

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

REPLY BRIEF FOR DEFENDANTS-APPELLANTS

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TABLE OF CONTENTS

PRELIMINARY STATEMENT 1

ARGUMENT 3

 POINT I

 THE DISTRICT COURT HAD NO BASIS
 FOR A SWEEPING DECLARATORY JUDGMENT
 APPLICABLE TO THOUSANDS OF CASE REPORTS
 INVOLVING VARYING DEGREES OF ORIGINALITY 3

 POINT II

 THE DERIVATIVE WORK STANDARD PROPOSED
 BY HYPERLAW AND THE AMICI IS CONTRARY
 TO FEIST AND SECOND CIRCUIT LAW 5

 POINT III

 LIKE THE DISTRICT COURT, HYPERLAW AND
 THE AMICI IGNORE THE UNCONTESTED EVIDENCE
 THAT WEST'S WORK INVOLVES A MODICUM
 OF ORIGINALITY AND NON-TRIVIAL REVISIONS 11

 A. The Opposition Briefs Fail to Consider
 The Cumulative and Collective
 Originality in West's Case Reports 11

 B. The Originality of West's Citation
 Expansion and Revision Stands Unrefuted 12

 C. The Originality of West's "File Lines"
 And "Combines" Stands Unrefuted 18

 D. The Originality of West's
 Selection and Arrangement of
 Attorney Information Stands Unrefuted 20

 E. The Originality of West's Revision of
 Caption and Prefatory Material Stands Unrefuted 22

 POINT IV

 WEST'S EDITORIAL WORK CANNOT BE DENIED
 COPYRIGHTABILITY UNDER THE "MERGER DOCTRINE"
 OR BECAUSE "FACTS ARE NOT COPYRIGHTABLE" 23

POINT V

NO AUTHOR OF A DERIVATIVE WORK -- INCLUDING
WEST -- MUST IDENTIFY WHAT HAS BEEN ADDED TO,
OR CHANGED FROM, THE PRE-EXISTING WORK 26

POINT VI

SECTION 403 HAS NO BEARING ON WEST'S
ABILITY TO ENFORCE ITS COPYRIGHTS 28

POINT VII

NO PUBLIC POLICY JUSTIFIES THE
EVISCERATION OF WEST'S COPYRIGHTS 31

POINT VIII

THIS ACTION SHOULD HAVE BEEN
DISMISSED FOR LACK OF JUSTICIABILITY 34

CONCLUSION 35

TABLE OF AUTHORITIES

CASES

<u>Alfred Bell & Co. v. Catalda Fine Arts, Inc.,</u> 191 F.2d 99 (2d Cir. 1951)	passim
<u>American Dental Ass'n v. Delta Dental Plans</u> <u>Ass'n, 126 F.3d 977, 980-81 (7th Cir. 1997)</u>	25
<u>Apple Computer, Inc. v. Franklin Computer Corp.,</u> 714 F.2d 1240 (3d Cir. 1983), <u>cert. disp'd,</u> 464 U.S. 1033 (1984)	25
<u>Bentley v. Tibbals, 223 F.2d 47 (2d Cir. 1955)</u>	27, 28
<u>Building Officials & Code Adm. v. Code Technology,</u> <u>Inc., 628 F.2d 730 (1st Cir. 1980)</u>	32
<u>Callaghan v. Myers, 128 U.S. 617, 9 S. Ct. 177 (1888)</u>	9-10
<u>CCC Information Services, Inc. v. Maclean Hunter</u> <u>Market Reports, Inc., 44 F.3d 61 (2d Cir.</u> 1994, <u>cert. denied, 116 S. Ct. 72 (1995)</u>	24-5, 32
<u>Computer Associates Int'l, Inc. v. Altai, Inc.,</u> 982 F.2d 693 (2d Cir. 1992)	33
<u>DuPuy v. Post Telegram Co., 210 F. 883 (3rd Cir. 1914)</u>	10
<u>Feist Publications v. Rural Telephone Service Co.</u> 499 U.S. 340, 111 S. Ct. 1282 (1991)	passim
<u>Financial Information, Inc. v. Moody's Investors</u> <u>Service, Inc., 808 F.2d 204 (8th Cir. 1986),</u> <u>cert. denied, 484 U.S. 820 (1987)</u>	21
<u>Folio Impressions, Inc. v. Byer California, 937 F.2d</u> 759 (2d Cir. 1991)	6
<u>Gracen v. Bradford Exchange, 698 F.2d 300</u> (7th Cir. 1983)	8
<u>Grove Press v. Collectors Publication, Inc.,</u> 264 F. Supp. 603 (C.D. Cal. 1967)	18-19
<u>Grove Press, Inc. v. Greenleaf Publishing Co.,</u> 247 F. Supp. 518 (E.D.N.Y. 1965)	28
<u>Harper & Row Publishers, Inc. v. Nation Enterprises,</u> 471 U.S. 539, 105 S. Ct. 2218 (1985)	33

<u>Hasbro Bradley, Inc. v. Sparkle Toys, Inc.</u> , 780 F.2d 189 (2d Cir. 1985)	30
<u>Howell v. Miller</u> , 91 F. 129 (6th Cir. 1898)	9, 10
<u>Innovative Concepts in Entertainment, Inc. v. Entertainment Enterprises Ltd.</u> , 576 F. Supp. 457 (E.D.N.Y. 1983)	30
<u>International Harvester Co. v. Deere & Co.</u> , 623 F.2d 1207 (7th Cir. 1980)	26
<u>Kern River Gas Transmission v. Coastal Corp.</u> , 899 F.2d 1458 (5th Cir.), <u>cert. denied</u> , 498 U.S. 952 (1990)	24
<u>Key Publications, Inc. v. Chinatown Today Publishing Enterprises, Inc.</u> , 945 F.2d 509 (2d Cir. 1991) . . .	passim
<u>Kregos v. Associated Press</u> , 937 F.2d 700 (2d Cir. 1991) . . .	25
<u>L. Batlin & Son, Inc., v. Snyder</u> , 536 F.2d 486 (2d Cir. 1976), <u>cert. denied</u> , 429 U.S. 857 (1976)	7, 13
<u>M. Kramer Mfg. Co., Inc. v. Andrews</u> , 783 F.2d 421 (4th Cir. 1986)	11
<u>Maljack Productions, Inc. v. UAV Corporation</u> , 964 F. Supp. 1416 (C.D. Cal. 1997)	8
<u>Morrissey v. Procter & Gamble Co.</u> , 379 F.2d 675 (1st Cir. 1967)	24
<u>Neal v. Glickman</u> , 391 F. Supp. 1088 (N.D. Tex. 1975)	29
<u>Practice Management Information Corp. v. American Medical Ass'n</u> , 121 F.3d 516 (9th Cir.), <u>cert. denied</u> , 118 S. Ct. 339 (1997)	32
<u>Princess Fabrics, Inc. v. CHF, Inc.</u> , 922 F.2d 99 (2d Cir. 1990)	31
<u>Re-Alco Industries Inc. v. National Center for Health Education, Inc.</u> , 812 F. Supp. 387 (S.D.N.Y. 1993)	6
<u>Sanga Music, Inc. v. EMI Blackwood Music, Inc.</u> , 55 F.3d 756 (2d Cir. 1995)	28
<u>Signo Trading Int'l v. Gordon</u> , 535 F. Supp. 362 (N.D. Cal. 1981)	16

<u>Skinder-Strauss Assoc. v. Massachusetts Continuing Legal Educ., Inc.</u> , 914 F. Supp. 665 (D. Mass. 1995)	21
<u>State of Georgia v. Harrison Co.</u> , 548 F. Supp. 110 (N. D. Ga. 1982)	10
<u>Toro Co. v. R & R Products Co.</u> , 787 F.2d 1208 (8th Cir. 1986)	25
<u>Victor Lalli Enterprises, Inc. v. Big Red Apple, Inc.</u> , 936 F.2d 671 (2d Cir. 1991)	21
<u>Weissmann v. Freeman</u> , 868 F.2d 1313 (2d Cir.), <u>cert. denied</u> , 493 U.S. 883 (1989)	passim
<u>Woods v. Bourne</u> , 60 F.3d 978 (2d Cir. 1995)	7, 11

STATUTES AND LEGISLATIVE HISTORY

17 U.S.C. § 102(b)	26
17 U.S.C. § 405(a)	30
H. Rep. No. 94-1476, 94th Cong., 2d Sess.	30
86 Cong. 2d Sess., Study 33 (1959)	31

TREATISES AND ARTICLES

R. Berring, <u>On Not Throwing Out the Baby: Planning the Future of Legal Information</u> , 83 Calif. L. Rev. 615 (1995).	33
P. Goldstein, <u>Copyright</u> (1996), § 3.4	31
M. Nimmer & D. Nimmer, <u>Nimmer on Copyright</u> (1990), § 7.12 [C] [2]	28
W. Patry, <u>Copyright Law and Practice</u> (1994)	8, 11

PRELIMINARY STATEMENT

Briefs in opposition to the appeal of West Publishing Corporation and West Publishing Company (collectively, "West") have been filed by appellee HyperLaw, Inc. ("Hyperlaw"), and, as amici curiae, the American Association of Legal Publishers ("AALP") and a group of library associations (the "Library Groups").

