

"proper" light. More generally, the self-conscious evaluation of the state's symbols commemorating the past and inculcating values in the present — and hopefully for the future — is likely all that one can do. As Levinson says, nothing is really "written in stone." Teaching, writing, and otherwise influencing others about what we hope will make our society better is probably as much as can be done to assuage what troubles us.

IS ORIGINALITY IN COPYRIGHT LAW A "QUESTION OF LAW" OR A "QUESTION OF FACT?": THE FACT SOLUTION

INTRODUCTION

What is original? The question is hard enough to answer in everyday life, but it becomes infinitely more complex in the context of copyright litigation. Frequently, defendants argue that plaintiffs' works are not sufficiently original to be copyrightable, and thus cannot possibly hold valid copyrights.¹ This is a very powerful strategy because "[a] work that is not original does not have a limited scope of protection — it has no protection, regardless of how much labor went into its production."² Thus, before courts move on to the issue of infringement, as a threshold matter, they must first determine if the plaintiff's work is copyrightable, and therefore, capable of being infringed. This task is further complicated by the variety of works potentially covered by copyright law. The Copyright Act of 1976 identifies at least ten varieties of copyrightable works.³

Even before a court determines the existence of originality, it must address the issue of whether originality is a "question of law" or a "question of fact." Inconsistency and lack of clarity are pervasive on this issue. Yet, the decision is very important and is fraught with consequences. It determines whether the issue of originality will be decided by a judge or a jury, the scope of appellate review, and whether a judge can use summary judgment to dismiss a claim.

This Note advocates the "fact" approach because originality is an inherently subjective issue deeply rooted in community values. This approach would ensure that jurors, members of the commu-

¹ See, e.g., *CMM Cable Representative, Inc. v. Ocean Coast Properties, Inc.*, 97 F.3d 1504 (1st Cir. 1996); *Durham Indus. v. Tommy Corp.*, 630 F.2d 905 (2d Cir. 1980); *Lotus Dev. Corp. v. Borland Int'l, Inc.*, 788 F. Supp. 78 (D. Mass. 1992).

² William Patry, *Copyright in Collection of Facts: A Reply*, 6 COMM. & LAW 11, 27 (1984).

³ See 17 U.S.C. §§ 102(a), 103 (1994). Section 102 identifies eight categories of "works of authorship" covered by copyright:

- (1) literary works;
- (2) musical works, including any accompanying words;
- (3) dramatic works, including any accompanying music;
- (4) pantomimes and choreographic works;
- (5) pictorial, graphic, and sculptural works;
- (6) motion pictures and other audiovisual works;
- (7) sound recordings;
- (8) architectural works.

Section 103 adds two more categories: compilations and derivative works. For definitions see *infra* notes 36 and 62 and accompanying text.

nity, rather than judges, would be the primary adjudicators of originality. Part I traces the birth and development of the concept of originality in U.S. copyright law from its beginnings in the Constitution to the most recent United States Supreme Court statement on originality in *Feist Publications, Inc. v. Rural Telephone Service Co.*⁴ Part I also reviews the different methods of determining the presence or absence of originality in "works of authorship,"⁵ derivative works,⁶ and in compilations,⁷ with a particular emphasis on *Feist* and the Second Circuit's originality jurisprudence. Part II compares the lay and legal understandings of the concepts of "fact" and "law," and examines the consequences of treating originality as a "question of fact." Part III surveys some of the notable originality cases decided by courts as a matter of law, analyzes their outcomes, and points out the weaknesses of the "law" approach. Finally, Part IV proposes that originality should be treated as a question of fact in the context of copyright litigation. This conclusion takes into account the results of cases surveyed in Part III, the inherently amorphous and subjective nature of originality, and the impact of the "fact" approach on the distribution of functions between the judge and the jury, and the trial and appellate benches.

I. BACKGROUND ON ORIGINALITY

A. *The History of Originality*

The requirement of originality is rooted in Article I, Section 8, Clause 8, of the Constitution which provides that "Congress shall have Power . . . To promote the Progress of Science and useful Arts, by securing for limited Times to Authors . . . the exclusive Right to their . . . Writings."⁸ However, nowhere in the Constitution, the first copyright legislation,⁹ or the Copyright Act of 1909,¹⁰ the first comprehensive codification of U.S. copyright law, is there any mention made of "originality." In fact, until 1976 Congress was silent on the issue of originality. Instead, the courts developed the originality requirement as a prerequisite for copyright protec-

⁴ 499 U.S. 340 (1991).

⁵ For a definition see *infra* note 84 and accompanying text.

⁶ For a definition see *infra* note 62 and accompanying text.

⁷ For a definition see *infra* note 36 and accompanying text.

⁸ U.S. CONST. art. I, § 8, cl. 8.

⁹ The first federal copyright legislation was passed in 1790 and provided protection for "any map, chart, book or books." Act of May 31, 1790, ch. 15, 1 Stat. 124 (1790); see also CRAIG JOYCE ET AL., COPYRIGHT LAW § 1.04, at 10 (3d ed. 1994); Dale P. Olson, *Copyright Originality*, 48 MO. L. REV. 29, 39 (1983).

¹⁰ Ch. 320, 35 Stat. 1075 (codified at 17 U.S.C. §§ 1-216 (1976)) (repealed 1978).

tion.¹¹ Two nineteenth century Supreme Court opinions, the *Trade-Mark Cases*¹² and *Burrow-Giles Lithographic Co. v. Sarony*,¹³ were particularly influential in that they "discovered" the concept of originality in the Constitution. In the *Trade-Mark Cases*, the Supreme Court held that in order for a work to be a "writing" within the meaning of the Constitution, "originality is required."¹⁴ Then, in *Burrow-Giles*, the Supreme Court interpreted the Constitution's use of the term "author" as "he to whom anything owes its origin; originator; maker."¹⁵ In neither of these cases, however, did the Court venture to define originality, or to quantify the minimum amount necessary for a work to qualify for protection.¹⁶ The task of developing the appropriate guidelines was left to the lower courts, and perhaps to Congress.¹⁷

While the Copyright Act of 1976 finally announced that "[c]opyright protection subsists . . . in original works of authorship,"¹⁸ Congress did not offer a definition of originality anywhere in the Act.¹⁹ The omission was deliberate.²⁰ The legislative history of the 1976 Act reveals that "[t]he phrase 'original works of authorship' . . . is purposely left undefined, [and] is intended to incorporate without change the standard of originality established by the courts under the present copyright statute [the 1909 Act]."²¹

Yet, although the House Report referred to a "standard," such a uniform standard did not exist. Instead, originality jurisprudence was splintered, with "originality" often representing two distinct concepts.²² First, originality came to represent "independent creation," or nothing more than a prohibition on wholesale copying either from another copyrighted source or from the public domain.²³ Under this view of originality, two individuals who create

¹¹ See Olson, *supra* note 9, at 35-38 (discussing several early cases, particularly Justice Story's opinions in *Gray v. Russell*, 10 F. Cas. 1035 (C.C.D. Mass. 1839) (No. 5728) and *Emerson v. Davies*, 8 F. Cas. 615 (C.C.D. Mass. 1845) (No. 4436), in which Justice Story emphasized independent creation as prerequisite for protection).

¹² 100 U.S. 82 (1879).

¹³ 111 U.S. 53 (1884).

¹⁴ *Trade-Mark Cases*, 100 U.S. at 94.

¹⁵ *Burrow-Giles*, 111 U.S. at 58.

¹⁶ See Howard B. Abrams, *Originality and Creativity in Copyright Law*, 55 LAW & CONTEMP. PROBS. 3, 6 (1992).

¹⁷ For court-developed category-specific definitions of originality see *infra* notes 36-94 and accompanying text.

¹⁸ 17 U.S.C. § 102(a) (1994) (emphasis added).

¹⁹ See 17 U.S.C. § 101 ("definitions"). While the 1976 Act defines such seemingly mundane terms as "including" and "such as," there is no definition of originality.

²⁰ See Patry, *supra* note 2, at 18.

²¹ H.R. REP. NO. 94-1476 (1976), reprinted in 1976 U.S.C.C.A.N. 5659, 5664.

²² See Russ VerSteeg, *Rethinking Originality*, 34 WM. & MARY L. REV. 801, 805-11 (1993).

²³ *Id.* at 805-06. See, e.g., *Batin & Son, Inc. v. Snyder*, 536 F.2d 486, 490 (2d Cir. 1976) (en banc) ("Originality is . . . distinguished from novelty; there must be independent crea-

identical works without copying each other or anything in the public domain, could both potentially be considered authors of original works.²⁴

The second view of originality embodied the idea of creativity. This view originated in the *Trade-Mark Cases*, where the Supreme Court expanded its definition of "writings" by adding that "writings" are those works which are "founded in the creative powers of the mind," and are "the fruits of intellectual labor."²⁵ Recently, the Supreme Court reaffirmed this line of reasoning by stating that a copyrightable work must possess a "minimal degree of creativity."²⁶ The key word is "minimal." The courts have made it abundantly clear that creativity is not the same thing as aesthetic merit, and that the amount of creativity expected is, indeed, minimal.²⁷

In its 1991 decision *Feist Publications, Inc. v. Rural Telephone Service Co.*,²⁸ the Supreme Court unified the two strands of originality into a single standard of "creative originality."²⁹ The Court held that "[o]riginal, as the term is used in copyright, means only that the work was independently created by the author (as opposed to copied from other works), and that it possesses at least some mini-

tion, but it need not be invention in the sense of striking uniqueness, ingeniousness, or novelty. . . . Originality means that the work owes its creation to the author and this in turn means that the work must not consist of actual copying."); see also *Feist Publications, Inc. v. Rural Telephone Serv. Co.*, 499 U.S. 340, 345 (1991) ("Original, as the term is used in copyright, means only that the work was independently created by the author[,] as opposed to copied from other works . . .").

²⁴ Copyright law is distinct from patent law which requires novelty. See JOYCE ET AL., *supra* note 9, § 1.06 at 27. For a famous example of identical copyrightable creation see *Sheldon v. Metro-Goldwyn Pictures Corp.*, 81 F.2d 49, 54 (2d Cir. 1936) (Hand, L., J.) ("[I]f by some magic a man who had never known it were to compose anew Keat's Ode on a Grecian Urn, he would be an 'author.'"). Accord *Alfred Bell & Co. v. Catalda Fine Arts*, 191 F.2d 99, 103 (2d Cir. 1951) ("The 'author' is entitled to a copyright if he independently contrived a work completely identical with what went before; similarly, although he obtains a valid copyright, he has no right to prevent another from publishing a work identical with his, if not copied from his.").

²⁵ *Trade-Mark Cases*, 100 U.S. 82, 94 (1879). One hundred years later, the Second Circuit echoed this sentiment when it stated that implicit in the concept of originality is a "minimal element of creativity over and above the requirement of independent effort." *Batlin*, 536 F.2d at 490 (quoting I MELVILLE B. NIMMER, *THE LAW OF COPYRIGHT*, § 10.2, at 36 (1975)). Accord *Baltimore Orioles, Inc. v. Major League Baseball Players Ass'n*, 805 F.2d 663, 668 (7th Cir. 1986) ("The requirement of originality actually subsumes two separate conditions, i.e., the work must possess an independent origin and a minimal amount of creativity."); *Tempo Music, Inc. v. Famous Music Corp.*, 838 F. Supp. 162, 168 (S.D.N.Y. 1993) (originality of a harmony depends on exercise of "creative choice").

²⁶ *Feist*, 499 U.S. at 345.

