Copyrighting the Yellow Pages: Finding Originality in Factual Compilations

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Congress enacted the Copyright Act of 19761 ("the Act") partially to expand and clarify the scope of copyrightable subject matter.2 The Act, however, seems to contain an "undeniable tension": although copyright law does not protect facts, it sometimes protects arrangements of facts.3 Nowhere is this tension more apparent than in the area of factual compilations, such as directories and maps. The federal courts of appeals historically used conflicting approaches in granting copyright protection to factual compilations.4 Some courts rewarded the efforts of the compiler,5 while other courts required that the compiler demonstrate originality in the selection or arrangement of the compilation.6

In Feist Publications v. Rural Telephone Service Co.,7 a copyright infringement suit involving a white pages directory,
the Supreme Court attempted to clarify the law regarding copyright protection for factual compilations. The *Feist* decision, however, has led to different interpretations of copyright protection for other types of factual compilations. Courts have applied inconsistent standards when evaluating copyright protection for yellow pages directories.\(^8\) Clarifying the appropriate standard of protection is important not only to the yellow pages industry,\(^9\) which exceeds eleven billion dollars in annual sales,\(^10\) but also to other industries that produce factual compilations, particularly the computer database industry.\(^11\)

This Note argues that denying copyright protection to the arrangement and selection of compilations such as yellow pages directories is inconsistent with *Feist* and other established copyright law. Part I discusses the Copyright Act, examines the Supreme Court's guidelines for originality set forth in *Feist*, and

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8. Compare BellSouth Advertising & Publishing Corp. v. Donnelley Info. Publishing, 999 F.2d 1436 (11th Cir. 1993) (en banc) (finding no originality in a yellow pages directory), *cert. denied*, 114 S. Ct. 943 (1994) *with* Key Publications v. Chinatown Today Publishing Enters., 945 F.2d 509 (2d Cir. 1991) (finding originality in the selection and arrangement of a yellow pages directory). Although the courts in both *BellSouth* and *Key Publications* found no infringement of yellow pages directories, this Note argues that the two courts applied inconsistent tests that will sometimes lead to different results. *See* discussion *infra* part II.

The history of the *BellSouth* case provides a good illustration of the confusion that *Feist* has engendered. Before the *Feist* decision, the district court ruled in favor of BellSouth. BellSouth Advertising & Publishing Corp. v. Donnelley Info. Publishing, 719 F. Supp. 1551, 1569 (S.D. Fla. 1988). After the *Feist* decision, a panel of the Eleventh Circuit unanimously affirmed the district court. 933 F.2d 952, 961 (11th Cir. 1991). The full Eleventh Circuit, however, vacated the panel decision and granted rehearing en banc. 977 F.2d 1435 (11th Cir. 1992). The en banc court then reversed the district court. 999 F.2d 1436 (11th Cir. 1993) (en banc). Four judges did not participate, *id.* at 1438, and one judge strongly dissented, *id.* at 1471-85 (Hatchett, J. dissenting). The U.S. Supreme Court denied certiorari. 114 S. Ct. 943 (1994); *see also infra* notes 59-84 and accompanying text (discussing the *BellSouth* cases in more detail).


describes other relevant case law in the area of factual compilations. Part II compares the two leading post-Feist cases involving yellow pages directories and demonstrates that the approaches of the two cases may lead to inconsistent results. Part III examines the advantages and disadvantages of the two approaches and suggests the proper approach for protection of yellow pages directories. This Note concludes that courts should recognize that even “typical” yellow pages directories and similar factual compilations may contain sufficient originality to merit copyright protection.13

I. COPYRIGHT PROTECTION FOR FACTUAL COMPILATIONS

The Copyright Act specifically grants copyright protection to compilations of fact,14 but this protection extends only to the “material contributed by the author of such work, as distin-

12. See infra notes 99-100 and accompanying text (discussing the Eleventh Circuit’s approach to an “entirely typical” yellow pages directory).

13. Other legal avenues besides copyright law could provide protection to factual compilations. For instance, if a contractual relationship exists between the provider and the user of an online database, the provider may have a cause of action based on a breach of contract. See Paul T. Sheils & Robert Penchina, What’s All the Fuss About Feist? The Sky Is Not Falling on the Intellectual Property Rights of Online Database Proprietors, 17 U. DAYTON L. REV. 563, 571-78 (1992). State unfair competition laws also may provide remedies, to the extent that they are not preempted by congressional action. See id. at 579-84; see also Feist Publications v. Rural Tel. Serv. Co., 499 U.S. 340, 354 (1991) (indicating that unfair competition theories may provide protection under certain circumstances) (quoting 1 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 3.04 (1990)); Miller, supra note 11, at 525-27 (discussing protection under both contract and unfair competition).

Some commentators argue that Congress may be able to work around Feist’s constitutional mandate of originality in copyright by using its authority under the Commerce Clause, if it so desires. See Jane C. Ginsburg, No “Sweat”? Copyright and Other Protection of Works of Information After Feist v. Rural Telephone, 92 COLUM. L. REV. 338, 367-74 (1992); see also 1 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 1.09 (1993) (discussing the Commerce Clause as an alternative source of congressional power); Miller, supra note 11, at 536-38 (supporting Professor Ginsburg’s Commerce Clause arguments).

14. 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.” 17 U.S.C. § 101 (1988). “A ‘compilation’ results from a process of selecting, bringing together, organizing, and arranging previously existing material of all kinds, regardless of whether the individual items in the material have been or ever could have been subject to copyright.” H.R. Rep. No. 94-1476, 94th Cong., 2d Sess. 57 (1976), reprinted in 1976 U.S.C.C.A.N. 5659, 5670 [hereinafter HOUSE REPORT].
guished from the preexisting material employed in the work."¹⁵ Thus, the Act seems inconsistent because it grants copyright protection to compilations of fact while granting no protection to facts.¹⁶ The court-created "merger doctrine" supplements these provisions of the Copyright Act. Under this doctrine, a compilation receives no protection if "there is only one or so few ways of expressing an idea that protection of the expression would effectively accord protection to the idea itself."¹⁷

A. THE TRADITIONAL APPROACH

Historically, to determine whether a particular compilation deserved copyright protection, courts applied one of two different tests. Most courts, following the "creative selection approach," granted copyright protection only if the work contained at least a small amount of originality in the selection or arrangement of facts.¹⁸ Thus, under this approach, courts would not extend copyright protection to a compilation consisting only of a mechanical listing of facts and the facts themselves would remain part of the public domain.¹⁹ In contrast, a minority of courts followed the "sweat of the brow" theory and granted copyright protection to a compilation whose compiler had expended effort in making it, even if neither the selection nor the arrange-