Contrary to the assertions repeated throughout these opposition briefs, this appeal does not concern free access to the public domain judicial opinions of the United States Supreme Court and Court of Appeals. As Hyperlaw admitted at trial, the opinions of the Courts are available to everyone. They are not only available in slip opinion form and in bound volumes of *U.S. Reports*; they are also universally available in electronic form, on official "bulletin boards" and otherwise. Hyperlaw's own products -- and those of over 150 other providers of full-text federal and state case-law -- are in themselves conclusive confirmation that West has no "monopoly" over the judges' opinions.

Thus, there is nothing in the record, or reality, to support the specious claim that West's copyrights -- which have been upheld for over 100 years -- present a barrier to the dissemination of public domain opinions. Indeed, this tired myth of West's "monopoly" is nothing more than a subterfuge to justify the misappropriation of West's copyrighted, original work.

Ironically, the opposition briefs are based on the contention that all of West's enhancements are "trivial" when, in fact, the driving force behind this litigation is the desire to make money by copying West's decidedly non-trivial and valuable

editorial work (not public domain opinions, which are freely available elsewhere).¹ Moreover, in order to maintain the fiction that West's editorial additions and revisions to slip opinions are uniformly "trivial" and "mechanical," Hyperlaw and the amici simply ignore the conclusive evidence -- detailed in West's opening brief ("West Br.") at pages 5-21 -- that West's alterations are non-trivial and involve, at the very least, a "modicum" of originality.

Indeed, the opposition briefs do not refer to even one of the dozens of exhibits that document West's editorial work.² These exhibits, and the testimony of Donna Bergsgaard ("Bergsgaard"), demonstrate, through specific examples, that West (i) makes subjective, independent editorial judgments in revising, expanding, and updating judicial opinions; (ii) makes choices of expression entirely different from those made by other publishers; (iii) makes individualized editorial decisions as to expression on a case-by-case basis; and (iii) continually reevaluates and alters editorial choices in response to a subjective assessment of the changing tastes and needs of readers.

No one disputes the truth of West's evidence. Instead, unable to reconcile the record with their distorted generalizations about what West does, Hyperlaw and the amici conspicuously avoid

¹ The development of scanning technology -- by means of which anyone can easily copy another's work -- has fueled the recent assault on the copyrights of West and other publishers.

² The exhibits -- comprising over 2500 pages of the Exhibit Appendix -- include both specific, case-by-case examples of additions and revisions made by West and voluminous internal memoranda which document, more generally, the innumerable, ongoing editorial judgments made by West in preparing case reports.

any discussion of the most important evidence admitted at trial.³ This uncontested evidence compels reversal of the district court's sweeping denial of protection to the editorial revisions and additions in every one of West's past, present, and future *Supreme Court* and *Federal Reporter* case reports.

ARGUMENT

POINT I

**THE DISTRICT COURT HAD NO BASIS
FOR A SWEEPING DECLARATORY JUDGMENT
APPLICABLE TO THOUSANDS OF CASE REPORTS
INVOLVING VARYING DEGREES OF ORIGINALITY**

Neither Hyperlaw nor the amici deny that Hyperlaw, as the plaintiff in this declaratory judgment action, has the burden of proof and must rebut the presumption of validity accorded West's copyrights. Moreover, Hyperlaw, unlike other would-be copiers, does not limit its claim for relief to a specified work or portion of a work. Instead, having steadfastly refused to identify which case reports its hypothetical product would copy, Hyperlaw seeks the right to copy, verbatim, all of West's editorial enhancements in all of the hundreds of thousands of case reports protected by

³ In fact, Hyperlaw's summary of the "evidence at trial" consists of nothing more than its argumentative commentary on some excerpts from Bergsgaard's testimony, as Hyperlaw's witness, on the first day of the trial. Hyperlaw Brief ("Hyp. Br.") at 7-28. Many of the excerpts are taken out of context, and much of Hyperlaw's commentary is, as detailed below, blatantly false or misleading. In any event, nothing in Bergsgaard's first-day testimony is inconsistent with the testimony she gave as West's witness or the compelling documentary evidence -- all of which Hyperlaw ignores.

the *Supreme Court Reporter* and *Federal Reporter* copyrights.⁴

It is undisputed that the extent of West's editorial additions and revisions varies significantly from court to court, and case report to case report. West has more than met its burden -- by demonstrating the kinds of original, non-trivial additions and revisions which appear, in all manner of combinations, in its case reports. The opposition briefs do not contest this evidence.

Instead, ignoring the examples of West's most original editorial work (and the district court's acknowledgement that, in "some instances," West's work does involve originality), Hyperlaw and the amici base their arguments exclusively on examples of West's least original editorial work. For example, Hyperlaw claims that "what West actually does" can be demonstrated by a comparison of this Court's slip opinion in Fonar v. Domenick with West's case report at 105 F.3d 99. Hyp. Br. at 38-39. Since the district court's sweeping order is not limited to the Fonar case, this example is meaningless.⁵ Indeed, even if there were a hundred case reports in which West made no changes at all, that would in no way justify ignoring the undisputed evidence that, in other cases, West

⁴ Indeed, as previously demonstrated, and not refuted in the opposition briefs, the court below should have dismissed the action for lack of justiciability. See Point VIII, below.

⁵ Similarly, Hyperlaw -- despite having had access in discovery to West's archives for cases of all Circuits -- limited its evidence at trial to a partial one-volume sampling that reflected the editorial work on cases from only three of the thirteen Circuits. See E. 317-728. This evidence could not even theoretically support a finding that strips West of copyright protection for all of its *Federal Reporter* reports. On this ground alone, the district court erred in denying West's motion to dismiss at the conclusion of Hyperlaw's case.

makes non-trivial, original additions and revisions.⁶

POINT II

THE DERIVATIVE WORK STANDARD PROPOSED BY HYPERLAW AND THE AMICI IS CONTRARY TO FEIST AND SECOND CIRCUIT LAW

Hyperlaw and the amici not only ignore the record, as detailed below. They also refuse to acknowledge this Court's application of the "originality" test to a textual derivative work in Weissmann v. Freeman, 868 F.2d 1313 (2d Cir.), cert. denied, 493 U.S. 883 (1989). In Weissmann, the lower court found that the plaintiff's additions and modifications -- many of which involved selection and rearrangement of preexisting materials -- were "minuscule, demonstrating little originality." Id. at 1321. This Court reversed, holding that the court had ignored "the statutory scheme that expressly protects the selection of subject matter and content from underlying works, as well as the rearrangement of preexisting material taken from these works." The Court also noted that the non-trivial nature of the modifications was evidenced by the defendant's desire to copy them. Id. at 1322-23.

