

No. _____

**In the
Supreme Court of the United States**

STUART Y. SILVERSTEIN,
Petitioner,

v.

PENGUIN PUTNAM, INC.,
Respondent.

**On Petition for a Writ of Certiorari
to the United States Court of Appeals
for the Second Circuit**

PETITION FOR WRIT OF CERTIORARI

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QUESTIONS PRESENTED FOR REVIEW

The Second Circuit’s decision in the instant case presents an important question regarding this Court’s pronouncement as to the level of original creativity necessary to confer copyright protection upon a compilation under Sections 101, 102 and 103 of the Copyright Act of 1976, 17 U.S.C. §§ 101, 102, 103. This Court has held that “the requisite level of creativity is extremely low” and even a “minimal amount” is sufficient to make the compilation copyrightable.¹ *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co., Inc.*, 499 U.S. 340, 345, 348, 111 S. Ct. 1282, 1287, 1289 (1991). This Court further held that a compilation is entitled to copyright protection unless it occupies “a narrow category of works in which the creative spark is utterly lacking or so trivial as to be virtually nonexistent.” 499 U.S. at 359, 111 S. Ct. at 1294. Several Circuits have consistently interpreted and applied this Court’s standard.

The Second Circuit considered Penguin’s copying of Silverstein’s book, *Not Much Fun*, *verbatim* by literally cutting the book apart and pasting the pages into its manuscript for its book *Complete Poems*. Silverstein demonstrated that he exercised subjective creative judgment by selecting for inclusion in his work items that are not objectively recognizable, and have never previously been classified, as poems. This uncontroverted evidence, constituting vastly more than a “minimal amount” of

¹ The most authoritative American dictionary defines “minimal” as “constituting the least possible in size, number or degree; extremely minute.” *Webster’s Third New International Dictionary* (Springfield, Mass.: G. & C. Merriam, 1961, 1971 ed.) at 1438.

creativity, alone satisfies the *Feist* test for originality. However, the Second Circuit effectively held that a far greater level of creativity – and one that effectively flouts the *Feist* standard – must be shown in order to qualify for copyright protection. Thus, this Petition presents the question whether the Second Circuit’s decision (1) conflicts with the decisions of other United States courts of appeals on the same important matter, namely, the level of original creativity necessary to confer copyright protection upon a compilation under Sections 101, 102 and 103 of the Copyright Act of 1976, 17 U.S.C. §§ 101, 102, 103; and/or (2) apparently and directly conflicts with relevant decisions of this Court. Sup. Ct. R. 10(a), (c).

**PARTIES TO THE PROCEEDING
AND RULE 29.6 STATEMENT**

Petitioner, Stuart Y. Silverstein is a citizen of the State of California.

Respondent, Penguin Putnam, Inc., now known as Penguin Group (USA) Inc., is a wholly owned subsidiary of its parent corporation, Pearson-Longman, Inc., which is indirectly owned by Pearson plc., a public corporation.

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- Random House Unabridged 2nd Ed.* (New York:
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- Webster's Third New International Dictionary*
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PETITION FOR WRIT OF CERTIORARI

Petitioner, Stuart Y. Silverstein, respectfully petitions for a writ of certiorari to review the decision and opinion of the United States Court of Appeals for the Second Circuit entered on May 7, 2004.

OPINIONS BELOW

The Opinion of the Court of Appeals has been published at *Silverstein v. Penguin Putnam, Inc.*, 368 F.3d 77 (2d Cir. 2004), and is reproduced in Appendix B. The prior Opinion of the United States District Court for the Southern District of New York is reproduced in Appendix C.

JURISDICTION

The Court of Appeals' decision was entered on May 7, 2004. Silverstein filed a timely petition for rehearing on May 21, 2004. The Court of Appeals denied Silverstein's petition on August 23, 2004. (App. 1a-20a.) This Court's jurisdiction is invoked under 28 U.S.C. § 1254(1).

STATUTE INVOLVED

Section 101 of the Copyright Act of 1976, 17 U.S.C. § 101, provides:

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.

Section 102 of the Copyright Act of 1976, 17 U.S.C. § 102, provides:

(a) Copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived,

reproduced, or otherwise communicated, either directly or with the aid of a machine or device. Works of authorship include the following categories:

- (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.

(b) 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.

Section 103 of the Copyright Act of 1976, 17 U.S.C. § 103, provides:

(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, subsistence of, any copyright protection in the preexisting material.

STATEMENT OF THE CASE

A. Factual Background

While Dorothy Parker collected most of the poems and free verses that she wrote during her career in three books of original poetry and two subsequent compilations, she chose not to collect many other such works. (*Not Much Fun* (Dannay Declaration, Ex. B), at 62-63.) Plaintiff-Petitioner, Stuart Y. Silverstein (“Silverstein”) spent over one thousand hours at several libraries around the country searching in numerous periodicals and newspapers from 1915 through 1944 for items that could have been written by Parker. (Silverstein Deposition, at 135-136; Silverstein Interrogatory Answers, at ¶ 1; Originally Published Poems (McCabe Declaration, Ex. 20); Silverstein Declaration, at ¶¶ 3-4.) Silverstein then selected 122 items from a vastly larger pool of items attributed to Parker by making subjective judgments as to whether each item was, in his subjective opinion, written by Parker and, if so, whether it was a poem or verse or not. (Silverstein Deposition, at 42-64, 107-108, 143-145.) Silverstein further determined whether to select free verses to appear in a collection that by its very title was limited to poems. (Silverstein Deposition, at 137-139; Silverstein Interrogatory Answers, at ¶ 1(c); Silverstein Supplemental Interrogatory Answers, at ¶ 1(c).) Silverstein also exercised his subjective creative judgment in the coordination and arrangement of the Parker items by devising standard protocols for titling and editing changes, specifically punctuation, capitalization and indentation and particularly for distinguishing identically-titled poems and verses. (Silverstein

Deposition, at 66-99; Silverstein Interrogatory Answers, at ¶¶ 4(a), 5(a); *Not Much Fun* (Dannay Declaration, Ex. B), at 174.)

