

COPYRIGHT—COMPILATIONS OF FACTS—The selection of statistics in a baseball outcome predictive pitching form is within the subject matter of copyright. *Kregos v. Associated Press*, 937 F.2d 700 (2d Cir. 1991).

The Copyright Act of 1976¹ (Act) authorized copyright protection to original works fixed in a tangible form.² A copyright grants the exclusive right to copy the copyrighted work and a right to bar others from copying it.³ Copyright protection extends only to the ex-

1. Act of Oct. 19, 1976, Pub. L. No. 94-553, 90 Stat. 2572 (current version at 17 U.S.C. § 101 (1988)). See also *Roy Export Co. Estab. of Vaduz v. Columbia Broadcasting*, 672 F.2d 1095, 1101 (2d Cir. 1982), cert. denied, 459 U.S. 826 (1982) (stating that “the owner [of a work] secures federal protection by complying with the requirements of the . . . Act; if he does not, his published work is in the public domain”).

2. 17 U.S.C. § 102(a) (Supp. 1990). Section 102 provides in part that “copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device.” *Id.*; L. Ray Patterson & Craig Joyce, *Monopolizing the Law: The Scope of Copyright Protection for Law Reports and Statutory Compilations*, 36 UCLA L. Rev. 719, 757-66 (1989).

In the context of copyright law, original “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 minimal degree of creativity.” *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 111 S. Ct. 1282, 1287 (1991) (citing MELVILLE B. NIMMER & DAVID NIMMER, COPYRIGHT §§ 2.01 [A], [B] (1990)) [hereinafter NIMMER]. See also *Victor Lalli Enters., Inc. v. Big Red Apple, Inc.*, 936 F.2d 671, 674 (2d Cir. 1991) (rejecting the “sweat of the brow” test, which grants copyright protection “based on the effort or energy expended by the compiler of directories or other fact based works . . .”); *Toro Co. v. R & R Products Co.*, 787 F.2d 1208, 1212 (8th Cir. 1986); Dale P. Olson, *Copyright Originality*, 48 Mo. L. Rev. 29, 32-35 (1983).

“A work is ‘fixed’ in a tangible medium of expression when its embodiment in a copy or phonorecord, by or under the authority of the author, is sufficiently permanent or stable to permit it to be perceived, reproduced, or otherwise communicated for a period of more than transitory duration.” 17 U.S.C. § 101.

3. *Alfred Bell & Co. v. Catalda Fine Arts*, 191 F.2d 99, 105 (2d Cir. 1951). See also 17 U.S.C. § 106 (1976 & Supp. 1990). Section 106 of the Act states, in pertinent part, that the owner of copyright under this title has the exclusive right to do and to authorize any of the following:

- (1) to reproduce the copyrighted work in copies or phonorecords;
- (2) to prepare derivative works based upon the copyrighted work;
- (3) to distribute copies or phonorecords of the copyrighted work to the public by sale or other transfer of ownership, or by rental, lease, or lending;
- (4) in the case of literary, musical, dramatic, and choreographic works, pantomimes, and motion pictures and other audiovisual works, to perform the copyrighted work publicly; and
- (5) in the case of literary, musical, dramatic, and choreographic works, pantomimes, and pictorial, graphic, or sculptural works, including the individual

pression of an idea and does not afford protection to the idea itself.⁴ Ideas are protected under patent law.⁵

Generally, fact compilations are also entitled to copyright protection if the selection and arrangement of the facts were independent and creative.⁶ The facts compiled, however, are not protected and a subsequent compiler is free to employ the facts in a different compi-

images of a motion picture or other audiovisual work, to display the copyrighted work publicly.

Id.

4. *Alfred Bell*, 191 F.2d at 102. The court in *Alfred Bell* explained that [t]he claim to an invention or discovery of an art or manufacture must be subjected to the examination of the Patent Office before an exclusive right therein can be obtained; and it can only be secured by a patent from the government. The difference between the two things, letters-patent and copyright, may be illustrated by reference to the subjects just enumerated. Take the case of medicines. Certain mixtures are found to be of great value in the healing art. If the discoverer writes and publishes a book on the subject . . . he gains no exclusive right to the manufacture and sale of the medicine; he gives that to the public. If he desires to acquire such exclusive right, he must obtain a patent for the mixture as a new art, manufacture, or composition of matter. He may copyright his book, if he pleases; but that only secures to him the exclusive right of printing and publishing his book.

Id. Section 102 of the Act further provides 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) (1976).

5. *Id.* See *supra* notes 2 and 4 and accompanying text.

6. A compilation is defined as 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." 17 U.S.C. § 101. By enacting copyright laws, Congress "promote[s] the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries." U.S. CONST. art. I, § 8, cl. 8.

Section 103 of the Act provides in pertinent part that

[t]he copyright in a compilation or derivative work extends only to the material contributed by the author of such work, as distinguished from the preexisting material employed in the work, and does not imply any exclusive right in the preexisting material. The copyright in such work is independent of, and does not affect or enlarge the scope, duration, ownership, or subsistence of, any copyright protection in the preexisting material.

17 U.S.C. § 103(b) (1976).

The threshold level of the required creativity is easily exceeded. *Feist*, 111 S. Ct. at 1287. "The vast majority of works make the grade easily, as they possess some creative spark, 'no matter how crude, humble or obvious' it might be." *Id.* (quoting *NIMMER*, *supra* note 2, § 1.08 [C] [1]).

"A factual compilation is eligible for copyright if it features an original selection or arrangement of facts, but the copyright is limited to the particular selection or arrangement. In no event may copyright extend to the facts themselves." *Feist*, 111 S. Ct. at 1290. *E.g.*, *Eckes v. Card Prices Update*, 736 F.2d 859 (2d Cir. 1984); see *supra* note 2.

lation.⁷ Accordingly, copyright protection in a compilation is thin.⁸ Recently, the Second Circuit United States Court of Appeals, in *Kregos v. Associated Press*,⁹ ruled that the extent of originality and creativity in a pitching form presents a triable issue of fact.¹⁰

In 1982, plaintiff, George L. Kregos, designed a pitching form that was published in subscribing newspapers the following year.¹¹ The pitching form exhibits statistics of the past performances of the opposing pitchers scheduled to appear in upcoming games.¹² In 1984,

7. *Feist*, 111 S. Ct. at 1289. The court stated that "notwithstanding a valid copyright, a subsequent compiler remains free to use the facts contained in another's publication to aid in preparing a competing work, so long as the competing work does not feature the same selection and arrangement." *Id.* at 1289.

8. *Id.*

9. 937 F.2d 700 (2d Cir. 1991).

10. *Id.* at 702. See *Financial Info. v. Moody's Investors Serv.*, 808 F.2d 204 (2d Cir. 1986), *cert. denied*, 484 U.S. 820 (1987); *Harcourt, Brace & World, Inc. v. Graphic Controls Corp.*, 329 F. Supp. 517 (S.D.N.Y. 1971). See also *infra* notes 11, 12, 15 and accompanying text.

11. *Kregos v. Associated Press*, 731 F. Supp. 113, 114 (S.D.N.Y. 1990). On June 25, 1985, Kregos received a copyright for the computer software that generated the pitching form. *Id.* at 114 n.2. A year later, Kregos received another copyright for the physical form and accompanying legend explaining the categories of statistics. *Id.* A copyright on a work creates only a rebuttable presumption of validity. *Id.* at 117. Kregos derived the 1983 form at issue here from a 1970 design. *Id.* at 114. Moreover, the 1983 Kregos form continues to be published. *Id.*

12. *Kregos*, 937 F.2d at 702.

