

New York Times v. Tasini

**Plaintiff's Memorandum of Law in Support of
Motion for Summary Judgment, pp. 1-2 and 25-26**

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

..... X
JONATHAN TASINI, et al.

Plaintiffs

93 CIV.8678(SS)

-against-

THE NEW YORK TIMES CO, NEWSDAY, INC.,
et al.

Defendants
..... X

PLAINTIFFS' MEMORANDUM OF LAW
IN SUPPORT OF THEIR
MOTION FOR SUMMARY JUDGMENT
ON THE ISSUE OF LIABILITY

Preface

This is a case about spare parts and the used vehicles they come from -- vehicles that bear a striking resemblance to used cars.

In the life of an automobile, there comes a time when that vehicle is worth more *disassembled* than left put together. Then, the car is taken apart, and its parts are sold off -- the engine, the muffler, the bumpers, fenders, doors, the front and back windshields, and even the hubcaps may be sold separately by junk dealers or used-parts suppliers.

The same fate now awaits today's newspaper or magazine and tomorrow's literary or social science journal. Such publications have a short shelf life: They quickly become "yesterday's papers."

But after the publications no longer have any value at the newsstand, they still have plenty of value when they're disassembled and the "parts" -- i.e., articles, reviews, op-ed pieces, etc. -- are put up for sale.

As a consequence, even before the presses cool, the publications are dismantled¹ and their parts are sent off to LEXIS/NEXIS and/or University Microfilms Inc. (hereinafter "UMI"), where the parts experience a second life.

This is the story of twenty-one (21) such parts or articles and the journey that they and other articles like them have taken through the new technologies. It is also the story of the extent to which the authors' rights in those articles have been infringed along the way.

* * * * *

From a legal standpoint, the case presents the following issues inter alia:

(1) whether articles that freelance writers have written for The New York Times, Newsday and/or Sports Illustrated can be placed on NEXIS without the

¹ The effect of the procedures the publisher defendants employ in preparing data for transmission and/or delivery to Mead (see description in Affidavit of Emily Bass, hereinafter referred to as "Bass Aff.") results in the defendants' papers and magazines *appearing* to have been "disassembled." In actuality what occurs is that the publisher defendants *discard* their collective works and return to a *pre-collective work* state. They locate data files on their ATEX computer that contain copies of articles as they existed *before* they were merged with photos and graphics and integrated into the collective work and process these data files -- each of which contains only one article -- for transmission to Mead.

In the final analysis, the function that Mead and UMI perform in the commercial publishing world is not very different from Kinko's. They both copy individual contributions that were made to *different* collective works and bring them together in new and different combinations. In the case of Kinko's, however, the copy shop generally has to either copy from or disassemble a *preexisting* collective work in order to obtain the parts it needs for the new assemblage. See Basic Books, Inc. v. Kinko's Graphics Corp., 758 F.Supp. 1522 (SDNY 1991)(at professors' request, Kinko's copied excerpts from books and then compiled and bound them into "course packets"; some packets contained excerpts from as many as 43 different sources, including excerpts from collective works). In the case of Mead and UMI, on the other hand, they don't *have* to disassemble any preexisting collective works because the parts they need have already been provided to them as discrete "documents".²⁵ Indeed, they have not only already been provided to them, but the parts are already "logged" and *in inventory*.

The other major difference between the two "copying" services is that, in the case of Kinko's, Kinko's plays no part in deciding the selections that will be brought together in what are, in effect, new 'collective works'. (Third parties, such as business people, professors and students, make these decisions). In the case of Mead and UMI, on the other hand, these decisions are necessarily joint ones. Thus, while the customer may be the one who defines the search, Mead

²⁵ This is true at least insofar as the ASCII or text-based products and/or components are concerned.

and UMI are the ones that have pre-screened, pre-tagged and pre-identified the individual documents *from their inventory* that are relevant to the search.

Mead and UMI, therefore, even more than Kinko's, must be said to *authorize* their customers to reproduce, distribute and display contributions *apart from* their collective works.

C. The Publisher Defendants Are Guilty
Of Both Contributory and Vicarious
Infringement.

Courts and commentators have long recognized the existence of two types of third-party liability in copyright law: "vicarious liability" and "contributory liability." The publisher defendants are guilty of both.

"As a rule of thumb . . . , 'benefit and control are the sign posts of vicarious liability,' while 'knowledge and participation [are] the touchstones of contributory infringement.'" Singer v. Citibank N.A., 1993 U.S. Dist. LEXIS 6907, * 14 (SDNY 1993), quoting from Demetriades v. Kaufman, 690 F.Supp. 289, 293 (SDNY 1988). The defendants in this case satisfy the criteria for both types of liability because they must be said (1) to have had knowledge of the data base defendants' infringement of plaintiffs' rights; (2) to have facilitated, participated in and/or contributed to the data base defendants' infringement of plaintiffs' rights; (3) to have had a financial stake in and/or benefited from the infringement; and (4) to have had sufficient control to have prevented and/or stopped the infringement if they had chosen to do so.

New York Times v. Tasini

**Defendants' Memorandum of Law in Support
of Defendants' Motion for Summary Judgment,
pp. 10-11 and 20-21**

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

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JONATHAN TASINI, MARY KAY BLAKELY, :
BARBARA GARSON, MARGOT MIFFLIN, :
SONIA JAFFE ROBBINS and DAVID S. :
WHITFORD, :

Plaintiffs, :

93 Civ. 8678 (SS)

- v. - :

THE NEW YORK TIMES COMPANY, NEWSDAY, :
INC., TIME INC., THE MEAD CORPORATION :
and UNIVERSITY MICROFILMS INC., :

Defendants. :

----- x
MEMORANDUM OF LAW IN SUPPORT
OF DEFENDANTS' MOTION FOR SUMMARY JUDGMENT

Of Counsel:

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Attorneys for Defendants

in Exhibit G, the Readers' Guide to Periodicals (the "Readers' Guide") is an index of references to articles available in many periodicals including Sports Illustrated, The New York Times Magazine and The New York Times Book Review; Times Co. also has created its own publication, called The New York Times Index. (Exhibit I).

In the past, a person wishing to conduct research with back issues of these periodicals was required to go to a library, review the Readers' Guide or The New York Times Index and retrieve the paper editions (or microfilm spools) of the relevant periodicals from the library's "stacks." Now, the same person, sitting at home or in his or her office with a personal computer, is able to replicate on NEXIS the Reader's Guide research steps in a much more direct and efficient manner, retrieving directly from the "electronic stacks" of periodicals available the relevant information desired. Similarly, the advent of CD-ROM has enabled researchers to retrieve, instead of a microfilm spool, the appropriate CD-ROM disc which also is "searchable" because of codes embedded in the disc. In fact, even the old and venerable Readers' Guide has tried to keep pace with the way research is conducted today by publishing editions in on-line and CD-ROM formats that can be electronically searched. (Exhibit H). In short, the NEXIS computerized library and UMI CD-ROM products permit individuals to conduct traditional periodical research

with the efficiencies everyone, including Congress,⁵ anticipated that computers would bring.

C. Publication Of The Articles Purchased From Plaintiffs.

Although the manner by which freelance articles are selected for publication in The New York Times, Newsday and Sports Illustrated can vary, the usual process, applicable to most freelance writers with respect to all three publications, has been well-established for many years. (Stern Dec. ¶ 3; Keane Dec. ¶ 3; Hunt Dec. ¶ 3). With rare exceptions, freelance assignments at The New York Times and Newsday have been undertaken and completed without any written agreement. (Stern Dec. ¶ 4; Keane Dec. ¶ 4). Generally speaking, there have been no express negotiations over rights (Stern Dec. ¶ 4), and Times Co. uniformly has accepted articles on the basis of its practice of distributing each edition of The New York Times on paper, microfilm and CD-ROM, and in the NEXIS computerized library of periodicals. (Stern Dec. ¶ 4).⁶ Similarly, Newsday typically has not

5. See, e.g., infra note 22.

6. In rare cases, usually involving either (i) freelance writers who agree to submit multiple articles over a particular period, such as regular or periodic columnists, or (ii) freelance writers of independent stature, Times Co. has entered into a written agreement with the writer. Even those express transfers, however, which, as such, do not trigger the operation of Section 201(c), make clear Times Co.'s practice of distributing The New York Times in various media, including electronic media. (Stern Dec. ¶ 5).

microfilm, CD-ROM or in a computer server. As the House Report accompanying the Act states:²¹

Under the bill *it makes no difference what the form, manner or medium of fixation may be . . . whether embodied in a physical object in written, printed . . . magnetic or any other stable form, and whether it is capable of perception directly or by means of any machine or device "now known or hereafter developed.*

H.R. Rep. No. 1476, 94th Cong., 2d Sess. 52 (1976) (emphasis added).²²

Accordingly, whether a particular issue of The New York Times, Newsday, or Sports Illustrated objected to by plaintiffs is fixed in print, microfilm or electronic bytes "makes no difference" in determining its copyright status: each edition either is a copy of the same collective work or revised solely to permit format shifting, just as a vinyl LP edition of Sgt. Pepper's Lonely Hearts Club Band is a copy of exactly the same sound recording as are later reproductions of the album as a

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21. The legislative history of Section 201(c) is submitted herewith in a separate bound volume marked as Exhibit J.
 22. "[T]hat is the basis on which we drafted this bill. For example, you can read the bill from beginning to end and you won't find in it any reference to computers . . . [even though] these are one of the coming instruments of communication in the future. *We have tried to phrase the broad rights granted in such a way that they can be adapted as time goes on to each of the new advancing media.*" Copyright Law Revision: Hearings on H.R. 4347, 5680, 6831, 6835 Before Subcommittee No. 3 of the House Committee on the Judiciary, 89th Cong., 1st Sess. 57 (1965)(Testimony of George D. Cary, Deputy Register of Copyrights, May 26, 1965, on general revision bill which was enacted into law in 1976) (emphasis added).

CD copy, an analog cassette copy or a digital audio tape (DAT) copy.²³ (Petrosino Dec. ¶ 13; Riedel Dec. ¶ 10).

The definitions of the Act as applied to Section 201(c) reinforce that the printed paper limitation plaintiffs urge does not exist within the Act itself, but must be contractually imposed, which plaintiffs admit they did not do. (See supra note 13). Section 201(c) speaks of "reproducing and distributing" a freelancer's contribution. Under the Act, those rights are exercised by reproducing and distributing "copies." 17 U.S.C. § 106(1) and (3). The Copyright Act makes clear that "copies," consistent with the intent of Section 102(a), may be:

fixed by any method now known or hereinafter developed and from which the work can be perceived, reproduced or otherwise communicated, either directly or with the aid of a machine or device.

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23. That plaintiffs' medium-restrictive approach to the Copyright Act must be wrong is illustrated by the fact that each of plaintiffs' articles and the periodicals in which they appear already have undergone several media or format shifts: first when the freelancer submitted the article, whether on paper or on disc, to the publisher; next when the publisher converted it to its own digitized word processing system; and finally when it was shifted to the paper format at the printers. (Special Set of Time Admissions ¶¶ 1, 7; Special Set of Newsday Admissions ¶¶ 1, 4; Special Set of Times Co. Admissions ¶¶ 1, 6 (Exhibits F-1-F-3)). Plaintiffs' medium-specific approach, which ignores the technology-neutral structure of the Act, would require the acquisition of a whole variety of rights to the same article simply in order to prepare it for publication in print, a result completely inconsistent with the legislative history quoted above.

