let our readers know because we are incorporating the amendments into the case report.

Q. I understand that. But what you published is identical to what the Ninth Circuit published?

A. No.

Q. Except for your editor's note?

A. This is not identical to our case report and I don't think we need to go through step by step.

THE COURT: Other than the stylistic changes you made in parallel cites, etc., the text?

Other circuits do not--and they come from other court documents." Tr. at 54. "The appeal line can come from different sources. . . Sometimes it is on the slip opinion, sometimes it comes on other court documents that are related to the case."

Although West claims that attorney information in its reports in its *Federal Reporter Series* "is compiled by West", it admits that "it may be on the slip opinion." Tr. at 60. See e.g. Plaintiff's Exhibit 45 (E. 1216). "It may be coming in a separate letter from the court clerk. It may come from the docket sheet filed in the clerk's office and the dead copy will show you many different examples of where the attorney comes from." Id. West has no way of knowing where this information actually came from--and thus, no way of determining whether it was West or the court that added the information.

Then West "may add in" the city of practice, which, as was the case with the Supreme Court Reporter, can come from such sources as West's Legal Directory, telephone books or Bar Association books. Id. West also mechanically deletes duplicate names of counsel, combines the names of all counsel on one side of an appeal, and will delete deceased attorneys' names or the names of attorneys who had been terminated during the case. Tr. at 63-64.

The composition of the court of appeals deciding the case, what West calls the 'judge line', it obtains from the slip opinion, as well. West edits this information by merely "capitaliz[ing] the names. . . and put[ting] them into a format that West has chosen to use." Tr. at 69.

COURT: What do you mean by that?

THE WITNESS: We will use "before Mikva" with the Chief Judge coming first and followed by the circuitOne other thing we do is we will add the name of the judge. If there are two judges on the bench with the same last name we will add in the full name so there is no confusion.

Q. Where do you get all that information again, like

A. We will look through the court document. We may have to call the court.

Q. Do you ever change the names of the judges?

A. No, we do not. We may correct it if misspelled.

Tr. at 69-70. (Emphasis added.)

Again, when asked whether the judge lines in the *Federal Reporter Series* were formatted according to an internal policy, rule or a system contained in a manual, Ms. Bergsgaard testified, "Yes, we have guidelines for how we would like to present the judge information in the clearest way that we can." Tr. at 70. The following exchange with the court summarizes West's use of a repetitive, mechanical system or process.

THE COURT: The issue is no matter how the opinions may vary, does West have guidelines so they appear the same once they are published in West?

THE WITNESS: Yes.

Tr. at 71.

This testimony was followed by the concession that West obtains the text of the opinions reproduced in the *Federal Reporter* from courts--it "comes from the slip opinion." Tr. at 72. When asked what West does to that text, the response was the same as for *Supreme Court Reporter*. According to Ms. Bergsgaard, in its *Federal Reporter Series* West expands citations, adds parallel citations and "verifies"--"if there is an error in statute cite

[West] will correct it. . . [and] will also add parallel cites to a statute to U.S. Code and Congressional News." Tr. at 73.²⁸ In two circuits, West performs these tasks pursuant to contracts. In "the Fifth and the Eleventh Circuits [as] part of that contract [West does] the cite checking and verification." Id. In those two circuits, the slip opinions printed by West assert West's copyright only for the synopsis and headnotes--not for any verification or expansion of cites, or any other non-creative changes to the text of the opinion. Ms. Bergsgaard testified that

. . . we would not claim a copyright in the work that we did for the slip opinion except for the synopsis and the headnotes.

Id.

West tries to make much of changes it makes to the cites to cases referred to in these federal court opinions. Ms. Bergsgaard testified that West checks and corrects cites and captions to cases cited in the opinion, adds parallel cites (where the court hasn't already included them), conforms extension page cites to West's own reporters, substitutes citations in the opinion with cites to West reporters or Westlaw, and inserts parenthetical information (such

Of course, the court may have already incorporated parallel or expanded citations, as Ms. Bergsgaard admitted:

Q. Now, in some cases the decisions you receive from the court already have those parallel cites in them, don't they?

A. Some do and some do not.

Q. So in some cases West is adding them but in some cases the court is adding them?

A. The court may use them, yes.

Tr. at 76-77. In those instances West can have no copyright.

as 'cert. denied') after cites. Tr. at 74-79.

However, Ms. Bergsgaard's characterizations of West's tasks reveal that West employees simply perform numerous, but repetitive and mechanical tasks based on a style manual. All of these tasks are performed according to a system of guidelines determined by West's editorial department and set forth in a series of memoranda that have been around for many years. Tr. at 78.