The opposition briefs do not deny that Weissmann is directly on point. Nor do they deny that the standard enunciated in Alfred Bell & Co. v. Catalda Fine Arts, Inc., 191 F.2d 99 (2d cir. 1951) ("Catalda") -- i.e., a "distinguishable variation" to

⁶ The district court, in comments from the bench at the close of trial (E. 311-12), plainly recognized the insurmountable evidentiary problem posed by the sweeping declaration sought by Hyperlaw. Yet the court failed to address this in its decision, glossing over the evidentiary gap with generalized impressions -- themselves unsupported by anything in the record -- as to what West does "in most instances."

which the author has contributed something more than "merely trivial" -- remains the law of this Circuit and is consistent with Feist Publications v. Rural Telephone Service Co., 499 U.S. 340, 111 S. Ct. 1282 (1991) ("Feist"). In Folio Impressions, Inc. v. Byer California, 937 F.2d 759, 764-65 (2d Cir. 1991), this Court reconfirmed Weissmann's holding that copyrightability requires only independent creation and "minimal" originality. In Re-Alco Industries Inc. v. National Center for Health Education, Inc., 812 F. Supp. 387 (S.D.N.Y. 1993) ("Re-Alco"), a derivative work case involving teacher manuals, the court (Mukasey, J.), citing Weissmann, emphasized the "low threshold of originality necessary to protect variations" on public domain works:

A copyright is invalid only if the subject work shows no originality -- that is, if the copyrighted work is in no way a "distinguishable variation" on something already in the public domain... "All that is needed for a finding of sufficient originality is a 'distinguishable variation' that is not merely trivial, even if the copyrighted work is based on prior copyrighted or public domain works." Further, the "selection and ordering of particular facts or elements" can provide the basis for a finding of originality.

Id. at 393 (citations omitted) (emphasis added).

Tellingly, Hyperlaw and the amici cite no case-law from this Circuit dealing with textual derivative works.⁷ Instead, they disregard the existence of Catalda and Weissmann, arguing that West's additions and modifications should be denied protection unless West's editors change the court opinions so substantially

⁷ The ALLP brief, based in its entirety on the transparently false premise that West seeks a copyright in the judicial opinions themselves, does not address the derivative work standard.

that they are "rewriting case law..." Library Groups Br. at 18.⁸

This untenable contention is not, as the opposition briefs suggest, supported by Woods v. Bourne, 60 F.3d 978 (2d Cir. 1995) ("Woods"), or L. Batlin & Son, Inc., v. Snyder, 536 F.2d 486 (2d Cir. 1976), cert. denied, 429 U.S. 857 (1976) ("Batlin").⁹ In Batlin, the derivative work was a plastic replica of an iron toy bank that was "practically an exact copy and [any] differences are so infinitesimal they make no difference." Id. at 489. In this context, the Court's finding that there was no "substantial" difference was clearly not intended to establish a standard higher than that set forth in Catalda, upon which the Court relied.¹⁰ Similarly, the decision in Woods, a music case, in no way suggested that Weissmann (cited by the Court) was erroneous in applying the

⁸ Hyperlaw makes essentially this same argument throughout its brief, suggesting that West's dedication to "accuracy" is somehow inconsistent with editorial originality. Obviously, one may have equally "accurate" case reports which include significantly different citation choices, different reports of subsequent case developments, and different selections and arrangements of attorney data and prefatory material.

⁹ Nor is there any colorable basis for invoking the language in Batlin that warns against extending copyrightability to "minuscule variations" by "mischievous copiers intent on appropriating and monopolizing public domain work." See, e.g., Library Groups Br. at 13. In Batlin and its progeny, the derivative work's variation is virtually imperceptible even when it is compared to the public domain work. In this case, the variations are not "minuscule" and can be immediately discerned by anyone upon a side-by-side comparison. Moreover, there is nothing whatsoever in the record to support the frivolous innuendo that West's dedication, over the past century, to the preparation of annotated, revised case reports represents a "mischievous" scheme to monopolize public domain work. See Point VII, below.

¹⁰ See commentary by Nimmer and others, quoted in West Br. at fns. 39 and 40.

Catalda test -- which requires only that the new material be more than "merely trivial" -- to a textual derivative work.¹¹

In fact, of course, there is no authority for the notion that a textual work must be "substantially" altered -- in the sense of changing the work in some fundamental way -- for the owner of a derivative work to claim protection for new material. One need not rewrite a single line of Shakespeare in order to claim copyright protection for original annotations and cross-references in a newly published edition. Similarly, one who updates a work may leave its original content intact but will still be entitled to protection for any revisions and additions which are not "merely trivial."

In short, this Court's occasional use of the word "substantial" in derivative work cases does not impose a burden beyond that imposed by Catalda, Weissmann, and Feist.¹² Moreover, this standard is fully applicable to works based on government publications. As held in Callaghan v. Myers, 128 U.S. 617, 647, 9 S. Ct. 177, 184 (1888), and consistently reaffirmed in the decades

¹¹ Moreover, to the extent that the Woods Court relied on Gracen v. Bradford Exchange, 698 F.2d 300 (7th Cir. 1983), a visual artwork case, it is respectfully submitted that Gracen cannot be reconciled with Feist and is, in any case, inapplicable to cases involving textual derivative works. See, e.g., 1 W. Patry, Copyright Law and Practice 162 (1994), stating that the court in Gracen "misunderstood the [originality] standard altogether."

¹² See Mallack Productions, Inc. v. UAV Corporation, 964 F. Supp. 1416 (C.D. Cal. 1997), in which the court confirmed that, in light of the applicability of the minimalist Feist standard to derivative works, "the degree of originality required to create a copyrightable derivative work is low. [The] contention that a derivative work must contain 'substantial originality' in order to receive statutory copyright is simply wrong." Id. at 1426 (emphasis added).

since, the original contributions of case-report publishers are no less protectible than those of other authors.¹³

The government-work cases cited in the opposition briefs do not hold otherwise. Indeed, Howell v. Miller, 91 F. 129 (6th Cir. 1898), relying on Callaghan, holds that when a publisher compiles official statutes, all of his original work -- including "marginal references" -- is embraced by the publisher's copyright. 91 F. at 138. The Howell court found no infringement because a new edition of annotated statutes took nothing from the earlier edition but public domain statutes and official sidenotes, making "no use whatever of [Howell's] annotations and digests." 91 F. at 140-41.¹⁴ In complete contrast, Hyperlaw seeks to copy, verbatim, all of West's editorial work.¹⁵

¹³ Unsurprisingly, the AALP brief offers no authority for its outlandish assertion that Callaghan and its progeny are "no longer valid precedent" because the 1976 Act "clarified" the issue of copyright protection for government works. Callaghan presumes precisely what the 1976 Act states: that there is no copyright protection for any work of the U.S. Government. That premise is completely consistent with the longstanding principle -- apparently denied by AALP -- that authors of derivative works based on U.S. government works are entitled to protection of their original work only (not a copyright in the U.S. Government work itself).

¹⁴ Furthermore, because the plaintiff was seeking injunctive relief, and because the defendant's work had been commissioned by the state, the Howell court imposed a standard of proof on the plaintiff far higher than that usually required. 91 F. at 142.

¹⁵ In Howell, the defendant denied copying the plaintiff's notes; the plaintiff contended that the similarity of the notes proved otherwise. The court, in the language quoted out of context in the Library Groups' brief (p. 16), supported its finding of no verbatim copying by observing that the notes in question would, by their nature, inevitably be substantially similar even in the absence of copying. The court clearly indicated, however, that it would find the kind of verbatim copying proposed by Hyperlaw to be an infringement.

DuPuy v. Post Telegram Co., 210 F. 883 (3rd Cir. 1914), and State of Georgia v. Harrison Co., 548 F. Supp. 110 (N. D. Ga. 1982), are entirely inapposite. The plaintiff in DuPuy did not seek protection for original elements of a derivative work; on the contrary, he wanted to enforce a private copyright in a complete work copied almost entirely from a government bulletin. The court therefore rejected plaintiff's claim out of hand, with no detailed analysis of the differences between the plaintiff's work and the government work.¹⁶ In State of Georgia, the court held only that generic title headings for statutes are "mere labels" and "may not be copyrighted." None of the editorial additions and revisions at issue in this case can conceivably be described as "mere labels."¹⁷

Thus, notwithstanding the attempt, in the opposition briefs, to impose a new or higher standard, the issue on this appeal remains a straightforward one: Did the district court err in holding that none of the hundreds of thousands case reports in question contain non-trivial, distinguishable additions and/or revisions sufficient to satisfy Catalda and Feist? As previously demonstrated, and not refuted by Hyperlaw or the amici, the

¹⁶ In fact, the court's description of the changes made by the plaintiff in DuPuy indicates that, unlike West, he did not, for example, update the government bulletin; add any new factual material; or reorganize the material in the bulletin.

