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June 30, 2008

Dean Michael H. Schill
University of California Los Angeles
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Box 951476
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Re: Complaint re Academic Misrepresentations by Adjunct Professor David Nimmer

Dear Dean Schill:

Thank you for your letter of June 6, 2008, which I have attached for your reference. I had hoped that you would be able to mediate this situation. I had hoped that Professor Nimmer and Morgan Chu would have responded to my letters. I am now forced to file a formal complaint concerning Professor David Nimmer.

Professor Nimmer, while an adjunct law professor at the University of California, published a scholarly article in the Houston Law Review containing what in my opinion are false and deliberately misleading statements in as many as 27 pages of the article.¹ These statements appear to have been intended to accrue to the personal, financial, and professional gain of Professor Nimmer and his law firm.

This article contains material constituting in my opinion academic fraud. At that time in 2001, and currently, Professor Nimmer was of counsel at Irell & Manella. The apparent academic fraud was to the personal detriment of me, my company HyperLaw, and HyperLaw's attorneys, Paul Ruskin and Carl Hartmann.

This letter is written to you acting on behalf of the Regents of the University of California. I address it to you because when Professor Nimmer wrote the article in question, he was an adjunct professor at University of California at Berkley, and he is now an adjunct professor at your school, both part of the University of California. Because my allegations involve academic fraud, I would assume that they should be conveyed to the dean of the division of the institution where the professor currently is employed.

The details of the complaint are contained in the attached letters from me to Professor Nimmer and Morgan Chu, a partner at Irell & Manella who once was and may still be an adjunct

¹ David Nimmer, *Copyright in the Dead Sea Scrolls - Authorship and Originality*, 38 HOUS. L. REV. 1 (2001). The entire article is available at http://www.houstonlawreview.org/archive/downloads/38-1_pdf/HLR38P1.pdf.

Professor at UCLA. If I have stated anything inaccurately in these letters, please note that I have given Nimmer and Chu every possible opportunity to respond with any corrections, but, they have chosen to ignore these charges and I have patiently waited for months to give them time to respond.

As you can see from those letters, I have described a situation where in my opinion Professor Nimmer deliberately misrepresented that he and Irell & Manella, were attorneys on the side of the successful party in a landmark decision regarding the copyrightability of the text of legal opinions, *Matthew Bender v. West*, 158 F.3d 674 (2d Cir. 1998), *aff'g*, No. 94 Civ. 0589, 1997 WL 266972 (S.D.N.Y. May 19, 1997), *cert. denied sub. nom. West v. Hyperlaw*, 526 U.S. 1154 (1999).

This is not true. In fact, the opposite is true. My company, HyperLaw, was the only party with regard to the text issue, and HyperLaw's attorneys, Carl Hartmann and Paul Ruskin, were the only counsel participating in the trial on text, West's appeal, and HyperLaw's successful contest of the petition for certiorari. I know this personally because, being an attorney and graduate of the University of Chicago Law School as well as the owner of HyperLaw, I provided support in the litigation, and am personally aware of exactly what positions were advocated by Professor Nimmer and Irell & Manella and their client.

Professor Nimmer's apparent deception takes advantage of the possible confusion that exists because the standard short form case citations of both the text and citation Second Circuit opinions include only the name of Nimmer's client Matthew Bender.² A full Bluebook citation of the text case would have included HyperLaw v. West as the case name in the certiorari citation of the text opinion.

As one example, Professor Nimmer's discussion at pages 47-49 can only be read in my opinion to convey falsely that he and his firm had filed an opposition to West's petition for certiorari on the text appeal. I draw no other conclusion from pages 47-49 and the egregious out of place footnote 187. This representation is patently preposterous for a simple reason. At the Second Circuit appeal of the text case, Reed Elsevier, owner of Lexis and soon to acquire Matthew Bender, filed an amicus brief *supporting West and opposing HyperLaw*. Between the time of the Second Circuit appeal and the filing of the petition for certiorari by West, Matthew Bender (Nimmer's and Chu's client) was in fact acquired by Reed Elsevier.³ Thus Nimmer's client was

² There was a companion decision concerning the copyright to West's citations, *Matthew Bender v. West Publishing Co.*, 158 F.3d 693 (2d Cir. 1998), *cert. denied*, 526 U.S. 1154 (1999), in which Nimmer and his firm, as well as HyperLaw and its counsel, were jointly parties. Although Nimmer's article cites both cases, the article concentrates on HyperLaw's text decision. The article deliberately conflates the two decisions so that Nimmer appears to have been successful counsel on the text issue, when his client actually opposed the winning position.

³ Although Reed Elsevier's acquisition of Matthew Bender from the Times Mirror Company was not consummated until July 31, 1998 the acquisition agreement was signed April 27, 1998. Even earlier, Times Mirror and Reed Elsevier had been collaborating starting at least with a 1996 joint venture to operate Shephard's. Then Reed Elsevier agreed to provide the text of its case law on Lexis to Matthew Bender. Reed Elsevier's Amicus Brief was filed September 29, 1997 and the Second Circuit decision was issued on November, 3, 1998. Unquestionably, West's petition for certiorari on the text issue was filed after Nimmer's client Matthew Bender had been acquired by Reed

by the time of the petitions for certiorari Reed Elsevier, *which was opposing HyperLaw on this text issue*. So, it is absurd for Nimmer to make his implicit claim on page 49, following a discussion of the text issue.

Thus, none of Matthew Bender, Irell & Manella, David Nimmer, Morgan Chu, Lexis, or Reed Elsevier supported HyperLaw's successful challenge to West with regard to text.

This case was, and is, of importance for the public interest and in defining the scope of public domain in copyright law. The importance of the case is of course demonstrated by Professor Nimmer devoting so much of a scholarly article to the case and to Morgan Chu's most recent references. *See below*.

My complaint does not allege sloppiness, negligence or mistake. The complaint does not involve poor scholarship. Professor Nimmer's article is in my view deliberately deceptive. The article manipulates the confusion of case captions and relies as well on Professor Nimmer's reputation in the field of copyright law. Nor would failing memory due to lapse of time be a factor; Professor Nimmer's participation in the case occurred only a year or two prior to the writing of the article.

The reason that my complaint comes years after the publication is that I was not aware of Professor Nimmer's article until April, 2008 when Morgan Chu was quoted in a Law.com article as having made similar misstatements. I then asked Chu if the misrepresentations had in fact been made by Chu, but he did not respond to my multiple requests. This silence prompted my research to ascertain whether others had conflated the cases and that is when I discovered the article by Chu's partner David Nimmer. Among other things, the lack of response from Professor Nimmer and Mr. Chu establishes the continuing economic and reputational importance of the misrepresentations.

I would like to close with a statement in Judge Martin's ruling on HyperLaw's request for attorneys' fees in *Matthew Bender v. West*.⁴ I suggest that this statement be compared to the somewhat self-serving view of reality presented in Nimmer's Dead Sea Scrolls article, oddly enough with metaphors to biblical antiquity as well.

When David vanquished Goliath, the Israelites rewarded him by making him their King. While Hyperlaw's vanquishing of West's monopoly over judicial opinions may be far less impressive, all it asks for its efforts is that it be reimbursed for the substantial legal fees

Elsevier. Still unexplained is the relationship between these events and the settlement agreements between West and Lexis (Mead) resulting from the *West v. Mead* case, wherein Mead licensed text and citations from West and agreed not to challenge West claimed copyrights in case law.

⁴ *Matthew Bender v. West*, No. 94 Civ. 0589, (S.D.N.Y. July 2, 2001) (awarding attorneys' fees to HyperLaw) *rev'd*, No. 1-7850 (U.S.C.A. 2nd Cir.. July 17, 2002) (denying attorneys' fees to HyperLaw for failing to establish bad faith on the part of defendant West.) See www.hyperlaw.com/westlit/litdocs/2001-07-02-Martin-J-District-Court-Atty-Fee-III.html and www.hyperlaw.com/westlit/litdocs/2002-07029-01-7850_ATTY-FEE-IV.pdf. The Second Circuit had in its earlier decision at *Matthew Bender v. West*, 240 F.3d 116 (2001) denied attorneys' fees to HyperLaw because it found that West's claims for copyright in the text of its opinions were "objectively reasonable."

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West forced it to incur in order to vindicate the public's right of access to judicial opinions. It prevailed against an adversary that did all that it could to make this litigation as expensive as possible, no doubt hoping that a small company such as Hyperlaw would not stay the course. In these circumstances, the court continues to be of the view that Hyperlaw is entitled to an award of the entirety of its attorneys' fees.

I await the courtesy of your reply.

Sincerely



Alan D. Sugarman

cc: Professor David Nimmer
Morgan Chu, Esq.
Carl Hartmann, Esq.
Paul Ruskin, Esq.

Attachments:

Excerpts from Houston Law Review Article With References to *West v. Bender* Marked for Emphasis with Comments.

Letter of April 4, 2008 to Morgan Chu et al.

Letter of May 17, 2008 to David Nimmer, Morgan Chu, and Elliot Brown.

Letter of May 27, 2008 to David Nimmer and Morgan Chu.

Letter of May 29, 2008, to Dean Schill.

Letter of June 6, 2008 from Dean Schill.

Excerpts from Reed Elsevier Amicus Brief, United States Court of Appeals for the Second Circuit, re the HyperLaw text appeal, Docket No. 97-791, dated September 29, 1997.

Excerpts from the Second Circuit text decision in *Matthew Bender v. West* dated November 3, 1998, 158 F.3d 674, Docket No. 97-7910.

Excerpts from West's Petition of Certiorari to the U.S. Supreme Court re Docket re 158 F.3d 674 (2nd Cir., Docket No. 97-7910).

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Excerpt from the 1998 10-K of the Time Mirror Company showing the acquisition of Matthew Bender by Reed Elsevier on July 31, 1998.

Eriq Gardner, An Operating System for Law: Online Cases, IP Law & Business, Law.Com, March 31, 2008, with quotations attributed to Morgan Chu conflating the two Matthew Bender opinions and thus apparently taking credit for being counsel on both opinions.

Note: A pdf version of this letter and attachments may be downloaded at this non-public url:
<http://www.hyperlaw.com/private-temp/issue.pdf>

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June 30, 2008

Via E-Mail inquiry@houstonlawreview.org

Stephanie Cecere
Editor-in-Chief
Houston Law Review
100 Law Center
Houston, TX 77204-6060

Dear Ms. Cecere:

I enclose recent correspondence to the Dean of UCLA Law School and Professor David Nimmer relating to misrepresentations I believe were made in an article in the Spring 2001 Edition of the HOUSTON LAW REVIEW, Volume 38, Number 1, David Nimmer - COPYRIGHT IN THE DEAD SEA SCROLLS: AUTHORSHIP AND ORIGINALITY (PP.1-218).

I would be most appreciative were a correction notice to be added to the beginning of your on-line version of the article,¹ as follows:

This article discusses and cites to two separate Second Circuit opinions, both bearing the same name, *Matthew Bender v. West*. One opinion concerns a challenge to West's claimed copyrights in citations, in which the prevailing parties were Matthew Bender and the intervenor HyperLaw, Inc. The second opinion relates to a challenge to West's claimed copyrights in the text of West's versions of judicial opinions, for which the only prevailing party was the intervenor, HyperLaw, Inc. Matthew Bender did not participate in that part of the case. Most of the citations in this article are to the latter text opinion. The author was not counsel in that part of the case. The Houston Law Review, which should have vetted the article more thoroughly, regrets any implications to the contrary.

I am not asking for the correction notice simply due to a "mistake" previously made. The errors would have been corrected at the time had the law review editors simply read the first page of the appellate decisions, if compliance with Bluebook form had been insisted upon, and perhaps if the editors resisted any faculty pressure if such existed. As the attached letters show, my belief is that the claimed misrepresentations were not a result of mistake and may constitute academic fraud.

I also ask that you request Westlaw and Lexis to add the same correction to the on-line versions of the article.

¹ The Table of Contents for this issue is at your web site, <http://www.houstonlawreview.org/archive/hlrtc38n1.html>, and the article appears at http://www.houstonlawreview.org/archive/downloads/38-1_pdf/HLR38P1.pdf.

Sincerely

A handwritten signature in cursive script, reading "Alan D. Sugarman".

Alan D. Sugarman

cc: Professor David Nimmer
Morgan Chu, Esq.
Carl Hartmann, Esq.
Paul Ruskin, Esq.

Attachments:

Letter of June 30, 2008 to Dean Schill with multiple attachments. (Note: A pdf version of that letter and attachments may be downloaded at this non-public url:
<http://www.hyperlaw.com/private-temp/issue.pdf>)

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April 5, 2008

Morgan Chu
Elliot Brown
Irell & Manella LLP
1800 Avenue of the Stars
Suite 900
Los Angeles, CA 90067-4276

Professor Lawrence Lessig
Stanford Law School
Crown Quadrangle
559 Nathan Abbott Way
Stanford, CA 94305-8610

Dear Morgan, Elliot and Larry:

Earlier this week, an article appeared in Law.Com written by Eriq Gardner concerning, among other things, the Mathew Bender and HyperLaw litigation against West Publishing Company.¹ Morgan was quoted in the article. Larry was mentioned, and perhaps was a source for the article, although, I assume that Larry did not gloss over justiciability.

We are all aware reporters do not always appreciate the subtleties of legal publishing, litigation and intellectual property, and this reporter certainly did miss the mark in many respects.

I am writing just to ask your cooperation, when you discuss litigation with reporters, that you point out that there were two decisions in the Matthew Bender-HyperLaw litigation: one related to the citation and the other relating to the copyrightability of the text of the court opinion as modified by West's enhancements.

Only Hyperlaw was involved in the part of the case and trial relating to the text. Matthew Bender specifically opted out of involvement in the text motions, trial, and appeals. Interestingly, on the text decision appeal, Reed Elsevier (which owns Lexis) filed a brief opposing HyperLaw, and soon thereafter Reed Elsevier acquired Matthew Bender. Even

¹ "An Operating System for Law: Online Cases" By Eriq Gardner; IP Law & Business, Law.com. March 31, 2008. <http://www.law.com/jsp/legaltechnology/pubArticleLT.jsp?id=1206700930604>

April 5, 2008

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the United States Department of Justice would not file an amicus on the text claims, though it did on the citation claims.

There were two distinct opinions of the Second Circuit, and two distinct petitions for certorari. Carl Hartmann and Paul Ruskin represented HyperLaw on both parts of the case, although I was quite involved as well in the representation of HyperLaw.

Of course, we were quite chagrined when we were denied attorney's fees in the unpublished Second Circuit opinion, which has received little discussion. In my view the fee opinion chills those who defend against baseless copyright claims. Having not received fees (i.e., not paid) and having engaged in a pure pro bono activity, at least we would like the "history" to reflect our "contributions."

Of course, we had a terrific relationship with Irell & Manella, and they provided much intellectual and other support in these cases and even on the text issue.

HyperLaw still exists as a company, although, I earn my living practicing law.

Notwithstanding, HyperLaw is compiling, formatting, and hosting local zoning opinions on its web site at present, initiated because of a zoning matter I am handling.

HyperLaw this past year has completed and successfully tested in production a software system to collect and host United States District Court opinions and associated meta-data, but, I do not wish to release a product where we cannot assure that all opinions have been collected. Nor am I inclined to dump the opinions into a formless repository or to fund public access to these decisions.

HyperLaw still has res judicata protection against claims from West Publishing should it decide to copy and publish West opinions. It is my thought that Yahoo, Microsoft, or Google would rather buy HyperLaw, than relitigate against West.

Best regards.

Sincerely

A handwritten signature in cursive script, reading "Alan D. Sugarman".

Alan D. Sugarman

cc: Elliot Brown ebrown@irell.com
Carl Hartmann
Paul Ruskin

Morgan Chu, mchu@irell.com
Lawrence Lessig, Lessig@pobox.com

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May 17, 2008

Professor David Nimmer
Mr. Morgan Chu, Esq.
Mr. Elliot Brown, Esq.
Irell & Manella LLP
1800 Avenue of the Stars
Suite 900
Los Angeles, CA 90067-4276

Re: Nimmer and Irell & Manella Continuing Misstatements Concerning
Bender v. West and the Copyright of Text of Judicial Opinions

Dear David, Morgan, Elliot:

I am following up on my letter to Morgan Chu and Elliot Brown of April 5, 2008, concerning an article in Law.Com written by Eriq Gardner, which misstated the circumstances of the Mathew Bender and HyperLaw declaratory judgment copyright litigation against West Publishing Company.¹ I have not received a response either to the letter or to my subsequent e-mail.

The Gardner article, which quoted Chu, described a single appellate decision in the Bender v. West litigation, but as you well know, there were two decisions, one about citations and the other about text.² Chu, as quoted in the article, seemed to conflate the two decisions and to thereby take credit for having won the judgment that West's enhanced text could not be copyrighted. This is not accurate and also obscures an understanding of the context of this case and the objectives of the parties.

¹ "An Operating System for Law: Online Cases" By Eriq Gardner; IP Law & Business, Law.com. March 31, 2008 at <http://www.law.com/jsp/legaltechnology/pubArticleLT.jsp?id=1206700930604>.

² The appellate decisions in the Matthew Bender litigation, cited as required by the Bluebook, are as follows:

The text appeal: Matthew Bender v. West, (2nd Cir. 1998), *aff'g*, No. 94 Civ. 0589, 1997 WL 266972 (S.D.N.Y. May 19, 1997), *cert. denied sub. nom.*, West v. Hyperlaw, 526 U.S. 1154 (1999).

The citation appeal: Matthew Bender v. West Publishing Co., 158 F.3d 693 (2d Cir. 1998), *aff'g*, No. 94-Civ. 0589 (S.D.N.Y. November 22, 1996 and March 12, 1997), *cert. denied*, 526 U.S. 1154 (1999).

I had assumed the writer Eriq Gardner misunderstood what he was told by Chu.

Now, I am not so sure for, after Gardner's article, I decided to look at other commentary on the case.

To my surprise and dismay, I learned that Chu's 2008 reported statements closely paralleled and reissued the statements in David Nimmer's 2001 article in the Houston Law Review: David Nimmer, *Copyright in the Dead Sea Scrolls - Authorship and Originality*, 38 HOUS. L. REV. 1 (2001) (hereafter the "Article").³

Anything written by David Nimmer in the copyright field, especially on a case where he claimed to have been counsel, will be taken seriously. Nimmer is a Professor at UCLA Law School, as well as of counsel for Irell & Manella. He is the current author for the copyright law treatise bearing his father's name, considered to be the standard reference in the field, and published by Reed Elsevier.