Silverstein did not merely locate and arrange items that are objectively recognizable as Parker's poems. Rather, Silverstein determined to be poems and selected for *Not Much Fun* **short passages that he found buried in multi-page book reviews,² a chatty personal letter,³ and even a magazine ad** intended to promote sales of another poet.⁴

In May 1994, during the course of this work, which consumed more than a year, Silverstein met Jane von Mehren, then the executive editor of Viking Penguin (the predecessor entity to Defendant-Respondent, Penguin Putnam, Inc. ("Penguin")). (Silverstein Deposition, at 149-151; Von Mehren Deposition, at 61.) Silverstein told her that he "was doing some research and found some stuff of Dorothy Parker's that apparently had not been published in 70, 80 years." (Silverstein Deposition, at 150.) Von Mehren told Silverstein that she was interested and requested to see some samples and then to see his manuscript. (*Id.* at 150-151.)

In June 1994, Silverstein delivered a manuscript to von Mehren, every page of which carried this notice:

² "Chris-Cross" and "After Dawn" (*Not Much Fun* (Dannay Declaration, Ex. B), at 174, 181; Originally Published Poems (McCabe Declaration, Ex. 20), at 150, 156.)

³ "Letter to Robert Benchley" (*Not Much Fun* (Dannay Declaration, Ex. B), at 78; Originally Published Poems (McCabe Declaration, Ex. 20), at 60.)

⁴ "Letter to Ogden Nash" (*Not Much Fun* (Dannay Declaration, Ex. B), at 180; Originally Published Poems (McCabe Declaration, Ex. 20), at 155.)

“Compilation ©1994 Stuart Y. Silverstein. All rights reserved.” (Von Mehren Deposition, at 67-68; Silverstein Manuscript and June 4, 1994 Cover Letter (McCabe Declaration, Ex. 16).) Von Mehren as well as other editors at Penguin understood that Silverstein was asserting a copyright in the compilation of his manuscript. (Von Mehren Deposition, at 68-71; Millman Deposition, at 50-52; Court Deposition, at 33-34.) Penguin’s senior editors discussed the manuscript at an editorial meeting and among themselves. (Court Deposition, at 30-35; Millman Deposition, at 38-45; Von Mehren Deposition, at 64-66, 70-71.) Penguin ultimately offered to buy Silverstein’s compilation in October 1994 to include in a larger collection of Parker’s works. (October 28, 1994 Von Mehren Memo to Peter Lampack (McCabe Declaration, Ex. 17).) Silverstein rejected the Penguin offer. (Von Mehren Deposition, at 60-78; Court Deposition, at 144-145; October 28, 1994 Von Mehren Memo to Peter Lampack (McCabe Declaration, Ex. 17).)

Silverstein ultimately contracted with the Scribner imprint of Simon & Schuster, Inc., which published his book *Not Much Fun: The Lost Poems of Dorothy Parker* (“*NMF*”) in July 1996. In 1999, Penguin published *Dorothy Parker: Complete Poems* (“*Complete Poems*”). One discrete 181-page section of *Complete Poems* is titled “Poems Uncollected By Parker,” which, with the exception of one item, supplies precisely the same selection of poems and free verses as *NMF*. (See *Complete Poems* (Dannay Declaration, Ex. D); *Not Much Fun* Hardcover Edition (Dannay Declaration, Ex. B); *Not Much Fun* Paperback Edition (Dannay Declaration, Ex. C).) Von Mehren’s direct subordinate, Michael Millman, edited *Complete Poems*; von Mehren’s direct superior, Penguin Putnam publisher Kathryn Court – the top editor for the Penguin imprint in the United States -- was involved in the decisions to offer to purchase *NMF* and then to approve the

Complete Poems project. (Von Mehren Deposition, at 70-73, 77, 89-93.)

It is undisputed that, in preparing *Complete Poems*, either Penguin or its editor, Colleen Breese, bought a hardcover copy of *NMF*, photocopied it (except for one poem), cut apart those photocopies, pasted them onto new sheets of paper and delivered them to Penguin in that form as the “Poems Uncollected By Parker” section of the *Complete Poems* manuscript. Breese further admitted that she submitted the manuscript in that form without changing so much as a single letter in any item and Penguin then published *NMF* – *verbatim* – as the discrete “Poems Uncollected By Parker” section of *Complete Poems*. (App. 7a; Breese Deposition, at 95-96, 141-143, 156-158, 160, 215, 220-222; Millman Deposition, at 64, 157-159.)

Breese testified that she merely gave “a general look” at the items in the original source and *NMF* in order to determine “[t]hat there were words on the page, it was the format, the title was there. That kind of thing.” (Breese Deposition, at 230.) *NMF* neither directly states nor indirectly implies that the poems are identical to the original text. Breese testified that she noticed that Silverstein had created or changed titles for some of the items and even wrote “title?” where those items appeared in her copy of *NMF*. (Breese Deposition, at 196-197, 209; Breese Handwritten Notes on Copy of *Not Much Fun* (McCabe Declaration, Ex. 12) at 174, 181.) Having admittedly explicitly observed that Silverstein had edited *some* parts of the various items from their original forms, Breese could not reasonably have assumed that other parts, *i.e.*, the text, were untouched.

Penguin senior editor Michael Millman testified that Breese submitted to him a manuscript that consisted of “xeroxes of poems that had already been published, [including

the poems and verses published in *NMF*,] which we wanted to go into [*Collected Poems*].” (Millman Deposition, at 233, 237.) With the manuscript, Breese sent a cover letter in which she explicitly described her “cutting and pasting.” (August 23, 1998 Breese Letter to Millman (McCabe Declaration, Ex. 7).)

Even though Penguin editors are “instructed to refer potential legal issues that arise in the course of their duties to the company’s legal department,” Millman, the senior editor of *Complete Poems*, never bothered to consult Penguin’s legal department to determine if Penguin’s *verbatim* copying of the poems and verses in *NMF* comported with copyright law or company policy. (Millman Deposition, at 17, 89-91, 104-05; Court Deposition, at 178-79.)

Court admitted that she could not recall any other instance during her twenty years of publishing experience in which a publisher photocopied material on which a copyright was explicitly asserted and then republished the material without obtaining permission from the original author. (Court Deposition, at 149-150.) Nor was she aware of another instance in which “Penguin deliberately copied a book in which another publisher/writer asserted a copyright.” (*Id.* at 152.) Nor could von Mehren recall having heard of any such conduct in *her* seventeen years’ experience in the publishing industry. (Von Mehren Deposition, at 52-54.)