¹⁷ Moreover, State of Georgia involved the efforts of the state itself to freely distribute an official version of state statutes, not, as in this case, the efforts of a private publisher to appropriate the original work of another private publisher.

district court plainly erred.¹⁸

POINT III

**LIKE THE DISTRICT COURT,
HYPERLAW AND THE AMICI IGNORE
THE UNCONTESTED EVIDENCE THAT WEST'S WORK INVOLVES
A MODICUM OF ORIGINALITY AND NON-TRIVIAL REVISIONS**

A. **THE OPPOSITION BRIEFS FAIL TO CONSIDER THE CUMULATIVE
AND COLLECTIVE ORIGINALITY IN WEST'S CASE REPORTS**

Weissmann clearly analyzes a textual derivative work in terms of the cumulative originality -- all the evaluative judgments and substantive changes -- reflected in the new author's various revisions and additions. See also M. Kramer Mfg. Co., Inc. v. Andrews, 783 F.2d 421, 439 (4th Cir. 1986) (derivative work originality "must be reviewed as a whole, not just reviewed or analyzed part by part").

As demonstrated below, the uncontested evidence demonstrates that each kind of editorial work done by West, in itself, often meets the Feist and Catalda standards. What is even

¹⁸ Reversal is compelled here under both the "clearly erroneous" and de novo standards of review. (As one commentator has noted, the issue as to whether "originality" is a question of law or fact remains unsettled, the issue having not been "authoritatively decided" in Woods. W. Patry, Copyright Law & Practice, 1996 Supplement, at 18.) The district court's review of the evidence, replete with material errors and omissions, was no less erroneous than its interpretation of the law, and is not entitled to deference. Indeed, the appellate posture in this case is strikingly similar to that in Weissmann, where this Court held the trial court's findings to be "clearly erroneous because they have left us, after a thorough review of the all the evidence, with a firm conviction that the district court was mistaken." 868 F.2d at 1323. The Court found that, absent findings based on witness credibility, which might be entitled to deference, "the trial judge cannot insulate his findings on originality from appellate review..." Id. at 1322. Here, as in Weissmann, the credibility of witnesses played no role in the findings below.

more compelling, however, is that the district court's all-encompassing decision denies protection even to those case reports in which West contributes a variety of substantive revisions and additions in each and every section of the case report.

B. THE ORIGINALITY OF WEST'S CITATION
EXPANSION AND REVISION STANDS UNREFUTED

Only by ignoring the record can Hyperlaw and the amici maintain that West's revision and expansion of citations in slip opinions are uniformly "mechanical," "trivial," and "commonplace."

1. West's Work Derives from No "Commonplace" Practice
And Involves More Than the Required Modicum of Originality

As issued by judges, and made freely available to all interested parties, slip opinions contain references to the decisions and orders of the entire range of federal, state, and other courts, as well as statutes. The courts' references may include citations to official reporters, slip opinions, official and unofficial statute sources, unpublished memoranda opinions and orders, unofficial bound-volume or looseleaf reporters, and numerous electronic sources. The choice of which citations to include -- or whether to include a citation at all -- varies from court to court, judge to judge, and opinion to opinion.

If, as Hyperlaw and the amici claim, this case were analagous to Feist, there would exist a commonplace practice (akin to the alphabetized white-pages format) that makes it "practically inevitable" that any private publisher of judicial opinions will always revise and expand the citations in slip opinions in the same "institutionalized" way. If this were so, then there would be

merit to the argument that West's contributions constitute no more than "sweat of the brow" labor and "skill" in filling in the spaces of a universally accepted, "garden-variety" format.¹⁹

Indisputably, there is no such "commonplace" practice. Many publishers make no changes at all in slip opinions, and West submitted overwhelming evidence that publishers who do make changes make different ones from West. Like the district court, Hyperlaw and the amici refer vaguely to "standard" practices and the Bluebook, willfully disregarding the undisputed evidence that West does not follow the Bluebook and is, in fact, directly at odds with the Bluebook on the use of parallel citations for U.S. Supreme Court and state court opinions.

Indeed, there is no evidence that any (let alone all) of West's revisions and additions are made pursuant to a "commonplace" practice or are "practically inevitable." To note just a few examples (others are detailed at West Br., pp. 7-12), there is plainly no "standard practice" for case-report publishers as to:

- Whether an electronic citation should be added to existing citations in the slip opinions -- and whether a court's electronic citation should be replaced or expanded. It is undisputed that West makes these determinations on an ongoing, source-by-source basis, based on West's subjective assessment of each print source's availability, relative

¹⁹ As it is, the references to "skill" and "training" in the opposition briefs are a distortion of Batlin, where the originality requirement was not met by the "skill" and "special training" needed to produce plastic molds converting a toy bank from one medium to another. 536 F.2d at 491. Here, West obviously does not rely on any comparable skill (e.g., the computer skills of its opinion verifiers) as the basis for originality but, rather, on the judgments and expressive contributions of its attorney-editors.

permanence, and usefulness to West's readers.

- If, and how, to update citations in slip opinions. Every publisher has at least three options -- to leave citations as they appear in the opinion, to update them as of the date of case-report publication, or to update them only as of the date of the original order.
- Whether to add one or more citations when the court refers to a case only by name. Not only is there no industry-wide "common practice" for this editorial decision; there is no generalized practice at West. Rather, West makes this decision on a case-by-case basis, based on its editors' assessment -- revised on a continuing basis -- of the relative "popularity" of often-cited cases.
- Which opinions will be so hard to find in print that two electronic citations, rather than one, should be provided.

Nor, despite its familiarity, does West's original selection of parallel citations for Supreme Court decisions conform to any pattern but West's own.²⁰ There is nothing "inevitable" about West's unusual triple-citation, which expands the official cite with two citations chosen from over 20 possible references. Hyperlaw disingenuously refers to this as "the same citation form used by everyone" (Hyp. Br. at 13) despite the undisputed evidence that (i) other publishers consistently choose an entirely different selection of citations (E. 3624-3690), and (ii) the Bluebook prohibits the use of either of West's chosen parallel citations.

²⁰ Ironically, in maintaining the fiction that West's editorial work involves "commonplace" revisions, Hyperlaw and the amici rely on the fact that many features of West's case reports are well-known to the legal profession. That some of West's original editorial choices are so familiar as to be taken for granted, and often echoed in opinions and briefs, does not, of course, make them any less deserving of copyright protection.

In fact, although West does not bear the burden of proof, the record (see West Br. at 7-12) demonstrates that West's citation changes, rather than conforming to some "garden-variety" practice, reflect a broad array of independent, evaluative, individualized judgments. Moreover, these judgments, as evidenced by revised and superseded internal memoranda, are continually reassessed.²¹

The opposition briefs, avoiding any description of West's specific judgments, dismiss them all as too "mechanical" to meet the Feist standard. Yet this position cannot possibly be reconciled with the holding of this Court in Key Publications, Inc. v. Chinatown Today Publishing Enterprises, Inc., 945 F.2d 509 (2d Cir. 1991). If there is a modicum of originality in deciding which restaurants on a list are of interest to Chinese-Americans, or which are likely to stay open for a while, the test is surely also met by deciding, e.g., which sources are sufficiently useful, available, or permanent to stand alone, and which require the addition of an electronic parallel citation.