²⁷ See, e.g., *id.* (noting that a work will satisfy the originality requirement regardless of "how crude, humble or obvious" the creative contribution may be (quoting I MELVILLE B. NIMMER, *COPYRIGHT*, § 1.08[C][1] (1990)); *Alfred Bell*, 191 F.2d at 103 ("No matter how poor artistically the 'author's' addition, it is enough if it be his own.").

²⁸ 499 U.S. 340 (1991).

²⁹ See Jane C. Ginsburg, *No "Sweat?" Copyright and Other Protection of Works of Information After Feist v. Rural Telephone*, 92 COLUM. L. REV. 338, 339-40 (1992).

mal degree of creativity."³⁰ Thus, after *Feist*, authors must not only prove that they created their works independently, but also that they infused their works with a "creative spark," "the fruits of [their] intellectual labor," with the "singularity" of their own "personality."³¹ Finally, *Feist* held that "[o]riginality is a constitutional requirement."³² The Court traced the development of originality jurisprudence from the *Trade-Mark Cases* onward, and concluded that "[o]riginality remains the *sine qua non* of copyright; accordingly, copyright protection may extend only to those components of a work that are original to the author."³³

B. Methods of Discovering and Measuring Creativity

Creativity is an extremely elusive and subjective concept. In litigation, the difficulty lies in measuring creativity, and in drawing the line between sufficient and insufficient creative efforts.³⁴ Courts have wrestled with defining and measuring creativity, usually with little success, for over a hundred years.³⁵ Several special-

³⁰ *Feist*, 499 U.S. at 345. Some commentators have objected to the Court's definition of originality in terms of "creativity." See, e.g., Russ VerSteeg, *Sparks in the Tinderbox: Feist, "Creativity," and the Legislative History of the 1976 Copyright Act*, 56 U. PITT. L. REV. 549 (1995). However, because the Court did define originality in terms of "creativity," this is the standard which the lower courts must follow, and the standard which this Note assumes. Other interpretations of originality are beyond the scope of this Note.

³¹ The quoted phrases are reflective of the various characterizations of creativity. See *Feist*, 499 U.S. at 345 ("creative spark"); *Trade-Mark Cases*, 100 U.S. 82, 94 (1879) ("the fruits of intellectual labor"); *Bleistein v. Donaldson Lithographic Co.*, 188 U.S. 239, 250 (1903) (Holmes, J.) ("Personality always contains something unique. It expresses its singularity even in handwriting, and a very modest grade of art has in it something irreducible, which is one man's alone. That something he may copyright unless there is a restriction in the words of the act.").

³² *Feist*, 499 U.S. at 346. The Court invoked the Constitution several times reflecting the significance of the argument. See *id.* at 351 ("originality is a constitutionally mandated prerequisite for copyright protection"); *id.* at 363 ("As a constitutional matter, copyright protects only those constituent elements of a work that possess more than a *de minimis* quantum of creativity.").

³³ *Id.* at 348. The explicit constitutionalization of originality limited Congress' power to grant protection to unoriginal works, and to meddle with the prevailing statutory definition of copyrightable subject matter. See Ginsburg, *supra* note 29, at 339-40. Unless *Feist* is overruled at some future point, the term "original works of authorship," or its equivalent, will remain intact in copyright legislation and will continue to be of paramount importance. See 17 U.S.C. § 102(a) (1994) (emphasis added).

³⁴ See Mitzi S. Phalen, *How Much Is Enough? The Search for a Standard of Creativity in Works of Authorship Under Section 102(a) of the Copyright Act of 1976*, 68 NEB. L. REV. 835, 837-38 (1989).

³⁵ The concept of independent creation does not seem to cause nearly as much trouble. Most likely this is because independent creation is a relatively objective inquiry in a very subjective field of copyright law: courts must simply determine that the author has not plagiarized. For example, an author of a derivative work must demonstrate to the court's satisfaction that the added material originated with him and was not borrowed from another source. See Phillip E. Page, *The Works: Distinguishing Derivative Creations Under Copyright*, 5 CARDOZO ARTS & ENT. L.J. 415, 419 (1986).

ized approaches have emerged, all of which are extremely subjective.

I. Compilations

Under the Copyright Act of 1976, "[a] compilation is a work formed by the collection and assembling of preexisting materials or of data that are selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes an original work of authorship."³⁶ Copyright protection, however, extends only to "material contributed by the author."³⁷ Therefore, the compiler does not acquire any rights in the preexisting material.³⁸ Likewise, the copyright status of the preexisting material does not change by virtue of its inclusion in a compilation; that which was copyrighted remains so, as does that which was in the public domain.³⁹

Until 1991, the vast majority of courts used one of two methods to evaluate originality in compilations. Some courts rewarded the compiler's "sweat of the brow" by holding that a compilation was original by virtue of the labor, time, money, and skill employed in its production.⁴⁰ Other courts believed that the "sweat of the brow" doctrine violated the basic tenets of copyright law,⁴¹ and found originality in compilations only if the compiler had exhibited creativity (often referred to as "judgment"), in the assembly and/or coordination of data.⁴² In 1991, the Supreme Court finally

³⁶ 17 U.S.C. § 101. Compilations also include collective works. "A collective work is a work, such as a periodical issue, anthology, or encyclopedia, in which a number of contributions, constituting separate and independent works in themselves, are assembled into a collective whole." *Id.*

³⁷ 17 U.S.C. § 103(b). *See also Feist*, 499 U.S. at 348 ("[C]opyright protection may extend only to those components of a work that are original to the author.").

³⁸ *Feist*, 499 U.S. at 348.

³⁹ *Id.*

⁴⁰ *See, e.g., West Publ'g Co. v. Mead Data Central, Inc.*, 799 F.2d 1219 (8th Cir. 1986) (holding that case reporters are original because of the labor involved in their production). A detailed analysis of the merits or faults of the "sweat of the brow" doctrine is beyond the scope of this Note. However, for one author's approving viewpoint see Robert Denicola, *Copyright in Collection of Facts: A Theory for the Protection of Nonfiction Literary Works*, 81 COLUM. L. REV. 516 (1981).

⁴¹ *See Financial Info., Inc. v. Moody's Investors Serv., Inc.*, 808 F.2d 204, 207 (2d Cir. 1986) ("The [1976] statute . . . requires that copyrightability not be determined by the amount of effort the author expends, but rather by nature of the final result. To grant copyright protection based merely on the 'sweat of the author's brow' would risk putting large areas of factual research material off limits and threaten the public's unrestrained access to information.").

⁴² This approach was well-developed in the Second Circuit. *See, e.g., Kregos v. Associated Press*, 937 F.2d 700, 704 (2d Cir. 1991) (holding that, by choosing for his pitching form nine categories of data out of a "universe of available data," plaintiff exercised sufficient selectivity to raise a question of fact as to the originality requirement); *Financial Info.*, 808 F.2d at 206 (finding compilation of bond cards not original because compiler's employees chose and arranged information by rote, without using any judgment); *Eckes v. Card Prices Update*, 736 F.2d 859, 863 (2d Cir. 1984) (holding that baseball cards catalog

settled the debate in *Feist*, ruling that effort alone can never be "original" in the constitutional sense.⁴³ Instead, the Court held that a compilation, like any other work, must reflect a "minimal degree of creativity"⁴⁴ before it may be copyrightable.⁴⁵

Feist involved a telephone directory, a very mundane type of compilation. Rural, was the telephone service provider in north-west Kansas.⁴⁶ The white pages portion of Rural's directory listed alphabetically the names and telephone numbers of its customers.⁴⁷ Feist published telephone directories containing both white and yellow pages for a much wider geographic region than the individual telephone service providers,⁴⁸ and eventually copied over a thousand of Rural's listings.⁴⁹ Rural brought an infringement suit against Feist, which raised the uncopyrightability of Rural's white pages as a defense.⁵⁰ The district court granted summary judgment to Rural,⁵¹ and the Tenth Circuit affirmed.⁵² The Supreme Court granted certiorari and reversed the holding of the Tenth Circuit.

Feist delineated a three-step approach for evaluating originality in compilations. First, there must be a collection of "pre-existing material, facts, or data."⁵³ Second, the data must be selected, coordinated, or arranged. And third, by virtue of such selection, coordination, or arrangement, an original work of authorship must be

was original and copyrightable because plaintiff exhibited "creativity and judgment" in selecting 5000 premium cards out of 18,000 cards possible).

⁴³ *See Feist*, 499 U.S. at 349-54.

⁴⁴ *Id.* at 345.

⁴⁵ *Id.* at 351 ("[O]riginality is a constitutionally mandated prerequisite for copyright protection.").

⁴⁶ *Id.* at 342.

⁴⁷ *Id.*

⁴⁸ *Id.* at 342-43. While Feist's white page directory contained 46,878 entries and covered eleven telephone service areas in fifteen counties, Rural's white pages had only 7700 entries and covered a single telephone service area. *Id.* at 343. Feist, like Rural, distributed its directory free of charge, and raised funds by selling advertisements in its yellow pages. *Id.*

⁴⁹ Feist and Rural were fierce competitors. While Rural gathered its information by simply listing all of its customers, Feist negotiated with the eleven telephone providers operating in northwestern Kansas for the use of their white pages listings. Only Rural refused to cooperate. Rural's refusal was problematic for Feist because the attractiveness of Feist's directory lay in its completeness; businesses would have been more reluctant to advertise in Feist's yellow pages if they could not reach all-of the-customers in the area. Rural's refusal, however, did not dampen Feist's enthusiasm. Feist simply copied, without Rural's permission, 1309 listings from Rural's directory and included them in its own directory. *Id.* at 343-44.

⁵⁰ *Id.* at 344.

⁵¹ *Rural Tel. Serv. Co. v. Feist Publications, Inc.*, 663 F. Supp. 214 (D. Kan. 1987).

⁵² *Rural Tel. Serv. Co. v. Feist Publications, Inc.*, 916 F.2d 718 (10th Cir. 1990).

⁵³ *Feist*, 499 U.S. at 357.

created.⁵⁴ Since the facts embodied in a compilation are not themselves copyrightable,⁵⁵ the compiler must show a minimal amount of creativity in their selection, coordination, or arrangement, in order to imbue the compilation as a whole with sufficient originality so as to make it copyrightable.⁵⁶ Although the Court did not attempt to list the kinds of organizational structures that cross the creativity threshold, it did say that the structure chosen must be a product of choice⁵⁷ that reflects the "the existence of . . . intellectual production, of thought, and conception,"⁵⁸ and that it not be merely "mechanical" or "routine."⁵⁹ Rural's white pages did not pass this test. The Court found that Rural's selection of all of its customers and its alphabetical arrangement of the listings "could not [have been] more obvious."⁶⁰

⁵⁴ *Id.* For thorough discussions of *Feist* see Abrams, *supra* note 16, and Ginsburg, *supra* note 29.

⁵⁵ It has been long recognized that facts *per se* are not copyrightable. See *Feist*, 499 U.S. at 344 ("[F]acts are not copyrightable That there can be no valid copyright in facts is universally understood."); *Bellsouth Adver. & Publ'g Corp. v. Donnelley Info. Publ'g Inc.*, 999 F.2d 1436, 1440 (11th Cir. 1993) (noting "the inherent tension between the axiom . . . that facts are not copyrightable and . . . the principle that compilations of fact generally are"); *Financial Info., Inc. v. Moody's Investors Serv., Inc.*, 808 F.2d 204, 207 (2d Cir. 1986) ("Facts may not be copyrighted."). The prohibition on copyrightability of facts lies in the nature of facts themselves — true facts (as opposed to "doctored" facts) are discovered; they always exist until found by a scientist or a researcher. Facts are not "authored" by anyone and do not originate from anyone. See *Feist*, 499 U.S. at 347 (facts are not original in the constitutional sense, and therefore not copyrightable, because they cannot be authored). Facts which can be termed discoveries may be protected by patent law.

