

Copyright for Indexes, Revisited

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It has been two years since I have devoted more than fleeting attention in the *ASI Newsletter* to the matter of copyright and indexes. Some new ASI members have asked for a recap of what has appeared in these pages previously. What I will try to do here is provide an overview of the issue and then add some remarks about recent court cases. For those with access to previous issues of the *ASI Newsletter*, I have discussed copyright in the following issues; #92, May/June 1989, pp. 1, 7-9; #93, July/Aug 1989, pp. 4-6; and #95, Nov/Dec 1989, pp. 6-8.

One way to approach this topic is to look at situations when the indexer would not own copyright. This discussion is limited to two situations: works made for hire and failure to meet the originality requirement.

Works Made for Hire

In the case of a work made for hire, the employer or commissioning agent owns the copyright (see § 201 (b), unless otherwise noted, all references are to the Copyright Act of 1976). A work for hire is either created by an employee as part of his or her employment or is a specially ordered or commissioned work (see § 101).

In June 1989 the U.S. Supreme Court held that the determination of whether an author is an employee will be based solely upon the traditional common law agency requirement that the employer must have the right to control the manner and means by which the work is accomplished (see *Community for Creative Non-Violence v. Reid*, USSC No. 88-293, hereafter *CCNV v. Reid*). Justice Marshall delivered the opinion for a unanimous Court and wrote the following:

In determining whether a hired party is an employee under the general common law of agency, we consider the hiring party's right to control the manner and means by which the product is accomplished. Among the other factors relevant to this inquiry are the skill required; the source of the instrumentalities and tools; the location of the work; the duration of the relationship between the parties; whether the hiring party has the right to assign additional projects to the hired party; the extent of the hired party's discretion over when and how long to work; the method of payment; the hired party's role in hiring and paying assistants; whether the work is part of the regular business of the hiring party; whether the hiring party is in business; the provision of employee benefits; and the tax treatment of the hired party.

Examining the circumstances of this case in light of these factors, we agree with the Court of Appeals that Reid was not an employee of CCNV but an independent contractor. True, CCNV members directed enough of Reid's work to ensure that he produced a sculpture that met their specifications. But the extent of control the hiring party exercises over the details of the product is not dispositive. Indeed, all the other circumstances weigh heavily against finding an employment relationship. Reid is a sculptor, a skilled occupation. Reid supplied his own tools. He worked in his own studio in Baltimore, making daily supervision of his activities from Washington practicably impossible. Reid was retained for less than two months, a relatively short period of time. During and after this time, CCNV had no right to assign additional projects to Reid. Apart from the deadline for completing the sculpture, Reid had absolute freedom to decide when and how long to work. CCNV paid Reid \$15,000, a sum dependent on "completion of a specific job, a method by which independent contractors are often compensated...." Finally, CCNV did not pay payroll or social security taxes, provide any employee benefits, or contribute to unemployment insurance or workers' compensation funds. (*CCNV v. Reid*, supra).

The reasoning used in the citation above can be easily applied to the typical relationship between a freelance book indexer and a publisher. There is no employer-employee relationship. So, this aspect of the work for hire definition is not applicable to indexes written by indexers who are independent contractors.

The next portion of the work for hire definition may apply to indexes written by freelancers. Part (2) of the definition is lengthy. However, [Arthur Miller and Michael Davis](#) provide a succinct description of Part (2) in their book *Intellectual Property*:

The second circumstance under which a work can become one for hire requires the conjunction of three essential elements: the work must be "specially ordered or commissioned," it must be described by one of the nine categories of section 101(2), and the parties must agree in writing that the work is one for hire (Miller and Davis:385).

Note that all three elements above must be present in order for an index to be considered a work for hire. Indexes are commonly "specially ordered or commissioned." For example, if an editor calls an indexer and asks if the indexer can write an index for a specific book, we can consider this specially commissioned work.

Of the nine categories listed in § 101(2), two categories are of interest to indexers: compilations and supplementary works. Indexes are even mentioned by name as an example of a supplementary work.

