

UNITED STATES DISTRICT COURT  
SOUTHERN DISTRICT OF NEW YORK

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HYPERLAW, INC., :  
Intervenor-Plaintiff, : JURY TRIAL  
- against - : DEMANDED  
WEST PUBLISHING COMPANY, : INTERVENOR  
Defendant. : COMPLAINT  
-----x  
-----x  
MATTHEW BENDER & COMPANY, INC., :  
Plaintiff, :  
- against - :  
WEST PUBLISHING COMPANY, : CIV. NO. 94-0589  
Defendant. :

-----x  
Intervenor-Plaintiff, HyperLaw, Inc., for its  
Complaint against West Publishing Company, alleges as follows:

**JURISDICTION AND VENUE**

1. This Court has subject matter jurisdiction pursuant to 26 U.S.C. §§ 1331 and 1338(a). This action arises under Article I, § 8, cl. 8, of the U.S. Constitution (the "Copyright Clause"), the Copyright Act, 17 U.S.C. § 101 et seq. (the Copyright Clause and the Copyright Act hereinafter "the Copyright Laws") and the Lanham Act, 15 U.S.C. § 1051 et seq., and seeks relief pursuant to 28 U.S.C. § 2201.

2. Intervenor-Plaintiff HyperLaw, Inc., ("Hyperlaw") is a privately held corporation duly organized and existing under the laws of the State of Delaware, is qualified to do business in the State of New York, and has as its principal and sole place of business the County, City, and State of New York, within this District.

3. Defendant West Publishing Company ("West") is a privately held corporation duly organized and existing under the laws of the State of Minnesota, with its principal place of business in Eagan, County of Dakota, Minnesota. West maintains offices in the County, City, and State of New York, within this District, where it conducts substantial business.

4. Venue is proper in the Southern District of New York pursuant to 28 U.S.C. §§ 1391(b) and 1400(a).

#### NATURE OF THIS OF ACTION

5. HyperLaw seeks declaratory and related relief as against the defendant West to determine that defendant West does not hold copyrights to citations, page numbering, corrections, parallel citations, names of counsel, and other factual and identifying material contained in two specific West publications, *Supreme Court Reporter*® and *Federal Reporter*®, and that HyperLaw's planned use of that information neither infringes any valid copyright of West, nor constitutes unfair competition.

6. This action concerns acts by defendant West to privatize and misappropriate the text of laws of the United States by asserting copyrights in citations to judicial

opinions, and by asserting claims of copyright over factual material and material created by the federal government. Defendant has attempted to copyright the body of the law itself—perverting the purposes of the Copyright Clause of the Constitution and the Copyright Act by stifling creativity and erecting a barrier between the citizenry and their law.

7. The Copyright Act does not make copyright available for a work of the United States Government. The Constitution authorizes copyrights only to "secure for limited Times to Authors the exclusive Right to their respective Writings." Copyright presupposes originality by the originator, the author of the work. As to the federal case law, the originator(s) are the federal courts.

8. Citation of judicial opinions is the password to accessing the law. In the legal system of the United States, the opinions of the federal courts are the law, ignorance of which may result in civil and criminal liability or penalty.

9. West has erected restrictions and encumbrances upon such access to federal judicial opinions, privatizing the law, and interfering with the due process rights of the citizenry, inconsistent with the Copyright Act and the Constitution of the United States, including the Copyright Clause, the First Amendment, the Sixth Amendment, the Seventh Amendment, and the Fourteenth Amendment; as the law, and citation thereto, is entitled to substantially less protection under the Copyright Clause and the Copyright Act than are names and addresses in telephone books.

10. HyperLaw publishes CD-ROM ("Compact Disc Read-Only-Memory") discs containing computer readable versions of recent

opinions of the United States Supreme Court and the United States Courts of Appeals. HyperLaw desires to incorporate and use information to which defendant West has wrongfully claimed copyright, in HyperLaw's CD-ROMs.

11. HyperLaw has communicated with defendant West to determine whether such uses by HyperLaw would infringe on West's copyrights--and to clarify West's vague, broad assertions regarding copyright. In response, West warned HyperLaw that if HyperLaw included information as to which West made such claims without a license from West, there would be legal consequences and, further, specifically and wrongfully asserted that HyperLaw would thereby be engaged in unfair competition against West.

12. HyperLaw contends that it has an unqualified right to copy information for which protection under the Copyright Laws is not available to West.

#### BACKGROUND

13. HyperLaw is a publisher of CD-ROMs, and was incorporated in 1991.

14. In January, 1992, HyperLaw began publishing *Supreme Court on Disc*<sup>TM</sup>, an annual CD-ROM containing recent opinions of the United States Supreme Court, the first CD-ROM publication of this nature. (A copy of the latest release of this CD-ROM is attached hereto as Exhibit 2.)