The Nimmer article extensively discusses the Matthew Bender litigation in as many as twenty seven pages. The Article focuses upon the HyperLaw text copyright side of the case. The article cites to the HyperLaw's text opinion twenty two times, but to the Bender-HyperLaw citation opinion only 4 times. The Article scantily, if ever, advises the reader that there were two opinions in the case: the HyperLaw text opinion and the joint HyperLaw-Matthew Bender citation opinion.

Despite addressing mostly the HyperLaw text opinion in the Article, Nimmer defines "Bender v. West" to apply only to the citation opinion and case, and then stated he was counsel for Matthew Bender in "Bender v. West" (see below.) Yet, subsequently, he inconsistently applies the term "Bender v. West" to the text case and decision as well as the citation case and decision. But, Nimmer and Irell & Manella was not counsel in the trial and appeal for the text opinion, the focus of his Article.

Just to be clear, the appeal of the citation case was an appeal from the Summary Order of Judge John Martin of March 12, 1997.⁴ Judge Martin certified his November 22, 1996 citation bench opinion for appeal. I think Judge Martin's quotation is pretty clear:

"The issue of West's copyright interest in its pagination is the only issue present in the action by Matthew Bender. While other issues are presented in the Hyperlaw action they are totally distinct from the pagination issue."

³ The entire article is available from the Houston Law Review at http://www.houstonlawreview.org/archive/downloads/38-1_pdf/HLR38P1.pdf. Excerpts from the article referring to the Matthew Bender case have been posted, as fair use, at HyperLaw's web site at <http://www.hyperlaw.com/docs/2008/2001-excerpts-re-Bender-Hyperlaw-Nimmer-Houston-Law-Review-Article.pdf>.

⁴ <http://www.hyperlaw.com/westlit/litdocs/1997-03-12-Summary-Order-Citation.html>

Having falsely implied that Irell & Manella represented a party in the HyperLaw text case, what Nimmer neglected to state was that he and Irell & Manella and Matthew Bender were neither counsel nor party in the HyperLaw text part of the case. Nimmer also neglected to state that, by the end of the case, his client was no longer Matthew Bender, but Reed Elsevier, and, that at least from 1996, Reed Elsevier, which opposed HyperLaw on the text issue, was influential in directing the case.

Nimmer never clarifies that he and Irell & Manella were counsel only with regard to the citation part of the case. To the contrary, Nimmer conflates the two decisions in such a way as to make it appear falsely that Matthew Bender and Irell & Manella were the successful parties and counsel for both sets of decisions. Actually, Nimmer is never even very clear that there were two, rather than one, Second Circuit opinions, so intent was Nimmer on conflating the opinions.

Not only is this completely untrue, since HyperLaw and its attorneys were the only party and counsel on the text issue, Nimmer's implication is preposterous. Irell & Manella and Matthew Bender had nothing to do with the trial, appeal, and petition for certiorari concerning this issue. HyperLaw's initial complaint raised the text issue clearly and unmistakably; Matthew Bender's original complaint avoided the text issues altogether.

Indeed, the real party in interest behind Matthew Bender had become Reed Elsevier, which on the text issue took a position in the same case as amicus opposing HyperLaw. In 1997, Reed Elsevier and the Proskauer law firm filed an aggressive amicus brief before the Second Circuit opposing HyperLaw in the text case.

As disclosed in Time Mirror's SEC filings and new reports, during much of the litigation, Matthew Bender and Reed Elsevier were in a "strategic partnership" operating Shephard's. Subsequently, Reed Elsevier acquired Matthew Bender - after the appellate oral argument, but prior to the Second Circuit opinions. Certainly, when the petitions for certiorari were filed, Reed Elsevier owned Matthew Bender.

I will now provide more detail as to the foregoing statements.

Nimmer's article appears to be carefully written in such a way to not only not mention these salient facts, but to diminish if not conceal HyperLaw's part in the case. Nimmer's limited definition of, and then inconsistent use of, the term "Bender v. West" is revelatory.⁵

Nimmer's extensive discussion of the "Matthew Bender" case begins in Section IV at page 44.

⁵ Nimmer states in his first footnote that Professor Craig Joyce edited the article three times.

As the section's preface, he quotes Judge Jacobs from the text appeal, providing a footnote citing the text appeal, 158 F. 3d 674, but with an incomplete citation. The citation in footnote 163 excludes the phrase "*sub nom. West v. HyperLaw*", ignoring all standard citation rules as to citing a case where the case name is changed on appeal.⁶ Had the citation been properly formed, a reader right from the start of this section would have been apprised that the party of interest in the text appeal was HyperLaw, not Matthew Bender.

Only three lines into this introductory section on page 44, Nimmer defines the term "the Bender v. West" case by citing in the footnote only to the citation case at page 693, ignoring the text opinion at 158 F. 3d 674. Footnote 165 states:

¹⁶⁵. 158 F.3d 693 (1998), *cert. denied*, 526 U.S. 1154 (1999). Along with my colleagues Morgan Chu, Elliot Brown, and Perry Goldberg, I represented Matthew Bender against West Publishing Company at all three court levels.

This would be a true statement if referring only to the citation decision 158 F.3d 693, but absolutely untrue if suggesting to a reader that Nimmer was counsel in the text decision. Nimmer had just cited the text decision as 158 F. 3d 674 in footnote 163 in a way so as to obscure HyperLaw's involvement.

Nimmer has now defined Bender v. West as meaning only the citation case for the purpose of stating that he and Irell & Manella had been counsel for Matthew Bender. This is a disingenuous definition, for Nimmer then uses the term "Bender v. West" in a

⁶ ALWD Manual, Rule 12.10(b); Bluebook Rule 10.7.2, University of Chicago Manual of Legal Citation Rule 4.2(c). Oddly, or as an attempt at covering up what he was going to do, Nimmer states in his first footnote to his Article: "

"The citation form used in this address conforms to the author's preferences."

Nimmer provided five other "full" citations to the text case at footnotes 472, 519, 556, 686, and 710 - all of which should have included "*sub. nom West v. HyperLaw*", but did not.

There are many different citation forms - but, citation form does not mean obscuring citation substance. For example, in footnote 556 on page 114, Nimmer cites the district court text decision which led to the Second Circuit text appeal at 158 F.2 674 as follows:

"Hyperlaw v. West, No. 94 CIV. 0589, 1997 WL 266972, (S.D.N.Y. May 19, 1997)."

Nimmer here leaves out (ignoring what any law student is taught on the first day of a legal writing course) the citation to the affirming Second Circuit opinion.

Nimmer in footnote 556 chose to refer to the district court text case below as HyperLaw v. West rather than Matthew Bender v West. By so doing, he again obscured the connection between the district court decision cited in footnote 556 and the affirming appellate opinion which he dwells on throughout the article. See discussion below.

broader sense to apply both to the citation issues as well as mostly to the HyperLaw text case where Nimmer and Bender were neither counsel nor party.

The article proceeds for 27 pages to discuss mostly the text case while conflating the two issues and decisions. It is true that a suspicious and careful reader possibly might catch that the citation to the HyperLaw text opinion in footnote 163 is slightly different than the citation to the citation opinion in footnote 165. But, even the most careful reader would not know that the appeal referred to in footnote 163 was an appeal from the district court case cited in footnote 556 on page 114, which I discuss below.

Not only were Matthew Bender and Irell & Manella quite simply not involved in the HyperLaw text case, but, indeed, in 1996, we believed Matthew Bender gratuitously provided arguments about text in an attempt to subvert HyperLaw's position by suggesting in its summary judgment motion on citation on August 5, 1996, that the text "emendations" might be copyrightable, but the copyright was unenforceable due to copyright abuse. Carl Hartmann, one of HyperLaw's attorneys, remembers the ensuing harsh conversation with Elliot after this was filed. Or perhaps, even then, Irell & Manella was planning on having it both ways. Another possibility is that Matthew Bender concurred with the point I had made in my original complaint, that the citation copyright claimed by West was a citation to cases that, even though enhanced, were not copyrightable.

Matthew Bender was then under the control or working in concert with Reed Elsevier which owned Lexis. Although Reed Elsevier clearly wished to see the overruling of the *West v. Mead*⁷ citation ruling, it did not wish to see a ruling on the copyrightability of enhanced text.

Lexis had always worked through or supported surrogates to overturn *West v. Mead*. In 1992, Lawyer's Cooperative⁸ was instrumental in the proposal of legislation to overturn the *West v. Mead* citation decision. At the hearing on this legislation, I submitted a proposal to extend the legislation to additions, corrections, and modification of judicial opinions.⁹ My text proposal was met with stony silence by the assembled legal

⁷*West v. Mead*, 616 F. Supp. 604 (D. Minn. 1985), *aff'd*, 799 F.2d 1219 (8th Cir. 1986), *cert. denied*, 479 U.S. 1070 (1987).

⁸ Lawyers Cooperative 1992 was then under the aegis of Katherine M. Downing, who in 1993 became President and Chief Executive Officer of Lawyers Cooperative.. In 1995-96, she became, President and Chief Executive Officer of Matthew Bender. During the litigation of *West v. Mead*, she was employed by Mead-Lexis and her responsibilities included that litigation.

⁹ Irell & Manella extensively, without any attribution, used my "work-product" consisting of my advocacy in other arenas against West including the inconsistent positions taken by West before the Wisconsin Supreme Court which was considering a public domain citation. I was the primary advocate pressing West on its inconsistent positions. In its summary judgment submission (see Nimmer's footnote 556 discussed below) Irell & Manella referred to the Wisconsin Supreme Court hearings and also pointed out that West's expert Robert Berring was a West consultant. But, it was not Matthew Bender or Irell & Manella who attacked Berring before the House Judiciary Committee and the American Association of Law Libraries for

publishers and the congressional staff (Bill Patry, interestingly, was then counsel for the committee.) Later, the Department of Justice lined up against our position on text, and, as we see, eventually, so did Reed Elsevier-Lexis.

A major reason I intervened in 1994 in Matthew Bender's case against West was that I knew the legal publishers were talking out of both sides when it came to this text copyright issue, and I feared, presciently, that the issue would be compromised in litigation between the largest legal publishers, as ultimately Matthew Bender did as to the so-called Texas-Curtis Hill action. The Matthew Bender complaint filed in February, 1994 sought very limited relief, and no relief as to West's claim to copyright to text. Unlike HyperLaw, Bender did not even have a product on the market, so there were serious justiciability issues. Bender's proposed product was limited to cases from federal courts located in New York State as stated in paragraph 13 of the complaint:

his conflict. It was not Matthew Bender or Irell & Manella who attacked Berring for the same conflict before the Wisconsin Supreme Court. Similarly, I hounded Vance Opperman and West's attorney Schatz etc. in those forums and other forums as to West's inconsistent varying position on their copyright claims to the first page citation. I do not recall Matthew Bender, Nimmer, or anyone else attacking Berring and Opperman at those times.

An example of my activities outside the litigation but related to the litigation is shown in this posting I made on the Law Library mail list on September 16, 1994, the substance of which ended up being reflected in the decisions on the text issue:

Well, not actually so. The trial transcript in the 1988 West v. Mead trial, which was three years after the District Court preliminary injunction decision, subsequently appealed to the 8th Circuit, tells an altogether different story. An average volume of West has 1500 or so pages. The paperbound advance sheets are assembled on a pre-set schedule (i.e., there is a Federal Reporter volume once a week). For the advance sheets, the decisions are assembled based upon what is available. A computer, albeit with control of widows etc, paginates the cases. Once the 1500 page or so limit is reached, a new volume number is assigned. Within an paperbound advance sheet volume, cases are generally but not always organized by court. But, even this arrangement does not exist in the permanent bound volume because the volumes are assembled (sic) from 2 or 3 paperbound advance sheets. The arrangement as finally appears has no usefulness or meaning, so even if one granted to you that there was some creativity, which I do not, the result of the creativity provides nothing of use (that is the order of the cases in the book had no usefulness). Indeed, the span of dates of the decisions in a typical volume spans as much as 4 or 5 months.

See posting of Alan D. Sugarman, Re: West Publishing v. Mead Data Center, September 16, 1994, at <http://www3.wcl.american.edu/cni/9409/3473.html>.

Notably, the silence from Irell & Manella was palpable when HyperLaw moved to recuse the first judge in the case after the judge hosed down Matthew Bender and HyperLaw in discovery determinations. Irell & Manella let HyperLaw do the dirty work, the judge recused herself, and only then, before the new judge, did Irell & Manella complain about the discovery rulings of the first judge. Basically, Matthew Bender had been a free-rider on many issues - which was fine, but, not at the expense of a rewrite of history.

13. Matthew Bender will publish a new CD-ROM publication entitled "Search Master New York Practice Library With Cases". The first release of this publication will be a comprehensive collection of published and unpublished decisions of the Second Circuit Court of Appeals, and the four United States District courts within the State of New York, covering the last five years. Future releases will include earlier years.

By contrast, HyperLaw's complaint was specific, detailed, supported by exhibits, and basically blew the entire case open. HyperLaw was actually publishing its CD - but without the West citations. HyperLaw sought to include West citation to cases from all U.S. courts of appeals in all states- a super-set of the Federal Reporter and sought to copy cases from the Federal Reporter where needed. This was a great expansion of the Bender case, and, it was two years or so later when Mathew Bender followed in HyperLaw's steps, after Reed Elsevier decided to back Matthew Bender by providing the text of the cases. Judge Martin's justiciability decision of May 1, 1996, provides no indication that Matthew Bender was obtaining text from Lexis. Judge Martin describes scanning of cases. Mathew Bender did not even have a product until June of 1995, as stated in its First Supplemental Complaint, and even that was a test product.¹⁰

Anyone can read Matthew Bender's unspecific vague complaint filed as Exhibit 6 to HyperLaw's complaint, and compare the Bender complaint to the complaint that HyperLaw filed four weeks later. HyperLaw's complaint became the road map for the case. HyperLaw was quite clear as to its claims on the text issues, and raised virtually all the legal issues that Bender and HyperLaw would later brief.¹¹ Despite Bender's difficulties in locating the court copies of decisions to scan, Bender appeared to be concerned that others might copy decisions from Bender publications, to assert the right to scan from the West reporters. But, HyperLaw challenged West head-on on this issue.

Despite the confusion sown in the Nimmer article, Matthew Bender and Irell & Manella filed no briefs or other filings in the text case - not in the motion for summary judgment,

¹⁰ Matthew Bender filed a second action in June 1995 in the Southern District, known as the Texas product action, 95 Civ. 4496. This complaint might have included a claim as to West copyrights in text, but, Matthew Bender did not file for summary judgment on the text claims. I do not have the complaint in this case. The case was closed after the citation summary judgment was entered in November, 1996. The docket is not clear, but, as feared by HyperLaw in 1994 as to settlements, it is apparent that West and Matthew Bender entered into a confidential settlement on the text issue, if it was asserted at all in that case. The case was closed on March 14, 1997.

¹¹ HyperLaw's Complaint dated March 9, 1994 and Bender's Complaint dated January 31, 1994 (attached as Exhibit 6 to HyperLaw's Complaint) may be found at http://www.hyperlaw.com/westlit/litdocs/1994-03-07-HLvWest_complaint-with-ex.pdf.

not at the two day trial of the text case (although Elliot Brown observed silently from the back row), not in the form of a post-trial brief, not on the appeal to the Second Circuit and not on the petition for certiorari.

Nimmer's narrative at pages 48 and 49 of the Article is thus all the more misleading. Page 48 is devoted entirely to the text case - and contains four footnotes citing the text case. The fifth footnote, note 187, states

"As noted above, this writer represented Bender. Refer to note 165 supra."

Because Nimmer's footnote appears on page devoted entirely to the HyperLaw's text case and is surrounded by citations to the HyperLaw text appeal, most readers would assume that Nimmer, the writer, represented Bender in the text decisions to which the entire page and other citations on the page are devoted. This is not so. Footnote 165 refers only to the citation case. This is falsehood by context. Although an accurate statement taken out of context, it is materially false in context.

On this same page 48, Nimmer states, in the continuing effort to assert that he and Irell & Manella won the text appeal the following:

"The Second Circuit drops a footnote at this point containing two citations. The first is to a case that counsel for Bender cited both to the district court and Second Circuit.¹⁸⁶"

Anyone reading this sentence would assume, quite in opposition to the truth, that: (1) in the appeal where the Second Circuit "dropped a footnote," Nimmer and Irell and Manella had filed a brief and were representing a party - and (2) the actual party in the district court and the Second Circuit (HyperLaw) had not cited the case, which, of course HyperLaw had. (See page 33 of [HyperLaw's Post-Trial Brief](http://www.hyperlaw.com/westlit/litdocs/1997-03-04-HyperLaw-Post-Trial-Brief.htm) dated March 4, 1997.¹²

Having discussed only the text case on page 48, Nimmer at the top of the very next page, page 49, discusses his involvement in the filing of "a" petition for certiorari, in the singular, to the U.S. Supreme Court for the case.

In any event, West applied to the Supreme Court for a writ of certiorari.¹⁸⁹ The denial of that petition means that Bender v. West now stands as res judicata."

To be clear again: in Bender v. West case, there were **two** petitions filed by West for writ of certiorari, one as to the citation decision, and the other as to the HyperLaw text decision. Matthew Bender and Irell and Manella had **no** involvement in the HyperLaw text petition of certiorari - that was only HyperLaw. Any reader would conclude that the petition to which Nimmer refers on page 49 was the petition for certiorari for text, the

¹² <http://www.hyperlaw.com/westlit/litdocs/1997-03-04-HyperLaw-Post-Trial-Brief.htm>.

only matter to which the entire prior page was devoted. Not so, for the prior page was devoted entirely to an appeal that Nimmer had nothing to do with.

A reader would never know, but Nimmer on page 49 was referring to West's petition for certiorari on the different citation issue. Nimmer here had switched the subject from the HyperLaw text case to the citation case somewhere between the last line of page 48 and the first line of page 49, with no indication to the reader.

Nimmer then states in this same sentence's footnote 189 on page 49, that:

"[O]ur client made a surprising decision -- to join in the certiorari petition to end once and for all West's 'scarecrow copyright' by which it had chased competitors out of the field."

