

VINCENT VAN GOGH, "SWEAT OF THE BROW" AND DATABASE PROTECTION

*Jordan M. Blanke**

I. INTRODUCTION

A recent New York Times article¹ described the plight of a former computer programmer who decided to devote himself full time to the creation of the definitive Vincent van Gogh Web site. Over the course of five years, David Brooks collected, scanned and digitally reproduced copies of every known work of van Gogh, including paintings, drawings, watercolors, sketches and letters -- to and from van Gogh. The resulting Web site, The Vincent van Gogh Gallery,² is very attractive and comprehensive.

Brooks was extremely upset to learn that someone in the Netherlands had also created a Web site devoted to van Gogh, and had apparently copied many of the graphical images that Brooks had made. Furthermore, the site contained the translated text of the 864 letters that Brooks had compiled. The resulting Web site, About Van Gogh Art,³ is also very attractive and comprehensive.

Brooks said it took him five years to compile his site, but "the man who stole my site was able to do it in a matter of two hours."⁴ Brooks said there were about 15 images that "you simply can't find anywhere else in color, and I found them on this guy's Web site, the same size, pixel for pixel."⁵

What was possibly even more painful for Brooks to discover was that most of what had been copied was done so legally. Other than the translated letters,⁶ which are subject to copyright protection as derivative works,⁷ the rest of the material is part of the public domain and, therefore, freely copyable.⁸

Many a reader may sympathize with the plight of David Brooks, who painstakingly, tediously, even lovingly, gathered a great deal of information over a long period of time to create an excellent Web site. However, copyright law does not help him in this situation. In fact, its primary purpose demands that it permit this kind of copying. David Brooks compiled a database containing primarily public domain works. These works cannot be afforded any further protection under copyright law. Instead, if there were any protection to be found, it would be for the creativity in the compilation of the Web site as a whole.

* Professor of Computer Information Systems and Law, Stetson School of Business & Economics, Mercer University.

¹ Nancy Matsumoto, *When the Art's Public, Is the Site Fair Game?*, N.Y. TIMES, May 17, 2001, at G6.

² The Vincent van Gogh Gallery, at <http://www.vangoghgallery.com> (last visited Mar. 14, 2002).

³ About Van Gogh Art, at <http://www.about-van-gogh-art.com> (last visited Mar. 14, 2002).

⁴ Matsumoto, *supra* note 1.

⁵ *Id.*

⁶ The letters were removed from the About Van Gogh Art Web site. *Id.*

⁷ 17 U.S.C. §§ 101, 103(b) (2001).

⁸ The present duration of a copyright in the United States for a natural person is life of the author (artist) plus 70 years. 17 U.S.C. § 302 (2001). While this duration has varied over the years, there is no question that the works of van Gogh, all created over 100 years ago, had long since entered the public domain.

Ever since the advent of the CD-ROM, and particularly since the time that the Internet and World Wide Web became part of our daily lives, there has been a question as to whether the contents of databases should be protected. Before we became "digitized," copying large quantities of information was often a difficult and tedious task. Now, technology has made the act of copying as simple as clicking a mouse.

One need only to look at the Web to see how easy it has become to collect and copy information of any type. Words, images, music and video are compiled neatly, and digitally, on thousands of Web sites, waiting to be read, viewed, listened to, and copied, by even the most novice of computer users.⁹

While some people may view the Web as a utopian environment, where ideas and information are readily and freely exchanged, others may see it as a horrific nightmare, where goods and wares are stolen by thieves who cannot even be seen. The digital media that have evolved and replaced their analog counterparts over the last two decades have all come to roost on the Web. Massive amounts of digital information, in numerous formats, are now available in cyberspace.

This paper examines how copyright law and other legal theories have been used to protect databases in general, with a special emphasis on databases found on the Internet. It presents a model for applying copyright principles to databases. The model focuses on the creativity of the compilation and the creativity of its components. This paper concludes that copyright law, even with the advent of the Internet, should not be extended to protect non-creative compilations of non-creative works. Such works exhibit no originality or creativity, and therefore, should not be protected by copyright. If a database is worthy of any copyright protection, it is either because its individual components are copyrightable, or because its arrangement, coordination or selection of data is sufficiently creative. The medium where the database is stored should not change the legal principles.

This paper also explores some of the alternate legal theories that have been used to protect databases, including contract law, trespass to personal property, and misappropriation. Finally, this paper discusses the sui generis right for databases established by the European Union, and efforts in this country to legislate similar protection.

What Is a Database?

The term "database" is very broad. It includes both non-electronic and electronic collections of data. For example, it includes a traditional, paper telephone directory, as well as an electronic version of the directory contained on a CD-ROM or on a Web site. It includes what we could call either "creative" or "non-creative" compilations of data. A creative compilation would exhibit some degree of creativity or originality in the arrangement, coordination or selection of its data. A non-creative compilation would exhibit no such creativity or originality, for example, an alphabetical listing of names and addresses.

⁹ A search of the name "Van Gogh" on the Yahoo! search engine returns over 70 matching Web sites, most of which contain paintings, drawings and other works of Van Gogh, at <http://www.yahoo.com/> (last visited Mar. 14, 2002).

Furthermore, databases may contain individual elements that are creative works, worthy of copyright protection themselves. For example, the individual components of a collection of photographs or newspaper articles may each be entitled to copyright protection. In contrast, we may have a compilation of facts, such as names and addresses, or public domain items, like court cases or old songs, that are not individually entitled to copyright protection. We could describe these individual components as being either "creative" or "non-creative" works.

Broadly speaking, a database includes any collection of data. The collection (or compilation) may be creative or non-creative, and the data themselves may be creative or non-creative. Thus, we have four different combinations, e.g., a creative compilation of non-creative facts. As we will see, only some of these combinations should be entitled to copyright protection.

II. PROTECTING DATABASES UNDER COPYRIGHT LAW

A. *History of Copyright Law*

In order to better understand what the copyright law protects, it is important to trace some of its history. The scope and duration of its protection have changed dramatically over the years as the technology has changed. The source of authority for copyright law comes from the Intellectual Property Clause of the United States Constitution, which states that Congress shall have the power "[t]o 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."¹⁰

As this language clearly suggests, the main purpose of the copyright and patent systems is to benefit the public at large – to promote the progress of science and the useful arts.¹¹ This is achieved by granting to authors and inventors exclusive rights (i.e. a

¹⁰ U.S. Const. art. I, § 8, cl. 8.

¹¹ The drafters of the Intellectual Property Clause were greatly influenced by the language from the title to the Statute of Anne, the English Copyright Act of 1710: "An act for the encouragement of learning, by vesting copies of printed books in authors or purchasers of such copies during the times therein mentioned." 8 Anne, ch. 19 (1710). Professor L. Ray Patterson describes in great detail the probable origin of the Intellectual Property Clause, and the implications of the words and phrases that were included and those that were excluded. See L. Ray Patterson, *Copyright Overextended: A Preliminary Inquiry into the Need for a Federal Statute of Unfair Competition*, 17 DAYTON L. REV. 385, 396-403 (1992). Also significant, and explained in great detail by Professor Patterson, is the fact that two types of copyrights had evolved under English law: a statutory copyright and a common law copyright. The former focused on the rights of the copyright owner to publish and sell the book. These rights lasted only for a finite period of time. The latter focused on a natural law theory under which the author was entitled to a property right in his work that would, theoretically, last forever. This common law copyright was modified, however, by case law that recognized this property interest only until the work was published (at which time the statutory copyright would come into play). Patterson surmises that the founding fathers were well aware of the two different types of copyrights under English law, and chose the statutory approach, rather than recognize a property-like interest in the author. *Id.* at 401-403. See also Edward Walterscheid, *Defining the Patent and Copyright Term: Term Limits and the Intellectual Property Clause*, 7 J. INTEL. PROP. L. 315, 316-56 (2000) (detailed discussion of the evolution of the American copyright); *Suntrust Bank v. Houghton Mifflin Co.*, 268 F.3d 1257, 1260-63 (11th Cir. 2001) (court discussed the history and purpose of the copyright law in vacating a lower court order that had enjoined publication of *The Wind Done Gone* because it infringed the copyright of *Gone With the Wind*).

limited monopoly) for a specified period of time. If the author's or writer's creation does not satisfy the minimum requirements of copyright or patent law, the creation is not protected – it becomes part of the public domain. Similarly, even if the creation does warrant protection, once the specified period of time for the exclusive rights expires, the creation becomes part of the public domain.¹²

Facts are not copyrightable. Scientific principles and mathematical formulas are not patentable. They are part of the public domain. Society can benefit from such a public domain only if the information in it is freely accessible. The system rewards authors and inventors in order to provide an incentive for them to continue to create.¹³ But the reward comes with a price. After its term of protection expires, that creation becomes part of the public domain.

Over the course of time, the scope of the copyright law expanded to accommodate new technologies. As new media for expression developed, they were added to the reach of the law. At the same time, the duration of the copyright protection also greatly increased.

The first copyright law, the Copyright Act of 1790, granted a copyright interest to authors of maps, charts and books for a period of 14 years, renewable for one additional term of 14 years.¹⁴ In 1802, prints and engravings became eligible for protection.¹⁵ In 1831, musical compositions were added to the list, and the length of the first term was increased from 14 to 28 years.¹⁶ In 1856, the subject matter was extended to include the

¹² In *Suntrust*, the court stated the copyright laws were enacted to achieve "three main goals: the promotion of learning, the protection of the public domain, and the granting of an exclusive right to the author." 268 F.3d at 1261.

The second goal of the Copyright Clause is to ensure that works enter the public domain after an author's rights, exclusive, but limited, have expired . . . The public is protected in two ways: the grant of a copyright encourages authors to create new works . . . and the limitation ensures that the works will eventually enter the public domain, which protects the public's right of access and use.

Id. at 1262.

¹³ See *Sony Corp. v. Universal City Studios, Inc.*, 464 U.S. 417 (1984) (The Supreme Court held that the sale of home videotape recorders was not a contributory infringement because many of the copyright owners of programs broadcast over the airwaves would not object to the mere "time-shifting" of the recorded programs). In discussing the purpose of the Intellectual Property Clause, the Court stated:

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

"The copyright law, like the patent statutes, makes reward to the owner a secondary consideration. In *Fox Film Corp. v. Doyal*, 286 U.S. 123, 127 [1932], Chief Justice Hughes spoke as follows respecting the copyright monopoly granted by Congress, 'The sole interest of the United States and the primary object in conferring the monopoly lie in the general benefits derived by the public from the labors of authors.' It is said that reward to the author or artist serves to induce release to the public of the products of his creative genius." *United States v. Paramount Pictures, Inc.*, 334 U.S. 131, 158 (1948).