The 1983 Kregos form is comprised of the following statistics:

category	column#	name of statistic
	1*	-name of teams
	2*	-scheduled pitchers
	3*	-game time
	4*	-odds
1. For current season	5	-wins/losses (W/L)
	6	-earned run average (ERA)
2. Against the opposing pitcher at particular site of the game for pitcher's entire career	7	-W/L
	8	-innings pitched (IP)
	9	-ERA
3. For last 3 starts	10	-W/L
	11	-IP
	12	-ERA
	13	-men on base average (MBA)

Kregos, 731 F. Supp. at 114, 115 (see Appendix 1). The symbol "*" denotes that the statistic is not at issue in *Kregos*. *Id.* Facts or the "categories of information concerning each day's game" in columns one through four are not eligible for copyright protection. *Kregos*, 937 F.2d at 702. See also *Feist Publications, Inc., v. Rural Tel. Serv. Co.*, 111 S. Ct. 1282, 1287 (1991); *Financial Information*, 751 F.2d at 504. ERA includes only the average number of earned runs per nine innings "attributable to the pitcher and not his teammates' errors." *Kregos*, 731 F. Supp. at 115 n.3. Kregos argued that the MBA statistic is the heart of the Kregos 1983 pitching form. Brief for Appellant at 12, *Kregos v. Associated Press*, 937 F.2d 700 (2d Cir. 1991) (No. 90-7469). Specifically, Kregos contends that according to his subjective judgment

the Associated Press (AP) published a similar pitching form.¹³ Co-defendant Sports Features Syndicate, Inc. (Sports Features) amassed the statistics for the 1984 AP form.¹⁴ The 1983 Kregos form and the 1984 AP form essentially contain the same statistics.¹⁵

Kregos requested that AP terminate publication of the competing form.¹⁶ When AP refused to comply, Kregos filed a complaint alleging both copyright infringement of the compilation of selected statistics displayed in the 1983 Kregos form pursuant to the Act and trademark infringement for false designation of origin pursuant to Section 43(a) of the Lanham Act seeking declaratory, injunctive and monetary remedies.¹⁷ Kregos and AP then made cross-motions for

[t]he MBA statistic interrelates with the ERA statistic to result in a better overview of a pitcher's current performance. For example, while the ERA . . . statistic informs a subscriber of how many runs are being scored off a pitcher during the course of a nine inning game, the MBA statistic informs a reader how many men are reaching base against a given pitcher within the course of a nine inning game. Kregos himself considers his MBA statistic to be more revealing than the ERA statistic in that it demonstrates to what extent a pitcher has exposed himself to trouble even if no runs or few runs have been scored A comparison between these statistics might inform a reader that many runs are being scored off a pitcher and many players are reaching base, or that few runs are being scored off a pitcher but many men are reaching base

. . . . Moreover, since both the MBA and ERA statistics are calculated over a pitcher's last three starts in Kregos' current form, the combined and interrelated information conveyed by the MBA and ERA statistic is purposefully focused on only the current performance of a pitcher.

Id. at 12-13.

13. *Kregos*, 731 F. Supp. at 115. AP and Sports Features, however, redesigned their pitching form in 1986. *Id.* Specifically, AP's 1986 form included a new statistic, team record (TEAM REC), in the first category of the Kregos 1983 form. *Id.* See *supra* note 12 and accompanying text. TEAM REC represents "the team's record in games started by the particular pitcher during the specific season." *Id.* In addition, AP now compiles the statistics in the second category of the Kregos form against the opposing pitcher regardless of the situs of the game and for only the current season. *Id.*

14. *Id.*

15. *Id.* There are, however, slight differences between the Kregos and AP forms. *Id.* The AP form contains two renamed categories. *Id.* First, the "MBA" statistic was described as "average hits and walks per game (AHWG)." *Id.* Second, the "odd" statistic was identified under "line" in the AP form. *Id.* In addition, the Kregos form contained an explanation and analysis of the statistics that was slightly more detailed than the AP form. *Id.* See *Weissmann v. Freeman*, 868 F.2d 1313, 1321 (2d Cir. 1989), *cert. denied*, 493 U.S. 883 (1989) (discussing protection of derivative works); 17 U.S.C. § 101 (Supp. 1988) (defining derivative work as "based upon one or more preexisting works . . ."); Michael F. Bowman, Comment, *The Second Circuit's Analysis of Derivative Works by Joint Authors: Good Law - Poor Application*, 56 BROOK. L. REV. 551 (1990).

16. *Kregos*, 731 F. Supp. at 115.

17. *Id.* at 116. Infringement is established by proving that the defendant had "access to the copyrighted work and a substantial similarity [exists] between the two works." Business

summary judgment.¹⁸ The district court, citing *Financial Information, Inc. v. Moody's Investors Service*,¹⁹ first granted summary judgment in favor of AP with regard to the copyright claims, because the Kregos pitching form was insufficiently original and creative as most statistics had appeared in previously existing forms.²⁰ On appeal, however, the Second Circuit reversed the judgment of the district court.²¹

Other jurisdictions which have previously examined the issue of whether a compilation is entitled to copyright protection include the Eastern District of Illinois in *Rand McNally & Co. v. Fleet Management Systems, Inc.*²² The court in *Rand McNally* concluded that a "Mileage Guide" appearing on a particular map containing a collection of mileages between principal cities was protected under the copyright laws as a compilation.²³ The court further noted that *Rand McNally* was not required to be the discoverer of the mileages contained in the mileage table data of the map as a prerequisite to protection.²⁴

Trends Analysts v. Freedomia Group, Inc., 887 F.2d 399, 402 (2d Cir. 1989). See *Stormy Clime LTD. v. ProGroup, Inc.*, 809 F.2d 971, 974 (2d Cir. 1987).

18. *Kregos*, 731 F. Supp. at 116. See *Walker v. Time Life Films, Inc.*, 784 F.2d 44, 48 (2d Cir. 1986), cert. denied, 476 U.S. 1159 (1986) (discussing when a court may determine issue of copyright infringement on motion for summary judgment).

19. 751 F.2d 501 (2d Cir. 1984), cert. denied, 484 U.S. 820 (1987) (rejecting copyright protection to a publisher of Daily Bond Cards, which listed five statistics on certain redeemable municipal bonds). See *infra* note 38.

20. *Kregos*, 731 F. Supp. at 118. Examples of preexisting pitching forms include the Siegel 1978 form and the Eckstein 1981 form. *Kregos v. Associated Press*, 937 F.2d 700, 703-04 (2d Cir. 1991). See *Durham Indus., Inc. v. Tomy Corp.*, 630 F.2d 905, 911 (2d Cir. 1980) (recognizing that although the question of copyright infringement is generally a question of fact, there are instances where summary judgment is appropriate if similarity encompasses noncopyrightable material); *Hoehling v. Universal City Studios, Inc.*, 618 F.2d 972, 977, 979-80 (2d Cir. 1980), cert. denied, 449 U.S. 841 (1980); *Harcourt, Brace & World, Inc. v. Graphic Controls Corp.*, 329 F. Supp. 517, 521 (S.D.N.Y. 1971). See also *supra* note 18.

21. *Kregos*, 937 F.2d at 702. The court noted that the "prior publication of some of the statistics on Kregos' form might indicate . . . that his selection [was] not sufficiently different from those grouped in earlier publications to satisfy minimal creativity." *Id.* at 705. See *Victor Lalli Enters., Inc. v. Big Red Apple, Inc.*, 936 F.2d 671, 673 (2d Cir. 1991) (stating that clearly erroneous standard is employed to review district court's determination of whether work is sufficiently original to warrant copyright protection); cf. *Worth v. Selchow & Righter Co.*, 827 F.2d 569 (9th Cir. 1987), cert. denied, 485 U.S. 977 (1988) (holding that summary judgments in copyright infringement actions are reviewed de novo).

22. 600 F. Supp. 933 (E.D. Ill. 1984), *reh'g denied*, 634 F. Supp. 604 (E.D. Ill. 1986). See *Eckert v. Hurley Chicago Co.*, 638 F. Supp. 699 (N.D. Ill. 1986) (stating that in plaintiff's brochure the facts are not copyrightable, but the arrangement and presentation of the facts are protectable elements).

23. *Rand McNally*, 600 F. Supp. at 939.

24. *Id.* at 935.