Nimmer fails to disclose that Irell & Mineola's "client" at the time of the citation petition for certiorari in 1998 referred to in footnote 189 was no longer Matthew Bender, but Reed Elsevier. Reed Elsevier had completed its acquisition of Matthew Bender.¹³ And Reed Elsevier had just finished opposing HyperLaw on the very same appeal. So, Nimmer may have wished, three years later or even at the time, that his firm and clients were supporting the text challenge of HyperLaw, but, they were not.

Let's start with the obvious facts to provide more authority to my earlier assertions:

- When Matthew Bender started the case in 1994, it was owned by the Times Mirror Company.
- Reed Elsevier in 1994 then owned and currently owns Lexis (once owned by Mead.)
- Reed Elsevier through Lexis was a party to the license agreement entered into in 1998 when the West v. Mead case was settled with a license agreement, which covered citations and text.
- Lexis would not be required to pay citation royalties to West if the Supreme Court overturned the West v. Mead citation holding.
- In the Mead-Lexis license from West for the use of West's pagination, Lexis was prohibited from challenging the citation holding of West v. Mead, thus Reed Elsevier could not have initiated a case challenging the West citations, such as the one brought by Matthew Bender.

¹³ According to the [Times Mirror Company 1998 10-K](#), the divestiture of Matthew Bender to Reed Elsevier was completed on July 31, 1998, the agreement as to which was reached on April 27, 1998 (see page 70).

- Matthew Bender filed the case in 1994 in February. No sooner was the case underway than Bender and West entered into "settlement negotiations" between June 1994 to February, 1995.
- On July 3, 1996 the Times Mirror Company and Reed Elsevier announced they would jointly acquire Shephard's from McGraw Hill as part of a "broader strategic alliance between Matthew Bender and LEXIS_NEXIS."¹⁴ The New York Times correctly predicted that Reed Elsevier eventually would acquire Matthew Bender.¹⁵
- At some point, in 1996, Matthew Bender disclosed in the Bender v. West litigation that it was now obtaining the text for all of its cases on its CD-Rom product being litigated, not by scanning, but directly from Lexis, and using the search engine of Lexis's subsidiary, Folio.¹⁶ This was a substantial change in Matthew Bender's product and case. Thus Matthew Bender no longer would have had standing to challenge the text copyrights since it was not intending to violate the claimed copyrights of West as to text, unless Lexis wanted to open the can of worms that Lexis also had copied West books. Plus, as it turned out, Matthew Bender's new masters did not want them to make such a challenge to West.

¹⁴ The [Times Mirror Company 8-K of October 15, 2006](#) at page 3 states that Times Mirror signed the agreement to purchase Shephard's on July 3, 1996 and includes the purchase agreement for Shephard's.

¹⁵ The [Times Mirror Company 10-Q of November 5, 2006](#) states:

Subject to the completion of a pending regulatory review, it is anticipated that Shepard's will be contributed, in exchange for cash, to a new 50/50 partnership between the Company and Reed Elsevier, Inc., as part of a broader strategic alliance between Matthew Bender, Times Mirror's legal publisher, and LEXIS-NEXIS, a Reed Elsevier subsidiary and provider of full-text online information services in the legal, news, business and government areas.

* * *

In addition, in the third quarter of 1996, Times Mirror and Reed Elsevier Inc. announced a strategic alliance which includes three elements: first, the formation of a 50/50 partnership to own and operate Shepard's; second, a long-term cross-license agreement to offer Matthew Bender publications online through LEXIS and to provide a significant portion of the LEXIS case law database through Matthew Bender's CD-ROM products; and third, the joint pursuit of other product development and acquisition opportunities. The formation of the partnership with Reed Elsevier is expected to be completed later this year, pending regulatory review.

¹⁶ It is believed that the deal for Matthew Bender to use Lexis to obtain the text of the cases for its CD-ROM was entered into sometime around July 3, 1996. See the [Times Mirror 10-Q of August 14, 1996](#), Page 11, 12. This is the first reference I have found as to a relationship between Lexis and Reed Elsevier. It was on August 5, 1996, that Matthew Bender filed its motion for summary judgment.

- On November 22, 1996, Judge Martin granted summary judgment to both HyperLaw and Matthew Bender on the citation issues. (HyperLaw's text ruling was not until May 19, 1997.)
- On November 27, 1996, five days after Judge Martin ruled against West on the citation issues, Times Mirror Company and Reed Elsevier PLC, continuing the evolution of their relationship, announced completion of the joint venture for Shepard's. Gary Goldstein, key witness in Matthew Bender v. West and the Bender official in charge of the litigation, was appointed General Manager of Shepard's. Effectively, Goldstein had now become a joint employee of Matthew Bender and Reed Elsevier.
- Reed Elsevier on September 9, 1997, by its law firm Proskauer, filed an [amicus brief](#) in the text appeal 97-7910 opposing HyperLaw. (The caption on the brief read "HyperLaw v. West"). This appeal was the text appeal cited twenty-two times in Nimmer's Article.
- In April, 1998, Reed Elsevier and Times Mirror announced the sale of Matthew Bender to Reed Elsevier, and the sale was consummated in July, 1998.
- The Second Circuit decision for both appeals was on November 4, 1998.
- By the time the petitions on certiorari were due to be answered in 1999, Matthew Bender was then owned by Reed Elsevier, which had already filed the amicus brief opposing HyperLaw and supporting.

Nimmer's client was in fact not Matthew Bender, but Reed Elsevier, when in 1999 Nimmer was in Israel working on the petition for certiorari (see page 49 of the Article.) Even earlier than 1998, and probably back to 1996, it is apparent that Reed Elsevier was calling the shots in the litigation. I wonder if the Second Circuit was aware when Proskauer filed the amicus brief that Reed Elsevier and Matthew Bender were in a joint venture.

When Nimmer states in footnote 556 that Bender had filed a motion of summary judgment which led to the district court's May 19, 1997 decision on the copyrightability of West's enhance text, he makes a demonstrably and material false statement:

⁵⁵⁶. In a letter to HyperLaw dated October 9, 1991, West advised that "you should *carefully* compare the enclosed copy of the public domain *slip opinion* in *Mendell* [*v. Gollust*, 909 F.2d 724 (2d Cir. 1990)] to the West *case report* of the same case," claiming that "you will see that the slip opinion and case report vary *substantially* in their selection, coordination, and arrangement of material included." Exhibit 13 to Intervenor Complaint, *HyperLaw, Inc. v. West Publ'g Co.*, No. 94 CIV. 0589, 1997 WL 266972, (S.D.N.Y. May 19, 1997) (emphases in original). In fact, comparison of the opinion portion of West's report of *Mendell v. Gollust* shows it to be letter-for-letter identical to

the slip opinion, except for the addition of parallel citations. Declaration of Michelle Kramer, dated July 31, 1996, **filed in support of Matthew Bender's motion for Summary Judgment**, Ex., 1 at 1, *Hyperlaw v. West*, No. 94 CIV. 0589, 1997 WL 266972, (**S.D.N.Y. May 19, 1997**). (emphasis supplied).

Not only is the claim of having filed a motion for summary judgment on the May 19, 1997 text decision just plain false, the rest of this footnote is even more revealing of Nimmer and Irell & Manella's attempts at hijacking.

- First, footnote 556 states quite incorrectly in the last line that the declaration was:

"filed in support of Matthew Bender's motion for Summary Judgment, Ex., 1 at 1, *Hyperlaw v. West*, No. 94 CIV. 0589, 1997 WL 266972, (S.D.N.Y. May 19, 1997)." ¹⁷

Nimmer's statement is completely untrue. The decision cited was the district court decision concerning the text claims of May 19, 1997. By then, Matthew Bender was done with the district court. Matthew Bender filed no motion for summary judgment for the May 19, 1997 decision and did not participate in the trial of the issue. Nimmer seems here to claim, consistent with the other implied claims in the article that he, Irell & Manella and Matthew Bender litigated the text case and decision, but they did not. This is extraordinary: even though he names the decision as "*HyperLaw v. West*", Nimmer has his firm and Matthew Bender falsely claiming that this decision was a result of Bender and Irell's motion for summary judgment.

- Second, a reader of the entire Article would have no way of understanding that this decision was the decision below from which the appeal at 158 F.3d 674 was taken. In contravention of all citation rules, even common sense citation, Nimmer fails to include the citation here of the Second Circuit affirming opinion, an opinion he has cited twenty other times in his article. I would be surprised if any student editor of any major law review would accept this citation, even, if a famous professor threatened to withdraw the article from publication.
- Third, the implication in Nimmer's footnote, that Bender's provision of my correspondence to the court was some insightful contribution to the text decision, is equally absurd - and feeble. In 1991, I had an exchange of correspondence with West. These letters were so material that I attached them to my specific and

¹⁷ *Hyperlaw v. West*, No. 94 CIV. 0589, 1997 WL 266972, (S.D.N.Y. May 19, 1997), copy at <http://www.hyperlaw.com/westlit/litdocs/1997-05-19-176-Martin-Order-Text.html>. Judge Martin in his order of March 12, 1997 had been unmistakably clear as to Bender's non-participation in this issue when he states:

"The issue of West's copyright interest in its pagination is the only issue present in the action by Matthew Bender."

Copy of order at: <http://www.hyperlaw.com/westlit/litdocs/1997-03-12-Summary-Order-Citation.html>.

documented complaint,¹⁸ to show that West's "enhancements" to Mendell v. Gollust were insignificant. We were very well aware of these letters, thank you. And, Judge Martin was also fully aware of the letters. They were the proverbial smoking gun through the whole case. So, for Matthew Bender to make reference to these letters in an unrelated declaration was nothing more than just getting on the bandwagon. (It is also telling the Matthew Bender was unable itself to present its own compelling evidentiary documentation.) And, then to use the unrelated declaration in a scholarly article to try to create the impression that Matthew Bender litigated the text case, is inappropriate at the very least.

More examples could be provided. Were these misstatements, despite their repetitive nature, a result of sloppiness? Did Nimmer create a deliberate misrepresentation to gain some advantage? Is it not chutzpah for this to be done in an article about originality - although I do admire the creativity?

I am not ignoring the 2008 Law.Com article apparently quoting Morgan Chu to the same effect. Morgan Chu has ignored my request that he correct the article, if he had been misquoted.

Attached are excerpts from the Article. The references to the text appeal are highlighted in yellow, and those to the citation appeal are highlighted in pink. The pink areas are in a sea of yellow highlighted text.

I await your response.

Best regards.

Sincerely



Alan D. Sugarman

cc:

Carl Hartmann
Paul Ruskin

cc by e-mail to:

ebrown@irell.com
mchu@irell.com
nimmer@irell.com24

¹⁸ HyperLaw's March 7, 1994 initial complaint of 210 pages with 24 exhibits may be found at http://www.hyperlaw.com/westlit/litdocs/1994-03-07-HLvWest_complaint-with-ex.pdf. A reading of the Complaint shows how gratuitous and superfluous was the Bender affidavit.

District Court HyperLaw Text Decision:
Matthew Bender v. West, No. 94 Civ. 0589, 1997 WL 266972 (S.D.N.Y. May 19, 1997)
Second Circuit HyplerLaw Text Opinion:
Matthew Bender v. West, 158 F. 3d 674 (2nd Cir. 1998)
Supreme Court Denial of Certiorari for HyperLaw Text Opinion
West v. Hyperlaw, 526 U.S. 1154 (1999)

Second Circuit Text Decision: Matthew Bender v. West, 158 F. 3d 674 (2nd Cir. 1998), aff'g, No. 94 Civ. 0589, 1997 WL 266972 (S.D.N.Y. May 19, 1997), cert. denied sub. nom. West v. Hyperlaw, 526 U.S. 1154 (1999).

HOUSTON LAW REVIEW

ADDRESS

References to HyperLaw Text
Issue highlighted in yellow.
158 F.3d 674

References to Citation Issue
Highlighted in Pink
158 F.3d 693

COPYRIGHT IN THE DEAD SEA SCROLLS

AUTHORSHIP AND ORIGINALITY

*David Nimmer**

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Footnote re
Author's
Preferences re
citation form.

* © 2001 by David Nimmer, Of Counsel, Irell & Manella, Los Angeles, California; Distinguished Scholar, Berkeley Center of Law and Technology. This work was delivered as the Fifth Annual Houston Law Review Lecture Series Frankel Lecture. A number of people were kind enough to react to portions of this work. I thank especially those who offered comments on the whole presentation: Craig Joyce, Dick Lanham, James Oakes, Tim Lim, Michael Birnhack, Mark Rose, Talia Einhorn, Craig Joyce, Peter Jaszi, Ariel Goldstein, Bob Rotstein, Yoni Hoffman, Craig Joyce (his third reading, this time) and Gloria Nimmer (a/k/a "Mom"). Sharon Ben-Shachar and Russell Chorush provided wonderful research assistance.

Unless otherwise noted, all translations from ancient and medieval Hebrew are mine. Yonina Hoffman and Sharon Ben-Shachar translated the modern Hebrew from the Israeli judicial opinions. In general, I transliterate the letter *qof* herein with a "q"—except where a "k" is generally used, such as "Akiva."

The citation form used in this address conforms to the author's preferences.

Second Circuit Citation Opinion
Matthew Bender v. West Publishing Co., 158 F.3d 693 (2d Cir. 1998)

Supreme Court Denial of Certiorari Citation Opinion:
Matthew Bender v. West Publishing Co., cert. denied, 526 U.S. 1154 (1999),

IV.
TO THE MIDDLE EAST FROM WEST

[F]aithfulness to the public-domain original is the dominant editorial value, so that the creative is the enemy of the true.

Judge Dennis Jacobs¹⁶³

The Dead Sea Scrolls, although frequently invoked as an emblem for ancient revelation,¹⁶⁴ actually show up in only one U.S. copyright case. The case is *Bender v. West*.¹⁶⁵ Although it treats copyright in the context of CD-ROMs containing judicial opinions, this opinion actually evinces a good deal of overlap with the case of the Dead Sea Scrolls, *Qimron v. Shanks*.¹⁶⁶

For over a century, West has been the premier reporter of judicial decisions within the United States. Though it serves as official reporter of only a few jurisdictions, for most of the twentieth century it constituted the *de facto* reporter for all federal court decisions, and those of many states as well.¹⁶⁷ In a common law system, the law of the land is contained in judicial systems. Those judicial opinions themselves, according to ancient authority, are not subject to copyright,¹⁶⁸ no matter how creative the judges might

163. *Matthew Bender & Co. v. West Publ'g Co.*, 158 F.3d 674, 688 (2d Cir. 1998), *cert. denied*, 526 U.S. 1154 (1999).

164. Previous references in U.S. case law to the scrolls used them as an archetype for a blockbuster revelation:

Since 1983, no new information has come to light that would make this court better informed about the intent of the 1871 Congress than the Supreme Court was informed in 1983. The legislative-history equivalent of the Dead Sea Scrolls has not been discovered or called to our attention.

Lyes v. City of Riviera Beach, 166 F.3d 1332, 1352–53 (11th Cir. 1999) (footnote omitted) (en banc) (Edmondson, J., concurring in part and dissenting in part). See also Joel D. Berg, *The Troubled Constitutionality of Anti Gang Loitering Laws*, 69 CHL-KENT L. REV. 461, 469 n.61 (1993) (“[M]any laws are incomprehensible to many lawyers; laypersons may just as well try and translate the Dead Sea Scrolls rather than waste their time trying to figure out what the law either commands or forbids.”).

165. 158 F.3d 693 (1998), *cert. denied*, 526 U.S. 1154 (1999). Along with my colleagues Morgan Chu, Elliot Brown, and Perry Goldberg, I represented Matthew Bender against West Publishing Company at all three court levels.

166. Refer to Chapter V *infra*.

167. See L. Ray Patterson & Craig Joyce, *Monopolizing the Law: The Scope of Copyright Protection for Law Reports and Statutory Compilations*, 36 UCLA L. REV. 719, 727 n.21 (1989). See also 1 F. Cas. iii (1894) (West refers to itself as “the official reporter of the federal courts”); *Garfield v. Palmieri*, 193 F. Supp. 137, 143 (S.D.N.Y. 1961), *aff’d*, 297 F.2d 526, 527–28 (2d Cir. 1962) (holding a judge’s forwarding of the court’s opinion to West for publication immune from liability as part of the judge’s *official* duties).

168. *Callaghan v. Myers*, 128 U.S. 617, 661–62 (1888); *Banks Law Publ'g Co. v.*

Citation Case #1

Text Case #1

have been in crafting their words.¹⁶⁹ Thus, a researcher in, say, 1985, although free under copyright law to access judicial opinions anywhere, as a practical matter could do so only through the instrumentality of West's reporters. West's product as of that date was not only *nonpareil* but also effectively unchallenged by any competitor.

West successfully excluded competitors from the field via an early skirmish held in 1986.¹⁷⁰ Despite the harsh criticism that that decision attracted,¹⁷¹ it provided West with a litigation juggernaut that lasted for over a decade. Then, legal publisher Matthew Bender & Company decided to take on West by publishing on CD-ROM its own rival compilation of cases, **some indirectly derived from West's reporters**. Bender included references to West pagination in its CD-ROM, inasmuch as that pagination is required to cite cases to courts and in legal scholarship. In addition, Bender included what can be termed "the *textus receptus* of judicial opinions," which is the manner in which West publishes them in its quasi-official reporters. Bender filed for declaratory relief that it did not violate West's copyright in the process.¹⁷²

At base, *Bender v. West* presented two copyright issues for resolution. First, conceding that the judges' opinions themselves were not subject to protection, West claimed copyright in the pagination of its case reporters.¹⁷³ Second, West claimed copyright in emendations to the opinions themselves.¹⁷⁴ If

Lawyers' Coop. Publ'g Co., 169 F. 386, 390–91 (2d Cir. 1909), *appeal dismissed*, 223 U.S. 738 (1911). Cf. *Wheaton v. Peters*, 33 U.S. (8 Pet.) 591, 613 (1834) (finding law reports "objects of literary property"). See also *West Publ'g Co. v. Mead Data Cent., Inc.*, 799 F.2d 1219, 1239 (8th Cir. 1986) (Oliver, J., dissenting in part). On the early practices in the United States of judicial reporting, leading up to *Wheaton v. Peters*, see Craig Joyce, *The Rise of the Supreme Court Reporter: An Institutional Perspective on Marshall Court Ascendancy*, 83 MICH. L. REV. 1291 (1985).