The last element noted by Miller and Davis, that the parties must agree in writing that the work is one for hire, is the element most often lacking in the relationship between an indexer and a client. The Copyright Act is very specific about this requirement. Yet, I am certain that now, as in 1989, most freelance indexers work without a written contract. Lacking a written agreement that specifically states that both parties, indexer and commissioning agent (i.e., the publisher), agree that the index is a work for hire, the index cannot be considered a work for hire. If the index satisfies other requirements for copyright, then the indexer owns the copyright.

Other Requirements

What works are entitled to copyright protection? The Copyright Act states that "Copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device" (§ 102(a)).

The concept of "original works of authorship" is central to the matter of copyright. Earlier this year, the U.S. Supreme Court held that the white pages of a telephone book published by Rural Telephone did not meet the constitutional or statutory requirements for copyright protection. Justice O'Connor delivered the opinion of the unanimous Court and wrote about the originality requirement in this way (internal citations not included):

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 low; even a slight amount will suffice. The vast majority of works make the grade quite easily, as they possess some creative spark, "no matter how crude, humble or obvious" it might be (*Feist Publications, Inc. v. Rural Telephone Service Co., Inc.*, USSC No. 89-1909, Slip Opinion, p.4).

It is worth our time to examine this Supreme Court case in more detail since several issues emerge that are applicable to indexes. This case involves a directory publisher (Feist) and a local telephone company (Rural Telephone). Feist publishes area-wide phone directories that encompass an area larger than that served by

any one local phone company. Feist asked Rural Telephone for permission to license Rural's white page listings for a directory that would cover 11 different service areas. Rural refused to grant permission. So, Feist extracted the listings from Rural's white page directory without permission. Rural brought a copyright infringement suit against Feist. Lower courts ruled in favor of Rural and held that telephone directories are copyrightable. The Supreme Court, however, held that Rural's white pages are not entitled to copyright, and that Feist's use of them did not constitute infringement.

The white page phone directory can be described as a factual compilation. A compilation is defined as "a work formed by the collection and assembly 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" (§ 101). The U.S. Copyright Office considers an index that is not a work for hire a compilation (as per [ASI meeting with Harriet Oler](#), Chief of the Examining Department, U.S. Copyright Office). As for facts, facts themselves are not entitled to copyright. "This is because facts do not owe their origin to an act of authorship" (*Feist v. Rural*, p.6).

"Factual compilations, on the other hand, may possess the requisite originality. The compilation author typically chooses which facts to include, in what order to place them, and how to arrange the collected data so that they may be used effectively by readers. These choices as to selection and arrangement, so long as they are made independently by the compiler and entail a minimal degree of creativity, are sufficiently original that Congress may protect such compilations through copyright laws" (*Feist v. Rural*, p.7).

Note that the Court stresses the need for selection and arrangement by the compilation author. (Is this not one of the more demanding tasks of the indexer?) O'Connor brings this matter up again when she writes, "Facts are never original, so the compilation author can claim originality, if at all, only in the way the facts are presented. To that end, the statute dictates that the principal focus should be on whether the selection, coordination, and arrangement are sufficiently original to merit protection" (*Feist v. Rural*, p.17).

In this Supreme Court case, "facts" are the names, addresses, and phone numbers in Rural's white page directory. These facts are not copyrightable. These names are not original to Rural Telephone; the names existed before they appeared in Rural's white pages and they would have continued to exist if the white page directory had never been published. The issue that remains is whether Rural Telephone selected, coordinated, or arranged these facts in an original manner. The Court addresses the issue very clearly:

As mentioned, originality is not a stringent standard; it does not require that facts be presented in an innovative or surprising way. It is equally true, however, that the selection and arrangement of facts cannot be so mechanical or routine as to require no creativity whatsoever. The standard of originality is low, but it does exist (*Feist v. Rural*, p.21).