¹⁶. Feist, 499 U.S. at 345. "Common sense tells us that 100 uncopyrightable facts do not magically change their status when gathered together in one place. Yet copyright law seems to contemplate that compilations that consist exclusively of facts are potentially within its scope." Id.
¹⁹. See, e.g., Worth v. Selchow & Righter Co., 827 F.2d 569 (9th Cir. 1987) (affirming the trial court's determination that Trivial Pursuit's use of the "factual content" of the plaintiff's trivia books was not infringement), cert. denied, 485 U.S. 977 (1988); Southwestern Bell Tel. & Tel. Co. v. Associated Tel. Directory Publishers, 756 F.2d 801 (11th Cir. 1985) (using the "original work" standard to determine the Atlanta Yellow Pages met the originality requirements); Eckes v. Card Prices Update, 736 F.2d 859, 862-63 (2d Cir. 1984) (concluding that the plaintiffs "exercised selection, creativity and judgment" in compiling their pricing guide of baseball cards); Miller v. Universal City Studios, Inc., 650 F.2d 1365 (5th Cir. 1981) (stating that copyright protection for directories depends on "originality" and the author's "industriousness" in distinguishing directories from the made-for-television movie at issue).
ment of the compilation was original. The Supreme Court considered these conflicting approaches in Feist Publications v. Rural Telephone Service Co.

B. The Feist Decision

In Feist, the plaintiff, Rural Telephone Services Company ("Rural"), published a telephone directory. A competitor, Feist Publications, copied the listings from Rural's white pages, verified their accuracy, obtained additional information from telephone customers, and published its own directory. Rural brought suit, claiming copyright infringement. In its decision, the Court considered the two traditionally competing theories.

Confusion over the "sweat of the brow" doctrine first arose from the Copyright Act of 1909, ch. 320, §§ 1-64, 35 Stat. 1076-1088 (1909) (codified as amended at 17 U.S.C. §§ 101-1010 (1988 & Supp. IV 1992)). Because the 1909 Act was ambiguous and included the originality requirement only implicitly, some courts incorrectly focused on the language in § 5(a), which listed factual compilations as a category of protected works. Feist, 499 U.S. at 352. These courts, erroneously interpreting § 5 as granting compilations copyright protection per se, without any requirement of originality, developed the "sweat of the brow" theory to justify this protection. Id. at 352-53. Justice O'Connor quoted the "classic formulation" of the theory: "[t]he right to copyright a book upon which one has expended labor ... does not depend upon whether ... such materials show literary skill or originality, either in thought or in language, or anything more than industrious collection." Id. (quoting Jeweler's Circular Publishing Co. v. Keystone Publishing Co., 281 F. 83, 88 (2d Cir.), cert. denied, 259 U.S. 581 (1922)).

The "sweat of the brow" doctrine possesses "numerous flaws, the most glaring being that it extended copyright protection beyond selection and arrangement ... to the facts themselves. ... 'Sweat of the brow' courts thereby eschewed the most fundamental axiom of copyright law—that no one may copy right facts or ideas." Id. at 353. Professor Nimmer further criticized this approach:

The desire of the courts ... to protect the industriousness of the researcher is both understandable and in a sense commendable. It is nonetheless incorrect; for those courts fail to apply the standard of originality as it is understood in the law of copyright. ... [T]o accord copyright protection on this basis alone distorts basic copyright principles in that it creates a monopoly in public domain materials without the necessary justifications of protecting and encouraging the creation of "writing" by "authors."

1 Nimmer & Nimmer, supra note 13, § 3.04[B][1].
The Court rejected the "sweat of the brow" theory, reasoning that "originality, not 'sweat of the brow,' is the touchstone of copyright protection."\(^{26}\) It held that even if Rural's directory as a whole qualified for copyright protection,\(^{27}\) Feist's actions did not constitute copyright infringement because Rural's directory was not original.\(^{28}\) The Court explained that despite the apparent tension between copyright protection for facts and compilations, copyright handles both in a consistent fashion:

Copyright treats facts and factual compilations in a wholly consistent manner. Facts, whether alone or as part of a compilation, are not original and therefore may not be copyrighted. 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.\(^{29}\)

In justifying its decision, the Court went beyond the Copyright Act and further stated that "[o]riginality is a constitutional requirement."\(^{30}\) The Court acknowledged Rural's substantial effort in compiling the directory, but explained that copyright rewards originality, not effort.\(^{31}\) The Court evaluated the various components of the Rural white pages directory to determine their originality. As a preliminary matter, the Court found that the information in each listing was merely factual with nothing

\(^{26}\) Id. at 359-60.

\(^{27}\) The parties agreed that Rural's directory as a whole had a valid copyright, because it contained a foreword and original advertisements. Id. at 361.

\(^{28}\) Id. at 363-64.

\(^{29}\) Id. at 350-51.

\(^{30}\) Id. at 346. The Constitution grants Congress the power to "promote 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.

Commentators have questioned the Supreme Court's reasons for rooting its decision in the Constitution, arguing that the Court should have based its decision on statutory considerations alone. See Ginsburg, supra note 13, at 341; Paul J. Heald, The Vices of Originality, 1991 Sup. Ct. Rev. 143, 144 (noting that Justice O'Connor's majority opinion "bludgeon[s] the [constitutional] point home in at least seven places"); Robert A. Kress, Introduction, 17 U. DAYTON L. REV. 323, 328-29 (1992). One commentator further argued that Feist is simply confusing and hard to interpret. See Timothy Young, Note, Copyright Law: Copyright Protection for Factual Compilations: The White Pages of the Phone Book Are Not Original Enough to Be Copyrighted—But Why?—Feist Publications, Inc. v. Rural Telephone Service Co., 111 S. Ct. 1282 (interim ed. 1991), 17 U. DAYTON L. REV. 631, 660 (1992). But see David Lange, Sensing the Constitution In Feist, 17 U. DAYTON L. REV. 367, 374 (1992) (praising Feist for signalling "a new era of coherence in the constitutional law constraining intellectual property"). These criticisms may be well-founded, but this Note assumes that Feist will remain the law and deals with copyright principles within the context of Feist.

\(^{31}\) Feist, 499 U.S. at 363-64.
original warranting copyright protection. The Court then considered the selection, coordination, and arrangement of Rural's white pages—elements that the Copyright Act specifically lists as copyrightable. The Court found nothing original about selecting the names, addresses, and phone numbers of subscribers listed in the phone book. Similarly, the Court found no originality in the arrangement and coordination of the phone book and noted that "there is nothing remotely creative about arranging names alphabetically in a white pages directory." Thus, because the arrangement and selection of the directory lacked originality, the Court held that those aspects of the directory did not meet the minimum standards of originality necessary for copyright protection. The Court noted, however, that "the originality requirement is not particularly stringent. A compiler may settle upon a selection or arrangement that others have used; novelty is not required. Originality requires only that the author make the selection or arrangement independently . . . and that it display some minimal level of creativity." According to the Court, the white pages do not rise to even this minimal level of originality.