Penguin violated its own policies when it published *NMF verbatim* as a discrete section of *Complete Poems*. (Breese Deposition, at 95-96, 141-143, 156-158, 160, 215, 220-222; Millman Deposition, at 26-32, 63, 157-160; August 23, 1998 Breese to Millman Letter (McCabe Declaration, Ex. 7); Court Deposition, at 23-29, 46-52; *Viking Penguin Authors Guide* (McCabe Declaration, Ex. 10); April 18, 1996 Karen Mayer Letter to All Adult Trade and Mass Market Editors

(McCabe Declaration, Ex. 11).) Penguin did so despite explicitly possessing actual knowledge at the time that Silverstein was asserting compilation copyright protection in *NMF*. (Millman Deposition, at 63-64, 159-161; Von Mehren Deposition, at 68-70; Court Deposition, at 33-34.) Penguin issued seven printings of *Complete Poems* from April 1999 through 2002, at least four of which were released after Silverstein notified Penguin of his claim. (May 17, 2000 Glen Kulik Letter to Phyllis Grann (McCabe Declaration, Ex. 12); Silverstein Declaration, at ¶ 8.)

In the “Note on the Text” found in *Complete Poems*, Penguin falsely asserts that the poems and verses contained in that book are “faithfully reproduced from Dorothy Parker’s original collection . . . and [for Poems Uncollected by Parker] from Bookman, Life, McCall’s, Nation, New Republic, The New Yorker, New York Herald Tribune, New York World, Saturday Evening Post, Saturday Review, Vanity Fair, Vogue, and Yale Review.” (*Complete Poems*, (Dannay Declaration, Ex. D), at xxxix.) Both Breese and Millman admitted that such statement is not now and never was true. (Breese Deposition, at 241-242; Millman Deposition, at 301-304.)

Breese herself questioned whether some of Silverstein’s selections actually were poems and whether they should have been selected for *Complete Poems*, but she ultimately decided to defer to Silverstein’s creative judgment and, upon that pretext, copied Silverstein’s selection. (Breese Handwritten Notes on Copy of *Not Much Fun* (McCabe Declaration, Ex. 12), at 174-182; Breese Deposition, at 196-198.) Penguin also deferred to Silverstein’s creative judgment and excluded precisely those items that Silverstein had determined not to select for his compilation, although another scholar previously

had determined several such items to be poems. (Silverstein Deposition, at 45-51; Silverstein Interrogatory Answers, at ¶ 3(a).)

Then, after it flagrantly copied virtually all of Silverstein's book, Penguin took great care to omit from *Complete Poems* any credit or attribution either to Silverstein or his book. Despite all of her professed scholarly work and full citation of all authorities on which she relied in her dissertation, Breese suggested, astonishingly, that Silverstein's name not be mentioned at all in *Complete Poems*: "I don't think we want to direct people to the competition." (August 23, 1998 Colleen Breese Letter to Michael Millman (McCabe Declaration, Ex. 13).) Millman agreed and the book as published fully concealed Penguin's complete reliance on *NMF* for the full text of the "Poems Uncollected By Parker" section of Penguin's book.

B. The District Court Proceedings

Silverstein instituted this action by filing a Complaint against Penguin, seeking to redress Penguin's *verbatim* copying and publication of *NMF* as part of *Complete Poems*. In his Amended Complaint, Silverstein asserted claims for copyright infringement, violation of the Lanham Act and immoral trade practices and unfair competition under New York law.

On April 4, 2003, the District Court issued its Opinion and Order which (a) granted Silverstein's summary judgment motion as to liability on all of his claims; (b) denied Penguin's summary judgment motion; (c) stated that Penguin was enjoined from selling or further distributing *Complete Poems*; and (d) scheduled a status conference to consider the specific language of the injunction. (App. 23a-41a.) The District Court held that Silverstein held a valid copyright in *NMF*, finding that his selection, arrangement and coordination of the

material reflected a substantial amount of creativity and judgment that was well beyond the minimum requirement for originality. The District Court also found that (a) Penguin copied *NMF* by photocopying it, cutting-and-pasting the photocopies and republishing them; (b) Penguin's copying infringed Silverstein's copyright; and (c) Penguin's "failure to give any credit or attribution to *Not Much Fun* was deliberate and not inadvertent." The District Court further held that Penguin had (a) violated Section 43(a) of the Lanham Act (15 U.S.C. § 1125(a)) by passing off *Complete Poems* as its own work and willfully failing to credit Silverstein; and (b) engaged in immoral trade practices and unfair competition under New York law by failing to designate Silverstein as the source of the work.

On April 14, 2003, Penguin filed its Notice of Appeal challenging the language in the District Court's Opinion and Order that referred to the enjoining of Penguin's sale and further distribution of *Complete Poems*. On June 11, 2003, the District Court entered an Order which permanently enjoined Penguin from publishing, selling or marketing *Complete Poems* and ordered Penguin to recall all unsold copies of *Complete Poems* that already were distributed. (App. 48a-50a.) On that same day, the District Court also issued an Opinion and Order denying Penguin's motion to stay the injunction pending appeal. (App. 42a-47a.) On June 16, 2003, Penguin filed a second Notice of Appeal directed to the Court's June 11, 2003 Order and the two appeals were consolidated. The Second Circuit denied Penguin's motion for stay of the injunction pending appeal on July 21, 2003.