Similarly, West's work is unmistakably "evaluative" when it decides whether a citation to Northern Mariana Islands Reporter

²¹ Hyperlaw, baldly misrepresenting the record, asserts that Bergsgaard testified that West's revisions and additions are made pursuant to a "style" that has been in existence for more than "20 years." Hyp. Br. at 16. In fact, the testimony in question (E. 65-66), wrenched out of context by Hyperlaw, does not relate to any of West's editorial revisions or additions but only to the location of the attorney summaries within the case reports. Similarly, Hyperlaw asserts that internal memoranda reflecting some of West's editorial guidelines "have been around for many years" (Hyp. Br. at 24), when, in fact, the record -- replete with recent, revised, and re-revised memoranda -- confirms the uncontested testimony that West continually revises its editorial decisions.

is so valuable to West's readers that it shouldn't simply be replaced by a citation to one of West's regional reporters. In that case, West's editors have decided that the local citation is not sufficiently valuable. On the other hand, West has decided that a citation to Virgin Islands Reports is valuable enough to be retained even if it could be replaced by a regional citation. (E. 3498-3500.) How can these, and other, opinion-saturated decisions conceivably be labeled as "mechanical"? How can deciding whether a case is so "popular" that it requires no citation be deemed less "evaluative" than the judgments in Key Publications? And what is in any way "automatic" about West's decision, continually revisited and subject to change, that *Lawyers' Edition* is so useful to West's readers (and so complementary to *Supreme Court Reporter*) that every Supreme Court citation should be expanded to include three citations rather than the usual one or two?²²

The opposition briefs, too intent on denigrating West's work to be distracted by what West actually does, offer only conclusory generalizations and circular arguments. The record establishes, beyond question, that West's revamping of citations --

²² Indeed, it is ludicrous for the Library Groups to suggest that West's choice of what citations to add or substitute "merely involve[s] a mechanical process equivalent to converting Fahrenheit temperatures to Celsius temperatures." Library Groups Br. at 16, citing Signo Trading Int'l v. Gordon, 535 F. Supp. 362 (N.D. Cal. 1981). Whereas Fahrenheit is the automatic equivalent for Celsius, there are several possible citations for most decisions (regional reporters, specialized reporters, electronic citators), over 20 possible U.S. Supreme Court citations -- and undisputed evidence that courts and publishers differ in their preferences and choices.

in many, if not all, case reports -- involves far more than the requisite modicum, or "dash," of originality.

2. West's Work Is Not Trivial

In complete contradiction of the evidence, the court below found that West's citation revisions are uncopyrightable because they purportedly conform with the Bluebook and some other, unspecified "standard of the legal profession." (A. 504). Unlike Hyperlaw and the amici, however, even the district court did not find West's revision and expansion of citations to be "trivial." Indeed, the court recognized parallel and alternative citations as "the most significant additions West makes to the opinions..." Id.

West's versions of the opinions provide a reader with more, and different, information about where to find cited cases and statutes. West selectively replaces outdated citations with more current citations that reflect subsequent developments in the cited cases. And West expands and clarifies citations so that readers can find, within the cited cases, the location of specific holdings or facts. In all these ways, West's versions of the opinions are different from the slip opinions in ways that are more than "merely trivial."

Hyperlaw and the amici offer no authority for their contention that such substantive textual changes should be deemed "merely trivial." Indeed, they avoid textual derivative work cases, preferring to rely on the wholly inapposite findings in mere-change-of-medium cases like Batlin, and Woods, a music case. Moreover, the one textual derivative work case that is cited, Grove

Press v. Collectors Publication, Inc., 264 F. Supp. 603 (C.D. Cal. 1967), simply highlights the evidence of West's originality.

In Grove Press, the court found, in the non-binding context of a motion for injunctive relief, that plaintiff's edition of a public domain work was not copyrightable, because the only changes made by the publisher "consisted almost entirely of elimination and addition of punctuation, changes of spelling of certain words, elimination and addition of quotation marks, and correction of typographical errors." 264 F. Supp. at 605 (emphasis added). Noting, moreover, that these changes "required no skill beyond that of a high school English student," the court found the revisions to be "trivial" and devoid of originality.

In Grove Press, there was no evidence that any subjective judgments were involved in the revision, and no evidence that any content was added, deleted, altered, updated, or rearranged. West, in complete contrast, makes innumerable editorial judgments and significantly alters the content of the pre-existing work.

C. THE ORIGINALITY OF WEST'S "FILE LINES"
AND "COMBINES" STANDS UNREFUTED

The opposition briefs ignore the uncontested evidence that West's treatment of subsequent case history involves non-trivial additions; evaluative judgments (again, at least as opinion-based as those in Key Publications); and editorial decisions as to what expression will best summarize often-complex case developments. See West Br. at 12-15.

For example, Hyperlaw asserts that there is no evidence of file lines except those which are "straightforward," capable of

being expressed only in one or two ways, and "subject to widely accepted rules of citation." Hyp. Br. at 45. In fact, there is nothing in the record that suggests that there are any rules, let alone "widely accepted" ones, dictating how subsequent orders should be reported.²³ Moreover, the opposition briefs simply ignore the evidence that West's choices of expression are often anything but obvious or inevitable.²⁴

Above all, Hyperlaw and the amici ignore the district court's recognition of West's originality in this area. Commenting at the close of trial, the court stated: "There may be a small percentage of cases where you have that complex subsequent history that requires detailed study and the exercise of great judgment as to how you articulate that." (E. 312) The court did not alter this assessment.²⁵ Instead, the court decided, despite its own finding that each case report must be analyzed as a separate derivative

²³ Nor is there any evidence to support Hyperlaw's contention that West's choices -- in this or any other matter of editorial discretion -- follow some court directive. Indeed, Bergsgaard's uncontested testimony is that West will ignore requests from the courts when inconsistent with West's editorial choices (see, e.g., E. 76). Hyperlaw refers to a letter to West from a Fourth Circuit clerk requesting a change in West's editorial policy regarding file lines. (Hyp. Br. at 25; E. 1158.) There is not an iota of evidence that West acceded to this request.

²⁴ In AT&T v. NLRB, 67 F.3d 446 (2d Cir. 1995), for example, there was documented editorial discussion as to whether to publish an amending order as part of case report, or separately, and an editor then created -- as evidenced by handwritten notes -- the file line, "Order Clarifying Decision on Rehearing." (E. 1723-35, 1813) This summary chooses to report, and leave out, certain aspects of, and information, in the amending order; the file line could certainly be worded in a dozen other ways.

²⁵ Nor did the court provide any basis for its assertion that this originality appears only in a "small percentage of cases."

work, that West's work in this "small percentage of cases," no matter how original and non-trivial, should be stripped of copyright protection merely because the same level of originality isn't achieved "in most instances." (A. 501)

The undisputed originality of West's work in some cases presented a clear evidentiary barrier to the sweeping declaration, applicable to all cases, sought by Hyperlaw. There is no basis in copyright law for the district court's decision to "sidestep" that barrier, and the opposition briefs do not even attempt to justify the lower court's plain error in this regard.

D. THE ORIGINALITY OF WEST'S SELECTION AND ARRANGEMENT OF ATTORNEY INFORMATION STANDS UNREFUTED

Hyperlaw and the amici, contending that West's selection and arrangement of attorney information is "mechanical" and devoid of evaluative judgment, again simply ignore the overwhelming evidence to the contrary.²⁶ For example, how can West's editorial decisions as to selection and arrangement of attorney information for *Supreme Court Reporter* be "mechanical" or "commonplace" when the record demonstrates that West's attorney summaries are entirely different in content and form (different lawyers, differently identified, with different affiliation and location information) from those in at least two competing publications? See West Br. at 15-17; A. 489 (side-by-side comparison).

It is therefore clear that there are numerous ways to

²⁶ Contrary to the Library Groups' assertion (at p. 11), much of the attorney data selected and arranged by West does not appear either in slip opinions or court docket sheets. West Br. at 15-18.

select and arrange attorney data for case reports.²⁷ In complete contrast, the directory at issue in Skinder-Strauss Assoc. v. Massachusetts Continuing Legal Educ., Inc., 914 F. Supp. 665 (D. Mass. 1995), simply listed, alphabetically, every practicing Massachusetts attorney, along with the most standard information (address, phone and fax numbers, etc.). The court found that the publisher did not make any choices comparable to those made in Key Publications; that the choice of data was "determined by forces external to the compiler"; and that any lawyer directory would "include virtually the same information." Id. at 676-77.

Clearly, West's choices of which attorneys to include in its *Supreme Court Reporter* summaries are independent of "external forces" or any "commonplace" practice.²⁸ West has subjectively

²⁷ Hyperlaw's contention that West copies attorney data from Martindale Hubbell "exactly as Hyperlaw proposes to copy it from West" (Hyp. Br. at 9) is absurd. West uses numerous sources when it compiles, selects, and arranges attorney data; it never copies any of these sources' selection and arrangement -- which is what Hyperlaw wants to copy, verbatim, from West. Equally outrageous is the assertion (Hyp. Br. at 21) that West "has no way of knowing" what attorney data was provided by the court; the compilation of attorney summaries, as Bergsgaard testified in detail (E. 230-237), is documented in exhibit after exhibit, all ignored by Hyperlaw.