C. PROTECTION FOR THE YELLOW PAGES AFTER FEIST

Although Feist clarified the extent of copyright protection for white pages listings, the decision left unanswered many questions about the treatment afforded other factual compilations, including yellow pages directories. In Key Publica-
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tions v. Chinatown Today Publishing Enterprises, the Second Circuit decided an infringement case involving a yellow pages directory. The creator of the Key directory, Ms. Wang, had collected business cards from businesses that she thought were of particular interest to the Chinese-American community. She sorted the information by type of business, placed each listing in the appropriate category, listed the English and Chinese names, addresses, and telephone numbers of the businesses, and published a directory in 1989. In 1990, the defendant published a yellow pages directory (the "Galore directory") that was also of particular interest to the Chinese-American community. Approximately seventy-five percent of the listings in the Galore di-

in Feist," required "selection, coordination, arrangement, enhancement, and programming . . . that establish the originality and requisite creativity"). Commentators disagree about the extent of protection for computer databases. Some assert that Feist will only minimally affect databases: "[C]ontrary to reports of its demise, copyright remains a vibrant source of protection for proprietors of online databases. Feist should not be read to declare open hunting season on online databases; infringers should proceed at their peril." Sheils & Penchina, supra note 13, at 571. Others feel that Feist leaves databases virtually unprotected: "For proprietors of databases that are compilations of factual material, . . . the copyrights [that] their databases are assuredly entitled to may offer only illusory protection. . . . Under the Supreme Court's analysis, a competitor would be infringing no copyright if it simply stole the data and left the base." Jessica Litman, After Feist, 17 U. DAYTON L. REV. 607, 609 (1992).

Decisions involving other forms of factual compilations have varied. For example, the Second Circuit denied protection to a statistical chart listing data concerning horse racing information, finding nothing original in the arrangement or selection of the information. Kregos v. Associated Press, 937 F.2d 700 (2d Cir. 1991). In contrast, the court did find sufficient originality in a blank form containing different categories of baseball statistics. Victor Lalli Enters. v. Big Red Apple, Inc., 936 F.2d 671, 673 (2d Cir. 1993). A determination of the proper scope of copyright protection for the yellow pages would have an impact on these and other types of factual compilations, as well.

41. See supra note 30 (listing sources critical of Feist).

The Feist Court looked for originality during its infringement analysis, because Feist conceded Rural's directory as a whole deserved copyright protection. 499 U.S. at 361. The Key Publications court, by contrast, first looked for originality to determine whether Key had a valid copyright. 945 F.2d at 512-14. Upon finding originality in the Key directory, the court then proceeded to ask whether the Galore directory had copied any of the Key directory's original aspects. Id. at 514-16. In spite of this difference, the two courts used the same test for originality.
43. Key Publications, 945 F.2d at 511.
44. Id.
45. Id.
rectory had also appeared in the Key directory. The district court found that the Galore directory infringed upon Key’s copyright.

On appeal, the Second Circuit found that certain aspects of the Key directory were sufficiently original to qualify for copyright protection. Contending that the test of originality under Feist was “not particularly rigorous,” the court found that Ms. Wang had performed an original act of selection: she excluded from her publication businesses that she believed would soon close. According to the Second Circuit, this selection showed sufficient thought and creativity to satisfy the Feist standard of originality. Additionally, Ms. Wang selected businesses that were of particular interest to the New York City Chinese-American community, another selective act the court deemed original.

The court further held that when Ms. Wang divided the listings into different business types she performed an original act of arrangement. Although the court found that some of the categories were typical of any yellow pages listing, it reasoned that others, such as “BEAN CURD & BEAN SPROUT SHOPS,” were particularly relevant to the Chinese-American community. Even if Ms. Wang had chosen only typical categories, however, the court asserted that this fact would not preclude a finding of originality. Additionally, the court found that the arrangement was “in no sense mechanical, but involved creativity on the part of Ms. Wang in deciding which categories to include,” reasoning that both the Copyright Act and Feist require originality and creativity, not novelty.

The court concluded that Key Publications possessed a valid copyright in its directory and that certain aspects of the direc-

46. Id.
47. Id. at 511-12.
48. Id. at 512.
49. Id. at 513.
50. Id.
51. The court carefully drew a distinction between deciding which categories to include and placing individual businesses within categories. Choosing and naming categories was an original act, but placing each listing in a category was “the sort of mechanical task that does not merit copyright protection.” Id. at 515.
52. Id. at 514.
53. Id.
54. Id.
tory were original. To win an infringement suit, however, a plaintiff must be able to show a "substantial similarity" between the works. Because the arrangement of the Galore directory was not "even remotely similar" to the Key directory, and because the two directories contained only a small degree of duplication, the court held that the Galore directory did not infringe the Key directory.

At approximately the same time that the Second Circuit heard *Key Publications*, the Eleventh Circuit also addressed the issue of factual compilations in the context of the yellow pages. In *BellSouth Advertising & Publishing Corp. v. Donnelley Information Publishing*, BellSouth Advertising & Publishing Cor-

56. The court acknowledged that the level of originality was not particularly high, but the tasks of selection and arrangement "entailed the de minimis thought needed to withstand the originality requirement." *Key Publications*, 945 F.2d at 514.

57. E.g., *id.*; Eckes v. Card Prices Update, 736 F.2d 859, 863 (2d Cir. 1984). The Second Circuit defined "substantial similarity" as "whether an average lay observer would recognize the alleged copy as having been appropriated from the copyrighted work." *Ideal Toy Corp. v. Fab-Lu Ltd.*, 360 F.2d 1021, 1022 (2d Cir. 1966).

The "substantial similarity" that supports an inference of copying sufficient to establish infringement of a copyright is not a familiar concept to the public at large. Rather, "[i]t is a term to be used in a courtroom to strike a delicate balance between the protection to which authors are entitled under an act of Congress and the freedom that exists for all others to create their works outside the area protected by infringement." *Warner Bros. v. American Broadcasting Cos.*, 720 F.2d 231, 245 (2d Cir. 1983).

58. The court said that an exact replica clearly would have infringed the Key directory, but copyright extends further than just an exact replica. Otherwise, the court noted, an infringer could avoid the copyright by simply changing one fact in the entire listing. *Key Publications*, 945 F.2d at 514.