15. In July 1993, HyperLaw began publishing *Federal Appeals on Disc*<sup>TM</sup>, a quarterly CD-ROM of substantially all recent opinions of all of the United States Courts of Appeals,

excepting the Federal Circuit (which is being included in HyperLaw's March, 1994 release).

16. *Federal Appeals on Disc* was the first CD-ROM case reporter of all or substantially all of the opinions of the U.S. Courts of Appeals for a given year. The CD-ROM contains approximately 10,000 opinions from 1993; equivalent to 200,000 pages of typed text. A copy of the latest release of that CD-ROM is attached as Exhibit 1.

17. HyperLaw offers its CD-ROMs for sale to lawyers, and to the general public; including, but not limited to, libraries, students, and public interest groups.

18. HyperLaw obtains the text of substantially all "published" opinions and, for some courts, also unpublished opinions, directly from the federal appellate courts.

19. HyperLaw formats each opinion; prepares an initial section or "header" of bibliographic information; inserts codes and tags ("hyper-links") utilized by a computer program to permit automatic cross-references; organizes the cases by date; and generates a full-text searchable computer file for inclusion on a CD-ROM.

20. Defendant West is a legal publisher. For approximately 100 years, West has been engaged in publishing opinions of federal courts.

21. West's practice has been to create "case reports" from federal appellate judicial opinions by preparing editorial notes and other editorial materials which it integrates with the opinions.

22. West publishes and sells its federal circuit court and United States Supreme Court case reports in various ways, including, but not limited to, two series of volumes referred to as "reporters"—West's *Supreme Court Reporter* and *Federal Reporter*.

23. HyperLaw makes no use of materials from West's *Supreme Court Reporter* or *Federal Reporter* publications, except to prepare a separate table which provides a cross-reference to the initial page and volume citation to the West's *Federal Reporter*. In the course of preparing this table, opinions which were missing or amended are identified by HyperLaw.

24. HyperLaw has sought, and presently seeks to copy information not subject to copyright from the West publications: the text of those opinions not provided to HyperLaw by the courts, corrections, amendments, names of counsel, parallel citations, West citation, and the interior pagination from volumes of West's *Supreme Court Reporter* and the *Federal Reporter*.

25. Defendant West does not hold valid copyrights for the material HyperLaw has sought and presently seeks to copy.

26. The non-copyrighted information from the West publications will be incorporated into the text of opinions as now appear in HyperLaw's present CD-ROMs.

27. In a recent copyright infringement action against a Georgia publisher of CD-ROMs containing judicial opinions, West stated that:

each West Reporter contains the following editorial enhancements which West contends

was created entirely by West: (a) West citation for the case; (b) case synopsis, including summary of the facts, the court's holding and the procedural history of the case; (c) numbered headnote(s) summarizing portions of the opinion relating to specific points of law, including the editorial designation of the statutes that relate to each headnote; (d) topic designation for each headnote; (e) topic designations for each headnote with individual "Key Number System" registered trademark symbols (keys) and numeric designations; (f) miscellaneous information prepared by West inserted within the text of the judicial opinion including parallel citations, corrections and cross-reference numbers relating back to corresponding headnote numbers; and a West trademark at the end of each case report. (Emphasis added).

See Exhibit 3, Par. 10, Complaint, *West Publishing v. Gross et al*, No. 1-93-CV-2071 (N.D. Ga., filed September 10, 1993).

28. For the purposes of this action only, the term "West Editorial Additions" shall mean only the following:

(i) case synopsis, including West's summary of the facts and the court's holding; (ii) numbered headnote(s) summarizing portions of the opinion relating to specific points of law, including the editorial designation of the statutes that relate to each headnote; (iii) topic designation for each headnote; (iv) topic designations for each headnote with individual "Key Number System" registered trademark symbols (keys) and numeric designations; (v) cross-reference numbers relating back to corresponding headnote numbers; and (vi) a West trademark at the end of each case report.

The term "Full Text Case Reports" shall mean the text of opinions of the federal appellate courts, and shall not include these West Editorial Additions.

29. West stated in the copyright infringement action referred to in paragraph 27 above, that "[e]ach volume of West's ... publications includes a copyright notice and contains material wholly original to West including, without limitation, the editorial enhancements to each case report as specified [above], and the selection, coordination and arrangement of cases reported therein, including the numbering of pages of volumes which reflect that arrangement." See Exhibit 3, Paragraph 16.