⁵⁶ *Feist*, 499 U.S. at 350, 357-58. See also Ginsburg, *supra* note 29, at 342.

⁵⁷ Justice O'Connor, who wrote the opinion for the unanimous Court, suggested that the manner in which the compiler exercises his choice in the selection, coordination, or arrangement of information determines the existence of sufficient creativity. *Id.* at 348.

⁵⁸ *Id.* at 362 (quoting *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 59-60 (1884)).

⁵⁹ *Id.*

⁶⁰ *Id.* Justice O'Connor did not find anything even remotely creative in either Rural's selection or arrangement of the telephone listings. She called Rural's selection of all of its customers an "obvious" choice. *Id.* The alphabetical arrangement of names within the directory was an "age-old practice, firmly rooted in tradition and so commonplace that it has come to be expected as a matter of course." *Id.* at 363. It was also "not only unoriginal [but] practically inevitable." *Id.* The white pages as a whole were a "garden-variety [telephone directory] devoid of even the slightest trace of creativity." *Id.* at 362.

Two very strong but unspoken currents of thought run through *Feist*. The opinion implied that some methods of selecting and arranging information are so self-evident and commonplace, or are "such cultural cliché[s]" that we either "do not want anyone to be able to claim a monopoly [in them, or] we instinctively reject the idea that anyone claiming a copyright [in these methods] actually originated [them]." Abrams, *supra* note 16, at 16-17. Consequently, alphabetizing a list of names, arranging historical facts in chronological order, or listing books in a card catalog by call number, author, or title are all such obvious methods of organizing information that they themselves may be said to be in the public domain. A corollary to this conclusion, is that a compiler cannot just dump information into a commonly-used generic format. See *id.* Instead, he must infuse the organizational structure of the compilation with his subjective judgment, with what another court would later call a "*de minimis* [of] thought," so that the compilation as a whole reflects the compiler's personality to some small, yet identifiable, degree. See *Key Publications, Inc. v.*

2. Derivative Works

The Copyright Act of 1976 defines a derivative work as a work

[B]ased upon one or more preexisting works, such as a translation, musical arrangement, dramatization, fictionalization, motion picture version, sound recording, art reproduction, abridgment, condensation, or any other form in which a work may be recast, transformed, or adapted. A work consisting of editorial revisions, annotations, elaborations, or other modifications which, as a whole, represent an original work of authorship, is a 'derivative work.'⁶¹

Thus, a derivative work is anything that takes a preexisting copyrightable work,⁶² regardless of whether this work is in the public domain, and "recasts," "transforms," or "adapts" it in some way. The copyright in a derivative work extends only to the author's original contributions, and does not affect the copyright or the public domain status of the preexisting work.⁶³ For example, an author of a new English language translation of *Oedipus Rex* could copyright his effort, however the copyright would be limited to the author's choice of word, grammar, and presentation. The copyright would not extend to the story itself, and the translation would not take the story out of the public domain.⁶⁴ Therefore, another translator would be free to translate *Oedipus Rex* anew.

Chinatown Publ'g Enter., Inc., 945 F.2d 509, 514, 517 (2d Cir. 1991); see also Abrams, *supra* note 16, at 16, 18 (pointing out some "obvious" arrangements such as listing American presidents chronologically, zip codes numerically, and baseball players by their batting averages); Brian A. Dahl, *Originality and Creativity in Reporter Pagination: A Contradiction in Terms?*, 74 IOWA L. REV. 713, 719-20 (1989) ("In the rearrangement, the author is putting her own personality into her compilation and thereby satisfies the originality requirement."); Ginsburg, *supra* note 29, at 344-45 (commenting on inevitability of certain arrangements in certain subject areas, such as organizing case reporters according to hierarchy of jurisdiction).

⁶¹ 17 U.S.C. § 101 (1994).

⁶² The preexisting work must itself "come within the general subject matter of copyright set forth in section 102," H.R. REP. NO. 94-1476, at 57 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5664, meaning that the pre-existing work must itself be "an original work . . . of authorship fixed in any tangible medium of expression." 17 U.S.C. § 102(a). For a list of "works of authorship" see *supra* note 3. Thus, a painter who paints a landscape creates a "pictorial" work, 17 U.S.C. § 102(a)(5), not a derivative work because the landscape is based on nature, not on a preexisting "original work of authorship."

⁶³ See H.R. REP. NO. 94-1476, at 57 ("Copyright in a 'new version' covers only the material added by the later author, and has no effect one way or the other on the copyright or public domain status of the preexisting material.")

⁶⁴ See Page, *supra* note 35, at 418, 419 n.31. Another author would also be free to use the ideas embodied in *Oedipus Rex* to write a new tragedy, as the statute specifies that "[i]n no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work." 17 U.S.C. § 102(b). For a good summary of definition of derivative works see Page, *supra* note 35, at 418-19.

While the definition of derivative works helps us to understand what the second author must take in order to have a derivative work, the far more critical issue is what he must add.⁶⁵ A court must evaluate the quantity and quality of the author's contributions to determine if there is sufficient minimal creativity to merit copyright protection.

Courts have developed their own standards for making this determination, as the statute does not specify such a standard. The Second Circuit took the lead in *Alfred Bell & Co. v. Catalda Fine Arts, Inc.*,⁶⁶ where it adopted the "distinguishable variation" test.⁶⁷ In *Alfred Bell*, the plaintiffs, who used a mezzotint engraving process to reproduce paintings by old masters, sued the defendants for copying eight of the mezzotints⁶⁸ through a lithographic printing process.⁶⁹ The defendants challenged the validity of plaintiffs' copyrights, claiming that the mezzotints were unoriginal copies of paintings in the public domain, and thus were ineligible for copyright protection.⁷⁰

Although the mezzotints were reproductions, the Court held that they were not really duplicates, but interpretations of the old masters.⁷¹ The nature of the mezzotint process⁷² foreclosed the production of exact copies because engraving reflects the conception and the skill of each individual engraver, which always produce some variations.⁷³ Writing for the majority, Judge Frank found such unavoidable variations sufficiently original to be copyrightable because "[a]ll that is needed to satisfy both the Constitution and the [1909] statute is that the 'author' contributed something more than a 'merely trivial' variation, something recognizably 'his own.'"⁷⁴ Judge Frank also stressed that the cause of the variations is irrelevant: "[a] copyist's bad eyesight or defective musculature, or a shock caused by a clap or thunder, [all] may yield sufficiently distinguishable variations. Having hit upon such a variation unintentionally, the 'author' may adopt it as his own and

⁶⁵ See Page, *supra* note 35, at 419.

⁶⁶ 191 F.2d 99 (2d Cir. 1951).

⁶⁷ See *id.* at 102 (quoting Gerlach-Barklow Co. v. Morris & Bendien, 23 F.2d 159, 161 (2d Cir. 1927)).

⁶⁸ Mezzotints are derivative works because they are based on and adapt preexisting pictorial works which could themselves be the subject of copyright. See 17 U.S.C. § 101.

⁶⁹ See Olson, *supra* note 9, at 51.

⁷⁰ See *id.* at 50; see also VerSteeg, *supra* note 30, at 581.

⁷¹ See Olson, *supra* note 9, at 50-51.

⁷² For a description of the making of a mezzotint see *id.*

⁷³ See *id.* (discussing and quoting from the district court's opinion in *Alfred Bell*, 74 F. Supp. at 975).

⁷⁴ *Alfred Bell & Co. v. Catalda Fine Arts, Inc.*, 191 F.2d 99, 102-03 (2d Cir. 1951) (quoting Chamberlin v. Uris Sales Corp., 150 F.2d 512 (2d Cir. 1945)).

copyright it."⁷⁵ Thus, after *Alfred Bell*, an author claiming ownership of a valid copyright in a derivative work must point out the variations he has made, and then allow the court to determine if those variations are "distinguishable," rather than "merely trivial."⁷⁶

Of course, under the variation test, one must be able to define the nature of a variation. One commentator⁷⁷ has suggested that:

There are an infinite number of ways to change, or vary, a work that is fixed in a tangible medium. One can enlarge or reduce the size. One can use a different medium — for example, marble instead of bronze. One can change the relative proportions of the physical, material object itself, perhaps by enlarging one surface while reducing another Or, one can alter the artistic embellishment on the object, turning a smiling face into a frown, for instance, by reversing the image. One can also add or subtract features such as color or individual elements.⁷⁸

The possibilities are endless. Although two options, merely changing the scale or medium, have been discounted by some authorities,⁷⁹ numerous viable alternatives remain.

⁷⁵ *Id.* at 105.

⁷⁶ See VerSteeg, *supra* note 22, at 846. The minimalist "trivial" variation test was undercut twenty-five years later in *Batlin & Son, Inc. v. Snyder*, 536 F.2d 486, 490 (1976), where the Second Circuit announced a "substantial" variation approach. This may have been an effort on the part of the Second Circuit to impose an additional requirement of "aesthetic excellence." See Olson, *supra* note 9, at 54-55. However, in light of Feist's "minimum creativity" standard, it is unclear if the "substantial variation" standard is still valid today.

⁷⁷ See VerSteeg, *supra* note 22, at 846-56.

⁷⁸ *Id.* at 846.

⁷⁹ The idea of recognizing originality in the mere change of scale has been roundly criticized ever since the decision in *Alva Studios, Inc. v. Winninger*, 177 F. Supp. 265 (S.D.N.Y. 1959). In *Alva*, the district court found sufficient creativity in a sculptor's meticulous reduced-scale reproduction of Rodin's extremely intricate bronze sculpture *The Hand of God*. See Abrams, *supra* note 16, at 42 ("An exact copy in a different size as a variation on an original work certainly does not seem to be any more creative than choosing to list names in alphabetic order."); Gregg Oppenheimer, *Originality in Art Reproductions: "Variations" in Search of a Theme*, 26 BULL. COPR. SOC'Y 1, 26-28 (1982) ("A change in size should not qualify as a 'distinguishable variation' in the graphic elements of a work of art."); Page, *supra* note 35, at 422-23 (stating that the *Alva* decision was "troublesome," and that besides his skill the sculptor "contributed nothing to the resulting product that could justifiably be regarded as 'his own.'"). But see VerSteeg, *supra* note 22, at 847 ("Even an enlargement or reduction is a concrete variation because it involves either an addition or a subtraction of matter.")

