Feist Reconsidered

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Whether copyright in phone directory white pages covers facts comprising customers' names, towns, and telephone numbers is not particularly earth-shaking. Yet, in resolving the question, Feist Publications, Inc. v. Rural Telephone Service Company, Inc, 499 U.S. 340, 344 (1991), has had a major effect on copyright law, and perhaps beyond.

Before considering the opinion, however, consider the origin of such directories. If telephone franchises are conditioned on their publication, as is surely true, are they "authored" by utility commissions or by phone companies? Because Art. I § 8 cl. 8 and the Copyright Act protect only "authors" and works of "authorship," the Court might have disposed of the case on those grounds.

It did not. The *Feist* opinion first, 499 U.S. at 346, finds support for a long-standing aversion to protecting facts, as such, in the Constitution and, only later, 499 U.S. at 355, in 17 U.S.C. § 102. The opinion then, 499 U.S. at 355, reconciles that aversion with 17 U.S.C. § 103, which protects compilations. In doing so, it seizes upon originality instead of authorship. This is peculiar because Art I § 8 cl. 8 and the two statutory provisions each refer to "authors" or "authorship." Yet, only § 102 mentions originality — and then, only in phrases linked to authorship. Thus, support for an authorship requirement would have been easier — particularly in light of the facts before the Court.

Given the lack of need, it is also remarkable that the opinion considers the Constitution at all, much less before turning to the Act. That approach seems incompatible with the case or controversy requirement. It is certainly at odds with the proposition that, if possible, constitutional issues are to be avoided, U.S. v. Rumely, 345 U.S. 41, 45 (1953). Signaling a limit to congressional power to protect unoriginal works was at best premature. Moreover, should that be necessary, the outcome

would be less than certain under the deferential rational basis test applied in Eldred v. Ashcroft, 537 U.S. 186, 204 (2003).

Nevertheless — presumably motivated by *Feist* — the Copyright Office seems sometimes to apply a standard that might be more apt for design patents. Consider, for example, Paul Morelli Design, Inc. v. Tiffany and Co., 200 F.Supp.2d 482 (E.D. Pa. 2002). After jewelry was refused copyright registration for lack of originality, infringement was nevertheless urged as permitted by § 411(a) — a section further discussed in my article, "Judicial Review of Copyright Examination," 44 IDEA 479, 504 (2004).

Ralph Oman, the former Register, was prepared to testify on plaintiff's behalf. Had that been permitted, Marybeth Peters, the current Register, intended to join the fray — something also permitted by § 411(a). Perhaps sensing that she has better ways to use her time, the court did not permit Oman to testify. Whether such testimony would have aided the jury is unclear. In any event, based on an unreported jury charge, it, too, found the jewelry to lack originality.

A second telling example is presented by Re Learning Curve Toys (Aug. 11, 1999) — justifying a refusal by the Copyright Board of Appeals to register three of nine toys. Even as a compilation, the Board's opinion recites, at 7, that: "[a]ny compilation consisting of less than *four selections* is considered to lack the requisite authorship." [Emphasis added.] That language is noteworthy for its reference to authorship rather than originality, but the distinction may make no difference in that context.

Learning Curve is perhaps more noteworthy because its four-points-of novelty-test, derived from Copyright Compendium II § 307.01, is facially applicable only to nondramatic literary works. That might be apt for, e.g., a compilation of haiku but far less so in other contexts. For example, should a public domain poem set to a folk tune be refused copyright?

Ultimately, *Feist* states, 499 U.S. at 364: “Given that some works must fail, we cannot imagine a more likely candidate. Indeed, were we to hold that Rural’s white pages pass muster, it is hard to believe that any collection of facts could fail.”

It seems unfortunate that such a slender reed could result in making objective, rather than subjective, novelty the test for either authorship or originality. That is particularly compelling insofar as the Office’s fact-finding capacity to evaluate such matters is at best limited.