169. From the beginning, judges have expended tremendous creativity in the task of judicial interpretation. See generally Susanna L. Blumenthal, *Law and the Creative Mind*, 74 CHI.-KENT L. REV. 151 (1998). Nonetheless, that type of creativity, like the creativity that goes into a scientific breakthrough, has never warranted copyright protection. Refer to Case 6 (The Atom) *supra*; Case 14 (Fermat) *supra*.

170. *West Publ'g Co.*, 799 F.2d at 1222.

171. See, e.g., *Monopolizing the Law*, *supra* note 167, upon which the Supreme Court repeatedly relies in *Feist*.

172. Another legal publisher, HyperLaw, intervened as a party plaintiff to vindicate a similar claim. The companion cases discussed below arose from West's losses to Bender and HyperLaw, respectively.

173. *Matthew Bender & Co. v. West Publ'g Co.*, 158 F.3d 674, 695 (2d Cir. 1988), *cert. denied*, 526 U.S. 1154 (1999). Note that the custom of pagination goes back to antiquity. *Between Volumnen and Codex*, *supra* note 146, at 88. Use of Arabic numerals for this purpose dates back to 1516. *THE PRINTING PRESS AS AN AGENT OF CHANGE*, *supra* note 17, at 106 n.202.

174. *Bender*, 158 F.3d at 677.

Citation Case #2

Text Case #2

accepted, West's copyright claim would prevent Bender and others from producing usable case compilations on CD-ROM.

Before explicating the legal issues, it is necessary to exclude from consideration the uncontroversial aspects of West's copyright. All parties admitted for purposes of the litigation that West enjoyed copyright protection over its case reporters as a whole, insofar as those volumes include syllabi authored by West, summarizing the holdings of each case; key numbers, by which West categorized individual components of those cases; headnotes that West generated, encapsulating each holding represented by a key number; and other ancillary material, such as tributes and prefaces at the beginning of individual volumes and indices at the end of those volumes. The nub of the disagreement between the parties concerned the following:

Pagination. Except for very short opinions, the text of any given case begins on one page and then continues, from page to page, across the reporter. Citations to opinions, by practice and individual court order,¹⁷⁵ must be to the particular page in which the cited proposition occurs; for example: 171 F.2d 318, 320. West contended that reprinting public domain judicial opinions, along with a notation as to where the subject break occurred in the West reporters—in the foregoing example, of the form “*320”—violated West's pagination copyright.

Emendations. Before publishing opinions, West “massages” those opinions in various ways. Thus, the final text of an opinion as it appears might contain numerous differences from the way that the judge authored it. For instance, the judge might refer to “*Feist Pub. v. Rural Tele. Co.*, 499 U.S. 340 (1990).” When the reference appears in a West case reporter, it could be printed in the following format: “*Feist Publications, Inc. v. Rural Telephone Service Co.*, 499 U.S. 340, 113 L. Ed. 2d 358, 111 S. Ct. 1282 (1990).” Again, by practice and individual court order, quotations to opinions must be in the latter formulation.¹⁷⁶

In addition, courts do not collect names of attorneys. West includes information as to attorney names. Of necessity, West chooses, among various options, how to present the names of

175. See, e.g., 3D CIR. R. 28.3(a). For a catalog of many such local rules, see *Monopolizing the Law*, *supra* note 167, at 727 n.21.

176. It is for that reason that West's emendations effectively constitute the “*textus receptus* of judicial opinions,” as claimed above.

counsel. In terms of subsequent history of cases and in other allied respects, West also adds features to its reporters.¹⁷⁷

The Second Circuit denied West's claims in two companion opinions.¹⁷⁸ Those opinions explicate copyright's standard for "originality" as requiring "that the work result from 'independent creation' and that the author demonstrate that such creation entails a 'modicum of creativity.'"¹⁷⁹ The former simply means that the work was not copied from a prior source.¹⁸⁰ The latter means that certain works, notwithstanding the absence of copying, are too banal to warrant copyright protection.¹⁸¹

As to star page numbers corresponding to the breaks in pagination in West's reporters, the Second Circuit relied on West's concession that the page breaks in its reporters were inserted by computer, applying rote methodology, rather than through the exercise of any human creativity. The court also cited an alternative rationale, discussed below.¹⁸²

As to the various alterations that West imbued into the judicial opinions, the court conceded that the threshold for creativity is low in order to achieve copyright protection, "even in works involving selection from among facts."¹⁸³ Nonetheless, even

177. The emendations are slightly more complicated than the foregoing summary. As summarized by the Second Circuit, West claims originality in the following enhancements:

??The format of the party names—the "caption"—is standardized by capitalizing the first named plaintiff and defendant to derive a "West digest title," and sometimes the party names are shortened (for example, when one of the parties is a union, with its local and national affiliations, West might give only the local chapter number, and then insert "etc.").

??The name of the deciding court is restyled. For example, West changes the slip opinion title of "United States Court of Appeals for the Second Circuit" to "United States Court of Appeals, Second Circuit."

??The dates the case was argued and decided are restyled. For example, when the slip opinion gives the date on which the opinion was "filed," West changes the word "filed" to "decided."

??The caption, court, docket number, and date are presented in a particular order, and other information provided at the beginning of some slip opinions is deleted (such as the lower court information, which appears in the West case syllabus).

Bender, 158 F.3d at 683 (footnote omitted).

178. *Id.* at 674, 693.

179. *Id.* at 681 (emphasis in original).

180. *Key Publ'ns, Inc. v. Chinatown Today Publ'g Enters.*, 945 F.2d 509, 512–13 (2d Cir. 1991). Illustrative here would be Marklund's forgery and Charlie's copying of *A Tale of Two Cities*. Refer to Cases 11–12 (*Doppelgänger*, *Forgery*) *supra*.

181. *Feist* itself exemplifies that phenomenon. Note that these two ingredients are labeled *originality* and *creativity* in Chapter II *in fine supra*.

182. Refer to Chapter VII, section (A)(2) *infra*.

183. *Bender*, 158 F.3d at 689.

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in those cases, the Second Circuit limited copyright protection to “evaluative and creative” works, in which the compiler exercises “subjective judgments relating to taste and value that were not obvious and that were not dictated by industry convention.”¹⁸⁴

These considerations neither deny the value of West’s case reporters nor the praise due their compilers. The court concluded as follows:

West’s editorial work entails considerable scholarly labor and care, and is of distinct usefulness to legal practitioners. Unfortunately for West, however, creativity in the task of creating a useful case report can only proceed in a narrow groove. Doubtless, that is because for West or any other editor of judicial opinions for legal research, faithfulness to the public-domain original is the dominant editorial value, so that the creative is the enemy of the true.¹⁸⁵

The Second Circuit drops a footnote at this point containing two citations. The first is to a case that counsel for Bender cited both to the district court and Second Circuit.¹⁸⁶ The second did not come from any brief submitted by the parties;¹⁸⁷ instead, Judge Jacobs alighted on it independently:

On the other hand, preparing an edition from multiple prior editions, or creating an accurate version of the missing parts of an ancient document by using conjecture to determine the probable content of the document may take a high amount of creativity. See, e.g., Abraham Rabinovich, *Scholar: Reconstruction of Dead Sea Scroll Pirated*, Wash. Times: Nat’l Wkly. Edition, Apr. 12, 1998, at 26 (discussing scholar’s copyright infringement claim in Israeli Supreme Court relating to his reconstruction of the missing parts of a “Dead Sea Scroll” through the use of “educated guesswork” based on knowledge of the sect that authored work).¹⁸⁸

Of course, the remark constitutes obiter dictum. Nonetheless, it is interesting that the sole reference in any reported decision in the United States to *Qimron v. Shanks* occurs in this context.

184. *Id.*

185. *Id.* at 688. The quotation should be recalled in the context of Qimron’s claim to protection by virtue of the extent of scholarly labor that he expended on *4QMMT*. Refer to Chapter VIII *infra*.

186. *Bender*, 158 F.3d at 688 n.13, citing *Grove Press, Inc. v. Collectors Publication, Inc.*, 264 F. Supp. 603 (C.D. Cal. 1967) (holding that even 40,000 changes made to a work, in the form of correcting punctuation and typographical errors and the like, stand outside copyright protection).

187. As noted above, this writer represented Bender. Refer to note 165 *supra*.

188. *Bender*, 158 F.3d at 688 n.13.

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In any event, West applied to the Supreme Court for a writ of certiorari.¹⁸⁹ The denial of that petition means that *Bender v. West* now stands as res judicata.

189. West filed its petition for certiorari while I was living in Jerusalem. Elliot Brown finished drafts of our opposition every night, which was morning my time when he e-mailed it to me, where I worked on the draft while he slept, only to continue the process the next day.

While we were preparing the opposition, our client made a surprising decision—to join in the certiorari petition, asking the Supreme Court to affirm summarily and thereby end once and for all West’s “scarecrow copyright” by which it had chased competitors out of the field. Thus, the “opposition” that we ultimately filed with the Supreme Court actually joined in West’s request for review.

Completing the surrealism, West vitriolically attacked our non-opposition. But the matter ended when the Supreme Court refused to hear the matter.

VII.
MIND BENDER

The study of the Dead Sea Scrolls is and has always been neither theology nor science but an exercise in almost pure religious metaphor.

Neil Silberman⁴⁷¹

There are many levels on which to confront the copyright lessons of *Qimron v. Shanks*. The previous chapter looked at some of the particulars animating that controversy, leading to case-specific applications of such doctrines as fair use and unclean hands. The present chapter, by contrast, proceeds on a more universal level. As a way of examining authorship and the proper bounds of copyright protection, this chapter takes lessons from the Second Circuit's *Bender v. West* case, applying them to the general enterprise of scholars seeking copyright protection in their reconstruction of ancient scrolls. These considerations thus apply not only to Elisha Qimron himself, but across the board to all who seek to reconstruct old texts, regardless of the circumstances.

A. *Fact/Expression Dichotomy*

West, like the scholars of the Dead Sea Scrolls, labored in a domain in which "faithfulness to the public-domain original is the dominant editorial value."⁴⁷² The same considerations that doomed West's copyright likewise forestall Qimron's claim. The Supreme Court's standard in *Feist* (the "telephone book white pages" case) governs here: "[C]opyright assures authors the right to their original expression, but encourages others to build freely upon the ideas and information conveyed by a work. This principle, known as the idea/expression or fact/expression dichotomy, applies to all works of authorship."⁴⁷³

In *Bender v. West*, the Second Circuit invoked the fact/expression dichotomy to find such copying as occurred on the

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⁴⁷¹. THE HIDDEN SCROLLS, *supra* note 190, at 50.

⁴⁷². *Matthew Bender & Co. v. West Publ'g Co.*, 158 F.3d 674, 688 (2d Cir. 1998).

⁴⁷³. *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 349–50 (1991).

As applied to a factual compilation, assuming the absence of original written expression, only the compiler's selection and arrangement may be protected; the raw facts may be copied at will. This result is neither unfair nor unfortunate. It is the means by which copyright advances the progress of science and art.

Id.

safe side of the line.⁴⁷⁴ Star pagination merely conveys unprotected information.⁴⁷⁵ By the same token, any copying of Qimron's manuscript reconstruction, as opposed to his translation of *MMT* or his commentary thereon, is similarly nonactionable. For it represents, pure and simple, the facts as to how TR expressed himself 2,000 years ago, reproduced as faithfully as Qimron was capable of achieving.

1. Originality

a. Quantum of Originality

At the outset, a distinction must be acknowledged. *Bender v. West* held that the page numbers at issue there contained no copyrightable expression whatsoever, having been rotely inserted by a computer.⁴⁷⁶ Qimron, by contrast, labored for eleven years to reproduce *4QMMT*. Thus, the factors that animated the court in *Bender v. West* could be argued to actually safeguard Qimron's protection.

Moreover, it may be conceded that Qimron reconstructed *4QMMT* differently than any other would have done. What greater proof of originality could there be than the distinctiveness of his contribution?

We turn first to that last consideration. Then, the discussion winds back to whether, in the ultimate analysis, *Bender v. West* favors Qimron's position.

b. "Distinctive" Does Not Translate to "Original"

Does copyrightable originality follow from the fact that Qimron's reconstruction was unique to him—that no other human being on earth would have put the bits and pieces of manuscript together in exactly the same way (assuming that to be the case)? Properly construed, distinctiveness does not equate to copyrightable expression.

Both *Bender v. West* and *Feist* bear out that proposition. In the former case, there is no doubt that the particular case

Citation Case #3

474. In a profound sense, there is a subjective element even in the most "objective" fact. "Nature states no 'facts': these come only within statements devised by human beings to refer to the seamless web of actuality around them." ORALITY AND LITERACY, *supra* note 1, at 68. Facts themselves "have no necessary stable existence, but are themselves texts." Robert H. Rotstein, *Beyond Metaphor: Copyright Infringement and the Fiction of the Work*, 68 CHI.-KENT L. REV. 725, 769 (1993). However true in the noumenal realm, these considerations are too metaphysical for the pragmatic concerns animating the law. Refer to Part Two *infra*.

475. *Bender*, 158 F.3d at 701.

476. Refer to Case 17 (The Bingo Cards) *supra*.

reporters produced by West were unique to it. No other competitor, left to its own devices, would ever develop a single volume, let alone a whole series, identical to any book of the *Federal Reporter* (i.e., containing the same page number divisions, the same citation methodology, the same attorney names presented in the same format, etc.). Yet the Second Circuit ruled that those factors, despite their distinctiveness, lie outside copyright protection.

An even stronger application of this principle emerges from the Supreme Court's ruling that copyright protection is lacking in the white pages of a telephone book.⁴⁷⁷ In the first place, a telephone company must assign a unique phone number to each user (just as West must assign a unique page number to each page). That process itself can be complex.⁴⁷⁸ Moreover, that phone number, like West's page numbers, is not an "antecedent fact"; it springs into existence only by virtue of the putative property owner's labor.⁴⁷⁹ Yet those circumstances by themselves do not confer copyright status.

Moreover, each phone book directory containing alphabetized white pages itself represents a profoundly unique compilation, reflecting innumerable choices by its creator. Consider a simple thought experiment.

??In a town live 1,000 individuals whose names have been collected from time immemorial in standard alphabetical order. To the town now move ten strangers—Axel aus der Mühlen,⁴⁸⁰ Sharon Ben Shachar,⁴⁸¹ Chou En Lai,⁴⁸² the artist formerly known as Prince,⁴⁸³ and diverse

477. Refer to Case 5 (The Phonebook) *supra*.

478. See WHO OWNS INFORMATION?, *supra* note 283, at 39.

479. "A telephone number is not like a mathematical algorithm or law of nature that lies waiting to be discovered . . ." *Id.*

480. Which name should be treated as his surname? Should it go by capitalization? Or by order?

481. As an initial matter, should the letter *chet* in her name be transliterated as "Shachar" or "Shahar." Next, should this entry come after surnames such as Benshein? Or does the space mean that it should come before?

482. Axel, the German's first name, is also his given name; but Chou, the Chinese's first name, is his family name, not his given name. (Using the appellation "Christian name" instead of "given name" even more starkly highlights the value judgments at play here.)

483. That individual has been no stranger to copyright litigation. See *Paisley Park Enters., Inc. v. Uptown Prods.*, 54 F. Supp. 2d 347, 348–49 (S.D.N.Y. 1999) (issuing an order preventing Prince's videotaped deposition from being exploited on defendants' Web site). In *Pickett v. Prince*, 52 F. Supp. 2d 893, 896 (N.D. Ill. 1999), *aff'd*, 207 F.3d 402 (7th Cir. 2000), a fan created a guitar in the shape of Prince's symbol/name. Because the fan appropriated that copyrighted image without authorization, he was denied copyright in his product, by application of the rule confronted above that is relevant to Qimron as well.

members of the same Irish clan (who were split up upon entry to Ellis Island and who therefore spell their names differently): McCormick, MacCormick, M'Cormick, McOrmick, MacOrmick, Maccormick, and Mac Cormick. A hundred employees of the telephone company produce a hundred distinctive lists when attempting to integrate just those ten names.⁴⁸⁴

??Of course, the chore of compiling a phone book does not end there. In addition to deciding how to alphabetize "nonstandard" names, a value judgment also must be made as to where to draw the boundaries. One could chose the municipality of Beverly Hills; or the entire region of West Los Angeles, including Beverly Hills (or excluding it!); or South Beverly Hills alone; or South Beverly Hills together with Beverlywood; or South Beverly Hills, Beverlywood, and the Pico-Robertson neighborhood; or South Beverly Hills, extending all the way to Century City; or South Beverly Hills extending to Century City, but stopping at Century Park East; etc.

From these considerations, it should be evident that almost limitless patterns are available. Indeed, one could imagine the possibility of producing as many different white-pages directories for communities of the United States as there are theoretically permutations for bingo cards.⁴⁸⁵ The fact that any phone directory produced by a given individual is unique and distinctive to her and would match the phone directory produced by no other individual does not by itself vouchsafe the existence of copyright protection. For Justice O'Connor, speaking on behalf of a unanimous Supreme Court, has told us that all alphabetized white-page directories stand outside copyright protection.

2. *Literary Work vs. Material Object*

We return to the argument that *Bender v. West*, by excluding from protection the page breaks rotely inserted by computer, favors copyright for 4QMMT, which required eleven years of Qimron's painstaking labor to produce. For this purpose, it is

Refer to Chapter VI, section (B)(2) *supra*. The district court's discussion of the doctrine of unauthorized exploitation is one of the most elaborate of any case. *Pickett*, 52 F. Supp. 2d at 901-09 & n.17 (relying on NIMMER ON COPYRIGHT, the "treatise[] cited ubiquitously as authority in copyright cases").

484. Humans quite obviously work according to different criteria than the mechanistic ones programmed into a computer, as anyone trying to access a ponderously named Web site can attest. See David Nimmer, *Puzzles of the Digital Millennium Copyright Act*, 46 J. COPYRIGHT SOC'Y 401, 450 n.236 (1999).

485. Refer to Case 17 (Bingo Cards) *supra*.

necessary to advert to a more evanescent facet of *Bender v. West*.

This particular aspect did not even occur to me throughout preparing and replying to the cross-motions for summary judgment in the district court. In fact, we had already prevailed in a final judgment below and were brain-storming about the appellate brief before becoming aware that we had been ignoring the fact that West's whole claim to pagination copyright rested on conflating a "fundamental distinction" of copyright law. We therefore argued this new basis to the Second Circuit, which adopted it as an alternative basis.⁴⁸⁶ (West, meanwhile, did not even try to address our new theory, directly or obliquely, in its reply brief—from which we inferred that no answer was possible.)