Mere change of medium has also found many opponents. See, e.g., 1 MELVILLE B. NIMMER, *THE LAW OF COPYRIGHT* § 20.2, at 94 (1975) (suggesting that it is "ludicrous . . . that the first person to execute a public domain work of art in a different medium thereafter obtains a monopoly on such work in such medium."); *Accord* Durham Indus., Inc. v. Tomy Corp., 630 F.2d 905, 910 (2d Cir. 1980) (holding that "the mere reproduction of . . . Disney characters in plastic" is not sufficiently creative regardless of the skill involved); *Batlin & Son, Inc. v. Snyder*, 536 F.2d 486, 491 (2d Cir. 1976) (holding that reproduction of the Uncle Sam bank from metal into plastic not sufficiently creative). Cf. Oppenheimer, *supra*, at 22-24 (suggesting that while the idea of reproducing a work in a different medium should not be considered original, the expression of a work in a different medium could be given sufficient variation in the expression). Oppenheimer suggests that this may account

Only after the variations are identified, sometimes with the aide of an expert witness,⁸⁰ can it be determined whether these variations are more than "merely trivial." In making this decision, the judge or the jury has to consider issues such as whether a particular variation alone is sufficient to entitle the work to copyright protection, or perhaps, whether an aggregation of relatively minor variations justifies a finding of sufficient creativity.⁸¹ These judgments are necessarily subjective. There is no obvious formula that will help to decide when a variation crosses the threshold of the trivial. If deleting one small stroke of paint from a perfect reproduction of a Rembrandt painting could arguably be considered trivial, then how does one decide how many deletions it would take for the changes to be sufficient, and for the reproduction to be copyrightable as a derivative work?⁸²

3. Works of Authorship⁸³

One of the most difficult questions to answer in the field of originality jurisprudence (perhaps explaining why there is comparatively little scholarship on the issue), is how to measure creativity in truly "original" works of authorship, those that are neither derivative works nor compilations within the meaning of the statute. Some commentators have suggested that one way to approach these works is to realize that nothing in this world is truly "original" because all creativity ultimately draws on already existing elements.⁸⁴ Thus, writers either "derive" their works from preexisting

for the divergence of outcomes in *Alfred Bell* and *Batlin*. While in *Batlin* the idea of reproducing an Uncle Sam bank in plastic was not copyrightable, in *Alfred Bell* the patterns of lines and dots in the mezzotints were because they reflected the engravers' expression. The engravers could not claim originality in reproducing the paintings by the mezzotint process, but they could claim valid copyright in their patterns of lines and dots. See *id.*

⁸⁰ Sometimes expert testimony is necessary to pinpoint variations. This is true in the areas of computers and music where some of the most valuable variations may not be apparent to the naked eye or ear, but would require examination and explanation of musical notation or computer code. Typically, neither judges nor juries are expected to have such sophisticated knowledge.

⁸¹ See VerSteeg, *supra* note 22, at 852-53.

⁸² The Rembrandt example is drawn from Page, *supra* note 35, at 421. VerSteeg also suggests that adding one freckle to a drawing of an already freckled redhead, or changing the angle of the curve of Mona Lisa's smile by one degree would likely be too trivial to be original. Of course, these examples beg the question: how many freckles, if any, would it take for the addition to be considered a more than trivial variation; or, how much more, or less, would an artist have to make Mona Lisa smile or frown to have his work considered original? See VerSteeg, *supra* note 22, at 850.

⁸³ For ease of reference this Note refers to all works that are neither compilations nor derivative works as "works of authorship."

⁸⁴ For instance:

Virgil borrowed much from Homer; Bacon drew from earlier as well as contemporary minds; Coke exhausted all the known learning of his profession; and even Shakespeare and Milton, so justly and proudly our boast as the brightest

letters and grammatical structures, or they select and rearrange letters, words, and punctuation to produce works of literature that are, essentially, compilations of preexisting materials.⁸⁵ Likewise, musicians select and arrange musical notes, while painters "draw" on nature, people, and objects around them to present their creative visions.⁸⁶ One who accepts this view of works of authorship may try to apply it to the standards of creativity developed in the context of derivative works and compilations.⁸⁷

Alternatively, in *Atari Games Corp. v. Oman*,⁸⁸ Judge (now Justice) Ginsburg relied upon an instinctive or subjective judgment of a work, based on one's experience of the world. In *Atari*, the Register of Copyrights refused to register the video game "Breakout," citing lack of originality in its audio-visual display.⁸⁹ Breakout's display consisted of a rectangular paddle that bounced around a square "ball," which knocked off rectangular multi-colored "bricks" off the top level of the screen, thereby scoring points.⁹⁰ The Register refused to copyright the video game because it consisted of nothing more than an aggregation of common geometric shapes and colors.⁹¹ The district court agreed and granted summary judgment against Atari on the copyrightability issue.⁹² Judge Ginsburg reversed, but did not give a clear reason for the reversal. Rather, she merely noted that in the past "simple shapes, when selected or combined in a distinctive manner indicating some ingenuity, have been accorded copyright protection both by the Register and in

originals[,] would be found to have gathered much from the abundant stores of current knowledge and classical studies in their days.

Emerson v. Davies, 8 F. Cas. 615, 619 (C.C.D. Mass. 1845) (No. 4,436) (Story, J.). See also Page, *supra* note 35, at 418; VerSteeg, *supra* note 22, at 816.

⁸⁵ See VerSteeg, *supra* note 22, at 816 (potentially "every work is, to some degree, either a compilation of preexisting elements and/or works, or else a derivation of preexisting work or works.").

⁸⁶ See Page, *supra* note 35, at 418.

⁸⁷ See VerSteeg, *supra* note 22, at 869. Great care would have to be exercised, however, in choosing the proper subjects of comparison. *Id.* A photograph, for instance, replicates nature to the minutest degree. At first glance, this would suggest that a photographer is not an author within the meaning of copyright law because he does not originate the picture but merely copies it from nature. Photography, however, has been recognized as copyrightable subject matter for over a hundred years. In *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53 (1884), the Supreme Court found that at a minimum, the photographer's use of lighting and camera angles makes each photograph a product of the photographer's "intellectual conception." *Id.* at 60. Thus, under the trivial/substantial variation test a court would have to compare not nature and the photograph, but a photograph and another photograph.

⁸⁸ 888 F.2d 878 (D.C. Cir. 1989).

⁸⁹ *Id.*

⁹⁰ *Id.* at 879.

⁹¹ *Id.* at 880.

⁹² *Id.*

court."⁹³ The court found that Breakout's selection and rearrangement of common shapes demonstrated a minimal element of ingenuity heretofore unseen. This is the most subjective of approaches, and potentially the most troublesome.

II. THE LAW/FACT DICHOTOMY AND ORIGINALITY

Before deciding whether originality should be treated as a question of fact or law, it is first necessary to understand what these terms mean, and briefly to consider the differences between "questions of fact" and "questions of law." From the start, it must be noted that these terms often have a very different meaning in the legal, as opposed to the lay, context.⁹⁴ Webster's dictionary, for example, defines fact as "a thing that has actually happened or that is really true; reality; actuality; truth."⁹⁵ Thus, in the lay understanding a fact is something that has objective, historical significance. It can be observed, discovered, reconstructed, or deduced by answering such questions as who, what, where, when, and how, and by using one's senses.⁹⁶ In contrast, Webster's dictionary defines law as "all the rules of conduct established and enforced by the authority, legislation, or custom of a given community."⁹⁷ Under this definition, law is a body of principles that determines the standard of behavior.

Unfortunately, these definitions lose their distinctiveness when they are transposed into the legal environment, and are applied to concrete situations. For instance, anyone would likely accept as a "fact" that a car is red or that it is raining. These are observable phenomena; they either do or do not exist, do or do not happen. However, for an attorney each term has significance only in a specific context. For example, although a lay person may observe *A* working for *B* and conclude that *A* is "in fact" *B*'s "employee," *A* may not qualify as an "employee" either under a worker's compensation statute, or for the purposes of *B*'s tort liability under *respondeat superior*.⁹⁸ An attorney may view the condition

⁹³ *Id.* at 883.

⁹⁴ For a wonderful detailed discussion of the differences between the lay and the legal conceptions of "law" and "fact" see Kenneth Vinson, *Disentangling Law and Fact: Echoes of Proximate Cause in the Workers' Compensation Coverage Formula*, 47 ALA. L. REV. 723, 737-45 (1996).

⁹⁵ WEBSTER'S NEW WORLD DICTIONARY OF THE AMERICAN LANGUAGE 501 (2d ed. 1986) [hereinafter WEBSTER'S DICTIONARY].

⁹⁶ See Vinson, *supra* note 94, at 737 (agreeing with the dictionary and commenting that to non-lawyers fact, "denotes an event, an actuality, a piece of what happens in the real world as experienced through sensory perception").

⁹⁷ WEBSTER'S DICTIONARY, *supra* note 95, at 799.

⁹⁸ See Vinson, *supra* note 94, at 725.

of employment either as a fact or a legal conclusion drawn from other facts depending on the circumstances and the question asked. Thus, in the legal world, "law" and "fact" are mutable concepts controlled by both the physical and policy background of each particular event.⁹⁹ Litigation transforms the absolute lay concepts of "law" and "fact" into uncertain legal categories of "questions of law" and "questions of fact."

It is precisely this mutability and uncertainty that prompted the Supreme Court to comment on the "the vexing nature of the distinction between questions of fact and questions of law,"¹⁰⁰ and to note that there is "no rule or principle that will unerringly distinguish a factual finding from a legal conclusion."¹⁰¹ Yet, although telling the difference between the two may be a "vexing" task, the differentiation is very often accomplished by answering a single question: Who do we want to decide this issue, the judge or the jury? Traditionally, common law courts give "questions of fact" to the jury, and leave "questions of law" for the judge to decide.¹⁰² Thus, the categories of "questions of law" and "questions of fact" are frequently used as a convenient short-hand for allocating matters between the decision-makers.¹⁰³

Once the allocation of decision-making is recognized as the key to the law/fact dichotomy, the relevant inquiry becomes whether the judge or the jury is more competent to determine the question of originality.¹⁰⁴ At the turn of the century, Justice Holmes urged against judicial meddling in originality. He wrote:

It would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits. At the one extreme, some works of genius would be sure to miss appreciation. Their very novelty would make them re-

⁹⁹ See *id.* at 737-45.

¹⁰⁰ Pullman-Standard v. Swint, 456 U.S. 273, 288 (1982) (citation omitted).

¹⁰¹ *Id.*

¹⁰² See Stephen A. Weiner, *The Civil Jury Trial and the Law-Fact Distinction*, 54 CAL. L. REV. 1867 (1966) (noting that this allocative function can be traced back to the sixteenth century).

¹⁰³ See *Miller v. Fenton*, 474 U.S. 104, 113-14 (1985) ("[T]he decision to label an issue a 'question of law,' a 'question of fact,' or a 'mixed question of law and fact' is sometimes as much a matter of allocation as it is of analysis."); Vinson, *supra* note 94, at 743 ("[T]he truth is that [an] issue is called a question of fact only because we chose to pass it to the jury."); Richard A. Machonkin, Note, *Markman v. Westview Instruments, Inc. and Hilton Davis Chemical Co. v. Warner-Jenkinson Co.: The Federal Circuit Gets Its Law and Its Facts Straight*, 9 HARV. J.L. & TECH. 181, 182-83 (1996).

¹⁰⁴ The allocation of decision-making duties between the judge and the jury proceeds on the assumption that "as a matter of the sound administration of justice, one judicial actor is better positioned than another to decide the issue in question." *Miller*, 474 U.S. at 114.

pulsive until the public had learned the new language in which their author spoke. It may be more than doubted, for instance, whether the etchings of Goya or the paintings of Manet would have been sure of protection when seen for the first time. At the other end, copyright would be denied to pictures, which appealed to a public less educated than the judge. Yet if they command the interest of any public . . . it would be bold to say that they have not an aesthetic and educational value—and the taste of any public is not to be treated with contempt.¹⁰⁵

Justice Holmes feared that judges, by virtue of their elitist education and upbringing, would not evaluate works on their own merits. Instead, he felt that they would tend to make broad value judgments and condemn as uncopyrightable either highly original works not yet recognized as such, or “populist” works aimed at mass consumption.¹⁰⁶ Implicit in Justice Holmes’s statement is the conclusion that originality is inexorably linked to the communal perception of what is artistic, imaginative, or inventive, and that ordinary people, who are the intended audience and consumers of such creative works, are more competent to judge them. It is reasonable to conclude then, that originality should be a “question of fact,” so that the jurors, as members of the intended audience may have the opportunity to pronounce their judgment of originality.

This view finds support in many areas of law. For instance, nine circuits treat likelihood of confusion in trademark law as a “question of fact,” because “the question is whether the marks look similar to consumers, not whether the marks look similar to judges.”¹⁰⁷ Similarly, juries usually determine reasonableness of conduct in tort law since persons of various occupations and educational backgrounds “know more of the common affairs of life than does one man [and] can draw wiser and safer conclusions [from facts] than can a single judge.”¹⁰⁸ Substantial similarity in copy-

¹⁰⁵ *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 252 (1903).

