97-7910

To be argued by:
JAMES F. RITTINGER

United States Court of Appeals

FOR THE SECOND CIRCUIT

MATTHEW BENDER & COMPANY, INC.,

Plaintiff,

HYPERLAW, INC.,

Intervenor-Plaintiff-Appellee,

—v.—

WEST PUBLISHING CO. and WEST PUBLISHING CORPORATION,

Defendants-Appellants.

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

BRIEF FOR DEFENDANTS-APPELLANTS

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CORPORATE DISCLOSURE STATEMENT

Pursuant to FRAP 26.1, defendants-appellants West Publishing Company and West Publishing Corporation state that they are indirect wholly-owned subsidiaries of The Thomson Corporation, a company which is publicly traded in the United Kingdom and Canada but not in the United States.

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PRELIMINARY AND JURISDICTIONAL STATEMENTS

This is an appeal from a decision (1997 WL 266972) of the Honorable John S. Martin, Jr., United States District Court Judge for the Southern District of New York. The district court's jurisdiction over this declaratory judgment action concerning protection under the Copyright Act arises under 28 U.S.C. § 1331. The Court of Appeals' jurisdiction arises under 28 U.S.C. § 1291.

The court's memorandum and order (A. 494) ("Decision") was entered on May 19, 1997; defendants-appellants West Publishing Corporation and West Publishing Company (collectively, "West") filed a notice of appeal on June 18, 1997. A final judgment as to all remaining claims (A. 508) was entered on June 30, 1997, and West filed a notice of appeal (A. 510) on July 17, 1997.[1]

ISSUE PRESENTED FOR REVIEW

Did the district court err in holding that none of the extensive editorial additions and revisions made by West in adapting judicial opinions for publication as case reports in *Supreme Court Reporter* and *Federal Reporter* (apart from synopses, headnotes, and key numbers) are entitled to copyright protection?

STANDARD OF REVIEW

When, as in this case, the issue is the trial court's application of a legal standard to undisputed facts, the de novo standard of appellate review is applicable. See U.S. v. McCombs, 30 F.3d 310 (2d Cir. 1994).

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[1] References to documents in the Appendix appear as "A. ___." The trial transcript and exhibits are contained in separately paged volumes and referenced as "E. ___." Unless otherwise noted, all E. references through E. 246 are to the trial testimony of Donna Bergsgaard.

STATEMENT OF THE CASE

I. The Nature of the Case

In this action, intervenor-plaintiff HyperLaw, Inc. ("Hyperlaw") seeks a declaration that it may copy -- verbatim -- hundreds of thousands of unspecified case reports from thousands of West's volumes in the *Supreme Court Reporter* and *Federal Reporter* series. It is not disputed that copyright protects certain components of the reports. However, Hyperlaw -- which bases this action for declaratory judgment on a hypothetical product -- asserts that, once West's syllabi, headnotes, and key numbers are redacted, copyright law does not bar the copying, for purposes of resale, of every word of an unlimited number of West case reports.[2]

At trial, the undisputed evidence demonstrated that West's adaptation of public domain judicial opinions ("Opinions") for publication as case reports in *Supreme Court Reporter* and *Federal Reporter* involves contributions -- wholly apart from syllabi, headnotes, and key numbers -- that easily meet the "originality" standard set forth by the Supreme Court, in Feist Publications, Inc. v. Rural Telephone Service Co., Inc., 499 U.S. 340, 111 S. Ct. 1282 (1991) ("Feist"), and by this Court. The creation of the reports involves, inter alia:

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[2] West has never objected to the copying, even by competitors, of individual case reports, notwithstanding their protection by copyright. It is only the threat of wholesale copying of reports by a "free-riding" competitor that compels West to assert and defend its clear entitlement to protection under the Copyright Act.

(a) substantial updating, revision, and expansion of the citations in Opinions, and the addition of new citations, based on innumerable independent editorial judgments;

(b) the addition to Opinions, on a selective, case-by-case basis, of new material, created and/or compiled by West, reflecting subsequent case developments;

(c) the addition to Opinions -- tens of thousands of which contain no information whatsoever concerning attorneys -- of West-compiled reports of selected attorney-related data; and

(d) revision, editing, and reorganization of the procedural data in Opinions (captions, court lines, date and disposition lines, etc.) to render them more readable and useful.

Notwithstanding the overwhelming uncontested evidence showing West's independent expression, the district court ruled that Hyperlaw's unlimited verbatim copying for its hypothetical product would be non-infringing. Indeed, although the court could not possibly know which reports would be copied, it held that anything that Hyperlaw might ever take from West would be devoid of originality under Feist, and "trivial" in terms of what West has added to the public domain Opinions. This holding was the result of the trial court's numerous errors in applying the relevant law to the undisputed facts, including the following:

1. The court erroneously imposed a standard that demands significantly more than the "modicum" of originality required by Feist and far more than the distinguishable, "non-

trivial" variation required by this Court for derivative-work copyright protection.

2. The court ignored material, dispositive evidence of West's originality -- including case examples as well as hundreds of pages of memoranda reflecting West's ongoing, highly original editorial judgments in deciding how to revise and expand Opinions.

3. The court based its conclusions on findings which are not supported, and/or contradicted, by the record.

4. The court issued a declaratory judgment applicable to every single case report ever published by West in *Supreme Court Reporter* and *Federal Reporter*, well over 300,000 case reports in all. Yet it relied on a generalized and inaccurate description of what West does "in most cases" rather than an analysis of what West may do in those reports involving greater levels of originality.

The district court's many errors in this case may be attributable, at least in part, to its mistaken impression that copyright protection for the original material in West's case reports impedes access to "what is basically a government document," and raises special "policy considerations" because "the opinions published by West are written...by federal judges." (Decision at 3; A. 496) There is no basis in the Copyright Act, or the record, for that notion.[3] To the contrary, witnesses for both

[3] Tellingly, in a prior proceeding in this case, the district court mischaracterized West's compilations as "the official reports" (November 22, 1996 Hearing at 36; A. 418). Similarly, the court defined the issue at trial as "whether each reported decision found in the West reports is an original work of West authorship" (Decision at 5; A. 498) when, in fact, the authorship at issue includes not only West's revision of the decisions but also, inter

sides confirmed that the public, including Hyperlaw, has ample access -- without copying West's original work -- to the public domain judicial Opinions included in the case reports. See, e.g., E. 125, 140-141, 148-150, 194-196, 236-37.

Moreover, West's valuable additions and modifications in the reports are precisely the kind of authorship that the Copyright Act is intended to encourage. Congress has made a significant statutory decision in extending protection to the work of those who annotate, revise, and update pre-existing works and those who select and arrange factual data. The district court's holding -- that West's contributions are not even protected against verbatim copying by a free-riding competitor -- is thus contrary to the Act's intent, and, if affirmed, would provide a strong disincentive to the production of compilations and derivative works.

II. The Evidence At Trial

At trial the testimony of Donna Bergsgaard, manager of West's manuscript department ("Bergsgaard"), together with West's documentary exhibits, demonstrated that West makes non-trivial revisions and additions to public domain Opinions based on individual judgments by attorney editors; that these judgments are subject to continual reassessment and case-by-case variation; and that these editorial decisions are entirely independent.[4] See,

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alia, the creation of attorney summaries and new material reflecting post-decisional orders and developments.

[4] West's trial exhibits included both examples of West's "dead copy" files -- i.e., the documentation, for each report, of the revisions and additions made in the Opinions -- and internal

generally, E. 78, 166-68, 177-78, 184-85. Set forth below is a summary of the undisputed evidence presented at trial which -- as discussed in greater detail in the legal argument section, pp. 21-46, infra -- requires reversal, based on an application of these facts to the relevant copyrightability standard.

A. THE EVIDENCE AS TO WEST'S REVISION, EXPANSION, ADDITION, AND UPDATING OF CITATIONS IN SLIP OPINIONS

The trial record established that West consistently revises, expands, updates, and adds to the courts' case and statute citations. See, e.g., E. 173-176, 181, 191, 203-4.[5] The evidence also demonstrates that West makes innumerable judgments, often on a case-by-case basis, as to what references should appear in case reports and how particular references are best expressed.[6]

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memoranda reflecting West's ongoing editorial judgments as to what revisions and additions should be made to Opinions. See Exhs. D(a)-D(z) (E. 1723-3430) and Exhs. K, M-V, EE-GG. (E. 3473-3585, 3691-4427) Aside from a few cases chosen to show how West treats post-decision case developments, the "dead copy" examples were all chosen at random. (E. 165) The other exhibits contain over 700 pages of guidelines and memoranda, including day-to-day reassessments and case-by-case queries, generated by West in the past few years alone.