30. Illustrative of West's attempt to broadly assert copyright to non-original, factual, and "sweat of the brow" material is the West advertisement "The difference between raw text and a West Full-Text Plus tm opinion is black and white...", appearing in the National Law Journal, July 27, 1992, Pages 6-7. See Exhibit 7.

#### **MISCELLANEOUS INFORMATION**

31. Parallel citations and names of counsel ("miscellaneous information" for which West also claims copyright) are merged into the text of the cases in such a way that it is not reasonably possible to distinguish between such additions by West, and the works of the government. These additions are also factual, and do not evidence originality or creativity.

32. Citations and page numbering ("miscellaneous information" for which West claims copyright) are factual or

identifying material not subject to copyright, and, to the extent they may have otherwise been subject to copyright, such claims are based upon compilation not subject to copyright, as described below.

#### CORRECTIONS

33. West also claims that corrections to opinions in West's *Supreme Court Reporter* and *Federal Reporter* are further "miscellaneous information" for which West claims copyright.

34. Upon information and belief, after the release of an initial federal opinion, corrections (including typographical corrections, substantive amendments, and modifications) may be made to opinions by (or with the approval of) the federal appellate courts.

35. Depending on the Circuit and the nature of the correction to the opinions, and unless the court or clerk of the court issues a formal order or notice, these corrections are not always docketed and filed in the files maintained by the clerk of the court.

36. Employees of the federal judiciary advise West of corrections to slip opinions or advance sheets, or West may advise employees of the judiciary of suggested corrections. Employees of the federal judiciary may approve or disapprove of the changes.

37. Employees of the federal judiciary provide corrections to West and approve or disapprove of corrections made by or provided to West as part of their official duties.

38. Some circuits provide corrections to defendant West on a preferential basis, not similarly available to HyperLaw.

39. The Reporter of the Supreme Court of the United States provides West with "marked-up" copies of slip opinions indicating corrections made in the Preliminary Print, and West then makes those corrections in the *Supreme Court Reporter*.

40. In preparing volumes of the *Federal Reporter* and *Supreme Court Reporter*, West engages in no significant corrections or additions to the texts of the opinions other than those made by or approved by judges, clerks or other employees of the judiciary.

41. In the copyright notice in West's *Supreme Court Reporter* and *Federal Reporter*, West makes the assertion of copyright by claiming copyright on the entire contents with the following "exception":

Copyright is not claimed as to any part of the original work prepared by a United States Government officer or employee as part of that person's official duties.

42. Corrections to cases, which West defines as "miscellaneous information" and for which West claims copyright, are works of the government for which copyright cannot be claimed.

43. Corrections to cases consists of factual information for which copyright cannot be claimed.

44. Corrections to cases are not original works within the meaning of the Copyright Laws, and thus copyright cannot be claimed.

45. Corrections to federal judicial opinions may not be copyrighted under the Copyright Clause.

**SELECTION, ORGANIZATION, AND ARRANGEMENT**

46. The *Federal Reporters* contain the opinions designated as "published" by the United States Courts of Appeals for the First, Second, Third, Fourth, Fifth, Sixth, Seventh, Eighth, Ninth, Tenth, Eleventh, District of Columbia and Federal Circuits.

47. HyperLaw's *Federal Appeals on Disc* CD-ROM contains all or substantially all of the Full Text Case Reports that appear in recent volumes of the *Federal Reporter*.

48. HyperLaw's *Federal Appeals on Disc* CD-ROM also contains certain unpublished opinions not published in full-text form in the *Federal Reporter*.

49. HyperLaw's *Federal Appeals on Disc* CD-ROM, attached as Exhibit 1, contains substantially all of the Full Text Case Reports that appear in Volume 1 of the Third Series of West's *Federal Reporter* (1 F.3d).

50. Not included on HyperLaw's CD-ROM, but reproduced in West's 1 F.3d, are one Full Text Case Report from the Fifth Circuit, two from the Ninth Circuit, six from the Tenth Circuit, and one from the Eleventh Circuit.

51. The selection of what is a "published" United States Court of Appeals opinion is made initially by each of the respective courts.

52. In preparing volumes of the *Federal Reporter*, West engages in no, or substantially no, original "selection."

53. After initial release by a court, an unpublished opinion may later be "published" because it is appealed to the Supreme Court or because of a determination by the respective court.

54. In preparing volumes of the *Federal Reporter*, West engages in no, or substantially no, original "selection."

55. In publishing volumes of the *Federal Reporter*, West initially publishes the opinions in paperbound advance volumes. Within a paperbound volume, West generally, but not always, organizes the opinions by Circuit, and, within each Circuit, by date.

56. Case reports in West's *Federal Reporter* do not appear in a date order within or across volumes, as earlier cases may appear after later cases.