New York Times v. Tasini

**Defendants' Memorandum of Law in Further
Support of Defendants' Motion for Summary
Judgment, pp. 2-3, 17-19 and n. 19**

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

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JONATHAN TASINI, MARY KAY BLAKELY, :
BARBARA GARSON, MARGOT MIFFLIN, :
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Defendants. :

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MEMORANDUM OF LAW
IN FURTHER SUPPORT OF DEFENDANTS' MOTION
FOR SUMMARY JUDGMENT AND IN OPPOSITION
TO PLAINTIFFS' MOTION FOR SUMMARY JUDGMENT

Of Counsel:

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P. Mem. at 40-41, they contend that the rights acquired by publishers pursuant to Section 201(c) of the Copyright Act are limited to the print medium. Id. As demonstrated below, Congress was well aware of such systems, and the Act was drafted to account for their continued development. See infra at 6-9. There is no basis to assert that the Section 201(c) grant to publishers -- which the architects of the Act referred to both as a right and as a privilege -- is any more limited to the printed paper medium than is any other provision of the Copyright Act. See infra at 19-23; Memorandum of Law in Support of Defendants' Motion for Summary Judgment ("D. Mem.") at 16-23. Section 201(c), which expressly refers to the reproduction and distribution of collective works such as periodicals, uses the same expansive, medium-neutral terms found in Section 106 of the Act. Plaintiffs offer no reason why the identical words found in one section of the Act take on a more narrow meaning when used in a subsequent section.

Second, with analogies to "spare parts" and "used cars," plaintiffs argue that because individual computer files are used in the process of creating the NEXIS and CD-ROM copies of the periodicals, this necessarily results in the publication of "*individual articles* and *not* as part of *any* collective works." P. Mem. at 1, 37. Plaintiffs' admissions that defendants create the NEXIS and CD-ROM editions of the respective periodicals as entire collective works, just as the paper editions are created -- including by use of the same computer files used to create the paper editions -- expose this argument as strained and factually incorrect. Bass Aff. ¶¶ 11, 18, 46. Plaintiffs have submitted no evidence, and none exists, that any of the

defendants have exploited any of the plaintiffs' articles apart from publishing them in microfilm, NEXIS and CD-ROM formats together with all of the other articles that make up the paper copy of the collective work. See infra at 14-15.

As a result, plaintiffs eventually base their "spare parts" analogy on an argument that the addition of digital coding, which makes it possible to search for and retrieve individual articles without physically paging through entire issues, infringes their rights. As defendants made clear in their opening brief, D. Mem. at 10-11, however, articles may be searched for and read on an individual basis whatever the medium -- paper, microfilm or digital. The addition of search codes invisible to a reader, just like the codes added to CD copies of sound recordings (which make it possible to search for and play particular tracks), does not determine copyright status. Instead, the only relevant inquiry is whether the transformation from one medium to another creates a new, derivative work. Under well-established copyright principles, the mechanical transformation of a work printed on paper to a machine-readable format does not result in a new derivative work, just as a CD is not a new, derivative work of a vinyl LP or cassette sound recording. See infra at 17-19.

Third, plaintiffs claim that, because issues of the periodicals appearing in the NEXIS computerized library and on certain CD-ROM products do not contain photographs and various other non-textual elements found in paper copies of The New York Times, Sports Illustrated and Newsday, those digital copies are infringing. Section 201(c), however, permits "any revision" to the collective work. Once again,

Statements of H. Pilpel, 1965 Report at 152 ("in terms of changing the contributions, or their order, or including different contributions, obviously the magazine writers and photographers would not object"); H.R. Rep. No. 2237, 89th Cong., 2d Sess. 117 (1976) (publisher may not "revise the contribution itself" without express permission). Modifications to the layout of a newspaper or magazine are within the discretion of the publisher as the copyright owner of the collective work and do not involve any of plaintiffs' copyright interests. At no time did plaintiffs create, control or bargain for placement of their articles on a particular page or together with accompanying photographs or particular graphics elements.

Plaintiffs also make the somewhat related argument, once again without citation to any relevant authority, that by adding codes and electronic markers to assist in the retrieval of electronic information, the publishers, NEXIS and UMI have infringed plaintiffs' exclusive rights to create derivative works of their articles. P. Mem. at 21-22 and 33. This claim must be rejected.¹⁸ A non-paper copy of a periodical is not a derivative work, but, from the point of view of the Copyright Act and the Copyright Office, is the *same work* as the paper copy. The articles are identical and remain textually unaffected by any coding. To qualify as a separate

18. As an initial matter, plaintiffs have not alleged either in their Complaint or their Amended Complaint any infringement of their rights with respect to derivative works and, therefore, there was no discovery on this matter. Accordingly, plaintiffs should not be permitted pursuant to Fed. R. Civ. P. 15, more than two years later, to again amend their pleadings to add such a claim. Browning Ave. Realty Corp. v. Rosenshein, 774 F. Supp. 129, 146 (S.D.N.Y. 1991) (denying leave to amend complaint after extensive discovery where action had been pending for more than two years).

derivative work, the manner of rearranging or otherwise modifying a prior work must constitute more than a minimal contribution; there must be a new element of originality sufficient to support the issuance of a separate copyright registration. Feist Publications, Inc. v. Rural Telephone Serv. Co., 499 U.S. 340, 349 (1991). Where there has been a mechanical change in medium and the alterations to a work consist of non-creative decisions to delete entire categories of material on a uniform basis, a new derivative work has not been created. See L. Batlin & Son, Inc. v. Snyder, 536 F.2d 486, 491 (2d Cir.), cert. denied, 429 U.S. 857 (1976) (change in medium, scale or size of sculptural work did not result in separate derivative work); Signo Trading Int'l Ltd. v. Gordon, 535 F. Supp. 362, 364 (N.D. Cal. 1981) (choice of dialect, which resulted in certain synonyms being used in a translation to the exclusion of others, did not create copyrightable derivative work); Grove Press, Inc. v. Collectors Publication, Inc., 264 F. Supp. 603, 605 (C.D. Cal. 1967) (40,000 changes consisting "almost entirely of elimination and addition of punctuation, changes of spelling of certain words, elimination and addition of quotation marks, and correction of typographical errors" were not separately copyrightable). See also Compendium of Copyright Office Practices § 306.02(a) ("transliterations and similar processes by which letters or sounds from one alphabet are converted to another are not copyrightable since the conversion is merely a mechanical act"); § 306.02(c) (for abridgements to be copyrightable as derivative works, "more selectivity is required than merely omitting a section"); § 496.03 (sound recordings released in new formats,

such as CDs, are not registrable "[w]here only . . . slight variations or minor additions of no substance have been made").¹⁹

In short, revisions are expressly permitted by the Act, 17 U.S.C. § 201(c), and the coding about which plaintiffs complain does not satisfy the standards for a derivative work. In any event, to the extent there is a derivative work, which there is not, it would be derivative only of the collective works in which the respective publishers own the exclusive copyright, including the right to prepare derivative works. 17 U.S.C. § 106.²⁰

II.

PLAINTIFFS' ASSERTED PRIVILEGE/RIGHT DICHOTOMY IS A FALSE DISTINCTION WITHOUT LEGAL BASIS.

Buried in a curious footnote and in a single sentence is plaintiffs' unprecedented suggestion that even if the publishers' authority under Section 201(c)

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19. The coding revisions involved in transforming the periodicals to digital format are similar to coding contained on the CD format of analog sound recordings, which, although they permit the selection of individual tracks and the display of the time remaining in the recording, do not constitute derivative works. Compendium of Copyright Office Practices § 496.03.
20. That plaintiffs, or even defendants in their contracts (see P. Mem. at 21-22), use the term derivative work, does not transform a work into a derivative work if elements added to the work do not satisfy the "originality" standards described by the Supreme Court in Feist and the Second Circuit in Batlin, neither of which plaintiffs even cite. Although plaintiffs complain, without citation to the record, that information may be added before a periodical is placed on NEXIS such as the title of an article, the author's name and the word count, P. Mem. at 21, plaintiffs themselves appear to acknowledge that such revisions fall within the express recognition by Congress that additions to a work such as "illustrations or front matter" do not result in the creation of a separate derivative work. P. Mem. at 22; H. Rep. No. 1476, 94th Cong., 2d Sess. 122 (1976).

New York Times v. Tasini

**Plaintiff's Memorandum of Law in
Opposition to Defendants' Motion for Summary
Judgment, pp. 1-3, 6-10 and 29-30**

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

JONATHAN TASINI, MARY KAY BLAKELY
BARBARA GARSON, MARGOT MIFFLIN,
SONIA JAFFE ROBBINS, and DAVID S.
WHITFORD,

Plaintiffs,

- vs. -

NEW YORK TIMES CO., NEWSDAY INC.,
TIME INC., THE MEAD CORPORATION, and
UNIVERSITY MICROFILMS INC.,

Defendants.

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Index No.:

93 CIV 8678
(SS)

PLAINTIFFS' MEMORANDUM OF LAW
IN OPPOSITION TO
DEFENDANTS' CROSS-MOTION FOR SUMMARY JUDGMENT

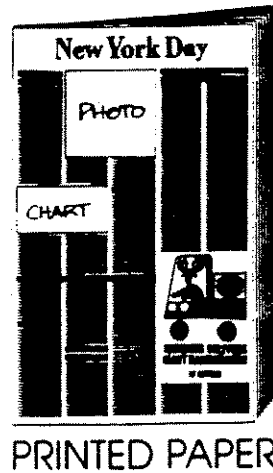
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Counsel for Plaintiffs

Preface

Some pictures are worth a thousand words. For example:



These graphics show the error in the defendants' argument: they cannot credibly

(1) claim that all they have done is make available electronically a collective work that has already appeared in print, or

(2) pretend that what plaintiffs are objecting to is the defendants making a collective work available in a different medium.

Plaintiffs' objection is that the defendants are attempting *by indirection* to do what the law does not permit them to do *by direction*. Defendants do so by employing a medium whose essential characteristics are fundamentally incompatible with the very limited privilege that collective-work publishers have been afforded under section 201(c) of the Copyright Act. By making use of such a medium, the publisher of the collective work *necessarily* exceeds the scope of the statutory "license" it has been given and violates the freelance author's exclusive rights.

Although the defendants try hard to ignore this fact, the Copyright Act of 1976 distinguishes between the copyright in a "contribution" and the copyright in a "collective

work"¹ and provides, in the case of freelancers, that the former vests in the author of a contribution.² Unless the freelancer expressly grants a newspaper publisher *more*, all the publisher gets under the Act is the "privilege" of reproducing and distributing a freelance article, photo or graphic that has been contributed to its newspaper *as part of that particular* collective work, any revision of *that* collective work, and any later collective work *in the same series*. 17 U.S.C. § 201 (c). It does not get any rights *in the* particular article or contribution itself and cannot exploit the contribution as a discrete work. See 17 U.S.C. §§103, 106 and 201(c).

No one could contend that *under section 201(c)*, Newsday or The New York Times could:

(1) cut plaintiffs' articles out of the newspapers in which they appeared, refashion each article so that it fits on a leaflet or flyer and hand the flyers out on the street,

(2) re-send the individual computer files containing plaintiffs' articles to the typesetter, prepare a proof of each individual article and sell copies of these *proofs* out on the streets, *or*

(3) re-type plaintiffs' articles, xerox the re-typed articles, and then have copies of these copies distributed on the street.

If The New York Times can't legally do any of those things, *neither can it make plaintiffs' articles available as part of an electronic data base*. This is necessarily so because, in ~~the~~ latter case as in the former, the publisher is doing *precisely* what section 201(c) of the Copyright Act prohibits: separating individual contributions from the collective works to which they were contributed in order to exploit them as discrete

¹ Significantly, with one exception, every time the defendants either refer to or quote from section 201(c), *they leave out the first sentence of the section*.

² Where the author is a staff writer for the publisher of a collective work or has prepared a contribution as a "work for hire", section 201(b) makes the publisher of the collective work rather than the actual creator the "author" of the contribution for purposes of the Act. Under these circumstances and only under these circumstances, the publisher of the collective work will own the copyright in an underlying contribution as well as the copyright in the collective work from the outset.

works. If the publisher cannot do this *in the print medium*, then neither can it do it *in any other medium*, including an electronic data base.³

ARGUMENT

The defendants assert an entitlement to summary judgment on the basis of their claim: (1) that they automatically acquired the right to exploit plaintiffs' articles in all media *as a matter of law*, (2) that plaintiffs were obligated to expressly reserve any rights that they wanted to retain, and (3) that they failed to do so.