[5] West revises the citations in virtually all Supreme Court Opinions, and at least 75-80% of Court of Appeals slip opinions (excepting the Fifth and Eleventh Circuits). (E. 200) Hyperlaw's "dead copy" sample -- for the first 100 pages of *Federal Reporter 3rd* -- shows that West added parallel citations and/or alternative citations in 100% of the decisions included in the sample. See Exh. 1. (E. 317-728)

[6] This work is done, in part, by a staff of about 19 "opinion verifiers" who learn to apply West's editorial guidelines during a six-month, case-by-case training period. Additional training is required for statute citation revision. (E. 78, 162, 166) When the general guidelines do not answer an editorial question, attorney editors make case-by-case judgments. (E. 185) Written guidelines are revised on a day-to-day basis. See, e.g., Exh. P; March 15, 1995 memorandum, updated December 27, 1995, concerning parallel and

Parallel Citations

West decides when to add parallel citations, and which parallel citations to add, based upon its evaluation of its readers' needs and the relative usefulness -- at any point in time -- of various sources of cases and statutes. (E. 32, 192, 195)

(a) Expansion of citations to Supreme Court decisions. West has chosen to expand all Supreme Court case citations to include references to *Supreme Court Reporter* and *Lawyer's Edition* as well as *U.S. Reports*. This decision is based on usefulness and availability and, in particular, on the credibility of *Lawyer's Edition* as a research tool and the ways in which it differs from *Supreme Court Reporter*. (E. 32, 195) West's choice of parallel citations is different from other publishers' choices.[7] (E. 196) At least 20 other citations could be added to a *U.S. Reports* citation, but West chooses not to add them. (E. 32) See also Exh. HH (Insta-Cite listing). (E. 4427) The Bluebook recommends citation to *U.S. Reports* only and states, "Do not give a parallel citation."[8]

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alternative citations to table references ("THIS MEMO SUPERSEDES ALL PREVIOUS MEMOS REGARDING TABLE REFERENCES..."). (E. 3502)

[7] For example, eight other publishers of Supreme Court opinions -- including U.S. Law Week -- choose not to add parallel citations to either *Supreme Court Reporter* or *Lawyer's Edition*. See Exhs. W(c)-(j). (E. 3624-3690) Some reporters add no parallel citation at all to *U.S. Reports* citations; others add parallel citations other than *Supreme Court Reporter* or *Lawyer's Edition*. Id.

[8] Only when the case does not appear in *U.S. Reports* does the Bluebook direct citation to "S. Ct., L. Ed, or U.S.L.W., in that order of preference." The Bluebook, 15th Ed. (1991), at 165 (emphasis added).

(b) Addition of official state citations. See, e.g., Exh. D(h). (E. 2535) West has decided that all references to state cases should cite, if possible, both an official reporter and a West reporter. This editorial decision is reaffirmed daily despite "calls from law clerks telling us not to do that" (i.e., not to add an official citation) when the cited state case is outside the jurisdiction of the court issuing the opinion.[9] (E. 76, 198-199)

(c) Addition of Westlaw citations. When the Opinion provides a citation to looseleaf, specialized or electronic reporters, or slip opinions, West decides whether to add a Westlaw citation. (E. 110-11, 190-3) See Exhs. N, P, U.[10] (E. 3490-97, 3501-02, 3551-77) West chooses to retain LEXIS citations, and add Westlaw citations, when readers would find it particularly useful to have both citations. (E. 181-182) See also Exh. P. (3501-02)

(d) Addition of parallel citations to statutes. West decides when, and how, to add statute parallel citations, based on the same kinds of editorial judgments involved in revising case citations. (E. 192) See, e.g., Exh. D(p). (E. 2823)

(e) Addition of early reporter citations. When decisions that pre-date West reporters are cited, West sometimes adds early reporter citations. (E. 197) See, e.g., Exh. D(c). (E. 1930)

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[9] This editorial decision is also in direct conflict with the rule adopted by the Bluebook. (E. 76, 198)

[10] See, e.g., Exhs. D(a) (Westlaw citations added to N.L.R.B. reporter cites) (E. 1759-60); D(v) (Westlaw citation added to LEXIS cite) (E. 3005); D(g) (Westlaw citations added to slip opinion cite) (E. 2376-77).

Alternative Citations

West will completely delete a citation in an Opinion and substitute an "alternative citation" when, in the judgment of West's editors, the original citation should be improved upon in terms of usefulness, currency, or accuracy. (E. 33, 179-181) In making this determination, West assesses the present and future availability, and usefulness, of sources -- and also considers whether the judicial opinion will be made less readable by retaining a citation which is not particularly useful. (E. 180)

(a) Replacing electronic service or periodical citations. If an electronic or periodical citation can be replaced by a more permanent or generally available citation, West usually substitutes an alternative citation. See, e.g., Exh. D(e) (E. 2122) (Westlaw cite deleted); E. 117 (U.S. Law Week cite deleted). See also Exhs. N, P, U. (E. 3490-97, 3501-02, 3551-77)

(b) Replacing references to slip or memorandum opinions. Under certain circumstances, but not others, West deletes court citations to slip opinions or unpublished memoranda and replaces them with more useful citations to reporters or electronic services.[11] See, e.g., Exh. D(x) (E. 3199); Exh. D(e) (E. 2125).

(c) Replacing selected reporter citations. If an Opinion cites to a publication which appears on lists maintained (and periodically updated) by West's editors, this citation will be entirely deleted so long as it can be replaced by a citation to a

[11] As noted above, in some cases West will retain the slip opinion reference and add a Westlaw citation. Exh. D(g) (E. 2376).

source which West believes is more widely accepted and/or more likely to be permanently available. See Exh. O. (E. 3498-3500) Conversely, West editors also maintain and update lists of those reporter citations that never should be deleted. Id.[12]

(d) Replacing selected outdated citations. If an Opinion includes citations which, as of the date of the opinion, were outdated, West substitutes, when possible, up-to-date citations. For example, West will delete a citation indicating that a petition for certiorari has been filed, and will substitute more up-to-date information (i.e., that the petition has been granted or denied), but only if the petition had been acted upon as of the day of the opinion. (E. 79, 186-87) See Exhs. R, D(c); D(x). (E. 3529, 1929, 3197) See also E. 118 (substitution of correct statute citation for completely erroneous citation)

Entirely Added Citations

When an Opinion refers to a case by name, but provides no citation, West will independently add its own citation -- unless the case appears on West's "Popular Name Listing," a subjective list of well-known cases created and periodically updated by West's

[12] These lists provide undisputed evidence of West's nuanced expressions of editorial judgments with respect to alternative citations. For example, as of August 22, 1995, the list of citations to be deleted whenever possible included Idaho Supreme Court Reports, Montana Bankruptcy Reporter, and Northern Mariana Islands Reporter, while the list of citations never to be deleted included Idaho Bankruptcy Court Reports and Virgin Islands Reports. Exh. O. (E. 3498-3500)

editors, based on their case reading. (E. 75, 167-169) The 8/12/96 listing contains over 300 cases.[13] See Exh.. (E. 3473-90)

Internal Revision and Correction of Citations

If the citations in an Opinion are inconsistent with West's chosen expression, West revises them. (E. 172-175) For example, if a court uses a case name that substantially differs from the West-created "digest title" (the abbreviated name used throughout West's system), West revises the citation to conform with the West title.[14] (E. 20-22, 47, 172-73) West also revises Opinion texts, on a case-by-case basis, to make them internally consistent, and corrects any errors or omissions in citations.[15] (E. 30, 107, 162, 165-67, 170) See Exh. Q. (E. 3503-3528) These changes are generally made without court involvement, pursuant to West's independent editorial direction.[16] (E. 174, 176-77)

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[13] Also, when an Opinion refers to a judicial action without citation, West will independently add, if available, a citation. See, e.g., Exh. D(e) (court refers to a lower court's "opinion dated August 10, 1993," and West has added a citation). (E. 2124)

[14] See, e.g., Exh. D(y) (court's reference to Motor Coach Employees v. Lockridge replaced by more informative West title) (E. 3329); reference to Connell Co. v. Plumbers and Steamfitters changed to more informative title, Connell Const. Co. v. Plumbers and Steamfitters Local Union 100, which indicates that the case involved a construction company and a union. (E. 3323)

[15] See, e.g., Exh. D(p) (concurring judge's reference to M'Culloch v. Maryland changed to conform with majority's usage). (E. 2797, 2812) In this case it was decided that consistency within a case report was more important than West's general policy to accept either version of the McCulloch case name. (E. 169-70)

[16] Indeed, corrections made by the Supreme Court itself are not available until just prior to the publication of each *U.S. Reports* volume -- long after West has issued its advance reports and *Supreme Court Reporter* interim bound volumes. (E. 159)

Expansion and Completion of Citation Page References

Opinions often cite a case or statute for a specific rule or fact but do not provide an exact textual location. West expands and clarifies these "partial citations," adding references to "extension pages." (E. 32, 201) See Exh. S. (E. 3530-44) On a case-by-case basis, West's attorney editors decide whether, and how, to expand court citations and West-added citations -- by reading both the Opinion and the cited source to determine that a specific page reference can, and should, be added.[17] (E. 32-33, 112, 115, 202-04) See Exh. D(p). (E. 2798, 2818, 2911)

B. THE EVIDENCE AS TO WEST'S SELECTION, ARRANGEMENT, AND CREATION OF ADDITIONAL TEXT TO REFLECT SUBSEQUENT CASE DEVELOPMENTS

When a post-decision order is issued, West decides (i) whether to revise the case report and/or the opinion itself to reflect this new development, and (ii) what form that revision should take. (E. 80-81) These judgments are made independently, without court permission or direction, based on West's assessment of what readers will find most useful in how the form and substance are expressed. (E. 83, 221-24, 228) The various ways in which West treats subsequent developments include:

(a) No publication. West may choose not to publish, or report on, a subsequent order in any way. (E. 80)

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[17] West's Proposed Findings of Facts, submitted below, detail still other textual revisions by West, all involving editorial judgment, including: combining concurring/dissenting opinions with majority opinion in a single text (A. 455); completely re-drawing graphics (A. 455); and replacing a court's wording with West's wording (e.g., "opinion" instead of "majority opinion") (A. 453).