Nor can Rural claim originality in its coordination and arrangement of facts. The white pages do nothing more than list Rural's subscribers in alphabetical order. This arrangement may, technically speaking, owe its origin to Rural; no one disputes that Rural undertook the task of alphabetizing the names itself. But there is nothing remotely creative about arranging names alphabetically in a white pages directory. It is an age-old practice, firmly rooted in tradition and so commonplace that it has come to be expected as a matter of course.... It is not only unoriginal, it is practically inevitable. This time-honored tradition does not possess the minimal creative spark required by the Copyright Act and the Constitution (*Feist v. Rural*, p.22).

Hot on the heels of the *Feist v. Rural* decision, *The Wall Street Journal* (Sept. 24, 1991, B1) reported that "a federal appeals court ruled that listings from yellow-page phone directories can be copied by competitors as long as changes are made in the way the material is organized.... The federal appeals court in Manhattan ruled that no copyright infringement occurs when the competitor lifts some of the information but, for example, puts the telephone numbers under different headings.... Michael Epstein, an attorney in intellectual property law at Weil, Gotshal & Manges in New York, said that the decision could give publishers 'free rein to use the facts that are located in a compilation...if the arrangement or selection is different.'"

Pulling It Together

I have quoted extensively from the *Feist v. Rural* decision because the Court so clearly discusses the importance of selection, arrangement, originality, creativity, and authorship in regard to copyright. The federal appeals court ruling in the "yellow pages dispute" also relies heavily on the notion of arrangement. It is my opinion that authored subject indexes satisfy the requirements for selection, arrangement, originality, creativity and authorship regarding copyright. An authored subject index is not simply an alphabetical list of uncopyrightable preexisting material (facts). Instead, such an index results from analysis and synthesis of text, selection of entries based upon the indexer's judgment, and arrangement of entries in a consistent and sensible order.

Lacking case law in the matter of indexes and copyright, we remain in the realm of opinion without the backing of a court interpretation. And, opinion about this matter is diverse. For example, Dr. Hans Wellisch in his book, *Indexing from A to Z* (1991, p. 61) writes:

"Authors presumptively own all rights in works made for hire, absent an express written agreement signed by them stating otherwise" (Angel & Tannenbaum 1977, p, 59). This means that an indexer who wishes to obtain the copyright in an index that he or she compiled must include an explicit statement in the contract stipulating that the author or publisher waives copyright in the index.

I respectfully disagree with Wellisch and agree with Angel & Tannenbaum who say that lacking a written agreement stating otherwise, authors own all rights in works made for hire. As was pointed out earlier by Miller and Davis, three essential elements must exist in order for a work to be considered a work for hire-- one of these elements is a written agreement signed by both parties stating that the work shall be considered a work made for hire. In my opinion, the indexer as the author of the index, is the party in a position to waive copyright to the index through a written work for hire agreement or other instrument. The book author or publisher is in no position to waive copyright since neither is the originator of the authored work. However, these parties are in a position to obtain copyright for an index, but the index author must first waive or assign his or her copyright. Since a work made for hire involves the assignment of copyright to a party who did not originate the material, the Copyright Law correctly insists that originator (author) of the work "expressly agree in a written instrument" that the work be considered a work made for hire. It is the originator of the work who is waiving copyright and such a waiver must be done in an express manner.

I have submitted indexes to the Copyright Office and they have been accepted by the Copyright Office for registration. It is important to note that copyright registration does not necessarily mean that the indexes are copyrightable by the author. Miller and Davis make a similar point when they write about the copyrightability of computer programs, "Mere registration did not make them copyrightable, of course, but did reflect the view of many respected persons both within and without the Copyright Office that programs have sufficient originality and authorship to be copyrightable..." (1990, p. 307). Again, the lack of case law in this matter causes me to stress that the views expressed here are only my opinions, they lack the weight of court decisions. If two reasonable and reflective individuals such as myself and Dr. Wellisch can read the same material and arrive at different interpretations, imagine what will happen when this issue is handled by the courts! However, I do submit that authored subject indexes that are not works for hire have sufficient originality and authorship to be copyrightable.

References

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