Turning to that "fundamental distinction," the legislative history tells us that it pertains between a copyright and the material object in which it is embodied.⁴⁸⁷ Thus, a "literary work" can consist of the letters⁴⁸⁸ and words that form it, whereas a "book" is the tangible object that contains that literary work.⁴⁸⁹ Page numbers are an incident solely of a book, not of a literary work. To appreciate this phenomenon, imagine that West kept the same paper size and margins in alternative volumes designed for the visually impaired. In these large-type editions, the cases would manifestly occupy more pages, therefore producing different page breaks. Accordingly, the pagination would be wholly different, notwithstanding that the implicated literary work would be identical.⁴⁹⁰ By claiming a copyright in pagination,

Citation Case #4

486. *Matthew Bender & Co. v. West Publ'g Co.*, 158 F.3d 693, 699 n.9 (1998).

487. As the House Report expresses it, there is a fundamental distinction between the "original work" which is the product of "authorship" and the multitude of material objects in which it can be embodied. Thus, in the sense of the bill, a "book" is not a work of authorship, but is a particular kind of "copy." Instead, the author may write a "literary work," which in turn can be embodied in a wide range of "copies" and "phonorecords," including books, periodicals, computer punch cards, microfilm, tape recordings, and so forth.

H.R. REP. NO. 94-1476, at 53 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5666.

488. The distinction here is ancient, and provides the basis for a joke that is older than the United States. *See The Author as Proprietor*, *supra* note 19, at 24 ("Having been reprimanded for stealing an old woman's gingerbread cakes baked in the form of letters, a cheeky schoolboy . . . defended himself by explaining that 'the supreme Judicature of Great Britain had lately determined that lettered Property was common.'").

489. The Torah is a literary work that, besides being made into a book, could equally be embodied on papyri; on parchment scrolls in a cave at Qumran; on a CD-ROM; on a server attached to the Internet; or, as the Torah itself commands, on stone monuments set up atop Mt. Eival. *See Deuteronomy* 27:8.

490. To the extent that West attempted to file a separate registration certificate for its large-type edition, the Copyright Office would deny separate registration for the identical "literary work." *See* 37 C.F.R. § 202.1 (2000) (listing "mere variations of

West was trying to import copyright protection into a domain where it plays no role, namely to protect the manner in which a material object is formatted.

In a sense, Judge Dorner's finding of copyright protection for Qimron massively replicates West's error. For Qimron was attempting to put together the physical pieces that he found in the Judean desert, and then to fill in the gaps. How he fit those pieces together reflects a material object.⁴⁹¹ Consider, most obviously, the finding that Qimron decided to reassemble various manuscript segments horizontally rather than vertically.⁴⁹² Without doubting that Qimron might have cogitated long and hard on the problem and essayed numerous variants, this type of sleuth work relates not to matters subject to copyright protection (a literary work), but instead to arrangement of the parchment scraps on which it chanced to be written (a material object). To the extent that Qimron engaged in creativity in this domain, it related to *MMT's* material embodiment. It conflates legal categories to grant that type of activity copyright protection.

But, of course, even after arranging the fragments horizontally or vertically, lacunae remained, which Qimron filled in. Do those matters represent protected expression? To evaluate this aspect of the matter, we must turn to the merger doctrine.

B. Merger of Expression with Nonprotected Material

In *Bender v. West*, another argument advanced to bar copyright protection for West's alteration to judicial opinions came in the merger doctrine.

The fundamental copyright principle that only the expression of an idea and not the idea itself is protectable has produced a corollary maxim that even expression is not protected in those instances where there is only one or so few ways of expressing an idea that protection of the expression would effectively accord protection to the idea itself.⁴⁹³

Text Case #12

typographic ornamentation" among examples of "Material not subject to copyright").

491. As a scholar in the field notes, one strategy to employ in text reconstruction is to reconstruct "the text of a scroll"; but an alternative strategy that is often efficacious is to "reconstruct the scroll itself, the patterned shapes of the holes and breaks [that] are a reliable aid in arriving at the original order of what remains of the scroll fragments." *How to Connect Dead Sea Scroll Fragments*, *supra* note 210, at 250 (emphasis in original). See *Laser Bones*, *supra* note 56, at 287 n.40 (discussing how DNA analysis is used on the Dead Sea Scrolls to analyze fragments according to animal skin used; sometimes even by individual animal).

492. Refer to Chapter V, section (B)(2) *supra*.

493. *Matthew Bender & Co. v. West Publ'g Co.*, 158 F.3d 674, 688 n.12 (quoting *Kregos v. Associated Press*, 937 F.2d 700, 704 (2d Cir. 1991)). The next sentence from the

The Second Circuit declined to invoke the merger doctrine, based on its antecedent holding that copyright protection was unavailable for West's case reporters.⁴⁹⁴ In addition, the Second Circuit noted that the emendations that West made to judicial opinions do not constitute "building blocks of understanding," for which application of the merger doctrine would have been ripe.⁴⁹⁵

1. *Building Blocks of Understanding*

West's emendations to judicial opinions—such matters as inserting an escort citation or italicizing a case name—are plainly not "building blocks of understanding." Turning to manuscript reconstruction, by contrast, the opposite dynamic pertains.

The reconstruction of TR's words do not represent "approximative statements of opinion"⁴⁹⁶ by Qimron. Instead, they represent, to the best of Qimron's ability, what the Teacher of Righteousness actually said. Insofar as Qimron's philological, historical, archaeological and other skills permit, they represent an attempt at objectivity,⁴⁹⁷ not simply an "expression of subjective opinion" as to what TR might have said.⁴⁹⁸ Strugnell captures the matter metaphorically:

A. [I]n the case here of MMT and Qimron, having then done our joint work, we have squeezed the orange as hard as we can, we have got as much as we can out of it, and what we have got is, we're pretty sure is reliable, it's not lemon juice.

Q. It's reliably what?

A. It's reliably good orange juice.⁴⁹⁹

"The vitality of the scholarly life depends upon a scholar's ability to freely state his agreements and disagreements with

Text Case #13

quoted opinion states, "Our Circuit has considered this so-called 'merger' doctrine in determining whether actionable infringement has occurred, rather than whether a copyright is valid, an approach the Nimmer treatise regards as the 'better view.'" 937 F.2d at 705 (citations omitted). Plainly, although the current thoughts approach the matter generally, it would be best to evaluate the merger doctrine in the context of a particular infringement claim—an enterprise distinct from that of the present chapter.

^{494.} *Bender*, 158 F.3d at 688 n.12.

^{495.} *Id.* (citing *CCC Info. Servs., Inc. v. Maclean Hunter Mkt. Reports, Inc.*, 44 F.3d 61, 71 (2d Cir. 1994)).

^{496.} *CCC Info. Servs., Inc.*, 44 F.3d at 72.

^{497.} See Strugnell Testimony at 101.

^{498.} "This dichotomy between types of ideas is supported by the wording of various legislative pronouncements, which seem uniformly to contemplate denying protection to building-block ideas explaining processes or discoveries, and do not refer to expressions of subjective opinion." *CCC Info. Servs., Inc.*, 44 F.3d at 71 n.22.

^{499.} Strugnell Testimony at 102–03.

putting the fragments together and filling in the lacunae in a manner that she perceives to be correct.⁵¹⁶ Over the course of eleven years, Qimron had many ideas about what TR was saying.⁵¹⁷ One was to substitute an *ayin* for an *aleph*. Another was to assemble fragments widthwise rather than lengthwise. The only way to express each of those ideas is through the text that Qimron proposed. In these and every other instance of manuscript reconstruction, the expression merges with the idea. Even more than a map is the most effective way to convey the idea of where to locate a suggested pipeline route, a reconstructed manuscript is the *only* effective way to convey the ideas regarding how to reconstruct that manuscript.⁵¹⁸ It is impossible to imagine that Congress intended to foreclose competition in *ideas* about how to assemble ancient manuscripts via copyright law. Qimron's proposed reconstruction, which merges idea with expression, therefore stands outside copyright protection.

C. Enemy of the True

Bender v. West states that “the creative is the enemy of the true.”⁵¹⁹ That *aperçu* carries great force as applied to the chore of manuscript reconstruction.

516. As long as selections of facts involve matters of taste and personal opinion, there is no serious risk that withholding the merger doctrine will extend protection to an idea. . . . However, where a selection of data is the first step in an analysis that yields . . . even a better-than-average probability of some result, protecting the “expression” of the selection would clearly risk protecting the idea of the analysis.

Kregos v. Associated Press, 937 F.2d 700, 707 (2d Cir. 1991).

517. The amount of effort invested in conceiving the idea does not confer protection. In *Kern River*, the court found that the plaintiff “conducted expensive and detailed field work to acquire the information needed to formulate . . . the precise location of their pipeline.” 899 F.3d at 1464. This factor did not change the conclusion that the idea of the location of the pipeline and the maps in which it was embodied were inseparable. Similarly, the years that Qimron put into the reconstruction of the manuscript are immaterial to the fact that his reconstructed manuscript is the only effective expression of his ideas.

518. The amount of cogitation, number of permutations considered, and other intellectual labor that goes into manuscript reproduction makes it no more subject to copyright protection than do the equivalent factors that underlie preparation of a pipeline map.

519. **Matthew Bender & Co. v. West Publ'g Co.**, 158 F.3d 674, 688 (2d Cir. 1998), *cert. denied*, 526 U.S. 1154 (1999).

Text Case #14

1. Copyright Estoppel⁵²⁰

Vindication of the fact/expression dichotomy discussed above⁵²¹ comes as well in a different doctrine of law, copyright estoppel. This doctrine arises when an author disavows the seemingly creative nature of her work to claim that it actually portrays objective factual material.⁵²²

Care must be taken to apply the estoppel doctrine with real-world sensitivities. In other words, simply because a work's packaging would fool the ingenuous (or humorless) into believing it a work of fact is no reason to blinker common sense when it screams the opposite.⁵²³ Examples are legion:

??In *A Study in Scarlet*, *The Sign of the Four*, and innumerable adventures, Sir Arthur Conan Doyle presented what seemed to be the real-world adventures of a Victorian detective named Sherlock Holmes as recounted by his faithful amanuensis, Dr. Watson. Nonetheless, there can be no question but that the good knight engaged in copyrightable expression to produce the tales.⁵²⁴ By the same token, *I Claudius* was authored

520. It should be noted that a question of copyright estoppel did not remain at the end of the day in the *Bender v. West* opinions, for West early on abandoned the argument that its factual reporters contain its own creative expression rather than the judge's words. *Id.* at 681 n.4.

521. Refer to Chapter VII, section (A) *supra*.

522. In *Oliver v. Saint Germain Foundation*, 41 F. Supp. 296 (S.D. Cal. 1941), the plaintiff's book, *A Dweller on Two Planets*, related that the manuscript was a factual account entirely dictated to him by a spirit from another planet known as Phyllos, the Thibetan. *Id.* at 297. In finding for the defendant, the court held that "equity and good morals will not permit one who asserts something as a fact which he insists his readers believe as the real foundation for its appeal to those who may buy and read his work, to change that position for profit in a law suit." *Id.* at 299. In *Arica Institute, Inc. v. Palmer*, 970 F.2d 1067 (2d Cir. 1992), the plaintiff claimed that its author had "discovered" the ego fixations [of the human spirit], which are scientifically verifiable 'facts' of human nature"; it was therefore estopped to claim copyright protection. *Id.* at 1075.

By contrast, in *Cummins v. Bond*, 1 Ch. 167 (1926), the plaintiff medium produced an account of the Apostles, purportedly written contemporaneously with them, by engaging in "automatic writing" from a 1900-year-old spirit. *Id.* at 168-69, 173. Noting that "I have no jurisdiction extending to the sphere in which [the dead spirit] moves," *id.* at 173, the Chancery judge declined to hold that "authorship and copyright rest with some one already domiciled on the other side of the inevitable river," *id.* at 175, and thus held for plaintiff. *Id.* at 176. See Peter H. Karlen, *Death and Copyright*, COPYRIGHT WORLD, Apr. 1994, at 43, 46-47.

523. Readers have long looked to novels as the guideposts for their own lives. See *Introduction to A HISTORY OF READING*, *supra* note 146, at 25. But those who fail to realize the fictitious intent here belong "in the same category as the people who send cheques to radio stations for the relief of suffering heroines in soap operas." ANATOMY OF CRITICISM, *supra* note 159, at 76.

524. 1 NIMMER ON COPYRIGHT § 2.11[C].

Text Case #15

For the poet, perhaps,⁵⁴⁷ it may be accurate that “that is all Ye know on earth, and all ye need to know.”⁵⁴⁸ But in this sublunary sphere, at least, without contesting that there is a “higher truth” in works of fiction,⁵⁴⁹ there is a sharp break between the creative and the true,⁵⁵⁰ which for these purposes we can denominate the subjective and the objective.⁵⁵¹ To reiterate, “the creative is the enemy of the true.” Simply stated, copyright protects subjective expression, as recognized by *Bender v. West*⁵⁵² and countless other cases.⁵⁵³

Qimron presents himself to the world as an objective historian, not as the “sylvan historian” immortalized in Keats’s well-wrought *Ode*.⁵⁵⁴ Having elected to proceed in the objective sphere insofar as manuscript reconstruction is concerned, Qimron lacks copyright protection for that labor. He is estopped to claim otherwise.

3. Intermingled Material

There is a third facet to the estoppel doctrine, this one with a

547. It did not, however, convince T.S. Eliot and other critics of the *Ode*. See CLEANTH BROOKS, *THE WELL WROUGHT URN* 124–25 (1947). Brooks’s whole book can be taken as defending Keats’s insight against his detractors. See also LIONEL TRILLING, *The Poet as Hero: Keats in His Letters*, in *THE OPPOSING SELF: NINE ESSAYS IN CRITICISM* 32 (1955).

548. *Ode on a Grecian Urn*, line 59. On one reading, this interplay undergirds even The Law, whose “solemn guardians . . . strove for beauty and by their very beauty for truth.” THE READER, *supra* note 84, at 181.

549. Manifestly, people would soon stop reading literature if they did not find applications therein to their own life. See THE PLEASURES OF READING, *supra* note 527, at 49; Amy B. Cohen, *Copyright Law and the Myth of Objectivity: The Idea-Expression Dichotomy and the Inevitability of Artistic Value Judgments*, 66 IND. L.J. 175, 184–86 (1990). The Bible itself attempts “to realize through the medium of literature an order of truth that utterly transcends literature.” THE WORLD OF BIBLICAL LITERATURE, *supra* note 155, at 46.

550. “History makes particular statements, and is therefore subject to external criteria of truth and falsehood; poetry makes no particular statements and is not so subject.” NORTHROP FRYE, *THE GREAT CODE: THE BIBLE AND LITERATURE* 46 (1982).

551. One commentator identifies “authorial subjectivity as the hallmark of original works of authorship.” Jane C. Ginsburg, *Creation and Commercial Value: Copyright Protection of Works of Information*, 90 COLUM. L. REV. 1865, 1867 (1990). See *Figures of the Author*, *supra* note 194, at 15; *The Law’s Eye*, *supra* note 113, at 83. But see *Dropping the Subject*, *supra* note 25, at 108, 109 (postulating that it distorts to view “authorship and its law as a transparent adjunct of human subjectivity”; “historiography of authorship and copyright need not be subsumed in the analysis of subjectivity”).

552. 158 F.3d 674, 689 (2d Cir. 1996), cert. denied, 526 U.S. 1154 (1999).

553. See *Fin. Info., Inc. v. Moody’s Investors Serv., Inc.*, 808 F.2d 204, 206–08 (2d Cir. 1986) (holding that the “simple clerical task” of collecting the most straightforward information about bonds, with no subjectivity or variation whatsoever, was not copyrightable).

554. *Ode on a Grecian Urn*, line 3. As noted above, Qimron’s copyright case, insofar as it unfolded in the United States, did so in the courts of Pennsylvania. Refer to Chapter V, section (B)(1) *supra*.

Text Case #16

twist. When a putative copyright holder has mingled his purportedly protected expression inextricably with public domain material, there is reason to deny copyright protection. This lesson derives equally from *Bender v. West* and *Qimron v. Shanks*. For in both cases, the claimant took a legal text that was not subject to copyright protection, and claimed copyright based on its intermingled additions.⁵⁵⁵

a. *West*

The early correspondence between West and rival publishers leaves no doubt that West adopted a conscious policy of relying on its emendations to judicial opinions as the basis for asserting copyright protection in its reporters. West banked on the fact that it would be impossible for newcomers to separate out those emendations in attempting to engage in rival presentations of public domain judicial opinions. Instead, as West well knew, the intermingling of the “chaff” of West additions would make the entire “wheat” of the judicial opinions indigestible to all competitors.⁵⁵⁶

Arguing the illegitimacy of that practice, we cited to the district court a section of the Copyright Act that not only had never been relied upon in any published opinion but, to the best of my knowledge, had never even been previously cited to any court. The section in question provides that a published work reproducing works of the United States government must bear a copyright notice identifying, “either affirmatively or negatively, those portions of the copies . . . embodying any work or works protected under this title.”⁵⁵⁷ That provision, as illustrated by its legislative history,

is aimed at a publishing practice that, while technically justified under the [1909 Act], has been the object of considerable criticism. In cases where a Government work is published or republished commercially, it has frequently been

Text Case #17
This was the case appealed to the 2nd Circuit and the appellate decision is cited 20 times in this article - but under the name *Bender v. West*

555. For these purposes, we discard the specialized argument postulated above that *4QMMT* remains subject to copyright through 2002. Refer to Chapter VI, section (B)(1) *supra*.

556. In a letter to HyperLaw dated October 9, 1991, West advised that “you should carefully compare the enclosed copy of the public domain slip opinion in *Mendell v. Gollust*, 909 F.2d 724 (2d Cir. 1990)] to the West case report of the same case,” claiming that “you will see that the slip opinion and case report vary substantially in their selection, coordination, and arrangement of material included.” Exhibit 13 to Intervenor Complaint, *HyperLaw, Inc. v. West Publ’g Co.*, No. 94 CIV. 0589, 1997 WL 266972, (S.D.N.Y. May 19, 1997) (emphases in original). In fact, comparison of the opinion portion of West’s report of *Mendell v. Gollust* shows it to be letter-for-letter identical to the slip opinion, except for the addition of parallel citations. Declaration of Michelle Kramer, dated July 31, 1996, filed in support of Matthew Bender’s motion for Summary Judgment, Ex., 1 at 1, *Hyperlaw v. West*, No. 94 CIV. 0589, 1997 WL 266972, (S.D.N.Y. May 19, 1997).