Comparing the arrangement of the two directories, the court further noted only three of the twenty-eight categories in Chinatown Today's directory duplicated categories in Key's directory. The court did note that both directories listed many of the businesses under similar categories (e.g. as "attorneys and accountants" in the Chinatown Today directory and "attorney and law offices" in the Key directory), but placing listings under categories was not a copyrightable act. Finally, the court looked for a substantial similarity in the selection of businesses listed. Only seventeen percent of Key's listings were present in the Galore directory, and the listings that were included did not come primarily from any one category of Key's directory. Thus, the court found that the listings were not substantially similar. *Id.*

For these reasons, the court concluded that Chinatown Today's directory did not infringe Key's directory. *Id.* at 515-16. To hold otherwise, the court said, essentially would grant Key a monopoly on each of its listings. As long as Chinatown Today used different principles of selection and arrangement, it was entitled to copy the factual information from the Key directory. *Id.* at 516.

poration (BAPCO) published a yellow pages directory and gave one free listing to every business-rate subscriber. After publication of the BAPCO directory, Donnelley Information Publishing, Inc. and Reuben H. Donnelley Corp. (collectively "Donnelley") marked each listing in the BAPCO directory with codes that indicated the size and type of advertisement and the line of business in which the subscriber engaged. Subsequently, Donnelley developed a database containing information about each subscriber. Relying on this database, Donnelley contacted prospective customers and solicited business for its own directory. BAPCO brought suit for copyright infringement, and the district court ruled in BAPCO's favor. A panel of the Eleventh Circuit affirmed the district court's decision in a widely criticized

60. Id. at 1438.
61. Id. at 1439.
62. Id.
63. Id. at 1438-39.
65. Many commentators have criticized the panel decision in BellSouth for being inconsistent with Feist, which the Court decided just a few months earlier. See, e.g., 1 NMmER & NMmER, supra note 13, § 3.04[B] n.53.1 (calling one of the court's findings "ill-taken"); Ginsburg, supra note 13, at 352-53 (noting that the court seems to have "sensed some weakness" in its own arguments); Robert A. Gorman, The Feist Case: Reflections on a Pathbreaking Copyright Decision, 18 RUTGERS COMPUTER & Tech. L.J. 731, 753 (1992) (raising "some doubt as to whether the Feist requirement of minimal creativity was satisfied" in the panel decision); Raskind, supra note 42, at 331 n.3 ("[T]he court seems to have cited Feist and otherwise ignored its reasoning."); Yen, supra note 18, at 1376 n.149 (calling the Eleventh Circuit's findings "rather questionable").

Many of the panel findings are questionable. For instance, the court said that BAPCO had been original in selecting the geographic boundaries of its directory, selecting the closing date for listings in its directory, coordinating all the information into one complete listing, and arranging the coordinated listings into various categories. BellSouth, 933 F.2d at 957-58. It is difficult, however, to see how acts of selecting geographic boundaries, setting a closing date, and coordinating the information are different from acts that are part of creating a white pages directory, yet such acts do not meet even the minimal level of originality required for copyright protection. See Feist Publications v. Rural Tel. Serv. Co., 499 U.S. 340, 361 (1991). The Eleventh Circuit panel gave no reason for making this distinction.
opinion. On rehearing, the Eleventh Circuit sitting en banc reversed the original panel decision.

To determine whether Donnelley had infringed the en banc panel considered which, if any, aspects of the BAPCO di-


67. BellSouth Advertising & Publishing Corp. v. Donnelley Info. Publishing, 999 F.2d 1436 (11th Cir. 1993) (en banc), cert. denied, 114 S. Ct. 943 (1994). The lone dissenter in the en banc BellSouth decision, Judge Hatchett, was one of the three judges who heard the original panel decision. He sharply criticized the majority opinion:

The majority’s holding establishes a rule of law that transforms the multi-billion dollar classified publishing industry from a business requiring the production of a useful directory based on multiple layers of creative decision-making, into a business requiring no more than a successful race to a data processing agency to copy another publisher’s copyrighted work-product. In reaching this incredible result, the majority forsakes thoughtful analysis of the evidence under the governing principles articulated in Feist, and leaps to a conclusion based on nothing more than its collective judgment of what ought to be copyrightable. Id. at 1471 (Hatchett, J., dissenting).

Judge Hatchett agreed with the majority that acts of selecting geographic boundaries and coordinating phone numbers with addresses and names are not protected acts of selection. Id. at 1473. He argued, however, that choosing a system of headings is an original act of selection. Additionally, he argued that categorizing businesses under certain headings constitutes an original act of arrangement, id. at 1474-75, and thus made an argument that Key Publications rejected. Key Publications v. Chinatown Today Publishing Enters., 945 F.2d 509 515 (2d Cir. 1991). Moreover, he argued that BAPCO exercised original selection and arrangement when it included only business rate customers and choose the directory’s geographic boundaries. BellSouth, 999 F.2d at 1477-78 (Hatchett, J., dissenting).

Judge Hatchett also devoted several pages to detailing exactly how Donnel-ley had copied listings from BAPCO’s directory. Id. at 1479-85. It is difficult to see why this discussion is relevant, because Donnelley did not contest the fact that it had used BAPCO’s directory in preparing its own. Because BAPCO could show access, the only meaningful question was substantial similarity.

Judge Hatchett also contended that the majority had reached its decision by considering evidence not presented to the district court. Id. at 1481 n.8. The majority disagreed with this assertion. Id. at 1443 n.17 (opinion of the court).

68. The parties in the BellSouth cases stipulated that the BAPCO directory as a whole was copyrightable. Consequently, the court moved directly to the question of infringement. BellSouth, 999 F.2d at 1440; 933 F.2d at 965. The parties in Key Publications, discussed infra, made no such stipulation, so the court first had to determine whether the directory deserved copyright protection. See Key Publications, 945 F.2d at 512-14. Despite this difference, the two cases posed identical questions. In focusing on whether there was infringement, the court in the BellSouth cases asked the same questions of originality that the Key Publications court answered before it reached the question of in-
The court ruled that when BAPCO selected a geographic scope, determined prospective customers, and offered a number of free listings, it did not perform original acts of selection. Instead, the court considered these acts to be "techniques for discovering facts." According to the court, under Feist, "[t]he protection of copyright must inhere in a creatively original selection of facts to be reported and not in the creative means used to discover those facts." Furthermore, the court found no originality in the arrangement and coordination of BAPCO's directory, concluding that the arrangement was "entirely typical" of yellow pages listings, just as the white pages listings at issue in Feist.

The court held further that BAPCO's arrangement deserved no protection under the merger doctrine, which denies copyright protection if there is only one way or are very few ways to express an idea. Because BAPCO's arrangement was, for any practical purpose, the only way to organize a useful business directory, the court held that it would be unfair to grant BAPCO copyright protection for this arrangement.

In addition to finding that the overall organization of the directory lacked originality, the court concluded that nothing in the coordination or arrangement of BAPCO's system of headings was original. Even if Donnelley had copied the headings from BAPCO's directory, the court ruled that selecting certain business categories, such as "Attorneys" or "Banks," was so obvious that it lacked the originality necessary to qualify for copyright protection. BAPCO's choice of headings also failed under the merger doctrine: the court held that the use of these headings was original.

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fringement. See supra note 42 (comparing the approaches of the courts in Feist and Key Publications).