²⁸ The Library Groups completely miss the point when they attempt to liken West's selection and arrangement to that in Victor Lalli Enterprises, Inc. v. Big Red Apple, Inc., 936 F.2d 671 (2d Cir. 1991), or Financial Information, Inc. v. Moody's Investors Service, Inc., 808 F.2d 204 (8th Cir. 1986), cert. denied, 484 U.S. 820. In Victor Lalli, it was undisputed that the publisher's selection and arrangement of fact categories was exactly the same as that of all racing-chart publishers. Id. at 672-73. In Financial Information, it was beyond dispute that the five basic facts listed on the Daily Bond Cards were an "inevitable" choice devoid of originality; the issue was, rather, whether subjective judgment was used in filling in the specific information in each category.

In this case, on the other hand, all of West's basic choices

decided which attorneys are of the most importance and interest to West's readers; other publishers make different choices.²⁹ Thus, West's attorney summaries -- which provide substantial additional information and are indisputably non-trivial -- are plainly entitled to protection as original elements of a derivative work.³⁰

E. THE ORIGINALITY OF WEST'S REVISION OF
CAPTION AND PREFATORY MATERIAL STANDS UNREFUTED

The opposition briefs cite nothing in the record to support the claim that West's revisions of the prefatory material in slip opinions conform to "preexisting rules." The uncontested evidence is that West makes all of these revisions independently, in accordance with its own subjective judgments.³¹ Moreover, in

clearly involve subjective judgment -- i.e., what the amicus brief of Reed Elsevier calls "Step One" creativity -- and this originality is not lost simply because the basic choice is reaffirmed in numerous applications. Moreover, West, unlike the publisher in Financial Information, has offered compelling, uncontested information that its choices of expression are the result of individualized, case-by-case judgments as well as the subjective creation of widely applicable editorial guidelines.

²⁹ Similarly subjective are West's decisions as to how to identify each attorney and how much other information to include. Again, other publishers make different decisions in these areas.

³⁰ There is, again, no "commonplace" practice for attorney summaries for Court of Appeals case reports, although a few of the courts that include attorney data in slip opinions have made some choices of selection and arrangement similar to West's. Thus, the level of originality in the *Federal Reporter* summaries varies from court to court as well as case to case. (In complex cases, for example, the attorney data -- whether appearing in the slip opinion or compiled by West -- undergoes extensive selection and rearrangement. See West Br. at 18; E. 2933-34, 3795-96.)

³¹ Hyperlaw asserts, preposterously, that West's choices in selecting and arranging this material are "exactly the same as [those of] the authoring courts" (Hyp. Br. at 19) when the documentary evidence shows how West, in case after case, substitutes its choices for the courts'. West Br. at 19-21.

asserting that West's changes are uniformly "trivial," Hyperlaw and the amici ignore the undisputed evidence that West may, in more complex cases, delete most of the names in a caption or substitute a completely reorganized version of the caption and prefatory material for the court's arrangement. See West Br. at 19-21.

As Weissmann plainly reaffirms, the Copyright Act protects the work of those who revise and rearrange preexisting materials in non-trivial ways. In at least some case reports, West's revision of the caption, court line, date line, and other prefatory material is plainly entitled to protection as an original element of a derivative work.

POINT IV

**WEST'S EDITORIAL WORK CANNOT BE DENIED
COPYRIGHTABILITY UNDER THE "MERGER DOCTRINE"
OR BECAUSE "FACTS ARE NOT COPYRIGHTABLE"**

In essence, Hyperlaw and the amici argue that West should be denied protection from verbatim copying because of the factual nature of what West contributes. This contention is directly antithetical to Feist, Weissmann, and Re-Alco, which confirm that -- in derivative works as well as compilations -- original selections or arrangements of facts are protectible. Hyperlaw does not want to use West as a source of factual data. Rather, it demands the right to copy, verbatim, thousands of case reports, each containing West's original selection and presentation of facts. The Copyright Act and Feist plainly bar Hyperlaw from engaging in this blatant piracy -- just as the infringer in Key Publications was barred from copying a selection of restaurants

(consisting of facts) and the infringer in Weissmann was barred from copying the plaintiff's revisions (consisting of rearranged and added facts).³²

The attempt to invoke the "merger" doctrine in this case is also completely misguided. The innumerable editorial revisions and additions in West's case reports are, indisputably, not the expression of a "hard," utilitarian, discrete idea, such as "the idea for locating a proposed pipeline in the chosen corridor" in Kern River Gas Transmission Co. v. Coastal Corp.³³, or a generally useful "building-block" concept, as discussed in CCC Information Services, Inc. v. Maclean Hunter Market Reports, Inc., 44 F.3d 61 (2d Cir. 1994), cert. denied, 116 S. Ct. 72 (1995) ("CCC").

Indeed, West does not seek protection for the idea of parallel and alternative citations, or the idea of expanding case reports to include attorney summaries or reflect subsequent case

³² According to Hyperlaw's argument, virtually all compilations and factually enhanced derivative works would be stripped of copyright protection, on the theory that they contain uncopyrightable facts. Hyperlaw's reliance on Morrissey v. Procter & Gamble Co., 379 F.2d 675 (1st Cir. 1967), a pre-Feist decision, is entirely inapposite. Morrissey involved neither a compilation nor a derivative work but, rather, an infringement claim for the copying of a brief rule for a "sweepstakes" contest. The court held that the substance of the rule was so "straightforward and simple" that a copyright would prevent anyone else from using the rule, and, therefore, "copyright does not extend to the subject matter at all..." Id. at 678-679. Here, in complete contrast, Hyperlaw is not prevented from using any of the facts in a copyrighted West case report -- only from copying, verbatim, a case report, or portion of a case report, which embodies original, protectible editorial judgments and creative choices.

³³ 899 F.2d 1458, 1464 (5th Cir.), cert. denied, 498 U.S. 952, 111 S. Ct. 374 (1990).

developments.³⁴ On the contrary, the material at issue is the expression of West's particular editorial judgments, "infused with opinion," as to which specific information is most useful for West readers, and how best (often, on a case-by-case basis) to express and arrange that selection of information.³⁵ This Court, rejecting the application of the merger doctrine to original selections or arrangements, has emphasized, in CCC, Key Publications, and Kregos v. Associated Press, 937 F.2d 700 (2d Cir. 1991), that the expression of evaluative criteria -- whether applied to specific items or categories of data -- is protectible.³⁶

³⁴ Contrary to the conclusory assertions in the opposition briefs, the record demonstrates that each of these ideas can be, and has been, expressed in different ways by different publishers. See, e.g., Apple Computer, Inc. v. Franklin Computer Corp., 714 F.2d 1240, 1253 (3rd Cir. 1983), cert. dismissed, 104 S. Ct. 690 (1984) (merger doctrine inapplicable where idea can be expressed in different ways).

³⁵ For this reason, Hyperlaw's claim that West's revisions and additions to thousands of case reports are uncopyrightable as a "system" (Hyp. Br. at 40-41) is nonsensical. West's editorial enhancements cannot possibly be described as an "idea, procedure, process, system, method of operation, concept, principle, or discovery..." 17 U.S.C. § 102(b). See, e.g., American Dental Ass'n v. Delta Dental Plans Ass'n, 126 F.3d 977, 980-81 (7th Cir. 1997) (taxonomy of dental procedures not a "system" or "process"); Apple Computer, Inc., supra, 714 F.2d at 1250 (§ 102(b) applicable only to "method," not to "instructions themselves"); Toro Co. v. R & R Products Co., 787 F.2d 1208 (8th Cir. 1986) (parts list is protectible even if "idea" of how to designate parts is uncopyrightable). Indeed, under Hyperlaw's interpretation, any work created pursuant to original organizing principles would be -- contrary to well-settled law -- uncopyrightable as a "system."