¹⁰⁶ *Accord North Coast Indus. v. Jason Maxwell, Inc.*, 972 F.2d 1031, 1034-35 (9th Cir. 1992). In *North Coast*, the Ninth Circuit refused to hold as a matter of law that a fabric design modeled on Mondrian’s artwork was not original. Judge Schroeder wrote that:

If we were to accept the view that, as a matter of law the differences in the placement of geometric shapes should be regarded as trivial, we would be forced to conclude that Mondrian’s creativity with geometric shapes ended with his first painting, and that he went on to paint the same painting a thousand times. This is not the judgment of art history, and it cannot be the correct judgment of a court as a matter of law. The plaintiff was entitled to have the validity of its copyright determined by a trier-of-fact.

Id. at 1035.

¹⁰⁷ See Patricia J. Kaeding, *Clearly Erroneous Review of Mixed Questions of Law and Fact: The Likelihood of Confusion Determination in Trademark Law*, 59 U. CHI. L. REV. 1291, 1298 (1992).

¹⁰⁸ See *Weiner*, *supra* note 102, at 1880-81 (quoting *Sioux City & Pac. R.R. v. Stout*, 84 U.S. (17 Wall.) 657, 663-64 (1873)).

right law is often treated as a “question of fact,” because the test is whether two works appear to be substantially similar to an “ordinary observer.”¹⁰⁹ Like originality, these three issues are invariably subjective and are firmly tied to community standards, to what the community views as being reasonable, confusing, or pilfered. These determinations call for subjective judgments based on peoples’ experiences and perceptions of the world, and as such, they are best made by a group, rather than by a single individual.¹¹⁰

Several procedural consequences would follow if originality were treated as a “question of fact.” Normally, a decision to classify any issue as a “question of fact” greatly narrows the scope of appellate review on that issue. Jury fact determinations are reviewed with the greatest deference and are subject to reversal only if no reasonable jury could have come to such a conclusion on the evidence presented.¹¹¹ Similarly, Rule 52(a) of the *Federal Rules of Civil Procedure* requires appellate courts to review judicial findings of fact under the strict “clearly erroneous” standard.¹¹² Questions of law, on the other hand, are reviewed *de novo*.¹¹³ Thus, if originality were classified as a “question of fact” appellate judges would have much less freedom to superimpose their own views and biases over the decision of the jury or district court judge.

Labeling originality a “question of fact” rather than “a question of law” would allow more copyright claims to go to a jury by limiting the court’s power to dismiss copyright claims for lack of originality during the early stages of litigation. Judges would almost certainly not be able to grant defendants’ motions to dismiss

¹⁰⁹ *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F.2d 487, 489 (2d Cir. 1960) (Hand, L., J.) (emphasis added); see also *North Coast*, 972 F.2d at 1034 (determining that the trier of fact is to decide question of substantial similarity because the outcome depends on the reactions of the “ordinary reasonable person”).

¹¹⁰ See Richard D. Friedman, *Standards of Persuasion and the Distinction Between Fact and Law*, 86 Nw. U. L. REV. 916, 923-24 (1992) (“[W]here the general principle is that prevailing community standards are to supply the norm, the jury may be more likely than a court to act in accordance with those standards; ‘reasonable speed’ and ‘ordinary care’ are good illustrations.”).

¹¹¹ See Martin B. Louis, *Allocating Adjudicative Decision Making Authority Between the Trial and Appellate Levels: A Unified View of the Scope of Review, the Judge/Jury Question, and Procedural Discretion*, 64 N.C. L. REV. 993, 994 n.7 (1986) (noting that the standard of review of jury findings is judicially created and citing authorities). One accepted, but rarely used, exception to the deferential review concerns constitutional facts, giving rise to constitutional rights, which federal courts may review independently. *Id.* at 1000.

¹¹² FED. R. CIV. P. 52(a). “Clearly erroneous findings are those that leave the circuit court with the definite and firm conviction that a mistake has been made.” Brett T. Reynolds, *Appellate Review of Lanham Act Violations: Is Likelihood of Confusion a Question of Law or Fact?*, 38 Sw. L.J. 743, 752 (1984) (citing *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 855 (1982) and *United States v. United States Gypsum Co.*, 333 U.S. 364, 395 (1948)).

¹¹³ See Louis, *supra* note 111, at 993; Reynolds, *supra* note 112, at 752. On *de novo* review, an appellate court disregards the trial court’s findings and makes independent conclusions as if it is itself the trial court. See BARRON’S LAW DICTIONARY 130 (3d ed. 1991).

for failure to state a claim for which relief can be granted.¹¹⁴ Because such motions require the judge to "accept the material facts alleged in the complaint as true,"¹¹⁵ the judge would have to accept all initial claims of originality as true, and deal with the merits of the issue at a later stage. Moreover, the use of summary judgment and judgments as a matter of law would also be curtailed if the court's power was limited. Courts may grant summary judgments, or judgments as a matter of law, only when the facts are so skewed towards the movant's side that no reasonable jury could find for the non-movant.¹¹⁶ This strict standard, combined with the uncertainty implicit in most originality determinations due to the variety of potential points of view, would considerably narrow the category of works that would fail the originality test at the summary judgment stage of litigation, as many outcomes would be "reasonable" and, thus, not subject to summary judgment. Hence, a much greater portion of works would survive to reach the jury; arguably, the more competent decision-maker.

Nevertheless, there are at least two potential drawbacks to treating originality as a "question of fact." The first is the danger of inconsistent jury verdicts. Most of the time, juries do not and may not explain their reasoning.¹¹⁷ Jury verdicts and conclusions are generally not reported,¹¹⁸ have no precedential value, and are not binding in future cases.¹¹⁹ This would allow two different juries to arrive at two different conclusions on similar facts. As a result, jury adjudication of originality could lead to "[i]nconsistencies among verdicts [that] could be expected to introduce a lawless element into the administration of justice in copyright cases, quite inconsistent with the aim of treating like cases alike."¹²⁰ Yet, as Part III of

¹¹⁴ See FED. R. CIV. P. 12(b)(6).

¹¹⁵ *Cohen v. Koenig*, 25 F.3d 1168, 1172 (2d Cir. 1994).

¹¹⁶ See FED. R. CIV. P. 56(c) (summary judgment to be granted "if the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to judgment as a matter of law"); FED. R. CIV. P. 50 (judgment as a matter of law to be granted if "there is no legally sufficient evidentiary basis for a reasonable jury to find for [the non-movant] on that issue"). See also *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248, 250-51 (1986) (citing the reasonable jury standard for summary judgment and noting that the summary judgment is for all practical purposes equivalent to the standard for the judgment as a matter of law, with timing as virtually the sole difference).

¹¹⁷ See *Lotus Dev. Corp. v. Borland Int'l, Inc.*, 788 F. Supp. 78, 95 (D. Mass. 1992). Specific verdicts and written interrogatories are the narrow exceptions. When jurors render a specific verdict or answer interrogatories their reasoning may be inferred from the answers. See FED. R. CIV. P. 49(a) & (b).

¹¹⁸ See *Weiner*, *supra* note 102, at 1885; see also *Friedman*, *supra* note 110, at 923-24.

¹¹⁹ See *Weiner*, *supra* note 102, at 1875.

¹²⁰ *Lotus*, 788 F. Supp. at 95.

this Note will demonstrate, the treatment of originality as a "question of law" does not guarantee consistency.

The second problem with treating originality as a "question of fact" involves a possible increase in frivolous claims. Because judges will be greatly limited in their ability to grant motions to dismiss and summary judgments, more cases will receive a trial on the merits, potentially clogging the courts and encouraging undeserving litigants to press their claims and to try their luck.¹²¹ This concern may be minor, however, "when compared with the danger of retrying entire . . . cases at the appellate level,"¹²² which is what often happens when an arguably "factual" issue, such as originality, is labeled "a question of law" and subjected to *de novo* review in the court of appeals.¹²³ At the very least, such a retrial represents a tremendous waste of judicial resources. Furthermore, the higher costs associated with a larger number of cases reaching the trial stage would be offset not only by the reduced costs of shorter appeals, but also by a larger number of settlements. Parties confronted with the prospect of incurring significant trial expenses would likely be more willing to settle, thus unclogging trial court dockets, and reducing attendant costs.

III. THE (INADEQUATE) LAW SOLUTION

Courts have not reached a consensus on how to label originality. Some treat it as a "question of fact,"¹²⁴ and others as a "question of law."¹²⁵ Some, such as the Seventh Circuit, flirt with both approaches.¹²⁶ Some circuits say that originality is a "question of fact," but in reality they treat it as one of "law."¹²⁷ Either way, it is judges, not juries, who make the majority of the decisions, often with debatable and troubling results. Part III examines several such opinions by appellate judges who, by all indications, treated originality as a question of law. The decisions are segregated into categories — compilations, derivative works, and "works of author-

¹²¹ See *Reynolds*, *supra* note 112, at 773 (discussing a similar possibility if the issue of "likelihood of confusion" in trademark law were treated as a question of fact).

¹²² *Id.*

¹²³ See *infra* Part III, notes 150-51 and accompanying text.

¹²⁴ See, e.g., *Financial Info., Inc. v. Moody's Investors Serv., Inc.*, 808 F.2d 204, 207 (2d Cir. 1986) ("The district court's determination of whether the work was sufficiently original to merit copyright protection was one of fact.").

¹²⁵ See *Bellsouth Adver. & Publ'g Corp. v. Donnelley Info. Publ'g Inc.*, 999 F.2d 1436 (11th Cir. 1993).

¹²⁶ See *American Dental Ass'n v. Delta Dental Plans Ass'n*, 39 U.S.P.Q.2d 1714, 1720 n.2 (N.D. Ill. 1996) (noting that "[i]n this circuit, the treatment has been inconsistent," and citing cases).

¹²⁷ The Second Circuit is sometimes guilty of this infraction. See, e.g., *Key Publications, Inc. v. Chinatown Publ'g Enter., Inc.*, 945 F.2d 509 (2d Cir. 1991).

ship" — in order to highlight the glaring inconsistencies and questionable, biased judgments.

A. *Compilations*

Factual compilations often become objects of copyright litigation. Recently, the Second Circuit, which admittedly treats originality as a "question of fact,"¹²⁸ and the Eleventh Circuit, which appears to treat the issue as one of law,¹²⁹ came to opposite results when posed with the question of whether the material embodied in yellow pages was original. Yet, both were post-*Feist* decisions and applied *Feist's* principles.

In *Key Publications, Inc. v. Chinatown Today Publishing Enterprises Inc.*,¹³⁰ the Second Circuit found the selection and arrangement of the plaintiff's yellow pages to be original and copyrightable. The plaintiff published a telephone directory aimed at New York City's Chinese-American community.¹³¹ The yellow pages contained the telephone numbers and addresses of businesses in Chinatown and elsewhere.¹³² The listings were selected on the basis of their appeal to the Chinese-American consumers and were categorized by type of business.¹³³ Defendants copied about 1500 of Key Publications' listings and Key Publications sued for infringement.¹³⁴ After a bench trial, the district court ruled that Key Publications held a valid copyright,¹³⁵ and the Second Circuit affirmed that judgment.¹³⁶

The Second Circuit found that Key Publications' directory was original because it exercised sufficient "creative" judgment in both the selection¹³⁷ and the arrangement¹³⁸ of the listings. In arriving

¹²⁸ See, e.g., *Kregos v. Associated Press*, 937 F.2d 700, 704 (2d Cir. 1991) (holding that "[i]t cannot be said as a matter of law [that plaintiff who selected] nine items for his pitching form out of the universe of available data . . . has failed to display enough selectivity to satisfy the requirement of originality"); see also *Financial Info.*, 808 F.2d at 207.