C. The Court of Appeals' Decision

The Court of Appeals' decision was entered on May 7, 2004. In its decision, the Court of Appeals considered the creative nature of Silverstein's selection of the items that he

included in *Not Much Fun*. The Court of Appeals stated that “Parker herself created the category of uncollected Parker poems by collecting fewer than all her poems in her lifetime; so that the principle of selection owes nothing to Silverstein.” (App. 9a) The Court of Appeals dismissed the evidence that Parker’s bibliographer, Calhoun, had classified various items written by Parker as poems or not poems differently than Silverstein had. (App. 9a-12a) The Court of Appeals noted that “Professor Calhoun does not seem to be a party to this scholarly dispute” since “Silverstein has never communicated with Calhoun and has no direct knowledge of what, if anything, he ‘concluded.’” (App. 10a) The Court of Appeals further stated that Calhoun and Silverstein may have had alternative rationales for their classifications. (App. 10a-12a)

The Court of Appeals stated that “if the selection process imbues a compilation with the requisite creative spark, the compilation may be protected so long as there are indicia that principles of selection (other than all-inclusiveness) have been employed.” (App. 15a) The Court of Appeals then held that Silverstein’s selection from a universe of voluminous writings of 122 items that he subjectively determined to be poems written by Dorothy Parker may not qualify for copyright protection as an original compilation because that selection is inherently all-inclusive of the items chosen and therefore not a selection at all. (App. 17a)

The Court of Appeals also held that Silverstein was estopped to claim a copyright on the basis of the 600 punctuation, titling and formatting edits that Silverstein made to standardize the text and titles he created because his book did not contain a notice informing readers that such changes were made. (App. 14a-15a) The Court of Appeals further held that, “[e]ven if Silverstein’s creative contribution to the selection of Mrs. Parker’s previously uncollected poems is non-trivial, and even if Penguin’s appropriation of it was

deliberate, enforcement of his rights by a preliminary or permanent injunction that stops publication of *Complete Poems* is an abuse of discretion.” (App. 18a-19a)

The Court of Appeals vacated the District Court’s Order entering summary judgment and remanded the action to the District Court for further proceedings to resolve various questions of fact. (App. 19a-20a)

REASONS FOR GRANTING THE PETITION

This Court should grant Silverstein’s Petition for Writ of Certiorari because the Second Circuit in the instant case has entered a decision that (1) conflicts with the decisions of other United States courts of appeals on the same important matter, namely, the level of original creativity necessary to confer copyright protection upon a compilation under Sections 101, 102 and 103 of the Copyright Act of 1976, 17 U.S.C. §§ 101, 102, 103, apparently and directly conflicts with relevant decisions of this Court. SUP. CT. R. 10(a), (c). This Court has held that “the requisite level of creativity is extremely low” and even a “minimal amount” is sufficient to make the compilation copyrightable.⁵ *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co., Inc.*, 499 U.S. 340, 345, 348, 111 S. Ct. 1282, 1287, 1289 (1991). This Court further held that a compilation is entitled to copyright protection unless it occupies “a narrow category of works in which the creative spark is utterly lacking or so trivial as to be virtually nonexistent.” 499 U.S. at 359, 111 S. Ct. at 1294. Several Circuits have consistently interpreted and applied this Court’s

⁵ The most authoritative American dictionary defines “minimal” as “constituting the least possible in size, number or degree; extremely minute.” *Webster’s Third New International Dictionary* (Springfield, Mass.: G. & C. Merriam, 1961, 1971 ed.) at 1438.

standard. However, the Second Circuit effectively held that a far greater level of creativity – and one that effectively flouts the *Feist* standard – must be shown in order to qualify for copyright protection.

This Court should note particularly that “minimal,” as properly defined and understood, is an oddity which allows more objectively accurate interpretation and application than is allowed by almost any other standard or burden of proof. It is an objectively quantifiable standard; almost all standards and burdens of proof are to greater or lesser extent subjective—and that applies whether the particular standard or burden happens to be “small,” or “substantial”; or whether it requires the “preponderance of” or “clear and convincing” evidence; or it triggers yet another search for that elusive “reasonable man”—in fact, with the notable exception of “strict liability,” virtually all standards and burdens of proof are ultimately subjective. But “minimal” is *not*: as properly defined and applied, it applies the very specific and quantifiable standard of “any” instances or evidence whatever—that is, one such instance. Here there are 68 instances of original selection alone.

Nor can these 68 instances be characterized as “garden-variety” or “trivial.” *Feist*, 499 U.S. at 358-359. Very few compilations are literary in nature; almost are collections of facts: that is, directories, almanacs, and the like. *Feist*, for example, was about a directory. It is clear from the underlying context of that ruling that when Justice O’Connor cautioned about “garden variety” or “trivial” changes, she was thinking about minor and practically unimportant differences in the manner in which the material is presented. Certainly Silverstein would agree that a compilation should not be conferred with copyright protection if the only changes alleged are, for example, to change the headings from boldface to underlined italic on an “Annual

Soybean Production by State” list. But selection is the basic and fundamental underlying element of *any* compilation, and *any* differences in selection—so long as they are not intended solely to distinguish the collection at issue from a previously copyrighted compilation (as properly noted in *Key Publ’ns, Inc. v. Chinatown Today Publ’g Enters., Inc.*, 945 F.2d 509, 514 (2d Cir. 1991))—are by their very nature non-trivial.

The Second Circuit acknowledged that Penguin copied Silverstein’s book, *NMF*, *verbatim* by literally cutting the book apart and pasting the pages into its manuscript for its book *Complete Poems*. (App. 6a-7a) Silverstein demonstrated that in compiling *NMF* he selected 122 items that he subjectively determined to be poems or verses which Dorothy Parker had written, including **short passages that he found buried in multi-page book reviews,**⁶ **a chatty handwritten personal letter,**⁷ **and even a magazine ad.**⁸ No one previously recognized these latter items as poems, including Parker’s bibliographer, Randall Calhoun. As the District Court correctly recognized, Silverstein made those selections by “relying on his own taste, judgment and informed decision-making.” (App. 31a) This uncontroverted evidence, constituting far more than a “minimal amount” of creativity, alone satisfies the *Feist* test for originality.

⁶ “Chris-Cross” and “After Dawn” (*Not Much Fun* (Dannay Declaration, Ex. B), at 174, 181; Originally Published Poems (McCabe Declaration, Ex. 20), at 150, 156.)

⁷ “Letter to Robert Benchley” (*Not Much Fun* (Dannay Declaration, Ex. B), at 78; Originally Published Poems (McCabe Declaration, Ex. 20), at 60.)

⁸ “Letter to Ogden Nash” (*Not Much Fun* (Dannay Declaration, Ex. B), at 180; Originally Published Poems (McCabe Declaration, Ex. 20) at 155.)