57. When preparing a bound permanent volume of *Federal Reporter*, West combines several paperbound volumes.

58. In the permanent volume of *Federal Reporter*, opinions from a particular Circuit are not found consecutively and appear in several separated locations.

59. Within *Federal Reporter*, opinions are not arranged with the creativity or originality required under the Copyright Laws.

60. Accordingly, there is no "arrangement" or "coordination" of the opinions in the final bound volumes of *Federal Reporter* sufficient to support a claim of copyright.

61. Upon information and belief, in preparing volumes of the *Supreme Court Reporter*, defendant West obtains opinions directly or electronically from the Court or engages in the wholesale scanning or keying-in of all of the Court's slip opinions, Preliminary Print of the United States Reports, and the United States Reports.

62. Opinions in the *Supreme Court Reporter* are ordered substantially as they will appear in the public domain United States Reports: by date, seniority of the Justice announcing the opinion, and as otherwise indicated by employees of the Court to West. In so publishing the *Supreme Court Reporter*, West engages in no "arrangement" or "coordination."

63. West publishes all orders and opinions that the Supreme Court makes public.

64. In publishing *Supreme Court Reporter*, therefore, West engages in no substantial or original "selection" of the cases and orders that appear therein.

65. In publishing *Supreme Court Reporter*, West does not engage in "arrangement" or "coordination" of the cases and orders that appear therein in a manner sufficient to support a claim of copyright.

66. The page number which happens to be placed on the first page of an opinion along with the volume number of West's *Federal Reporter* or *Supreme Court Reporter* in which a given opinion appears (referred to hereinafter as a "Case Citation") are not subject to copyright pursuant to the Copyright Laws.

67. The page numbers placed on the pages subsequent to the first page of each opinion within West's *Federal Reporter* and *Supreme Court Reporter* (referred to hereafter as "pin-point citations") are not subject to a claim of copyright pursuant to the Copyright Laws.

68. West has no interest in the selection, coordination, and arrangement of the cases reprinted in, Case Citation, or citation to the page numbers therein, of the *Federal Reporter*, subject to copyright.

#### WEST'S USE OF GOVERNMENT PROPERTY

69. For certain Circuits, including the Fifth and Eleventh Circuits, West has entered into contracts with, and is thus paid by the judiciary, to print slip opinions.

70. Upon information and belief, in printing *Federal Reporter*, Defendant West directly uses the electronic typesetting computer files prepared under these slip opinion printing contracts. See Exhibits 20, 21 and 22, correspondence of May and June 1993 between Alan D. Sugarman, HyperLaw, Inc. and Dwight D. Opperman, President, West Publishing Co.

71. Except for corrections provided by the Fifth and Eleventh Circuits to West, and not to other publishers, the text of opinions appearing in the *Federal Reporter* for the Fifth and Eleventh Circuit is identical to the text printed by West when it prints the slip opinions. See, Exhibits 21, 22 and 23.

72. Upon information and belief, those slip opinion printing contracts between West and the Administrative Office

of the United States contain a provision substantially as follows:

All furnished workproduct, materials, and all other items made or furnished by the Contractor as required, and paid for by the Government, shall remain or become the property of the United States, and shall not be submitted, loaned, leased, displayed or sold to any other party by the Contractor. (Emphasis added.)

See Exhibit 23, letter dated March 17, 1993 from the Administrative Office of United States Court to Alan D. Sugarman, HyperLaw, Inc.

73. Upon information and belief, West purchases from other slip opinion printers their databases created pursuant to similar agreements with the Administrative Office of the United States Courts, and uses those databases to create the *Federal Reporter*.

74. West has no valid copyright claim to these works of the United States Government.

#### CORRESPONDENCE BETWEEN WEST AND HYPERLAW

75. Since July 1, 1991, HyperLaw has repeatedly attempted to obtain, from West, a description and clarification of what is claimed (or not claimed) under these asserted West copyrights. See Exhibits 8 through 21.

76. HyperLaw sought, among other things, clarification of the extent West copyright claims with regard to HyperLaw's intended publications, including, among other things, use of

Case Citations, Pin-Point Citations, corrections, names of counsel, and parallel citations.

77. In response to requests by HyperLaw, West has repeatedly refused to clarify or otherwise specify the extent of its copyright claims, insisted, instead, that HyperLaw obtain a license from West, and on August 1, 1991 warned HyperLaw that "[i]f you proceed in any other way, you do so at your own risk." See Exhibit 9 attached hereto.

78. On August 21, 1991 West reiterated its August 1, 1991 warning: "Finally, I believe that the last sentence of my previous letter was -- and remains -- clear." See Exhibit 11.