Id. at 429.

¹⁴ Copyright Act, ch. 15, 1 Stat 124 (1790).

¹⁵ Copyright Act, ch. 36, 2 Stat 171-172 (1802).

¹⁶ Copyright Act, ch. 16, 4 Stat 436-439 (1831).

public performance of dramatic works,¹⁷ in 1865, photographs,¹⁸ and in 1870, paintings, drawings and statues.¹⁹ In 1909, the copyright law was completely revised (the "1909 Act").²⁰ It provided copyright protection for "all the writings of an author," and extended the length of the second renewal term to 28 years, thus authorizing copyright protection for a period of 56 years.

B. The Copyright Act of 1976

The copyright laws were completely overhauled again by the Copyright Act of 1976 (the "1976 Act").²¹ The copyright interest now extends to "original works of authorship fixed in any tangible medium of expression"²² and includes: "(1) literary works; (2) musical works, including any accompanying words; (3) dramatic works, including any accompanying music; (4) pantomimes and choreographic works; (5) pictorial, graphic, and sculptural works; (6) motion pictures and other audiovisual works; (7) sound recordings; and (8) architectural works."²³

One of the reasons for the dramatic changes in the 1976 Act was to correct and clarify a number of copyright principles relevant to the protection of databases.²⁴ Under the 1909 Act, one of the subject matter categories for copyright was "books, including composite and cyclopaedic works, directories, gazetteers, and other compilations."²⁵ Despite language in the section that indicated that this did not mean that all compilations were automatically copyrightable, some courts erroneously inferred that directories and other such compilations were copyrightable *per se*.²⁶ This misinterpretation also gave rise to the "sweat of the brow" doctrine, which incorrectly awarded copyright protection to compilers of facts or ideas merely because they had gathered together such information.²⁷

The 1976 Act introduced two important definitions. Under Section 101, a "collective work" is defined as a "work, such as a periodical issue, anthology, or encyclopedia, in which a number of contributions, constituting separate and independent works in themselves, are assembled into a collective whole."²⁸ 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."²⁹ The term "compilation" includes "collective works."³⁰

¹⁷ Copyright Act, ch. 169, 11 Stat 138-139 (1856).

¹⁸ Copyright Act, ch. 126, 13 Stat 540-541 (1865).

¹⁹ Copyright Act, ch. 230, 16 Stat 212-217 (1870).

²⁰ 17 U.S.C. § 1 (1909) (repealed 1978).

²¹ Copyright Act, 90 Stat. 2541 (1976) (current version at 17 U.S.C. § 101 (2001)).

²² 17 U.S.C. § 102 (2001).

²³ *Id.*

²⁴ See *Feist Publications, Inc. v. Rural Telephone Service Co. Inc.*, 499 U.S. 340, 350-60 (1991); see also *infra* notes 45-55 and accompanying text.

²⁵ 17 U.S.C. § 5(a) (1909) (repealed 1978).

²⁶ *Feist*, 499 U.S. at 352.

²⁷ *Id.* at 352-56.

²⁸ 17 U.S.C. § 101 (2001).

²⁹ *Id.*

³⁰ *Id.*

The 1909 Act had provided that copyright protects only the "copyrightable component parts" of a work.³¹ There was much confusion as to what this meant.³² Section 102(b) of the 1976 Act shed some light: "In 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."³³ Congress emphasized that this section did not change the law, but merely clarified it.³⁴ Copyright protection would no longer extend to compilations of facts that were not original.³⁵

Finally, and significantly, with the 1976 Act, "Congress enacted two new provisions. First, to make clear that compilations were not copyrightable *per se*, Congress provided a definition of the [previously discussed] term 'compilation.' Second, to make clear that the copyright in a compilation did not extend to the facts themselves, Congress enacted § 103."³⁶ Under that section, "compilations" became the subject matter of a separate copyright interest.³⁷ The copyright in a compilation "extends only to the material contributed by the author of such work, as distinguished from the preexisting material employed in the work."³⁸ The copyright in a compilation is "independent of, and does not affect or enlarge the scope, duration, ownership, or subsistence of, any copyright protection in the preexisting material."³⁹ The 1976 Act also provides that there may be separate copyright interests in a collective work as a whole, and in each separate contribution.⁴⁰ Thus, the 1976 Act makes clear the distinction between the database, as a whole, and its components.

The 1976 Act effectively ended the common law copyright. Under the 1909 Act, the federal copyright protected only published works. A whole body of state common law

³¹ 17 U.S.C. § 3 (1909) (repealed 1978).

³² *Feist*, 499 U.S. at 355-56.

³³ 17 U.S.C. § 102(b) (2001).

³⁴ *Feist*, 499 U.S. at 355-56 (the Court quoted from House and Senate reports stating that "Section 102(b) in no way enlarges or contracts the scope of copyright protection under the present law. Its purpose is to restate . . . that the basic dichotomy between expression and idea remains unchanged"). See H. R. REP. NO. 94-1476, at 57 (1976); S. REP. NO. 94-473, at 54 (1975).

³⁵ *Feist*, 499 U.S. at 355-56.

³⁶ *Id.* at 356.

³⁷ Subject matter of copyright: Compilations and derivative works.

(a) The subject matter of copyright as specified by section 102 includes compilations and derivative works, but protection for a work employing preexisting material in which copyright subsists does not extend to any part of the work in which such material has been used unlawfully.

(b) The 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 (2001).

³⁸ *Id.*

³⁹ *Id.*

⁴⁰ Contributions to collective works.

Copyright in each separate contribution to a collective work is distinct from copyright in the collective work as a whole, and vests initially in the author of the contribution. In the absence of an express transfer of the copyright or of any rights under it, the owner of copyright in the collective work is presumed to have acquired only the privilege of reproducing and distributing the contribution as part of that particular collective work, any revision of that collective work, and any later collective work in the same series. 17 U.S.C. § 201(c) (2001).

had evolved alongside federal copyright law to protect unpublished works. Since under the 1976 Act, the federal copyright interest attaches upon fixation in a tangible medium, there is no need for a common law copyright, and it is specifically preempted.⁴¹

The 1976 Act also increased the length of a copyright to the life of the author plus fifty years. Subsequently, the Sonny Bono Copyright Term Extension Act of 1998 (the "Copyright Extension Act") further expanded the duration of a copyright to the life of the author plus seventy years.⁴² Thus the term of a copyright has grown from a period of 14 to 28 years to one that will likely span four generations or more.⁴³

C. *The Feist Case*

While a few cases wrestled with the new provisions of the 1976 Act,⁴⁴ it was not until 1991 that the Supreme Court decided a major copyright case involving databases, *Feist Publications, Inc. v. Rural Telephone Service Company, Inc.*⁴⁵ Feist, the publisher of a telephone directory, copied the names and addresses of all the listings from competitor Rural's directory.⁴⁶ Rural sued for copyright infringement. The lower courts found for Rural, holding that the telephone directories were copyrightable, that there was copying, and that, therefore, there was copyright infringement.⁴⁷

The Supreme Court reversed, finding no copyright interest in Rural's directory.⁴⁸ The Court emphasized that originality is a constitutional requirement for copyright:

The *sine qua non* of copyright is originality. To qualify for copyright protection, a work must be original to the author. . . . Original, as the term is used in copyright, means only that the work was independently created by the author (as opposed to copied from other works), and that it possesses at least some minimal degree of creativity. . . . To be sure, the requisite level of creativity is extremely

⁴¹ 17 U.S.C. § 301(a)-(b) (2001). See *infra* notes 115-22 and accompanying text.

⁴² Pub. L. No. 105-298, 112 Stat. 2827 (1998) (codified at 17 U.S.C. §§ 301-304). See *Eldred v. Ashcroft*, 239 F.3d 372, (D.C. Cir. 2001), *reh'g denied*, 255 F.3d 849, *cert. granted*, 70 U.S.L.W. 3514 (U.S. Feb. 19, 2002) (No. 01-618) (action seeking, among other things, a declaratory judgment to hold unconstitutional the extension of copyright terms under the Copyright Extension Act).

⁴³ L. Ray Patterson, *Copyright in the New Millennium: Resolving the Conflict between Property Rights and Political Rights*, 62 OHIO ST. L.J. 703, 706-707 (2001) (questioning how the public interest is served by increasing the copyright term to the life of the author plus seventy years); see LAWRENCE LESSIG, *THE FUTURE OF IDEAS: THE FATE OF THE COMMONS IN A CONNECTED WORLD* (2001) (criticizing the extension of copyright terms, and proposing a radical revision of copyright terms to five years, renewable 15 times).

⁴⁴ Compare *United Tel. Co. of Mo. v. Johnson Publishing Co.*, 855 F.2d 604 (8th Cir. 1988) (finding a copyright infringement for copying portions of a white page phone directory), with *Eckes v. Card Prices Update*, 736 F.2d 859 (2d Cir. 1984) (court found sufficient originality to warrant copyright protection for a baseball card price guide, and found copyright infringement because of sufficient evidence of substantial similarity). For a discussion of *Eckes*, see *infra* notes 75-78 and accompanying text.

⁴⁵ 499 U.S. 340 (1991). Because of the significance of the Court's rejection of the "sweat of the brow" theory, Professor Patterson states that *Feist* may well be the Court's most important copyright decision since its first, *Wheaton v. Peters*, 33 U.S. (8 Pet.) 591 (1834). Patterson, *supra* note 11, at 387.

⁴⁶ 499 U.S. at 343-44.

⁴⁷ *Id.* at 344.