³⁶ Like the copyright owner in Key Publications, West applies its criteria, on an item-by-item, case-by-case basis, when it evaluates (or re-assesses) the usefulness of each citation source, or when it decides how to treat a subsequent case development. Like the plaintiff in Kregos, West makes some editorial decisions (e.g., its decision to include only certain attorneys, and certain data, in Supreme Court Reporter) which are applied in numerous

POINT V

**NO AUTHOR OF A DERIVATIVE WORK --
INCLUDING WEST -- MUST IDENTIFY WHAT HAS BEEN
ADDED TO, OR CHANGED FROM, THE PRE-EXISTING WORK**

Desperately searching for reasons why West's copyrights, even if valid, should nonetheless be eviscerated, Hyperlaw and the amici argue that West has an obligation to highlight, for the would-be copier, all of West's original revisions and additions.

This argument is not only devoid of merit. It also lays bare the underlying premise of the opposition briefs: West should be subjected to standards and obligations not imposed upon any other copyright owner (or authorized by the Act) so that West's competitors can be given a "free pass" to wholesale infringement.

In fact, of course, there is no provision in the copyright law -- and never has been -- that requires authors of adapted fairy tales, updated reference books, or any other derivative works to "red flag" what portions of their works are in the public domain (or will enter the public domain when some prior copyright expires). Cf. International Harvester Co. v. Deere & Co., 623 F.2d 1207, 1213 (7th Cir. 1980) (no obligation to explain scope of patent to potential infringer).³⁷ Nor is there any

instances. The opposition briefs do not dispute that, under the law of this Circuit, an original selection of facts or categories does not become less protectible simply because it is frequently repeated. See Brief of Amicus Curiae Reed Elsevier at 11-16.

³⁷ Moreover, the suggestion that the author of a compilation or derivative work must identify within the body of his work each copyright-protected element would create staggering practical problems. Works such as directories and databases would be burdened with tedious and pointless copyright explanations -- solely for the benefit of would-be copiers.

authority for the argument that a derivative work author has no copyright protection unless the modifications to the pre-existing work are readily apparent from the surface of the text, alone.³⁸

Bentley v. Tibbals, 223 F.247 (2d Cir. 1915), is completely inapposite. Bentley held that copying of an illegally imported foreign work which the defendant knew to be uncopyrighted (either through violation of the manufacturing clause or failure to register the work) was permissible even though the copied work also contained some material which had previously been registered. This is the exact opposite of the situation here, where West has registered its copyrights in all of the works in question, and where Hyperlaw is well aware of West's claims of copyright.

Further, the court in Bentley stated that "we do not decide that [plaintiff] has lost his copyright in the [previously registered work], so that any one is at liberty to reprint that book." Id. at 257. Indeed, Nimmer cites Bentley for the

³⁸ The Court should therefore disregard the implication, throughout the opposition briefs, that West's modifications are somehow less copyrightable if they are not obvious from the face of West's case reports alone. Hyperlaw repeatedly asserts that Bergsgaard was unable to identify specific changes in case reports from the West text alone, and the Library Groups refer darkly to West's "silent" modifications. In fact, of course, there is no reason why Bergsgaard, or anyone at West, should recall what changes were made, on an individualized, case-by-case basis, to each of thousands of case reports. Nor is there any significance to the fact that West's modifications can be detailed only by a side-by-side comparison between case reports and slip opinions (and any amending orders). This is how courts consistently analyze the nature of the original contribution to derivative works. Indeed, it is only when a side-by-side comparison reveals that the alterations are "imperceptible" that the courts use this as a basis for finding insufficient originality.

proposition that courts "have declined to find a forfeiture of the copyright in the underlying work" when derivative works were published with defective notice under the 1909 Act. M. Nimmer & D. Nimmer, Nimmer on Copyright (1990), § 7.12[C][2] at 7-99 & n.58.

Similarly, Sanga Music, Inc. v. EMI Blackwood Music, Inc., 55 F.3d 756 (2d Cir. 1995), has no relevance here. In Sanga, the plaintiff allowed a public-domain folksong to be published without any indication that she herself had written one of the verses. In that situation, where the public has "been misled into a reasonable belief that the work had been placed in the public domain," this Court found that the song's publication nullified the plaintiff's common-law copyright. No one pretends, of course, that West has ever published a case reporter without a copyright notice, or that would-be infringers like Hyperlaw have been "misled" to believe that the entire case-report is in the public domain.³⁹

POINT VI

SECTION 403 HAS NO BEARING ON WEST'S ABILITY TO ENFORCE ITS COPYRIGHTS

Equally absurd is the contention that Section 403 of the Copyright Act bars West's enforcement of its copyrights for case reports published in *Federal Reporter* and *Supreme Court Reporter*

³⁹ Like Bentley and Sanga, Grove Press, Inc. v. Greenleaf Publishing Co., 247 F. Supp. 518 (E.D.N.Y. 1965), did not involve a derivative work but, rather, a separate work that lost its copyright protection when published, as part of a larger, uncopyrighted work, without the required pre-Berne notice.

between January 1, 1978, and February 28, 1989.⁴⁰ Nothing in the record is cited to support the vague assertions that West failed to comply with § 403. In fact, shortly after the enactment of the 1976 Act, West changed its copyright notices to read, for example:

Copyright © 1980
by
West Publishing Co.

Copyright is not claimed as to any part of the original work prepared by a United States Government officer or employee as part of that person's official duties.

West has used this form on virtually all federal case reporters published after the 1976 Copyright Act took effect.

West's expanded notice fully comports with the public policy underlying § 403. The notice alerts the reader that the West volumes contain works authored by U. S. government officials or employees, and that "no copyright is claimed in [their] original work." Persons wishing to copy the original works can use the information provided by West to obtain copies from the courts.

Hyperlaw and the amici offer no support -- because there is none -- for their suggestion that West was, or is, obliged to go further and to specify item-by-item, case-by-case, every element that is protected by copyright. Cf. Neal v. Glickman, 391 F. Supp. 1088 (N.D. Tex. 1975) (failure to disclose, in copyright application, significant public domain content in work did not

⁴⁰ Hyperlaw and the amici do not dispute that West's pre-1978 notices were entirely adequate under the statute. They also concede that, since March 1, 1989, West has had no duty to place any copyright notice at all -- including a notice pursuant to § 403 -- on its books in order to enjoy complete copyright protection.

constitute "unclean hands"). Nor is there any evidence that any commercial publisher has ever used such a notice.⁴¹ Indeed, any finding that copyrights are unenforceable because of § 403 notices without "item by item claims of originality" would put the copyrights of innumerable publishers in jeopardy.⁴²

Moreover, in the 20 years since § 403 was enacted, the Copyright Office has routinely registered West's copyrights without questioning the adequacy of its notice, and there is not one iota of evidence, in or out of the record, that anyone has ever been misled by West's copyright notice. Anyone using a West reporter

⁴¹ Section 403 requires only that the copyright notice contain a "statement" identifying those "portions" of the work in which copyright is claimed or disclaimed. Nothing in the law even suggests that one must identify, in the body of the work, what is copyright-protected. Yet that, according to the opposition briefs, is what West must provide -- since even a category-by-category listing (itself wildly impracticable) would not give a would-be copier case-by-case details on which material is original to West.