Only the last contention has any merit. Plaintiffs did *not* expressly reserve any rights in the stories and/or articles they wrote for Newsday, The New York Times, and Sports Illustrated. *They were not required to*. As demonstrated above, notwithstanding the defendants' contentions to the contrary, under sections 103, 106, and 201(a) and (c) of the Copyright Act, all rights in plaintiffs' articles automatically vested in the plaintiff freelance-authors, *not* the defendant-publishers, and remained with the freelance authors since they did not expressly give them away. (See Point I. A (1), post.)

All that the defendants received -- in the cases of Newsday Inc. and The New York Times Company, pursuant to the very limited statutory "privilege" provided for by section 201(c), and, in the case of Time Inc., pursuant to a license embodied in a letter-agreement drafted by the defendant -- was permission to reproduce and distribute plaintiffs' articles *as part of* the collective works described in their respective "licenses",⁴

³ Although the defendants seem to believe that they derive some benefit from continuing to pretend that plaintiffs have sought to "limit them to printing on paper" or to preclude them from making microfilm copies of their papers, that is decidedly not the case and counsel for plaintiffs has repeatedly told them so.

One of the reasons for objecting to the certain electronic media -- i.e, coded electronic search and retrieval systems -- but not print media is that the former, but not the latter, are dependent upon the type of separation we are talking about.

⁴ The "privilege" provided for by section 201(c) is in the nature of a very limited "compulsory license." Accordingly, both that privilege and the permission accorded Time Inc. under its letter-agreement with David Whitford shall be referred to as "licenses."

for having infringed his rights. Assume that our contribution author (and owner) is a freelancer. His contribution may be depicted:



When a publisher of a collective work owns not only the copyright in the collective work,⁷ but *also* the copyrights to all of the individual contributions that make up the collective work, it holds a similar set of rights.⁸ It is entitled to exploit the collective work and/or any of the contributions included in it in any and all media, to prevent others from exploiting either in any and all media, and to hold anyone who *does* exploit one or the other without its consent liable for having infringed its rights.⁹ Assume that the author of the company. The collective work may be depicted:



Each ● represents a contribution, the copyright to which is owned by the collective work author.

⁷ To reiterate, see πs' Mem. at 5-8 (Plaintiffs' Memorandum in Support of Their Motion for Summary Judgment on the Issue of Liability will hereinafter be referred to as 'πs' Mem. '), the copyright in a collective work attaches *only* to those aspects of the work that are the collective author's property, i.e., those aspects of the work *that have been added by the collective author* (e.g., the ordering and arrangement of a collective work; the placement of a contribution in juxtaposition to other contributions in a collective work) and are, thus, the collective author's property.

17 U.S.C. § 103(b) makes this incontrovertibly clear. It provides:






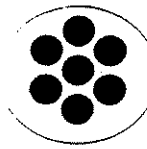

The copyright in a compilation or derivative work extends only to the material contributed by the author of such work, as *distinguished from the preexisting material employed in the work, and does not imply any exclusive right in the preexisting material.* The copyright in . . . [the collective or derivative] work is independent of, and *does not affect . . . the scope, duration, ownership, or subsistence of, any copyright protection in the preexisting material.* 17 U.S.C. § 103(b)(emphasis added).

⁸ The publisher may own the copyright in the contributions either because they have been produced by its staff, because they have been produced as "works for hire," or because the copyright and all of the rights in the contributions have been transferred to it.

⁹ The part of the collective work that is replicated (e.g., forward, one of the contributions, bibliography) will determine which copyright needs to be enforced: i.e., the copyright which the collective work author holds in one of the contributions or the copyright it holds in the collective work proper.

In each of these instances, the proprietor of the copyrights involved can, *with impunity*, exploit the material that is subject to copyright in any and all media because no matter how transformative or deconstructive a particular medium (or the technology that is associated with that medium) may be, the copyright proprietor is *not* in danger of infringing anyone else's rights. He, she or it *owns* all of the rights.

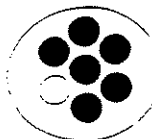
Thus, it will not matter whether what is being published in the second medium is the same set of materials that was published in the first medium or some subset of those materials. Because it holds title (copyright) to the entire universe, the collective work author also owns the copyrights to whatever subset of materials is published.

1st Medium	2nd Medium	Comments
		Freellance Author owns copyright in the contribution and can exploit it in all media
		Newspaper publisher owns copyright in contribution and can exploit it in all media
		Newspaper publisher owns copyright in each contribution as well as in collective work and can therefore exploit them in all media whether or not
		the medium is deconstructive. No one's rights are infringed.

These, of course, are the easy cases.

The question that is presented by *this* case is: what happens when the publisher of a collective work does *not* own one or more of the contributions included in the collective work?

Let us assume, again, that the author of the collective work is a newspaper company. Its collective work may be depicted:



Under what circumstances can the collective work author exploit the collective work (and the contributions included in it) in media other than the medium in which it was first published? Under what circumstances is it precluded from doing so because such exploitation would constitute an infringement of the contribution authors' rights?

Can it treat the same as or does the difference between the two affect what it can and cannot do with the collective work?

The answer, obviously, depends *both* on any rights (or privileges) that the publisher has been given with respect to any contributions it does not own, *and* the uses that are made of the contributions. Any use of a contribution that exceeds the license that the collective work author has been given -- whether as the result of an express transfer or pursuant to section 201(c) -- will necessarily constitute an infringement. See, e.g., *Quinto v. Legal Times of Washington, Inc.*, 506 F. Supp. 554 (D.D.C. 1981).¹⁰ This

¹⁰ The same analysis applies, of course, in the case of derivative works. See generally *Stewart*, 495 U.S. at 223, 110 S. Ct. at 1761 ("[t]he aspects of a derivative work added by the derivative author are that author's property, but the element drawn from the pre-existing work remains on grant from the owner of the pre-existing work"; "[s]o long as the pre-existing work remains out of the public domain, its use is infringing if one who employs the work does not have a valid license or assignment" to use the pre-existing work in the fashion it is being used); *Russell v. Price*, 612 F.2d 1123, 1128 (9th Cir. 1979), cert denied, 446 U.S. 952, 100 S. Ct. 2919 (1980) ("[t]he established doctrine prevents ... infringing use of the underlying work ... so long as the underlying work itself remains copyrighted"); *Gilliam v. American Broadcasting Cos., Inc.*, 538 F.2d 14, 20 (2d Cir. 1976) (most of the courts that have reached the conclusion that "[o]ne who obtains permission to use ... copyrighted ... [material] in the production of a derivative work ... may not exceed the specific purpose for which permission was granted" have dealt

means that, like the owner of copyright in a derivative work, the owner of copyright in a collective work cannot exercise its rights in such a fashion as to infringe any of the exclusive rights still held by the owner of copyright in the underlying work.

While, under other circumstances, it might require a slightly more sophisticated analysis to determine whether the use that was being made of an underlying work was infringing, *in this case*, the calculus is exceedingly simple, and the conclusion indisputably clear: The use the defendants have made of plaintiffs' works *is* infringing.

The reason this is so is that the defendants have exceeded the scope of the "licenses" they were given. Those licenses limited them to reproducing and distributing plaintiffs' contributions *as part of* particular collective works and *gave them no other rights*.¹¹ Notwithstanding these limitations, the defendants

. (1) reproduced and distributed the contributions *not* as part of collective works, but as separate works,

. (2) prepared derivative works based upon these separate works, and

. (3) authorized others to display, reproduce, distribute, and perform¹² the works as separate works.

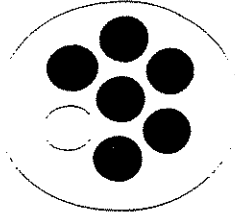


(See π s' Mem. at 15 - 33).

"with the improper extension of the underlying work *into media* or time . . . *not covered by the grant of permission to the derivative work proprietor*"; G. Ricordi & Co. v. Paramount Pictures, Inc., 189 F.2d 469 (2d Cir. 1951), cert denied, 342 U.S. 849, 72 S. Ct. 77 (1951).

¹¹ In the case of Newsday and The New York Times, each of which published a newspaper, they were given the privilege of "reproducing and distributing the contribution as part of that particular collective work, any revision of that collective work, and any later collective work in the same series." 17 U.S.C. § 201(c). In the case of the Time Inc. Magazine Company, which published Sports Illustrated, it was given the right "first to publish the Story in the Magazine", and non-exclusive rights thereafter to publish it either in another Time Inc. publication or to syndicate the Story in another publication. (Exh. 36 attached to the Bass Affidavit submitted in support of Plaintiffs' Motion for Summary Judgment, hereinafter referred to as 'Exh.').

¹² The defendants claim that the right to perform plaintiffs' works is not implicated by this case. The statutory definitions suggest otherwise.

As the following diagram suggests, each such use of plaintiffs' works necessarily results in an infringement of plaintiffs' rights:

1st Medium	2nd Medium	Comments
		Newspaper publisher owns copyright in collective work and in <i>certain</i> contributions. To the extent it employs deconstructive medium or technology in fashion that exploits contribution
		in which it does <i>not</i> hold the copyright, it clearly infringes the freelancer's rights.

C. The Electronic Information Products At Issue In This Litigation Do Not Constitute Electronic Versions Of The "Particular Collective Works" To Which The Plaintiffs' Articles Were Contributed Or "Revisions Of That Collective Work."

1. The Defendants' Attempt to Portray Themselves As Simply Engaged In A Little "Format-Shifting" Is At Odds With The Facts.

The defendants' protestations to the contrary notwithstanding, it is simply not possible on the undisputed facts in this case¹³ -- which are reviewed in the Bass Affidavit

¹³ Plaintiffs understand certain statements in the defendants' declarations to be an attempt to *recharacterize* certain facts or place a gloss on them, but not either to assert new facts or to dispute facts that were previously attested to by their Rule 30(b)(6) witnesses. Among the statements plaintiffs so understand are the following:

(1) Its repeated statements to the effect that one or another publisher provided NEXIS "on a daily basis a complete copy of the same computer text-files the printers use to create that day's paper edition of ... [the defendant's periodical];" and a related statement to the effect that NEXIS provided UMI "a magnetic tape containing a copy of the computer text-files the printers used to create each of the preceding month's daily editions of The New York Times, as transmitted to NEXIS." Since the printers or printing plants do not even use computer text-files, plaintiffs take it that all the defendants must mean is that the same ATEX files that were sent to the typesetter, prior to the preparation of a mechanical, were subsequently stripped of their typesetting instructions, placed in separate electronic files, encoded, and sent to NEXIS.

(2) The defendants' repeated statements to the effect that "issues" of one or another periodical were "reproduced and distributed in a variety of formats," when the undisputed facts establish that what was reproduced and distributed cannot properly be characterized as "issues."

(3) Their statements to the effect that it was the "practice" of one or another publisher "to acquire from freelance writers the right to publish all . . . [of the articles of a given periodical] in a variety of

absolutely clear. It provides that “[a]nyone who violates any of the exclusive rights of the copyright owner . . . is an infringer of . . . copyright” 17 U.S.C. § 501(a). It does not except violations of a right that overlaps another right.⁴⁴

Conscious of the fact that their “overlap” argument is nothing other or more than an effort to inveigle the Court into ignoring the plain meaning of the statute, the defendants attempt to bolster that effort with a reductio ad absurdum argument. In attempting to demonstrate the unreasonability of plaintiffs’ position, the defendants demonstrate the sophistry of their own. They state:

That this overlap of section 106 rights may occur is not new and is not created simply when “electronic publishing rights” are involved. For example, a paper copy of Newsday, including its front page, tabloid-size photo is both reproduced and distributed . . . when it is printed and shipped by Newsday. . . . The photograph on the front page also is displayed when that copy sits in a newsrack. That does not mean, however, as the logic of plaintiffs’ argument would dictate, that Newsday cannot sell copies of Newsday at newsracks featuring the cover page unless it separately has acquired “display” rights from a freelance photographer whose work appears on the front page.