⁴⁸ *Id.* at 362-64.

low; even a slight amount will suffice. The vast majority of works make the grade quite easily, as they possess some creative spark.⁴⁹

The Court held that Rural's selection, coordination, and arrangement of its listings, by alphabetical order of surname, could not have been more obvious, and accordingly, did not satisfy this minimum constitutional standard for copyright protection.⁵⁰

The Court discussed the interplay between two well-established propositions: that facts are not copyrightable, and that compilations of facts generally are, as long as there is some originality in the selection or arrangement of the facts.⁵¹ The Court cautioned that even if there were such originality, the copyright would in no event extend to the facts themselves.⁵² The Court made clear that under the 1976 Act, "originality, not 'sweat of the brow,' is the touchstone of copyright protection in directories and other fact-based works."⁵³ It also held that "copyright in a factual compilation is thin. 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."⁵⁴

In commenting on the fairness of this result, the Court observed that

It may seem unfair that much of the fruit of the compiler's labor may be used by others without compensation. As Justice Brennan has correctly observed, however, this is not 'some unforeseen byproduct of a statutory scheme.' . . . It is, rather, 'the essence of copyright,' and a constitutional requirement. The primary objective of copyright is not to reward the labor of authors, but 'to promote the Progress of Science and useful Arts.' . . . As applied to a factual compilation, assuming the absence of original written expression, only the compiler's selection and arrangement may be protected; the raw facts may be copied at will. This result is neither unfair nor unfortunate. It is the means by which copyright advances the progress of science and art.⁵⁵

Thus after *Feist*, it is clear that copyright protection will not extend to databases merely because time or effort is spent compiling information. Rather, copyright protection is only available if either the individual elements are worthy of protection, or the database as a whole, because of some creative selection, coordination or arrangement, is original enough to qualify for protection.⁵⁶ This standard applies regardless of where the database is stored.

⁴⁹ *Id.* at 345 (citations omitted).

⁵⁰ *Id.* at 362. See John M. Conley et al., *Database Protection in a Digital World*, 6 RICH J.L. & TECH. 2, ¶ 46 (1999), at <http://www.richmond.edu/jolt/v6i1/conley.html> (which observes that *Feist* has been of little instructive use to subsequent cases on the issue of minimum spark of creativity, since it contained probably the least creative possible arrangement of facts i.e. alphabetical order).

⁵¹ 499 U.S. at 344-45.

⁵² *Id.* at 349-51.

⁵³ *Id.* at 359-60.

⁵⁴ *Id.* at 349.

⁵⁵ *Id.* (citations omitted).

⁵⁶ See Patterson, *supra* note 11, at 404-407, in which the author criticizes a variety of legal fictions that have extended copyright protection from "original works of authorship" to things like "computer databases containing factual material." Patterson refers to these copyrights as "neo-copyrights" – "works of low

Feist was decided in 1991 and just as the digital world was beginning to take shape. Personal computers and audio CDs were everywhere and CD-ROMs were beginning to become popular. The Internet was evolving quickly. By the mid-1990s, the technological landscape had changed. Computers were faster, more powerful, and could store greater amounts of data. Read/write CD drives became available, and probably, most importantly, the Web grew exponentially. Anyone with a computer and a modicum of ingenuity could digitize, compile and copy (or copy and compile) almost anything. Cyberspace became an electronic trading post, with unlimited potential – a dream world for some, a nightmare for others.⁵⁷

III. THE MODEL

A number of difficult copyright questions have quickly crystallized in this new digital age.⁵⁸ It is extremely important that the copyright law continue to promote the progress of the arts and sciences by rewarding the creativity of authors. It is equally important, however, to recognize that copyright law can easily stifle that progress by overextending protection.⁵⁹ It may be tempting to "reward" every "creation" with copyright protection, but we must not lose sight of the basic principles behind the law. The Internet provides unprecedented access to information. We must be careful, however, not to unduly restrict the free flow of that information by extending copyright protection where it does not belong.

The Internet facilitates the easy collection and compilation of data. While some of these compilations may qualify for copyright protection, most will not. A simple table can be very useful in focusing on the criteria necessary to determine whether a compilation is entitled to copyright protection.

authorship granted without regard to constitutional copyright policies." Patterson, *supra* note 11, at 386 (footnote omitted).

⁵⁷ See generally LAWRENCE LESSIG, CODE AND OTHER LAWS OF CYBERSPACE (1999) (discussing the evolution of cyberspace, and the interplay of code and law, and how they impact each other with regard to the regulation and growth of cyberspace).

⁵⁸ In addition to the question concerning copyright protection for databases, there have been numerous copyright concerns related to cyberspace and the Internet. Among some of the more notable cases are *A & M Records, Inc. v. Napster, Inc.*, 239 F.3d 1004 (9th Cir. 2001) (addressing questions concerning the "sharing" of copyrighted songs over the Internet); *Universal City Studios, Inc. v. Corley*, 273 F.3d 429 (2nd Cir. 2001) (addressing questions concerning the legality of anti-circumvention legislation passed to prevent copying of copyrighted works); *Eldred v. Ashcroft*, *supra* note 42, (questioning the legality of, among other things, legislation that extended the durations of existing copyrights).

⁵⁹ See LESSIG, *supra* note 43. Professor Lessig contends that new, restrictive intellectual property laws have strangled the creativity and innovation that was the hallmark of the early days of the Internet.

	Creative Works (constituent materials copyrightable)	Non-creative Works (constituent materials not copyrightable)
Creative Compilation of	<ul style="list-style-type: none"> • Compilation protected because creative and as "collective work" • <i>E.g.</i>, CD-ROM of copyrighted cartoons • <i>E.g.</i>, <i>New York Times</i> Web site of photographs 	<ul style="list-style-type: none"> • Compilation protected because creative • <i>E.g.</i>, Yellow Pages for Chinatown • <i>E.g.</i>, Baseball card price guide
Non-creative Compilation of	<ul style="list-style-type: none"> • Compilation protected as "collective work" • <i>E.g.</i>, Complete works CD of copyrighted songs • <i>E.g.</i>, Journal issue of scholarly articles 	<ul style="list-style-type: none"> • Compilation not protected • <i>E.g.</i>, Alphabetical telephone directory • <i>E.g.</i>, Complete works of Shakespeare

Table 1

Table 1 illustrates the four possible categories of databases, describing each as either a creative or non-creative compilation of either creative or non-creative works. While this may sound confusing at first, it allows for a simpler application of the legal principles involved.

Viewing Table I as having four quadrants, the two left side quadrants, contain creative works, which are considered "collective works" under the Copyright Act.⁶⁰ Accordingly, not only would there be copyright protection for the individual elements of these collections, but there would also be protection for the collections as a whole.⁶¹

In the upper left quadrant, we might have, for example, a CD-ROM containing a collection of copyrighted cartoons or comic strips. As part of this database, an interface would permit a user to access the individual cartoons in a variety of (creative) ways. For example, in addition to being able to access the cartoons, by title, by author, or by date, one might be able to access them by genre (e.g. black humor, satire, Japanese animation), by subject matter (e.g. family, children, sports), or by time (e.g. prehistoric, 1930s, future). Another example would be a Web site created by the *New York Times* containing a collection of (copyrighted) news photographs. The Web site might be designed to permit access of the photographs in a variety of different ways, making the selection, arrangement and coordination of the content, if not unique, certainly original. Under current law, any Web site that provides a minimum spark of creativity in its interface would qualify for copyright protection as a creative compilation. If such a Web site has content that also qualifies as a creative work, then this cyberspace database would belong in the upper left quadrant.

In the lower left quadrant are the non-creative compilations of creative works. These also are considered to be "collective works" under the Copyright Act.⁶² In this quadrant

⁶⁰ 17 U.S.C. § 101 (2001).

⁶¹ See *supra* notes 28-40 and accompanying text for a discussion of the distinctions between a "collective work" and a "compilation" under the Copyright Act.

⁶² *Id.*

belong, for example, a journal or magazine containing (only) a collection of (copyrighted) articles,⁶³ a "Complete Works" CD containing (copyrighted) songs, or a Web site containing a collection of numbered links to (copyrighted) images. In these examples, the copyright owners of the individual works would retain their interests unaffected by inclusion in the "collective work," and the copyright owner of the "collective work" would acquire only the privilege of reproducing and distributing the individual work as part of that particular "collective work."⁶⁴

The two upper quadrants contain creative compilations. The upper left quadrant, as we have already seen, contains creative compilations of creative works. The upper right quadrant contains creative compilations of non-creative works (e.g., facts, public domain material). For example, we may have a yellow pages directory containing an original selection of categories geared towards a particular community,⁶⁵ or a baseball card catalog listing prices and designating certain cards to be "premium."⁶⁶ Similarly, a Web site containing non-creative works, but with a creative interface (i.e., one whose selection or arrangement of facts is original), would belong in the upper right quadrant.⁶⁷

Any database in the two upper quadrants (i.e., a creative, as opposed to a non-creative, compilation) qualifies as a "compilation" under the Copyright Act, as its definition speaks of a collection of preexisting materials or data that are selected, coordinated or arranged in such a way that the resulting work as a whole constitutes an original work of authorship.⁶⁸ This is specifically the type of database that *Feist* addressed. Bear in mind, however, that inclusion in the upper right quadrant does not change the nature of the underlying work. The ("non-creative") facts or public domain material in a database in

⁶³ See *New York Times v. Tasini*, 533 U.S. 483, 121 S.Ct. 2381 (2001). The Supreme Court held that magazines and newspapers cannot include, in electronic databases, articles written by freelance writers without additional permission or assignment from the author. The Court held that under the Copyright Act, the author retains his or her rights to the individual contribution (unless, of course, he or she assigns them), and the publisher of the collective work has only the privilege of reproducing the individual work as part of the whole collective work. *Id.* at 2394. The publishers had contended that inclusion in the electronic database was merely a revision of the collective work, as specified in the statute. *Id.* at 2390. The Court disagreed, holding that the individual article appeared in the database entirely independent from the collective work and was not a revision at all. It held that the author still retained his rights in that independent work. *Id.* at 2392.

⁶⁴ See 17 U.S.C. §§ 103, 201(c) (2001). It is worth noting at this point that such a "non-creative compilation" of a "creative work" falls within the definition of a "collective work" because its contributions constitute separate and independent works themselves, but would not fit with the definition of a "compilation" because of the absence of preexisting materials that are selected, coordinated, or arranged in such a way that the resulting work would constitute an original work of authorship (i.e., no creative spark) were it not for the last sentence of the definition that specifically includes collective works as a "compilation." 17 U.S.C. § 101 (2001). This is significant because only "compilations," and not "collective works," are included within the subject matter of copyrights. 17 U.S.C. § 103 (2001).