(b) Creation of "file line." When West chooses not to publish a subsequent order, it may decide to report the subsequent action in a "file line" written by a West editor who has evaluated the new order.[18] (E. 80, 220-21) The writing of file lines requires the editor to describe the action accurately in the fewest possible words, choosing what data, and how much detail, to include. This sometimes can "be quite difficult," and it may be unclear what the court is doing in some cases.[19] (E. 221)

(c) Creation of "combine." On a case-by-case basis, West decides whether -- and how -- to incorporate a subsequent order into the Opinion to create a "combine." (E. 80) With amending orders, for example, West decides whether (i) merely to make the changes indicated in the order, or (ii) to incorporate the changes and also publish, following the modified opinion, the order itself (which may include explanatory material and/or a dissenting view), in whole or part.[20] (E. 80-81, 86, 223-228)

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[18] See, e.g., Exh. D(c) (file line added to reflect denial of rehearing reported on multi-case order sheet) (E. 1977); Exh. D(e) (two file lines added to reflect denial of rehearing and later denial of "rehearing and suggestion for rehearing en banc" as held in separately issued orders). (E. 2200)

[19] "File lines" are only one way to report on later orders. West's editors have decided that file lines (as opposed to, e.g., table listings) are most useful in these reports. (E. 221-2)

[20] See, e.g., Exhs. D(a) (E. 1723-35, 1813) (editor decides, after queries, to publish edited amending order as part of case report, with file line, "Order Clarifying Decision on Rehearing"); D(b) (E. 1823, 1891) (decision to revise Opinion to reflect order, and create file line, but not to publish amending order itself). By contrast, Hyperlaw's testimony was that it inserts all later orders "at the beginning of the opinion" and makes no attempt to create new material or distinguish among the orders. (E. 148-149)

(d) Decision to delay publication. When a subsequent order is received late in the publication process, West conducts a "careful analysis" to determine how important the new material is to the Opinion, and how confused readers would be by the order's separate, later publication. Depending on its evaluation of these factors, West decides where, when, and how the material in the subsequent order should be expressed. (Bound volume schedules may undergo costly delays to make the "combine" possible.) (E. 224-26)

(e) Creation of combine-related file lines. To alert readers to changes in the Opinion text, or the inclusion of a subsequent order, West creates and adds file lines. (E. 80, 223, 226, 228) See, e.g., fn. 20, supra; Exh. D(f) ("As Amended on Denial of Rehearing and Rehearing En Banc"). (E. 2219) West creates original file lines for approximately 13-15% of the case reports in each *Federal Reporter* volume. (E. 230)

(f) Separate publication. If West decides that readers will not be overly confused or misled by separate publication of the case report and a subsequent order, West may publish the order separately and add a cross-reference to the earlier report. One factor in this analysis is how long the prior opinion has been in circulation before the issuance of the subsequent order. (E. 80, 224-26, 229) See, e.g., Exh. II. (E. 4430-39)

(g) Republication. If a subsequent order is received after bound-volume publication, West may decide that complete republication of the report, with appropriate revisions and

additions, is necessary if the modification is "so major" and so changes the case that "readers would be confused..." West then independently decides, on a case-by-case basis, how to incorporate the subsequent order in a republished case report. These decisions as to when, where, and how the material in the subsequent order should be expressed are made solely by West and do not depend on whether, and how, the court itself decides to republish the opinion.[21] (E. 82-84, 227-28, 244-45)

C. THE EVIDENCE AS TO WEST'S ORIGINAL ATTORNEY SUMMARIES

The evidence demonstrates West's judgments in selecting and arranging data for attorney summaries in *Supreme Court Reporter* and *Federal Reporter*. West has different guidelines, subject to change and variation, for each series. See Exh. FF. (E. 3738-3877)

The Attorney Summaries in Supreme Court Reporter

The Opinions issued by the Supreme Court contain no attorney information whatsoever. (E. 237) West adds summaries of (i) the names of arguing counsel (but no other attorneys) and (ii) the city and state of practice -- but no other information -- for each attorney. (E. 17-19) In deciding what should be expressed in

[21] In the Ninth Circuit, for example, the Court of Appeals routinely republishes its slip opinions to reflect subsequent orders, but West only republishes those case reports which it deems to require republication. (E. 228, 244) When both the court and West do republish, the results are often different, and West's decision-making is entirely independent. See, e.g., Exh. D(f) (E. 2219-21, 2273-2325), in which West chose to create a file line and editorial note (neither of which appear in the court's republished version); to incorporate the corrections specified in the amending order into the opinion; and also to publish most of the order as well (because, inter alia, a dissent was involved). (E. 227-28)

each summary, West's criteria include concision, readability, and potential reader interest in contacting counsel. (E. 232, 235) West generally obtains counsel names from the Court's "journal copy," which appears months before an opinion is issued. West takes only attorneys' names; it does not copy any style or language or other data.[22] For each selected attorney, West obtains other data from non-Court sources. (E. 16, 236-7)

Many other publishers of Supreme Court decisions include no attorney information. See Exhs. W(d)-(h), (j). (E.3632-79, 3686-90) Moreover, when other Supreme Court reports do include attorney data, the publishers -- e.g., U. S. Law Week and Florida Law Weekly Federal -- make editorial choices entirely different from West's, and different from each other:

(a) Different attorney selection. West selects only arguing counsel, but Law Week also includes briefing attorneys, and Florida Law Weekly apparently includes only the "lead" counsel, who may not have argued. See Exhs. W(b)-(c), (i) (E. 3611-31, 3680-85); side-by-side comparison (A. 489). The resulting selections of names therefore will almost always be strikingly different.[23]

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[22] Attorney names are sometimes added based on other sources, often the attorneys themselves. (E. 17) West does not seek the Court's approval or verification but, rather, makes judgments as to whether to add attorney-supplied names. (E. 17, 235) See Exh. FF (e.g., 4/3/95 Memorandum from D. Gies re Attorney Corrections) (E. 3739-3741).

[23] In Exh. W, West names the two attorneys who argued for petitioners in two related appeals; Law Week names those attorneys, but also names four others as being "on the briefs"; and Florida Law Weekly names, as sole counsel, neither of the attorneys selected by West. (E. 3612, 3631, 3680) Also, West names Kent L. Jones alone as respondent's counsel, but Law Week gives six names

(b) Different information selection. West includes only attorneys' names and cities of practice. Law Week and Florida Law Weekly, unlike West, include law firm affiliations and sometimes do not include the city of practice. (E. 3612, 3631, 3680) (A. 489)

(c) Different treatment of multiple appeals. For an opinion addressing two appeals with non-identical parties, West indicates which counsel argued for which petitioners; Florida Law Weekly gives no such indication. (E. 3612, 3680) (A. 489)

(d) Different arrangement. West arranges its summaries at the end of all prefatory material, including the Court syllabus, directly before the opinion; Law Week places its summaries at the end of the entire report; and Florida Law Weekly places its summaries before the syllabus. (E. 3612, 3631, 3680)

The Attorney Summaries in the Federal Reporter

In preparing an attorney summary for each *Federal Reporter* report, West's judgments as to selection and arrangement vary among circuits, as does the compilation process.[24] In general, West selects the following data -- not the same selection chosen

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and Florida Law Weekly gives none, choosing instead to identify counsel as "Solicitor General, U.S. Dept. of Justice." Id.

[24] In some circuits, Opinions contain no attorney data; West obtains it from docket sheets, directories, and attorneys. See, e.g., Exhs. D(e); D(q). (E. 2173-4; 2942-2945) In other circuits, West edits and reorganizes the existing data, and obtains additional data, as necessary, to create the desired compilation. See, e.g., Exh. D(h). (A. 493; E. 2520-1) Although West does some editorial work as a slip-opinion publisher for the Fifth and Eleventh Circuits (and claims no rights in that work when published by West), it prepares no attorney summaries for those Circuits' slip opinions. (E. 159) Thus, attorney summaries are added to these Circuits' Opinions as part of West's original authorship, just as they are in the other circuits.

for *Supreme Court Reporter* -- for *Federal Reporter* summaries: (a) names of briefing, as well as arguing, attorneys; (b) specification of each attorney's role; and (c) cities of practice (but no address or telephone data), law firm affiliations, and agency titles.[25]

West brings together all selected attorney data in a single summary, positioned directly before the judge line. (E. 65) West edits, arranges, and words the selected information, making judgments, often on a circuit-by-circuit or case-by-case basis, as to what detail, and what form, to use in identifying attorneys' roles (arguing, briefing, or both); how to identify parties with appropriate counsel; and how to treat complex cases -- e.g., when the opinion is related to more than one action.[26] (E. 63, 232-34)

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[25] As with the Supreme Court case reports, West may or may not, depending upon the case-by-case circumstances, add attorney names supplied by the attorneys themselves. See fn. 22.