Finally, West states that it also receives "amending orders, supplemental opinions, additional information that may pertain to the case." Tr. at 80. According to Ms. Bergsgaard, when West receives such information,

We may choose not to publish the order at all but to put the information in file line. That would be such as a rehearing denied, and West would create the file line but not publish the order. We may choose to publish the order with cross references between the two. We may choose to incorporate the entire order into the text of the opinion and we may or may not put a file line in there indicating what has been amended. Or we can do a combination of things. We can publish the subsequent order in part incorporate part of that order directly into the opinion.

Tr. at 80. West concedes, "[t]he court, when it's writing its amending order will certainly direct that this language be changed." Tr. at 81. But Ms. Bergsgaard attempted to soften that admission by testifying that, "that is not a direct [sic.] to West as to what West should do with it." Id. Thus, once again, West's claims are that it employed its editorial judgment to print exactly what a court prints, or to make a change exactly as a court orders.

When asked if she knew of any instance where West ever handled such changes in a manner other than as directed by a court, Ms.

Bergsgaard could not recall even a single incident of West's contrary choice. "I don't know. I don't know whether the court has ever said 'add this footnote' and we didn't do it." Id.

West's claim of it's independent decision-making is similarly refuted by Plaintiff's Exhibit 34 (E. 1158), a letter from the Chief Deputy Clerk of the Fourth Circuit to Ms. Bergsgaard. This exhibit is clear that West was given explicit instructions regarding what to add or delete, and what it should not change in these file lines. West was told by the court, in no uncertain terms, that it should

not reflect in the file line that the opinion has been amended. If the amendment is significant, the Court will issue an amended, supplemental or superceding opinion.²⁹

Moreover, West's own documents consistently reflect that it simply follows specific directives from the courts when it comes to such matters as withdrawing opinions from publication.³⁰

When asked if West would ever re-publish a volume to make changes, or whether such changes were simply a matter of circumstance of when a supplement was published, Ms. Bergsgaard tried to evade by "suggesting" that this happened frequently--

²⁹ This is similar to West's "choice" to publish tables listing unpublished opinions exactly as they occur in government publications. See Plaintiff's Exhibit 37. (E. 1162) ("We will follow the format of the table currently published by the United States Court of Appeals for the Second Circuit.")

³⁰ See Plaintiff's Exhibit 33 (E. 1157), a letter to the Clerk of the Court from West's Editorial Counsel stating, "Unless the Court enters an order which specifically states that such a three-judge opinion is to be withdrawn from publication, we will include it in the bound volume [of Federal Reporter]." West, in fact, does exactly what its Editorial Counsel states--what the courts direct.

although when pressed, she suggested that perhaps this was not the case, that it happened only in state court cases; and could not think of even a single instance where it had happened with the *Federal Reporter*.

THE WITNESS: Oh, I don't know the statistics. We republish cases maybe a couple come up every week at least. We also have the option of withdrawing an opinion from advance sheet.

Q. I am sorry, a couple of reprints come up after the bound volume has come out?

THE COURT: After the advance sheet.

A. Again --

Q. In Federal Reporter?

A. Again, I am thinking of the National System.

THE COURT: Let's keep it to Federal system.

A. I don't know. I don't have any statistics that.

Id. at 85-86.

West maintains that its "combines" are original. However, West admits that however it chooses to deal with supplemental information, all of the resultant text is governmental text.³¹

Q. On these combines, and this may be a bad way to phrase this question, but is everything to the north of combine and the south of the combine government text? In other words, when West does a combine, it's adding something that the court has written to something that was already there, isn't that correct?

A. Not always. Sometimes we will take the court order and we will remove the correcting part of the order and merge that into the text and then we add an editor's note indicating what we have done, and then we will publish the remainder of the order.

Q. And I guess what I am asking is in all the text -- let's take a situation where you append a subsequent order to the end of a text, do you ever append something that the court doesn't write, anything other than exactly what the court writes?

In any case, it is uncontested that HyperLaw does not arrange its combines in the same manner as West. HyperLaw's practice is to place any identifiable combines at the beginning of its cases--so that the reader does not have to go through the entire decision only to find that it has been amended. Tr. at 148-149.

A. We will append the order from the court after have done our editing and our modification to it.

Q. I understand that. What I am asking is is the actual stuff that you append, it's always things that come from the court, isn't it?

A. Yes.

Tr. at 86-87. See also Tr. at 88-89.

There are also several miscellaneous changes made by West. "Footnotes may not be marked up in text. There may be three different footnotes numbered 3. There may starred footnotes that cannot be reproduced. There may be footnote A and B. There may be some headings that are missed. It may go from one sub-heading to three." Tr. at 92. "Sometimes when that happens [West] calls the court. . .and the court tells [West] to make that change". Ms. Bergsgaard stated that she "does not know" if West sometimes is the only publisher that has that change. Tr. at 96. The documentary evidence and Mr. Sugarman's testimony that this does occur stands uncontested. It is absolutely critical to note, as Mr. Sugarman testified (Tr. at 128), that even if he had an unlimited amount of funding, he could not obtain all official copies of historic circuit court cases because West received and encouraged corrections from some courts not available to other publishers by any means.