⁶⁵ See *Key Publications, Inc. v. Chinatown Today Publishing Enterprises, Inc.*, 945 F.2d 509 (2d Cir. 1991) (where the court found a copyright interest in the yellow pages directory, but did not find sufficient evidence of substantial similarity in the allegedly infringing directory). See *infra* notes 79-84 and accompanying text.

⁶⁶ See *Eckes v. Card Prices Update*, 736 F.2d 859 (2d Cir. 1984) (a pre-*Feist* case which would be decided the same, wherein the court found sufficient originality to warrant copyright protection for a baseball card price guide, and found copyright infringement because of sufficient evidence of substantial similarity). See *infra* notes 75-78 and accompanying text.

⁶⁷ See *supra* notes 51-56 and accompanying text, for a discussion of *Feist*.

⁶⁸ 17 U.S.C. § 101 (2001).

the upper right quadrant will not gain any copyright protection for those components. Only the compilation as a whole will warrant any protection. And as we will see from the cases below, this protection may or may not be of much value.⁶⁹

In the two right side quadrants are databases containing only non-creative works (i.e., facts and public domain materials). These are the databases that are most often the subject of legal discussion. As *Feist* emphasized, facts (and public domain materials) cannot be protected by copyright.⁷⁰ Whether a database containing non-creative works deserves any copyright protection as a "compilation" will be determined by applying the principles of *Feist* (and placing it above or below the middle line bisecting the quadrants). For example, a Web site with a sufficiently creative interface would belong in the upper right quadrant.

In the lower right quadrant are the non-creative compilations of non-creative works, for example, an alphabetical telephone directory, a table containing the names of all the presidents and vice presidents and the years they served, or a collection of all the works of William Shakespeare. These are databases that do not warrant any copyright protection because they lack creativity – they are non-creative compilations of non-creative works.⁷¹ It is irrelevant whether they exist in electronic or non-electronic form, or whether they are printed in a book or reside in cyberspace. This result is precisely what the copyright law was intended to and should produce.

IV. APPLYING THE MODEL TO DATABASE COPYRIGHT CASES

Most of the database copyright cases involve the two right side quadrants. That makes sense because the two left side quadrants contain creative works, i.e., databases whose individual components are independently copyrightable. It is of far less concern to get a copyright in a database as a whole if the individual items are themselves protectable. The two right side quadrants contain non-creative works, i.e., databases of facts or public domain works. For most of these cases, the typical approach for a court is to:

- apply the principles enunciated in *Feist*, and determine whether there is enough originality in the selection, coordination or arrangement of the facts to confer copyright protection in the compilation,⁷² and
- determine whether there was copyright infringement, by comparing the allegedly infringing database to the original to see if there is substantial similarity with the protected portion of the database.⁷³

The Second Circuit has decided several copyright cases involving databases, both before and after *Feist*.⁷⁴ In *Eckes v. Card Price Update*,⁷⁵ a pre-*Feist* case, the court

⁶⁹ See *infra* notes 72-113 and accompanying text.

⁷⁰ See *supra* notes 45-56 and accompanying text.

⁷¹ *Id.*

⁷² *E.g.*, *Key Publications, Inc. v. Chinatown Today Publishing Enterprises, Inc.*, 945 F.2d 509, 513 (2d Cir. 1991) (where the court found sufficient originality in the selection, coordination or arrangement of the listings in the yellow pages directory to entitle it to copyright protection). For a further discussion of *Key Publications*, see *infra* notes 79-84 and accompanying text.

⁷³ *E.g.*, *id.* at 515-516 (where the court compared the two yellow pages directories, and held that there was not infringement because the two directories were not substantially similar). For a further discussion of *Key Publications*, see *infra* notes 79-84 and accompanying text.

applied principles that nonetheless would be applicable today. It found that the plaintiff had exercised "selection, creativity and judgment"⁷⁶ in choosing which among the 18,000 baseball cards in its price guide should be deemed "premium" cards, and so had a copyright interest in the guide.⁷⁷ It found infringement upon sufficient evidence of copying by defendant.⁷⁸

In another case, decided shortly after *Feist*, the Second Circuit found sufficient originality in a yellow pages telephone directory to warrant copyright protection.⁷⁹ The court upheld the finding of the district court that there was sufficient originality in the selection of the categories in the directory.⁸⁰ The court, however, found no infringement since the two directories were not substantially similar.⁸¹ It stated that the "key issue is not whether there is overlap or copying but whether the organizing principle guiding the selection of businesses for the two publications is in fact substantially similar."⁸² It discussed the *Feist* case, and pointed out that the Second Circuit had rejected the "sweat of the brow" doctrine twenty-five years earlier.⁸³ It also distinguished the *Eckes* case on the facts, stating that there was not nearly as much copying of the creative portions of the directory.⁸⁴

Both *Eckes* and *Key Publications* were appropriately found to belong in the upper right quadrant, i.e., creative compilations of non-creative works. However, it is important to understand that the copyright protection afforded such compilations is very thin. In *Eckes*, the defendant copied a significant portion of the creative selection of the data, thus the court found infringement. In *Key Publications*, however, since only category headings and individual listings were copied, and because they were merely unprotectable facts, there was no infringement.

In *CCC Information Services, Inc. v. Maclean Hunter Market Reports, Inc.*,⁸⁵ the Second Circuit focused on a database containing used car valuations. The court examined the originality of not only the selection and arrangement of the data, but also of the valuations themselves. It held that both were sufficiently original to warrant copyright protection.⁸⁶ The database was a creative compilation of works that were

⁷⁴ It should not be surprising that many of these cases have come from the Second Circuit because of the large presence in New York of the publishing industry.

⁷⁵ 736 F.2d 859 (2d Cir. 1984). The defendant published a competing baseball card guide that contained almost exactly the same 5,000 cards that were deemed "premium" by the plaintiff. The court noted that there were many instances of unusual spellings of certain names in the plaintiff's checklist that were repeated in the defendant's guide.

⁷⁶ *Id.* at 863.

⁷⁷ *Id.* at 863-64.

⁷⁸ *Id.* at 864.

⁷⁹ *Key Publications, Inc. v. Chinatown Today Publishing Enterprises, Inc.*, 945 F.2d 509 (2d Cir. 1991). In addition to predictable categories, such as Accountants and Bridal Shops, there were ones, like Bean Curd & Bean Sprout Shops, that were particularly geared towards the Chinese community to which the directory was aimed.

⁸⁰ *Id.* at 513-14.

⁸¹ *Id.* at 515-16.

⁸² *Id.* at 516.

⁸³ *Id.*

⁸⁴ *Id.* at 516-17.

⁸⁵ 44 F.3d 61 (2d Cir. 1994), *cert. denied*, 516 U.S. 817 (1995).

⁸⁶ *Id.* at 67-68.

themselves original creations and, therefore, protected by copyright law. Accordingly, this case belongs in the upper left quadrant.

Other circuits also have addressed these issues. In another case involving the upper left quadrant, *CDN Inc. v. Kapes*,⁸⁷ the Ninth Circuit found that the prices of coins in a price guide were sufficiently original to warrant copyright protection.⁸⁸ The court agreed with the district court's determination that the prices in the guide were not merely facts, but rather were "wholly the product of [plaintiff's] creativity."⁸⁹

BellSouth Advertising & Publishing Corporation v. Donnelley Information Publishing, Inc.,⁹⁰ was another dispute between publishers of competing yellow pages. The parties stipulated that BellSouth's directory qualified for copyright protection as a compilation.⁹¹ After discussing *Feist* and *Key Publications*, the Eleventh Circuit reversed the district court's grant of summary judgment for BellSouth, and instead granted summary judgment for Donnelley.⁹² The court stated,

[b]y copying the name, address, telephone number, business type, and unit of advertisement purchased for each listing in the [BellSouth] directory, Donnelley copied no original element of selection, coordination or arrangement.⁹³

The holding in *BellSouth* is particularly relevant for electronic databases today. While the selection, coordination or arrangement of the facts might give rise to some degree of copyright protection, it will not extend to the underlying facts themselves. In other words, the copyright protection afforded a creative compilation of non-creative facts is very thin.

The Eleventh Circuit faced a similar situation in *Warren Publishing, Inc. v. Microdos Data Corp.*⁹⁴ Warren published a Television & Cable Factbook. It alleged that Microdos's competing directory infringed the 1) format of the data fields, 2) the coordination and arrangement of these fields, and 3) the selection of the community categories.⁹⁵ The district court granted partial summary judgment, holding that 1) the data fields were not sufficiently original to warrant copyright protection, 2) the coordination and arrangement of the fields was sufficiently original, but that Microdos's coordination and arrangement was not substantially similar, and 3) the selection of the community categories was sufficiently original, and Microdos's selection was substantially similar.⁹⁶ Therefore the district court granted a permanent injunction against Microdos on the basis of this third finding.⁹⁷

⁸⁷ 197 F.3d 1256 (9th Cir. 1999)

⁸⁸ *Id.* at 1259.

⁸⁹ *Id.* at 1260.

⁹⁰ 999 F.2d 1436 (11th Cir. 1993) (en banc), *cert. denied*, 510 U.S. 1101 (1994).

⁹¹ *Id.* at 1438.

⁹² *Id.* at 1446.

⁹³ *Id.*

⁹⁴ 115 F.3d 1509 (11th Cir. 1997).

⁹⁵ *Id.* at 1513.

⁹⁶ *Id.* at 1513-14.

⁹⁷ *Id.* at 1514.