Silverstein demonstrated at least 68 **documented** instances in which Silverstein and other authorities, including Calhoun, the eminent novelist Somerset Maugham and Penguin's editor, Colleen Breese, disagreed as to whether various items were poems. (Silverstein Deposition, at 43-65, 107-108, 137-139; Silverstein Interrogatory Answers, at ¶¶ 2(a), 2(b), 3(a); Silverstein Supplemental in Interrogatory Answers, at ¶ 1(c); Breese Deposition, at 196-198; Breese Handwritten Notes on Copy of *Not Much Fun* (McCabe Declaration, Ex. 12), at 174-182; Silverstein Manuscript and June 4, 1994 Cover Letter (McCabe Declaration, Ex. 16).) Each of those instances in itself constitutes that “minimal” “creative spark” that is entitled to copyright protection because a selection is original per *Feist* when another person engaging in the same exercise would not necessarily “select the same categories of information.” *Matthew Bender & Co. v. West Publ'g Co.*, 158 F.3d 674, 682 (2d Cir. 1998).

Nevertheless, the Second Circuit held that Silverstein's subjective selection may perhaps not be entitled to compilation copyright protection as an original work, despite this Court's holding in *Feist*, 499 U.S. at 345, 348. The Second Circuit's decision relies on an utterly false premise; that is, the issues of whether an item (a) constitutes a poem and (b) was written by Dorothy Parker are objectively determinable – that every scholar would have selected as did Silverstein – despite extensive and explicit evidence to the contrary – that other scholars did *not* select as Silverstein had done. The Second Circuit disregarded Silverstein's exercise of subjective creative judgment by selecting items that are not objectively recognizable, and have never previously been classified, as poems. Silverstein demonstrated conclusively that he did not merely locate and arrange items that are objectively recognizable as Parker's poems.

Indeed, the Second Circuit's decision in this case conflicts with the decisions of several other circuit courts in its interpretation of this Court's holding in *Feist*. The Second Circuit created this split of authority when it applied a new, more stringent, and unsupported standard to determine when copyright protection should be afforded to a compilation. It is of vital importance to the future of copyright law that this Court grant Silverstein's petition for review because the Second Circuit's ruling sanctions egregious copyright infringement and threatens immediate harm to authors of compilations whose original works actually are protected by copyright. It is also important that this Court seize this opportunity to mend this split of authority because it involves a very important issue of copyright law.⁹

A. The Second Circuit's New Standard for Copyright Protection of Compilations Conflicts with the Decisions of Other Circuits.

The Second Circuit in the instant case departed from the precedent of several other circuit courts when it articulated a standard for measuring whether a compilation is entitled to copyright protection that is different from the other circuits' interpretation of the standard set out by this Court in 1991 in

⁹ The interlocutory nature of the Second Circuit's ruling does not militate against its review by this Court. This Court's resolution of the issue in the Petition will hasten the completion of this litigation and the issue in the Petition is "fundamental to the further conduct of the case." *Land v. Dollar*, 330 U.S. 731, 734, 67 S. Ct. 1009, 1010 n.2 (1947). Additionally, as discussed below, the Second Circuit's decision "is clearly erroneous under [this Court's] precedents" and will produce "immediate consequences," given the Second Circuit's reversal of the District Court's injunction." *Mazurek v. Armstrong*, 520 U.S. 968, 975, 117 S. Ct. 1865, 1868 (1997).

Feist. Most circuits have interpreted the *Feist* “minimal degree of creativity” test to mean that a court rarely will hold that a compilation displaying the author’s personal subjective selection, coordination or arrangement contains insufficient creativity to render it a protected original work of authorship. These circuits have held that ultimately *Feist* only requires a minute amount of creativity to establish originality warranting copyright protection.

Apparently the Second Circuit did not believe that *Feist* clearly stated that the ultimate inquiry under the originality test is **whether** there was minimal creativity in selection, coordination or arrangement of the material, not the **precise degree** of such creativity or whether that creativity is **pervasive**. Under the Second Circuit’s decision, an author’s subjective personal selection of items from a greater universe (Silverstein’s selection of what he considered to be Dorothy Parker’s poetry from a voluminous universe of writings) may not be entitled to compilation copyright protection because that selection is inherently all-inclusive of the items chosen and therefore not a selection at all – in other words, once Silverstein made his original and creative selections, he made no further original and creative selections. (App. 5a, 9a, 15a) The Second Circuit’s decision conflicts with the decisions of other circuits because, instead of determining whether a compilation involves an original creative process, it evaluates that creativity only after saddling Silverstein with some additional unarticulated standard or measure.¹⁰

¹⁰ The Second Circuit itself tacitly acknowledged that it erred by inappropriately changing the standard for copyright protection despite possessing no authority to do so. In a later decision, the Second Circuit cited its *Silverstein* decision in stating that a protectable compilation merely requires an original selection that displays a “minimal degree of creativity,” and that “selection”

In *Feist*, this Court declined to extend copyright protection to the compiler of a white pages telephone directory and provided guidance on how courts should analyze compilations for purposes of copyright protection. Several Circuits interpreted this Court's guidance that a compilation should be afforded protection so long as it was created independently and unless it falls in the "narrow category of works in which the creative spark is utterly lacking or so trivial as to be virtually nonexistent." 499 U.S. at 358-359. See, e.g., *Mid America Title Company v. Kirk*, 881 F.2d 417, 420 (7th Cir.1993) (holding that "only a modicum of originality in the selection process") (*citation omitted*); *Alcatel USA, Inc. v. DGI Technologies, Inc.*, 166 F.3d 772, 787 (5th Cir.1999) (holding that the "requisite level of creativity is extremely low" and that some creative spark is sufficient, "no matter how crude, humble or obvious") (*citations and quotations omitted*).

implies some judgment in choosing facts from a given body of data." *MyWebGrocer v. Hometown Info., Inc.*, 375 F.3d 190, 193 (2nd Cir. 2004). As if in tacit admission that it had articulated an additional and unwarranted element, the court then added that it had recently held in the instant case that "if the selection process **imbues** a compilation with the requisite creative spark, the compilation may be protected so long as there are indicia that principles of selection (other than all-inclusiveness) have been employed." *Id.* (emphasis added). "Imbue" is defined as "to tinge or dye deeply" or to "permeate." *Webster's Third New International Dictionary* (Springfield, Mass.: G. & C. Merriam, 1961, 1971 ed.) at 1129. The Second Circuit apparently erroneously believes that, even where a "minimal degree of creativity" has been demonstrated, the author must further establish that the selection imbues or permeates the entire work with a "creative spark." This Court's decision in *Feist* imposes no such additional – and onerous – requirement.