557. 17 U.S.C. § 403 (1994).

Text Case #19

Text Case #18
This was the case appealed to the 2nd Circuit

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. This in no way suggests to the public that the bulk of the work is uncopyrightable and therefore free for use.⁵⁵⁸

Based on West’s failure to follow that provision, Bender argued that West had committed copyright misuse,⁵⁵⁹ thereby invalidating protection over its reporters published during the pendency of that provision.⁵⁶⁰ As we pointed out to the district court, West always had the option of including its emendations [in brackets] or in a special **type font**, or otherwise distinctively segregated from the public domain judicial opinions. West, however, availed itself of no such option. Instead, it consciously mixed its emendations into the text on a seamless basis, so that it would be impossible to separate it out absent the commercially unfeasible activity of parsing West’s reporters line-by-line.⁵⁶¹

The district court agreed. Thus, *Bender v. West* became the only judicial opinion in U.S. history that I know of to cite that section of the Copyright Act as part of its rationale.⁵⁶²

b. Qimron

At first blush, Qimron’s activity stands at the opposite end of the spectrum from West’s. First, the provision noted above applies solely to works of the United States Government, thus excluding *MMT*. Second, Qimron’s reconstruction of *4QMMT* includes within brackets the materials that he has posited as part of his reconstruction.⁵⁶³ In other words, he apparently adopted the very methodology that we criticized West for omitting. It would seem, therefore, that Qimron is immune from the criticism that we leveled at West.

Further examination undermines that conclusion. It is necessary to revert here to the realization that Qimron can lay claim to copyright protection solely for the mistakes that he committed, rather than for accurate re-creation of the words authored by the Teacher of Righteousness.⁵⁶⁴ Such brackets as

This is HyperLaw's attorney's fee district court case I.

Text Case #21

558. H. R. REP. NO. 94-1476, at 145 (1976).

559. Refer to Chapter VI, section (A)(2) *supra*.

560. That version of 17 U.S.C. § 403 was in operation from January 1, 1978, through March 1, 1989.

561. See Declaration of Michelle Kramer, *supra* note 556.

562. *Bender v. West*, 53 U.S.P.Q.2d 1436, 1438 (S.D.N.Y. 1999).

563. The material not in brackets, in turn, represents the matter that he simply transcribed from the ancient documents. See FACSIMILE EDITION, *supra* note 259, at Plate 8.

564. Refer to Chapter IX, (C)(2) *infra*.

IX.

INCENTIVES TO CREATE

The immediate effect of our copyright law is to secure a fair return for an “author’s” creative labor. But the ultimate aim is, by this incentive, to stimulate artistic creativity for the general public good.

Justice Potter Stewart⁶⁵⁸

Copyright is redolent of public policy.⁶⁵⁹ The issues arise in *Qimron v. Shanks* no less than in *Bender v. West*.

A. *Incentives and Access*

A Lockean⁶⁶⁰ view would posit that natural law⁶⁶¹ confers on authors the right to exploit their artistic progeny.⁶⁶² Whatever the philosophical merits of that⁶⁶³ point of view,⁶⁶⁴ “the [U.S.]

658. *Twentieth Century Music Corp. v. Aiken*, 422 U.S. 151, 156 (1975).

659. As the Supreme Court has stated, “The monopoly privileges that Congress may authorize are [not] primarily designed to provide a special private benefit.” *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 429 (1984).

The point is not merely that the individual rights of authors must be *balanced* against the social good. The Constitution stipulates that authors’ rights are created to serve the social good, so any balancing must be done *within* the overall context of the public good, i.e. between the specific aspect of the public good that is served by intellectual property . . . and other aspects of the public good such as the progressive effects of the free circulation of ideas.

Jeremy Waldron, *From Authors to Copiers: Individual Rights and Social Values in Intellectual Property*, 68 CHI.-KENT L. REV. 841, 848–49 (1993) (footnotes omitted).

660. For a taxonomy of intellectual property into its Lockean and Hegelian justifications, see Justin Hughes, *The Philosophy of Intellectual Property*, 77 GEO. L.J. 287, 296–300, 330–32 (1988).

661. “On the one hand, although the official line about copyright is that it is a matter of social policy, judicial and scholarly rhetoric on the subject retains many of the characteristics of natural rights talk.” *From Authors to Copiers*, *supra* note 659, at 848.

662. All of these cultural developments — the emergence of the mass market for books, the valorization of original genius, and the development of the Lockean discourse of possessive individualism — occurred in the same period as the long legal and commercial struggle over copyright. Indeed, it was in the course of that struggle, under the particular pressures of the requirements of legal argumentation, that the blending of the Lockean discourse and the aesthetic discourse of originality occurred and the modern representation of the author as proprietor was formed.

The Author as Proprietor, *supra* note 19, at 30. See Wendy J. Gordon, *A Property Right in Self-Expression: Equality and Individualism in the Natural Law of Intellectual Property*, 102 YALE L.J. 1533, 1540–50 (1993); *Figures of the Author*, *supra* note 194, at 13.

663. Of course, things are not as simple as all that. The Lockean view actually blends natural law with an instrumentalist rationale about increasing utility. See *The Philosophy of Intellectual Property*, *supra* note 660, at 296–97.

664. A simple view contrasts the Continental *droit d’auteur*, derived from a natural-

society that will benefit in the long-run through the encouragement of authorship by affording a temporary “personal gain” during the term of copyright protection.⁶⁸³ It is instructive to bring that purpose to bear against the claims advanced by Qimron, reverting to *Bender v. West* as well in this context.

B. Should Copyright Provide an Incentive to Secretly Alter Judicial Opinions?

From a strictly pragmatic standpoint, it strikes me that West ultimately lost its copyright case for one major reason. This reason finds no reflection in the various opinions issued by the courts. Nonetheless, it underlies, perhaps, the sensibilities that were brought to bear on the dispute.

For over a century, West has been in business to sell case reporters. Undoubtedly reaping billions of dollars during that time,⁶⁸⁴ it has established a premier—and, in my opinion, deserved—reputation for accuracy and reliability. When West sells a volume of case reporters, it represents to the public that the volume in question accurately sets forth the words of the judges as contained in the opinions collected therein. Given that those opinions constitute “the law” in a common-law system, West achieves its sterling reputation for accurately purveying “the law.” (In fact, West had always professed such fidelity to the judges’ words that it once defeated a libel charge on the basis that the words contained in the *Federal Reporter* reflected those of the judge whose opinion was reproduced, West Publishing Company being merely the conduit for conveying those words to the public.⁶⁸⁵)

When it came time, however, to litigate the copyright issue, West made an abrupt *volte-face*. By laying claim to protection over the emendations that it inserted into its reporters, West claimed copyright over matters that judges did *not* write. In other words, West, which had always prided itself on accuracy and the ability of lawyers and judges to quote “the law” out of its reporters without fear of error, was now claiming that those same reporters were replete with material of West’s own invention, unratified by the judges into whose opinions they were

683. See *The End of Copyright*, *supra* note 443, at 1416.

684. As a privately held corporation, its revenues were always secret, but the \$3.43 billion that Thompson paid to purchase West in 1996 surely reveals the company’s worth as of that time. See Yolanda Jones, *You Can’t Get Where you are Going Unless You Know Where You Have Been: A Timeline of Vendor-Neutral Citation Developments*, at <http://vls.law.vill.edu/staff/yjones/citation>.

685. See *Lowenschuss v. West Publ’g Co.*, 402 F. Supp. 1212, 1216–17 (E.D. Pa. 1975), *aff’d*, 542 F.2d 180 (3d Cir. 1976).

inserted and unbeknownst to its customers who thought that they were reading the judges' words, not West's.

No one, I dare say, has ever thought to purchase a West reporter in order to obtain West's emendations. Instead, practitioners and judges alike have always sought West volumes because of the fidelity with which they report the words of the judges themselves. Thus, West was, in effect, claiming copyright protection over deformations that it had inserted into the law.⁶⁸⁶

As a matter of incentives, there is little reason to encourage purveyors of judicial opinions to secretly alter them. To the extent that West can ensure punctilious replication of what the judges intended, then its editors are to be applauded. On the other hand, to the extent that those editors have injected subjective expression into case reporters that are sold under the pretense of accurately portraying the law, then their activity becomes less than socially compelling. In this larger sense, therefore, it is wholly to be expected that West's copyright claims failed.

C. *Should Copyright Provide an Incentive for Bad Scholarship?*

Qimron v. Shanks arises at the intersection of two interests: copyright protection and scholarly protection. When viewed through the former lens, the various doctrines canvassed herein demonstrate why the plaintiff's interest failed to measure up. Yet one must also advert to the other interests that *Qimron* brought to bear—those of a scholar. The discussion below attempts to untangle those threads, beginning with the latter doctrine.

1. *Scholarly Convention*

The Israel Antiquities Authority vested exclusive control over 4QMMT first in Strugnell, and then later in *Qimron*.⁶⁸⁷ By a scholarly convention known as *editio princeps*, that status guaranteed *Qimron* priority in publishing the document— notwithstanding that the doctrine of *editio princeps* itself nominally enjoys no legal standing.⁶⁸⁸ Yet along came *Shanks*, iconoclast of scholarly convention. In the battle between, on the

Text Case #22

^{686.} West actually had the audacity to advance this claim explicitly at an early stage in the litigation. *Matthew Bender & Co. v. West Publ'g Co.*, 158 F.3d 674, 681 n.4 (1998), *cert. denied*, 526 U.S. 1154 (1999) ("West initially claimed some creativity in its corrections to the text of opinions, but it has abandoned this claim . . .").

^{687.} Refer to Chapter V, section (A)(2) *supra*.

^{688.} See *PLAYING DARTS WITH A REMBRANDT*, *supra* note 228, at 164. For a further discussion of this doctrine, refer to Chapter X, section (B)(1) *infra*.

X.
MORAL

American copyright law, as presently written, does not recognize moral rights or provide a cause of action for their violation, since the law seeks to vindicate the economic, rather than the personal, rights of authors.

Judge Joseph Edward Lumbard⁷⁰⁹

In addition to analyzing Qimron's complaint for copyright infringement, it is necessary to address the other cause of action joined in his complaint—for violation of his moral rights. Although the case made copyright headlines,⁷¹⁰ it is actually in the domain of moral rights that Qimron felt injured, and that moved the judge to rule in his favor.

A. *Chronology*

The chronology at issue in *Qimron v. Shanks* was such that Shanks's publication preceded Qimron's own. A table illustrates:

DATE	DESCRIPTION
1952	Cave 4 excavated.
1954	<i>MMT</i> assigned to Strugnell.
1960s through 1970s	Tantalizing fragments revealed to the public about the existence of <i>MMT</i> .
1984	Strugnell and Qimron openly discuss <i>MMT</i> at a scholarly conference.
1991	Biblical Archaeology Society publishes <i>A Facsimile Edition of the Dead Sea Scrolls</i> .
1992	Qimron files suit against Shanks.
1993	Judge Dorner issues district court ruling.
1994	Oxford University Press publishes <i>DJD X</i> about <i>MMT</i> .
2000	Israeli Supreme Court affirms.

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⁷⁰⁹. Gilliam v. Am. Broad. Cos., 538 F.2d 14, 24 (2d Cir. 1976).

⁷¹⁰. See, e.g., Abraham Rabinovich, *Scholar: Reconstruction of Dead Sea Scroll Pirated*, WASH. TIMES: NAT'L WKLY. EDITION, Apr. 12, 1998, at 26, 26 cited in Matthew Bender & Co. v. West Publ'g Co., 158 F.3d 674, 688 n.13 (2d Cir. 1998), cert. denied, 526 U.S. 1154 (1999).

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Via Fax 310-203-7199

May 27, 2008

Professor David Nimmer
Mr. Morgan Chu, Esq.
Irell & Manella LLP
1800 Avenue of the Stars
Suite 900
Los Angeles, CA 90067-4276

Re: Nimmer and Irell & Manella Continuing Misstatements Concerning
Bender v. West and the Copyright of Text of Judicial Opinions

Dear David and Morgan:

I am following up on my letter to Morgan Chu and Elliot Brown of April 5, 2008, my follow up e-mail, and my letter of May 17, 2008 sent concerning statements in Law. Com attributed to Morgan Chu and statements in an article by Professor Nimmer in the Houston Law Review.

I have received no acknowledgements from any of you as to having received my prior correspondence.

I am faxing this letter in the event that you did not receive these prior communications sent to you at the e-mail addresses indicated on the web sites of Irell & Manella and UCLA Law School.

Concerning my discussion of Professor Nimmer's article, perhaps it was too long for you to have found the time to read thoroughly.

To help you out, here are a few findings from my letter of May 17, 2008:

- Nimmer in his article falsely claimed that Irell & Manella had filed a motion for summary judgment which led to the district court's HyperLaw text decision on May 19, 1997; this decision related only to HyperLaw's text motion.
- Nimmer falsely inferred, if not stated, that he and Irell & Manella had filed a petition for certiorari opposing the Second Circuit holding in favor of HyperLaw as to the copyrightability of text.

- Nimmer falsely inferred, if not stated, that he and Irell & Manella were counsel of record as to the Second Circuit opinion as to copyrightability of text.
- Nimmer failed to disclose that when the petitions for certiorari from the Second Circuit appeals had been filed, Matthew Bender had been acquired by Reed Elsevier, and that Reed Elsevier had already filed an amicus brief in the Second Circuit opposing HyperLaw's text challenge.
- Thus, not only were Nimmer and Irell & Manella and Matthew Bender neither counsel nor party in HyperLaw's text copyright challenge, but, Reed Elsevier, owner of Matthew Bender, formally opposed HyperLaw.
- Nimmer's article, published in a well regarded law review, was able to perpetuate these misrepresentations, in part by failing to conform citations in his article to basic legal citation requirements universally applicable to scholarly law publications.¹
- Nimmer's article could be considered misrepresentation of the facts for the benefit of the writer, and, Chu's reported statements to Law.Com were a further publication of these misrepresentations. Both of you have not only ethical responsibilities as lawyers, but ethical responsibilities as academic law professors.

In the Law.Com article, as I have brought to your attention, comments attributed to Chu paralleled those of Nimmer's, the two opinions were conflated, and Chu appeared to have taken credit for the text opinion, in which his actual client Reed Elsevier had filed a brief the appeal of HyperLaw's text ruling..

I await your immediate responses.

Sincerely



Alan D. Sugarman

cc: Carl Hartmann
Paul Ruskin
Elliot Brown

cc by e-mail to:
ebrown@irell.com, mchu@irell.com, nimmer@irell.com

¹ I believe both of you have been editors of the law review at your respective law schools. Among the rules ignored was ALWD Manual, Rule 12.10(b); Bluebook Rule 10.7.2, University of Chicago Manual of Legal Citation Rule 4.2(c) as to citing a case where the case name is changed on appeal. Not citing an affirming appellate opinion is very basic as well.

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May 29, 2008

Dean Michael H. Schill
UCLA School of Law
Box 951476
Los Angeles, California 90095-1476

Re: Question Re Review of Academic Misrepresentations by UCLA Adjunct Law Professors

Dear Dean Schill:

Below, please find a copy of the e-mail sent to you on May 28, 2008:

Dear Dean Schill:

I have been placed in an uncomfortable position by one, or perhaps two, of your adjunct professors - David Nimmer (and Morgan Chu?) - concerning seemingly deliberate misrepresentations in a law review article authored by Nimmer and basically reiterated by Chu in an on-line legal news article.

Without going into the details of the matter, which are fully understood by Nimmer and Chu and who have been stonewalling my amicable efforts, I would urge that you provide them with counseling in order to mediate this matter.

I see no point in embarrassing them by providing further details at this point in time.

It is not clear to me whether Chu is, or was, an adjunct professor. I do see that he spoke at your recent commencement and is somewhat involved in your institution.

They cannot make the issue go away by ignoring the issue.

I would appreciate your speaking with them and doing what you can to urge them to resolve the issues.

I am a lawyer and graduate of the University of Chicago Law School.

Sincerely,

Alan D. Sugarman

ps - Please acknowledge receipt.

Sincerely



Alan D. Sugarman



MICHAEL H. SCHILL
DEAN AND PROFESSOR OF LAW

OFFICE OF THE DEAN
SCHOOL OF LAW
BOX 951476
LOS ANGELES, CA 90095-1476

June 6, 2008

Alan D. Sugarman
17 W. 70 Street, Suite 4
New York, NY 10023

RE: Question Re Review of Academic Misrepresentations by UCLA Adjunct
Law Professors

Dear Mr. Sugarman:

I recently received your letter expressing concerns on articles authored by David Nimmer and Morgan Chu. Thank you for bringing this matter to my attention.

Unfortunately, while I may understand your frustration, I do not feel that it would be appropriate for me to become involved in this matter. I apologize that I can not provide you further assistance on this.

Sincerely,

A handwritten signature in black ink, appearing to read "Michael Schill".

Michael H. Schill

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An Operating System for Law: Online Cases

By Eriq Gardner
[IP Law & Business](#)
March 31, 2008

Carl Malamud has been bothered for 25 years by the fact that U.S. case law is locked away from the public's eyes. As a wonkish graduate student at the Indiana University School of Business in the 1980s, he was forced on occasion to sneak into the law school library to look something up -- because the library was for law professors and law students only.

In the years that followed Malamud has scored an extraordinary track record at getting information into the public domain. Thanks to him and other digital activists, in the mid-1990s the Securities and Exchange Commission put the financial filings of public companies online. In the late 1990s, due in part to aggressive lobbying by Malamud, the Patent and Trademark Office made the full database of granted patents and trademarks available and searchable online. Recently, as part of his effort to get the Smithsonian Institution to free up access to its collection of historical images, Malamud bought and downloaded 6,000 images and posted them on the free Web-sharing service Flickr.

800-POUND GORILLAS

But now, at the age of 48, Malamud is ready to head back to the problem that troubled him as a young man, taking on what he calls "the 800-pound gorilla in the room." Because of the [E-Government Act of 2002](#), which encourages government entities to publish documents online, recent case law has begun to trickle online, aided by the efforts of nonprofit academic groups and corporations. Malamud, however, wants it all online -- every federal district and appeals court decision back to the early 20th century. To do so means loosening the legal grip over this information held by Thomson Corp., whose West business unit is publisher of Federal Reporter, Federal Appendix and other publications. (In the interest of full disclosure, ALM Properties Inc., the publisher of *IP Law & Business*, licenses its content to West, which includes it in its electronic research services.)