HyperLaw believes the record reflects that West actively set about, in a number of ways, to make certain that it had the only "true copy" of court decisions--acting so that only West received the changes. In the end, however, intent is irrelevant--what is critical is that no publisher, no matter how thorough or precise, no matter where it looks or how much it spends, can ever obtain official copies of many decisions; as only West was given many of the official changes--changes not reflected even in the courts' files in the file copies of decisions.

Q. If you had an unlimited amount of money, could you go out and get the court opinions of the Court of Appeals from courts?

A. With all the corrections that were added, no, I could not.

Following Ms. Bergsgaard's recitation of West's changes to opinions of federal courts of appeals, and after she stated that she had included all of the changes that West makes in the *Federal Reporter* (Tr. at 98-99), HyperLaw examined Ms. Bergsgaard in some detail regarding one such case of West's choosing, a case which West had originally used to describe its many changes--*Mendall v. Gollust*. Ms. Bergsgaard was taken through the case point-by-point, and was unable to identify any other changes. Tr. at 104-119. (See also, Plaintiff's Exhibit 16 (E. 1092), HyperLaw's letter regarding *Mendall v. Gollust*, with various versions of the case.)

Alan Sugarman, President of HyperLaw, was then called to testify regarding the HyperLaw product, and the manner in which it does (and will) obtain court opinions for inclusion. First, HyperLaw has continuously produced a product which reports all available decisions of the U.S. Supreme Court and Federal Courts of Appeals. Tr. at 281-284.

Second, HyperLaw will copy and add non-copyrightable materials from the *Supreme Court Reporter* and *Federal Reporter Series* to its product. Tr. at 284-285. HyperLaw has repeatedly stated that it will add the following to its existing product to create the new product: (a) information regarding cases that HyperLaw reports but has not obtained specific items--this would include attorney names

and citations; (b) opinions of federal judges that HyperLaw had not been able to obtain for its existing period of coverage; and c) opinions from (prior) periods not currently included in HyperLaw's product, where those cases were referenced or cited in cases already in HyperLaw's product. Tr. at 288-291.

Third, HyperLaw, (as it has always stated) in publishing its new product, will directly redact, on the original text (with no intermediate copy) any copyrightable text which it can identify as being West's authorship--such as those headnotes and syllabi that were authored by West. All of HyperLaw's examples to West over the years have used this method. Tr. at 122-124. Early in the case, West had been supplied an entire volume of pages from one of its reporters which contained the redacted materials (see, e.g. Plaintiff's Exhibit 52 (E. 1230)).

Finally, the record reflects that West has filed copyright registrations for all volumes of its Supreme Court Reporter and Federal Reporter Series, applicable here³³. West's copyright notices, appearing in its reporters, are also non-specific³⁴ as to

³³ See e.g. West's Trial Exhibit A (E. 1625-1714), indicating that West claimed copyright in revisions, additions, and annotations, without denoting them or specifically identifying them.

³⁴ West stipulated at trial that it does not have a copyright notice regarding parallel citations or alternative citations. Id. at 97. (Stipulation by Mr. Rittinger in response to questioning of Ms. Bergsgaard.) In addition, a review of West's copyright notices (see Plaintiff's Exhibit 11 (E. 792)) reveals that none of those notices specifies any of the "authorship" West contends exists.

MR. RITTINGER. . . . We will stipulate we don't have a
copyright notice that says parallel citations,
(continued...)

the identification, basis and extent of its copyright claims in its case reports³⁵. Nowhere in its reporters does West specifically identify material "authored" by West, or distinguish it from original court text.

SUMMARY OF ARGUMENT

1. The district court correctly held that the changes West makes to the actual text written by federal justices and judges

(...continued)

specifically alternative citations, if that will move it along more quickly.

THE COURT: Good. Let's move on.

³⁵ Typical copyright notices from the *Supreme Court Reporter* and *Federal Reporter*:

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.

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.

which appear in its *Supreme Court Reporter* and *Federal Reporter Series* (excepting synopses, syllabi, headnotes and key numbers) lack the requisite creativity or originality to qualify for copyright protection--both individually and collectively.

2. The text of judicial decisions by justices of the United States Supreme Court and judges of the Federal Courts of Appeals do not qualify for copyright protection, even if some minor changes made to the vast amount of governmental text by West are determined by this Court to be arguably original; either because they are trivial, or because that small number of discretely identified changes can be removed before copying.