[26] See, e.g., 11/15/91 memorandum on "Attorney Preparation -- C.A. Cases" (E. 3795-96); 8/21/92 memorandum on use of "defendant-appellant," "defendant-appellant cross-appellee," and other terms (E. 3764); Exh. D(q) (single summary compiled and arranged by selecting limited data from two docket sheets, deleting redundant names, and adding language to clarify attorney/client affiliations) (E. 2933-34). West's editors also decide under what circumstances a case report may be published without an attorney summary (undated query to Sue Schway and Phyllis Dean) (E. 3801) and how to treat deceased or "terminated" attorneys. (E. 64). See, e.g., handwritten query dated 6/13 (E. 3749); 3/15/93 memorandum on "'Term.' Attorneys" regarding case-by-case queries (E. 3789); and 4/25/96 memorandum on "Terminated Attorneys," which states, "These are general guidelines only; please review text of the opinion before deleting these attorneys." (E. 3747)

D. THE EVIDENCE AS TO WEST'S REVISION AND REORGANIZATION OF CAPTIONS, COURT LINES, DATE LINES, AND OTHER DATA

West significantly modifies the non-decisional text of Opinions, revising and rearranging this material in accordance with general editorial guidelines and case-by-case judgments. (E. 207-09) See Exhs. EE and GG. (E. 3691-3737, 3878-4426) These revisions result, in many cases, in clearly different expression and/or content when the court and West versions are compared. (A. 491-93)

Revision and Reorganization of Captions

West edits the courts' captions for readability and concision, and many captions -- generally, those which are long or complex, or both -- undergo extensive abridgement, revision, and reorganization. (E. 47) West deletes caption information which it considers extraneous or better placed elsewhere in the case report -- including "appeal lines" and lower court docket information.[27] (E. 58-59, 217-19) On a case-by-case basis, West decides, balancing readability against completeness, whether a long court caption should be shortened for the sake of concision, and whether deleted party names should be reported in an appendix.[28] (E. 47)

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[27] See, e.g., Exh. D(f) (E. 2247, 2309) (deletion of description of order, lower court data, court's city location); Exh. D(q) (E. 2927, 2948) (deletion of lower court data and docket numbers); Exh. D(p) (E. 2782, 2789, 2893) (deletion of Court line, appeal line, and Court note, from U.S. Supreme Court slip opinion); Exh. D(e) (E. 2147, 2200) (deletion of extensive lower court information, including footnote re district court judge).

[28] Compare, for example, the same case as reported at 421 U.S. 616 and 95 S.Ct. 1830. The caption in the official report reads:

> CONNELL CONSTRUCTION CO., INC. v. PLUMBERS & STEAMFITTERS LOCAL UNION NO. 100, UNITED ASSOCIATION OF JOURNEYMEN &

When captions involve duplication of parties or multiple actions, West reorganizes the data to create a more concise and useful caption. (E. 47, 210-213) See, e.g., Exh. D(q) (combining two separate captions to make a more readable title, deleting data and adding an editorial note) (E. 2929, 2948); and Exh. D(h) (reorganizing and deleting data to combine case names).[29] (A. 493)

Revision and Rearrangement of Court Lines and Date Lines

West consistently revises, rewords, rearranges, and adds other prefatory data. (E. 52-54) West revises and rearranges the wording and placement of "court lines" to conform them to West's chosen expression. See, e.g., Exh. D(h). (E. 2330; A. 493) Although only some Opinions refer to both dates, West also uniformly includes the dates of argument and decision, adding missing information and revising and rearranging the data in

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APPRENTICES OF THE PLUMBING & PIPEFITTING INDUSTRY OF THE UNITED STATES AND CANADA, AFL-CIO

The caption in West's case report reads:

CONNELL CONSTRUCTION COMPANY, INC., Petitioner, v. PLUMBERS AND STEAMFITTERS LOCAL NO. 100, etc.

[29] Also, West enhances the usefulness of nearly all captions by selecting --and capitalizing -- certain caption names for the case's "West digest title." (E. 20-21, 210-11) The reader is thus provided, at a glance, with an abbreviated case name in which West seeks to balance concision and informativeness, choosing from numerous possibilities and where and how to use abbreviations.

Opinions to conform to West's choices of wording, abbreviation, and location.[30] A. 493)

ARGUMENT

POINT I

UNDER ALL APPLICABLE STANDARDS, WEST'S EDITORIAL ENHANCEMENTS ARE ENTITLED TO COPYRIGHT PROTECTION

A. ADAPTATIONS, REVISIONS, AND COMPILATIONS OF JUDICIAL OPINIONS ARE ENTITLED TO FULL PROTECTION UNDER THE COPYRIGHT LAW

What is not at issue in this action is the right of anyone to obtain and publish the unedited judicial opinions of federal judges. Like West and every other publisher, Hyperlaw is free to gather, and publish, public domain opinions. See Wheaton v. Peters, 33 U.S. 591, 668 (1834); Banks v. Manchester, 128 U.S. 244, 254, 9 S. Ct. 36, 40 (1888). Indeed, Hyperlaw admitted at trial that it can, and does, obtain virtually all judicial opinions from the courts -- but would prefer to copy West's annotated, expanded, and revised case reports.[31] (E. 125, 140-141, 150)

It has long been settled that a publisher owns a protectible copyright interest in original editorial enhancements to judicial opinions. In Callaghan v. Myers, 128 U.S. 617, 647, 9 S. Ct. 177, 184 (1888), the Supreme Court held that the preparer of a volume of case reports is fully entitled to a copyright "which

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[30] For example, some courts use "filed" to indicate the decision date; West changes this, since some readers might read "filed" to mean the appeal's filing date. (E. 54, 213)

[31] Hyperlaw offered no evidence that it was unable to obtain current or historical slip opinions (or any corrections made by the courts) from the courts.

will cover the matter which is the result of his intellectual labor." The courts have followed Callaghan consistently and found that any original editorial elements which a publisher adds to bare-bones judicial opinions are protected by the publisher's copyright.[32] See, e.g., West Publishing Co. v. Lawyers Cooperative Publishing Co., 79 F. 756, 761 (2d Cir. 1897); West Publishing Co. v. Edward Thompson Co., 176 F. 833, 837 (2d Cir. 1910).

Thus, the fact that West compiles and adapts judicial opinions -- as opposed to any other governmental or non-governmental public domain works -- does not subject it to different, higher standards for originality than those applicable to other compilations and derivative works. Creators of derivative works and compilations based on governmental works are not second-class copyright citizens, and, contrary to the court's assertion below, special "policy considerations" do not warrant any dilution of the protection given these copyright owners by Congress.[33]

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[32] In Sheldon v. Metro-Goldwyn Pictures Corp., 309 U.S. 390, 401, 60 S. Ct. 681, 684-85 (1940), the Supreme Court explained that Callaghan stands for the proposition that "the copyright of a reporter of judicial decisions was sustained with respect to the portions of the books of which he was the author, although he had no exclusive right in the judicial opinions."

[33] As noted above, there is nothing in the record to suggest that the result below is needed to ensure access to judicial opinions or promote competition. In any event, the Supreme Court has held that, the alleged "social value" of dissemination (even where significant First Amendment interests are involved) does not empower a court to approve the theft of copyrighted property. Harper & Row, Publishers, Inc. v. Nation Enterprises, 471 U.S. 539, 559, 105 S. Ct. 2218, 2230 (1985).

B. THE CREATION OF WEST'S CASE REPORTS INVOLVE BOTH DERIVATIVE WORK AND COMPILATION ELEMENTS

"Compilations and derivative works completely overlap the classes of subject matter specified in section 102(a). Some overlaps also exist between the two categories themselves." 1 M. Nimmer & D. Nimmer, Nimmer on Copyright §2.16, 2:206 (1990) (footnotes omitted). In creating its case-reports, West acts as a compiler, choosing, for example, (i) the selection and arrangement of the case-report elements; (ii) what attorney-related material to include, and how to arrange and express it; and (iii) which citations to include in the opinions. At the same time, West also acts as a derivative work author -- updating, revising, annotating, and adding new elements to judicial opinions. Both as an author of a compilation and of a derivative work, West demonstrated the originality of its expression -- the judgments involved, the non-trivial nature of the additions and modifications -- at trial.

B. THE *FEIST* STANDARD

The standard for copyrightability set forth in Feist is applicable whether West's editorial work is analyzed in terms of derivative work or compilation. See, e.g., Atari Games Corp. v. Oman, 979 F.2d 242, 244-245 (D.C. Cir. 1992) (Feist applicable to audiovisual work); 2 W. Patry, Copyright Law and Practice 1225 (1994) (Feist applicable to derivative works). Originality, under Feist, "looks to creative process rather than novel outcomes or results..." Tempo Music, Inc. v. Famous Music Corp., 838 F. Supp. 162, 169 (S.D.N.Y. 1993) (analysis of derivative work).

All that Feist requires for West's enhancements to be copyrightable is that they be independently created (i.e., not copied) and display a "modicum" of originality. Feist, 499 U.S. at 346, 111 S. Ct. at 1289. Only editorial elements that are "devoid of even the slightest trace" of originality will fail to qualify as copyrightable. Id. at 362, 111 S. Ct. at 1296.[34]

Thus, the essential inquiry is whether West exercises a "modicum" of originality in its revisions and additions. There can be no question that it does. The record demonstrates that West makes innumerable, substantive editorial choices -- without court direction or approval -- in determining the content and expression of the *Supreme Court Reporter* and *Federal Reporter* case reports. The record also establishes that West's judgments involve assessments of readability, clarity, completeness, availability (present and future) of sources, and other subjective considerations related to making the reports more useful.[35]

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[34] "To be sure, the requisite level of creativity is extremely low; even a slight amount will suffice. The vast majority of works make the grade quite easily, as they possess some creative spark, 'no matter how crude, humble or obvious' it might be." Id. at 345, 111 S. Ct. at 1287 (citations omitted).

[35] The Feist Court found that the alphabetized list followed an "age-old practice," one "so commonplace" as to be "practically inevitable." 499 U.S. at 363, 111 S. Ct. at 1296-97. Indeed, the copyright claimant in Feist had no real choice how to arrange a white page directory, particularly given that state law prescribed the selection of data, and, in any event, only a few basic decisions were involved. Id. In this case, West makes dozens of multi-part, variable judgments, and there is no evidence that any of West's choices are commonplace, "practically inevitable," or dictated by law, or that they follow any external guidelines. On the contrary, the evidence of other publishers' practices confirms the originality and independence of West's choices.