The Seventh Circuit confronted this issue in *Illinois Bell Telephone Co. v. Haines & Co.*²⁵ shortly before the United States Supreme Court in *Feist Publications, Inc. v. Rural Telephone Service Co.*²⁶ In *Illinois Bell*, a telephone company brought a copyright infringement action against a telephone directory publisher alleging that the publisher copied its white pages.²⁷ Relying on the publishing company's admission that it had consulted Illinois Bell's directory in producing its directory, the court affirmed the infringement ruling.²⁸ Furthermore, the court found that the directory's white pages contained sufficient originality warranting a finding of copyright protection.²⁹ *Feist*, however, has effectively overruled *Illinois Bell*.³⁰

The Eighth Circuit in *Hutchinson Telephone Co. v. Fronteer Directory Co.*,³¹ has also discussed the issue of whether the white page listings are copyrightable compilations of facts.³² Plaintiff Hutchinson was granted a monopoly to operate a telephone company in the State of Minnesota.³³ By its charter, plaintiff was required to publish a telephone book.³⁴ The Eighth Circuit reversed the district court and held that Hutchinson was entitled to a copyright to protect its white page directory because it was an original work within the meaning of the Act.³⁵ The district court, however, reasoned that the

25. 905 F.2d 1081 (7th Cir. 1990), *cert. granted and judgment vacated*, 111 S. Ct. 1408 (1991).

26. 111 S. Ct. 1282 (1991). *See infra* notes 38-41 and accompanying text.

27. *Illinois Bell*, 905 F.2d at 1084.

28. *Id.* at 1086. *Cf.* *Hutchinson Tel. Co. v. Fronteer Directory Co. of Minn.*, 586 F. Supp. 911, 913 (D. Minn. 1984), *rev'd*, 770 F.2d 128 (8th Cir. 1985) (district court held that when a telephone company was required by law to publish white pages in a directory, the work would not constitute an "original work of authorship" and no copyright protection was available).

29. *Illinois Bell*, 905 F.2d at 1085. The *Illinois Bell* court reasoned that [a]s to originality, where a telephone directory is assembled from data collected and constantly revised by the telephone company, courts consistently have held that such a directory is copyrightable. It is evident that a directory compiled by a telephone company from its internally maintained records may be said to be independently created.

Id. at 1086.

30. *See infra* notes 38-41 and accompanying text. *Cf.* *Konor Enters., Inc. v. Eagle Publications Inc.*, 878 F.2d 138 (4th Cir. 1989) (upholding a copyright infringement claim instituted by a publisher of a military telephone directory).

31. 770 F.2d 128 (8th Cir. 1985).

32. *Id.* *See Sem-Torq, Inc. v. K-Mart Corp.*, 936 F.2d 851 (6th Cir. 1991).

33. *Hutchinson Tel. Co. v. Fronteer Directory Co.*, 586 F. Supp. 911, 913 (D. Minn. 1984), *rev'd*, 770 F.2d 128 (8th Cir. 1985).

34. *Hutchinson*, 586 F. Supp. at 913.

35. *Hutchinson*, 770 F.2d at 133. *Cf.* *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 111 S. Ct. 1282 (1991). *See supra* note 2 defining an original work and *infra* note 39 and accompanying text.

directory was unoriginal because Hutchinson was required by law to publish its white pages.³⁶ Moreover, the circuit court rejected the lower court's ruling that copyright protection would unjustifiably extend the Hutchinson telephone monopoly.³⁷

As discussed above lower courts had previously addressed the question of the extent of copyright protection for compilations of facts, however, it was only recently that the Supreme Court reconsidered same in *Feist Publications, Inc. v. Rural Telephone Service Co.*³⁸ In *Feist*, the Court held that telephone book white pages were

36. *Hutchinson*, 586 F. Supp. at 913. The district court reasoned that "the purposes of the Copyright Act— to encourage works of intellect and to secure the general benefits which inure to the public through the author's labors— could not be served by granting Hutchinson copyright protection." *Id.* The Court of Appeals for the Eighth Circuit disapproved and stated that

[t]he proper focus is not whether Hutchinson's sole motivation for maintaining the records is the publication of a directory, but whether the directory itself is derived from information compiled and generated by Hutchinson's efforts. That Hutchinson alone, solicited, gathered, filed, sorted, and maintained the information on which the directory is based is undisputed. The fact that Hutchinson requires its subscribers to supply the information in the directory under a state requirement is irrelevant: a telephone company would find it necessary to gather such information irrespective of any state-mandated requirement, if for no other reason, than to bill customers for services provided.

Hutchinson, 770 F.2d at 131-32.

37. *Id.* at 132-33. The Court of Appeals reasoned that the District Court's conclusion ignores the fact that whatever monopoly power Hutchinson has is circumscribed by pervasive state regulation of its policies, service, and pricing. The revenue Hutchinson earns from its copyrighted directories is considered by the state in setting Hutchinson's telephone rates. Thus, to afford copyright protection for Hutchinson's white pages directory hardly can be said to "extend" Hutchinson's monopoly in a manner contrary to the public interest. Indeed, to the extent that higher directory revenues result in lower rates for telephone service, copyright protection for Hutchinson's directories tends to serve the public interest.

Id.

38. 111 S. Ct. 1282 (1991). Before the Copyright Act of 1909, some courts misapplied the statute and erroneously concluded that compilations were copyrightable per se because it was listed in the statute as a possible copyrightable work. *E.g.*, *Leon v. Pacific Tel. & Tel. Co.*, 91 F.2d 484 (9th Cir. 1937); *Jeweler's Circular Publishing Co. v. Keystone Publishing Co.*, 281 F. 83 (2d Cir. 1922), *cert. denied*, 259 U.S. 581 (1922); *Olson*, *supra* note 2, at 42-46.

In *Eckes v. Card Prices Update*, 736 F.2d 859, 863 (2d Cir. 1984), the court held that a guide containing a comprehensive listing of baseball cards and its current market price is protected under the copyright laws, because the creator exercised "selection, creativity, and judgment in choosing among the 18,000 or so different baseball cards in order to determine which were the 5,000 premium cards." The same court in *Financial Info. v. Moody's Investors Serv.*, 808 F.2d 204 (2d Cir. 1986), *cert. denied*, 484 U.S. 820 (1987), denied copyright protection to a publisher of Daily Bond Cards, which listed five statistics on certain redeemable municipal bonds. Specifically, the court in *Financial* reasoned that there was insufficient proof of originality and creativity to render the Daily Bond Cards copyrightable. *Financial*, 808 F.2d at 208. "The researchers had five facts to fill on each card—nothing more and nothing less. They some-

not protected under copyright even though the author independently assembled the names, because the compilation did not satisfy the requirement of creativity as the selection of listings "could not be more obvious . . . [and] there is nothing remotely creative about arranging names alphabetically. . . . It is not only unoriginal, it is practically inevitable."³⁹ Although an author of a compilation of fact may have selected and arranged the facts independently satisfying the originality requirement, the compiler must also demonstrate that the compilation embraces "some minimal level of creativity."⁴⁰ Because of the prevalent existence of alphabetically arranged telephone white page directories in communities, the court declared as a matter of law the white pages lacked the requisite creativity.⁴¹

After the United States Supreme Court resolved the issue of the copyrightability of white pages, the lower courts then embarked on the resolution of whether the yellow pages in a directory are entitled to protection.⁴² In *Bellsouth Advertising & Publishing Corp. v. Donnelley Information Publishing Inc.*,⁴³ a publisher of a yellow pages directory filed suit against another publisher for copyright infringement, trademark infringement and unfair competition.⁴⁴ It was undisputed that the defendant had copied from the Bellsouth yellow page directory directly onto lead sheets and then into the Donnelley directories.⁴⁵ The court also relied on the presence of common errors between the two directories to find "copying" of the Bellsouth directory.⁴⁶ The court rejected the defendant's fair use defense because

times did minor additional research in order to find these facts, but little 'independent creation' was involved." *Id.* The court in *Kregos* advocated that the *Kregos* form "falls between the extremes illustrated by *Eckes* and *Financial*." *Kregos v. Associated Press*, 937 F.2d 700, 704 (2d Cir. 1991). See also *supra* notes 6 and 12 discussing copyrightability of facts.

39. *Feist*, 111 S. Ct. at 1296-7. But cf. *Dow Jones & Co. v. Board of Trade of City of Chicago*, 546 F. Supp. 113 (S.D.N.Y. 1982) (holding that compilation of stock market indexes was entitled to copyright protection because of the effort, selectivity and judgment exercised in their composition, and the nonfunctional purposes to which the indexes were put).