The Eleventh Circuit, noting that the district court did not have the benefit of its *BellSouth* decision,⁹⁸ reversed the third finding.⁹⁹ The court explained that copyright protection for a compilation of facts is very thin, and that there is infringement only when the selection, coordination, or arrangement is copied, not when merely the factual material is copied.¹⁰⁰ The court held that Warren's selection of which community headings to use was not sufficiently original to warrant protection in the first place.¹⁰¹ Warren used only whatever geographical description the individual cable companies told it to use. Warren "did not exercise any creativity or judgment in 'selecting' cable systems to include in the Factbook, but rather included the entire relevant universe known to it."¹⁰² The court held that:

[s]imply because Warren may have been the first to discover and report a certain fact on a cable system does not translate these facts of discovery into acts of creation entitled to copyright protection . . . [and quoting from *BellSouth*] "Just as the Copyright Act does not protect 'industrious collection,' it affords no shelter to the resourceful, efficient, or creative collector."¹⁰³

In two prominent cases involving West Publishing and its publication of court decisions, the Second Circuit explored in detail the issue of which elements of a compilation are entitled to copyright protection and which are not. The court basically had to decide whether the cases belonged in the upper or lower right quadrants. Both cases were captioned *Matthew Bender & Co. v. West Publishing Co.*¹⁰⁴ In the first case,¹⁰⁵ the court held that only those elements that are original are entitled to copyright protection, and that originality is dependent upon a showing of a modicum of creativity. It stated that court opinions are themselves factual, and therefore part of the public domain.¹⁰⁶ It held that while some of the information that West adds to the opinions is original, for example, the syllabus, the headnotes, and the key numbers,¹⁰⁷ other information is not, for example, the attorney information,¹⁰⁸ the subsequent procedural history,¹⁰⁹ and the parallel citations.¹¹⁰ Thus West cannot claim copyright protection in

⁹⁸ *Id.* at 1511 n.2.

⁹⁹ *Id.* at 1513.

¹⁰⁰ *Id.* at 1515.

¹⁰¹ *Id.* at 1517-19.

¹⁰² *Id.* at 1518. Ironic as it may seem, an argument can be made that the more comprehensive the compilation of data, the less likely that there will be protection from copyright law. If the selection or arrangement of data is merely the inclusion of the entire relevant universe, there is arguably very little or no "creativity" involved. This would likely result in very thin or no copyright protection for such a compilation. See Richard L. Stone & John D. Pernick, *Protecting Databases: Copyright? We Don't Need No Stinkin' Copyright*, 16 *COMPUTER LAW*. 17, 17 (1999).

¹⁰³ *Warren*, 115 F.3d at 1520.

¹⁰⁴ 158 F.3d 674 (2d Cir. 1998); 158 F.3d 693 (2d Cir. 1998).

¹⁰⁵ 158 F.3d 674 (2d Cir. 1998).

¹⁰⁶ *Id.* at 679.

¹⁰⁷ *Id.* at 676-77.

¹⁰⁸ *Id.* at 683-84.

¹⁰⁹ *Id.* at 684-85.

¹¹⁰ *Id.* at 685-88.

the latter. In the second case,¹¹¹ the court held that West's star-pagination system was not creative enough to warrant protection under *Feist*.

The *West* cases are significant because they deal with public domain material, not just facts. But just like facts, the act of collecting and compiling them does not transform them into a copyrightable product. As the Supreme Court observed in *Feist*, "[c]ommon sense tells us that 100 uncopyrightable facts do not magically change their status when gathered in one place."¹¹²

Applying this legal analysis to the Vincent van Gogh Web sites, there can be no doubt that there is no protection for the individual elements involved, i.e., the images containing Van Gogh's public domain paintings, drawings, watercolors and sketches. While the creator of a Web site certainly has copyright protection for the original parts of her design, there is very little protection for the "facts." Unless she adds enough to the original to be considered a derivative work, which is unlikely for the art reproductions, but was apparently accomplished for the translation of the letters, she cannot prevent the copying of works already in the public domain. As discussed above, the public is entitled to, and must have, free access to this material.¹¹³ A copyright interest in the compilation of such public domain material, i.e., a Web site, does not bootstrap protection for the individual components.

V. PROTECTING DATABASES UNDER STATE LAW

A. *The Issue of Preemption*

A number of cases have attempted to protect the contents of databases (particularly electronic ones) under legal theories other than copyright.¹¹⁴ They have met with mixed results. The biggest challenge facing a state law claim is surviving preemption under Section 301 of the Copyright Act, which provides, in pertinent part,

(a) On and after January 1, 1978, all legal or equitable rights that are *equivalent* to any of the exclusive rights within the general scope of copyright as specified by section 106 in works of authorship that are fixed in a tangible medium of expression and come within the subject matter of copyright as specified by sections 102 and 103, whether created before or after that date and whether published or unpublished, are governed exclusively by this title. Thereafter, no person is entitled to any such right

¹¹¹ 158 F.3d 693 (2d Cir. 1998).

¹¹² *Feist*, 499 U.S. at 345.

¹¹³ See *supra* note 12 and accompanying text.

¹¹⁴ *ProCD v. Zeidenberg*, 86 F.3d 1447 (7th Cir. 1996) (contractual restriction in shrinkwrap license), see *infra* notes 123-35 and accompanying text; *Matthew Bender & Co. v. Jurisline.com*, 91 F. Supp. 2d 677 (S.D.N.Y. 2000) (contractual restriction in shrinkwrap license), see *infra* notes 136-39 and accompanying text; *eBay, Inc. v. Bidder's Edge, Inc.*, 100 F. Supp. 2d 1058 (N.D. Cal. 2000) (trespass to personal property), see *infra* notes 143-48 and accompanying text; *Ticketmaster Corp. v. Tickets.com, Inc.*, 2000 U.S. Dist. LEXIS 12987 (S.D. Cal. 2000) (trespass to personal property), see *infra* notes 149-52 and accompanying text; *NBA v. Motorola, Inc.*, 105 F.3d 841 (2d Cir. 1997) (misappropriation) see *infra* notes 153-62 and accompanying text.

or equivalent right in any such work under the common law or statutes of any State.

(b) Nothing in this title annuls or limits any rights or remedies under the common law or statutes of any State with respect to--

(1) subject matter that does not come within the subject matter of copyright as specified by sections 102 and 103, including works of authorship not fixed in any tangible medium of expression; or . . .

(3) activities violating legal or equitable rights that are *not equivalent* to any of the exclusive rights within the general scope of copyright as specified by section 106.¹¹⁵

Under this provision, courts have held that a state common law or statutory claim is preempted if the work is within the scope of the subject matter of copyright, and if the rights granted under state law are equivalent to any of the exclusive rights of a federal copyright.¹¹⁶ In *Computer Associates International, Inc. v. Altai, Inc.*,¹¹⁷ the Second Circuit held that "Section 301 thus preempts only those state law rights that may be abridged by an act which, in and of itself, would infringe one of the exclusive rights provided by federal copyright law."¹¹⁸ The court enunciated the so-called "extra element" test:

But if an "extra element" is "required instead of or in addition to the acts of reproduction, performance, distribution or display, in order to constitute a state-created cause of action, then the right does not lie 'within the general scope of copyright,' and there is no preemption." . . . A state law claim is not preempted if the "extra element" changes the "nature of the action so that it is qualitatively different from a copyright infringement claim."¹¹⁹

The court noted that under the "extra element" test, it had previously preempted unfair competition and misappropriation claims grounded solely in the copying of protection expression, and preempted a tortious interference with contract claim grounded in the impairment of a plaintiff's right under the Copyright Act to publish derivative works.¹²⁰ It also noted that other unfair competition claims based upon breach of confidential relationship, breach of fiduciary duty, and trade secrets, had, however, survived preemption under section 301.¹²¹ Probably the hardest task facing a court with a

¹¹⁵ 17 U.S.C. § 301 (2001) (emphasis added).

¹¹⁶ See *United States ex rel. Berge v. Bd. of Trustees*, 104 F.3d 1453 (4th Cir. 1997) (state conversion claim preempted by copyright law); *NBA v. Motorola, Inc.*, 105 F.3d 841 (2d Cir. 1997) (state misappropriation claim preempted by copyright law).

¹¹⁷ 982 F.2d 693 (2d Cir. 1992). *Computer Associates* [hereinafter *CA*] had sued *Altai* for copyright infringement and trade secret misappropriation. The district court found that *Altai* had infringed one version of *CA*'s program, but not another. It also held that copyright law preempted the misappropriation claim. The appellate court affirmed the copyright holdings, but vacated the preemption ruling and remanded for further proceedings. *Id.* at 696-97.

¹¹⁸ *Id.* at 716 (quotations omitted).

¹¹⁹ *Id.*

¹²⁰ *Id.* at 717.

¹²¹ *Id.*

preemption challenge is determining whether the state claim requires such an "extra element."

In order for a state law claim to successfully survive a copyright preemption challenge, some "extra element" sufficient to distinguish it from the kind of protection afforded by the copyright law needs to be shown.¹²² Few attempts have met with success.

B. Contract Cases

Besides misappropriation and unfair competition, other common law claims include contract and trespass. In *ProCD v. Zeidenberg*,¹²³ the plaintiff compiled and sold a CD-ROM telephone directory containing listings from over 3,000 print directories. The defendant bought a copy of the consumer version of the CD-ROM, extracted the listings from the disk, and created a Web site where he sold access to those names and numbers. Rather than pursue a (probably unsuccessful) copyright infringement claim,¹²⁴ the plaintiff sued the defendant alleging breach of the terms of the license agreement, which prohibited any commercial use of the product.¹²⁵ The court found for the plaintiff, holding "shrinkwrap licenses" enforceable under Wisconsin law¹²⁶ and not preempted by the Copyright Act.¹²⁷ The court noted that a function of preemption is "to prevent states from giving special protection to works of authorship that Congress has decided should be in the public domain."¹²⁸ The court distinguished, however, between the rights granted by contract and those protected by copyright law: "Copyright law forbids duplication, public performance, and so on . . . A copyright is a right against the world. Contracts, by contrast, generally affect only their parties; strangers may do as they please, so contracts do not create 'exclusive rights'".¹²⁹

Both of these findings are questionable. First, there has been much controversy over the enforceability of "shrinkwrap licenses".¹³⁰ They are enforceable in some states.¹³¹

¹²² In many of the cases where a state claim was not preempted by section 301, there was a required element of a breach of a confidential relationship or of a fiduciary duty, such as is often the case in a trade secret claim. See *Bateman v. Mnemonics, Inc.*, 79 F.3d 1532, 1549 (11th Cir. 1996) (state trade secret claim satisfies the "extra element" test); *Oddo v. Ries*, 743 F.2d 630 (9th Cir. 1984) (conversion claim related to breach of duty by partner not preempted by copyright law); *Warrington Associates, Inc. v. Real-Time Engineering Systems, Inc.*, 522 F. Supp. 367 (N.D. Ill. 1981) (trade secret claim not preempted by copyright law).

¹²³ 86 F.3d 1447 (7th Cir. 1996).