Indeed, the complexity of many of West's decisions about expression is not required under Feist or this Court's subsequent decisions -- which consistently reemphasize that "the required level of originality [to be copyrightable] is minimal":

> The thrust of the Supreme Court's ruling in Feist was not to erect a high barrier of originality requirement. It was rather to specify, rejecting the strain of lower court rulings that sought to base protection on "sweat of the brow," that some originality is essential to protection of authorship and that the protection afforded extends only to those original elements. Because the protection is so limited, there is no reason under the copyright law to demand a high level of originality. To the contrary, such a requirement would be counterproductive. The policy embodied into law is to encourage authors to publish innovations for the common good -- not to threaten loss of their livelihood if their works of authorship are found insufficiently imaginative.

CCC Information Services, Inc. v. Maclean Hunter Market Reports, Inc., 44 F.3d 61, 65-66 (2d Cir. 1994), cert. denied, 116 S. Ct. 72 (1995) ("CCC").[36]

Moreover, the fact that an independent judgment may be based on logic -- or that others have made similar judgments -- does not make the resulting expression any less original. CCC, 71 F.3d at 67; Key Publications, Inc. v. Chinatown Today Publication Enterprises, Inc., 945 F.2d 509, 513 (2d Cir. 1991). But a claim of originality is supported by evidence -- like that in the record

[36] "The key factor is the exercise of some editorial judgment in the selection of data." 1 W. Patry, Copyright Law and Practice 199-200.

-- that there is more than one way for an author to choose or express information. Engineering Dynamics, Inc. v. Structural Software, Inc., 26 F.3d 1335, 1336 (5th Cir. 1994), supplemented on denial of rehearing, 46 F.3d 408 (5th Cir. 1995).[37]

c. THE *CATALDA* STANDARD

This Court's standard for originality in derivative works conforms to Feist, as it must, in raising no greater barrier than the minimal "modicum" test. The standard was enunciated in Alfred Bell & Co. v. Catalda Fine Arts, Inc., 191 F.2d 99, 102-3 (2d Cir. 1951) ("Catalda"):

> ...[A] "copy of something in the public domain" will support a copyright if it is a "distinguishable variation"... All that is needed to satisfy both the Constitution and the statute is that the "author" contributed something more than a "merely trivial" variation, something recognizably "his own." Originality in this context "means little more than a prohibition of actual copying." No matter how poor artistically the author's addition, it is enough if it be his own.

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[37] West's originality is further highlighted by the many cases in which minimal exercises in judgment satisfied the standard. See, e.g., CCC, 44 F.3d at 67 (including values for cars with some, but not all, optional features); Kregos v. Associated Press, 937 F.2d 700, 704 (2d Cir. 1991) (including some, but not all, statistical categories for pitchers); J. R. O'Dwyer Co. v. Media Marketing International, Inc., 755 F. Supp. 599, 605 (S.D.N.Y. 1991) (selecting which listed firms were "true" P-R firms); Budish v. Gordon, 784 F. Supp. 1320 (N.D. Ohio 1992) (streamlining of tables containing public domain data); Key Publications, supra, 945 F.2d at 513 (leaving out businesses unlikely to remain open for very long); Nester's Map & Guide Corp. v. Hagstrom Map Co., 796 F. Supp. 729, 733 (E.D.N.Y. 1992) (listing some, but not all, cross streets, with assignment of approximate street numbers); Eckes v. Card Prices Update, 736 F.2d 859, 863 (2d Cir. 1984) (dividing list of baseball cards into two groups, "premium" and "common").

191 F.2d at 102-03 (citation and footnotes omitted).[38]

In later decisions, this Court has confirmed that the "originality requirement for a revised version is a 'minimal' or 'modest' one." Weissmann v. Freeman, 868 F.2d 1313, 1321 (2d Cir.), cert. denied, 493 U.S. 883 (1989) ("Weissmann") (citation omitted). In L. Batlin & Son, Inc. v. Snyder, 536 F.2d 486 (2d Cir.), cert. denied, 429 U.S. 857 (1976) ("Batlin"), the Court, citing Catalda, found that a plastic replica of an iron toy bank (a public domain work) did not meet the standard of "something more than a 'merely trivial' variation" -- because a side-by-side comparison established that the plastic replica merely changed the physical medium of the work; it was "practically an exact copy and [any] differences are so infinitesimal they make no difference." Id. at 489.[39] See also Dan Kasoff, Inc. v. Novelty Jewelry Co.,

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[38] See also 1 Nimmer on Copyright §3.03; 3-13 (enhancements are protectible if they are "sufficient to render the derivative work distinguishable from its prior work in any meaningful way...").

[39] Batlin -- which preceded Feist -- did not, by referring to the requisite variation as "substantial" (536 F.2d at 490), erect some higher threshold of originality than the Catalda standard:

> It is true the Batlin opinion stated: "there must be some substantial variation, not merely a trivial variation such as might occur in the translation to a different medium." But this must be taken in the context of the facts of that case, where converting a cast iron "Uncle Sam" bank into plastic form was held not to constitute sufficient originality. Batlin did not suggest a new test for derivative work originality. On the contrary, it relied heavily upon the teachings of [Catalda] ....Courts that are free to adopt either standard tend to follow Batlin, in preference to Gracen [v. The Bradford Exchange, 698 F.2d 300 (7th Cir. 1983)].

309 F.2d 745, 746 (2d Cir. 1962) ("faint trace" of originality required).[40]

As the Statement of Facts makes plain, West's alterations of opinions are anything but "merely trivial" and easily meet this Court's standard for derivative-work originality.

POINT II

THE DISTRICT COURT ERRONEOUSLY DENIED COPYRIGHT PROTECTION TO HUNDREDS OF THOUSANDS OF CASE REPORTS BASED ON ITS CURSORY ANALYSIS OF WHAT WEST DOES "IN MOST INSTANCES"

As discussed at Point III, the district court erred in holding that the kinds of revisions and additions most often made by West lack sufficient originality for copyright protection. The court also erred in assuming that a finding as to what West does "in most instances" would provide a basis for its mass invalidation of the copyrights on every one of the hundreds of thousands of reports in *Supreme Court Reporter* and *Federal Reporter*.

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1 Nimmer on Copyright §3.03, 3-16, n. 36 (citation omitted). Indeed, after Batlin, this Court explicitly reaffirmed that Catalda "remains the law in this Circuit." Weissmann, supra, 868 F.2d at 1321.

[40] Although the Court, in Woods v. Bourne, 60 F.3d 978 (2d Cir. 1995), referred to Gracen (which, again, preceded Feist), it neither questioned the authority of Catalda nor suggested that Batlin established a more demanding standard. See R. VerSteeg, Rethinking Originality, 34 Wm. & Mary L. Rev. 801, 883, fn. 17 (1993) ("Quite obviously...the court in Batlin used the term 'substantial variation' merely to delineate a point just above 'trivial,' and not, as Judge Posner suggested in Gracen, to forge a new level of variation that was copyrightable..."). See also Godinger Silver Art Co. Ltd. v. International Silver Co., 37 U.S.P.Q. 2d 1453, 1455 (S.D.N.Y. 1995) (finding that Catalda and Batlin use same standard and criticizing Gracen); 1 W. Patry, Copyright Law and Practice 162, stating that the court in Gracen "misunderstood the [originality] standard altogether."

A. HYPERLAW FAILED TO MEET ITS BURDEN OF PROOF

In this declaratory judgment action, Hyperlaw had the burden of proving that the editorial enhancements it seeks to copy are not West's original work. See Greenbie v. Noble, 151 F. Supp. 45, 68 (S.D.N.Y. 1957) (requiring a copyright owner to prove originality may impose "an impossible burden"); see also 22A American Jurisprudence 2d § 232 (1988) (party seeking declaratory judgment must demonstrate basis for relief).[41]

Hyperlaw's failure to meet this burden is inescapable. Its potentially infringing product was completely hypothetical; at no time was there a clear or consistent representation as to how many -- or which -- case reports would be copied. Before trial, Hyperlaw insisted that "wholesale copying" would not be involved. Later it vaguely acknowledged that the product might copy, verbatim, tens of thousands of case reports -- perhaps as many as 30% or 75% or 100% of the *Federal Reporter* reports -- but admitted that it never even attempted to conduct any analysis of how much of West's work would be copied. E. 295-297.[42]

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[41] Under 17 U.S.C. § 410(c), West's copyright certificates (Exh. A; E. 1635) are prima facie evidence of the validity of West's copyrights, and Hyperlaw has the burden of proving the invalidity of the copyrights claimed by West. See Oboler v. Goldin, 714 F.2d 211, 212 (2d Cir. 1983); Hasbro Bradley, Inc. v. Sparkle Toys, Inc., 780 F.2d 189, 192 (2d Cir. 1985).

[42] In fact, Hyperlaw rested without offering any evidence of the intended copying, and the court erred in failing to dismiss this action for lack of justiciability. See Point IV, infra.

B. THE DISTRICT COURT ERRONEOUSLY RELIED ON CONJECTURE AND GENERALIZATION IN ISSUING A SWEEPING DENIAL OF COPYRIGHT PROTECTION TO EVERY CASE-REPORT IN EVERY VOLUME AT ISSUE

Thus, to prevail in this action, Hyperlaw had to prove that none of the *Supreme Court Reporter* or *Federal Reporter* case reports (reaching back to the 19th century) involves sufficient originality to be protected by copyright. The district court did not review each report to determine the extent of West's contributions on a case-by-case basis. Nor could the court make a finding that West's procedures produce the same level of original expression for every case report. On the contrary, the record makes it clear that the nature and extent of West's editorial work varies from court to court, year to year, and case to case.

Under the circumstances, the district court should have dismissed Hyperlaw's claim, at the outset, as seeking an advisory opinion based upon mere conjecture.[43] Having failed to do so, the court was then compelled to dismiss Hyperlaw's claim unless it could find, based on a comprehensive review of the evidence of West's most original editorial work in each area, that there would be no copyright protection even for a case report that reflected all of West's most complex judgments and expressive revisions and additions.[44] The district court made no such finding.