40. *Feist*, 111 S. Ct. at 1288. "The selection and arrangement of facts cannot be so mechanical or routine as to require no creativity whatsoever." *Kregos*, 937 F.2d at 704.

41. *Feist*, 111 S. Ct. at 1297.

42. See *Bellsouth Advertising & Publishing Corp. v. Donnelley Info. Publishing, Inc.*, 719 F. Supp. 1551 (S.D. Fla. 1988), *aff'd*, 933 F.2d 952 (11th Cir. 1991).

43. *Id.* Cf. *Key Publications, Inc. v. Chinatown Today Publishing Enters., Inc.*, 945 F.2d 509 (2d Cir. 1991) (holding that yellow page directory for Chinese American businesses was entitled to copyright protection but defendant's directory did not infringe).

44. *Bellsouth*, 719 F. Supp. at 1553.

45. *Id.* at 1555. Donnelley did not dispute the validity of Bellsouth's copyright registration for its directory. *Id.* at 1553.

46. *Id.*

there was extensive copying.⁴⁷ Lastly, with regards to the copyright infringement claim, the court granted summary judgment in favor of Bellsouth.⁴⁸

The Second Circuit Court of Appeals in *Kregos*, upon examination of *Feist*, determined that the issues of originality and creativity could not be resolved as a matter of law because the record is devoid of a "prior form that is identical to [Kregos'] nor one from which his varies in only a trivial degree."⁴⁹ Because the exact selection of statistics in the 1983 Kregos form cannot be found in the earlier pitching forms, the Second Circuit determined that the district court erred

47. *Bellsouth*, 719 F. Supp. at 1560-61. The court summarized the fair use defense as follows:

The fair use defense is summarized as a narrow exception to the Copyright Act which permits the use of copyrighted material under certain circumstances without the owner's consent. Fair use is an equitable rule of reason which must be decided on a case-by-case basis. The burden is on Donnelley, the party asserting it.

. . . The Copyright Act . . . lists four factors which should be considered in evaluating whether a particular use is fair. These are:

(1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit education purposes;

(2) the nature of the copyrighted work;

(3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and

(4) the effect of the use upon the potential market for or value of the copyrighted work.

Id. at 1560. (citations omitted). See also *Association of Am. Medical Colleges v. Cuomo*, 928 F.2d 519 (2d Cir. 1991), *cert. denied*, 112 S. Ct. 184 (1991); *New Era Publications Int'l v. Carol Publishing Group*, 904 F.2d 152 (2d Cir. 1990), *cert. denied*, 111 S. Ct. 297 (1990).

48. *Bellsouth*, 719 F. Supp. at 1558. The court found that the Bellsouth directory was an original and creative work because Bellsouth performed acts of selection, coordination, and arrangement. *Id.* at 1557. The court stated that

[Bellsouth] performs various acts of selection which contribute to the publication of the directory. These acts include selection of the geographical area to be covered by a directory; selection of the number of free listings to be provided; selection of the requirement that businesses use business telephone service in order to advertise in the [Bellsouth] directory; selection by the sales force of the headings which will be available for a particular directory; selection of the headings under which an advertiser's listing will appear; selection of the criteria under which advertisers may or may not be permitted to advertise under headings not related to their business; selection of free listings to be provided telephone subscribers; selection of customers who will be contacted by premise sales personnel, telephone sales personnel and no contact; selection of the date of commencement of sales campaign; and selection of the date of closing the directory.

Id. at 1557-58. (citations omitted).

The court also found in favor of the plaintiff Bellsouth with respect to the trademark infringement and unfair competition claims by denying defendant's motions for summary judgment. *Id.* at 1569.

49. *Kregos v. Associated Press*, 937 F.2d 700, 705 (2d Cir. 1991). See *Past Pluto Prods. Corp. v. Dana*, 627 F. Supp. 1435, 1443 (S.D.N.Y. 1986).

when it held that the Kregos form lacked the requisite originality and creativity.⁵⁰ The court vigorously rejected the lower court's reasoning because the fact that most of the individual statistics had appeared in previously existing forms is inconsequential as compilations of facts, by definition, communicate previously determined facts.⁵¹ Accordingly, Kregos was not required to be the discoverer of the particular statistics depicted in the pitching form.⁵²

The next issue which the court addressed was whether the idea of publishing an outcome predictive pitching form had merged into the expression of that particular idea because the number of ways of expressing that idea were finite.⁵³ Kregos argued that the pitching form was copyrightable and the idea/expression merger doctrine was irrelevant because there were a myriad of statistics and a manifold of ways to organize same.⁵⁴ The district court disagreed asserting that there were indeed a restricted number of ways of representing such statistics because the newspapers refused elaborate forms.⁵⁵ Consequently, Judge Goettel posited that analysts were restricted in their expression as they were constrained to include only the most pertinent statistics.⁵⁶

Other jurisdictions which have previously examined the idea/expression doctrine include the Third Circuit in *Educational Testing Services v. Katzman*.⁵⁷ The court in *Educational Testing* rejected

50. *Kregos*, 937 F.2d at 704.

51. *Id.* at 705. See Jane C. Ginsburg, *Creation and Commercial Value: Copyright Protection of Works of Information*, 90 COLUM. L. REV. 1865, 1903-04 (1990).

52. *Kregos*, 937 F.2d at 705.

53. *Id.* See *Toro Co. v. R & R Products Co.*, 787 F.2d 1208, 1212 (8th Cir. 1986); Ronald P. Smith, Comment, *Arrangement and Editions of Public Domain Music: Originality in a Finite System*, 34 CASE W. RES. L. REV. 104, 108-22 (1983).

Copyright protection "covers only the work's particular expression of the idea, not the idea itself." *Eden Toys, Inc. v. Marshall Field & Co.*, 675 F.2d 498 (2d Cir. 1982). See also *Herbert Rosenthal Jewelry Corp. v. Kalpakian*, 446 F.2d 738, 741 (9th Cir. 1971).

54. *Kregos v. Associated Press*, 731 F. Supp. 113, 119 (S.D.N.Y. 1990). See Brett N. Dorny & Michael K. Friedland, Comment, *Copyrighting "Look and Feel": Manufacturers Technologies v. Cams*, 3 HARV. J.L. & TECH. 195 (1990); Comment, *Derivative Works and the Protection of Ideas*, 14 GA. L. REV. 794, 800-812 (1980); cf. *Matthew Bender & Co. v. Kluwer Law Book Publishers*, 672 F. Supp. 107 (S.D.N.Y. 1987) (holding that there were only a very limited number of ways to arrange the information about personal injury and wrongful death settlements and awards in chart form).

55. *Kregos*, 731 F. Supp. at 119. Cf. *Apple Computer, Inc. v. Franklin Computer Corp.*, 714 F.2d 1240, 1253 (3d Cir. 1983), *cert. dismissed*, 464 U.S. 1033 (1984) (discussing different ways of expressing a computer program).

56. *Kregos*, 731 F. Supp. at 119.

57. 793 F.2d 533, 539 (3d Cir. 1986). See also *Apple Computer*, 714 F.2d at 1252-54. (asserting that the merger doctrine applies when there are no or few other ways of expressing a

the defendant's argument that the merger doctrine applied to the questions prepared by Educational Testing Services, a nonprofit corporation dedicated to the development and administration of educational testing programs such as the Scholastic Aptitude Test.⁵⁸ The defendant charged a fee to prepare its students for the educational tests.⁵⁹ The court declared that the defendant violated the copyright laws by incorporating questions prepared by Educational Testing Services into its own preparation tests.⁶⁰

The Eighth Circuit in 1986 held that a manufacturer's idea of a parts numbering system to readily identify its products was capable of diverse expression.⁶¹ Specifically, the court posited that a copyright in a parts numbering system would not monopolize the idea because the systems will deviate according to the particular information chosen to be encoded into the designation and the method of selecting the designation will vary.⁶² The court, however, denied copyright protection because the parts numbering system in this case was not sufficiently original to warrant protection.⁶³ The company simply assigned a random number to a particular replacement part when created.⁶⁴ Judge Timbers clarified its ruling by stating that the particu-

particular idea); *Mazer v. Stein*, 347 U.S. 201, 217 (1954) (stating that only the expression of an idea and not the idea itself is protected under copyright); *Baker v. Selden*, 101 U.S. 99 (1880).