79. In May of 1992, HyperLaw continued to request clarification from West, and requested that West permit HyperLaw to include only the Case Citation, that first page and volume citation, to the *Supreme Court Reporter* in HyperLaw's *Supreme Court on Disc* CD-ROM.

80. In a letter to West dated May 21, 1992 (Exhibit 14) HyperLaw sought to clarify the copyright claims from West's present President's sworn testimony to the Subcommittee on Intellectual Property and Judicial Administration of the House Committee on the Judiciary on May 14, 1992 that "[n]either does West claim that its citations--such as '681 F.Supp. 1228'-- are *in and of themselves copyrightable.*" West responded only that "'in and of itself' has its normal English meaning." See Exhibit 15, Letter from West to HyperLaw dated May 28, 1992. But see Exhibit 24, Statement of Ralph Oman, Register of Copyrights.

81. HyperLaw learned of a prior copyright infringement action brought by West against a publisher of case law CD-ROMs in Nebraska. *West Publishing v. ROM Publishers, Inc.*, No. 4-88-803 (D.Minn. filed September 16, 1988) Upon information and belief, as a result of that action, that publisher is now defunct.

82. Immediately after commencing the referenced action in the Northern District of Georgia, West issued a press release announcing the action and warning others of West's plans to utilize litigation to assert such copyrights. This warning resulted in an apprehension that any activity such as was described in that complaint would result in similar legal action by West. (See Exhibit 4, West Publishing Company, Press Release dated September 10, 1993.) Press inquiries were directed by the Press Release to attorney Joseph Musilek, of Opperman, Heins & Paquin.

83. Upon information and belief, Joseph Musilek of Opperman, Heins & Paquin then spoke, on the record, with a reporter for the National Law Journal, which resulted in an article entitled "West Moves to Protect Opinions" in the December 27, 1993, edition of the National Law Journal. The article announced other West litigation which created additional, similar apprehension. See Exhibit 5.

84. HyperLaw's *Federal Appeals on Disc and Supreme Court on Disc* are published without the pagination, citation, correction, and other non-original factual materials contained in the West Reporters.

85. West's copyright claims and warnings to HyperLaw, its, public warnings, public statements, willingness to engage

in litigation, and ability to engage in such litigation have created an apprehension by HyperLaw that it will be sued by West for publishing public, non-copyrightable information from West's *Federal Reporter* and *Supreme Court Reporter*, which is thus impairing HyperLaw's ability to publish public, non-copyrightable information from West's *Federal Reporter* and *Supreme Court Reporter*.

#### **FIRST CAUSE OF ACTION FOR DECLARATORY JUDGMENT**

86. HyperLaw repeats and realleges the allegations of paragraphs 1 through 85 above, and incorporates herein those paragraphs, and other paragraphs hereafter, by reference.

87. Factual material such as names of counsel, parallel citations, corrections, and amendments (other than the West Editorial Additions set forth in paragraph 28 above) made by West in West's *Supreme Court Reporter* and *Federal Reporter* are not original material and are not otherwise subject to copyright protection pursuant to the Copyright Laws.

#### **SECOND CAUSE OF ACTION FOR DECLARATORY JUDGMENT**

88. HyperLaw repeats and realleges the allegations of paragraphs 1 through 87 above, and incorporates herein those paragraphs, and other paragraphs hereafter, by reference.

89. Factual material such as names of counsel, parallel citations, corrections, and amendments (other than the West Editorial Additions set forth in paragraph 28 above) made by West in Volume 111 of West's *Supreme Court Reporter* and Volume 1 of the Third Series of West's *Federal Reporter* are

not original material and are not subject to copyright protection pursuant to the Copyright Laws.

### THIRD CAUSE OF ACTION FOR DECLARATORY JUDGMENT

90. HyperLaw repeats and realleges the allegations of paragraphs 1 through 89 above, and incorporates herein those paragraphs, and other paragraphs hereafter, by reference.

91. Corrections, and amendments made by West in West's *Supreme Court Reporter* and *Federal Reporter* (other than the West Editorial Additions set forth in paragraph 28 above) are not original material, because they are factual material, and are also works of the government of the United States, and thus are not subject to copyright protection pursuant to the Copyright Laws.

### FOURTH CAUSE OF ACTION FOR DECLARATORY JUDGMENT

92. HyperLaw repeats and realleges the allegations of paragraphs 1 through 91 above, and incorporates herein those paragraphs, and other paragraphs hereafter, by reference.

93. Corrections made by West in Volume 111 West's *Supreme Court Reporter* and Volume 1 of the Third Series of West's *Federal Reporter* (other than the West Editorial Additions set forth in paragraph 28 above) are not original material and are also works of the government of the United States, and are not subject to copyright protection pursuant to the Copyright Laws.