3. Even if this Court determines that some or all types of changes that West makes to the text of judicial decisions may qualify for copyright protection, and the Court further determines that a copyright can exist on the actual text obtained from a governmental source and that discretely identified items cannot be removed, Section 403 of the Copyright Act renders all West federal case reporters published between the effective date of the Copyright Act of 1976 (January 1, 1978) and the effective date of the Berne Convention Implementation Act (March 1, 1989) uncopyrighted and in the public domain.

4. The district court correctly denied West's motions to dismiss for lack of justiciability.

ARGUMENT

I. The Changes that West Makes to Uncopyrightable Judicial Opinions Lack the Requisite Originality to Qualify for Copyright Protection.

The Copyright Act of 1976 ("the Act") affords copyright protection only to "original works of authorship fixed in any tangible medium of expression". 17 U.S.C. § 102. West states that it does not dispute that works of the federal government, including decisions authored by the judges and justices of the federal courts, are not subject to copyright protection³⁶. West claims, however, that by making minor, mechanical modifications to uncopyrightable judicial opinions it transforms them into original works of its own authorship, entitled to copyright protection. As Judge Martin correctly determined:

The changes that West makes to an opinion that it publishes do not make the reported decision "independently copyrightable." If one looks at each opinion as a whole then it seems clear that the changes made by West are trivial indeed. Minor changes to the caption, the identification of judges and information as to the attorneys, together with the insertion of subsequent history, are not sufficient to qualify West's reprints as "original works of authorship."

Mem. Op. at 6.

Judge Martin's decision is firmly supported by the law. The starting point for any analysis of copyrightability is, of course,

³⁶ See 17 U.S.C. § 105 ("Copyright protection under this title is not available for any work of the United States Government. . .") Much like § 105 of the 1976 Act, § 8 of the 1909 Act provided, "no copyright shall subsist in the original text of any work which is in the public domain, * * * or in any publication of the United States government, or any reprint, or in whole or in part, thereof."

the Constitution. In Feist Publications v. Rural Telephone Service Co., 499 U.S. 340, 111 S. Ct. 1282 (1991), the Supreme Court explained that the Constitution permits copyright protection only for works that are "original":

Originality is a constitutional requirement. . . . [O]riginality 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."

499 U.S. 346³⁷. Thus, it is the Constitution that mandates that West's copy of a judicial opinion must possess originality if it is to merit copyright protection. As Judge Martin found, West's reprints of judicial opinions lack the requisite originality for the several distinct and independent reasons.

A. West's reports of judicial opinions lack originality because they are not a substantial variation from the judicial opinions as issued by the courts.

It is well established that a derivative work (i.e., a work--

West and Reed Elsevier ask this Court to circumvent Feist, and create by judicial doctrine what Congress has refused to adopt: a version of a European-conceived database protection proposal, modified to give West and Reed Elsevier de facto copyright over governmentally created and funded information--a proposal for which they have lobbied in Europe and the U.S. over opposition by the entire scientific community and many publishers. J.H. Reichman and Pamela Samuelson, Intellectual Property Rights in Data?, 50 Vanderbilt Law Review 50 (1997) (the Court's particular attention is directed to note 7). In 1995, West was frustrated in an earlier failed attempt to sneak database protection provisions into the Paperwork Reduction Act. See Doug Obey and Albert Eisele, West: A Study In Special Interest Lobbying, The Hill, February 22, 1995. (Article discussing exposure of the skulduggery which ended with the defeat of a West promoted amendment to the 1985 Paperwork Reduction Act to obtain special interest database protection legislation. Available at <http://www.hyperlaw.com/hill13.htm>)

such as West's report of judicial decisions--based on one or more preexisting works) possesses the requisite originality for copyright only if the changes to the preexisting work result in a "substantial variation" from the preexisting work. See Woods v. Bourne Co., 60 F.3d 978, 990 (2d Cir. 1995) (quoting L. Batlin & Son, Inc. v. Snyder, 536 F.2d 486, 491 (2d Cir. 1976) (en banc), cert. denied, 429 U.S. 857 (1976)). In L. Batlin & Son, Inc., the seminal case on derivative works, this Court stated:

We do follow the school of cases in this circuit and elsewhere supporting the proposition that to support a copyright there must be at least some substantial variation, not merely a variation.

Id. at 491. As the Batlin en banc court further explained,

[t]o extend copyrightability to minuscule variations would simply put a weapon for harassment in the hands of mischievous copiers intent on appropriating and monopolizing public domain work.