The District of Columbia Circuit applied such an interpretation of *Feist*. *Atari Games Corp. v. Oman*, 979 F.2d 242 (D.C. Cir. 1992). The court applied the *Feist* rules to a video game because it found the audiovisual work to be analogous to the compilation of facts discussed in *Feist*. *Id.* at 245. The court held that this Court’s discussion of the creativity standard “left no doubt that the requirement is indeed modest” *Id.* at 244 (*citations omitted*). The court further noted that *Feist* teaches that the “vast majority of works make the [copyright] grade quite easily” and that the protection threshold should not be ratcheted up “beyond the minimal creative spark required by the Copyright Act and the Constitution.” *Id.* at 247 (*citations and quotations omitted*). Applying this standard, the D.C. Circuit held that the video game at issue was entitled to copyright protection. While the game was a fairly simple use of commonplace shapes, the court found that the abstract representation in the game was creative, noting, for example, that the choice of colors and shapes were not an obvious or inevitable choice. *Id.*

The Ninth Circuit also applied this interpretation of *Feist* in a unique case involving a book of alleged revelations from celestial beings. *Urantia Foundation v. Maaherra*, 114 F.3d 955, 959 (9th Cir. 1997). Avoiding the question of who authored the revelations, the court determined the book was a compilation, assuming that the revelations were the equivalent of non-copyrightable facts. Quoting *Feist*, the court held that copyright protection would only be withheld if the book belonged to “that narrow category of works in which the creative spark is utterly lacking or so trivial as to be virtually nonexistent.” *Id.* at 959. The court found that the authors “chose and formulated the specific questions asked . . .” of the celestial beings and held that the selection of the revelations “could not have been so ‘mechanical or

routine as to require no creativity whatsoever.” *Id.* at 959, quoting, *Feist*, 499 U.S. at 362, 111 S. Ct. at 1296.

The Second Circuit’s application of its new standard to the facts of this case illustrates its departure from the precedent of the other circuits. The Petitioner in this case, Silverstein, searched through vast and various materials from libraries around the United States and selected what he personally and subjectively considered to be poetry and verses written by Dorothy Parker. (Silverstein Deposition, at 42-64, 107-108, 143-145.) In some instances, he extracted Parker’s poetry from short passages that he found buried in multi-page book reviews,¹¹ a chatty personal letter,¹² and even a magazine ad intended to promote sales of another poet.¹³ No one previously recognized these items as poems, not even Parker’s bibliographer, Randall Calhoun. And the reverse also occurred: the record indicates conclusively that in several instances Silverstein *refused* to select items explicitly characterized as “poems” by other authorities – not only by Professor Calhoun, but also by the eminent British novelist Somerset Maugham, among others. The record also conclusively indicates that Silverstein refused to select items that Silverstein believed to be wrongly attributed to Mrs. Parker by other sources, although in those instances the

¹¹ “Chris-Cross” and “After Dawn” (*Not Much Fun* (Dannay Declaration, Ex. B), at 174, 181; Originally Published Poems (McCabe Declaration, Ex. 20), at 150, 156.)

¹² “Letter to Robert Benchley” (*Not Much Fun* (Dannay Declaration, Ex. B), at 78; Originally Published Poems (McCabe Declaration, Ex. 20), at 60.)

¹³ “Letter to Ogden Nash” (*Not Much Fun* (Dannay Declaration, Ex. B), at 180; Originally Published Poems (McCabe Declaration, Ex. 20) at 155.)

opinions both pro and con were utterly subjective due to the lack of any objective evidence whatever for either side. By the standard applied by several other Circuits, this selection process clearly entitles Silverstein's compilation to copyright protection.

Just as the D.C. Circuit found in *Atari* that the choice of colors and shapes in a video game was entitled to protection, that Circuit would also have protected Silverstein's selection of writings to be included in his compilation of poetry. Similarly, just as the Ninth Circuit in *Urantia Foundation* found creativity in the authors' selection of questions to ask celestial beings, that Circuit would have extended protection to Silverstein's creativity in the investigation and selection of where and what writings would reveal more of Parker's poetry.

Conflicting with the decisions of several other circuits, the Second Circuit held in this case that Silverstein's selection from a universe of voluminous writings of 122 items that he subjectively determined to be poems written by Dorothy Parker may not qualify for copyright protection as an original compilation. The uncontroverted evidence that was adduced clearly demonstrated far more than a "minimal amount" of creativity required under the *Feist* test for originality. While the other circuits have interpreted *Feist* to only withhold copyright protection from that narrow category of works in which the creative spark is utterly lacking or so trivial as to be virtually nonexistent, the Second Circuit held that a compilation is subject to some undefined but vastly higher standard. This contradicts the precedent of the other circuits, which have interpreted *Feist* to extend copyright protection to a compilation even if there is only a modicum of originality

in the selection process. The Second Circuit¹⁴ thereby split with several other circuits when it interpreted *Feist* to withhold copyright protection from compilations when the reviewing court somehow determines that it was not created with **enough** creativity. Therefore, the Second Circuit's interpretation undermines the basic function of the originality test. This Court should seize the opportunity to clarify that minimal creativity is the detectable indicator of originality and not a separate element subject to the arbitrary measure of reviewing courts.