¹²⁴ The data itself would not have been protected by copyright. Arguably, the compilation may have warranted some degree of protection, although the court noted early in its discussion that "[w]e may assume that this database cannot be copyrighted, although it is more complex, contains more information (nine-digit zip codes and census industrial codes), is organized differently, and therefore is more original than the single alphabetical directory in *Feist*." *Id.* at 1449 (italics omitted).

¹²⁵ *Id.* at 1450.

¹²⁶ *Id.* at 1452-53.

¹²⁷ *Id.* at 1453-54.

¹²⁸ *Id.* at 1453.

¹²⁹ *Id.* at 1454.

¹³⁰ Ever since 1988, there have been questions about the validity and enforceability of shrinkwrap licenses. See *Vault Corp. v. Quaid Software Ltd.*, 847 F.2d 255 (5th Cir. 1988) (which was the first major case to invalidate a shrinkwrap license). Indeed much of the controversy over the drafting of a proposed Article 2B of the Uniform Commercial Code and subsequent emergence of the Uniform Computer Information

Secondly, it is questionable whether state contact law can, in effect, give copyright-like protection to otherwise non-protectable "facts" merely by distinguishing the type of use, i.e., commercial vs. noncommercial.¹³² The court in *Zeidenberg* basically held that such a distinction made a qualitative difference in the protection given, and was, therefore, an appropriate "extra element."¹³³ In effect, what the court did was transform the contractual relationship between the parties into a trust or fiduciary relationship.¹³⁴ It is doubtful that this approach will be widely followed, particularly in cyberspace, where parties typically deal with each other at much greater than arm's length.¹³⁵

With somewhat similar facts, the District Court for the Southern District of New York, in *Matthew Bender & Co. v. Jurisline.com*,¹³⁶ granted a motion to remand a case to state court for consideration of fraud and breach of contract claims. The plaintiff sought to protect its database of uncopyrightable court decisions by enforcing a shrinkwrap license under which the defendant had agreed not to make use of the data for commercial purposes.¹³⁷ The court rejected the defendant's assertion that it should retain jurisdiction over the case because of the preemption argument, holding that the fraud and breach of contract claims sought protection that was not the equivalent of the rights granted under copyright law.¹³⁸ The court pointed out in a footnote that it was not ruling on whether the shrinkwrap license was valid and binding.¹³⁹

Even if such a license agreement is deemed enforceable, it remains to be seen how far the courts will go in distinguishing between the rights granted by the copyright law in the underlying work, and the rights specified by contract in how "facts" can be used. As discussed above, the copyright system rewards an author for his or her creative work, but then requires that the work become part of the public domain after expiration of the term of protection.¹⁴⁰ Similarly, if a work is determined not to qualify for copyright protection because of lack of originality, the copyright law should preempt any other law from

Transaction Act pertained to the validity and enforceability of shrinkwrap licenses. See Scott J. Spooner, *The Validation of Shrink-Wrap and Click-Wrap Licenses by Virginia's Uniform Computer Information Transactions Act*, 7 RICH. J.L. & TECH. 27 (Winter 2001), at <http://www.richmond.edu/jolt/v7i3/article1.html>. These same questions are now arising in slightly different form in so-called "click-wrap" and "browse-wrap" license cases. In *Specht v. Netscape Communication Corp.*, 150 F. Supp. 2d 585 (S.D.N.Y. 2001), the court refused to enforce the terms of "click-wrap" and "browse-wrap" licenses, which would have compelled arbitration of any dispute arising thereunder.

¹³¹ See generally Brian D. McDonald, *Contract Enforceability: The Uniform Computer Information Transactions Act*, 16 BERKELEY TECH. L.J. 461 (2001).

¹³² See 1 MELVILLE B. NIMMER & DAVID NIMMER, *NIMMER ON COPYRIGHT* § 3.04[B][3][a](1997).

¹³³ 86 F.3d at 1454.

¹³⁴ The court acknowledged that Congress is able to preempt even the enforcement of contracts pertaining to copyrights, but nonetheless concluded that private contracts were different. *Id.* at 1454. It seemed that the court stretched a great deal to try to reach some ground on which prior decisions had successfully withstood preemption challenges. See *Altai*, 982 F.2d 693, and *supra* notes 117-22 and accompanying text.

¹³⁵ In *Specht*, a district court in New York refused to enforce the terms of a "click-wrap" or "browse-wrap" license because it was not clear that the user even knew of the license provision or took any action to assent to it. 150 F.Supp. at 591-96.

¹³⁶ 91 F. Supp. 2d 677 (S.D.N.Y. 2000).

¹³⁷ *Id.* at 678.

¹³⁸ *Id.*

¹³⁹ *Id.* at 678 n.1.

¹⁴⁰ See *supra* note 12 and accompanying text.

providing equivalent protection; the work becomes part of the public domain.¹⁴¹ Any other result would contravene the purpose of the copyright law.¹⁴²

C. Trespass to Personal Property

Two California cases have explored another possible avenue for protection of online databases. In *eBay, Inc. v. Bidder's Edge, Inc.*,¹⁴³ the District Court for the Northern District of California granted eBay's request for a preliminary injunction on a claim of trespass to personal property.¹⁴⁴ The court held that eBay would likely succeed on its trespass claim, finding that it would be able to establish that the defendant intentionally and without authorization interfered with its possessory interest in its computer system, and that eBay was thereby damaged.¹⁴⁵ The court noted that the injunction prohibited the defendant from automatically querying eBay's site; it did not prevent it from querying the site by specific request, i.e., in response to a user's query for information about a particular item.¹⁴⁶

The court rejected the defendant's argument that the Copyright Act preempted the trespass claim.¹⁴⁷ It held that the "right to exclude others from using physical personal property is not equivalent to any other rights protected by copyright and therefore constitutes an extra element that makes trespass qualitatively different from a copyright infringement claim."¹⁴⁸

Shortly after the *eBay* case, another California district court entertained a similar trespass claim. In *Ticketmaster Corp. v. Tickets.com, Inc.*,¹⁴⁹ one of Ticketmaster's claims against the defendant was for trespass. The District Court for the Central District of California discussed favorably the trespass theory presented in *eBay*, but refused to grant a preliminary injunction, holding that there was insufficient proof of enough interference with the plaintiff's property to satisfy the requirements for trespass.¹⁵⁰ While the defendant often accessed Ticketmaster's site, there was no proof that it interfered to

¹⁴¹ This position is supported by the legislative history. The House Report states that:

As long as a work fits within one of the general subject matter categories of sections 102 and 103, the bill prevents the States from protecting it even if it fails to achieve Federal statutory copyright because it is too minimal or lacking in originality to qualify, or because it has fallen into the public domain.

H.R. REP. NO. 94-1476 at 131 (1976). See *supra* note 12 and accompanying text.

¹⁴² See *supra* note 11 and accompanying text.

¹⁴³ 100 F. Supp. 2d 1058 (N.D. Cal. 2000). The defendant operated an aggregation Web site that collected information about various online auctions. eBay operates the largest online auction site. Naturally the defendant was interested in obtaining as much information as possible from eBay. Accordingly, the defendant used automated robots to query eBay's site about 100,000 times a day, accounting for 1.53% of the total activity on eBay's site.

¹⁴⁴ *Id.* at 1073.

¹⁴⁵ *Id.* at 1069-72.

¹⁴⁶ *Id.* at 1073.

¹⁴⁷ *Id.* at 1072.

¹⁴⁸ *Id.*

¹⁴⁹ 2000 U.S. Dist. LEXIS 12987 (S.D. Cal. 2000). Ticketmaster is the largest online ticket seller. The defendant also sells some tickets online, but primarily provides information about concerts, including places, dates, times, and where to buy the tickets. If a user of the defendant's site so desires, he or she can be linked directly to Ticketmaster's site to buy tickets.

¹⁵⁰ *Id.* at *14-18.

any extent with Ticketmaster's regular business.¹⁵¹ Had there been more evidence of interference with plaintiff's business, as was the case in *eBay*, the court appeared ready to enjoin such use under a trespass theory.¹⁵²

The trespass theory appears to be a novel way to limit access to information. However, as these two cases illustrate, unless there is a considerable, quantifiable and detrimental toll taken on one's personal property (e.g., one's Web server), the theory will be of limited value.

D. Misappropriation

Another legal theory that has gotten some attention is misappropriation. In *NBA v. Motorola, Inc.*,¹⁵³ the Second Circuit reversed a permanent injunction against Motorola that had been granted on that basis. The National Basketball Association wanted to stop the sale by Motorola of hand-held pagers that received updated scores and statistics taken from television and radio broadcasts of NBA games in progress. The state misappropriation claim was based on the "hot-news" doctrine enunciated in an old Supreme Court case, *International News Service v. Associated Press*.¹⁵⁴ In that case, the Associated Press was able to prevent the International News Service from intercepting and copying its news articles transmitted by wire under a common law misappropriation theory. At the time, there was no federal copyright interest in such transmission. However, since 1976, copyright law specifically covers simultaneously recorded transmissions of live performances and sporting events.¹⁵⁵ Thus the NBA's radio and television broadcasts of its game are protected by copyright, but the games themselves, and the scores and statistics they generate, are not.¹⁵⁶ The court held that the copyright law preempts the NBA's misappropriation claim, and that only a "narrow 'hot news' misappropriation claim survives preemption for actions concerning material within the realm of copyright."¹⁵⁷ Specifically, the court held that the central elements of an *INS* misappropriation claim are:

- (i) the plaintiff generates or collects information at some cost or expense,
- (ii) the value of the information is highly time-sensitive,
- (iii) the defendant's use of the information constitutes free-riding on the plaintiff's costly efforts to generate or collect it,
- (iv) the defendant's use of the information is in direct competition with a product or service offered by the plaintiff,
- (v) the ability of other parties to free-ride on the efforts of the plaintiff would so reduce the incentive to produce the product or service that its existence or quality would be substantially threatened.¹⁵⁸

¹⁵¹ *Id.* at *17.

¹⁵² *Id.* at *18.

¹⁵³ 105 F.3d 841 (2d Cir. 1997). The National Basketball Association wanted to stop the sale by Motorola of hand-held pagers that received updated scores and statistics taken from television and radio broadcasts of NBA games in progress.

¹⁵⁴ 248 U.S. 215 (1918).

¹⁵⁵ 105 F.3d at 845. See 17 U.S.C. § 101 (2001).