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[43] See Point IV, infra. Indeed, what Hyperlaw sought -- in essence, the assistance of a United States district judge in designing the future Hyperlaw product by defining how much can be stolen from West -- is antithetical to the purpose and scope of the Declaratory Judgment Act.

[44] The court never considered, for example, a report in which West, inter alia, (i) substantially edited and completely reorganized a multi-case caption, deleting numerous parties; and

Instead, as detailed below, the district court's analysis -- which makes no reference to the record -- is impermissibly cursory as well as erroneous. Repeatedly, despite its own holding that each case report must be analyzed as a separate derivative work, the court relies on its impression of what West does in "most instances," ignoring West's more original work. (Decision at 8, 11; A. 501, 504) Moreover, even when the court does apparently acknowledge the originality of a particular West revision, it illogically denies copyrightability on the ground that such judgments occur only in a "limited number of instances." (Decision at 11; A. 504) Since there is no case report Hyperlaw might not copy, the fact that even some contain protectible material bars judgment in Hyperlaw's favor.[45]

(ii) added multiple West-created, distinctively worded "file lines" to reflect unusual subsequent orders; and added a West-created attorney summary, compiled from sources outside the Opinion and involving all the decisions as to selection-and-arrangement and wording which West sometimes encounters; and modified every citation in the opinion by revising, updating, deleting, and adding citations in accordance with West's most detailed, nuanced guidelines; and added citations where none existed; and, after editorial evaluation, delayed publication to incorporate some, but not all, of a subsequent order into the original opinion; and separately published some, but not all, of the subsequent order directly following the revised, original opinion; and added an editorial note related to the subsequent order; and created new, clearly different graphics to replace a color exhibit issued as part of the original opinion.

[45] There is nothing in the record to support any quantification of how often West has made particular revisions (involving different levels of originality) in over 300,000 case reports over the years. In fact, notwithstanding its access to thousands of "dead copy" files during discovery, Hyperlaw limited its evidence at trial to a handful of recent examples from less than a third of the relevant courts. Moreover, at the June 1996 justiciability hearing, Hyperlaw represented that its copying would be limited to current material. (A. 429-34) In reliance on this testimony, and

POINT III

THE DISTRICT COURT'S FINDINGS AS TO "ORIGINALITY" ARE CONTRADICTED BY THE RECORD AND CONTRARY TO LAW

In considering what West adds, and changes, in transforming a court-issued Opinion into a case report, the district court (i) applied a higher standard than that imposed by Feist and Catalda, and (ii) relied on findings of fact unsupported, or contradicted, by the record. The court clearly erred in finding that West's contributions to a case report, collectively, are always "merely trivial" and devoid of originality -- and that every one of West's case reports therefore may be copied verbatim. The court misapplied the law to the undisputed facts, ignoring the overwhelming evidence that West's original expression is the result of subjective judgments at all levels, including individualized, case-by-case decisions.[46]

As demonstrated below, even West's editorial work in each single context -- e.g., the expansion and revision of citations --

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Hyperlaw's failure to introduce any evidence to the contrary before resting its case, West offered little evidence as to West's editorial work on case reports prior to 1990. (Hyperlaw submitted no evidence whatsoever on the issue of pre-1990 copyrightability.) West was therefore prejudiced by the court's decision to allow Hyperlaw to re-open its case after both sides had rested and introduce evidence that it intended to engage in wholesale copying of case reports from all time-periods. See Point IV, below.

[46] The documentary evidence, completely ignored by the court, shows that West's editorial process involves not only the application of West's detailed guidelines (many of which are highly complex and subject to continual change) but also specific, case-by-case decisions by attorney editors as to choices of expression.

meets, in itself, both the Feist and Cataldа tests. However, West's originality must be judged on the basis of the cumulative effect of its additions and revisions, and the multiple judgments involved, in each case report -- not by atomizing each individual element.[47]

In Weissmann, supra, this Court held that the originality requirement was met by cumulative modifications which were similar to, but in many respects less substantial than, those often made by West.[48] Finding that the trial court had erroneously discounted plaintiff's additions and revisions on the ground they "repeated verbatim portions of prior works," the Court emphasized the "statutory scheme that expressly protects the selection of subject matter and content from underlying works, as well as the rearrangement of preexisting material." 868 F.2d at 1322. In this case, too, the district court plainly erred in finding that West's collective additions and revisions in creating a case report never involve even a "modicum" of originality, and never result in a derivative work distinguishable from the court-issued Opinion in any non-trivial way.

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[47] This Court recently warned against the dangers of basing copyrightability analysis on an approach which isolates each element or ignores the "protectible expression within an unprotectible element." See Softel, Inc. v. Dragon Medical and Scientific Communications, Inc., 118 F.3d 955, 964 (2d Cir. 1997).

[48] In Weissmann, the Court found collective originality in the plaintiff's selection and arrangement of photos; references to recent reports in the "pertinent literature"; small textual additions; and rearrangement of the "manner and order of presentation of material," including the incorporation of portions of prior works. 868 F.2d at 1322.

A. PARALLEL AND ALTERNATIVE CITATIONS

The district court described West's addition of parallel citations and replacement of court citations with alternative citations as the "most significant additions West makes to the opinions..." Decision at 11 (A. 504) Indeed, a West case report, by offering a reader more, and different, information about where to find cited cases and statutes, clearly offers a protectible "variation." Yet the court erroneously denied copyright protection, holding -- despite overwhelming evidence to the contrary -- that the judgments involved in these additions and revisions reflect "not...even a modicum of originality." Id.

1. Parallel Citations

In denying protection to West's expansion and revision of citations, the trial court relied on its findings that (i) "[i]n most instances the determination of which parallel citations to include are [sic] basically mechanical and reflect no level of originality," and (ii) the "selections made tend to conform to the standard of the legal profession and appear consistent with those recommended in A Uniform System of Citation." Id.[49]

These findings have no support in the record (which the court does not cite) and, indeed, are explicitly contradicted by undisputed evidence. The Statement of Facts, supra, at 7-8,

[49] As discussed above, at Point II, even if the court were correct in its finding as to the originality of what West does "in most instances," this finding cannot support an order which applies to what West does in all instances.

details the kinds of judgments regularly made by West in adding parallel citations, including:

> • Whether, in general, to add any parallel citations to the citations in Opinions.
>
> • How many, and which, parallel citations to add in each situation. For example, when the court cites only *U.S. Reports*, the evidence shows that West has chosen to add two citations, out of over a dozen possibilities; that this choice is based on a substantive and subjective editorial evaluation; and that other publishers have decided to add either no parallel citations or completely different parallel citations.
>
> • Whether to add official state reporter citations, particularly in those cases in which the court prefers that they not be used.
>
> • Under what circumstances an electronic citation should be added to such citations as looseleaf services and specialized reporters.
>
> • Under what circumstances parallel citations should be added when the court provides only one citation to a statute.

The nature of these judgments -- choices of expression reflecting, inter alia, West's opinion as to the relative usefulness to its readers (now and in the future) of various sources -- is completely inconsistent with the court's characterization of West's determinations as "basically mechanical." West evaluates sources based on its subjective assessment of their availability, popularity, likely permanence, and particular features (e.g., the ways in which *Lawyer's Edition* complements *Supreme Court Reporter*).[50] These kinds of evaluations

[50] The district court entirely ignored, inter alia, West's subjective judgments reflecting the increasing use of electronic sources and decreasing availability of print sources -- e.g., which

are similar to -- but far more varied and complex than -- those made by the compiler in Key Publications, supra, who simply deleted those restaurants not expected to stay open for very long.

Furthermore, the evidence contradicts the court's finding that West's citation selection conforms with the recommendations in A Uniform System of Citation (the "Bluebook"). Although the Bluebook states that citations to *U.S. Reports* should stand alone, with no parallel citation, West has decided to add two parallel citations to all *U.S. Reports* citations.[51] Similarly, directly contrary to the Bluebook rule, and despite protests from some courts, West has chosen to expand state court citations with citations to official state reporters in all cases. (E. 76, 198-99)

2. Alternative and Revised Citations

The court's findings were equally erroneous with respect to alternative citations, each of which involves deleting a court's own citation as well as adding a new citation. Even a partial summary of West's judgments in replacing and revising citations confirms that the decisions involved are not "mechanical":

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sources are so widely available that an electronic citation need not be added, or which cases are so hard to find in print that two electronic citations should be included. (see E. 181-82).

[51] As noted above, the record also shows that other publishers do not add the same citations as West, confirming that, contrary to the district court's suggestion, there is no single "standard of the legal profession" with respect to citation choices. Moreover, even if some other publishers did make the same judgments as West, this would not constitute evidence that West's choices lacked originality -- particularly in light of the likelihood that others have followed West, rather than the other way around.

- Whether to delete any citations provided by the courts and substitute other citations.

- Under what circumstances the court's citations to electronic sources should be deleted, and what citation(s) should be substituted.

- Under what circumstances the court's citations to slip opinions or memorandum opinions should be deleted, and what citation(s) should be substituted.

- Which specialized reporter citations should be deleted from Opinions, if a more widely used citation is available, and which should always be retained.

- Under what circumstances an outdated citation should be deleted and replaced by an updated citation.

- Under what circumstances the case name provided in an Opinion should be revised to conform to West's preferred "digest title."

- Under what circumstances citations in Opinions should be revised to (i) conform to West's editorial guidelines or (ii) ensure consistency within the case report.