69. BellSouth, 999 F.2d at 1441.
70. Id.
71. Id.
72. Id.
73. Id. at 1442-43; see also Feist Publications v. Rural Tel. Serv. Co., 499 U.S. 340, 363 (1991) (holding that arranging names alphabetically in the white pages is "practically inevitable" and therefore deserves no copyright protection).
74. See Feist, 499 U.S. at 361.
75. BellSouth, 999 F.2d at 1442.
76. See supra note 17 and accompanying text (discussing the merger doctrine).
77. BellSouth, 999 F.2d at 1442.
78. See supra notes 72-74 and accompanying text (discussing the Feist Court's creativity requirement for selection of facts).
79. BellSouth, 999 F.2d at 1444.
ings was essentially the only useful way to organize a yellow pages directory.80

Finally, the Eleventh Circuit criticized the district court for comparing the appearance of the Donnelley and BAPCO directories,81 concluding that similar appearance did not necessarily imply that Donnelley had copied protected aspects.82 The court recognized that the amount of information that Donnelley took from the BAPCO directory was substantial "in a purely quantitative sense" but contended that this fact alone did not mean that Donnelley had copied the original aspects.83 Although the court acknowledged that copying so much of the plaintiff's work might seem unfair, it noted that in *Feist* the Court cautioned that "[t]he primary objective of copyright is not to reward the labor of authors," but to promote progress in science and the arts.84

II. DISTINGUISHING THE SECOND AND ELEVENTH CIRCUIT APPROACHES TO THE YELLOW PAGES

At first glance, it may appear that the two circuits in the yellow pages cases arrived at the same decision: as long as a competitor does not make an exact or very similar replica, it may copy yellow pages listings without fear of infringement liability. A closer examination, however, reveals subtle but important differences between the two approaches. Specifically, the Second Circuit's test allows a finding of infringement in some cases, even for a "typical" yellow pages listing.85 The Eleventh Circuit's test, by contrast, is much more restrictive and recognizes originality only in extremely limited circumstances, if at all.86

A. THE SECOND CIRCUIT'S APPROACH: THE "ORIGINAL ELEMENTS" TEST

Several factors in *Key Publications* indicate that the Second Circuit is willing to find originality in directories, given the right circumstances. In its analysis, the court carefully emphasized

80. *Id.*
81. The appendix to the court's opinion contains several pages comparing the appearance of the Donnelley and BAPCO page formats. See *id.* at 1447-70.
82. *Id.* at 1445.
83. *Id.*
85. See *infra* notes 87-92 and accompanying text.
86. See *infra* notes 93-100 and accompanying text.
the original elements of the directory, including the selection of businesses Ms. Wang included and the arrangement of the directory into several different categories. Accordingly, the court clearly indicated its willingness to find infringement even in cases in which the defendant had not made an exact replica, refusing to "read Feist in such a broad and self-defeating fashion." The court contended that such limited protection is unacceptable, concluding that although "copyright in a factual compilation is thin," we do not believe it is anorexic. As an example, the court noted that in the past, it had found infringement when an individual simply copied a selection of 5,000 "premium" baseball cards from a previously published directory.

By focusing on particular elements of the directory, the Second Circuit appears very willing to find protected aspects of originality in a yellow pages listing. The facts in Key Publications, however, were simply not appropriate for the court to find infringement, because the court held that the defendant's directory did not copy any original elements of the Key directory. If the defendant's directory had duplicated all the listings under one category, for instance, the court indicated it would have found infringement.

B. THE ELEVENTH CIRCUIT'S APPROACH: THE "GENERAL FORMAT" TEST

The Eleventh Circuit opinion in BellSouth is much more hostile than Key Publications to claims of copyright infringement of the yellow pages. Although the court did accept, for purposes of the case, that the BAPCO directory as a whole is

88. Id. at 514.
90. Id. at 516 (citing Eckes v. Card Prices Update, 736 F.2d 859 (2d Cir. 1984)).
91. "The selection of businesses for the [Galore directory was] significantly different from the 1989-90 Directory." Key Publications, 945 F.2d at 516.
92. Id. at 517. This duplication occurred in Eckes. The essential factor was that the 5,000 listings were the same 5,000 that were listed in the original guide as "premium." This was enough to satisfy the substantial similarity test for copyright infringement. Eckes, 736 F.2d at 863-64.
93. The court's opinion in BellSouth cited Key Publications only once, for a discussion of the "substantial similarity" standard. See BellSouth Advertising & Publishing Corp. v. Donnelley Info. Publishing, 989 F.2d 1436, 1445 n.23 (en banc), cert. denied, 114 S. Ct. 943 (1994). The dissent, on the other hand, cited Key Publications numerous times. See id. at 1471-85 (Hatchett, J., dissenting).
entitled to copyright protection, the court's opinion does not specify which aspects of the directory it considered protected. Rather, the court listed aspects of the directory that are not protected. For example, the court found no originality in BAPCO's selection of businesses to include in the directory, because BAPCO gave a free listing to every business-rate telephone customer. The court failed to note, however, that BAPCO deliberately chose to exclude residential rate customers, whereas Donnelley did include such customers in its directory. The choice to exclude certain businesses may not seem particularly creative. BAPCO's decision, however, contains as much a degree of creativity as excluding businesses that would soon close—a selection that the Second Circuit found worthy copyright protection in Key Publications.

Finding no originality in the selection of businesses in the BAPCO directory, the Eleventh Circuit turned to the issue of original arrangement. This analytical step marks the point at which the approaches of the two circuits differ significantly. The Eleventh Circuit, rather than focusing on the selection and arrangement of the elements of the directory, concentrated on the question of whether the general format of the directory was original. The court found that BAPCO's heading structure, "an alphabetized list of business types, with individual businesses listed in alphabetical order under the applicable headings," is "entirely typical" and deserves no protection. In this respect, the court's decision is similar to the treatment the Supreme

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94. Id. at 1440 & n.11. Although the court did not explain exactly what it meant by a valid copyright in the directory as a whole, it probably refers to the same things that received undisputed copyright protection in Feist, such as a foreword and original text within the advertising section. See supra note 27.

95. BellSouth, 999 F.2d at 1441.

96. The dissent raised this point. Id. at 1476-77 (Hatchett, J., dissenting). For a summary of the dissenting opinion, see supra note 67.

97. Every business-rate telephone subscriber within the specified geographical boundaries received one free listing under the appropriate heading. Each was then free to purchase additional listings under different headings or advertisements to go along with its listings. BellSouth, 999 F.2d at 1438. Because of the factual situation, it is impossible to know how the court would have ruled if BellSouth had shown some discretion in choosing which businesses to include.

98. Before discussing the arrangement of headings within the directory, the court found that the arrangement of listings within each category was "entirely typical." Id. at 1442. This is in accord with Key Publications, in which the court said that arranging businesses under headings was mechanical and not original. Key Publications v. Chinatown Today Publishing Enters., 945 F.2d 509, 515 (2d Cir. 1991).