B. The Second Circuit's Ruling Conflicts With This Court's Decision in *Feist*

The Second Circuit's ruling also apparently and directly conflicts with this Court's decision in *Feist*. In that case, this Court held that "the requisite level of creativity is extremely

¹⁴ Unfortunately, the Eleventh Circuit also appears to have drifted from the *Feist* moorings. See e.g., *Warren Publ'g, Inc. Microdos Data Corp.*, 115 F.3d 1509 (11th Cir. 1997). See *Ethan R. York, Warren Publishing, Inc. v. Microdos Data Corp.: Continuing the Stable Uncertainty of Copyright in Factual Compilations*, 74 Notre Dame L. Rev. 565 (1999). Like the Second Circuit in the instant case, the Eleventh Circuit "focus[ed] attention on semantics of the lower court rather than on the possible copyrightable aspects of Warren's factbook." 74 Notre Dame L. Rev. at 587. "The Act, and *Feist* interpreting it, even with all the loose ends it left, made clear that originality is the basis of copyright protection and should be the emphasis of examining courts." 74 Notre Dame L. Rev. at 587-588. "*Feist* clearly calls for a low standard and does not support the heightened standard the Eleventh Circuit applies to such cases." 74 Notre Dame L. Rev. at 589.

low” and even a “minimal amount”¹⁵ is sufficient to make the compilation copyrightable. *Feist Publ’ns*, 499 U.S. at 348, 111 S. Ct. at 1287, 1289. This Court also held that a compilation is entitled to copyright protection unless it occupies “a narrow category of works in which the creative spark is utterly lacking or so trivial as to be virtually nonexistent.” 499 U.S. at 359, 111 S. Ct. at 1294. Despite demonstrating that Silverstein made a subjective personal selection of items from a greater universe (Silverstein’s selection of what he considered to be Dorothy Parker’s poetry from a universe of a voluminous quantity of uncollected writings), the Second Circuit held that *Not Much Fun* may not be not entitled to compilation copyright protection because that selection may be all inclusive of the items chosen and therefore not a selection at all. (App. 5a, 9a, 15a)

¹⁵ As discussed in passing on page 12, footnote 5 above, “minimal” is defined in its primary and most commonly-accepted sense in the three most authoritative English-language dictionaries as follows: (1) the *Oxford English Dictionary 2nd Ed.* (Oxford, England: Oxford University Press, 1989) definition: “extremely small; very slight, negligible; constituting a bare minimum, only just adequate”; (2) the *Webster’s Third New International Dictionary* (Springfield, Mass.: G. & C. Merriam, 1961, 1971, at 1438) definition: “constituting the least possible in size, number, or degree : extremely minute”; and (3) the *Random House Unabridged 2nd Ed.* (New York: Random House, 1987, at 1225) definition: “the least possible.” In other words, “minimal” defines the least possible amount that is more than absolutely nothing – that is, a single instance – and is *not* a synonym for “small.” As “minimal” is the word the *Feist* court carefully selected and imposed, in its precise and commonly-accepted primary meaning it *does* define the *Feist* standard, and its application here requires only the most rudimentary familiarity with the undisputed facts.

Thus, the Second Circuit's ruling apparently and directly conflicts with this Court's holding in *Feist* by requiring that a far greater level of originality must be shown in order to qualify for copyright protection.

C. If This Court Declines to Review This Case, Immediate Egregious Copyright Infringement May Ensnare

The District Court issued an injunction and then refused the Defendant's request for permission to continue selling its copies of Silverstein's protected compilation while it appealed. Under Second Circuit precedent, to overturn the District Court's issuance of the permanent injunction, Penguin was required to demonstrate that the District Court abused its discretion by relying on clearly erroneous findings of fact or an error of law. *Davis v. N.Y.C. Housing Authority*, 278 F.3d 64, 79 (2d Cir. 2002); *U.S. v. International Brotherhood of Teamsters*, 266 F.3d 45, 49 (2d Cir. 2001); *S.C. Johnson & Son, Inc. v. Clorox Co.*, 241 F.3d 232, 237 (2d Cir. 2001). Nevertheless, after improperly holding that the District Court erred in recognizing Silverstein's copyright, the Second Circuit also reversed the District Court's injunction.

The Second Circuit acknowledged that Penguin's editor "photocopied *Not Much Fun*, cut the poems apart with scissors, and pasted them into the Penguin manuscript chronologically." (App. 7a) The Second Circuit further conceded that Silverstein's selection might have been sufficiently creative to confer copyright protection. (App. 5a, 15a, 18a-19a) Nonetheless, the Second Circuit held that, "[e]ven if Silverstein's creative contribution to the selection of Mrs. Parker's previously uncollected poems is non-trivial, and even if Penguin's appropriation of it was deliberate, enforcement of his rights by a preliminary or permanent

injunction that stops publication of *Complete Poems* is an abuse of discretion.” (App. 18a-19a)

The District Court’s purported erroneous findings of fact or an error of law appeared to be in its clear failure to grasp the essence of Silverstein’s subjective creative selection process. The Second Circuit determined that, because the poems in Silverstein’s book were unpublished, Parker herself selected them when she decided not to publish them. (App. 17a) The court also held that Silverstein did not give any “notice or warning” of his selection process other than “completeness.” (App. 18a) The court then repeated one of the elements of its new standard of copyright protection and stated that “all” is not a selection. *Id.* Without these erroneous findings, the Second Circuit would not have had a basis for finding that the District Court’s injunctive relief was an abuse of discretion.

Silverstein clearly is entitled to injunctive relief which protects him from the effect of Penguin’s knowing and calculated copyright infringement. 17 U.S.C. § 503(b). Section 503(b) of the Copyright Act gives courts authority to “order the destruction or other reasonable disposition of all copies or phonorecords found to have been made or used in violation of the copyright owner’s exclusive rights,” and to compel the infringer to cease selling or further distributing infringing material. *National Football League v. Primetime 24 Joint Venture*, No. 98 Civ. 3778, 1999 U.S. Dist. LEXIS 15261, at *12 (S.D.N.Y. Sept. 27, 1999), *aff’d* 211 F.3d 10 (2d Cir. 2000). This statutory provision authorizing the issuance of a permanent injunction supplies conclusive and comprehensive legal authority for the injunction granted by the District Court. *See Sub-Contractors Register, Inc. v. McGovern’s Contractors & Builders Manual, Inc.*, 69 F.Supp. 507 (S.D.N.Y. 1946) (destruction of all infringing materials, and the means to produce them, were appropriate

remedies against book publisher who infringed Silverstein's copyright and competed unfairly against him).

The District Court's injunction does not preclude Penguin or anyone else from publishing Parker's "complete" poems or complete works. Rather, the District Court's order only protects Silverstein's unique selection, arrangement and coordination in *NMF* and very limited extensions to that selection. The Second Circuit erroneously found that Silverstein's selection represents the mere collection of items that are objectively identifiable as Parker's uncollected poems and that every other scholar embarking upon that task would make the same selection. However, as Silverstein amply demonstrated and the District Court recognized, Silverstein exercised subjective, creative judgment in selecting the poems and verses he collected in *NMF* and made choices from the universe of possible items that were unique and different from those made by other scholars. Silverstein even included as items several short passages that he discovered in multi-page book reviews, a chatty personal letter, and even a magazine ad.