Id. at 492.³⁹

³⁹ This Court also previously condemned the type of mischief that comes from recognizing copyright protection for such unidentified, minuscule variations:

[O]ne who so embodies copyrighted with uncopyrighted matter that one reading his work cannot distinguish between the two has no right to complain if the book is republished by third parties. . . . One cannot ascertain what part of the [work] contains the copyrighted matter. . . unless he is able to obtain from some source a copy of the original work and compare it letter by letter and word by word. . . This we do not think he is called upon to do. If one intends to assert his exclusive right to publish and sell copyrighted matter, he must so clearly indicate the matter in which he has the exclusive right that the public upon inspection can determine the question of its own rights therein. He cannot require the public to . . . compare it word by word with the uncopyrighted work. [Emphasis added.]

(continued...)

Subsequently, this Court reaffirmed Batlin in Durham Industries, Inc. v. Tomy Corp., 630 F.2d 905 (2d Cir. 1980), holding that there was insufficient originality to give rise to a derivative copyright where there was "no independent création, no distinguishable variation from preexisting works, nothing recognizably the author's own contribution." Id. at 910. The Court recognized two important and related limitations to derivative copyrights.

First, to support a copyright the original aspects of a derivative work must be more than trivial. Second, the scope of protection afforded a derivative work must reflect the degree to which it relies on preexisting material and must not in any way affect the scope of any copyright protection in that preexisting work. (Emphasis added.)

Id. at 909. This second limitation is particularly true where the public domain work is something as important as the law of the land. Du Puy v. Post Telegram Co., 210 F. 883 (3d Cir. 1914); (followed in Greenbie v. Noble, et al., 151 F.Supp. 45 (S.D.N.Y. 1957)).

In Du Puy, the court denied a claim of copyright infringement for copying a newspaper article which was based upon a government bulletin in the public domain, despite the fact that the article

(...continued)

Bentley v. Tibbals, 223 F. 247, 256-57 (2d Cir. 1915) (emphasis added). Since even West's own witness, Ms. Bergsgaard, was unable, at trial, to determine changes made by West without comparing West's reports to the slip opinions, Bentley v. Tibbals requires striking down West's copyright claims.

"Factual material published and incorporated in official government records for the benefit of the public at large may not be privately appropriated and taken from that public under the guise of copyright." Greenbie v. Noble, et al., 151 F.Supp. at 66.

was not an exact re-publication. Id. at 884 ("[I]n many parts its exact wording being used, in other instances a change of a word or sentence here and there, but taken as a whole and from the standpoint of authorship the bulletin was the authority and origin of the article.").

This bulletin was a public official document, one which by its public character was by statute excepted from copyright appropriation. . . Seeing, then, as we do, that there was no original authorship in this Star article, that it was but a word redress of the substance of [the government bulletin], it is clear that a copyright thereof would be wholly at variance with that constitutional purpose which is the object of copyright legislation . . . what [was given] to the public in an official bulletin could not afterwards be taken from that public under the guise of copyright.

Id. at 884-885 (emphasis added). The very essence of Du Puy is that a private publisher cannot be allowed to appropriate a copyright in government documents by a "word redress of the substance" of the government work. The text at issue here is far more important to the public than a mere bulletin--it is the government's primary statement of the law. West cannot be allowed to appropriate a government work by alleged, unidentified "word redresses" that it has fruitlessly attempted to characterize at trial as "creative expression."

As Judge Martin correctly found, West's changes do not result in a "substantial variation" from uncopyrightable court opinions:

In sum, each of the changes that West makes to the cases it reports are trivial and, taken separately or collectively, they do not result in a "distinguishable variation" of the opinion written by the court. Waldman Publishing Corp v. Landoll, Inc., 43 F.3d 775, 782 (1994).

Mem. Op. at 11 (A. 504).⁴⁰ The fact that West's changes do not result in a substantial variation is not at all surprising when one considers that West's sole "intent is to make a very accurate report." Tr. at 35. For text that is specifically being held out as accurate re-publications of federal court opinions, it is axiomatic that West's reports cannot vary in any substantial way from the original.⁴¹ What West advertises is the exact opposite of authorship--it is slavish reproduction.

West's brief and Ms. Bergsgaard's trial testimony are replete with examples of West "sweat." Although conceding, as it must, that "sweat of the brow" is uncopyrightable, West's brief nonetheless goes on at great length about the tremendous research efforts in which its staff must engage: from ferreting out attorney names in Martindale-Hubbell to looking up the cities in which they practice and names of their firms, as well as cross-checking all parallel citations to other U.S. Supreme Court reporters.

West would have the Court believe that these exertions add up, in the words of Batlin, to "substantial variations" to the text of public domain opinions. But West's purported efforts in modifying the opinions of the federal courts is almost a complete charade. Indeed, the reality of what West does--which under close analysis

For example, Judge Martin held, "West may make some changes in the presentation of the names of judges involved in the decision, but these changes are clearly trivial." Id. at 10 (A. 503).