(Defts’ Mot. at 34-35).

The problem that the defendants suggest would be posed by plaintiffs’ position is specifically remedied by the statute. Section 109(c) of the Copyright Act of 1976 expressly provides that, notwithstanding the fact that someone may not have been given display rights under section 106 of the Act, they will nonetheless have the privilege under section 109 of the Act to display certain copies of a work *in a particular fashion*. The copies to which the privilege attaches are copies that the person owns or has been authorized by the owner to display. The privilege would clearly enable both Newsday

⁴⁴ It is respectfully submitted that the overlap was intended to make it easier for the copyright owner to prove infringement, rather than easier for the infringer to claim lawful use.

and any newsstands that legally carry Newsday to display copies of the paper. The provision reads:

Notwithstanding the provisions of section 106(5), the owner of a particular copy [of a work] lawfully made under this title, or any person authorized by such owner, is entitled, without the authority of the copyright owner, to display that copy publicly, either directly or by the projection of no more than one image at a time, to viewers present at the place where the copy is located.

17 U.S.C. § 109(c).

The very fact that Congress deemed it necessary to expressly legislate on this question is highly significant because if even the very limited display "privilege" provided for by this section must be expressly provided for and cannot be implied, then the more far-reaching display right provided for by section 106(5) cannot be the subject of implication either. It further follows that the defendants' "you-can-imply-a-right-when-it's-an-overlapping-right" argument has no basis in law and must be rejected.⁴⁵ (After all, if there were ever a copyright right that one would think would be implied, it is the right provided for by section 109(c).)

Since section 201(c) does not explicitly provide for the right to publicly display a work within the meaning of section 106(5), and such a right cannot be implied, it is not part of the statutory privilege.⁴⁶

⁴⁵ While the Act, from the owner of copyright's point of view, is not medium-specific, it is certainly right-specific. As just one example, see 17 U.S.C. § 115(5)(termination of compulsory license "renders either the making or the distribution, or both, . . . actionable as acts of infringement . . ."). Also see just about every copyright infringement case that has ever been litigated. E.g., Sony Corp. v. Universal City Studios, Inc., 464 U.S. 417, 473 n. 25, 104 S. Ct. 774, 805 n. 25, reh'g denied, 465 U.S. 1112, 104 S. Ct. 1619 (1984)(recognizing that a 1971 Amendment that prohibited "the unauthorized reproduction and distribution to the public" of copies of sound recordings did not prohibit "the performance of sound recordings through broadcasting or other means")

⁴⁶ Since the section 201(c) privilege does not incorporate such a right, it follows that the owner of copyright in the collective work cannot electronically display any contributions via NEXIS or ProQuest. (It may also be that, absent an express transfer of rights, the copyright proprietor in a collective work cannot electronically display a freelance contribution as part of that collective work -- such as in an image-only product.)

New York Times v. Tasini

District Court Decision:

972 F. Supp. 804 (S.D.N.Y. 1997)

pp. 816-19 and nn. 14 & 16

*804 972 F.Supp. 804

1997 Copr.L.Dec. P 27,672, 43 U.S.P.Q.2d
1801,
25 Media L. Rep. 2057

United States District Court,
S.D. New York.

Jonathan TASINI, Mary Kay Blakely, Barbara
Garson, Margot
Mifflin, Sonia Jaffe Robbins, and David S.
Whitford, Plaintiffs,

v.

The NEW YORK TIMES CO., Newsday Inc., Time
Inc., The
Atlantic Monthly Co., Mead Data Central Corp., and
University Microfilms Inc., Defendants.
No. 93 Civ. 8678(SS).
Aug. 13, 1997.

Freelance writers brought action against publishers for copyright infringement. Parties moved for summary judgment. The District Court, Sotomayor, J., held that publishers were entitled to place contents of their periodicals into electronic databases and onto CD-ROMs without securing permission of writers whose contributions were included in publishers' periodicals.

Defendants' motion for summary judgment granted; plaintiffs' motion for summary judgment denied.

West Headnotes

[1] Federal Civil Procedure Ⓒ 2534
170A ----
170AXVII Judgment
170AXVII(C) Summary Judgment
170AXVII(C)3 Proceedings
170Ak2533 Motion

170Ak2534 By Both Parties.

Simply because parties have cross-moved for summary judgment, and therefore have implicitly agreed that no material issues of fact exist, does not mean that court must join in that agreement and grant judgment as a matter of law for one side or the other. Fed.Rules Civ.Proc.Rule 56(c), 28 U.S.C.A

[2] Copyrights and Intellectual Property Ⓒ 45
99 ----

99I Copyrights
99I(E) Transfer
99k43 Assignments or Transfers
99k45 Requisites and Validity.
Terms of any writing purporting to transfer copyright interests, even a one-line pro forma statement, must be clear. 17 U.S.C.A. § 204(a).

[3] Copyrights and Intellectual Property Ⓒ 45
99 ----

99I Copyrights
99I(E) Transfer
99k43 Assignments or Transfers
99k45 Requisites and Validity.
Note or memorandum of transfer of copyright ownership can serve to validate prior oral agreement. 17 U.S.C.A. § 204(a).

[4] Copyrights and Intellectual Property Ⓒ 45
99 ----

99I Copyrights
99I(E) Transfer
99k43 Assignments or Transfers
99k45 Requisites and Validity.
Legend on check stating that periodical publisher had right to include authors' article in electronic library archives did not unambiguously transfer ownership of electronic rights in articles; publisher sent articles to electronic database before authors received or cashed checks, and reasonable interpretation of "electronic library archives" did not encompass commercial electronic database. 17 U.S.C.A. § 204(a).

[5] Copyrights and Intellectual Property Ⓒ 47
99 ----

99I Copyrights
99I(E) Transfer
99k43 Assignments or Transfers
99k47 Construction and Operation.
Periodical publisher's right "first to publish" author's article did not include right to republish article in commercial electronic database 45 days after article appeared in periodical.

[6] Copyrights and Intellectual Property Ⓒ 38
99 ----

99I Copyrights
99I(B) Scope
99k35 Scope of Exclusive Rights; Limitations
99k38 Distinct Portions of Work; Compilations and Derivative Works.
Copyright in new version of preexisting work

nonexclusive licenses. Unlike assignments or exclusive licenses or most other conveyances under copyright law, such limited grants are not transferrable. *See* 17 U.S.C. § 101 (defining "transfer of copyright ownership"). Because the publisher defendants own the copyrights in their collective works, plaintiffs reason that the electronic defendants are guilty of infringement even in the event that they are creating revisions--authorized by the publisher defendants--of the disputed periodicals. (Pl.s' Memo. Supp. Mot. Summ. J. at 16, n. 15; Pl.s' Memo. Opp. Def.s' Cross-Mot. Summ. J. at 19-23.)

Plaintiffs arrive at their understanding of the term "privileges" by juxtaposing Section 201(c) with Section 201(d). The first clause of the latter section provides that "[t]he ownership of a copyright may be transferred in whole or in part by any means of conveyance or by operation of law" 17 U.S.C. § 201(d)(1). According to Section 201(d)(2):

Any of the exclusive rights comprised in a copyright, including any subdivision of any of the rights specified by section 106, may be transferred as provided by clause (1) and owned separately. The owner of any particular exclusive right is entitled, to the extent of that right, to all of the protection and remedies accorded to the copyright owner by this title.

In plaintiffs' view, the fact that Section 201(d)(2) provides for the transfer of "rights" can only be taken to mean that the "privileges" identified in the preceding section of the Act are nontransferable. This approach distorts the relationship between Section 201(c) and Section 201(d).

Section 201(d)(2) does not speak only of "rights," but also of any "subdivision" of rights. The potential for such a subdivision of rights is created in the preceding section, 201(d)(1), which permits the transfer of copyright, "in whole or in part," either by conveyance or by "operation of law." This recognition of the potential for a partial transfer of copyright "by operation of law" follows from the fact that exactly such a transfer is effected in the preceding Section of the Act, Section 201(c), which extends certain enumerated "privileges" to publishers. In other words, the three provisions operate in tandem: Section 201(c) transfers plaintiffs' copyrights, "in part," to defendants--a permissible exercise under Section 201(d)(1)--and

therefore, under Section 201(d)(2), defendants are left with full authority over the "subdivision" of rights they acquire.

When Sections 201(c) and 201(d) are placed into historical context, the weakness in plaintiffs' position is all the more apparent. The 1976 Act, in significant part, amounts to a repudiation of the concept of copyright indivisibility, a principle pursuant to which the assorted rights comprising a copyright could not be assigned in parts, *i.e.* subdivided. *See* Nimmer, § 10.01 [A], at 10-5. Under this former regime, individual authors were at risk of inadvertently surrendering all rights in a contribution to a collective work either to the publisher of that work, or to the public. *Id.* Under Sections 201(c) and (d) of the 1976 Act, that threat is gone. Authors are no longer at risk of losing all rights in their articles merely because they surrender a small "subdivision" of those rights--either by operation of Section 201(c) or by express transfer--to the publishers of collective works.

The aim of Section 201(c)--to avoid the "unfair[ness]" of indivisibility--would not be further served by equating "privileges" with nonexclusive licenses. H.R. Report No. 94-1476, at 122 (1976), U.S.Code Cong. & Admin.News 1976, p. 5738. As explained, Congress was not responding to any perceived problem associated with the ability of publishers to enlist the help of outside entities to produce versions of their collective works, but rather to the risk that publishers of collective works might usurp all rights in individual articles. It simply would not have advanced its goal for Congress to have constrained publishers in their efforts to generate and distribute their permitted revisions and reproductions. Such an approach would not prevent the exploitation of individual contributions, but would serve only to undermine the competing goal of ensuring that collective works be marketed and distributed *816 to the public. *See* H.R.Rep. No. 94-1476, at 122 (1976), U.S.Code Cong. & Admin.News 1976, p. 5738 (characterizing the Section 201(c) privileges extended to publishers an "essential counterpart" to the basic presumption favoring authors).

The term "privilege" is used in Section 201(c) to underscore that the creators of collective works have only limited rights in the individual contributions making up their collective works; the term does not indicate that the creators of collective works are limited in exercising those few rights, or

"privileges," that they possess. Thus, to the extent that the electronic reproductions qualify as revisions under Section 201(c), the defendant publishers were entitled to authorize the electronic defendants to create those revisions.

2. Reproductions, Revisions, and Computer Technology

Plaintiffs advance several arguments in support of their view that the framers of Section 201(c) intended to limit the creators of collective works to revising and reproducing their works in the same medium in which those collective works initially appeared. For the reasons discussed, however, the Court finds nothing in the terminology of Section 201(c), the relevant legislative history, or the nature of revisions generally which supports such an approach. (FN7)

a. Display Rights

Plaintiffs contend that the right to reproduce articles as part of a collective work, because it is unaccompanied by other key rights, necessarily precludes the use of computer technologies. Plaintiffs refer to Section 106 of the 1976 Act, which lists the five exclusive rights, *i.e.*, the "bundle" of rights, constituting a copyright. The "reproduction" privilege identified under Section 201(c), as plaintiffs note, invokes the first of these rights--the right "to reproduce the copyrighted work in copies or phonorecords." *See* 17 U.S.C. § 106(1). Section 201(c) does not, however, implicate the distinct right, under Section 106, to "display the copyrighted work publicly." *Id.* at § 106(5). In plaintiffs' view, this absence of any express grant of "display" rights is fatal to defendants' position because a work cannot be reproduced electronically unless it is "displayed" on a computer screen.