In a letter to Thomson North American Legal President and CEO Peter Warwick in August, Malamud threw down the gauntlet. He wrote, "Codes and cases are the very operating system of our nation of laws, and this system only works if we can all openly read the primary sources." Two weeks later, Thomson deputy general counsel and Vice President Edward Friedland sent a letter back to Malamud highlighting "three categories of original work in the Reporters that West believes are subject to copyright protection," and signaling Thomson's willingness to defend its copyrighted intellectual property. If lawsuits fly, Malamud has friends and funding. Backing him in his newest nonprofit venture are Silicon Valley philanthropists such as eBay founder Pierre Omidyar-and, more controversially, Google Inc.

Meanwhile, getting case law into the public domain is becoming a top priority of tech zealots who want to build what they call Web 3.0, or the "[semantic Web](#)." The notion is that Internet users, organized in social networking collectives, can take basic information and build value on top of this information through aggregated wisdom and creativity. "Piling up case law in publicly available archives is only the first step," says Tom Bruce, director of



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the Legal Information Institute at Cornell University. He imagines a world in which words in a judge's decision are hyperlinked to other case decisions, or to academic analysis. And the Internet collective will take over West's role of making sure that case opinions online stay true to the judge's words, and that the proper note is added if a case is overruled. "In general, lawyers have been too frightened to want to take case law away from a trusted authority, and the user-generated-data crowd has been too eager to represent [the collective Web wisdom] as a panacea," says Bruce.

THE PUBLIC DOMAIN

On the face of it, the effort to get case law online should not be complicated. Everyone accepts that the actual words of legal decisions are in the public domain. But case law has been in the control of West so long, and West's organization of the data has become so accepted, that it is hard to draw the line where the public domain ends and West's copyright begins.

Historically, before the age of digital networks, circulating judicial decisions was difficult and expensive. In 1971 the government set up Juris, a database of collected federal case law that went back to 1900. Twelve years later, under a mandate by the Reagan administration to privatize as much of government as possible, Eagan, Minnesota-based West Publishing Co. was hired to take over the job of managing Juris.

In a stroke of corporate ingenuity, West developed a proprietary page-numbering system that affixed numbered citation to judicial scripture. Judges loved it. Soon, they required lawyers appearing in their courtroom to not only cite relevant decisions by name when arguing motions, but also the West citation number. The value of West's work was self-perpetuating. By the mid-1980s, Federal Reporter and other West publications had become near-sacred texts in the legal industry.

In 1993, 10 years after the government outsourced its management of case law to West (acquired by Thomson in 1996), the company announced that it was pulling out of Juris. Its original agreement gave it continued access to the case law database, but it now had something even more valuable: West had indelibly stamped America's legal code and case law with introductory headnotes, commentary, typographical and grammatical corrections, italicized and boldface emphasis to highlight key passages and indexing. West made money by selling subscriptions to its publications and also by selling additional services to help search and analyze its data. When, in the 1980s and 1990s, competitors like Lexis Nexis and public advocates like Jamie Love of the Taxpayer Assets Project complained and started challenging West's monopoly on case law, West argued that these "pagination" and value-added elements were copyrighted.

Malamud lives in a rural town in Sonoma, Calif., and has never been much interested in making money. He is the grandson of a famed neuropathologist, and both his parents were scientists: his father, a nuclear physicist and his mother, a physiologist. His first language was French, because he lived in Switzerland and France until he was 5 years old. After his family moved to a suburb of Chicago, Malamud went to an arts academy in Michigan (he plays the trumpet) and later to Indiana University, where he learned he was barely a good enough musician to make the jazz band. He did the course work to get a doctorate in business economics and public policy, but not the dissertation. When he moved to Washington, D.C., he spent his days doing database architecture for the Federal Reserve and his nights attending Georgetown Law School. After a year he dropped out. "I decided that I had learned all I wanted about the law," he says. "First year is constitutional law and contracts and properties, the real intellectual stuff."

Malamud's attention shifted once again to technology-specific networks and databases. He published several books on the subject of network architecture and formed a consultancy. In 1993 he started one of the Internet's first radio stations. *The New York Times* ran his picture on the front page and told Ted Turner to move over for the next generation in new media. Nicholas Negroponte, director of the MIT Media Laboratory, told the *Times*, "It's a brilliant idea." Then, according to Malamud, he called up and asked Malamud for his business plan. "What business plan?" Malamud responded. Thanks to his disinterest in cashing in, Malamud decided to make his organization, Internet Multicasting Service, a nonprofit, which, he says, "really disgusted a lot of people," and ensured that he wouldn't make the billions earned by other early Webcasters such as Mark Cuban.

After consulting with many government agencies, Malamud established a public interest group with the mission of getting government documents online. He set his sights on the SEC, which maintained a huge depository of regulatory filings by public corporations. The National Science Foundation gave him several hundred thousand dollars to get the data online. "I got a grant from the U.S. government to give to the U.S. government to purchase the data that we had already paid for with our U.S. tax dollars," says Malamud, chuckling at the irony.

SEC FILINGS AND EDGAR

His friends at Sun Microsystems chipped in some computer equipment. He also spent some of his own money. In 1994 he started putting some agency data online, making some SEC staffers extremely unhappy. At the time, the SEC had a \$14 million contract with Ohio-based Mead Data Central (now Lexis Nexis) to manage its [EDGAR](#) database and to disseminate the information wholesale. Mead's efforts, however, were lackluster, and its conflicts came under congressional review. (At the time, Mead also sold EDGAR SEC filings on Lexis.)

Then, after his Web site with SEC data had become very popular, Malamud posted a notice that the "service would terminate in 60 days." It wasn't his job to maintain the database, he told visitors to the site. To make it easy for the public to complain, Malamud recalls, he provided links to e-mail Vice President Al Gore, speaker of the House Newt Gingrich, and SEC Chairman Arthur Levitt. In actuality, Levitt didn't have an e-mail address, so Malamud made one up, collected the e-mails, printed them out, and marched into the SEC's office the next day and dropped off 15,000 pages of printouts.

insight **ALM** **EVENTS**

A few days later, Malamud and fellow activist Jamie Love crashed an SEC meeting on the future of EDGAR and hijacked the microphone. Many in the audience questioned whether the agency should be subsidizing Wall Street's thirst for corporate data. Malamud argued that indeed the general public wanted the data.

How much would a public EDGAR database cost the SEC to set up? Did they have enough computer equipment? Malamud answered these questions by loading his station wagon with computers, driving them to the SEC, and configuring their Cisco router and T-1 connection. "You have to show by doing," says Malamud. "Here's the important thing: Make them own it, and at the end of the day they'll be happy."

House of Representatives telecommunications subcommittee Chairman Edward Markey says Malamud's efforts "spurred the democratization of government information," while others credit him with introducing a whole new class of investors into the stock market. Higher powers also took notice. When Malamud wrote a book about his efforts organizing an Internet World Exposition in 1996, the Dalai Lama wrote the introduction, praising Malamud and his work of increasing transparency in government.

Today Malamud is more willing than ever to shame an adversary, making him more of a hero to some and unpleasantly abrasive to others. Last year Malamud agitated for getting congressional hearings online. C-SPAN claimed copyright. So Malamud sent an open letter to C-SPAN CEO Brian Lamb where he lectured, "You should not treat the U.S. Congress like Disney would treat Mickey Mouse." The letter was publicized on the blog being being, a favorite of the technorati. When C-SPAN changed its policy and put the video online without copyright, Malamud won being being's plaudits.

Malamud certainly won't be the first to challenge West's dominance over case law. In 1985 the company sued Mead Data Central in U.S. district court in Minnesota after Mead tried to use West's page number system in its own legal database, Lexis. (Mead countersued with an antitrust suit in Ohio district court.) West relied on the already established "sweat of the brow" doctrine that gave copyright to anybody who employed significant effort and time compiling public material. The district court, and later the U.S. Court of Appeals for the Eighth Circuit, affirmed West's copyright and ordered an injunction against Mead. The two companies later signed a confidential settlement that reportedly gave Lexis a limited license to use West's copyrighted materials.

But six years later, in 1991, the U.S. Supreme Court seemed to invalidate "sweat of the brow" as a legal doctrine in *Feist Publications, Inc. v. Rural Telephone Service Co.* In that case, Rural argued that Feist had violated copyright by pirating Rural's telephone listings to include in its own phone directory. The Supreme Court disagreed, ruling that information itself is not "original," and, therefore, not copyrightable. Justice Sandra Day O'Connor left the door slightly ajar by stating that there might be creative aspects in organization of "collections."

These two court cases set the stage for a major showdown in 1994. [Matthew Bender & Co. and intervenor HyperLaw sued West](#) in federal district court in New York, looking for a declaratory judgment that West's federal law publications were not copyrighted. Bender wanted to include a copy of case law with its treatises of analysis. HyperLaw was looking to sell case law on CD-ROM. Both claimed "a reasonable apprehension of litigation."

Each side brought in top IP litigators. On Bender's side, Irell & Manella partner Morgan Chu led the cause. On West's, Jeffrey Kessler, now a partner at Dewey & LeBoeuf, led a team that included prominent law professor Arthur Miller.

West's lawyers tried to get the case dismissed on grounds that the court had no jurisdiction, and that the issue was moot since HyperLaw had no intention of copying West's case law and there was no real threat of suit. Chu says now that West's strategy was "to get the case to Minneapolis, where they had precedent and the hometown company was beloved for their very admirable charitable endeavors."

The fight was nasty, with West attempting to impose sanctions on the plaintiffs. There were numerous appeals. In 1997 Judge John Martin, Jr., ruled that West's citation system displayed insufficient creativity to be protectable. The following year, the U.S. Court of Appeals for the Second Circuit affirmed the judgment. The Supreme Court denied cert.

"West's monopoly pricing is finished," a lawyer for HyperLaw told *The New York Times*. "You are about to see the price of legal research spiral downward," predicted another legal publisher.

But it just didn't happen.

For the next decade, nobody ran with the ball. HyperLaw mostly faded away. West cheered the fact that the court had at least deemed its headnotes as copyrighted, and, what's more, didn't signal retreat on any of its copyright claims. Asked today what copyrighted elements could be deleted if someone wanted to scan the Federal Reporter, Thomson Executive Vice President Rick King says he's not sure. "This gets into gray areas," he says. "The content itself is in the public domain. But if someone takes it and scans it in, I don't know if courts have decided that issue."

Current decisions are appearing freely online, if in a somewhat piecemeal manner. In addition to the spotty efforts of the courts themselves, some public and private enterprises have also been posting court decisions. AltLaw, a joint effort by Columbia Law School and the University of Colorado Law School, has put the last decade of federal appellate and Supreme Court opinions online, permitting free full-text searches. Justia Inc., a Palo Alto, Calif.-based company, has also started going down to courthouses and scanning judicial decisions for online use. (The company hopes to make money by offering other services, such as custom-designed Web sites for law firms.)

Those efforts may not go far to grab historical case law, particularly judicial decisions between 1923 and the end of the 20th century. So this year, after talking with lawyers and technologists at technology-trade publisher O'Reilly Media (with whom he shares office space), Malamud formed a new nonprofit called [Public.Resource.Org](#) and started purchasing previously scanned case law. "I brought my credit cards up to \$40,000 in debt," he says, "and just last week finally brought in enough foundation money that I was able to pay myself my back salary."

THE FASTCASE DEAL

Malamud has put out the call to buy case law scanned from courtroom files. In November he announced a deal with Washington, D.C.-based Fastcase Inc., that will provide him 1.8 million pages of federal case law, including all appeals court decisions from 1950 to the present and the full archive of all Supreme Court decisions. "Carl is a guy who is very impatient with things that don't make sense, which I totally get," says Ed Walters, CEO of Fastcase, which makes its money on value-added searching services.

The Fastcase deal is a start, Malamud says. But to achieve his ultimate objective, he may need to use the West publications he has already started scanning. So in mid-August Malamud sent the letter to West asking it "for guidance on the subject of where the public domain stops."

In its reply, West set out the three categories of work it believes are its IP. The first category included introductory material and headnotes, where no one would argue with West's copyright. The second category included "West's editorial enhancements" (annotations, revisions, and amplification of citations). The third category included "West's selection and arrangement ... of the individual case reports," which raised yelps from lawyers who represented Bender.

"That's an outrage," says Chu, who was asked by *IP Law & Business* to comment. "[Thomson] seems to be taking the position that because our [Bender's] case was the only court to address the issue, they can ignore it. But it [the appellate court] happens to be one of the most respected courts in the U.S., especially on copyright issues. They seem to be thumbing their nose at the Second Circuit."

Malamud says sending his letter was part of a calculated strategy, developed in consultation with lawyers at the Electronic Frontier Foundation, Stanford law professor Lawrence Lessig and others. If Malamud does decide to go ahead and use the scanned work, the team will borrow from Bender's playbook and file a motion for declaratory judgment in California.

Malamud certainly has plenty of critics. HyperLaw founder Alan Sugarman, who was instrumental in pushing the Bender suit forward, calls Malamud's efforts a "PR stunt" and thinks he should instead push judicial circuits like the U.S. bankruptcy courts to get their act together and publish their documents online. Sugarman worries that Malamud is "enabling the courts to palm off their own responsibilities."

Others don't see the lack of online case law as much of a problem. "I haven't heard any complaints from any lawyers on having access to the law," says Jeffrey Kessler, who no longer represents West.

And as word gets around that Google is funding Malamud's effort to wrest case law from West, critics are sure to charge that he is merely a stalking horse for the search giant's colossal ambitions. Google, the wizard of Internet distribution, has found copyright to be its enemy on many fronts, from video to books. "[CEO] Eric Schmidt and [VP] Vinton Cerf think I do good work," says Malamud. "They didn't buy the mission or anything." Google isn't commenting, but what would stop it from creating a business selling ads against pages of case law?

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This is West's petition for certiorari
from 158 F.3d 674. HyperLaw is a
respondent. Matthew Bender is not.

NO.

IN THE
Supreme Court of the United States

OCTOBER TERM, 1998

WEST PUBLISHING CO. and
WEST PUBLISHING CORPORATION,

Petitioners,

v.

HYPERLAW, INC.,

Respondent.

ON PETITION FOR WRIT OF CERTIORARI
TO THE UNITED STATES COURT OF APPEALS
FOR THE SECOND CIRCUIT

PETITION FOR WRIT OF CERTIORARI

JAMES F. RITTINGER

Counsel of Record

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Attorneys for Petitioners

West Publishing Company and West Publishing Corporation (collectively, "West") respectfully request that a writ of certiorari be issued to review the opinion and decision of the United States Court of Appeals for the Second Circuit entered in this case.

OPINIONS BELOW

The opinion of the United States District Court for the Southern District of New York (Pet. App. 47a-57a) is reported at 42 U.S.P.Q.2d 1930, 1996 WL 266972 (S.D.N.Y. May 19, 1997). The opinion of the United States Court of Appeals for the Second Circuit (Pet. App. 1a-46a) is reported at 158 F.3d 674. West's petition for rehearing with a suggestion for rehearing *en banc* was denied on December 22, 1998 (Pet. App. 60a-61a).

STATEMENT OF JURISDICTION

This is a declaratory judgment action by HyperLaw, Inc. ("HyperLaw") seeking judgment that it will not infringe West's copyrights in its compilations of case reports by verbatim copying of an unlimited number of the case reports (after redacting West's synopses, headnotes, and key numbers). The district court had jurisdiction under 28 U.S.C. §§ 1331, 1338(a), and 2201. The Court of Appeals had jurisdiction to hear the appeal under 28 U.S.C. § 1291. A timely petition for rehearing with a suggestion for rehearing *en banc* was denied on December 22, 1998, and this petition for a writ of certiorari was filed within 90 days of that date. This Court's jurisdiction is invoked under 28 U.S.C. § 1254(1), and Supreme Court Rule 13.

CONSTITUTIONAL AND STATUTORY PROVISIONS INVOLVED

Article I, section 8, clause 8 of the United States Constitution provides that:

The Congress shall have Power . . . To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.

CONCLUSION

For the foregoing reasons, it is respectfully submitted that this petition should be granted.

Respectfully submitted,

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Attorneys for Petitioners

 SECURITIES AND EXCHANGE COMMISSION
 WASHINGTON, D.C. 20549

FORM 10-K
 ANNUAL REPORT PURSUANT TO SECTION 13 OR 15(D) OF THE
 SECURITIES EXCHANGE ACT OF 1934
 FOR FISCAL YEAR ENDED DECEMBER 31, 1998 COMMISSION FILE NUMBER 1-13492

THE TIMES MIRROR COMPANY
 (EXACT NAME OF REGISTRANT AS SPECIFIED IN ITS CHARTER)

<TABLE>

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DELAWARE
 (STATE OR OTHER JURISDICTION OF
 INCORPORATION OR ORGANIZATION)

95-4481525
 (I.R.S. EMPLOYER
 IDENTIFICATION NO.)

TIMES MIRROR SQUARE
 LOS ANGELES, CALIFORNIA
 (ADDRESS OF PRINCIPAL EXECUTIVE OFFICES)
 </TABLE>

90053
 (ZIP CODE)

REGISTRANT'S TELEPHONE NUMBER, INCLUDING AREA CODE: (213) 237-3700

SECURITIES REGISTERED PURSUANT TO SECTION 12(B) OF THE ACT:

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TITLE OF EACH CLASS

NAME OF EACH EXCHANGE ON WHICH REGISTERED

Series A Common Stock	New York Stock Exchange and Pacific Stock
Premium Equity Participating Securities	New York Stock Exchange

</TABLE>

 SECURITIES REGISTERED PURSUANT TO SECTION 12(G) OF THE ACT:

Series C Common Stock
 (Title of Class)

Indicate by check mark whether the Registrant (1) has filed all reports required to be filed by Section 13 or 15(d) of the Securities Exchange Act of 1934 during the preceding 12 months (or for such shorter period that the Registrant was required to file such reports), and (2) has been subject to such filing requirements for the past 90 days. Yes ☒ No ☐

Indicate by check mark if disclosure of delinquent filers pursuant to Item 405 of Regulation S-K is not contained herein, and will not be contained, to the best of Registrant's knowledge, in definitive proxy or information statements incorporated by reference in Part III of this Form 10-K or any amendment to this Form 10-K. ☒

The aggregate market value of the voting stock of the Registrant held by non-affiliates of the Registrant on March 10, 1999 was approximately \$2.4 billion. (For purposes of this calculation, the market value of a share of Series C Common Stock was assumed to be the same as a share of Series A Common

of which there were no amounts outstanding at December 31, 1998. At March 10, 1999, the Company had \$60.0 million of borrowings outstanding under this line of credit.