¹²⁹ See *Bellsouth*, 999 F.2d 1436.

¹³⁰ 945 F.2d 509 (2d Cir. 1991).

¹³¹ *Id.* at 511.

¹³² *Id.*

¹³³ The listed businesses were selected by the Key Publication's president who collected business cards from businesses either affiliated with the Chinese-American community, or those which she believed should be listed in the yellow pages. The listings were categorized by type of business, for a total of 260 categories. There were approximately 9000 entries, each listed both in English and in Chinese. *Id.*

¹³⁴ *Id.*

¹³⁵ *Id.* There is no report of the district court decision as the decision was oral.

¹³⁶ *Id.* at 509.

¹³⁷ Key Publication's president chose specific businesses from a large number of available candidates, but also excluded those establishments that she believed were about to close. *Id.* at 513.

¹³⁸ The court concluded that the total organization of Key Publications' directory moved beyond the "mechanical." Although Key Publications primarily used such common

at this decision, the court wavered between treating originality as a question of law and as a question of fact. The court noted that the "record supports"¹³⁹ the district court's finding of originality in selection, seemingly treating the issue as one of fact. However, it also found originality in arrangement, by stating that "we believe" it exists, or "we agree" with the district court that it exists.¹⁴⁰ This language tends to support the conclusion that the Second Circuit reviewed the district court's decision *de novo*, made independent evaluations of the evidence, and treated the issue as one of law.

In *Bellsouth Advertising & Publishing Corp. v. Donnelley Information Publishing*,¹⁴¹ the Eleventh Circuit reached the opposite conclusion and found that the defendant did not copy copyrightable expression from plaintiff's yellow pages.¹⁴² The facts of *Bellsouth* are very similar to those of *Key Publications*. *Bellsouth*, the plaintiff, also published a yellow pages directory organized by type of business. *Donnelley*, *Bellsouth's* competitor, copied *Bellsouth's* listings and using that information, compiled its own yellow pages. *Bellsouth* sued for copyright infringement and the district court granted its motion for summary judgment, keeping the issue from a jury.¹⁴³ The Eleventh Circuit reversed¹⁴⁴ finding that *Bellsouth's* selection and arrangement were "entirely typical"¹⁴⁵ for a yellow pages business directory and "as a matter of law [did] not display the originality required to merit copyright protection."¹⁴⁶

categories as "Accountants," "Bridal Shops," and "Shoe Stores," it added some that one would not typically expect to find in a telephone directory, such as "Bean Curd & Bean Sprout Shops." *Id.* at 513-14.

¹³⁹ *Id.* at 513.

¹⁴⁰ *Id.* at 514.

¹⁴¹ 999 F.2d 1436 (11th Cir. 1993).

¹⁴² *Id.* at 1466.

¹⁴³ For a summary of factual background see *id.* at 1438-40. See also *Bellsouth Adver. & Publ'g Corp. v. Donnelley Info. Publ'g*, 719 F. Supp. 1551, 1568 (1992).

¹⁴⁴ The case had a long procedural history. After the initial grant of summary judgment to *Bellsouth* in the district court, the Eleventh Circuit affirmed by a panel decision. After *Feist Publications, Inc. v. Rural Telephone Serv. Co.*, 499 U.S. 340 (1991) came down, the affirmation was vacated, and a rehearing *en banc* granted. The present opinion is the eventual reversal of the district court by the Eleventh Circuit sitting *en banc*. See Kenneth S. Barrow, *Recent Developments in Copyright Law*, 2 TEX. INTEL. PROP. L.J. 155, 156 (1994).

¹⁴⁵ *Bellsouth*, 999 F.2d at 1442 (citing *Feist*, 499 U.S. at 361).

¹⁴⁶ *Id.* at 1445. The court did not consider *Bellsouth's* acts of selection, such as limiting the geographic reach of the directory, and setting the closing date beyond which the listings could not be changed, to be original because they were inevitable. The judges drew a parallel to *Feist* and commented that *Rural* must have engaged in the same acts of selection, yet the Supreme Court found *Rural's* directory uncopyrightable. See *id.* at 1441-45. The court also rejected the supposed creativity in *Bellsouth's* arrangement of the listings because:

. . . [M]any of the selected headings, for example "Attorneys" or "Banks," represent such an obvious label for the entities appearing under [them] as to lack the requisite originality . . . [Bellsouth] can claim no copyright in the idea of dividing churches by denomination or attorneys by area of specialty.

The outcomes of *Key Publications* and *Bellsouth* are irreconcilable. Both courts were confronted with virtually identical yellow page directories, yet one was found to be original and the other was not. To a large extent, the root of the discrepancy can be traced to the courts' treatment of originality as a "question of law." For instance, the Second Circuit found *Key Publication's* arrangement of information to be original because it included headings customized for the Chinese-American community.¹⁴⁷ But New York is an ethnically diverse city. Perhaps a jury composed of average New Yorkers would not have found any originality in headings such as "Bean Curd & Bean Sprout Shops," because they are exposed to such ethnic characterizations on a daily basis, and would have considered them "typical" in *Feist's* terms. Viewed in this light, the Second Circuit's conclusion that these headings are "original" is highly questionable, but could be explained by judicial detachment from the everyday of New York life. In contrast, the Eleventh Circuit was more realistic when it found that *Bellsouth's* headings, which reflected local terminology, were not original.¹⁴⁸ Like the headings in *Key Publications*, *Bellsouth's* headings most likely would also have appeared unoriginal to *Bellsouth's* average customers, as they reflected the everyday usage of that locality.

Yet, while the Eleventh Circuit avoided one trap, it fell into another. As Judge Hatchett's dissent pointed out, *Bellsouth* grouped 106,398 business listings from 32,559 different businesses, under approximately 7000 classified headings.¹⁴⁹ Judging by its grant of summary judgment in favor of *Bellsouth*, the trial court believed that this arrangement reflected the minimum amount of creative judgment necessary for a finding of originality. However, the Eleventh Circuit did not agree. Had the trial court treated originality as a "question of fact," the jury would have made this highly fact-specific, subjective evaluation, and the issue would have likely been resolved at the outset. Instead, the district court granted summary judgment, and the trial and appellate courts wound up reaching contradictory results. Neither decision was more or less correct than the other, and both reflected little more than each court's opinion unsupported by concrete legal reasoning. Judicial resources were wasted, and the result did not justify

Id. at 1444.

¹⁴⁷ *Key Publications, Inc. v. Chinatown Publ'g Enter., Inc.*, 945 F.2d 509, 514 (2d Cir. 1991).

¹⁴⁸ *Bellsouth*, 999 F.2d at 1444. See also *id.* at 1474 (Hatchett, J., dissenting).

¹⁴⁹ *Id.* at 1475 (Hatchett, J., dissenting).

the expenditure.¹⁵⁰

B. Derivative Works

While consistency is purportedly one of the main benefits of treating originality as a "question of law," *Key Publications* and *Bellsouth* demonstrate that consistency is not guaranteed when different courts decide almost identical questions. *Batlin & Son, Inc. v. Snyder*¹⁵¹ and *Durham Industries, Inc. v. Tomy Corp.*,¹⁵² undermine the judicial consistency argument even further, showing how inconsistent one judge can be in making originality determinations. In these cases, Judge Meskill, who participated in both decisions, came to contrary results on very similar facts.

In *Batlin*, the Second Circuit denied protection to a plastic replica of a metal "Uncle Sam" bank. The design of the metal bank¹⁵³ was well-known to the public and had been in the public domain since about the turn of the century. Snyder reproduced the bank as a plastic novelty toy and made several changes in the design in order to accommodate manufacturing needs and to keep it within a certain price range.¹⁵⁴ However, when Snyder put his bank on the market, *Batlin* noticed it and ordered his own version from a Hong Kong manufacturer.¹⁵⁵ When Customs agents informed *Batlin* that his banks were covered by Snyder's copyright and refused entry of the shipments, *Batlin* brought a declaratory action seeking to void Snyder's copyright.¹⁵⁶ The district court agreed with *Batlin*¹⁵⁷ and the Second Circuit affirmed, holding that Snyder's replica bank lacked the necessary variation on the pre-existing public domain cast iron bank to be original.¹⁵⁸

¹⁵⁰ Judge Hatchett argued that by ignor[ing] the evidence presented in the district court, [and by] allow[ing] the appellant to obtain an outright reversal . . . [t]he majority transform[ed] [the] en banc appellate court into no more than a multiple judge trial court that allows unsuccessful litigants to have the proverbial "second bite at the apple."

Id. at 1471.

¹⁵¹ 536 F.2d 486 (2d Cir. 1976).

¹⁵² 630 F.2d 905 (2d Cir. 1980).

¹⁵³ Uncle Sam, wearing his distinct outfit and leaning on an umbrella, stands on a pedestal next to his carpetbag. When one put a coin into Uncle Sam's hand and pressed a lever, the coin dropped into the carpetbag. See *Batlin*, 536 F.2d at 488.

¹⁵⁴ For example, he reduced the size of the bank, modified the shape of the carpetbag, and the American Eagle embossed on the pedestal held leaves instead of arrows. *Id.* at 488-89.

¹⁵⁵ *Batlin*, 536 F.2d 486 at 488.

¹⁵⁶ *Id.*

¹⁵⁷ *Batlin & Son, Inc. v. Snyder*, 394 F. Supp. 1389 (S.D.N.Y. 1975).

¹⁵⁸ See *Batlin*, 536 F.2d at 492. Although this discussion centers on the dissent, the majority's decision was itself problematic because it contradicted established Second Circuit precedent. The court denied Snyder's bank protection partly because it did not embody sufficient artistic skill and because many variations were motivated by practical considera-

In his dissent, Judge Meskill referred to many variations which the majority either failed to take into account or discounted as insignificant.¹⁵⁹ He felt that, collectively, these variations were sufficient to render Snyder's banks original.¹⁶⁰ Significantly, he concentrated on the variations themselves, and criticized the majority for instead focusing on the reasons for the variations — aesthetic, inadvertent, or practical — which should have been irrelevant to the question of originality.¹⁶¹

*Durham*¹⁶² was also a toy case and revolved around, among other things, wind-up figurines featuring the well-known Disney characters Mickey Mouse, Donald Duck, and Pluto.¹⁶³ Tomy, a toy manufacturer, made plastic wind-up toys under license from Disney.¹⁶⁴ In 1979, Tomy accused Durham of copying several of its toys and threatened Durham with a lawsuit. Durham responded by seeking declaratory judgment that it did not violate Tomy's rights. Tomy followed up by filing eight counterclaims for copyright infringement. Durham moved for and was granted summary judgment on all of the copyright counterclaims. The Second Circuit, in an opinion by Judge Meskill, affirmed.¹⁶⁵

The main, and almost sole, reason why Judge Meskill denied Tomy's toys' originality was because they looked like "prototypical"¹⁶⁶ Disney characters, only in plastic. Granted, it is a safe as-

tions. See *id.* at 491. The court spoke very negatively about the value of cheap "knock off" reproductions. See *id.* at 492. However, *Alfred Bell*, the controlling precedent at the time, had established that artistic merit is irrelevant to the originality inquiry, and that variations are copyrightable regardless of their origin. See *Alfred Bell & Co. v. Catalda Fine Arts*, 191 F.2d 99, 103 (2d Cir. 1951).