99. BellSouth, 999 F.2d at 1442 & n.13.
Court afforded the white pages in *Feist*. The court, however, failed to also consider whether the specific arrangement of categories and headings within the general structure might be original.

C. CONTRADICTIONS IN THE TWO APPROACHES

The Eleventh Circuit’s approach directly contradicts *Key Publications*. The Second Circuit acknowledged that the format of the Key directory was “common to most classified directories.” The court did not focus, however, on the general format. Instead, the court was concerned only with finding creativity in particular elements of the directory, such as the act of deciding “which categories to include and under what name.” The Eleventh Circuit in *BellSouth*, by contrast, would deny copyright protection to any arrangement of categories that seemed “entirely typical of its respective type,” regardless of how much creativity the compiler had demonstrated in selecting or arranging certain information.

The Second Circuit and Eleventh Circuit tests, therefore, differ significantly in their approaches to copyright protection for yellow pages directories. The Second Circuit considers the organization within specific elements of headings and businesses. Its approach recognizes that if the compiler used creativity in selecting and organizing the directory, the arrangement deserves copyright protection, even if the directory is typical of its kind. The Eleventh Circuit approach, in contrast, focuses on the overall organization of the directory, holding that listing businesses alphabetically under appropriate business headings can never be original, regardless of how an individual selected those headings and businesses.

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101. *Key Publications*, 945 F.2d at 514.
102. *Id.*
103. *BellSouth*, 999 F.2d at 1443 (quotations omitted).
104. The court cited two other examples of listings that were typical of their types. *BellSouth*, 999 F.2d at 1442 n.13. One of those examples was an automobile catalog that listed replacement parts. Even though the catalogs were arranged in three sections, the arrangement was obligatory for a parts catalog. The court was not concerned with the arrangement of those three sections or the businesses listed under them. *Cooling Sys. & Flexibles v. Stuart Radiator*, 777 F.2d 485, 492 (9th Cir. 1985).
105. See *Key Publications*, 945 F.2d at 513-14.
106. See *id*.
107. See *BellSouth*, 999 F.2d at 1441-43.
situations, of course, these tests will achieve identical results and result in a finding of no infringement, which occurred in the *Key Publications* and *BellSouth* cases.\(^{108}\)

In a slightly different factual situation, however, the two approaches would reach opposite results. If, for example, the Galore directory had copied and used all of the Key directory headings, the Second Circuit’s original aspects test would most likely have found infringement, because copyright law protected Ms. Wang’s original arrangement.\(^{109}\) She used creativity in choosing which headings to include.\(^{110}\) Indeed, copyright law would have protected the Key directory even if the two directories had not contained identical business listings.\(^{111}\) The Second Circuit would also likely have found infringement if the defendant’s directory had copied all of the listings under individual headings.\(^{112}\) In contrast, under the Eleventh Circuit’s general format test, such an arrangement would be “entirely typical” for a yellow pages listing and would deserve no copyright protection.\(^{113}\)

As the above example shows, the two different approaches can sometimes lead to different results. Because the two approaches may reach contradictory results, it is important to determine which approach is most consistent with *Feist* and to understand the implications of that approach to different types of factual compilations.

### III. RECOGNIZING ORIGINALITY IN FACTUAL COMPILATIONS

#### A. Problems With *BellSouth’s General Format Test*

The Eleventh Circuit’s *BellSouth* decision used a standard of originality that is inconsistent with the Supreme Court’s approach in *Feist*. In *Feist*, although the Court denied copyright protection to a white pages directory because it lacked originality, the decision indicated that the required standard of originality is quite low.\(^{114}\) Most compilations would qualify for

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108. *Id.* at 1446; *Key Publications*, 945 F.2d at 516-17.
109. *See Key Publications*, 945 F.2d at 514.
110. *See id.* at 513-14.
111. *See id.* at 514 (interpreting *Feist* to allow a finding of infringement even without exact duplication); *see also supra* text accompanying note 88.
112. *Key Publications*, 945 at 516-17.
113. *See BellSouth*, 999 F.2d at 1442 & n.13.
The white pages directory in Feist failed because its arrangement was "entirely typical." Specifically, the court stated that "there is nothing remotely creative about arranging names alphabetically in a white pages directory. It is an age-old practice, firmly rooted in tradition . . . . It is not only unoriginal, it is practically inevitable. . . . [It] does not possess the minimal creative spark required . . . ."

In BellSouth, the Eleventh Circuit, by interpreting Feist to bar copyright protection for the selection and arrangement of a yellow pages directory, ignored the fact that the level of creativity that Feist required in a factual compilation is quite low and that the arrangement and selection in a compilation need not be novel. Although the general structures of most yellow pages directories are similar, compiling a yellow pages directory may involve several original acts that require more creativity than the "entirely typical" compilation of a white pages directory. A compiler of a white pages directory simply gathers information from a geographical area and alphabetizes the data. Although this task may require significant effort, it requires no originality. The compiler of a yellow pages directory, by contrast, must make a number of original decisions, such as deciding which businesses to include, which categories to use, how to arrange the information, and how to present the information. The level of originality involved in these acts may not be extremely high, but, according to Feist, the level of originality and creativity necessary for protection should be minimal.

Thus, by requiring that a yellow pages directory be somehow atypical or unlike other yellow pages directories, the Eleventh Circuit has raised the threshold of required originality higher than the Feist decision established. Commentators agree

115. Id. Even if a compilation does receive copyright protection, however, that protection is limited. Id. at 359.
116. Id. at 362.
117. Id. at 363.
119. See supra text accompanying note 38 (quoting Feist's statement that "the originality requirement is not particularly stringent").
120. See Feist, 499 U.S. at 362.
121. Id. at 363-64.
123. Feist, 499 U.S. at 358-59.
124. See BellSouth, 999 F.2d at 1442.
that even a typical yellow pages directory deserves copyright protection under Feist. 125

The Eleventh Circuit test has other flaws, most notably, its reliance on the merger doctrine. 126 Under that doctrine, the court feared that granting copyright protection to a particular selection of headings in a yellow pages directory would prevent a competitor from using the same headings. 127 The merger doctrine, however, does not apply, because there are many possible selections of headings. The court's concern is misplaced. Granting copyright protection to a certain selection of headings would not in any way prevent a competitor's use of a similar or even identical headings, because "novelty is not required" for a factual compilation to receive copyright protection. 128 Copyright law prevents copying, not independent creation; therefore, a competitor would be free to use a similar or even identical headings provided that it selected these headings itself, rather than copying from the first directory. 129

Not only is the Eleventh Circuit's "originality" threshold improper from a legal standpoint, but it also may create financial disincentives to the creation of factual compilations. 130 The proper test for originality in factual compilations must protect

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125. Professor Nimmer, on whom the Court relied heavily in Feist, took for granted that yellow pages directories satisfy the minimal requirements of originality, even in light of Feist. "[Feist] does not bar copyright protection for telephone book yellow pages, or even white pages that are selected, coordinated or arranged in an original fashion." 1 Nimmer & Nimmer, supra note 13, § 3.04[B] (footnotes omitted); see also John P. MacDonald, The Search for Certainty, 17 U. Dayton L. Rev. 521, 535 (1992) ("By using the correct analysis the Key [Publications] court rendered a result that conforms with the meaning of Feist.").