ACQUISITIONS

On April 30, 1998, the Company acquired the Los Angeles area business of EZ Buy & EZ Sell Recycler Corporation (Recycler), consisting primarily of the Recycler publications in the Los Angeles, Orange, Riverside, San Bernardino and Ventura counties and a portion of Santa Barbara County for \$188.7 million. The Company also invested in preferred stock and provided a term loan to Target Media Partners, a new entity that owns all of the non-Los Angeles area assets of Recycler for a total amount of \$34.8 million.

In February 1999, Eagle New Media Investments, LLC, an investment affiliate of the Company, acquired Newport Media, Inc., a publisher of shopper publications in the Long Island and New Jersey areas, for \$132 million.

DISPOSITIONS

On July 31, 1998, the Company completed the divestiture of Matthew Bender in a tax-free reorganization and the sale of the Company's 50% ownership interest in Shepard's to Reed Elsevier plc. The two transactions were valued at \$1.65 billion in the aggregate. Proceeds from the sale of Shepard's were used to pay down commercial paper and short-term borrowings of \$222.4 million. Concurrently with the closing of the Matthew Bender transaction, the Company became the sole manager of Eagle New Media Investments, LLC (Eagle New Media). At December 31, 1998, the assets of Eagle New Media were \$605.8 million of cash and cash equivalents, \$753.0 million of Times Mirror stock, \$15.0 million of marketable securities and \$22.3 million of other assets. On October 9, 1998, the Company completed the divestiture of Mosby, Inc. to Harcourt General, Inc. in a transaction valued at \$415.0 million. Concurrently with the closing of the Mosby, Inc. transaction, the Company became the sole manager of Eagle Publishing Investments, LLC (Eagle Publishing). At December 31, 1998, the assets of Eagle Publishing were \$377.2 million of cash and cash equivalents, \$34.5 million of marketable securities and \$20.1 million of other assets. While the Company believes that the Matthew Bender and Mosby transactions were completed on a tax-free basis, this position may be subject to review by the Internal Revenue Service. The Company intends to deploy the assets of both LLCs to finance acquisitions and investments, including purchases of the Company's common stock, and does not intend to use those funds for the Company's general working capital purposes. For financial reporting purposes, Eagle New Media and Eagle Publishing are consolidated with the financial results of the Company.

The Company signed a definitive agreement on January 11, 1999 with Big Entertainment, Inc. to divest Hollywood Online, Inc., and its Web site, hollywood.com. Pursuant to the agreement, Big Entertainment, Inc. will issue newly-issued restricted stock to the Company with a then current quoted market value of \$31.0 million. Big Entertainment, Inc. also has the right, under certain circumstances, to pay up to \$1.0 million of the merger consideration in cash. The transaction is subject to customary regulatory and shareholder approval.

During the 1996 fourth quarter, the Company completed the exchange of its college publishing businesses for Shepard's, a primary legal citation service. The Company recognized a gain of \$121.6 million on the exchange of its college publishing businesses and the sale of its Spanish-language medical book publisher, Doyma Libros, and recorded a writedown of \$16.7 million for the January 1997 disposal of certain net assets of CRC Press, Inc. The pre-tax net gain on disposal of \$104.9 million amounted to \$32.0 million after applicable

Real Properties are not purchased by the Company, they will remain the assets of TMCT and may be leased by the Company at a fair value rent as provided for under the terms of the lease agreement. The lease provides for two additional 12-year lease terms with fair value purchase options at the end of each lease term. The lease is included as a property financing in the Company's outstanding debt obligations (see Note 12).

The Company and the Chandler Trusts share in the cash flow, profits and losses of the various assets held by TMCT. The cash flow from the Real Properties and the Portfolio is largely allocated to the Chandler Trusts and the cash flow from the Contributed Shares is largely allocated to the Company. Due to the allocations of the economic benefits in the TMCT, 80% of the Contributed Shares are included in treasury stock for financial reporting purposes and 80% of the preferred dividends on the Series A preferred stock are excluded from the preferred dividend requirements. The Company accounts for the investment in TMCT under the equity method. This net investment was \$96,416,000 and \$95,487,000 at December 31, 1998 and 1997, respectively, and is included in "Equity investments" in the consolidated balance sheets. During 1998 and 1997, the Company recognized \$3,739,000 and \$1,268,000 of equity income on this investment.

As a result of the Transaction, for financial reporting purposes and earnings per share calculations, the number of shares of Series A common stock outstanding was reduced by 6,001,000, the number of shares of Series A preferred stock outstanding was reduced by 735,000 and the annual preferred dividend requirements were reduced to \$21,697,000 beginning in 1998. Preferred dividend requirements for 1997 were reduced by \$3,168,000.

NOTE 3 -- DISCONTINUED OPERATIONS

During the second quarter of 1998, the Company reached agreements to divest Matthew Bender & Company, Incorporated (Matthew Bender), the Company's legal publisher, in a tax-free reorganization (see Note 4) and its 50% ownership interest in legal citation provider Shepard's. The two transactions were valued at \$1,649,650,000 in the aggregate and were completed in the third quarter of 1998. The disposition of the Company's 50% interest in Shepard's was consummated by a transfer of the respective partnership interests owned by two subsidiaries of the Company to affiliates of Reed Elsevier plc for a cash consideration of \$274,650,000. The Company recorded a net gain on these two transactions in the amount of \$1,108,452,000, net of expenses and \$163,585,000 of income taxes, primarily consisting of tax reserves as disclosed in Note 11. Also during the second quarter of 1998, the Company reached agreements to divest Mosby, Inc. (Mosby), the Company's health science/medical publisher, in a tax-free reorganization (see Note 4). The transaction was valued at \$415,000,000 and was completed in the fourth quarter of 1998. The Company recorded a net gain on this transaction in the amount of \$239,023,000, net of expenses and \$55,635,000 of income taxes, primarily consisting of tax reserves as disclosed in Note 11. While the Company believes that the Matthew Bender and Mosby transactions were completed on a tax-free basis, this position may be subject to review by the Internal Revenue Service.

NOTES TO CONSOLIDATED FINANCIAL STATEMENTS (CONTINUED)

These divestitures represent the final dispositions of the Company's professional and higher education publishing businesses and, as such, have been reflected as discontinued operations in the accompanying financial statements

 Alfred E. Osborne, Jr.

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SIGNATURE

TITLE

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/s/ ROBERT W. SCHULT

Director

 Robert W. Schult

/s/ WILLIAM STINEHART, JR.

Director

 William Stinehart, Jr.

/s/ WARREN B. WILLIAMSON

Director

 Warren B. Williamson

/s/ EDWARD ZAPANTA

Director

 Edward Zapanta

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EXHIBIT INDEX

Exhibits marked with an asterisk (*) are incorporated by reference to documents previously filed by Times Mirror, or its predecessor Old Times Mirror, with the Securities and Exchange Commission, as indicated. All other documents listed are filed with this report, unless otherwise indicated.

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|------|------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| *2.1 | Agreement and Plan of Merger by and among Times Mirror, Chandis Acquisition Corporation, Chandis Securities Company, and the shareholders of Chandis Securities Company, dated August 8, 1997 (Exhibit 2.1 to Times Mirror's Current Report on Form 8-K, dated August 8, 1997) |
| *2.2 | Contribution Agreement among Times Mirror, certain subsidiaries thereof, Chandler Trust No. 1 and Chandler Trust No. 2, dated August 8, 1997 (Exhibit 10.2 to Current Report on Form 8-K, dated August 8, 1997) |
| *2.3 | Amended and Restated Agreement and Plan of Merger, dated as of April 27, 1998, by and among Reed Elsevier U.S. Holdings Inc., Reed Elsevier Overseas BV, CBM Acquisition Parent Co., CBM MergerSub Corp., Times Mirror, TMD, Inc. and Matthew Bender Company, Incorporated (Exhibit 2.1 to Times Mirror's Current Report on Form 8-K, dated July 31, 1998) |

- *2.4 Partnership Interest Purchase Agreement, dated as of April 26, 1998, by and among Times Mirror, Shepard's Inc., TM ShepCo, Inc., Reed Elsevier Inc. and Reed Books Inc. (Exhibit 2.2 to Times Mirror's Current Report on Form 8-K dated July 31, 1998)
- *2.5 Amended and Restated Agreement and Plan of Merger, dated as of October 8, 1998 by and among Harcourt Brace & Company, Mosby Parent Corp., Mosby Acquisition Corp., Times Mirror and Mosby, Inc. (Exhibit 2.1 to Times Mirror's Current Report on Form 8-K, dated October 9, 1998)
- *3.1 Restated Certificate of Incorporation of Times Mirror, as filed with the Secretary of State of the State of Delaware on January 23, 1995 (Exhibit to Times Mirror's Registration Statement on Form S-4 (File No. 33-87482))
- *3.2 Certificate of Amendment to Certificate of Incorporation of Times Mirror, as filed with the Secretary of State of the State of Delaware on February 1, 1995 (Exhibit to Times Mirror's Registration Statement on Form S-4 (File No. 33-87482))
- *3.3 Certificate of Designations of Series C Common Stock, as filed with the Secretary of State of the State of Delaware on January 23, 1995 (Exhibit to Times Mirror's Registration Statement on Form S-4 (File No. 33-87482))
- 3.4 Amended and Restated Bylaws of Times Mirror
- *3.5 Certificate of Designations of Series A Preferred Stock (Exhibit 3.5 to Times Mirror's 1995 Annual Report on Form 10-K)
- *3.6 Certificate of Designations of Series B Preferred Stock (Exhibit 3.6 to Times Mirror's 1995 Annual Report on Form 10-K)
- *3.7 Certificate of Designation of Series C-1 Preferred Stock (Exhibit 4.1 to Times Mirror's Current Report on Form 8-K, dated August 8, 1997)
- *3.8 Certificate of Designation of Series C-2 Preferred Stock (Exhibit 4.2 to Times Mirror's Current Report on Form 8-K, dated August 8, 1997)
- *4.1 Indenture by and between New TMC Inc. (subsequently changed to The Times Mirror Company) and Wells Fargo Bank (successor to First Interstate Bank of California), as Trustee for the 7 1/4% Debentures due 2013 and 7 1/2% Debentures due 2023, dated January 30, 1995 (Exhibit 4.1 to Times Mirror's 1995 Annual Report on Form 10-K)

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- *4.2 Specimen Note for 7 1/4% Debenture due March 1, 2013 (New TMC Inc., subsequently changed to The Times Mirror Company) (Exhibit 4.2 to Times Mirror's 1995 Annual Report on Form 10-K)
- *4.3 Specimen Note for 7 1/2% Debenture due July 1, 2023 (New TMC Inc., subsequently changed to The Times Mirror Company) (Exhibit 4.3 to Times Mirror's 1995 Annual Report on Form

Docket Number for the text appeal in Matthew Bender v. West, decided as 158 F.3d 674.

97-7910

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

Although the primary case name is Matthew Bender v. West, this brief uses a caption that properly identifies HyperLaw as the only Plaintiff-Appellee.

HYPERLAW, INC.,

Plaintiff-Appellee,

— against —

WEST PUBLISHING COMPANY,

Defendant-Appellant.

Reed Elsevier was and is the owner of Lexis.

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

This is Reed Elsevier's Amicus Brief filed September 29, 1997 opposing HyperLaw and supporting West. See the attached page 23-24 from the brief.

**BRIEF FOR AMICUS CURIAE
REED ELSEVIER, INC.**

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Attorneys for Amicus Curiae
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New York, New York 10036
(212) 969-3950

JON A. BAUMGARTEN
CHARLES S. SIMS
ANNA KRASKE
Of Counsel

Prior to the filing of this brief, Reed Elsevier and Matthew Bender operated Shephard's under a joint venture formed in 1996. Then Reed Elsevier agreed to provide case law from Lexis to Matthew Bender for the CD-Rom product which was the subject of the litigation.. Then, after this brief was filed, Reed Elsevier acquired Matthew Bender.

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with the approach already marked out by this Court in *Kregos* and *Key Publications*. This Court should follow the road paved by its own prior decisions and reaffirm that the factual works may be copyrighted if the underlying selection, editing, or arrangement of facts is sufficiently creative under *Feist*.

D. In Light of the "Creation and Dissemination-Inducing" Policy Underlying the Copyright Clause, Fact Works That Are the Product of Creative Choices in the Selection, Editing, and Arrangement of Facts Are Copyrightable.

The very text of the copyright clause, and the leading cases considering it, tell us that the purpose of copyright is to encourage the creation and dissemination of original works by granting limited monopolies in such works. While providing a monopoly on the dissemination of an original work is valuable because it provides an incentive to the creation of the work, the limits to an author's monopoly are also important because they allow others to build on the first author's work, thus enriching society as a whole. The challenge of defining the application of copyright laws to compilations is to serve the public interest by striking the correct balance between the incentive-providing monopoly and the access-providing limits to that monopoly.²⁹

The error of Judge Martin's holding can be seen by considering the situation in which there is no inducement to enhance existing uncopyrightable works such as judicial opinions. If legal reporters carry only the versions of opinions issued by the

²⁹ See Copyright Office Report at 1.

courts themselves -- if they lack incentives to do more, because any competitor may swiftly scan and republish any enhancements free from liability -- then lawyers referring to the opinions will be disadvantaged by being deprived of the benefit of additional material that authors such as legal publishers would otherwise add to their compilations. Without protection for the enhanced version, there is surely a very reduced incentive for such publishers to invest creative labor in considering and choosing, out of the universe of possibilities, the enhancements that they will make in the interest of improving upon the existing works. A competitor would be free to enter the market and copy the enhanced work, saving time and money and getting a leg up on the original author because it need not expend any effort in considering optimal arrangement of information in the opinion.³⁰

At least one leading commentator has opined that the opinion in *Feist* "grossly neglects copyright's incentive role."³¹ But *Feist* does not mandate that no protection be granted to "low authorship" works; it merely states that protection will be available only to the extent that the author has made a contribution to the work that we can call "original," and indeed its

³⁰ Some have already asserted that the "uncertainties in U.S. law have begun to affect investment decisions, with producers choosing not to create particularly vulnerable databases, or not to disseminate them broadly, because of a perception that the risks are too great." *Copyright Office Report* at 74.

³¹ Jane C. Ginsburg, *No "Sweat"? Copyright and Other Protection of Works of Information* after *Feist v. Rural Telephone*, 92 Colum. L. Rev. 338, 350 (1992).

U.S. 2nd Circuit Court of Appeals

MATTHEW BENDER v WEST PUBLISHING CO.

UNITED STATES COURT OF APPEALS

FOR THE SECOND CIRCUIT

August Term, 1997

(Argued: March 16, 1998 Decided: November 03, 1998)

Docket No. 97-7910

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MATTHEW BENDER & COMPANY, INC.,

Plaintiff,

HYPERLAW, INC.,

Intervenor-Plaintiff-Appellee,

- v. -

WEST PUBLISHING CO. and WEST PUBLISHING CORPORATION,

Defendants-Appellants.

- - - - - x

B e f o r e: CARDAMONE and JACOBS, Circuit Judges, and SWEET,¹ District Judge.

Defendants publish compilations of reports of judicial opinions. Each report contains the text of the opinion combined with certain enhancements, including a syllabus, headnotes, key numbers to an outline of legal topics, parallel citations to cases cited in the text, identification of counsel, and in some cases, information on subsequent procedural history. Intervenor-plaintiff seeks a judgment declaring that copying individual case reports--after redacting the syllabi, headnotes, and key numbers-- would not infringe defendants' copyright because the other enhancements are not copyrightable. Defendants appeal from a judgment of the United States District Court for the Southern District of New York (Martin, J.), following a bench trial, ruling that such copying by intervenor-plaintiff did not reproduce copyrightable elements of defendants' work and granting declaratory judgment to intervenor-plaintiff.

Affirmed. Judge Sweet dissents in a separate opinion.

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JACOBS, Circuit Judge:

West Publishing Co. and West Publishing Corp. (collectively "West") publish compilations of reports of judicial opinions ("case reports"). Each case report consists of the text of the judicial opinion with enhancements that for the purposes of this case can be put in two categories: (i) independently composed features, such as a syllabus (which digests and heralds the opinion's general holdings), headnotes (which summarize the specific points of law recited in each opinion), and key numbers (which categorize points of law into different legal topics and subtopics), and (ii) additions of certain factual information to the text of the opinions, including parallel or alternative citations to cases, attorney information, and data on subsequent procedural history. HyperLaw, Inc. publishes compact disc-read only memory ("CD-ROM") compilations of Supreme Court and United States Court of Appeals decisions, and intervened as a plaintiff to seek a judgment declaring that the individual West case reports that are left after redaction of the first category of alterations (*i.e.*, the independently composed features), do not contain copyrightable material. West now appeals from a judgment of the United States District Court for the Southern District of New York (Martin, J.), following a bench trial, granting declaratory judgment in favor of HyperLaw. Matthew Bender & Co. v. West Publ'g Co., No. 94 Civ. 0589, 1997 WL 266972 (S.D.N.Y. May 19, 1997).

It is true that neither novelty nor invention is a requisite for copyright protection, but minimal creativity is required. Aside from its syllabi, headnotes and key numbers--none of which HyperLaw proposes to copy--West makes four different types of changes to judicial opinions that it claimed at trial are copyrightable: (i) rearrangement of information specifying the parties, court, and date of decision; (ii) addition of certain information concerning counsel; (iii) annotation to reflect subsequent procedural developments such as amendments and denials of rehearing; and (iv) editing of parallel and alternate citations to cases cited in the opinions in order to redact ephemeral and obscure citations and to add standard permanent citations (including West reporters). All of West's alterations to judicial opinions involve the addition and arrangement of facts, or the rearrangement of data already included in the opinions, and therefore any creativity in these elements of West's case reports lies in West's selection and arrangement of this information. In light of accepted legal conventions and other external constraining factors, West's choices on selection and arrangement can reasonably be viewed as obvious, typical, and lacking even minimal creativity. Therefore, we cannot conclude that the district court clearly erred in finding that those elements that HyperLaw seeks to copy from West's case reports are not copyrightable, and affirm.