58. *Educational Testing*, 793 F.2d at 540.

59. *Id.* at 536.

60. *Id.* at 540. Specifically, the court stated that

[w]e are, quite frankly unpersuaded that the number of questions that can be devised to test students on their knowledge of square roots or dangling participles is so limited that [Educational Testing Services'] questions designed for this purpose represent a merger with the underlying ideas. Although ETS cannot appropriate concepts such as rules of punctuation, analogies, vocabulary or other fundamental elements of English composition, it can, using its own resources, devise questions designed to test these concepts and secure valid copyrights on these questions. Other persons, similarly resourceful, have ample latitude and opportunity to frame noninfringing questions testing the same subjects.

Id.

61. *Toro Co. v. R & R Products Co.*, 787 F.2d 1208, 1212 (8th Cir. 1986). See *Morrissey v. Procter & Gamble Co.*, 379 F.2d 675, 678-79 (1st Cir. 1967) (declaring that copyright protection will be denied when "by copyrighting a mere handful of forms, [a party] could exhaust all possibilities of future use of the substance [of the idea]"). In short, the idea/expression doctrine is designed to prevent an author from monopolizing an idea merely by copyrighting a few expressions of it. *Toro*, 787 F.2d at 1212 (citing *Morrissey*, 379 F.2d at 678-79).

62. *Id.* at 1212. Cf. *Matthew Bender & Co. v. Kluwer Law Book Publishers*, 672 F. Supp. 107 (S.D.N.Y. 1987) (holding that there were only a very limited number of ways to arrange the information about personal injury and wrongful death settlements and awards in chart form).

63. *Toro*, 787 F.2d at 1213. See *supra* note 2 defining original.

64. *Toro*, 787 F.2d at 1213.

lar numbers chosen did not pertain to a certain type or category of parts nor did the numbers themselves convey a message.⁶⁵

The Southern District of New York confronted this issue in *Matthew Bender & Co. v. Kluwer Law Book Publishers*⁶⁶ shortly before the Second Circuit decision in *Kregos*.⁶⁷ Unlike the situation in *Educational Testing* and *Toro*, the *Matthew Bender* court applied the merger doctrine to selections of categories of data.⁶⁸ In *Matthew Bender*, Bender published a single volume work presenting in chart form information relating to personal injury and wrongful death awards and settlements.⁶⁹ The charts found in Bender's and Kluwer's books both utilized a six column chart, which extends across two facing pages with similar headings.⁷⁰ Bender brought suit, contending that the Kluwer book violated Bender's copyright.⁷¹

The court in *Matthew Bender* began its analysis by enunciating that Bender could not seek a copyright embodying the idea of compiling in chart form the applicable settlement and award data in personal injury cases.⁷² After reviewing the merger doctrine articulated in *Educational Testing* and *Toro*, the court concluded that the doctrine applied because the number of ways to organize the limited number of categories in useful and approachable fashions was limited.⁷³ Moreover, the court also explicated that the selection and arrangement of the headings on the charts were mechanically chosen

65. *Id.*

66. 672 F. Supp. 107 (S.D.N.Y. 1987).

67. *Id.* The *Matthew Bender* court adopted the definition of merger articulated in the case of *Educational Testing Servs. v. Katzman*, 793 F.2d 533 (3d Cir. 1986). *Matthew Bender*, 672 F. Supp. at 109. The court in *Educational Testing* stated that

[t]he merger principle . . . is a variation of the idea/expression dichotomy . . . when the idea and the expression of the idea coincide, then the expression will not be protected in order to prevent creation of a monopoly on the underlying "art." . . . [A]n expression will be found to be merged into the idea when "there are no or few ways other ways of expressing a particular idea."

Educational Testing, 793 F.2d at 539 (quoting *Apple Computer, Inc. v. Franklin Computer Corp.*, 714 F.2d 1240, 1253 (3d Cir. 1983), *cert. dismissed*, 464 U.S. 1033 (1984)).

68. *Matthew Bender*, 672 F. Supp. at 107. *See supra* note 54, 57-60 and accompanying text.

69. *Matthew Bender*, 672 F. Supp. at 108.

70. *Id.* The Bender chart included the following headings: amount, case, plaintiff, event, injury, relevant data. *Id.* The Kluwer chart headings included: amount, case/citation/attorneys, injured party, occurrence, specific injury, pertinent information. *Id.*

71. *Id.*

72. *Id.* at 109. The court explained that the idea is to "provide attorneys working on a medical malpractice case with a useful guide, in chart form, outlining the results achieved in prior similar cases." *Id.* at 110.

73. *Id.* Specifically, the court stated that

without the required amount of creativity.⁷⁴ The court reasoned that the categories employed in the chart were the only appropriate ones which could be used to compile the personal injury award data.⁷⁵

In *Wabash Publishing Co. v. Flanagan*,⁷⁶ the district court in the Northern District of Illinois declared that the plaintiff's particular selection and arrangement of data regarding horse races into a compilation was copyrightable material.⁷⁷ The court rejected the defendant's contention that the idea of compiling horse racing information was capable of only limited expression.⁷⁸ The court reasoned that there was a multitude of horse racing data that could be selected and arranged in diverse ways.⁷⁹

The situation in *Triangle Publications, Inc. v. Sports Eye, Inc.*⁸⁰ is partially parallel to that created in *Kregos*.⁸¹ The court in *Triangle* considered a copyright infringement claim in conjunction with a motion for preliminary injunction brought against a publisher of horseracing forms, who selected certain categories of horseracing information and included a statement as to how each horse in a particular race falls into a particular category.⁸² The plaintiff, however, reports a mass of raw data and does not attempt to make any comparisons or

[i]ndeed, the information can be divided into 9 categories While in theory there are numerous ways to place this information in chart form, from a practical point of view the number of ways to organize this information in a useful and accessible manner is limited. It would make little sense, for example, to arrange the information by listing all of the cases alphabetically or chronologically, or by organizing the cases according to the names of the attorneys listed alphabetically. These arrangements, while possible, would be of little value to a practitioner seeking relevant information.

Id.

74. *Id.* at 112.

75. *Id.*

76. No. 89 C 1923, 1989 WL 32939 (N.D. Ill. Apr. 3, 1989).

77. *Id.* The plaintiffs published two racetrack guides known as "The Red Sheet and The Green Sheet," which were registered with the United States Copyright Office. *Id.* The defendants also published racetrack guides ("The Red Streak and The Blue Streak"), which were very similar to plaintiff's sheets visually and in organization of content. *Id.*

78. *Id.*

79. *Id.* Although the court found that the racetrack guides were copyrightable material, the court refused to grant plaintiffs' motion for injunctive relief reasoning that plaintiffs had not satisfied their burden of establishing their likelihood of success on the merits of their copyright claim. *Id.* The plaintiffs made a prima facie showing of the ownership and validity of their copyrights because plaintiffs submitted copies of the registrations. *Id.* Defendants, however, rebutted plaintiffs' ownership of the copyrights by establishing that the plaintiffs released all rights in any copyright they had in the format of the racetrack guide to the public when the plaintiffs published some of the papers without notice of the copyright. *Id.*

80. 415 F. Supp. 682 (E.D. Pa. 1976).

81. *Id.* at 684.

82. *Id.* at 683. The Third Circuit has stated that

judgments about the horses that will race in the upcoming races.⁸³ The court found no infringement and denied the preliminary injunction because the racing forms were not substantially similar.⁸⁴ This case underlines the fact that the particular selection of categories in a form is copyrightable material and an outcome predictive form is capable of diverse expression.⁸⁵

Recognizing that granting copyright protection to categories of data may confer protection to ideas, the appellate court nevertheless reversed the district court's ruling.⁸⁶ The court, however, agreed with Judge Goettel's characterization of Kregos' idea.⁸⁷ Specifically, Kregos' idea was described as the idea "to publish an outcome predictive pitching form."⁸⁸ The court emphasized that Kregos did not establish a method of predicting the outcome of baseball games by Kregos' particular selection of statistics, but rather subjectively selected the relevant statistics Kregos deemed important when others attempt to make predictions about the outcome of a game.⁸⁹

[t]o establish a copyright infringement, the holder [of the copyright] must first prove that the defendant has copied the protected work and, second, that there is a substantial similarity between the works. The criterion for the latter requirement is whether an ordinary lay observer would detect a substantial similarity between the works.