- Under what circumstances additional page references should be inserted to citations in slip opinions, and which page references to insert.

See Statements of Facts, supra, at 9-10.

According to the district court, the "decision to cite to a bound volume rather than a ... computerized source does not reflect even a modicum of originality." Decision at 11. (A. 504) This finding ignores the evidence that these decisions as to expression -- i.e., whether to use (i) only a print citation, (ii) both print and electronic citations, or (iii) only an electronic citation -- involve an ongoing evaluation, in the light of the

increasing reliance on electronic sources, of the relative utility and availability of each cited print source.[52] (E. 179-81, 190-93) See Exhs. N, O, P, U. (E. 3490-3502, 3551-77)

Otherwise, the court simply makes no reference to the evidence of what West does in replacing and revising citations -- and completely ignores the evidence that West, like other authors of updated, revised versions (which are clearly protected as derivative works), decides how the pre-existing work should, and should not be, updated.[53] For example, West replaces outdated court citations only if the updated information was true as of the date of the decision -- a reflection of West's subjective judgment to make the court more knowledgeable as of the opinion date, but not clairvoyant. (E. 186-87) The court also ignores that a citation to a slip opinion, depending on West's judgment, may be replaced by an electronic citation or retained along with the new citation. Nor does the court acknowledge that West, in choosing which bound-reporter references to include in its expression, makes highly subjective decisions as to which specific sources should be eliminated if at all possible (e.g., Idaho Supreme Court Reports)

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[52] West's decision-making also involves an assessment of the effect of multiple citations on readability. (E. 180) The court ignored this subjective consideration as well.

[53] The court characterizes West's expansion of "partial citations" to include appropriate "extension pages" as a "mechanical search." Decision at 10. (A. 503) This finding ignores undisputed evidence that these revisions involve judgments -- as to whether, and how, to expand citations -- made by attorney editors, on a case-by-case basis, after reading both the Opinion and the cited source. See Statement of Facts, supra, at 12.

and which citations should always be retained (e.g., Idaho Bankruptcy Court Reports). See Exh. O. (E. 3489-3500)

B. ADDITION OF ENTIRELY NEW CITATIONS

The district court also ignored West's highly subjective decision, when an Opinion refers to a case by name but includes no source citation at all, either to leave the Opinion as written or express these citations fully in a way that conforms to West's guidelines. This decision depends on an assessment of whether a decision is "popular" enough to be cited by name only. West maintains, and updates, a list of "Popular Cases," based on the reading of cases by West's attorney editors, and adds a citation if the referenced case is not on this list.[54] Similarly, the court ignores the addition of entirely new citations, when appropriate, if an Opinion refers to a judicial action without providing either a case-name or citation. See Statement of Facts, supra, at 10-11.

C. TREATMENT OF SUBSEQUENT ORDERS

West's case reports indisputably become non-trivial variations on Opinions when they include additions and revisions that report on, or reflect, subsequent orders and other post-Opinion developments.[55] These contributions provide the kind of selective updating and annotation that are, in fact, the hallmarks

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[54] A recent version of the list is 17 pages long and contains over 300 cases. Exh. M. (E. 3473-90)

[55] These case reports are not merely "distinguishable" from, but substantially more useful than, public domain opinions. "File lines" and "combines" greatly enhance the efficiency of legal research by eliminating the need for attorneys, when referring to a case, to search for, interpret, and cite to related decisions that update the main decision.

of annotated and revised editions and other derivative works. The district court, however, denied any protection to this material based on its findings that:

(i) "In most instances," West's independently created "file lines" are "straightforward summaries of court action and the choice of methods of expressing these developments is generally limited and subject to widely accepted rules of citation"; and

(ii) West's judgments in deciding how to treat subsequent orders involve no originality because "the options are limited..." Decision at 8. (A. 501)

The court's blanket denial of protection to all case reports was clearly erroneous in light of its acknowledgement that at least some of West's "file lines" involve originality. Indeed, the evidence demonstrates that file lines are created from scratch; that West's editors make case-by-case choices of wording and details (e.g., whether to make specific reference to multiple parts of an order, dissents, individual judges, etc.); and that many file lines involve substantial creativity in finding concise phrases that accurately reflect complex or unclear case developments. See Statement of Facts, supra, at 12-14.[56] There is certainly nothing in the record to support a finding that West's independent choices of when to use, how to express, and where to place files lines are "subject to widely accepted rules of citation."

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[56] Furthermore, West uses judgment in deciding which subsequent developments warrant reporting at all and whether a file line -- as opposed, for example, to a table -- is the most useful way of expressing and conveying the information.

Similarly, the court mischaracterizes the judgments involved in West's selective publication of subsequent orders. It acknowledges that West must decide "whether to combine the two opinions" but ignores evidence that West also makes case-by-case judgments as to how to combine them -- e.g., which portions of the order, if any, should be incorporated into the initial opinion, printed as an addendum, or deleted. The court also ignores the numerous options and subjective judgments involved in deciding where, when, and if a subsequent order should be published -- e.g., whether the order warrants publication at all; whether the order is so important that bound-volume publication should be interrupted to permit combination; and whether, if bound-volume publication already has occurred, the order is so important (and reader confusion will be so great) that the case report should be entirely re-published to reflect the subsequent order. See Statement of Facts, supra, at 12-15.[57]

D. ATTORNEY SUMMARIES

Most of the Opinions at issue (all Supreme Court opinions and many of those from the Court of Appeals) contain no attorney information whatsoever. West's addition of originally compiled attorney summaries -- which provide an entire category of useful

[57] See, e.g., handwritten memos querying whether a subsequent order in AT&T v. N.L.R.B., 67 F.3d 446 (2d Cir. 1995), should be published separately or in a "combine," and editorial notes for the creation of a file line to be added to the combined report. (E. 1723-1735, 1813) By contrast, Hyperlaw's trial testimony was that it does not use the "form of the combine" but simply "inserts" all subsequent orders, unedited, "at the beginning of the opinion." (E. 148-149)

information that is otherwise absent -- indisputably results in a "distinguishable variation" that is far from trivial.

The district court did not find otherwise.[58] Moreover, the court acknowledged that "West clearly makes an editorial judgment as to which attorneys' names to publish and whether to add the city of practice..." Decision at 9. (A. 502) Nonetheless, the court held that West's selection and arrangement of attorney data is unprotectible, on the ground that "there are only a limited number of choices to be made." Id. The court cited no facts in support of this finding and ignored undisputed evidence that West makes individual editorial judgments in the selection, arrangement, and expression of attorney information that far surpass the standard set forth in Feist, CCC, and other cases cited above.

Indeed, the record demonstrates that West -- which has different selection-and-arrangement criteria for the two series in question -- makes not two but (depending on the court) four or five basic choices in every attorney summary; and that each choice involves numerous options, varies from court to court, and may involve case-by-case judgments (e.g., under what circumstances to include attorneys not listed in court records, or how to treat "terminated" attorneys). Moreover, it is undisputed that other publishers make entirely different decisions (from West and each other) on what data to include -- which attorneys, what identifying

[58] Although the court announced an overall conclusion that "each" of West's contributions is "trivial" (Decision at 11, A. 504), its discussion of West's attorney summaries (id. at 9, A. 502) does not refer to the derivative work standard.

information (law firm, title, etc.), what, if any, location information -- and where to place attorney summaries within the case reports. Finally, West makes detailed, case-by-case judgments on how to word and arrange the selected information and how to organize the attorney data in complex cases -- e.g., when the opinion is related to more than one action. See Statement of Facts, supra, at 15-18.

Under Feist, then, West's attorney summaries clearly are entitled to protection from verbatim, systematic copying of West's selection, arrangement, and expression -- protection which would prevent no one from taking the underlying facts.[59] The district court held otherwise, erroneously relying on this Court's decision in Financial Information, Inc. v. Moody's Investors Service, Inc., 808 F.2d 204 (2d Cir. 1986), cert. denied, 108 S. Ct. 79 (1987), in which the work in question -- in complete contrast to West's work -- never involved anything more than the "clerical" filling out of a fact card "with no room for selection or choices or judgment." Id. at 206-7.[60]

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[59] "[I]f the selection and arrangement [of facts or other pre-existing materials] are original, these elements of the work are eligible for copyright protection." 499 U.S. at 349, 111 S. Ct. at 1289 (emphasis added). The Feist Court also noted that a compilation author may be able to claim a copyright interest if he "clothes facts" with original wording. In such a case, "others may copy the underlying facts from the publication, but not the precise words used to present them." Id. at 348, 111 S. Ct. at 1298 (emphasis added).

[60] Equally inapposite is Hearn v. Meyer, 664 F. Supp. 832 (S.D.N.Y. 1987), a pre-Feist decision which did not involve either a derivative work or a compilation. In Hearn, the court -- addressing neither verbatim copying nor the requisite originality

E. CAPTIONS AND OTHER PREFATORY MATERIAL

The district court erroneously found that all of the changes West makes to Opinion captions "are simply a mechanical application of preexisting rules of citation." Decision at 7. (A. 500) This finding is contradicted by the evidence that West has independently developed its own detailed guidelines -- subject to case-by-case editorial judgments -- for the adaptation and revision of captions. See, e.g., Exh. EE. (E. 3691-3737) Moreover, the Decision provides no examples of what "preexisting rules," in the court's view, are "mechanical[ly]" applied when West shortens, edits, combines, and reorganizes captions, and chooses which party names to designate as its "digest title." Indeed, if such rules existed, all courts presumably would follow them -- and West would not find it necessary, in the interest of readability and clarity, to make the substantial revisions it does.