By focusing upon the "display" rights that are not granted under Section 201(c), plaintiffs fail to account fully for the "reproduction" rights that are extended to the owners of copyright in collective works. Although "reproduction" is not defined separately under the Act, Section 106 reveals--predictably enough--that reproductions result in "copies." As defendants emphasize, this is a term with a broad and forward looking definition:

'Copies' are material objects, other than phonorecords, in which a work is fixed by any

method now known or later developed, and from which the work can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device ...

17 U.S.C. § 101 (emphasis added). Thus, the right to reproduce a work, which necessarily encompasses the right to create copies of that work, presupposes that such copies might be "perceived" from a computer terminal. (FN8)

*817 Plaintiffs argue that the legislative history precludes the Court from reading "display" rights into Section 201(c). As plaintiffs point out, early draft versions of Section 201(c) extended the "privilege to publish"--instead of the privilege to "reproduce" and "distribute"--individual contributions in subsequent versions of a collective work. (Pl.s' Memo. Opp. Def. s' Mot. Summ. J. at 22, n. 37.) " 'Publication' is the distribution of copies ... of a work to the public." 17 U.S.C. § 101. More importantly, for plaintiffs' purposes, "publication" contemplates the public distribution of a work "for purposes of further distribution, public performance, or public *display*" *Id.* (emphasis added). The absence of the term "publish" from the final version of Section 201(c), according to plaintiffs, must therefore be taken to indicate the absence of any such display rights.

The problem with plaintiffs' argument is that it rests on the unfounded assumption that the replacement of the term "publish" in Section 201(c) necessarily amounted to a rejection not only of that term, but also of the rights it connotes. There is no hint in the pertinent legislative history, however, that Congress settled upon its "reproducing and distributing" language for purpose of diminishing the publication rights initially envisioned for the creators of collective works. To the contrary, it appears that the "reproducing and distributing" language--a seeming paraphrase of the "distribution of copies" language the Act uses to define "publication"--was meant to secure precisely those rights. Indeed, the House Report explicitly equates the privilege of "reproducing and distributing" a contribution as part of a "particular collective work" with the "privilege of *republishing* the contribution under certain limited circumstances." H.R. Report No. 94-1476, at 122 (1976), U.S.Code Cong. & Admin.News 1976, p. 5738 (emphasis added).

[9] In sum, both the terms of the 1976 Act, and the

pertinent legislative history, reveal a design to extend display rights, in "certain limited circumstances," to the creators of collective works. Thus, so long as defendants are operating within the scope of their privilege to "reproduce" and "distribute" plaintiffs' articles in "revised" versions of defendants' collective works, any incidental display of those individual contributions is permissible.

b. The Updated Encyclopedia

Plaintiffs' narrow reading of defendants' reproduction and revision rights is informed not only by the absence of any "display" rights under Section 201(c), but also by the examples of revisions included in the pertinent legislative history. In particular, plaintiffs rely upon the following passage of the House Report accompanying Section 201(c):

Under the language of this clause a publishing company could reprint a contribution from one issue in a later issue of its magazine, and could reprint an article from a 1980 edition of an encyclopedia in a 1990 revision of it; the publisher could not revise the contribution itself or include it in a new anthology or an entirely different magazine or other collective work.

H.R. Report No. 94-1476, at 122-23 (1976), U.S.Code Cong. & Admin.News 1976, p. 5738. To plaintiffs, the modest reach of the encyclopedia example suggests a narrow scope to the term revision, one not contemplating new technologies or significant alterations of format and organization.

For several reasons, plaintiffs are mistaken to approach the encyclopedia example as the outer boundary of permissible revision. Foremost, the language of Section 201(c) does not support the sort of media restriction that plaintiffs infer from the legislative history. *Cf. Demarest v. Manspeaker*, 498 U.S. 184, 190, 111 S.Ct. 599, 604, 112 L.Ed.2d 608 (1991) ("When we find the terms of a statute unambiguous, judicial inquiry is complete except in rare and exceptional circumstances."). Indeed, Section 201(c) contains no express limitation upon the medium in which a revision can be created. To the contrary, "any revision" of a collective work is permissible, *818 provided it is a revision of "that collective work." (FN9)

Plaintiffs attribute the absence of any express prohibition on electronic revisions to the fact that

electronic data bases were not a part of the "Congressional consciousness" at the time that Section 201(c) was drafted. (Pl.s' Memo. Supp. Summ. J. at 41.) It is more accurate to say that Congress was aware of such technologies, but did not fully understand their implications. *See* Arthur R. Miller, *Copyright Protection For Computer Programs, Databases, And Computer Generated Works: Is Anything New Since CONTU?*, 106 Harv. L.Rev. 977, 979 (1993). Recognizing its ignorance in such matters, Congress expressly declined--as of the time it passed the 1976 Act--to settle the copyright implications of "automatic systems capable of storing, processing, retrieving, or transferring information ..." 17 U.S.C. § 117 (repealed by Computer Software Protection Act, Pub.L. No. 96-517, § 117, 94 Stat. 3015, 3028 (1980)). Congress determined that such developing computer technologies required continued investigation, and organized a study of the matter by the National Commission on New Technological Uses of Copyrighted Works (CONTU). H.R.Rep. No. 1476, 94th Cong., 2d Sess. 116 (1976). In 1980, after CONTU determined that the 1976 legislation would afford "the desired substantive legal protection for copyrighted works which exist in machine readable form," Congress repealed the original Section 117. *Id.* at 40. Plaintiffs invoke this history, particularly the initial reluctance of Congress to delve into the realm of computer technologies, as evidence that Section 201(c) was not intended to vest defendants with electronic rights in their collective works.

The legislative history that plaintiffs describe undercuts their argument more than it advances it. The fact that Congress initially saw the need to pass Section 117 is strong indication that, in the absence of such an explicit limitation, it is to be presumed that the terms of the 1976 Act encompass all variety of developing technologies. With the repeal of Section 117, this presumption is restored with respect to computers. Thus, there is no remaining reason to foreclose the possibility of an electronic "revision" of a collective work.

As defendants emphasize, the 1976 Act was plainly crafted with the goal of media neutrality in mind. *See* Register's Report on the General Revision of the U.S. Copyright Law, included in Nimmer at Volume 5, Appendix 14 at 14-8 ("technical advances have brought in new industries and new methods for the reproduction and

dissemination of the ... works that comprise the subject matter of copyright.... In many respects, the [1909 Act] is uncertain, inconsistent, or inadequate in its application to present-day conditions."); *see also* Copyright Law Revision: Hearing on H.R. 4347, 5680, 6831, 6835 Before Subcommittee No. 3 of the House Committee on the Judiciary, 89th Cong., 1st Sess. 57 (1965) (testimony of George D. Cary, Deputy Register of Copyrights: "We have tried to phrase the broad rights granted in such a way that they can be adapted as time goes on to each of new advancing media."). Key terms of the Act are defined to accommodate developing technologies. *See, e.g.*, 17 U.S.C. § 101 (defining "copies" in terms of "any method now known or later developed"; defining "literary works" as works "expressed in words, numbers, or other verbal or numerical symbols or indicia, regardless of the nature of the material objects, such as books, periodicals, manuscripts, phonorecords, film, tapes, disks, or cards, in which they are embodied."). Equally telling, none of the provisions of the Act limit copyright protection to existing technologies. The unusual exception of the original Section 117 only demonstrates that Congress took steps to ensure that its media neutral approach could effectively accommodate developing technologies before ultimately determining that the terms of the 1976 Act were fully equipped for the task.

In sum, it is unwarranted simply to assume--on the basis of one example provided *819 in the legislative history of Section 201(c)--that Congress intended for the terms "reproduction" and "revision" to announce a radical departure from the media neutrality otherwise characterizing the Copyright Act of 1976.

c. A "Plain Reading" of the Term Revision

Throughout their pleadings, plaintiffs seemingly presume that a "revision," by its plain meaning, must be nearly identical to an original. Particularly in the context of the Copyright Act of 1976, this is not so obvious. Conceived as a "revision" of the 1909 Act, the 1976 Act thoroughly changed the face of copyright law in the United States. *See* Barbara Ringer, *First Thoughts On The Copyright Act Of 1976*, 22 N.Y.L. Sch. L.Rev. 477, 479 (1977).

At a bare minimum, the Copyright Act contemplates that a "revision" can alter a preexisting work by a sufficient degree to give rise to a new

original creation. *See* 17 U.S.C. § 101. Indeed, a "derivative work," which is itself an "original work of authorship," can be created by means of "editorial revisions" to a preexisting work. *Id.* Thus, even the revised encyclopedia might differ from its predecessor edition by a "substantial, and not merely trivial" degree. *See Eden Toys, Inc. v. Florelee Undergarment Co., Inc.*, 697 F.2d 27, 34 (2d Cir.1982). If "editorial revisions" can transform a work to this extent, the broader "any revisions" language of Section 201(c) suggests the promise of even greater change. (FN10)

[10] The structure and language of Section 201(c) confirm that the parameters of a permissible revision are broader than plaintiffs suppose. Section 201(c) authorizes publishers to "reproduce" an individual contribution "as part of ... any revision" of the collective work in which it initially appeared. By allowing only "reproductions" of individual contributions, and not revisions of those contributions, Congress plainly intended to prevent publishers from reshaping or altering the content of individual articles. With this limitation in place, Congress apparently was willing to permit publishers significant leeway, *i.e.*, the leeway to create "any revision" of their collective works.

The legislative history is consistent with this construction of Section 201(c). An early draft version of the provision permitted publishers to reproduce an individual contribution to a collective work "as part of that particular collective work and any revisions of it." Harriet Pilpel, a prominent author representative, expressed the following concern related to this language:

I have but one question with reference to the wording, and that is with respect to the wording at the end of subsection (c): "... and any revisions of it." If that means 'any revision of the collective work' in terms of changing the contributions, or their order, or including different contributions, obviously the magazine writers and photographers would not object. But there is an implication, or at least an ambiguity, that somehow the owner of the collective work has a right to make revisions in the contributions to the collective work. This is not and should not be the law, and consequently I suggest that the wording at the end of subsection (c) be changed to make that absolutely clear.

1964 Revision Bill with Discussions and Comments, 89th Cong., 1st Sess., Copyright Law

Revision, Part 5, at 9 (H. Comm. Print 1965). In other words, authors were comfortable permitting publishers broad discretion in revising their collective works, provided that individual articles would remain intact. Section 201(c) was modified to accommodate *820 these narrow concerns, and it now clarifies that a publisher is not permitted to revise an original contribution to a collective work, but is permitted to reproduce that contribution "as part of ... any revision" of "that collective work" in which it initially appeared.

In sum, Section 201(c) does not impose any significant limitations upon publishers through the use of such terms as "privilege," "reproducing," or "any revision." A privilege is transferrable; a reproduction can occur in any medium; and "any revision" might include a major revision. The key limitation imposed upon publishers under Section 201(c) rests in the fact that publishers are permitted only to reproduce a particular plaintiff's article "as part of" a revised version of "that collective work" in which the article originally appeared.