Universal Athletic Sales Co. v. Salkeld, 511 F.2d 904, 907 (3d Cir. 1975), *cert. denied, sub nom.*, Universal Athletic Sales Co. v. Pinchock, 423 U.S. 863 (1975).

83. *Triangle Publications*, 415 F. Supp. at 685.

84. *Id.*

85. *Id.* at 682.

86. *Kregos v. Associated Press*, 937 F.2d 700, 707 (2d Cir. 1991). The court's concern was illustrated

by an example of a doctor who publishes a list of symptoms that he believes provides a helpful diagnosis of a disease. There might be many combinations of symptoms that others could select for the same purpose, but a substantial question would nonetheless arise as to whether that doctor could obtain a copyright in his list, based on the originality of his selection. If the idea that the doctor is deemed to be expressing is the general idea that the disease in question can be identified by observable symptoms, then the idea might merge into the doctor's particular expression of that idea by his selection of symptoms. That general idea might remain capable of many other expressions. But it is arguable that the doctor has conceived a more precise idea—namely, the idea that his selection of symptoms is a useful identifier of the disease. That more limited idea can be expressed only by his selection of symptoms, and therefore might be said to have merged into his expression.

Id.

87. *Id.* at 706.

88. *Id.*

89. *Id.* at 707. The court noted that

[d]etermining when the idea and its expression have merged is a task requiring considerable care: if the merger doctrine is applied too readily, arguably available alternative forms of expression will be precluded; if applied too sparingly, protection will

The *Wabash* sheets containing the collection of data for horse races and the racing forms in *Triangle Publications* containing statistics and detailed information concerning the horses past performances are very similar to the pitching forms at issue in *Kregos*.⁹⁰ Accordingly, the Second Circuit determined that the merger doctrine was inapplicable because the past performances of the pitchers can be evaluated by a multitude of statistics and hence the idea will remain in the public domain.⁹¹ The court further reasoned that *Kregos'* idea that statistics can appraise the former performances of baseball pitchers was capable of diverse expression because there in fact existed pitching forms with differing statistics.⁹² These pitching forms were produced before the 1983 *Kregos* form and the 1984 AP form.⁹³

The district court proceeded to address the blank form doctrine as a third impediment to copyright protection.⁹⁴ The blank form doc-

be accorded to ideas. Recognizing this tension, courts have been cautious in applying the merger doctrine to selections of factual information

In one sense, every compilation of facts can be considered to represent a merger of an idea with its expression. Every compiler of facts has the idea that his particular selection of facts is useful. If the compiler's idea is identified at that low level of abstraction, then the idea would always merge into the compilers's expression of it.

Id. at 705-06.

90. *Id.*

91. *Id.* at 704. The court stated that

[f]or example, *Kregos* could have selected past performances from any number of recent starts, instead of using the three most recent starts. And he could have chosen to include strikeouts, walks, balks, or hit batters. By consulting play-by-play accounts of games, instead of box scores, he could have counted various items such as the number of innings in which the side was retired in order, or in which no runner advanced as far as second base. Or he could have focused on performance under pressure by computing the percentage of innings in which a runner scored out of total innings in which a runner reached second base, and he could have chosen to calculate this statistic for any number of recent starts.

Id.

92. *Id.* at 705.

93. *Id.* at 706. The court illustrated by stating that

Kregos' selection of categories includes three statistics for the pitcher's current season performance against the day's opponent at the site of the day's game; other charts select "at site" performance against the opponent during the prior season, and some select performance against the opponent over the pitcher's career, both home and away. Some charts include average men on base per nine innings; others do not. The data for most recent starts could include whatever number of games the compiler thought pertinent.

Id.

94. *Kregos v. Associated Press*, 731 F. Supp. 113, 120 (S.D.N.Y. 1990). *But cf.* *Edwin K. Williams & Co. v. Edwin K. Williams & Co.-East*, 542 F.2d 1053, 1060 (9th Cir. 1976), *cert. denied*, 433 U.S. 908 (1977) (holding that account books containing several pages of instructions on use of forms and advice on successful management of service stations conveyed information and were entitled to copyright).

trine was articulated in the Supreme Court decision of *Baker v. Selden*.⁹⁵ Justice Bradley, writing for the Court, began the analysis by acknowledging that plaintiff's copyright in a book explaining a system of bookkeeping does not grant the author the exclusive right to the use of the system.⁹⁶ The Court reasoned that the purpose of publishing a science or arts book is to proclaim to the community the useful information which the book contains.⁹⁷ Consequently, the Court advocated that the blank account forms contained in the book were not protected under the copyright laws because the forms do not convey information and function only to provide space for recording relevant material.⁹⁸ In addition, blank forms are not the subject of copyright, because the production of the forms involves no creativity in the selection and arrangement of information.⁹⁹ Similarly, the Eleventh Circuit in *John H. Harland Co. v. Clarke Checks, Inc.*,¹⁰⁰ rejected copyright protection to check stubs, which were manufactured by numerous bank stationary companies and which merely provided space to allow a check writer to record the date, dollar amount, payee and purpose of check.¹⁰¹ In certain circumstances, courts, however, have willingly approved of copyright protection to forms that contain substantial blank space.¹⁰² In *Harcourt, Brace & World, Inc. v. Graphic Controls Corp.*,¹⁰³ the court held that printed answer sheets, which were created for use in conjunction with student tests and designed to be corrected by machines were subject to copyright protection.¹⁰⁴ The court reasoned that the answer sheets, as

It is settled law that blank forms are not copyrightable because the forms fail to convey information and are designed to record information. *Bibbero Sys., Inc. v. Colwell Sys., Inc.*, 893 F.2d 1104, 1106 (9th Cir. 1990). See also *Baker v. Selden*, 101 U.S. 99 (1879); *John H. Harland Co. v. Clarke Checks, Inc.*, 711 F.2d 966, 971 (11th Cir. 1983). Examples of blank forms include "time cards, graph paper, account books, diaries, bank checks, scoreboards, address books, report forms, order forms and the like . . ." 37 C.F.R. § 202.1(c) (1982).

95. 101 U.S. 99 (1879).

96. *Id.* at 101.

97. *Id.* at 103.

98. *Id.* at 107. The forms displayed an arrangement of columns and headings that permitted entries for a day, a week, or a month to be recorded on one page or two facing pages. *Id.* at 100.

99. *Kregos v. Associated Press*, 937 F.2d 700, 708 (2d Cir. 1991). See *supra* note 94 and accompanying text.

100. 711 F.2d 966 (11th Cir. 1983).

101. *Id.* at 971.

102. *Kregos*, 937 F.2d at 708. See *supra* note 94 and accompanying text.

103. 329 F. Supp. 517 (S.D.N.Y. 1971).

104. *Id.* at 524. See *Norton Printing Co. v. Augustana Hosp.*, 155 U.S.P.Q. 133 (N.D. Ill. 1967)(recognizing copyright protection in laboratory test forms).

meticulously designed, conveyed information and encompassed meaning.¹⁰⁵

Although acknowledging that Kregos' pitching form was not a genuine blank form, the court concluded that Kregos' form was not eligible for copyright protection because the pitching form was adequately comparable to a blank form.¹⁰⁶ The Second Circuit first criticized per se findings of uncopyrightability when forms are involved.¹⁰⁷ Because the majority had earlier determined that the selection of categories of statistics found in the Kregos pitching form exhibited sufficient creativity to preclude a decree of uncopyrightability as a matter of law, the court summarily concluded that the blank form doctrine was inapplicable.¹⁰⁸

The United States Court of Appeals, Second Circuit next discussed the extent of protection that Kregos is entitled to if Kregos prevails at trial.¹⁰⁹ Specifically, the majority declared that Kregos' selection of statistics but not the arrangement of same was eligible for copyright protection as the latter is "surely . . . garden variety"¹¹⁰ The court further noted that the Kregos form is entitled to protection only against identical pitching forms.¹¹¹ Hence, Kregos may not successfully claim copyright infringement if a form-maker creates a pitching form that is similar to the Kregos form yet differs to an extent.¹¹²

Finally, the district court ruled on the trademark claims.¹¹³ In *Stormy Clime Ltd. v. ProGroup, Inc.*,¹¹⁴ the Second Circuit declared that to enjoin the copying of the appearance of a product or

105. *Harcourt*, 329 F. Supp. at 523.