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for the selection and arrangement of data -- found that, when two writers on an historical subject independently base their work on the same sources, the presence of substantially similar, factual passages will not support an infringement claim. Id. at 845-47. The court's misapprehension of the evidence and the law are also apparent in its statement that "West could not prevent a competitor who was not copying West's opinions from using the identical method for reporting the attorneys involved in the case." Id. West's attorney summaries do not simply reflect one or two basic choices constituting an uncopyrightable idea or "method," but rather, numerous, multi-part choices (of selection, arrangement, and wording), subject to court-by-court and case-by-case variation. This Court has consistently held that there is copyright protection for the "organizing principle" of selections and arrangements, if the principle involves sufficient originality, even absent the kind of case-by-case judgments made by West. See, e.g., Kregos v. Associated Press, supra, 937 F.2d at 706.

Equally erroneous is the court's finding that West's revisions of captions are uniformly "minor." The court ignores the evidence, inter alia, that West's reorganized and edited captions for complex cases often bear little resemblance to the Opinion captions -- or that West sometimes completely deletes the names of numerous parties from a lengthy caption. See Statement of Facts, supra, at 19-20. Similarly, the court's finding that no originality is involved in West's revision, selection, and arrangement of court line, appeal line, and date line information ignores West's subjective judgments in determining the most useful and readable arrangement and expression for readers, which is different from that in many slip opinions. See Statement of Facts, supra, at 20-21.[61]

In conclusion, West's editorial enhancements in each editorial area clearly meet the tests set forth in Feist and Catalda. Since the assessment of copyright validity must be made collectively based upon the sum total of these areas, it is clear beyond peradventure that the district court erred in finding that

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[61] West's overall, consistent coordination of the various elements in the case report -- including its arrangement, editing, rewording, and re-styling of the caption, court line, date line, and file line -- are protected for their individual originality and also for their cumulative effect as a distinctive unit with an original "total concept and feel." See, e.g., Branch v. Ogilvy & Mather, Inc., 765 F. Supp. 819, 823 (S.D.N.Y. 1990). Indisputably, a West case report, beginning with its signature selective capitalization of party names (to create an easily cited short "digest title"), is instantly recognizable, because of these consistent revisions and rearrangements, as a West case report, and not a slip opinion.

West's collective additions and revisions could never result in any West case report that would be entitled to copyright protection.

POINT IV

THE DISTRICT COURT ERRED IN DENYING WEST'S MOTION TO DISMISS FOR LACK OF JUSTICIABILITY

"The existence of an actual justiciable controversy depends upon the definiteness of the plaintiff's intention to produce a particular product which presents a question of possible infringement." International Harvester Co. v. Deere & Co., 623 F.2d 1207, 1216, n.11 (7th Cir. 1980) (emphasis added). In this case, the "particular product" was hypothetical, and, in light of Hyperlaw's failure to provide an adequate basis for adjudication, the court erred in denying West's motion to dismiss. See Notice of Motion (A. 423-35); motion raised and renewed during trial (E. 10-11, 152).

A. THE ACTION SHOULD HAVE BEEN DISMISSED AS MOOT

Prior to a June 1996 hearing, Hyperlaw described its intended copying vaguely and ambiguously.[62] At the hearing, the testimony was that Hyperlaw's "main" or "only" intended uses would be to copy (i) the names of attorneys which do not appear in Court of Appeals slip opinions; and (ii) a few "missing" Court of Appeals case reports -- about 1-2% of all cases (absent headnotes,

[62] Indeed, Hyperlaw's counsel confirmed and continued this evasive pattern in his closing argument by quoting the language, "certain of the noncopyrighted portions," from Pl. Exh. 55 (E. 1623), and adding, with evident satisfaction: "'Certain' -- that is all we have ever said." (E. 251-52)

synopses, and key numbers).[63] The testimony in no way indicated or suggested that Hyperlaw intended to engage in wholesale copying or any copying at all from West's pre-1993 reporters.[64] This representation remained unmodified throughout the trial, and until after both sides had rested. (E. 282)

West stated, before and during trial (E. 5, 9-10; A. 425-427), that it deemed the intended copying described at the 1996 hearing to be a "fair use," thus mooting any remaining justiciable controversy. Under the Declaratory Judgment Act, dismissal is compelled when an apparent controversy is later mooted. Stokes v. Village of Wurtsboro, 818 F.2d 4 (2d Cir. 1987); Mailer v. Zolotow, 380 F. Supp. 894, 896-97 (S.D.N.Y. 1974).[65] Thus, the court erred in failing to grant West's motion to dismiss.

B. DISMISSAL WAS ALSO COMPELLED BY HYPERLAW'S FAILURE TO PRESENT ANY EVIDENCE OF THE PRODUCT AT TRIAL

Before resting its case Hyperlaw offered no evidence of any kind as to what it intended to copy from West. With nothing in the record to establish the requisites of a declaratory judgment

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[63] See Justiciability hearing at 50-51, 83-85. (A. 429-434.) See also Hyperlaw trial testimony. (E. 279-281)

[64] The court's August 5, 1996 order reflects the fact that Hyperlaw's testimony limited its intended copying to these uses. The court refers to Hyperlaw's intention to add certain features to its current cases and makes no reference whatsoever to any intention to copy, e.g., earlier cases in toto. (A. 377-82)

[65] A stipulation that a use of copyrighted material is "fair use" conclusively moots the issue of copyright validity, whether in an infringement action or a suit for declaratory relief. See, e.g., Maxtone-Graham v. Burtchaell, 803 F.2d 1253, 1255 (2d Cir. 1986), cert. denied, 484 U.S. 1059 (1987) (unnecessary to reach argument that copyrights lack validity because summary judgment on the ground of fair use is affirmed).

action, dismissal was compelled. See Wembley v. Superba Cravats, 315 F.2d 87 (2d Cir. 1993).[66]

Instead of dismissing the action, the court improperly interrupted closing arguments and reopened the trial after both sides had rested so that Hyperlaw, over West's objections, could introduce inconsistent and prejudicial new evidence -- a 1994 affidavit of Hyperlaw's principal (E. 1623-24) and related testimony.[67] See Trial Transcript. (E. 266-67, 272, 274-78, 289-91) This affidavit had been received, during the trial proper, only after Hyperlaw explicitly agreed that it was not being admitted for its truth; in the "post-trial," the court allowed it to be admitted for its truth. (E. 157, 272) Furthermore, it describes the intended copying so vaguely as to be meaningless in terms of justiciability.[68] Finally, it antedates, by a year and a half,

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[66] Hyperlaw maintained at trial that the justiciability hearing testimony should not be deemed part of the record. (E. 266) Also, it was undisputed that the December 1994 affidavit (E. 1623), on which Hyperlaw's counsel attempted to rely in his closing argument, had not been admitted into evidence for the truth of the statements it contained. (E. 157, 272)

[67] The decision to reopen a case to permit the introduction of new evidence is reviewed for an abuse of judicial discretion. An abuse of discretion may be found where one of the parties is prejudiced, where the failure to submit the evidence earlier was the result of a lack of diligence, or where the interests of justice were not served by the reopening. Bradford Trust Co. v. Merrill Lynch, Pierce, Fenner & Smith, Inc., 622 F. Supp. 208 (S.D.N.Y. 1985), aff'd, 805 F.2d 49 (2d Cir. 1986). Here, all three factors are present.

[68] Indeed, the affidavit makes it clear that what Hyperlaw seeks is an advisory opinion. Instead of stating that Hyperlaw intends to include certain specific West materials in its product, it states that Hyperlaw, "upon order of this Court," will copy "the [unspecified] non-copyrighted materials" from West's current case reports and "certain of the [unspecified] non-copyrighted portions

Hyperlaw's superseding 1996 testimony -- which limited the proposed copying to two narrow situations, neither of which implicated copying of West's historical material.

West was clearly prejudiced by the admission of inconsistent, "post-trial" evidence of Hyperlaw's intent to engage in wholesale copying of reports from all time-periods. Relying on the hearing testimony, and on Hyperlaw having rested its case without establishing an intent to copy pre-1993 case reports, or to engage in wholesale copying, West offered little evidence as to West's pre-1990 editorial work (which was even more extensive) and none as to West's overall selection and arrangement of cases.[69]

C. THE RECORD PROVIDES NO SUFFICIENTLY DEFINITE BASIS FOR DECLARATORY JUDGMENT JURISDICTION OR ADJUDICATION

For a decision "to be anything other than an advisory opinion, the plaintiff must establish that the product presented to the court is the same product which will be produced if a declaration of noninfringement is obtained." International

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of the decisions and other [unspecified] non-copyrighted materials" from earlier volumes of West reports. (E. 1623-24)

[69] As Hyperlaw admitted (E. 299-300), up until trial it consistently maintained that "wholesale copying" was not at issue, and West therefore acceded to Hyperlaw's pre-trial request that evidence relating to wholesale copying or West's overall selection and arrangement of cases (which has been consistently recognized as copyrightable) be excluded at trial. The copying of all, or nearly all, of the case-reports in a particular volume would result in an infringing copy of West's protectible selection and arrangement. Also, West would not have waived its right to a jury trial if had known that Hyperlaw would admit to being, and seek permission to be, a wholesale copier.

Harvester v. Deere, supra, 623 F.2d at 1216. Thus, even if Hyperlaw's inconsistent and prejudicial testimony at the reopened trial is considered, Hyperlaw still failed to describe, even roughly, what, and how much, will be copied, verbatim, from West, and the court erred in issuing a declaratory judgment based on impermissible conjecture. See also Point II, supra.

CONCLUSION

For the foregoing reasons, the order of the district court should be reversed and the intervenor-plaintiff's complaint dismissed.

Respectfully submitted,

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