3. Revising "That Collective Work"

Although the "any revision" language of Section 201(c) is broad, a new work must be recognizable as a version of a preexisting collective work if it is to be fairly characterized a revision of "that collective work." 17 U.S.C. § 201(c). Considering that defendants are prohibited from changing the content of plaintiffs' individual articles, this gives rise to something which, at first blush, might seem puzzling: how can a particular collective work, one made up entirely of separate contributions, be revised without making changes to those contributions? The resolution of this question rests in the fact that collective works, even to the extent that they consist entirely of individual original contributions, possess distinguishing original characteristics of their own-- *i.e.*, they are greater than the sum of their parts. It is therefore possible to revise a collective work by changing the original whole of that work without altering the content of the individual contributions to that work. (FN11)

In order to identify the original characteristics of a collective work, it is useful to recognize that collective works are a form of compilation. "A compilation is a work formed by the collection and assembling of preexisting materials or of data that are selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes an

original work of authorship." 17 U.S.C. § 101. "Many compilations consist of nothing but raw data--*i.e.*, wholly factual information not accompanied by any original written expression." *Feist Publications, Inc. v. Rural Telephone Service Co.*, 499 U.S. 340, 345, 111 S.Ct. 1282, 1287, 113 L.Ed.2d 358 (1991). Collective works are a unique form of compilation only because they are not made up of facts, but of "separate and independent works" protected as the original contributions of individual authors. 17 U.S.C. § 101.

[11][12] Because it is a "bedrock principle of copyright" that no author may possess a copyright in facts, the Supreme Court has struggled to identify those aspects of factual compilations that might reflect the original contribution of the copyright holders in such works. *See Feist*, 499 U.S. 340, 111 S.Ct. 1282. Ultimately, the *Feist* Court determined that "[t]he only conceivable expression is the manner in which the compiler has selected and arranged the facts." *Id.* at 349, 111 S.Ct. at 1289. Because the creator of a collective work, like the creator of any compilation, has no rights in the component parts of his or her work, this same formulation applies. In other words, the creators of collective works are entitled to rights in those works only to the extent that they have demonstrated creativity in selecting and arranging preexisting materials into an original collective whole. *See* H.R. Report No. 94-1476, at 122, U.S.Code Cong. & Admin.News 1976, p. 5738 (explaining that publishers' "exclusive rights" extend "to the elements of compilation and editing that went into the collective work as a whole ..."). It is this original contribution which gives a collective *821 work its unique character, *i.e.*, which makes it identifiable as "that collective work."

Because compilations, and collective works, are characterized by the fact that they possess relatively little originality, defendants must walk a fine line in their efforts to revise their collective works. Defendants are not permitted to place plaintiffs' articles into "new anthologies" or "entirely different magazine[s] or other collective work[s]," but only into revisions of those collective works in which plaintiffs' articles first appeared. *See* H.R. Report No. 94-1476, at 122-23 (1976), U.S.Code Cong. & Admin.News 1976, p. 5738; *see also Quinto v. Legal Times of Washington, Inc.*, 506 F.Supp. 554 (D.D.C.1981) (holding that law school newspaper could not authorize a separate District of Columbia

different editors and different periodicals undoubtedly perform with varying degrees of success.

The defendant publishers' protected original selection of articles, a defining element of their periodicals, is preserved electronically. Articles appear in the disputed data bases solely because the defendant publishers earlier made the editorial determination that those articles would appeal to readers. (FN13) As a result, the disputed technologies copy far more than a "certain percentage" of the articles selected by the publisher defendants. *See Worth*, 827 F.2d at 573; *see also Kregos*, 937 F.2d at 710. Those technologies copy all of the articles which are selected to appear in each daily or weekly issue of *The New York Times* or *Newsday* or *Sports Illustrated*.

Although they recognize that the complete content of all of the articles from each disputed periodical are available electronically, plaintiffs point out that those articles are stored alongside almost countless other articles *824 that appeared in other issues of other periodicals. This immersion into a larger data base does not automatically mean, however, that the defendant publishers' protected original selection is lost. *See CCC*, 44 F.3d at 68 n. 8 ("The district court also believed that CCC did not infringe Red Book's original protected elements because CCC included Red Book's selection in a more extensive data base. We disagree."). Indeed, the electronic defendants avoid this risk by taking numerous steps to highlight the connection between plaintiffs' articles and the hard copy periodicals in which they first appeared. For instance, users access plaintiffs' articles through data bases consisting only of those articles printed in a particular identified periodical, or particular periodicals. More importantly, once an article is selected for review, that article is identified not only by author, but by the publication, issue, and page number in which it appeared. Thus, the electronic technologies not only copy the publisher defendants' complete original "selection" of articles, they tag those articles in such a way that the publisher defendants' original selection remains evident online. (FN14)

2. Aspects Of Defendants' Periodicals Not Preserved Electronically

According to plaintiffs, the electronic reproductions cannot reasonably be considered revisions of the publisher defendants' periodicals

because significant elements of each disputed periodical are not preserved electronically. Put differently, plaintiffs object to the Court's approach because it focuses upon that which is retained electronically, as opposed to that which is lost. Most notably, aside from the image-based CD-ROM, the disputed technologies do not reproduce the photographs, captions, and page lay-out of the defendant publications. With these significant differences between the technological reproductions and the defendant publications, plaintiffs' position has a certain appeal. There is no avoiding that much of what is original about the disputed publications is not evident online or on disc. Ultimately, however, these changes to the defendant publishers' hard copy periodicals are of only peripheral concern to the "revision" analysis.

By its very nature, a "revision" is necessarily a changed version of the work that preceded it. As already explained, (Section III.B.2.c., *supra*), Section 201(c) permits even major changes to collective works. The framers of that provision sought to avoid the exploitation of individual articles, and did not intend to prevent publishers from reworking their collective works in significant ways. In order to permit such reworking, while at the same time preventing changes to the substance of individual articles, Congress determined that publishers would have the leeway to preserve certain original aspects of their creations while discarding others. In the words of Section 201(c), Congress determined that publishers would be permitted to create "any revision" of their collective works. The critical question for the Court, then, is not whether the electronic reproductions are different from the publisher defendants' collective works; it is inevitable that a revision will be different from the work upon which it is based. The question for the Court is whether the electronic reproductions retain enough of defendants' periodicals to be recognizable as versions of those periodicals.

Because a collective work typically possesses originality only in its selection and arrangement of materials, it is to be expected that, in a revised version of such a work, *825 either the selection or arrangement will be changed or perhaps even lost. This is precisely what has happened here. Lacking the photographs and page lay out of the disputed periodicals, NEXIS and "The New York Times OnDisc" plainly fail to reproduce the original arrangement of materials included in the publisher defendants' periodicals. By retaining the publisher

defendants' original selection of articles, however, the electronic defendants have managed to retain one of the few defining original elements of the publishers' collective works. In other words, NEXIS and UMI's CD-ROMs carry recognizable versions of the publisher defendants' newspapers and magazines. For the purposes of Section 201(c), then, defendants have succeeded at creating "any revision[s]" of those collective works.

[16] The Court finds further support for its holding in the language of those compilation infringement cases that have already informed so much of the analysis in this decision. In particular, a work that copies *either* the original selection or the original arrangement of a protected compilation is "substantially similar" to that compilation for copyright purposes. *See Key*, 945 F.2d at 514 ("If the Galore Directory is substantially similar to the 1989-90 Key directory with regard to that arrangement of categories or that selection of businesses, then a finding of infringement can be supported.") (emphasis added). In other words, where a compilation possesses both an original arrangement and an original selection, a substantial similarity persists even where the original arrangement is sacrificed. *Id.* Thus, because the electronic data bases preserve defendants' original selection of articles, those data bases are "substantially similar," as a matter of law, to defendants' periodicals. (FN15)

By invoking the "substantial similarity" test of the compilation infringement cases, the Court does not mean to declare a fixed rule by which a revision of a particular collective work is created any time an original selection or arrangement is preserved in a subsequent creation. In certain circumstances, it is possible that the resulting work might be so different in character from "that collective work" which preceded it that it cannot fairly be deemed a revision. The Court need not speculate or hypothesize as to this possibility, however, because the electronic reproductions do more than merely preserve a defining element of the publishers' collective works. Those technologies preserve that element within electronic systems which permit users to consult defendants' periodicals in new ways and with new efficiency, but for the same purposes that they might otherwise review the hard copy versions of those periodicals. Indeed, in the broadest sense, NEXIS and CD-ROMs serve the same basic function as newspapers and magazines; they are all sources of information on the assorted

topics selected by those editors working for the publisher defendants. (FN16)

*826 In sum, if NEXIS was produced without the permission of The New York Times or Newsday or Time, these publishers would have valid claims of copyright infringement against MEAD. If "General Periodicals OnDisc" or "The New York Times OnDisc" was produced without the permission of The New York Times, that publisher would have a valid claim of infringement against UMI. In other words, absent a consideration such as fair use, the defendant publishers would be able to recover against the electronic defendants for creating unauthorized versions of their periodicals. *See* 17 U.S.C. § 107 (describing those circumstances in which the unauthorized creation of a substantially similar version of an original work is excused as "fair use"). The Court is unable to conclude that these electronic versions can be "substantially similar" to defendants' collective works for some purposes, without at least qualifying as "any revision[s]" of those works for present purposes. 17 U.S.C. § 201(c). This is particularly so in light of the fact that these technologies preserve this substantial similarity while retaining the basic character of the publisher defendants' periodicals. (FN17)

3. Section 201(c) And The Rights Of Authors

Plaintiffs are adamant that a ruling for defendants in this case leaves freelance authors without any significant protection under the 1976 Act. This result, according to plaintiffs, cannot be reconciled with the fact that the passage of Section 201(c)--and the dismantling of indivisibility--represented an important victory for individual authors.

As an initial matter, plaintiffs exaggerate the repercussions of this decision. The electronic data bases retain a significant creative element of the publisher defendants' collective works. In numerous other conceivable circumstances, Section 201(c) would apply to prevent the exploitation, by publishers, of individual articles. The New York Times, for instance, cannot sell a freelance article to be included in *Sports Illustrated*. *See Quinto*, 506 F.Supp. 554; *see also* H.R. Report No. 94-1476, at 122-23 (1976), U.S.Code Cong. & Admin.News 1976, p. 5738 ("the publisher could not revise the contribution itself or include it in a new anthology or

New York Times v. Tasini

Second Circuit brief:

**Brief for Plaintiffs-Appellants Garson and
Robbins**

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97-9181

97-9650(CON)

To be Argued by:
EMILY M. BASS, ESQ.

United States Court of Appeals
for the
Second Circuit

JONATHAN TASINI, BARBARA BELEJACK, MARY KAY BLAKELY,
BARBARA GARSON, DANIEL LAZARE, MARGOT MIFFLIN,
JOAN OLECK, SONIA JAFFE ROBBINS, LINDSY VAN GLEDER and
DAVID S. WHITFORD,

Plaintiffs-Appellants.

– against –

THE NEW YORK TIMES COMPANY, INC., NEWSDAY, INC., THE TIME
INCORPORATED MAGAZINE COMPANY, MEAD DATA CENTRAL
CORP., UNIVERSITY MICROFILMS INTERNATIONAL and
THE ATLANTIC MONTHLY COMPANY,

Defendants-Appellees.

ON APPEAL FROM THE UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF NEW YORK

BRIEF FOR PLAINTIFFS-APPELLANTS
BARBARA GARSON and SONIA JAFFE ROBBINS

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2/3/98

In the final analysis, plaintiffs' argument on the § 201(c) claims is essentially the same as the argument that was made in Quinto v. Legal Times of Washington, Inc., 506 F.Supp. 554 (D.D.C. 1981) and Wolff v. Institute of Electrical and Electronics Engineers, Inc., 768 F.Supp. 66 (SDNY 1991): defendants hold only the copyright in the collective work they created and cannot exercise the copyright in a freelance writer's contribution.¹² This means that they can't authorize their distribution either as independent articles or as part of new anthologies or collective works or convey an ownership interest to third parties.

The Court below did not so much reject the first two of these three arguments as avoid them. It held that even if an article is reproduced and distributed on a stand-alone basis or as part of a new and different anthology or collection of articles,¹³ it is still, somehow, "part" of the collective work in which it originally appeared or a "revised version" of that collective work. The Court justified this holding on the grounds that:

(a) a citation is displayed with each article that is retrieved from the NEXIS database that indicates the title and date of the periodical issue in which the article originally appeared, and that

(b) since all of the other articles that originally appeared together with the retrieved article in that periodical issue are also "present" in the database, they could, theoretically, also be retrieved.