⁴² Also, in the unlikely event that a court were to rule that West's § 403 notice is inadequate, West may still correct any affected notices. See 17 U.S.C. § 405(a). West registered its copyrights within five years of publication, as required by § 405(a)(2). This section also requires reasonable efforts to add notice to all publicly distributed copies "after the omission has been discovered." H. Rep. No. 94-1476, 94th Cong., 2d Sess. 147. (Hyperlaw misreads the statute to require that correction efforts occur within five years of publication.) As this Court has made clear, "discovery of the omission of proper notice takes place when the claimant is apprised that the notice is for some reason insufficient for its intended purpose." Hasbro Bradley, Inc. v. Sparkle Toys, Inc., 780 F. 2d 189, 195 (2d Cir. 1985). See also Innovative Concepts in Entertainment, Inc. v. Entertainment Enterprises Ltd., 576 F. Supp. 457 (E.D.N.Y. 1983) (excusing failure of notice due to "mistake of law" as to availability of copyright protection). There is no evidence that West has ever believed to this day that its copyright notice was inadequate.

plainly knows that the judicial opinions originated with a court.⁴³

Thus, it cannot be argued in good faith that West has violated either the letter or the spirit of § 403. There are no Copyright Office regulations prescribing the contents of an adequate § 403 notice. No reported judicial decision has interpreted § 403, much less found a forfeiture of copyrights based upon non-compliance. Above all, the policy underlying the Berne amendments strongly suggests that courts should rarely interpret pre-Berne notice requirements in such a way as to work a forfeiture of valuable copyrights. See Princess Fabrics, Inc. v. CHF, Inc., 922 F.2d 99, 105 (2d Cir. 1990) (Oakes, J., concurring); accord P. Goldstein, Copyright § 3.4, at 3:40 (1996).⁴⁴

POINT VII

NO PUBLIC POLICY JUSTIFIES THE EVISCERATION OF WEST'S COPYRIGHTS

Finally, Hyperlaw and the amici contend that West should be stripped of its copyrights because the public will benefit if it

⁴³ There is, moreover, nothing to suggest that § 403 was enacted in response to concerns about case reports -- the governmental nature of which is self-evident (particularly given the sophistication of the case-report readership). To the contrary, Congress seems to have been responding to scams such as the commercial publication of a book entitled, "How to Win Success in the Mail-Order Business," without any disclosure that the work had previously been published for free or at a nominal price by the U.S. Commerce Department. See "Copyright in Government Publications," Copyright Law Rev. Studies, 86 Cong. 2d Sess., Study 33, p. 36 n.42 (1959) (criticizing the conduct of the publisher in Matter of Arco Publishing Co., 47 F.T.C. 1729 (1951)).

⁴⁴ The district court did not find that § 403 was relevant to the issues of copyrightability and copyright validity. Instead, the court noted, in dicta, that compliance with § 403 might be a factor to be considered in a fair use analysis. A. 505-06.

can freely copy West's enhanced case reports.⁴⁵ There is nothing whatsoever in the record to suggest that copyright protection for West's enhancements prevents the free dissemination of judicial opinions, and the court below made no such findings of fact. There is no evidence that even a single opinion (or a single judicial correction to an opinion) is available only by copying West's case report.⁴⁶ Indeed, Hyperlaw's principal, Mr. Sugarman, admitted that the court's corrections, as well as the slip opinions, can be obtained from the U.S. Supreme Court and the Second Circuit, and offered no evidence to the contrary as to any other court. E. 140-141, 150.⁴⁷ The proliferation of reporting services confirms that judicial opinions can be obtained from numerous sources without

⁴⁵ In CCC, supra, 44 F.3d at 74, this Court rejected a similar argument, noting that the dedication of private intellectual property to the public could amount to an unconstitutional taking. Building Officials & Code Adm. v. Code Technology, Inc., 628 F.2d 730 (1st Cir. 1980), cited by the amici, did not hold that public adoption of a privately developed building code threw that work into the public domain, but merely said that a more fully developed record would help to clarify the policy issues. Here, Hyperlaw did not introduce one jot of evidence that would allow a court to "nationalize" West's case reports. See also Practice Management Information Corp. v. American Medical Ass'n, 121 F.3d 516, 518-20 (9th Cir.), citing CCC (refusing to invalidate copyright of publicly adopted codes), cert. denied, 118 S. Ct. 339 (1997).

⁴⁶ Furthermore, even if, arguendo, there were evidence that some opinions could be obtained only by copying West's case reports, such evidence might arguably be relevant to an infringer's fair use defense, but not to the issue of copyrightability. It clearly would offer no support for the district court's blanket denial of copyright protection -- which permits a free-riding competitor to copy the original work in all of West's reports, even when the public domain opinions are indisputably available to all.

⁴⁷ Contrary to Hyperlaw's reckless insinuations, and Mr. Sugarman's non-probative speculation (Hyp. Br. at 27), there is no evidence that any judicial correction has ever been provided "only" to West, and no other publisher. Nor is there evidence that any judicial corrections are "not reflected in the courts' files..."

illegal copying of West's case reports.⁴⁸

Moreover, lost in all the rhetoric of the opposition briefs is that the Constitutional purpose of copyright is to promote the useful arts by providing the incentives to create works of value to the public. As the Supreme Court has explained:

[I]t should not be forgotten that the Framers intended copyright itself to be the engine of free expression.

* * * *

[A]s one commentator has noted: "If every volume that was in the public interest could be pirated away by a competing publisher, . . . the public [soon] would have nothing worth reading.

Harper & Row Publishers, Inc. v. Nation Enterprises, 471 U.S. 539, 558-559, 105 S. Ct. 2218, 2229-30 (1985) (citation omitted).⁴⁹

West respectfully submits that the United States would not have the world's best legal reference system but for the copyright protection given to legal publishers.⁵⁰ For over a

⁴⁸ For example, the case chosen by Hyperlaw to exemplify its claim, Mendell v. Gollust, has been published not only by West but by U.S. Law Week (59 USLW 2116), Federal Securities Law Reporter (Fed. Sec. L. Rep., p. 95378), Federal Rules Service (17 Fed. R. Serv.3d 129), and LEXIS (1990 U.S. App. LEXIS 12833). These other publishers obviously had no difficulty obtaining the opinion. Clearly, what Hyperlaw seeks to copy is not the judges' opinion but West's original editorial work in the case report.

⁴⁹ This view is entirely consistent with that expressed by this Court in Computer Associates Int'l, Inc., v. Altai, Inc., 982 F.2d 693, 711-12 (2d Cir. 1992). In that case, the Court declined to broaden the scope of statutory copyright protection in order to provide incentives for "sweat of the brow" computer research and development. Here, the Court is asked to eviscerate the protection to which West's original work is entitled under the statute.

⁵⁰ See R. Berring, On Not Throwing Out the Baby: Planning the Future of Legal Information, 83 Calif. L. Rev. 615 (1995).

century, West's editorial judgment and creativity have been focused on publishing case reports that are often more informative, up-to-date, and useful than the court-issued slip opinions. If West's competitors were authorized to systematically scan West's editorial enhancements, the economic incentive to engage in this kind of original and productive enterprise would largely evaporate.

POINT VIII

**THIS ACTION SHOULD HAVE BEEN DISMISSED
FOR LACK OF JUSTICIABILITY**

As previously demonstrated (West Br. at 46-50), West's motions to dismiss, made before and during trial, should have been granted on the following grounds:

(1) At the justiciability hearing, Hyperlaw testified that it intended to copy from West in only certain, very limited circumstances. West subsequently deemed Hyperlaw's intended uses to be "fair use," mooting the action. Accordingly, the action should have been dismissed before trial.

(2) After both sides had rested, with Hyperlaw having presented no evidence of its intended copying, the court re-opened the trial and accepted new evidence -- inconsistent with Hyperlaw's pre-trial testimony and stipulations, and prejudicial to West -- that Hyperlaw intended to engage in wholesale copying from West.

(3) Even this improperly admitted evidence failed to describe what, and how much, the hypothetical Hyperlaw product would copy from West. The district court had an inadequate basis for a declaratory judgment and could only render an impermissible advisory opinion.

Hyperlaw refutes neither the facts nor the law cited by West in support of this argument. Emphasizing, irrelevantly, that the mechanics of the hypothetical product were demonstrated to the

court at the justiciability hearing, Hyperlaw does not deny that its hearing testimony limited the intended copying to minimal, current, "fill-in" uses -- or that it stipulated, just prior to trial, that "wholesale copying" was not at issue here. Nor does Hyperlaw deny that the only trial evidence as to intended copying -- evidence inconsistent with Hyperlaw's hearing testimony and pre-trial stipulations -- was introduced after both sides had rested, depriving West of the opportunity to present evidence relevant to wholesale copying and copying of older case reports.

Indeed, Hyperlaw's hypothetical product -- the subject of evasive, misleading, and contradictory representations throughout this litigation -- has never provided the proper basis for adjudication of a declaratory judgment action. The district court erred in denying West's motion to dismiss.


CONCLUSION

For the foregoing reasons, and those set forth in West's opening brief, the order of the district court should be reversed and the intervenor-plaintiff's complaint dismissed.

Respectfully submitted,

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