

West's Copyright Claim to Star Pagination Denied by Second Circuit

by David Ensign

In 1986, the Eighth Circuit Court of Appeals issued an opinion in *West Publishing Co. v. Mead Data Central, Inc.* granting a preliminary injunction in favor of West that prohibited Mead Data Central (MDC) from using pinpoint citations, called star pagination, to specific language within cases found in the National Reporter System (NRS). MDC had inserted star pagination citations within the text of opinions found in its LEXIS database so that users would know where that language was located in West reporters. MDC claimed West was trying to assert copyright protection in page numbers, and that mere bibliographic citation lacks sufficient originality to qualify for copyright protection.

West claimed the pinpoint citations were representative of the selection and arrangement of cases within the NRS. According to West, in using pinpoint citations, MDC was usurping the selection and arrangement, which is copyrightable.

Compilations

The NRS belongs to a class of works called compilations. A compilation is "a work formed by the collection and assembling of preexisting materials or of data that are selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes an original work of authorship." (17 U.S.C. 101 [1994]) The creator of a compilation cannot claim copyright protection for preexisting material that it incorporates, but can claim protection only for material contributed

by the author of the compilation. In its pivotal opinion in *Feist Publications, Inc. v. Rural Telephone Service Company, Inc.*, the U.S. Supreme Court determined that the mere expenditure of time, money, or effort in collecting material for compilations cannot be protected under copyright law; however the selection and arrangement of the preexisting material, if it is original, can be protected. Many scholars read the *Feist* case as a clear challenge to the validity of the *Mead* opinion.

Eighth Circuit Aftermath

In granting the preliminary injunction, the Eighth Circuit supported West's copyright claim, and West licensed star pagination to MDC. The ruling in *West Publishing Co. v. Mead Data Central, Inc.* was roundly criticized by copyright scholars. There was little doubt that LEXIS' use of star pagination would have an adverse effect on West's National Reporter System, but the decision muddled the common understanding that the text of court opinions is in the public domain. (Works of the U.S. government do not qualify for copyright protection. It has also been held that federal court opinions do not qualify for copyright protection. Similarly, copyright may not be claimed for state court opinions.) Many wondered if the Eighth Circuit's ruling was overturned by *Feist*, arguing that the NRS was more representative of a "sweat of the brow" work, which could not claim copyright protection because of a lack of requisite originality. After *Feist*, the Eighth Circuit confirmed its opinion in *Oasis Publishing Co. v. West Publishing Co.*, holding that the selection and arrangement of decisions contained in the NRS met the minimal originality requirement articulated in *Feist*.

The Second Circuit Weighs In

In two opinions issued in November 1998, the Second Circuit Court of Appeals came to different conclusions than the Eighth Circuit on these same issues. In *Matthew Bender & Co., Inc. and Hyperlaw, Inc. v. West Publishing Co.*, Matthew Bender asked the Second Circuit for a declaratory judgment regarding the availability of copyright protection for star pagination. Matthew Bender intended to produce CD-ROM products containing New York court opinions, some of which are contained in the NRS and some which are not. Within cases published in the NRS, Bender

wished to designate every page break within the published reporter by using a pinpoint citation. Once again, West argued that star pagination appropriates the arrangement of cases within the NRS. West said that a user would be able to utilize star pagination in the Bender product to reproduce cases exactly as they are arranged within the NRS, thereby infringing the copyrightable element of its compilation.

The majority said that there is no protectible element in star pagination. The assignment of page numbers is a function of the printing process, and not the result of an original or creative process on the part of West. Page breaks are therefore facts that cannot be protected by copyright. The majority felt that the fact that a user could reproduce a volume of the NRS using star pagination to the NRS did not infringe any copyright to which West might be entitled, since this would involve manipulation by the user that Bender did not invite or facilitate.

The second decision in *Matthew Bender & Co., Inc. and Hyperlaw, Inc. v. West Publishing Co.* involved West's claim of copyright in certain editorial revisions to published court opinions. Hyperlaw sought a declaratory judgment that no protectible element would be infringed if it electronically reproduced cases directly from the volumes of NRS court reporters. Not at issue was the copyrightability of the synopsis, headnotes, or the topic and key number system that is proprietary to West reporters. West claimed that it enhanced the opinions in its arrangement of prefatory information, such as the names of parties, court, and date of the decision; its selection and arrangement of attorney information; its arrangement of information regarding subsequent procedural developments; and its selection of parallel and alternative citations.

The majority opinion said that there is insufficient originality in the selection and arrangement of these elements to qualify for copyright protection, or that the elements themselves lacked the level of creativity or originality required to qualify for copyright protection. Hyperlaw would be permitted to reproduce opinions from West reporters, as long as the elements that were admittedly protected were not included.

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Judge Robert Sweet dissented in both opinions. He felt that the editorial enhancements met the low standard of creativity articulated in *Feist*. To permit Bender and Hyperlaw to employ star pagination without license would appropriate West's copyrightable contribution to the NRS, according to Sweet.

Supreme Court Denies Cert

The Second Circuit denied West's petition for a rehearing en banc, and on June 1, the Supreme Court denied certiorari without comment. This result would seem to remove barriers to a more competitive market for print and electronic products that would compete with the NRS. It would also permit the reproduction and distribution of court cases from the NRS, where West editorial features have been

masked. However, the Supreme Court's refusal to resolve this issue means that it may be litigated in other Circuits, with a possibility that other Circuits may adopt the holdings from the Eighth Circuit *Mead Data Central* and *Oasis* decisions.

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