In fact, this is West's major selling point, and its greatest virtue -- it has always stated with justifiable pride that it gathers and reports exactly what courts have decided -- even when there are changes that only West receives. West holds itself out as the definitive reporter.

is very little indeed-- underscores this Court's warning in Batlin that giving copyright protection to variations of such materials "would simply put a weapon for harassment in the hands of mischievous copiers intent on appropriating and monopolizing the public domain." 536 F.2d at 492.

To appreciate just how minuscule West's variations are from the Court of Appeals and Supreme Court slip opinions, the Court is invited to compare West's broad claims to what West has actually done. This can easily be accomplished, as it was repeatedly at trial, by comparing any randomly chosen case as published in West's federal reporters against the slip opinion. It is instructive to compare, by way of example, *Fonar Corp. v. Domenick*, a 1997 copyright case from this Court published by West at 105 F.3d 99, against the slip opinion of the same case.⁴² The names of attorneys, both as they appear in the slip opinion and as "edited" by West, show "NY" was changed to "New York" and names were capitalized.

Thus, the real value of obtaining the cases from West's reporters lies in changes that other publishers simply did not get, and can never obtain, in the historical body of federal appellate cases. Similar perusal shows that the "heavy editing" in which West purportedly engaged is truly minuscule and trivial. Indeed, just about the only change that is apparent in West's "edited"

⁴² It should be noted that this change may not have been made by West. It could have been called in by a court, West does not denote the difference.

version of *Fonar v. Domenick* appears before the conclusion:

Slip Opinion

105 F.3d at 106

cert denied, 116 S. Ct. 1015
(1996)

cert denied, ___ U.S. ___, 116 S.
Ct. 1015, 134 L. Ed. 2d 96 (1996)

For this addition West claims copyright protection.⁴³ Fortunately, this Court sitting en banc has already ruled out the possibility of copyright protection for any such trivia. Batlin, supra.

B. West's reports of judicial opinions lack originality because the material added by West consists solely of facts.

In addition to finding that West's reports of judicial opinions are not a "substantial variation" from the judicial opinions themselves, Judge Martin also indicated that the material added by West consists solely of facts.

It is a bedrock principal of copyright law that facts and ideas are not themselves copyrightable. Harper & Row, Publishers, Inc. v. Nation Enterprises, 471 U.S. 539 (1985). Judge Martin found that:

- "The case names are facts reported by the courts and West's modifications thereto are not significant enough to give it a protectible interest in the case title." Mem. Op. at 7 (A. 500).

⁴³ West concedes that it injects no original material into opinions of the Fifth and Eleventh Circuits. The conclusion therefore follows that the above comparison between a Second Circuit slip opinion and its West case report reflects material over which West claims it has expended the most originality. What is remarkable is that those few and insignificant changes would not qualify for protection even under the discarded "sweat of the brow" theory.

- "[T]he case title, the docket number and the date argued and decided . . . are clearly facts . . . , [and] there is nothing so original about West's expression of these facts that would entitle them to copyright protection. Id. at 7-8 (A. 500-501).
- "West adds to the title a 'file line' that will give subsequent history, such as 'rehearing denied' and the date of the action. In most instances these are straightforward factual summaries . . ." Id. at 8 (A. 501)⁴⁴.
- With regard to the names of the attorneys, "these are facts which West cannot copyright." Id. at 9 (A. 502)⁴⁵.

Nothing in West's arguments to this Court casts doubt on the accuracy of those straightforward conclusions.

C. West's reports of judicial opinions lack originality because West's changes are mechanically made pursuant to a system.

West's changes to judicial opinions do not give rise to

⁴⁴ The file lines "prepared" by West are little more than subsequent history (such as the fact that a rehearing was denied). In general the subsequent history is incomplete as it does not contain events occurring after printing of the hardbound volumes. West's objection to the copying of file lines has less to do with protecting the value of the information, than with its transparent attempt to sprinkle so-called "original creative information" in order to claim a de facto copyright over the full opinion. Because file lines sometimes may be added by a court itself, deletion of all file lines would also delete original court material.

⁴⁵ Although West states (West Brief at 41) that most Court of Appeals decisions do not contain attorney information, in fact, the First, Second, Third, Fourth, Ninth, Tenth, District of Columbia, and Federal Circuits include attorney information in their slip opinions, and West does nothing more than format this information. The other circuits actively "cooperate" with West in providing it with attorney information.

copyright protection for the separate reason that the changes are mechanically made as part of a process or system.

The Copyright Act expressly provides:

In no case does copyright protection for an original work in 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.