Professor Nimmer suggested two other examples that might meet the requirement of originality: a list of the one hundred most important phone numbers in town, chosen and ordered in a particular way, and an alphabetical listing of phone numbers relevant to operating a catering business. 1 Nimmer & Nimmer, supra note 13, § 3.04[B] n.54. It does indeed seem difficult to find a meaningful distinction between those two examples and a "typical" yellow pages directory.

126. See supra note 17 and accompanying text (discussing principles of the merger doctrine).

127. BellSouth, 999 F.2d at 1444.


129. Feist, 499 U.S. at 358; 1 Nimmer & Nimmer, supra note 13, § 2.01[B]. This is in contrast to patent law, in which a device infringes a patent even if the second inventor had no knowledge that the device already existed. 35 U.S.C. § 271(a) (1988).

130. See infra notes 140-145 and accompanying text (discussing economic incentives for the creation of factual compilations).
the original selection and arrangement of the fact but not the facts themselves.131

B. THE SECOND CIRCUIT'S ORIGINAL ELEMENTS APPROACH: A BETTER ANALYSIS OF ORIGINALITY

The Second Circuit's test for originality in *Key Publications* strikes the proper balance between protected and unprotected aspects of a factual compilation. In essence, the Second Circuit finds originality if a particular aspect of a factual compilation exhibits a minimal amount of creativity.132 Such protection, however, must necessarily be "thin" and covers only the selection and arrangement.134 Unlike the Eleventh Circuit, the Second Circuit, which has traditionally been the most influential in developing copyright law,135 properly follows the *Feist* approach. The court's analysis fits well with existing copyright jurisprudence.136

In its decision, the court recognized that although the creativity involved in the Key directory was minimal, it met the copyright threshold requirement of originality.137 The Supreme Court in *Feist* noted that novelty is not a requirement for originality and that a compiler could use a selection or arrangement that others had used.138 Following *Feist*, the *Key Publications* court appropriately looked for originality in the selection and arrangement of aspects of the yellow pages directory within this non-novel format.139

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131. See *Feist*, 499 U.S. at 350-51.
133. *Feist*, 499 U.S. at 349.
134. *Key Publications*, 945 F.2d at 513.
135. Raskind, supra note 42, at 338. The Second Circuit was one of the first circuits to use the "sweat of the brow" theory that *Feist* discarded. See Jeweler's Circular Publishing Co. v. Keystone Publishing Co., 281 F. 83 (2d Cir.), cert. denied, 259 U.S. 581 (1922). The *Feist* decision cited Jeweler's Circular as an example of a case that applied the flawed "sweat of the brow" doctrine. *Feist*, 499 U.S. at 353. The Second Circuit, however, abandoned the doctrine several years before the *Feist* decision. See Rosemont Enterps., Inc. v. Random House, Inc., 366 F.2d 303, 309-10 (2d Cir. 1966), cert. denied, 385 U.S. 1009 (1967). Subsequent Second Circuit decisions have applied the correct standard. See, e.g., Eckes v. Card Prices Update, 736 F.2d 859, 862 (2d Cir. 1984) (noting that the Second Circuit has been "particularly restrictive" in granting copyright protection based solely on the compiler's efforts).
136. See supra note 125 (discussing commentators, including Nimmer, who support the *Key Publications* approach).
137. *Key Publications*, 945 F.2d at 514.
139. *Key Publications*, 945 F.2d at 513-14.
In addition to being superior from a legal standpoint, the Second Circuit test is preferable from an economic standpoint. Because the purpose of copyright law is to promote the creation of beneficial works, the law should provide incentives to create useful factual compilations. If competitors can copy an entire compilation, they may receive a "free ride" and profit from the creator's work. Free riders may discourage creation of factual compilations because these imitators have lower costs and are able to charge less for their products. By offering greater protection to factual compilations, the Second Circuit's broader approach to originality helps to provide the necessary incentives.

The yellow pages provide a good illustration of these incentives. The first creator of a yellow pages directory gathers information about potential customers, solicits business, chooses categories, places businesses in categories, and arranges the directory in what the creator feels is an appropriate manner. Without any type of protection for the original work, a competitor would be free to enter the same market, use the same categories and arrangement, and essentially copy the original directory, saving time and money because of the original compiler's work. Because the original compiler has spent more money to create its directory, the second compiler has lower costs.

140. The "sweat of the brow" approach would also offer economic incentives to creators of factual compilations. That approach, however, goes too far, because it protects the facts themselves, which the Copyright Act does not permit. See 17 U.S.C. § 103(b) (1988); see also supra note 20 and accompanying text (discussing and criticizing the "sweat of the brow" approach).

141. See U.S. Const. art. I, § 8, cl. 8.

142. Copyright does have its limits, though. Other avenues may be available to protect factual compilations. See supra note 13.

143. See generally Yen, supra note 18, at 1364-75 (discussing the free rider problem). Professor Yen ultimately concluded that the creative selection approach does not provide the necessary incentive for creation of factual compilations and suggested a dramatic restructuring of copyright law. Id. at 1375-78. Discussion of such a proposal is outside the scope of this Note.

144. See id. at 1364-75.

145. See generally Dennis S. Karjala, Copyright and Misappropriation, 17 U. DAYTON L. REV. 885 (1992) (encouraging a permissive interpretation of the originality requirement to encourage the creation different types of useful works).

146. Of course, gathering business and soliciting customers, in and of themselves, are not protected activities. These activities could only receive protection under the "sweat of the brow" doctrine, which the Court discarded in Feist. See Feist Publications v. Rural Tel. Serv. Co., 499 U.S. 340, 353-54 (1991); see also supra note 20 and accompanying text (describing the "sweat of the brow" doctrine and discussing its flaws).
costs and is able to undercut the price of the first compiler. This punishes the first compiler and discourages it from creating the work.147

If the arrangement of the first directory receives copyright protection, the competitor may still use the facts contained in the original directory, of course, because facts are not copyrightable.148 The arrangement and selection of the directory, however, do receive protection,149 which would prevent the competitor from copying those aspects. This protection would increase the competitor's expenses and reduce the cost disparity between the original compiler and the competitor, thus providing more incentive for the creation of compilations.150

147. Cf. Karjala, supra note 145, at 926-28 (encouraging an extension of legal protection for works subject to piracy to encourage production of such works).
149. Feist, 499 U.S. at 350.
150. Although the Key Publications and BellSouth cases deal specifically with yellow pages directories, their approaches to protection of factual compilations have important ramifications for other types of compilations. The Feist Court held that the arrangement of a typical white pages directory lacked the necessary originality for copyright protection, see discussion supra part I.B., but Feist's application to other factual compilations is unclear, see supra note 40 (discussing additional areas of factual compilations). Under the Copyright Act, computer programs and databases are subject to copyright protection, see id., but the general format approach to the yellow pages would also undermine the congressional intent to protect the arrangement of such databases.