¹⁵⁹ Judge Meskill noted changes in the "anatomical proportions of the Uncle Sam figure, including shape and expression of face; design of the clothing (hat, tie, shirt, collar, trousers); detail around the eagle figure on the platform; placement of the umbrella; and the shape and texture of the satchel." *Batlin*, 536 F.2d at 493 (Meskill, J., dissenting).

¹⁶⁰ *Id.* at 494. (Meskill, J., dissenting).

¹⁶¹ *Id.* at 493. (Meskill, J., dissenting). The majority denied originality to Snyder's banks partly because some of the changes were motivated by the exigencies of manufacture. See *id.* at 488 (noting that "Snyder wanted his bank to be made of plastic and to be shorter than the cast metal sample 'in order to fit into the required price range and quality and quantity of material to be used.'"); *id.* (umbrella was included into a one-piece mold with the Uncle Sam figure to avoid manufacturing problems); *id.* at 489 (the eagle on the plastic bank held leaves instead of arrows because "arrows did not reproduce well in plastic on a smaller size"); *id.* (stressing that none of the differences "had any purpose other than the functional one of making a more suitable (and probably less expensive) figure in the plastic medium"); see also *Alfred Bell*, 191 F.2d at 105; Olson, *supra* note 9, at 45.

¹⁶² *Durham Indus., Inc. v. Tomy Corp.*, 630 F.2d 905 (2d Cir. 1980).

¹⁶³ Unfortunately, in this opinion Judge Meskill was not very generous in his description of the toys and there is no published district court opinion to refer to, thus factual details are scarce.

¹⁶⁴ *Durham*, 630 F.2d at 908-09. The toys were three inches tall and the wind-up mechanism allowed them to move. *Id.*

¹⁶⁵ The procedural history is set out *id.* at 907-08.

¹⁶⁶ *Id.* at 910.

sumption that most people know what Mickey, Donald, and Pluto look like; but, they do not invariably look the same. The characters appear in different poses and costumes in cartoons, in books, and on merchandise. But Judge Meskill did not describe what Tomy's toys looked like. He did not mention what they "wore," what poses they assumed, what sorts of facial expressions they had, if any, whether there were variations in coloring, whether the figurines had bases or whether they were standing on two legs, or four in Pluto's case. It is, of course, entirely possible that Tomy's toys lacked any distinguishable variation, but without a description of the toys it is impossible to judge. Just because they were instantly recognizable as Disney's famous characters does not necessarily mean that Tomy did not inject them with a spark of its own creativity.

In *Batlin* and *Durham*, Judge Meskill was confronted with almost identical fact patterns but showed a remarkable lack of consistency. He treated originality as a "question of law," but that treatment did not result in heightened predictability. Indeed, Judge Meskill's about-face from one case to the next was probably a surprise to those attorneys who were aware of his *Batlin* opinion, and likely, expected him to follow through in *Durham*. Ultimately, despite the treatment of originality as a "question of law," like cases were not treated alike, and once again the goal of predictability was not achieved. At the very least, had the trial courts in *Batlin* and *Durham* treated originality as a "question of fact" for the jury, no such false expectations would have been created in the first place.

C. Works of Authorship

While courts encounter a considerable amount of trouble when they attempt to evaluate the originality of compilations and derivative works, they face no less difficulty, if not more, when confronted with "original works of authorship." In *Toro Co. v. R & R Products, Co.*,¹⁶⁷ the Eighth Circuit denied existence of originality in Toro's parts-numbering system. Toro manufactured and sold lawn care equipment and replacement parts.¹⁶⁸ Each replacement part was randomly assigned a five or six-digit hyphenated number for identification.¹⁶⁹ R & R competed with Toro by manufacturing and selling compatible replacement parts.¹⁷⁰ When R & R used

¹⁶⁷ 787 F.2d 1208 (8th Cir. 1986).

¹⁶⁸ *Id.* at 1210.

¹⁶⁹ *Id.*

¹⁷⁰ *Id.* By making only the most frequently replaced parts, R & R kept its prices ten to twenty-five percent lower. *Id.* 1210 n.2.

numbers identical to Toro's to refer to its own replacement parts in its catalog, Toro sued for copyright infringement.¹⁷¹ The judge dismissed the copyright claim without letting it go to the jury.¹⁷² The Eighth Circuit affirmed, holding that Toro's numbers were not sufficiently original to be copyrightable.¹⁷³

Although the Eighth Circuit cited the Second Circuit's "more than a 'merely trivial' variation"¹⁷⁴ derivative works test, the court completely failed to discuss if and how Toro's combinations of numbers varied from prior similar schemes. There were at least three noticeable variations. First, Toro limited its sequences of numbers to five or six digits, instead of any lesser or greater combination of numbers. Second, Toro assigned a specific combination of numbers to a specific replacement part, creating a unique correlation.¹⁷⁵ Finally, Toro hyphenated the numbers, introducing a new element into the public domain numerals. Arguably, all of these variations colored Toro's numbering system with a tinge of Toro's "personality." But instead of considering the variations, the Eighth Circuit focused on Toro's motivations and concluded that the numbering system was unoriginal because it lacked a "meaningful pattern"¹⁷⁶ and was composed of random numbers assigned to various parts arbitrarily, "without rhyme or reason."¹⁷⁷

The court's focus on motivations and its insistence that originality requires "rhyme" and "reason" are troubling because they reflect a tinge of judicial bias. After all, are not spontaneity and lack of rational purpose often the essence of creativity? It does not seem likely that the court would have denied the *Mona Lisa* originality had Leonardo DaVinci not been able to explain the reason for Mona Lisa's smile. Yet, the court did require "reason" from Toro's numbering system. As a result, it appears that the court dismissed Toro's originality claim because it inappropriately judged the intrinsic value of Toro's creation, rather than the creation itself.¹⁷⁸ This is exactly the type of a result that Justice Holmes

¹⁷¹ *Id.* at 1210-11. There were other claims not relevant to this discussion which went to the jury.

¹⁷² *Id.* at 1211 (holding that Toro's numbers were an uncopyrightable system).

¹⁷³ *Id.*

¹⁷⁴ *Id.* at 1213 (quoting *Alfred Bell & Co. v. Catalda Fine Arts, Inc.*, 191 F.2d 99, 103 (2d Cir. 1951)). Although Toro's numbering system was not a derivative work within the meaning of the Copyright Act of 1976, it is possible to regard all works as essentially derivative of all that came before them, and to apply to them the originality standard of derivative works. See *supra* notes 85-88 and accompanying text for the discussion of this possibility.

¹⁷⁵ For a discussion of variations in Toro's system see VerSteeg, *supra* note 22, at 868-69.

¹⁷⁶ *Toro*, 787 F.2d at 1213.

¹⁷⁷ *Id.*

¹⁷⁸ See VerSteeg, *supra* note 22, at 870.

warned against,¹⁷⁹ and the reason why this question should have gone to the jury. Although the issue of Toro's parts-numbering system's originality is, admittedly, a close one, a jury verdict would have been a more accurate gauge of how the community would perceive this system.

IV. THE (PREFERABLE) FACT ALTERNATIVE

As the cases surveyed in Parts I and III demonstrated, judging originality is by no means an exact science. Because there are no absolute standards (and it would be impossible to fashion any), there is very little room for objectivity in the methods used to evaluate originality. The decision is almost entirely subjective. The decision maker is asked to reward works which introduce "more than a trivial variation," or to ignore arrangements that are "typical," "garden variety," and so forth.¹⁸⁰ But one man's "trivial" variation is another's substantial one. One woman's creative arrangement is another's cliché. One need only look to Judge Meskill's dissent in *Batlin*,¹⁸¹ or to the divergent results in *Key Publications*¹⁸² and *Bellsouth*,¹⁸³ to see how very similar fact patterns can engender contradictory results, simply because a few judges have a difference of opinion.

The judicial system as a whole puts a premium on bright line rules, predictability, and uniformity. But originality is inherently nebulous, and as such it is extremely poorly suited to judicial adjudication. Yet, if the courts must evaluate originality, the evaluation should not be left in the hands of one person — the solitary judge. Instead, as in the other fields of law where the proper standard hinges on community understanding,¹⁸⁴ jurors should make the decision as often as possible. Jurors are average representatives of their community and personify the multiplicity of opinions within it. Thus, they are more competent to decide this issue.¹⁸⁵ Their consensus decision would not only more accurately reflect the community's appraisal of a particular work, it would also avoid the creeping in of cultural and intellectual bias and snobbery.

¹⁷⁹ For a discussion of Justice Holmes views see *supra* notes 105-06 and accompanying text.

¹⁸⁰ See generally *Feist Publications, Inc. v. Rural Telephone Serv. Co.*, 499 U.S. 340 (1991); *Alfred Bell*, 191 F.2d 99 (2d Cir. 1951); *supra* Part I.

¹⁸¹ *Batlin & Son, Inc. v. Snyder*, 536 F.2d 486, 492 (1976) (Meskill, J., dissenting).

¹⁸² *Key Publications, Inc. v. Chinatown Publ'g Enter., Inc.*, 945 F.2d 509 (2d Cir. 1991).

¹⁸³ *Bellsouth Adver. & Publ'g Corp. v. Donnelley Info. Publ'g, Inc.*, 999 F.2d 1436 (11th Cir. 1993). For the comparison of the *Key Publications* and *Bellsouth* decisions see *supra* notes 130-50 and accompanying text.

¹⁸⁴ See *supra* notes 105-10 and accompanying text.

¹⁸⁵ See *supra* notes 107-10 and accompanying text.

One way of bringing the jury to the forefront of originality adjudication would be to call the issue a "question of fact." This label would not only give the issue to the jury *at trial*, but it would also make it easier for originality to get *to trial*, as it would be harder for the courts to grant motions to dismiss and summary judgments. It would also be harder for appellate courts to substitute their opinions for those of the juries or the trial court judges.

Some critics may argue that giving this issue to the jury would undermine the consistency of originality jurisprudence.¹⁸⁶ But, as this Note has demonstrated, judicial consistency is by no means guaranteed where originality is concerned. Judge Meskill's opinions in *Batlin*¹⁸⁷ and *Durham*¹⁸⁸ are considerable proof of how inconsistent *one* judge can be from one opinion to the next, seemingly applying one standard in one case, and a different one in another. Similarly, *Key Publications*¹⁸⁹ and *Bellsouth*¹⁹⁰ show how different courts can consider the same issue and virtually identical facts, and still arrive at contradictory results.¹⁹¹ Trying to synthesize several courts' opinions into a coherent whole can be a daunting, if not an impossible, task:

While one may not receive protection for structurally recasting Uncle Sam into another sculptural medium, one would receive derivative protection for Uncle Sam miniatures made with exactitude and precision. An oil portrait, taken not from life but from a film, yields no copyrightable work. Full protection, however, may be granted by taking any poster, painting, or movie still and writing at the bottom "Have a Nice Day" or "Put on a Happy Face."¹⁹²

Thus, although judicial verdicts create expectations, they frequently do not meet them, thereby, greatly reducing the predictability value of judicial determinations.

Clearly, if inconsistency of outcomes is an evil, then judicial

¹⁸⁶ See, e.g., *Lotus Dev. Corp. v. Borland Int'l, Inc.*, 788 F. Supp. 78, 95-96 (1992). Courts often prefer to classify complex issues as law because they hope that judicial determination will bring consistency and order to administration of justice. *Id.*

¹⁸⁷ *Batlin & Son, Inc. v. Snyder*, 536 F.2d 486, 492 (1976) (Meskill, J., dissenting).

¹⁸⁸ *Durham Indus., Inc. v. Tomy Corp.*, 630 F.2d 905 (2d Cir. 1980) (Meskill, J., writing for the court).

¹⁸⁹ *Key Publications, Inc. v. Chinatown Publ'g Enter., Inc.*, 945 F.2d 509 (2d Cir. 1991).