If permitted to stand, the Second Circuit's holding will jeopardize the validity of every compilation copyright and relegate the aggrieved author to the inadequate remedy of mere damages. The Second Circuit's holding erroneously rewards a pirate who steals a copyrighted compilation, even knowingly and deliberately, by permitting him to continue to sell his misappropriated work with impunity. Such a result constitutes a compulsory license with the author being forced to settle for "future damages as a sort of royalty." *National Football League*, 1999 U.S. Dist. LEXIS 15261, at *12. *Accord Paramount Pictures Corp. v. Carol Publ'g Group*, 11 F. Supp. 2d 329, 338 (S.D.N.Y. 1998).

D. The Importance of Reviewing the Issue in this Case

As even the Second Circuit recognized, Penguin actually cut the poems right out of Silverstein's book and pasted them into its own. The District Court held Penguin accountable for its wholesale appropriation of Silverstein's original work, but the Second Circuit reversed, applying a new and utterly unsupported and unsupportable standard for copyright protection. The Second Circuit's new standard dramatically weakens the copyright protection available to compilations of poetry and other material, as it invites competing publishers to simply appropriate original selections of poetry and other material by cutting and pasting the author's original work and republishing it with impunity. The Court should mend the split in authority caused by the Second Circuit decision because (1) it should preserve incentives for compiling literary and other materials; (2) it should clarify and reinforce the function of the originality test articulated in *Feist*; and (3) this case and area of law are in a good posture for this Court's review.

1. It is Important to Preserve the Protections and Incentives for Authors like Silverstein to Compile Otherwise Unpublished Works

Section 101 of the Copyright Act of 1976 recognizes that original compilations of preexisting materials or data have a unique value that should be recognized and protected as "an original work of authorship." 17 U.S.C. § 101. A compiler of missing works like Silverstein therefore is very important to our society, as he possesses the creative skill to mine what he believed to be poetry from the previously unpublished miscellaneous materials left behind by a great American poet. Silverstein asks not to be compensated for his labor, but for the benefits of his creative contribution, which is his alone and should be recognized and protected as such. Without

such a protection and incentive, scholars like Silverstein almost certainly will be unwilling to undertake to employ their creative talents to make valuable contributions to society like a compilation of poetry.

2. This Case and Area of Law Are Appropriate for This Court's Review

First, the legal issues of this case have been fully aired with the benefit of two published decisions on issues that have been heavily litigated for the past 13 years since *Feist*. Second, further rulings on these issues are not likely to resolve the split of authority, as the new standard applied by the Second Circuit is different in a fundamental way and cannot be reconciled with the precedent of the other circuits. Third, Congress cannot be counted upon to resolve this conflict, as the originality requirement is ultimately rooted in this Court's interpretation of the Copyright Act. Fourth, the central issue to be reviewed is whether the Second Circuit's establishment of a new rule of law was proper, making this case a good vehicle for resolving the conflicting standards.

E. The Second Circuit Erroneously Required Silverstein to Provide Notice of the Elements of His Copyright to a Pirate of His Work

The Second Circuit further held that, despite the prominent display of his copyright notice on *Not Much Fun*, and his compilation copyright registered at the U.S. Copyright Office, Silverstein was required to provide "notice or warning" that his compilation constituted "a selection by him from some larger body of poems, or a creative designation of a work as poetry that might otherwise be deemed something else." (App. 17a-18a) However, the Copyright Act does not require that a copyright holder describe the decisions he made to prepare his manuscript at the risk of losing his copyright protection. In fact, there no longer is any copyright notice

requirement as a condition to copyright protection. 2 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 7.02[C][3] at 7-19, § 7.03 at 7-23 n.1 (1987). The display of a copyright notice without more protects the **selection** and arrangement of a compilation despite any “false impression” the public might get from the absence of further information. NIMMER § 7.12[C][1] at 7-97, § 7.12 at 7-98. Nor, as a matter of standard practice, is such explication even expected, let alone required, either by the publisher or the mass market in a trade publication.

F. The Second Circuit Erroneously Held That Silverstein is Estopped From Asserting Infringement of His Editing Changes

Silverstein asserted that Penguin also infringed his copyright in *NMF* by copying 600 edits that he made to the text and titles he created for untitled items. (App. 14a) In *Feist*, the Supreme Court held that even a “minimal amount” of creativity confers compilation copyright protection. *Feist*, 499 U.S. at 345, 348. Nevertheless, the Second Circuit held that, “even assuming these changes were protectable, Silverstein is estopped from asserting infringement on this basis” because *NMF* “impl[ied] that the works appear as originally published by Mrs. Parker” and did not explicitly state that such changes to the text had been made. (App. 14a)

The Second Circuit cited *Arica Institute, Inc. v. Palmer*, 970 F.2d 1067 (2d Cir. 1992), in support of that holding, where the court barred an assertion of originality of certain theories where the author had affirmatively “represented” that they were factual. *Id.* at 1075. However, *Arica* requires representation; nowhere does *NMF* represent or even imply that the poems were reproduced without alteration from the original text – and the Second Circuit supplies no such examples from *NMF* – because none appear there. Nor did

the Second Circuit assert that Silverstein made any “representation” or that Penguin relied upon the purported implication.

Further, an author who displays a copyright notice on his work is not required to notify potential pirates of the precise elements of his copyright claim. NIMMER § 7.02[C][3] at 7-19, § 7.03 at 7-23 n.1, § 7.12[C][1] at 7-97, § 7.12 at 7-98. No publishing industry standard, custom or practice requires, or even expects, an author to include such a “Note.” Nor did the Second Circuit cite any such authority. The Second Circuit’s holding jeopardizes the validity of the copyrights held by the authors of thousands of compilations – and, given the Opinion’s expansive language – all copyrighted works which do not contain an explanatory “Note.” This likely will cause calamitous consequences in the media and publishing industries.

CONCLUSION

For the reasons stated, a writ of certiorari should issue to review the opinion of the Second Circuit.

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