#### FIFTH CAUSE OF ACTION FOR DECLARATORY JUDGMENT

94. HyperLaw repeats and realleges the allegations of paragraphs 1 through 93 above, and incorporates herein those paragraphs, and other paragraphs hereafter, by reference.

95. Even if factual material such as the names of counsel, parallel citations, corrections, and amendments made by West in West's *Supreme Court Reporter* and *Federal Reporter* (other than the West Editorial Additions set forth in paragraph 28 above) were susceptible to copyright, that material is indistinguishably merged with material not subject to copyright protection to such an extent that the material is not subject to copyright protection pursuant to the Copyright Laws.

#### SIXTH CAUSE OF ACTION FOR DECLARATORY JUDGMENT

96. HyperLaw repeats and realleges the allegations of paragraphs 1 through 95 above, and incorporates herein those paragraphs, and other paragraphs hereafter, by reference.

97. Even if factual material such as the names of counsel, parallel citations, corrections, and amendments made by defendant West and contained in Volume 111 of West's *Supreme Court Reporter* and Volume 1 of the Third Series of West's *Federal Reporter* (other than the West Editorial Additions set forth in paragraph 28 above) were subject to copyright protection, that material is indistinguishably merged with material not subject to copyright protection to such an extent that the such material is not subject to copyright protection pursuant to the Copyright Act.

**SEVENTH CAUSE OF ACTION FOR DECLARATORY JUDGMENT**

112. HyperLaw repeats and realleges the allegations of paragraphs 1 through 97 above, and incorporates herein those paragraphs, and other paragraphs hereafter, by reference.

113. The Case Citation (to the initial page and volume number) of the full text of opinions in West's *Supreme Court Reporter* and *Federal Reporter* is not subject to copyright protection by reason of insufficient collection, arrangement, and coordination of the full text of the opinions, and HyperLaw may use those Case in publishing comprehensive competing publications without infringing any valid West copyright.

**EIGHTH CAUSE OF ACTION FOR DECLARATORY JUDGMENT**

114. HyperLaw repeats and realleges the allegations of paragraphs 1 through 99 above, and incorporates herein those paragraphs, and other paragraphs hereafter, by reference.

115. The citation and pagination to each individual page within the full text opinions in West's *Supreme Court Reporter* and *Federal Reporter* ("Pin-Point Citation") are not subject to copyright protection by reason of insufficient collection, arrangement, and coordination of the full text of the opinions, and HyperLaw may use such Pin-Point Citation in publishing comprehensive competing publications without infringing any valid West copyright.

**NINTH CAUSE OF ACTION FOR DECLARATORY JUDGMENT**

116. HyperLaw repeats and realleges the allegations of paragraphs 1 through 101 above, and incorporates herein those paragraphs, and other paragraphs hereafter, by reference.

117. The citation and pagination of the full text opinions and orders in Volume 111 of *West's Supreme Court Reporter* and volume 1 of the Third Series of *Federal Reporter* are not subject to copyright protection by reason of insufficient collection, arrangement, and coordination of the full text of the opinions, and Intervenor-Plaintiff may use such citations and pagination in publishing comprehensive competing publications without infringing any valid West copyright.

**TENTH CAUSE OF ACTION FOR DECLARATORY JUDGMENT**

118. HyperLaw repeats and realleges the allegations of paragraphs 1 through 103 above, and incorporates herein those paragraphs, and other paragraphs hereafter, by reference.

119. Publication by HyperLaw of a CD-ROM containing all or substantially all of the opinions contained in a volume or volumes of the *Federal Reporter*, and including citations, page numbers, corrections, the names of counsel, and parallel citations taken from the *Federal Reporter* does not and would not constitute unfair competition under the Lanham Act.

120. Publication by HyperLaw of a CD-ROM containing all or substantially all of the opinions also contained in a volume or volumes of the *Supreme Court Reporter*, and including the page numbers, corrections, names of counsel, and parallel citations taken from the *Supreme Court Reporter*, does not constitute unfair competition under the Lanham Act.

ELEVENTH CAUSE OF ACTION FOR DECLARATORY JUDGMENT

107. HyperLaw repeats and realleges the allegations of paragraphs 1 through 106 above, and incorporates herein those paragraphs, and other paragraphs hereafter, by reference.

108. For a period of up to three years after the initial release of an opinion by the Supreme Court, there is not a standard or official federal judicial citation acceptable for use in court documents and legal publications with the exception of private citations of the *Supreme Court Reporter, United States Reports, Lawyers Edition*®, and *U.S. Law Week*®. Use of one or more of these private citations are required by federal courts, and the preferred use is the citation to *Supreme Court Reporter*.