¹⁹⁰ *Bellsouth Adver. & Publ'g Corp. v. Donnelley Info. Publ'g Inc.*, 999 F.2d 1436 (11th Cir. 1993).

¹⁹¹ See *supra* Part III.A.

¹⁹² *Page*, *supra* note 35, at 423 (comparing *Batlin*, 36 F.2d 486, *Alva Studios, Inc. v. Winninger*, 177 F. Supp. 265 (S.D.N.Y. 1959) (exact scale replica of Rodin's *Hand of God*), and *American Greetings Corp. v. Kleinfarb Corp.*, 400 F. Supp. 228 (S.D.N.Y. 1975)) (footnotes omitted).

determinations of originality do not abrogate that evil. In fact, they make matters worse because erroneous conclusions become precedent and improperly influence future cases. On the other hand, if juries examine originality and make a mistake, the same mistake cannot be perpetuated because jury verdicts do not have precedential significance.¹⁹³

Yet, some critics add that juries would present an additional (extra-judicial) threat to consistency because they would be free to disregard jury instructions, and reach conclusions contrary to established legal principles.¹⁹⁴ However, judges are not immune from using impermissible considerations to evaluate originality. In *Toro*,¹⁹⁵ for instance, the Eighth Circuit judges failed to apply the variation test properly, and instead allowed their value judgments to control the decision.¹⁹⁶ Likewise, the Second Circuit's opinion in *Batlin* clearly shows that the court was very reticent about finding originality in Snyder's plastic bank because it was a cheap, mass-produced, "kitsch" item, rather than what is traditionally considered "art."¹⁹⁷ The majority snubbed Snyder and his bank because Snyder made many changes for practical, rather than for inspired artistic reasons. In contrast, the court found creativity in the replica of a Rodin sculpture, because of the supposedly greater artistic value of the piece and the skill required to manufacture it.¹⁹⁸ Such elitism is incompatible, however, with the minimalist standard of creativity then prevailing in the Second Circuit, and later mandated by the Supreme Court.¹⁹⁹ Replicas of Rodin pieces may, indeed, be more artistically valuable than copies of Uncle Sam banks or parts-numbering systems, but that evaluation, as Justice Holmes noted,²⁰⁰ is not for judges to make. The elitism and snobbery

¹⁹³ See *Weiner*, *supra* note 102, at 1875.

¹⁹⁴ See *Lotus Dev. Corp. v. Borland Int'l, Inc.*, 788 F. Supp. 78, 95 (D. Mass. 1992). This argument implies a general distrust of juries and that juries are generally incapable of following instructions. Taken to its logical extreme, however, this argument would delegitimize the entire jury system. But because juries are an integral part of the U.S. judicial system, the system, apparently, gives juries more credit. A more thorough discussion of the merits of the jury system is beyond the scope of this Note, but for some pertinent comments see *Louis*, *supra* note 111, at 1008-12.

¹⁹⁵ *Toro Co. v. R & R Products, Co.*, 787 F.2d 1208 (8th Cir. 1986).

¹⁹⁶ See *supra* notes 178-79 and accompanying text.

¹⁹⁷ See *supra* note 158; see also *Batlin* 536 F.2d at 492; *Olson*, *supra* note 9, at 55 (suggesting that the bank was found to be unoriginal because it did not demonstrate "aesthetic excellence").

¹⁹⁸ See *Batlin*, 536 F.2d at 491-92 (discussing with approval *Alva Studios*, 177 F. Supp. 265 (where the court found originality in a scale replica of Rodin's sculpture *The Hand of God*)).

¹⁹⁹ See, e.g., *Alfred Bell & Co. v. Catalda Fine Arts, Inc.*, 191 F.2d 99, 102-03 (2d Cir. 1951), and *Feist Publications, Inc. v. Rural Tel. Serv. Co., Inc.*, 499 U.S. 340, 345 (1991).

²⁰⁰ See *supra* notes 105-06 and accompanying text.

should be avoided, but often they are not. In contrast, jury adjudication would lessen the danger of elitist conclusions.

However, litigants often do not request a jury trial, and trial judges still wind up making a large share of originality determinations either by way of a bench trial or through summary judgment. But even in this scenario, treating originality as a "question of fact" would be preferable. First, the incidence of summary judgments would decrease; an appropriate outcome considering the issue's complexity.²⁰¹ Regardless of whether the judge or the jury is slated to be the ultimate decision-maker in any particular trial, judges would be encouraged to avoid "quickie" summary judgments, and instead to develop fuller records, to give the issue greater consideration, and to allow plaintiffs to present better evidence.²⁰² This would help to reduce the number of questionable results like those reached in *Bellsouth*²⁰³ and *Durham*.²⁰⁴ In both of these cases originality was a "close" issue. However, because it is inappropriate to resolve "close" issues on summary judgment, these issues should have gone to trial.²⁰⁵

Second, treating originality as "question of fact" even in bench trials would reduce the risk of judicial error and bias at the appel-

²⁰¹ See Reynolds, *supra* note 112, at 771 (noting that federal courts often rule out summary judgment "when complex issues are involved," and citing cases).

²⁰² This is particularly relevant considering that a fundamental goal of copyright legislation is to foster creativity. See *Warner Bros. Inc. v. American Broadcasting Cos.*, 720 F.2d 231, 240 (2d Cir. 1983). Plaintiffs may simply not be able to present the best case possible at the summary judgment stage. See, e.g., *Kregos v. Associated Press*, 731 F. Supp. 113, 118 (S.D.N.Y. 1990) (summary judgment granted against plaintiff because the court found that plaintiff did not adequately rebut defendant's evidence). But, authors should not be denied the fruits of their labor, even if their works only barely pass the minimum threshold of creativity, just because they are unable to mount the best possible case early on during litigation. Otherwise, there may not be incentive for future creative work. This result would also be more compatible with the goal of fostering creativity through copyright laws.

²⁰³ *Bellsouth Adver. & Publ'g Corp. v. Donnelley Info. Publ'g Inc.*, 999 F.2d 1436 (11th Cir. 1993).

²⁰⁴ *Durham Indus. v. Tomy Corp.*, 630 F.2d 905 (2d Cir. 1980).

²⁰⁵ See *supra* note 116 and accompanying text. On at least two occasions two different courts recognized the impropriety of dismissing complex originality disputes on summary judgment, and treated originality as a "question of fact." In *Kregos v. Associated Press*, 937 F.2d 700 (2d Cir. 1991), the Second Circuit reversed a grant of summary judgment in favor of Associated Press, which was accused of infringing plaintiff's pitching forms. In compiling his pitching forms plaintiff selected nine categories of statistics to describe a baseball pitcher's performance. The Second Circuit refused to rule that such selection of nine items from a "universe of data" was unoriginal as a matter of law. Likewise, in *North Coast Indus. v. Jason Maxwell, Inc.*, 972 F.2d 1031 (9th Cir. 1992), the Ninth Circuit also reversed a grant of summary judgment against the plaintiff. In *North Coast*, defendant allegedly copied plaintiff's geometric design for women's pullover tops. Plaintiff's design was admittedly influenced by the works of the painter Mondrian and the trial court ruled that plaintiff's variations on the painter's theme were too trivial to be called original. The Ninth Circuit reversed because it believed that it was inappropriate for a court to act as an art critic. The court held that this issue should have been resolved by the fact-finder. See *supra* note 106 and accompanying text.

late level. On the one hand, if there is a danger that one judge's cultural bias will color the results at trial level, the danger triples (at least) when the claim reaches the appellate bench where there is great potential for several judges with similar educational backgrounds to reinforce each other's bias, thus producing an even more questionable result. On the other hand, as with most other issues, the trial court, rather than the appellate court, is better positioned to evaluate witness testimony and to draw inferences from both spoken and demeanor evidence.²⁰⁶ A judge's conclusion drawn from first-hand observations not only of the evidence but also of the evidence's effect on the parties and others present in the courtroom, would be more accurate than inferences drawn by appellate judges far removed from the trial environment.

Here, opponents may interject that appellate judges are in as good a position as the trial judge to evaluate originality when the case is based solely on documentary evidence, and should, therefore, be able to review the evidence *de novo*. This argument is flawed. Rule 52(a) of the *Federal Rules of Civil Procedure* clearly states that a trial judge's findings of facts must be reviewed under the clearly erroneous standard "whether based on oral or documentary evidence."²⁰⁷ The Rule clearly exhibits a preference for fact-finding at the trial level and the Supreme Court concurs, particularly when the trial judge has lived with the case for any appreciable length of time.²⁰⁸

The preference is reasonable because it encourages efficient allocation of judicial resources. When appellate courts treat originality as a "question of law" and review all the evidence *de novo*, they wind up duplicating the trial judge's fact-finding, which results in delays and an enormous waste of judicial resources. (In addition, this duplicative review has the potential to undermine the trial court's credibility.)²⁰⁹ *Bellsouth*²¹⁰ is a good example. The *Bellsouth* majority gave virtually no deference to the trial judge's conclusions, dismissing them almost entirely, and performed a *de novo* review of the evidence sitting as, essentially, another trial

²⁰⁶ See, e.g., George C. Christie, *Judicial Review of Findings of Fact*, 87 Nw. U. L. Rev. 14, 49 (1992).

²⁰⁷ FED. R. CIV. P. 52(a) (emphasis added).

²⁰⁸ See *Bose Corp. v. Consumers Union of the United States, Inc.*, 466 U.S. 485, 500 (1984); see also Louis, *supra* note 111, at 1002 (commenting on the Supreme Court's efforts to protect trial judges' fact-finding).

²⁰⁹ See Reynolds, *supra* note 112, at 769-70, 773 (discussing similar concerns in the context of "substantial similarity" inquiry in trademark law).

²¹⁰ See *Bellsouth Adver. & Publ'g Corp. v. Donnelley Info. Publ'g Inc.*, 999 F.2d 1436 (11th Cir. 1993).

court.²¹¹ This is exactly the kind of waste of judicial resources that should be avoided. In contrast, if appellate courts treat originality as a "question of fact," give trial judges due deference, and abstain from reevaluating the entire factual record, they may make adjudication more efficient by both simplifying and shortening the appeals process and encouraging settlements.²¹²

Of course, treating the issue as one of fact will not completely remove the power of review from the appellate bench. Jury instructions, as statements of the law, will still be reviewable *de novo*, and any jury verdicts based on incorrect instructions will have to be remanded for correction. In especially complicated cases, jurors could also be required to answer interrogatories or to render special verdicts, allowing appellate courts to gain insight into the jury's reasoning. Jury verdicts based on a misunderstanding of the law could then be reversed and remanded as well. Clearly, in the "question of fact" world, the jury would have a lot of power over originality determinations. But the jury would not be completely left to its own devices. Judges, on both the trial and appellate level, would retain procedural control.²¹³

In conclusion, originality is such an argumentative issue that it probably should never be examined in the courts because of its subjective nature. However, if originality must become a key element of copyright litigation, its final arbiter, as often as possible, should be the jurors — members of the community for whom, ultimately, authors create. Treating originality as a "question of fact" is the simplest way to ensure that jurors will, in fact, decide the fate of new works, and that appellate judges will not be able to substitute their judgments for the conclusions reached in trial court. If anyone must make a subjective "artistic" judgment, let this judgment reflect the community's values and understanding, rather than the opinion of judges who have little more than personal taste and some very subjective rules to rely upon.

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²¹¹ *Id.* at 1471 (Hatchett, J., dissenting).

²¹² See *supra* Part II.

²¹³ For instance, summary judgment or judgment as a matter of law, although inappropriate in most cases, will still be available to throw out of court the "obviously" unoriginal works—for example, an alphabetized white page directory.

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