17 U.S.C. § 102(b). The district court correctly found that West's changes to the visual "presentation" of facts (e.g., capitalizing the title of a case, abbreviating parties' names, or combining captions of cases reported together) are "simply a mechanical application of preexisting rules of citation." Mem. Op. at 7 (A. 500). Similarly, with regard to the changes West makes to the text of opinions, the district court found none which were not part of a process. Although West argued at trial that it makes many and varied changes to the text of opinions, on appeal West has abandoned most of these assertions.⁴⁶ At present, it is only pursuing two of the types of changes: inclusion of parallel citations to cases cited by the court, and changing some citations

With regard to the correction of misspellings, errors in the form or substance of citations, and instances where West calls a court to determine whether there is an error in an opinion, the district court found that, "there is no element of creativity or originality involved in these corrections." Id. at 10 (A. 503).

Additionally, with regard to the filling in of citations left blank by the court, "[t]his mechanical search for and addition of facts is clearly not protected by copyright." Id. Apparently West now agrees with the district court and has dropped these issues on appeal.

included by the court to more readily available sources.⁴⁷

In most instances the determination of which parallel citations to include are basically mechanical and reflect no level of originality⁴⁸. Here again the selections made tend to conform to the standard of the legal profession and appear consistent with those recommended in A Uniform System of Citation. Surely the decision to cite to a bound volume rather than an advance sheet or a computerized source does not reflect even a modicum of originality. Nor do the limited number of instances in which West makes a judgment as to which of a number of equally accessible sources should be cited give to its case reports a sufficient level of originality to invoke the protection of the Copyright Act.

Id. at 11 (A. 504). Indeed, West's own witness, Ms. Bergsgaard, testified that the changes West makes on these items strictly follow a policy manual -- systems or processes that had been in place at West for many years⁴⁹.

⁴⁷ Of course, West cannot claim copyright to any citations already included by the authoring court.

⁴⁸ West attempts to create an issue from the court's use of the phrase "in most instances." West's Brief at 28, 31. West argues that since there might have been an instance in a parallel citation was "original", declaratory judgment for HyperLaw would be error.

Notwithstanding that neither West nor anyone else can identify which citations originate with a court and which West inserted, West was given ample opportunity at trial to present all variations of its originality and creativity, but never proved at trial that any insertion of a parallel cite or change to an existing cite was original. West introduced reams of evidence at trial, chosen to best demonstrate its claims of originality--but the court simply didn't find any originality. In a last ditch effort, West now cries, "but there might still be an original citation out there somewhere!" Unfortunately for West, that cry is unsupported in the record.

⁴⁹ The insertion of parallel citations, as any law student can affirm, is an ultimate example of a sweat of the brow. Indeed, parallel citations can be automatically inserted and standardized by computer programs following a pre-programmed system of rules. The same programs can modify citations to make them conform to Bluebook style.

D. West's reports of judicial opinions also lack originality because the information being added can only be expressed in a very limited number of ways.

Yet another reason why West's reports of judicial opinions lack originality is that the facts added by West can only be expressed in a handful of different ways.

Where facts can only be expressed in a limited number of ways, the idea and expression are considered "merged," and the expression is not copyrightable. C.C.C. Info. Servs., Inc. v. MaClean Hunter Market Reports, Inc. 44 F.3d 61 (2d Cir. 1994). 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). In C.C.C., this Court held:

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. . . . ("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.")

Id. at 68 (emphasis added; citations omitted).⁵⁰

⁵¹ Writing for the Court in C.C.C., 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
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(continued...)

Judge Martin correctly found that the facts added by West can be expressed in only a few ways. For example, the factual

50

(...continued)

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 . . . ("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?

Id. at 72 (emphasis added; citations omitted). 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

* * *

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, not 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.

Id. at 72-73 (emphasis added). Here, any impairment of the public's access to the opinions of the federal judiciary will certainly inflict injury on the opportunity for public debate, and restrict access to public understanding of federal case law. Any balancing test must weigh heavily against granting West a monopolistic copyright in the law.

summaries in file lines are "straightforward . . . and the choice of methods of expressing (them) is generally limited and subject to widely accepted rules of citation." Id. at 8 (A. 501). That ruling is so plainly correct that West can cite no contrary examples in the record.

II. The District Court Correctly denied West's Motions to Dismiss for Lack of Justiciability.

Twice West tried to avoid being stripped of its wrongfully asserted copyrights by raising the meritless argument that HyperLaw's product is hypothetical. As set forth in detail above, after extensive briefing the district court held an evidentiary hearing and found that HyperLaw's product was sufficiently defined, and that HyperLaw had met its burden in demonstrating both a non-hypothetical product and reasonable apprehension. West called no witnesses then, and can cite to nothing in the record now. West has already lost this argument.