106. *Kregos v. Associated Press*, 731 F. Supp. 113, 120 (S.D.N.Y. 1990). See *supra* note 94 and accompanying text.

107. *Kregos v. Associated Press*, 937 F.2d 700, 708 (2d Cir. 1991). See *Edwin K. Williams & Co. v. Edwin K. Williams & Co-East*, 542 F.2d 1053, 1060 (9th Cir. 1976), *cert. denied*, 433 U.S. 908 (1977).

108. *Kregos*, 937 F.2d at 709.

109. *Id.*

110. *Id.* See *Past Pluto Productions Corp. v. Dana*, 627 F. Supp. 1435, 1444 (S.D.N.Y. 1986).

111. *Kregos*, 937 F.2d at 709. See *Howard v. Streach*, 725 F. Supp. 1572, 1574 (N.D. Ga. 1989). But see *Herbert Rosenthal Jewelry Corp. v. Kalpakian*, 446 F.2d 738, 741 (9th Cir. 1971) (finding copyright infringement when the objects are not identical but rather substantially similar); *Alfred Bell & Co. v. Catalda Fine Arts, Inc.*, 191 F.2d 99, 103 (2d Cir. 1951) (declaring that author is entitled to copyright if author independently created work that fortuitously is identical to a previous work).

112. *Kregos*, 937 F.2d at 710. See *supra* notes 13 and 15 and accompanying text.

113. *Kregos v. Associated Press*, 731 F. Supp. 113, 121 (2d Cir. 1991).

114. 809 F.2d 971 (2d Cir. 1987).

trade dress under section 43(a) of the Lanham Act, the plaintiff must demonstrate that the trade dress of the product has acquired secondary meaning and the design of the defendant competitor's product is likely to confuse the public as to its true origin.¹¹⁵ The court in *Ralston Purina Co. v. Thomas J. Lipton, Inc.*¹¹⁶ stressed that proving secondary meaning is a heavy burden that the plaintiff must overcome.¹¹⁷

Kregos argued that the 1983 Kregos form is source indicating and the 1984 AP form creates a likelihood of confusion as to source.¹¹⁸ The district court rejected this claim reasoning that the form was functional because competitors needed the particular selected statistics in the Kregos form to generate a valid pitching form.¹¹⁹ The Second Circuit affirmed on a different ground reasoning

115. *Id.* at 974. Section 43(a) of the Lanham Act provides that

[a]ny person who shall affix, apply, or annex, or use in connection with any goods or services, or any container or containers for goods, a false designation of origin, or any false description or representation, including works or other symbols tending falsely to describe or represent the same, and shall cause such goods or services to enter into commerce, and any person who shall with knowledge of the falsity of such designation of origin or description or representation cause or procure the same to be transported or used in commerce or deliver the same to any carrier to be transported or used, shall be liable to a civil action by any person doing business in the locality falsely indicated as that of origin or in the region in which said locality is situated, or by any person who believes that he or she is or likely to be damaged by the use of any such false description or representation.

15 U.S.C. § 1125(a) (1988).

116. 341 F. Supp. 129 (S.D.N.Y. 1972).

117. *Id.* at 133 (stating that to prove secondary meaning "it must be shown that the primary significance of the term in the minds of the consuming public is not the product but the producer). See also *Warner Bros. Inc. v. Gay Toys, Inc.*, 724 F.2d 327 (2d Cir. 1983).

118. *Kregos v. Associated Press*, 937 F.2d 700, 710 (2d Cir. 1991). To successfully present a Lanham Act claim, the plaintiff "must show a likelihood that an appreciable number of ordinarily prudent purchasers are likely to be misled, or indeed simply confused, as to the source of the goods in question." *Centaur Communications v. A/S/M Communications*, 830 F.2d 1217, 1219 (2d Cir. 1987) (quoting *Mushroom Makers, Inc. v. R.G. Barry Corp.*, 580 F.2d 44, 47 (2d Cir. 1978) (per curiam), *cert. denied*, 439 U.S. 1116 (1979)). In the seminal case of *Polaroid Corp. v. Polaroid Elecs. Corp.*, 287 F.2d 492 (2d Cir. 1961), *cert. denied*, 368 U.S. 820 (1961), the Second Circuit set forth eight factors to be analyzed in evaluating likelihood of confusion. Those factors are:

(1) the strength of the mark, (2) the degree of similarity between the two marks, (3) the proximity of the products, (4) the likelihood that the senior user of the mark will bridge the gap, (5) evidence of actual confusion, (6) the junior user's bad faith *vel non* in adopting the mark, (7) the quality of the junior's product, and, finally, (8) the sophistication of the relevant consumer group.

Id. at 495.

119. *Kregos v. Associated Press*, 731 F.Supp. 113, 121 (S.D.N.Y. 1990). "[C]opyright protection extends only to the artistic aspects, but not the mechanical or utilitarian features, of a protected work." *Durham Indus., Inc. v. Tomy Corp.*, 630 F.2d 905, 913 (2d Cir. 1980). See also

that Kregos had failed to establish secondary meaning "in the look and appearance of his form."¹²⁰

The district court then dismissed Kregos' contention that Sports Features' copyright notice on the 1984 AP form is false.¹²¹ The court reasoned that Kregos was required to establish a legitimate infringement claim before Kregos could maintain another Lanham Act claim.¹²² The circuit court reversed this pronouncement but emphatically declared that it would reject this claim if Kregos was simply arguing that the copyright notice is false because the AP form is infringing on the Kregos form as this contention would transform all copyright claims into Lanham Act claims.¹²³

The Honorable Robert W. Sweet sitting by designation on the court of appeals panel concurred in part and dissented in part.¹²⁴ Although assenting to the majority's conclusion that the Kregos form exhibited sufficient creativity to obtain copyright protection, Judge Sweet stated that the Kregos pitching form was ineligible for copyright protection pursuant to the idea/expression merger doctrine.¹²⁵ More specifically, the dissenter posited that the "Kregos' form constitutes an explanation of his preferred system of handicapping baseball games, and he seeks to use his copyright here to prevent others from practicing that system."¹²⁶ The majority found the case more akin to *Wabash* and *Triangle Publications*, but the dissenter claimed

LeSportsac, Inc. v. K-Mart Corp., 754 F.2d 71, 75 (2d Cir. 1985); *Score, Inc. v. Cap Cities/ABC, Inc.*, 724 F. Supp. 194, 200 (S.D.N.Y. 1989).

120. *Kregos*, 937 F.2d at 710. Before establishing secondary meaning, it must be "shown that the primary significance of the term in the minds of the consuming public is not the product but the producer." *20th Century Wear, Inc. v. Sanmark-Stardust Inc.*, 815 F.2d 8, 10 (2d Cir. 1987). See *Centaur Communications*, 830 F.2d at 1221; *Warner Bros.*, 724 F.2d at 327.

121. *Kregos*, 937 F.2d at 710-11. Although AP and Sports Features maintained that the pitching form was uncopyrightable, Sports Features applied a copyright notice on the AP forms to protect Sports Features in the event that the AP form contained copyrightable elements. Brief for Appellee at 9, *Kregos*, 937 F.2d 700 (No. 90-7469).

122. *Kregos*, 937 F.2d at 710.

123. *Id.* at 710-711. The court clarified its pronouncement by stating that Kregos could complain, for example, if Sports Features unfairly competed with him by falsely claiming that its form was originated by some well-known baseball player. . . . The fact that a proprietor fails to show sufficient secondary meaning in a mark to establish an infringement claim does not preclude his assertion of some other Lanham Act claim such as false designation of origin or false description.