109. The *Federal Reporter* is the only source which contains corrected versions of the slip opinions issued by the federal Courts of Appeal. The Case Citation and internal Pin-Point Citation in both the *Federal Reporter* and the *Supreme Court Reporter* have practical (and in many instances judicial) recognition as the "official" citation.

110. This recognition has been made possible as a result both by the actions of the federal judiciary, specifically the assistance provided by the federal judiciary to West, and the federal judiciary willingness to accept and adopt the West citation, with the active encouragement and support of West.

111. Thus, if the West copyrights were otherwise valid in any part, then HyperLaw's intended use is a fair use and by that reason, a valid defense to infringement.

WHEREFORE, Intervenor-Plaintiff HyperLaw prays that this Honorable Court enter a judgment declaring the rights and other legal relations of the parties as follows:

1. That West does not possess a federal statutory copyright in the Case Citation or the Pin-Point Citation to the *Supreme Court Reporter* and the *Federal Reporter*;

2. That West does not possess a federal statutory copyright of corrections, names of counsel, and parallel citations included in the *Supreme Court Reporter* and the *Federal Reporter*;

3. That HyperLaw will not infringe any valid West copyright by its intended use of Case Citations, Pin-Point Citations, page numbering, corrections, counsel names, and parallel cites taken from the *Supreme Court Reporter* and the *Federal Reporter*;

4. That HyperLaw's intended use of the Case Citations, Pin-Point Citations, page numbering, corrections, counsel names, and parallel cites taken from the *Supreme Court Reporter* and the *Federal Reporter* are protected under the Constitution of the United States, including the Copyright Clause, the First Amendment, the Sixth Amendment, the Seventh Amendment, and the Fourteenth Amendment;

5. That HyperLaw will not be engaged in unfair competition as against the defendant in using Case Citations, Pin-Point Citations, page numbering, corrections, counsel names, and parallel cites taken from the *Supreme Court*

Reporter and the *Federal Reporter* in HyperLaw's publication of *Supreme Court on Disc* and *Federal Appeals on Disc*;

6. For the recovery of full costs and reasonable attorney's fees pursuant to 17 U.S.C. 505; and

7. For such additional and further relief, in law and equity, as may be deemed just and appropriate.

Dated: New York, New York  
March 9, 1994

Respectfully Submitted,

LAW OFFICES OF  
PAUL J. RUSKIN

By:



Paul J. Ruskin, Esq.  
(PR-1288)

*Attorney for Hyperlaw, Inc.  
Intervenor-Plaintiff*

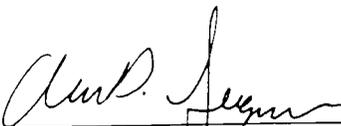
72-08 243rd Street  
Douglaston, New York 11363  
Telephone: (718) 631-8834  
Facsimile: (718) 631-5572

*Of Counsel:*  
Carl J. Hartmann III, Esq.

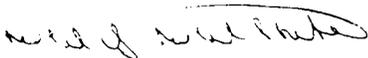
VERIFICATION

COUNTY OF NEW YORK            )  
  : ss.:  
STATE OF NEW YORK            )

I, ALAN D. SUGARMAN, being the President and Chief Executive Officer of the Intervenor-Plaintiff, HyperLaw, Inc., and pursuant to the requisite resolutions and authorizations, do state that HyperLaw, Inc., through me as its duly authorized officer, does hereby verify, under oath, that the facts and assertions made herein are true and accurate to the best of its knowledge.

  
\_\_\_\_\_  
ALAN D. SUGARMAN  
President and CEO, HyperLaw, Inc.

Subscribed and sworn to before me  
this 9th day of March, 1994



  
\_\_\_\_\_  
NOTARY PUBLIC

EDWARD S. POMERANTZ  
Notary Public-State of New York  
No. 44-8405123  
Qualified in Rockland County  
Commission Expires August 31, 1994

UNITED STATES DISTRICT COURT  
SOUTHERN DISTRICT OF NEW YORK

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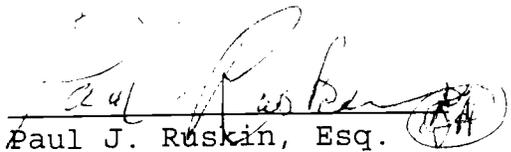
MATTHEW BENDER & COMPANY, INC.,	:	
	:	
Plaintiff,	:	94 CIV 0589 (LAP)
	:	
- against -	:	
	:	RULE 9
WEST PUBLISHING COMPANY,	:	CERTIFICATION
	:	
Defendant.	:	

-----X

Pursuant to Rule 9 of the General Rules of the Southern District of New York and to enable the judges of the court to evaluate possible disqualification or recusal, the undersigned counsel of record for a private (non-governmental) party certifies that the following are corporate parents, subsidiaries, or affiliates of HyperLaw, Inc., which are publicly held.