Although West continues on this tack, and now asserts a mootness argument, the facts as found by the court demonstrate that HyperLaw's product is real and its claim is vibrant. Minor, and specifically defined additions to an existing product hardly requires rocket-science--but the actual demonstration of a working version of the product at hearing, with detailed testimony regarding production methods puts this absurd argument to rest.

HyperLaw has described its product consistently. The same description of the new product is in its complaint, in discovery responses, and at trial. HyperLaw offered testimony and

documentary evidence regarding its product and its intended use of materials from West's *Supreme Court Reporter* and *Federal Reporter*. Plaintiff's Exhibit 55 (E. 1623); Tr. at 282-291. This testimony, as well as HyperLaw's previous testimony at the evidentiary hearing on justiciability is unrefuted and unchallenged by the record or any West witness. There is simply no factual or legal basis for West to challenge justiciability on appeal.

III. Section 403 of the Copyright Act Is a Partial or Total Bar to West's Claim of Copyright in the Text of Judicial Decisions And Reflects Congressional Intent.

In 1976, Congress passed a major revision to the Copyright Act⁵¹, which went into effect on January 1, 1978⁵². Section 105 of the Act states that, "Copyright protection under this title is not available for any work of the United States Government." Congress 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, § 403⁵³ 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.]

⁵¹ The Copyright Act of 1976. Public Law 94-553, 90 Stat. 2541 (1976).

⁵² The Act was amended in 1988, effective March 1, 1989. Berne Convention Implementation Act, Public Law 100-568, 102 Stat. 2853 (1988).

⁵³ Sec. 403. Notice of Copyright: Publications Incorporating United States Government Works.

Failure to meet this requirement was to be treated as an omission of the notice, subject to the provisions of § 405. Nor is there any great mystery regarding why § 403 was enacted--Congress moved 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:

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. [Emphasis added.]

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

To prevent that illegitimate business practice, in 1976 Congress provided the penalty for those who, like defendant West, reprint U.S. government works in such a manner as to claim false proprietorship therein: forfeit all copyright protection. Id.

("[f]ailure to meet the requirement would be treated as an omission of notice.") Congress implemented the forfeiture penalty through the vehicle of mandatory copyright notice requirements, which would cause the loss of copyright if violated. See 17 U.S.C. § 403 (1976) ("Whenever a work is published in copies . . . consisting preponderantly of one or more works of the United States Government, the notice of copyright . . . shall also include a statement identifying . . . those portions of the copies . . . embodying any work or works protected under this title"); 2 Nimmer on Copyright § 7.14.

During this period, West provided no 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.

Thus, West's failure to meet the requirements of § 403 must be treated as an omission of the copyright notice, subject to §405. Section 405 would excuse the omission if a relatively small number of copies had been publicly distributed without notice (not applicable here), or if the omission was corrected within five years and a reasonable effort is made to add notice to copies publicly distributed in the United States. West produced no evidence at trial that it attempted or effectuated a correction of the omissions within five years of each volume's publication⁵⁴ for

⁵⁴ At trial, West offered no excuse for its failure to comply with this requirement--not even to suggest it was unaware of it.
(continued...)

the period during which this statutory scheme was in place⁵⁵. In fact, West continued using the same copyright notice after 1989.

As a consequence of West's failure to provide proper copyright notices which satisfied the requirements of § 403, West's inadequate copyright notices must be treated as omitted. Since West did not correct this omission during the five year cure period following the publication of each volume, all West volumes published between January 1, 1978 and February 28, 1989 have forfeited any copyrights to which they might have been eligible.

That result comports with established doctrine in the Second Circuit. In Bentley v. Tibbals, supra at 256, this Court denied a request for protection to a work published with a copyright notice that left the reader "to ascertain [what is original and what is unprotected] for himself by a verbal comparison, word for word." Though Bentley v. Tibbals did not deal with judicial opinions, the

⁵⁴ (...continued)

Obviously West's actions were calculated to have the exact effect they had--confuse competitors and overreach its copyright claims.

⁵⁵ 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), effective March 1, 1989. These amendments removed the mandatory copyright notice provisions from §§ 401 et seq. 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 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.]

Court's concern to avoid a fraud on the public is equally present in the case at bar.

CONCLUSION

For the foregoing reasons, the Court should find that the district court did not err in holding that changes made by West in its *Supreme Court Reporter* and *Federal Reporter Series* to opinions of federal judges, do not qualify for copyright protection; and so finding, this Court should affirm the judgment of the district court.

Respectfully Submitted,

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CERTIFICATE OF SERVICE

I hereby certify that on November 25, 1997 I served 2 copies of this BRIEF FOR INTERVENOR-PLAINTIFF-APPELLEE HyperLaw, Inc., by delivery of the same to Federal Express for overnight delivery, upon:

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