Congress established the National Commission on New Technological Uses of Copyrighted Works (commonly known as CONTU) to make recommendations concerning copyright protection for computers, among other things. In response to CONTU's recommendations, Congress amended sections of the Copyright Act to make provisions for copyright protection for computers. Sheils & Penchina, supra note 13, at 570 n.60. In its report, CONTU described the protection that databases should receive:

The use of one item retrieved from [a database]—be it an address, a chemical formula, or a citation to an article—would not under reasonable circumstances merit the attention of the copyright proprietor. Nor would it conceivably constitute infringement of copyright. The retrieval and reduplication of any substantial portion of a data base, whether or not the individual data are in the public domain, would likely constitute a duplication of the copyrighted element of a data base and would be an infringement. . . .

It appears that adequate legal protection for proprietary rights in extracts from data bases exists under traditional copyright principles as expressed in the new law . . . . The unauthorized taking of substantial segments of a copyrighted data base should be considered infringing, consistent with the case law developed from infringement of copyright in various forms of directories.

FINAL REPORT OF THE NATIONAL COMMISSION ON NEW TECHNOLOGICAL USES OF COPYRIGHTED WORKS 42 (1978) [hereinafter CONTU REPORT] (emphasis added) (footnotes omitted).
Although appropriate from both a legal and a policy standpoint, the Second Circuit's original elements test does present a potential difficulty: courts may apply the test in an arbitrary manner. It may be fairly simple to determine when a directory contains an original selection or arrangement, but determining whether a competing directory meets the "substantial similarity" test for infringement may prove difficult. The court in *Key Publications* illustrated two extremes: a directory that copied all of the headings and the businesses listed in another directory would clearly infringe the copyright, but a directory containing only three of the twenty-eight categories and only seventeen percent of the same listings would not. The facts in these examples made the decisions relatively easy, but it is difficult to know where courts should draw the line between infringement and permitted duplication. Substantial similarity could require duplication of half of the headings or duplication of even ninety percent. If an individual changed one listing in a factual compilation, the *Key Publications* analysis would not preclude a finding of infringement, but if an individual changed five percent of the listings, the analysis could preclude such a finding. The *Key Publications* analysis does not provide clear answers to these problems. In contrast, the Eleventh Circuit...
test has the advantage of certainty.\textsuperscript{156} By simply denying copyright protection to virtually all "typical" yellow pages listings, the Eleventh Circuit approach eliminates troublesome gray areas.

Line drawing, however, is an unavoidable part of copyright law. Drawing copyright lines, although sometimes difficult and even arbitrary, is no more difficult in the case of factual compilations than in music or drama.\textsuperscript{157} "Nobody has ever been able to fix that boundary [between infringement and permitted duplication], and nobody ever can."\textsuperscript{158} The fact that the line will seem arbitrary, however, "is no excuse for not drawing it."\textsuperscript{159}

Courts can best deal with these problems by using the same substantial similarity analysis that they use in other areas of copyright law.\textsuperscript{160} Because the substantial similarity test is based on the perspective of the average lay observer,\textsuperscript{161} it makes sense to apply the same standard in the case of yellow page directories, whose target audience is the average consumer.\textsuperscript{162} The substantial similarity test for factual compilations, therefore, is whether an average lay observer would recognize the selection, arrangement, or coordination of the alleged copy as having been appropriated from the copyrighted directory.\textsuperscript{163} Although this test is not numerically precise, it provides per-

\textsuperscript{156} See discussion supra part II.B.

\textsuperscript{157} See, e.g., Arnstein v. Porter, 154 F.2d 464 (2d Cir. 1946) (drawing lines between musical selections); Sheldon v. Metro-Goldwyn Pictures Corp., 81 F.2d 49 (2d Cir.) (drawing lines between a book, a play, and a movie), cert. denied, 298 U.S. 669 (1936); Nichols v. Universal Pictures Corp., 45 F.2d 119 (2d Cir. 1930) (drawing lines between a play and a movie).

\textsuperscript{158} Nichols, 45 F.2d at 121 (L. Hand, J.).

\textsuperscript{159} Id. at 122.


\textsuperscript{161} See supra note 57 and accompanying text (discussing the substantial similarity test).

\textsuperscript{162} Suits involving directories do not necessarily go to an actual jury of lay observers, however. \textit{Feist, BellSouth,} and \textit{Key Publications} were all appeals from grants of summary judgment. In ruling on summary judgment motions, though, courts should use the standard of the average lay observer.

\textsuperscript{163} Cf. \textit{Ideal Toy Corp. v. Fab-Lu Ltd.}, 360 F.2d 1021, 1022 (2d Cir. 1966) (articulating the "substantial similarity" test as "whether an average lay observer would recognize the alleged copy as having been appropriated from the copyrighted work").
haps the best way to balance the Copyright Act's apparent ten-
sions.164 It provides protection for expression of the facts while
denying protection to the facts themselves.165

CONCLUSION

The Supreme Court settled questions of copyright for white
directories in Feist, requiring that the directories contain
at least a minimal amount of originality. The decision did not,
however, answer the question of whether the selection or ar-
rangement of the elements of compilations such as yellow pages
directories could be sufficiently original to qualify for copyright
protection. There is some inconsistency among the circuit courts
concerning the required level of originality. The Eleventh Cir-
cuit, in BellSouth, interpreted Feist to hold that a yellow pages
directory would need to be different from a typical directory in
its organization and arrangement to qualify for copyright protec-
tion. The Second Circuit, by contrast, held in Key Publications
that even a typical yellow pages listing deserves copyright pro-
tection if there is creativity in the selection of businesses listed
and in the arrangement and coordination of the directory. Al-
though the distinctions will not always matter, in certain situ-
atations, the two approaches may lead to opposite results.

The Eleventh Circuit test has the effect of raising the re-
quired threshold of originality for compilations higher than the
Feist decision allows. The less stringent Second Circuit test in
Key Publications sets the threshold of originality at the level re-
quired by Feist. The Second Circuit test's requirement of line
drawing, though more difficult to implement, is similar to re-
quirements in other areas of copyright law. In dealing with
cases of copyright infringement of the yellow pages and other
factual compilations, therefore, courts should use the standard
of originality suggested in Key Publications and protect the se-
lection and arrangement of such compilations.

164. See supra notes 14-17 and accompanying text (discussing the apparent
tensions in the Copyright Act).
165. See supra note 57 (discussing the balancing function of the substantial
similarity requirement).