**NONE.**

Dated: New York, New York  
March 9, 1994

By:  Paul J. Ruskin, Esq. (PR-1288)

Attorney for Hyperlaw, Inc.  
Intervenor-Plaintiff

72-08 243rd Street  
Douglaston, New York 11363  
Telephone: (718) 631-8834  
Facsimile: (718) 631-5572

## EXHIBITS TO THE COMPLAINT

**Exhibit 1:**

*Federal Appeals on Disc™* CD-ROM, December, 1993 Release, HyperLaw, Inc.

**Exhibit 2:**

*Supreme Court on Disc™* CD-ROM, November, 1992 Release, HyperLaw, Inc.

**Exhibit 3:**

Complaint in *West Publishing v. Gross et al*, No. 1-93-CV-2071 (United States District Court, N.D. Ga., filed September 10, 1993)

**Exhibit 4:**

West Publishing Company, Press Release dated September 10, 1993

**Exhibit 5**

"West Moves to Protect Opinions", New York Law Journal, December 27, 1993.

**Exhibit 6:**

Complaint in *Matthew Bender v. West Publishing Company*, No. Civ. 94-0589 (United States District Court, S.D.N.Y., January 31, 1994)

**Exhibit 7:**

West Publishing Company, Advertisement, "The difference between raw text and a West Full-Text Plus tm opinion is black and white...", National Law Journal, July 27, 1992, Pages 6-7.

**Exhibit 8:**

Letter Dated July 1, 1991, Alan D. Sugarman, HyperLaw, Inc. to Timothy Blank, Esq., West Publishing Co.

**Exhibit 9:**

Letter Dated August 1, 1991, James E. Schatz, Opperman Heins Paquin to Alan D. Sugarman, HyperLaw, Inc.

**Exhibit 10:**

Letter Dated August 12, 1991, Alan D. Sugarman, HyperLaw, Inc. to James E. Schatz, Opperman Heins Paquin.

**Exhibit 11 :**

Letter Dated August 21, 1991, James E. Schatz, Opperman Heins Paquin to Alan D. Sugarman, HyperLaw, Inc.

**Exhibit 12:**

Letter Dated September 19, 1991, Alan D. Sugarman, HyperLaw, Inc. to James E. Schatz, Opperman Heins Paquin.

**Exhibit 13:**

Letter Dated October 9, 1991, James E. Schatz, Opperman Heins Paquin to Alan D. Sugarman, HyperLaw, Inc.

Exhibit 14:

Letter Dated May 21, 1992, Alan D. Sugarman, HyperLaw, Inc. to James E. Schatz, Opperman Heins Paquin.

Exhibit 15:

Letter Dated May 28, 1992, James E. Schatz, Opperman Heins Paquin to Alan D. Sugarman, HyperLaw, Inc.

Exhibit 16:

Letter Dated May 29, 1992, Alan D. Sugarman, HyperLaw, Inc. to James E. Schatz, Opperman Heins Paquin.

Exhibit 17:

Letter Dated June 2, 1992, James E. Schatz, Opperman Heins Paquin to Alan D. Sugarman, HyperLaw, Inc.

Exhibit 18:

Letter Dated June 11, 1992, Alan D. Sugarman, HyperLaw, Inc. to James E. Schatz, Opperman Heins Paquin.

Exhibit 19:

Letter Dated June 18, 1992, James E. Schatz, Opperman Heins Paquin to Alan D. Sugarman, HyperLaw, Inc.

Exhibit 20:

Letter Dated May 23, 1993, Alan D. Sugarman, HyperLaw, Inc. to Dwight D. Opperman, President, West Publishing Co.

Exhibit 21:

Letter Dated June 14, 1993, Dwight D. Opperman, President, West Publishing Co. to Alan D. Sugarman, HyperLaw, Inc.

Exhibit 22:

Letter Dated June 21, 1993, Alan D. Sugarman, HyperLaw, Inc. to Dwight D. Opperman, President, West Publishing Co.

Exhibit 23:

Letter dated March 17, 1993, from the Administrative Office of United States Court to Alan D. Sugarman, HyperLaw, Inc.

Exhibit 24:

Exclusions of Copyright Protection for Certain Legal Compilations: Hearings on H.R. 4426 Before the Subcomm. on Intellectual Property and Judicial Administration, House Comm. on the Judiciary, 102nd Congress, 2nd Session, (7-32) (1992). Statement of Ralph Oman, Register of Copyrights.