¹⁵⁶ 105 F.3d at 847.

¹⁵⁷ *Id.* at 852.

¹⁵⁸ *Id.* at 852 (citations omitted).

The court held that the NBA had satisfied only the first two elements of the INS test.¹⁵⁹ It found that the NBA failed to show that the defendant was free-riding, since the defendant compiled its own scores and statistics of the games, and that the NBA failed to show any direct competition with its primary products, the playing of the games for live attendance and the licensing of broadcasts of the games.¹⁶⁰

The court also discussed with favor the similar holding of the *Zeidenberg* case, which held that a function of the copyright preemption statute is to "prevent states from giving special protection to works of authorship that Congress has decided should be in the public domain."¹⁶¹ The court concluded that the copyright law preempted the NBA's misappropriation claim.¹⁶²

Because of its long history, the misappropriation doctrine might very well be successfully applied to electronic or online databases. However, its application would be severely limited to those situations falling within the "hot news" exception. While some online databases might satisfy all five requirements, the biggest hurdle will be proof of the time-sensitive nature of the content. In situations where the database contents were time-sensitive, it is quite conceivable that the other elements could be readily satisfied.¹⁶³ Absent the element of time-sensitive data, however, it would be unlikely that there would be a sufficient "extra element" to distinguish the protection afforded by a misappropriation claim from that provided under the copyright law.¹⁶⁴

While the rationale enunciated in *INS*, that one should not "reap where it has not sown," still may be sound, it is inconsistent with the protection provided under the copyright law if one is reaping merely (unprotectable) facts.¹⁶⁵ If a database contains merely facts, those facts are not protected by copyright, regardless of whether the database is found online or in a traditional place.

VI. THE EUROPEAN UNION DATABASE DIRECTIVE

While the U.S. struggles with the protection of databases, the European Union adopted the Directive on Legal Protection of Databases.¹⁶⁶ The Directive provides that "databases which, by reason of the selection and arrangement of their contents, constitute the author's own intellectual creation shall be protected as such by copyright."¹⁶⁷ This is similar to U.S. law. However, it also provides a *sui generis* right that protects the contents of a database that may or may not exhibit such creative arrangement or

¹⁵⁹ *Id.* at 853-854.

¹⁶⁰ *Id.* at 853-54.

¹⁶¹ *Id.* at 850.

¹⁶² *Id.* at 854.

¹⁶³ See *supra* note 158 and accompanying text.

¹⁶⁴ See Jane C. Ginsburg, *Copyright, Common Law, and Sui Generis Protection of Databases in the United States and Abroad*, 66 U. CIN. L. REV. 151, 157-64 (1997).

¹⁶⁵ 248 U.S. at 239. In describing the rationale of the Supreme Court in the *INS* case, Professor Patterson emphasized that the Court did not find copyright protection for the news content, but rather "the Court proceeded on the ground that the issue involved was not protection for the material, but protection for the service of transmitting the material to clients. The transmission, however, did not give the transmitter rights in the dispatches as against the public." Patterson, *supra* note 43, at 730.

¹⁶⁶ Council Directive 96/9, 1996 O.J. (L 77) [hereinafter Directive].

¹⁶⁷ *Id.* at art. 3.

selection.¹⁶⁸ The maker of a database can prevent the "extraction and/or re-utilization of the whole or of a substantial part" of a database, as long as the maker can show that there has been "qualitatively and/or quantitatively a substantial investment in either the obtaining, verification or presentation of the contents."¹⁶⁹ This rewards precisely the "sweat of the brow" that *Feist* eliminated. This sui generis protection lasts for 15 years, and starts anew if the database is substantially changed.¹⁷⁰ The protection is available primarily to makers of databases in member countries, and only on a reciprocal basis.¹⁷¹

While there was understandably great concern about the potential unfair advantages afforded to European database producers, there has not been much of a problem because of 1) reluctance by several member countries to enact legislation,¹⁷² 2) confusion about what the Directive requires of the legislation,¹⁷³ 3) inconsistent, but, generally narrow, interpretation by courts of enacted legislation,¹⁷⁴ and 4) sufficient loopholes for U.S. companies to avoid problems.¹⁷⁵

¹⁶⁸ This protection is similar to that given by the copyright laws of Denmark, Finland, Iceland, Norway and Sweden. The so-called "Nordic Catalogue Rule" provides protection for non-creative compilations of facts regardless of creativity or originality. See Michael J. Bastian, Note, *Protection of "Noncreative" Databases: Harmonization of United States, Foreign and International Law*, 22 B.C. INT'L & COMP. L. REV. 425, 438-439 (1999). Bastian also compares the copyright law in Japan and the U.S. to the sui generis protection under the Directive:

In Japan, the courts require more than originality and a modicum of creativity in the selection or arrangement of its contents; they also require a modicum of novelty or "new thought." This approach produces a "hard to copyright" system. On the other hand, Japanese copyright, once obtained, is "easy to infringe." Compare this to the U.S. system. The U.S. courts set a low threshold of originality and a modicum of creativity for copyrightability. This produces an "easy to copyright" system. However, this is counter-balanced by the "thin" protection the U.S. extends to factual compilations, making databases "hard to infringe." . . . Accordingly, the "easy to protect/easy to infringe" system created by the EU for databases is functionally incongruous with the Japanese "hard to protect/easy to infringe" system and the United States' "easy to protect/hard to infringe" system.

Id. at 456-57 (footnotes omitted). See also Michael Freno, *Database Protection: Resolving the U.S. Database Dilemma with an Eye Toward International Protection*, 34 CORNELL INT'L L.J. 165, 182-84 (2001).

¹⁶⁹ Directive, *supra* note 166, at art. 7.

¹⁷⁰ *Id.* at art. 10.

¹⁷¹ *Id.* at art. 11.

¹⁷² See P. Bernt Hugenholtz, *The New Database Right: Early Case Law from Europe* (presented at the Ninth Annual Conference on International IP Law & Policy, Fordham University School of Law) (Apr. 19-20, 2001), available at <http://www.ivir.nl/publications/hughholtz/fordham2001.html> (stating that only Germany, Sweden and the United Kingdom had met the January 1, 1998 deadline for implementation of the Directive, and that the European Commission brought proceedings against Greece, Ireland, Luxembourg and Portugal before the ECJ for failure to implement the Directive).

¹⁷³ While the Directive requires a "substantial investment" by the database owner, measured either "qualitatively" or "quantitatively," there is little guidance as to what minimal amount of investment is required. *Id.* Similarly, while the Directive prohibits reutilization of a "substantial" part of a database, there is no definition or quantification of this term. *Id.*

¹⁷⁴ Hugenholtz describes 25 cases from several different countries with some unusual findings. *Id.* For example, one French case did not apply the database right where there had been unauthorized use of a CD-ROM on a Web site, but another French case did apply the right, finding that telephone directories were databases, and that their unlicensed use online violated the law. *Id.* German cases held that a collection of online real estate advertisements, telephone directories, both electronic and non-electronic, and a list of 251 alphabetized links on a Web site were databases, but that a collection of online music files was not. *Id.* See

While some of the European courts that have interpreted the new laws have found protection for "sweat of the brow" databases, others have been reluctant to expand the protection much further than traditional U.S. copyright law.¹⁷⁶ An appellate court in a recent British case has referred the matter to the European Court of Justice (the "ECJ") for clarification of several issues.¹⁷⁷ The court had specifically recognized that decisions of some other member states, specifically Sweden and the Netherlands, had adopted a narrower approach to database rights than had England, and wanted guidance from the ECJ.¹⁷⁸

Many of the European cases involved "synthetic data," data that is produced by the database owner itself, and is incapable of collection by independent research, such as telephone listings, sporting event dates, concert times, and broadcast schedules.¹⁷⁹ Some Dutch courts have denied protection to such databases on the basis that there was not a "substantial investment," as required by the Directive, because this information had to be created anyway in conjunction with the non-database activities of the business.¹⁸⁰

Another familiar theme in many of the European cases was "deep linking," where one Web site linked directly to data contained within another Web site, bypassing that site's

The Database Right Revolution Begins, MANAGING INTELL. PROP., May 2001, at 18, 19-21 [hereinafter *Revolution*] (discussing a German, two Dutch, and a British case); Stephen M. Maurer, P. Bernt Hugenholtz & Harlan J. Onsrud, *Europe's Database Experiment*, SCI., Oct. 26, 2001, at 789-90 (discussing a number of cases, and urging repeal of the Directive).

¹⁷⁵ See Maurer, Hugenholtz & Onsrud, *supra* note 174, at 790 ("Furthermore, the Council Directive contains a loophole: If a U.S. company wants database rights, it can get them by moving some of its operations to Europe or else by finding a local partner."); Malla Pollack, *The Right to Know?: Delimiting Database Protection at the Juncture of the Commerce Clause, the Intellectual Property Clause and the First Amendment*, 17 CARDOZO ARTS & ENT. L.J. 47, 112 (1999) ("'American' producers of databases can, moreover, obtain protection inside the European Union by supplying their databases through European affiliates or offices.").

¹⁷⁶ For a discussion of some of these cases, see Hugenholtz, *supra* note 172, and *infra* notes 179-82 and accompanying text.

¹⁷⁷ In *British Horseracing Board Ltd. v. William Hill Organization Ltd.*, Case No. CHANI/2001/0632/A3 (Sup. Ct. Jud., Ct. App., Jul. 31, 2001), available at http://www.courtservice.gov.uk/judgments/judg_home.htm, the Supreme Court of Judicature, Court of Appeal, referred the case to the ECJ for clarification of several points pertaining to the Directive. The British Horseracing Board [hereinafter BHB], the governing authority for British horseracing, sued William Hill, an online gambling establishment, for exceeding the scope of the licensed use of BHB's database on William Hill's Web site. The trial court, the High Court of Justice, Chancery Division, found for BHB, holding that BHB had a database right, and that William Hill had infringed it by extracting and reutilizing substantial parts of the database, and by repeatedly and systematically extracting and reutilizing insubstantial parts of it. See *Revolution*, *supra* note 174, at 20-22; Ingrid Hering, *Uncertainty as Database Protection Looms in U.S.*, MANAGING INTELL. PROP., Sept. 2001, at 8; Ingrid Hering, *ECJ Called on to Clarify Database Law*, MANAGING INTELL. PROP., Sept. 2001, at 16.