¹² The term "contributions" is used in the section to mean freelance works--such as an article or photograph--contributed to an issue of a periodical.

¹³ An "anthology" is a "collection of literary pieces of varied authorship." The American College Dictionary (Random House, Inc. 1964) at p. 52; see also The New Columbia Encyclopedia (4th Ed., Columbia University Press, 1975) at p. 116.

The fact that the District Court's assumptions don't justify its conclusion becomes readily apparent when one considers the following scenario: Assume that, after receiving an issue of Newsday for Tuesday, February 3, 1998, the proprietor of a newsstand

- 1) xeroxes several copies of it,
- 2) cuts each copy up into bits and pieces - with each piece containing no more than one article, one photograph, one cartoon frame, one chart, one editorial, one map, one advertisement, one letter-to-the-editor, etc.,
- 3) and stockpiles the bits and pieces at his newsstand.

Assume, further, that at all times he has at least one copy of each and every component of that evening's paper on hand in his stall.

A customer comes by at 6:35 p.m. and says: "I don't really have time to read tonight's paper, I just want to know what the latest is on the sex scandal out of Washington." The newsstand proprietor hands him one photograph or one news story. Has the customer received a complete "issue" of that day's Newsday? Has he received something substantially equivalent or similar?

Does the fact that all of the other elements of the paper are still at the newsstand or in the hawker's bag mean that the passerby has been given anything more than an individual article from a newspaper? That he or she has been given an original or revised issue of a newspaper? Obviously not. Does making a freelance article available in this fashion, by itself, violate the freelancer's rights? Obviously.

Now assume one further fact: i.e., that just as the proprietor of the newsstand hands a customer a one-article bit or piece, he stamps it with one or another of the following two legends: "Appeared in the February 3, 1998 issue of Newsday," or "Source: Newsday, February 3, 1998."

Does this change matters? Does the customer who walks away with an article carrying that citation get a complete "issue" of that day's Newsday? Has he received something substantially equivalent or similar to that collective work? Again, obviously not.

Assume still a few further facts: that the proprietor of our newsstand has been following this same procedure each day for the past twenty-one years, copying and cutting up hundreds of thousands of issues of different periodicals. By this point, he has amassed a stockpile of at least 322 million one-article or one-photograph bits and pieces. Not only are they in no particular order, but neither can it be determined how any of the articles relate to each other by looking at them as *they lie in the stockpile*.¹⁴

Can the newsstand proprietor's stockpile be said to represent a single issue of Newsday? The February 3, 1998 issue of Newsday? A revision of *that* issue? A later collective work in the same series? Again, obviously not.

¹⁴ You will recall that we assumed earlier in the scenario that the newsstand proprietor stamps a bit or piece *just as* he is handing it to a customer. Before being handed out, i.e., while the piece remains in the stockpile, it doesn't bear a citation or legend. (See, Statement of Facts, ante at p.10 n.7).

Finally, assume that when a customer comes by, the newsstand proprietor hands him a stack of page-images that hail from many different periodicals.

Has the customer received a complete issue of Newsday or any other collective work whose parts have made their way into the stockpile? Something substantially equivalent or similar to an issue of Newsday?

The answers, of course, are "no" and "no." What the customer has been given is a new anthology or compilation of materials from different periodicals, and not anything that would be recognizable by anyone as an issue of the original collective work.

ARGUMENT

I. THE MEANING OF SECTION 201(c).

This Court may review the issues presented in this appeal *de novo*. This is a case of first impression. Fonar Corp. v. Domenick, et al., 105 F.3d 99, 102 (2d Cir. 1997)

A. The Court's Construction: A Focus Limited To The Two Words "Any Revision."

When a statute sets forth exceptions to a general rule, the exceptions are to be narrowly construed.¹⁵ See e.g., Commissioner v. Clark, 489 U.S. 726(1989) (it is standard to read statutory exceptions narrowly in order to "preserve the primary operation of the general

¹⁵ The one who claims the benefit of the exception has the burden of proving that his, her or its claim comes within it. See generally Sutherland, Statutes and Statutory Construction § 47.11 (4th ed. 1984).

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Second Circuit brief:

Brief for Defendants-Appellees

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97-9181(L), 97-9650(CON)

To Be Argued By
BRUCE P. KELLER

United States Court of Appeals
for the
Second Circuit

JONATHAN TASINI, MARY KAY BLAKELY, BARBARA GARSON,
MARGOT MIFFLIN, SONIA JAFFE ROBBINS and DAVID S. WHITEFORD,

Plaintiffs-Appellants,

BARBARA BELEJACK, DANIEL LAZARE, JOAN OLECK and
LINDSY VAN GELDER,

Plaintiffs,

THE NEW YORK TIMES COMPANY, INC.; NEWSDAY, INC.;
THE TIME INCORPORATED MAGAZINE COMPANY; MEAD DATA
CENTRAL CORP. and UNIVERSITY MICROFILMS INTERNATIONAL,

Defendants-Appellees,

THE ATLANTIC MONTHLY COMPANY,

Defendant,

AMERICAN SOCIETY OF MEDIA PHOTOGRAPHERS, INC., ET AL.

Amicus Curiae

ON APPEAL FROM THE UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF NEW YORK

BRIEF FOR DEFENDANTS-APPELLEES

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Copyright Act as distinct from "rights" by making the former non-licensable. It is, therefore, impossible to conclude that a copyright privilege that plainly is licensable under Section 203(b) becomes non-licensable in Section 201(c). See Mills Music, 469 U.S. at 165 n.31 ("legislative body generally uses a particular word with a consistent meaning in a given context") (citation omitted).

III. APPELLANTS' "ANTHOLOGY" ARGUMENTS ARE INCORRECT.

The argument pressed most vigorously by Appellants and their amici is that Appellees have reproduced and distributed their contributions not as part of "that particular collective work," "any revision" of the collective work, or any "later collective work in the same series," but as part of a completely different work. Although each makes the argument in its own way, all contend that the copies of the periodicals included in the NEXIS library and the CD-ROMs at issue are not authorized under Section 201(c) because the NEXIS library and CD-ROMs constitute completely different works, in which the contents

of each collective work are "commingled into vast repositories of articles." (Tasini Br. at 18.)⁴¹

This argument mischaracterizes the digital copies in dispute and fails for three reasons: First, it is completely at odds with the undisputed facts as to how the electronic copies of the periodicals in dispute are placed into the NEXIS library and onto UMI's CD-ROMs. Second, by directly attacking the inherent characteristics of copies reproduced in a digital medium, it cannot be reconciled with either the plain language of the Act authorizing such copies or the legislative history recognizing that machine readable copies in databases are covered by the Act. Third, it obliterates the distinction between the copyright of a freelance author, which is limited to his or her own contribution itself, and the copyright of the owner of the entire collective work that entitles it to disseminate its work.

41. See also Garson Br. at 43-60; ASMP Br. at 14-17.

A. The Undisputed Facts Show That NEXIS And UMI's CD-ROMs Are The Electronic Equivalent Of Microfilm.

None of Appellants' contributions were added to the NEXIS library and CD-ROMs in dispute on an article-by-article basis. Instead, they were added "as part of" entire digital copies of The New York Times, Newsday or Sports Illustrated. The undisputed facts established that NEXIS receives, on an issue-by-issue basis (daily for The New York Times and Newsday; weekly for Sports Illustrated), a copy of the same computer files the publishers use to create the print version of the periodicals. The same is true of the material delivered to UMI to assemble issues of The New York Times appearing on Times OnDisc CD-ROMs. Moreover, the General Periodicals OnDisc CD-ROMs are scanned directly from the paper issues of the periodicals, of which Appellants' contributions also are a "part." In all cases, copies are added on a periodical-by-periodical basis, not, as Appellants would have it, as a random transmission of individual articles. See supra pp. 7-9.

It is no surprise, therefore, that both the NEXIS computerized library and UMI's CD-ROMs are marketed in the

same way they are created: as repositories of complete periodicals. NEXIS, for instance, is described as "the world's most comprehensive collection," not of articles, but of "international, national and regional publications, such as The New York Times, Associated Press, Reuters, Financial Times (of London), Le Monde and the Financial Post, along with other trade publications, newspapers, [and] reference data" found in "hard copy libraries." (Bass. Aff. Ex. 49 at M003220.)⁴² Similarly, UMI markets General Periodicals OnDisc as featuring "cover-to-cover reproduction of approximately 200 of the most requested general-interest periodicals." (Bass Aff. Ex. 50 at U001454.)

Notwithstanding these undisputed facts, Appellants claim that the paper copies of the original periodicals have been deconstructed into "single articles" (Garson Br. at 24, 39), leaving no "vestiges" of them in the digital versions. (Tasini Br. at 19.) That is false. As even Appellants are forced to admit, the record shows that "[a]ll of the

42. "Bass. Aff." cites refer to exhibits to the Bass Affidavit, originally submitted in support of plaintiffs' motion for summary judgment and part of the record below.

articles that appeared in each day's issue" are sent to NEXIS (JA 413-414, Garson Br. at 8), that all the articles are identified by "the page, section and date of the issue" (JA 393-95, Garson Br. at 9), and that the entire textual contents can be retrieved on an issue-by-issue basis. (JA 393-95, 452, Tasini Br. at 8.)⁴³

This undisputed record led the District Court to conclude that Appellants' contributions are presented as part of "a particular identified periodical, or . . . periodicals" (JA 453), just as is true, for example, of microfilm or hard copies stored on the shelves of library stacks.⁴⁴ There simply is no factual support for

43. The only differences Appellants can identify are those necessitated by the change in medium, e.g., replacement of typesetting commands with electronic markers (Garson Br. at 9), loss of the original layout, columnization and page-breaks, if any (Tasini Br. at 19), and the omission of certain print-specific visuals such as ads, charts and photographs. (*Id.*)

44. The District Court also correctly found that Appellees' periodicals retain and make evident, through "numerous steps," all of each publisher's "complete original 'selection' of articles," thus qualifying them as revised copies within the scope of Section 201(c). This "selection alone reflects sufficient originality to merit copyright protection." (JA 451-453.) The Act
(continued...)

Appellants' argument that the immersion of copies of a periodical into a larger database causes the original collective works to lose their identity such that they are no longer separately copyrighted works. (JA 446-47; Tasini Br. at 18-20.)⁴⁵

The District Court also rejected the argument that different works have been created because of the removal of photographs, paid death notices, column formats and other elements that are included in the collective work copyright that publishers (not freelancers) enjoy in their printed

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44. (...continued)
expressly provides protection for materials "that are **selected**, coordinated, or arranged [to] constitute[] an original work of authorship." 17 U.S.C. § 101.
45. Rejecting this point as inconsistent with the Act and the inherent nature of digital copies, the District Court emphasized, as Judge Leval did in CCC Info. Service Inc. v. Maclean Hunter Mkt. Reports, Inc., 44 F.3d 61, 68 n.8 (2d Cir. 1994), cert. denied, 516 U.S. 817 (1995), that copyrightable aspects of even a compilation, let alone a collective work, are retained when the selections of data comprising the compilation are "included" even without other identifying information, "in a more extensive data base." Here, because of the extensive efforts made to connect the digital copy to its print counterpart, those copyrightable editorial selections are even more apparent.

periodicals. After noting the breadth of the plain meaning of the "any revision" language and the context as to how such broad language was adopted (JA 442), the Court applied an even more rigorous standard to assess whether the electronic copies qualified as revisions: It analogized to the "substantial similarity" test used to determine copyright infringement. Using that approach, the Court found it undisputed that a "defining original characteristic" -- the "complete selection" of articles in each periodical -- survives in the electronic edition "in such a way as to preserve the 'basic character' of those periodicals." (JA 458, 480-81.)