Id. at 710. See also Leon Dayan, *The Scope of Copyright in Information: An Alternative to Classic Theory*, 42 FED. COMM. L.J. 239 (1990).

124. *Kregos*, 937 F.2d at 711.

125. *Id.* See *Lotus Dev. Corp. v. Paperback Software Int'l.*, 740 F. Supp. 37, 67 (D. Mass. 1990).

126. *Kregos*, 937 F.2d at 713. See *Baker v. Selden*, 101 U.S. 99 (1879).

that *Baker* and *Matthew Bender* were controlling.¹²⁷ Additionally, Judge Sweet objected to the majority's application of the merger doctrine because he maintains the court should evaluate the plaintiff's eligibility for copyright in conjunction with merger rather than the defendant's infringement.¹²⁸

The plaintiffs then petitioned the Second Circuit for a rehearing on the Lanham Act issue.¹²⁹ *Kregos'* motion, however, was denied.¹³⁰ The Second Circuit's refusal to reconsider its ruling, in effect an affirmation of the *Kregos* decision, represents the courts willingness to endorse the goals of the Copyright laws.¹³¹ This is principally important in situations where a work's copyrightable elements are not manifest.¹³²

Two days after deciding *Kregos*, the Second Circuit addressed the extent of copyright protection in a "horse racing form" in *Victor Lalli Enterprises, Inc. v. Big Red Apple, Inc.*¹³³ In *Victor Lalli*, the court rejected Victor Lalli's infringement claim, because the Lalli charts, containing the winning numbers of illegal gambling, was not copyrightable matter.¹³⁴ After reviewing, the circuit court declared that Lalli's forms containing horse racing statistics were functional non-original charts "that offer no opportunity for variation."¹³⁵ Unlike the pitching form in *Kregos*, the contents displayed in the horse racing form in *Victor Lalli* did not involve the selection and arrangement of information involving matters of taste and judgment.¹³⁶

In certain circumstances, copyright protection is essential to the creation of works because it drives the author to commit to his or her talent.¹³⁷ After the author has expended energy in creating a compila-

127. *Kregos*, 937 F.2d at 706.

128. *Id.* at 714-15. Judge Sweet stated the court should first decide "whether the copyrighted work satisfies the primary requirement of creativity, then . . . determine whether there is merger before extending copyright protection." *Id.* at 715.

129. Letter from David A. Einhorn, counsel for the defendant AP, to Liliana De Avila (July 15, 1991) (on file with the Seton Hall Journal of Sport Law) (discussing unpublished opinion of denial of rehearing).

130. *Id.*

131. *See supra* note 6.

132. *See supra* notes 2 and 6.

133. 936 F.2d 671 (2d Cir. 1991).

134. *Victor Lalli*, 936 F.2d at 671. *See also* Triangle Publications, Inc. v. New England Newspaper Publishing Co., 46 F. Supp. 198 (D. Mass. 1942).

135. *Victor Lalli*, 936 F.2d at 673.

136. *Id.*

137. Bowman, *supra* note 15, at 575. It is said that

[t]he monopoly privileges that Congress may authorize are neither unlimited nor primarily designed to provide a special private benefit. Rather, the limited grant is a

tion, society benefits if it is a useful work.¹³⁸ Courts, however, are reluctant to grant extensive copyright protection to compilations of facts.¹³⁹ Courts fear that the grant of a copyright may restrict access to facts already in the public domain.¹⁴⁰ Consequently, if a compiler is granted a copyright, the scope of protection will be narrow.¹⁴¹ This is true despite the fact that the compiler usually expends a considerable amount of energy investigating the facts or data to be compiled.¹⁴²

In *Kregos v. Associated Press*,¹⁴³ the Second Circuit vigorously displayed its commitment to the protection of an author's rights and to the goals of the copyright laws.¹⁴⁴ The Second Circuit was correct in its conclusion that the issues of originality and creativity in a baseball pitching form could not be resolved as a matter of law.¹⁴⁵ The court in *Kregos* in conjunction with *Feist* clearly defined the extent

means by which an important public purpose may be achieved. It is intended to motivate the creative activity of authors and inventors by the provision of a special reward, and to allow the public access to the products of their genius after the limited period of exclusive control has expired.

Sony Corp. of Am. v. Universal City Studios, 464 U.S. 417, 429 (1984), *reh'g denied*, 465 U.S. 1112 (1984); *see Twentieth Century Music Corp. v. Aiken*, 422 U.S. 151, 156 (1975).

138. Ginsburg, *supra* note 51, at 1899. Ginsburg suggests that

[o]ne consideration favoring the original authorship of impersonal, nonsubjective compilations, independent of the perspiration expended, focuses on the social benefits derived from their production. The social benefit justification assumes that copyright spurs the production of useful works that might not otherwise be created because the opportunity for recoupment of investment in an unregulated market seem too slim in light of the costs of production. Address lists, law reporters, and road atlases, for example, are all very useful works. . . . Copyright should remain available to prod the creation of these works. A corollary to the social benefit justification, however, might be: if the costs of production are low, then copyright may be unnecessary. As a result, one might object that the determination that certain works are socially desirable does not suffice to demonstrate that copyright is the appropriate means to ensure their creation, particularly if these works are less laboriously produced than they once were.

Id.

139. *See Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 111 S. Ct. 1282 (1991); *Financial Info. v. Moody's Investors Serv.*, 808 F.2d 204 (2d Cir. 1986), *cert. denied*, 484 U.S. 820 (1987); *Eckert v. Hurley Chicago Co.*, 638 F. Supp. 699 (N.D. Ill. 1986).

140. Ginsburg, *supra* note 51, at 1906. *See also supra* note 7 and accompanying text.

141. *See supra* note 112 and accompanying text. .

142. *See supra* note 2.

143. 937 F.2d 700 (2d Cir. 1991).

144. Mitchell E. Radin, *The Significance of Intent to Copy in a Civil Action for Copyright Infringement*, 54 (1) TEMP. L. Q. 1, 7-10 (1981). *See supra* note 6 and accompanying text.

145. *Kregos*, 937 F.2d at 701.

of originality required in compilations of facts.¹⁴⁶ The *Kregos* decision also reaffirms the Congressional intent to afford protection to compilations of facts.¹⁴⁷ More importantly, the *Kregos* case is a victory for compilers, who often have to justify their work more so than other creators of works or writings.¹⁴⁸

The facts in a compilation of course are not protected, but the selection and arrangement of the facts may be protected.¹⁴⁹ Framers of statistical forms seeking copyright protection for their forms must do more than collect facts or statistics.¹⁵⁰ They must have selected and arranged the facts with some individual judgment or creativity before a court will consider enjoining a competitor.¹⁵¹ The court will not consider and seek to protect the time invested in developing the statistical form.¹⁵² *Kregos* represents a court's willingness to extend the blanket of copyright protection to a compilation provided the selection and arrangement of the facts involved some degree of creativity or of individual taste.¹⁵³

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146. Robert C. Denicola, *Copyright Collections of Facts: A Theory for the Protection of Nonfiction Literary Works*, 81 COLUM. L. REV. 516, 531-532 (1981).

147. See *supra* note 6. See also *Koontz v. Jaffarian*, 617 F. Supp. 1108, 1112 (D.C. Va. 1985), *aff'd*, 787 F.2d 906 (1986).

148. *E.g.* *New York Times Co. v. Roxbury Data Interface, Inc.*, 434 F. Supp. 217, 221 (1977) (stating that because plaintiff's work is a product of "diligence [rather] than of originality or inventiveness, defendants have greater license to use portions of the plaintiff's compilation of facts under the fair use doctrine than they would have if a creative work had been involved").

149. See *supra* note 6 and accompanying text.

150. See *supra* note 39 and accompanying text.

151. See *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 111 S. Ct. 1282 (1991); *Educational Testing Serv. v. Katzman*, 793 F.2d 533, 539 (3d Cir. 1986). See *supra* note 135 and accompanying text.

152. Denicola, *supra* note 146, at 533-34.

153. See *Smith*, *supra* note 53, at 108-14.