It is not surprising that a British case is the first to go to the ECJ. The British had the strongest pre-Directive protection for non-creative databases (fifty years), and fought hardest for the sui generis protection. See W. Matthew Wayman, Comment, *International Database Protection: A Multilateral Treaty Solution to the United States' Database Dilemma*, 37 SANTA CLARA L. REV. 427, 439-40 (1997); Mark Schneider, *The European Union Database Directive*, 13 BERKELEY TECH. L.J. 551, 555-56 (1998).

¹⁷⁸ *BHB v. William Hill*, Case No. CHANI/2001/0632/A3.

¹⁷⁹ See Maurer, Hugenholtz & Onsrud, *supra* note 174, at 789-90.

¹⁸⁰ *Id.*

home page.¹⁸¹ These cases often focused on the loss of advertising revenue suffered by the site whose banner ads on the home page were bypassed, with some courts finding infringement, and some not.¹⁸² Courts in the member states will anxiously await the decision of the ECJ.

VII. U.S. LEGISLATIVE RESPONSES

Not surprisingly, after the Directive was adopted in Europe, there were attempts to pass similar legislation in the United States. Bills were introduced in the 104th,¹⁸³ 105th¹⁸⁴ and 106th¹⁸⁵ Congress, but none were passed. The 105th Congress came close to passing one of the bills, as part of the Digital Millennium Copyright Act, but the database provisions were removed at the last minute after the Department of Commerce, the Department of Justice, and the Federal Trade Commission voiced concern.¹⁸⁶

A memorandum from the Department of Justice addressed 1) whether the bill [House Bill 2652] would constitute a valid exercise of Congress's power under the Intellectual Property Clause, 2) whether, if not, it would constitute a valid exercise of Congress's power under the Commerce Clause, or whether the Intellectual Property Clause would preclude such legislation based upon the Commerce Clause, and 3) whether, if the Intellectual Property Clause would not preclude Congress from exercising its commerce power to enact such legislation, the First Amendment would restrict such power.¹⁸⁷ It basically concluded that both the Intellectual Property Clause and the First Amendment would greatly restrict Congress's ability to exercise its commerce power to protect factual collections of information.¹⁸⁸ Furthermore, the First Amendment imposes "significant

¹⁸¹ See *Revolution*, *supra* note 174, at 19; Maurer, Hugenholtz & Onsrud, *supra* note 174, at 790; Hugenholtz, *supra* note 172. The question of deep linking was addressed in an earlier stage of the Ticketmaster case, *see supra* note 149, with the court finding no copyright violation because there was no copying. 2000 U.S. Dist. LEXIS 4553, at *6.

¹⁸² For example a German court found that deep links to a job recruitment Web site resulted in infringement of a database, but a Dutch court found that deep links to a collection of newspaper articles was not infringement because the collection of the headlines of the articles did not constitute a database. See *Revolution*, *supra* note 174, at 19.

¹⁸³ Database Investment and Intellectual Property Antipiracy Act of 1996, H.R. 3531, 104th Cong. (1996).

¹⁸⁴ Collections of Information Antipiracy Act, H.R. 2652, 105th Cong. (1997) [hereinafter House Bill 2652].

¹⁸⁵ Collections of Information Antipiracy Act, H.R. 354, 106th Cong. (1999) [hereinafter House Bill 354] and Consumer and Investor Access to Information Act, 15 H.R. 1858, 106th Cong. (1999).

¹⁸⁶ The House passed House Bill 2652 as a stand-alone bill, and then as part of the Digital Millennium Copyright Act [hereinafter DMCA]. However, it was dropped from the DMCA in the House-Senate conference before final approval. See Jonathan Band & Makoto Kono, *The Database Protection Debate in the 106th Congress*, 62 OHIO ST. L.J. 869, 872 (2001); Conley et al., *supra* note 50 at ¶ 90.

¹⁸⁷ William Michael Treanor, Deputy Ass't. Att. Gen., Office of Legal Counsel, Dept. of Justice, Memorandum to William P. Marshall, Associate White House Counsel (July 28, 1998), at <http://www.acm.org/usacm/copyright/doj-hr2652-memo.html> [hereinafter Treanor, Memorandum]. See Russell G. Nelson, Recent Development, *Seeking Refuge from a Technology Storm: The Current Status of Database Protection Legislation after the Sinking of the Collections of Information Anti-Piracy Act and the Second Circuit Affirmation of Matthew Bender & Co. v. West Publishing Co.*, 6 J. INTELL. PROP. L. 453, 472-77 (1999) (discussing the concerns raised by the Department of Justice and the Federal Trade Commission).

¹⁸⁸ Treanor, Memorandum, *supra* note 187. See Pollack, *supra* note 175, at 61 (1999) (discussing House Bill 2652, and concluding that "a database protection act grounded on the Commerce Clause can pass

constraints on the ability of the government to restrict the dissemination of information that has been publicly disclosed."¹⁸⁹ The memo recommended that Congress limit any legislation to the narrow remnant of misappropriation of time sensitive, "hot news" left from *INS*, as discussed in the *NBA* case¹⁹⁰ in order to avoid potential conflicts with the Intellectual Property Clause and the First Amendment.

One state is even considering passing a database protection bill. The Georgia Senate unanimously passed a bill in 2001 that is very similar in nature to the European Union Directive and the various bills proposed in Congress.¹⁹¹ It would essentially prevent the extraction of data from a database for use in commerce. The bill was held over to the 2002 session and assigned to a special judiciary subcommittee. However, it will be even more difficult for a state to pass such legislation than for Congress. While federal legislation would have to overcome the Intellectual Property Clause/Commerce Clause/First Amendment battles,¹⁹² state legislation would have to be drawn extremely narrowly in order to avoid a successful federal preemption challenge.¹⁹³

The sui generis protection provided by the European Union and proposed in various bills in Congress is inappropriate for the United States. The Constitution clearly specifies both the purpose of the copyright law ("to promote the progress of science and the useful arts"), and the means by which to accomplish that goal ("by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries").¹⁹⁴ There has been great reluctance to enact legislation that would so dramatically alter basic principles of copyright law. Furthermore, it is unlikely that such sui generis protection would be authorized under the Commerce Clause, or be able to survive a First Amendment challenge.¹⁹⁵

constitutional scrutiny only if the act is carefully limited to situations of market failure. A database protection act would promote the progress of science and the useful arts if, and only if, without protection the facts would not be collected for use by other persons.") (footnote omitted); Paul J. Heald & Suzanna Sherry, *Implied Limits on the Legislative Power: The Intellectual Property Clause as an Absolute Constraint on Congress*, 2000 U. ILL. L. REV. 1119, 1178 (2000) (discussing House Bill 354, and its conflict with Congress's obligation to protect the public domain: "As the Court explained in *Feist*, facts have historically been considered to form a critical part of the public domain, available for anyone to use. Current doctrine protects a compilation of facts from copying to the extent that it evidences some originality in its arrangement, selection, or coordination, but the raw facts themselves must remain available for anyone to exploit. To the extent that the bill creates exclusive rights in facts themselves, the history and structure of the Intellectual Property Clause militate against Congress's power to grant such a right.") (footnotes omitted); Paul J. Heald, *The Extraction/Duplication Dichotomy: Constitutional Line-Drawing in the Database Debate*, 62 OHIO ST. L.J. 933, 944-45 (2001) (also discussing House Bill 354: "In accordance with the [importance of the public domain], Congress may protect a collection of information from wholesale replication for resale, but it may not protect facts from mere extraction. Congress therefore cannot use the Commerce Clause to get around the holding in *Feist* that facts per se may not be protected.") (footnote omitted). For a comprehensive collection of articles discussing the interaction and potential conflict between the Intellectual Property Clause and the Commerce Clause, see Heald & Sherry, *supra*, at 1120 n.7, 1177-78 n.409.

¹⁸⁹ Treanor, Memorandum, *supra* note 187.

¹⁹⁰ See *supra* notes 153-62 and accompanying text.

¹⁹¹ Georgia Data Base Protection and Economic Development Act of 2001, SB214 (2001).

¹⁹² See *supra* notes 187-89 and accompanying text.

¹⁹³ See *supra* notes 114-65 and accompanying text.

¹⁹⁴ U.S. Const. art. I, § 8, cl. 8. See *supra* notes 11-13, 187-89 and accompanying text.

¹⁹⁵ See *supra* notes 187-89 and accompanying text.

VIII. CONCLUSION

Legal theories in contract, trespass or misappropriation may be able to coexist with copyright law. However, because preemption will not permit these theories to circumvent equivalent rights provided by the copyright law, the application of these theories will remain very limited in scope. In order for a contractual provision to withstand preemption, it must provide protection that is different from that afforded by the copyright law. This will very difficult to do for the content of databases of non-creative works. Furthermore, such a contractual provision also may be subject to challenge if it comes as part of a shrinkwrap or clickwrap license, as probably would be the case in an online or electronic transaction. Trespass and misappropriation theories may have a better chance of surviving preemption challenges, but are typically so narrow as to provide very little protection.

The main purpose of the copyright system is "to promote the progress of science and the useful arts."¹⁹⁶ This is accomplished largely by encouraging the free flow of information and ideas.¹⁹⁷ The system rewards originality and creativity by giving the author a limited monopoly for a specific period of time. After this time, the work becomes part of the public domain. If a work does not qualify for protection because it lacks the requisite originality and creativity, it also becomes part of the public domain. Digital technology and the Internet have certainly changed the mechanics of copying, but they should not be used to justify a deviation from these basic principles. Neither copyright law nor any other legal theory should be permitted to impede this "life blood of a free society."¹⁹⁸

¹⁹⁶ U.S. Const. art. I, § 8, cl. 8. *See supra* note 11 and accompanying text.

¹⁹⁷ Professor Patterson states that "[c]opyright is essentially the law of communication and communication is the life blood of a free society." Patterson, *supra* note 43, at 731.

¹⁹⁸ *Id.* Patterson also observes:

The cost of disregarding the past will be the diminution of the right upon which a free society depends, the freedom to learn, a right guaranteed by the First Amendment and promoted by the Copyright Clause. Proprietary rights in information and learning not only reduce free speech rights to the status of an empty slogan, they also make a mockery of the limited copyright monopoly that the framers empowered Congress to grant.

Id. at 732.