Appellants attempt to divert attention from the periodicals themselves, and emphasize that any constituent article published in them can be read individually, without the rest of the collective work. Nothing in the record, however, indicates that, apart from articles accessed by Appellants themselves as part of this litigation, any third parties ever have independently accessed any of Appellants' "single articles." To the contrary, the record shows only that the databases at issue are used exactly as a researcher

would use the Reader's Guide to Periodical Literature ("Reader's Guide") -- i.e., to identify articles pertinent to his or her research and to access them on-line or on CD-ROM the same way they would be accessed from periodicals on shelves in a library's stacks. (JA 351, 481 n.6.) Because these electronic copies are accessed and used like print and microfilm and because the entire issue always is available, they are the electronic equivalent of microfilm. (JA 433-34 n.7.)⁴⁶

46. Appellants make numerous irrelevant arguments as to how their individual contributions might be accessed (Garson Br. at 8-11), but have introduced no evidence whatsoever to support them. Moreover, the status of a work under copyright law does not change depending on how it might be used. Even if Appellants' hypotheticals are intended to substitute for an unpled and unproven contributory infringement claim (because they never have alleged that the use of NEXIS or UMI CD-ROMs by third parties is infringing), that is yet another irrelevancy. Where, as here, the NEXIS library and UMI CD-ROM discs are "capable of substantial non-infringing uses," there can be no vicarious or contributory infringement based on possible improper uses by third parties. Sony Corp. of Am. v. Universal City Studios, Inc., 464 U.S. 417, 442 (1984) (emphasis added). The undisputed record shows not only that the entirety of a periodical's contents can be accessed using the NEXIS computerized library and UMI CD-ROM products, but also that these forms of electronic publication actually are used for, let alone capable

(continued...)

B. The "New Anthology" Analogy Is A Direct
Attack On Media-Neutrality.

The implications of Appellants' arguments are staggering. If adopted, all of the efforts undertaken in the past twenty years to create digital libraries and archives of collective works will be at risk because countless contributors to collective works suddenly will have infringement claims against publishers and libraries and archives. This result, a direct consequence of adopting Appellants' "new anthology" analogy, requires the unwarranted assumption that Congress intended to restrict periodicals and other collective works from being included in a larger database. (E.g., Tasini Br. at 15, Garson Br. at 36, 39-41, ASMP Br. at 6, 24-28.) The legislative history, however, conclusively disproves that assumption: those involved in drafting the Act, consistent with the media-neutral approach, were well aware of the vast storage capacity of the digital medium and analogized such digital copies, not to new anthologies, but to electronic libraries.

46. (...continued)
of, non-infringing purposes. (JA 344-45, 350-51.)

In fact, in 1975, as the Act was taking its final form, the Congressional committee that was drafting the Act received direct testimony confirming that computer databases would be used as vast libraries in which complete books and periodicals could be stored and accessed in exactly the way the NEXIS database and UMI CD-ROMs are used today. Hearings on H.R. 2223 at 338 (Add-47) (testimony of Paul G. Zurkowski, President, Information Industry Association) (under the Act, collective works such as encyclopedias and periodicals would be input, and through computer equivalents of the Reader's Guide, located to access individual contributions). See Hearings on H.R. 4347 at 68 (Add-34) (testimony of Lee Deighton, American Textbook Publishers Institute) (database is an "electronic information center" equivalent to "a duplicating rather than a circulating library").⁴⁷ See also Copyright Law Revision, Part 3, at

47. The ASMP brief argues that the decision below virtually destroys the subsequent licensing value of freelance contributions by making them "widely available to the public . . . without any payment." (ASMP Br. at 4.) The same argument can be made based on the wide availability of printed and microfilm periodicals available "to the public . . . without any payment" in public
(continued...)

418 (Add-21) (statement of George Schiffer, National Community Television Ass'n) (computer databases were "kinds of *libraries* as yet uninvented . . . when a manuscript will be fed into a computer and ordered as needed") (emphasis added).

Analogizing databases to libraries rather than "new anthologies" also is supported by the fundamental principle under the Act that there is no change in the copyright status of a work when converted to a digital medium.⁴⁸ It is for that reason that the Copyright Office

47. (...continued)
libraries. See supra p. 4. Far from violating any copyrights, such widespread availability is entirely consistent with the Act's "goal of ensuring that collective works be marketed and distributed to the public." (JA 433) (emphasis added). Moreover, in sharp contrast to ASMP's hypothetical concern, the record in this case is that not one Appellant could identify a single instance in which the availability of their contributions in digital copies or microfilm adversely affected their ability to resell their individual contribution. E.g., Ex. C-1 at 225-26 (Appellant Tasini was "[n]ot . . . aware of" any instance in which microfilm or electronic copies interfered with such "a sale"); see also Ex. C-2 at 81, Ex. C-3 at 125, Ex. C-4 at 96-97.

48. See supra pp. 20-26. The District Court adopted the same analogy. (JA 480-81 n.6.)

refuses to register automated databases "where the collection and arrangement" consists solely "of transferring data from hard copy to computer storage." Circular 65, Copyright Registration for Automated Databases 2 (U.S. Copyright Office 1992). In other words, the medium of a digital database is simply the container for content such as periodicals. Its physical or structural characteristics alone should not affect the substantive copyright status of the underlying collective work any more than does an entire year's worth of law reviews bound together in hard cover form and stored on a library shelf. Any other result would subvert the purpose of the Copyright Act's insistence on media-neutrality.⁴⁹

The degree to which Appellants' arguments compel results that are inexplicable under the literal terms of the Act and its legislative history is clear. By Appellants' reasoning, although Congress specifically intended, among

49. The ASMP actually makes this point when it pronounces that a bookshelf is not a revision simply because it holds one. (ASMP Br. at 3.) That is correct and under the Act, a CD-ROM containing many books is not a revision simply because it holds many.

other things, for a publisher of a volume of "a 1980 edition of an encyclopedia" to be able to "reprint an article" from that edition "in a 1990 revision," H.R. Rep. No. 1476 at 122 (Add-52), the same publisher could not, in order to make that encyclopedia easier to use, publish the revised 1990 copy on a CD-ROM with copies of other volumes comprising the rest of the encyclopedia. Such a revision would constitute a new and infringing collective work, by Appellants' reasoning, because the original contributions in each volume would have been "commingled" in the single CD-ROM. (Tasini Br. at 18.)⁵⁰

These results are inimical to the entire purpose of the Act: not to reward copyright owners as an end in

50. Given that in the nine years since the first CD-ROM encyclopedia appeared "it has become by far the dominant format and has made encyclopedias far more available," such a result is untenable. Matthew L. Wald, Reference Disks Speak Volumes, N.Y. Times, Feb. 26, 1998, at G12. Moreover, the risk to publishers and the public posed by Appellants' theories are far from theoretical. National Geographic already has been sued by freelance contributors for having reissued all of its prior paper copies on 30 CD-ROM discs entitled "The Complete National Geographic 108 Years of National Geographic Magazine on CD-ROM." See Faulkner v. National Geographic Soc'y, No. 97 Civ. 9361 (S.D.N.Y. filed Dec. 19, 1997).

New York Times v. Tasini
Second Circuit Decision:
206 F.3d 161 (2d Cir. 1999)
pp. 167-69 and n. 4

*161 206 F.3d 161

54 U.S.P.Q.2d 1032

United States Court of Appeals,
Second Circuit.

Jonathan TASINI; Mary Kay Blakely; Barbara Garson; Margot Mifflin; Sonia Jaffe Robbins and David S. Whitford, Plaintiffs-Appellants,
Barbara Belejack; Daniel Lazare; Joan Oleck and Lindsay Van Gelder, Plaintiffs,
v.
The NEW YORK TIMES COMPANY, INC.;
Newsday, Inc.; The Time
Incorporated Magazine Company; Mead Data
Central
Corp. and University Microfilms
International, Defendants-Appellees.
The Atlantic Monthly Company, Defendant.
Docket Nos. 97-9181, 97-9650
Argued April 26, 1999
Decided Sept. 24, 1999
Amended Feb. 25, 2000

Authors of articles previously published in periodicals brought copyright infringement action against publishers and owners of electronic databases after articles were made available on such databases. The United States District Court for the Southern District of New York, Sotomayor, J., 972 F.Supp. 804, entered summary judgment for defendants, and, 981 F.Supp. 841, denied authors' motion for reconsideration. Authors appealed. The Court of Appeals, Winter, Chief Judge, held that: (1) electronic and CD-ROM databases containing individual articles from multiple editions of periodicals did not constitute "revisions" of individual periodical issues, within meaning of Copyright Act provision governing collective works; (2) author that had express licensing agreement addressing republication rights with one publisher was not required to bring breach of contract claim; and (3) publisher was not entitled to relicense article of that author pursuant to express licensing agreement.

Reversed and remanded with instructions.

Opinion, 192 F.3d 356, withdrawn.

West Headnotes

[1] Copyrights and Intellectual Property Ⓒ53(1)
99 ----99I Copyrights
99I(J) Infringement
99I(J)1 What Constitutes Infringement
99k53 Acts Constituting Infringement
99k53(1) In General.

The unauthorized reproduction and distribution of a copyrighted work generally infringes the copyright unless such use is specifically protected by the Copyright Act. 17 U.S.C.A. § 101 et seq.

[2] Copyrights and Intellectual Property Ⓒ41(3)
99 ----99I Copyrights
99I(D) Ownership
99k41 Ownership
99k41(3) Joint Works;
Contributions to Collective Works.

[See headnote text below]

[2] Copyrights and Intellectual Property Ⓒ48
99 ----99I Copyrights
99I(E) Transfer
99k48 Licenses in
General.

Publishers of collective works are not permitted to include individually copyrighted articles without receiving a license or other express transfer of rights from the author, although there is statutory presumption that, when the author of an article gives the publisher the author's permission to include the article in a collective work, the author also gives a non-assignable, non-exclusive privilege to use the article as identified in the statute. 17 U.S.C.A. §§ 101, 103(b), 201(c).

[3] Copyrights and Intellectual Property Ⓒ41(3)
99 ----99I Copyrights
99I(D) Ownership
99k41 Ownership
99k41(3) Joint Works;
Contributions to Collective Works.

Electronic and CD-ROM databases containing individual articles from multiple editions of periodicals did not constitute "revisions" of individual periodical issues from which articles were taken, so publishers of periodicals could not relicense individual articles to databases, under

individual contribution to a collective work owns the copyright to that contribution, absent an express agreement setting other terms. *See id.* The rights of the author of a collective work are limited to "the material contributed by the [collective work] author" and do not include "any exclusive right in the preexisting material." 17 U.S.C. § 103(b). Moreover, the presumptive privilege granted to a collective-work author to use individually copyrighted contributions is limited to the reproduction and distribution of the individual contribution as part of: (i) "that particular [*i.e.*, the original] collective work"; (ii) "any revision of that collective work"; or (iii) "any later collective work in the same series." 17 U.S.C. § 201(c). Because it is undisputed that the electronic databases are neither the original collective work--the particular edition of the periodical--in which the Authors' articles were published nor a later collective work in the same series, appellees rely entirely on the argument that each database constitutes a "revision" of the particular collective work in which each Author's individual contribution first appeared. We reject that argument.

[3][4][5] We begin, as we must, with the language of the statute. *See Lewis v. United States*, 445 U.S. 55, 60, 100 S.Ct. 915, 63 L.Ed.2d 198 (1980). The parameters of Section 201(c) are set forth in the three clauses just noted. Under ordinary principles of statutory construction, the second clause must be read in the context of the first and third clauses. *See General Elec. Co. v. Occupational Safety & Health Review Comm'n*, 583 F.2d 61, 64-65 (2d Cir.1978) ("the meaning of one term may be determined by reference to the terms it is associated with" citing 2A Sutherland, *Statutory Construction* §§ 47.16 (*Noscitur a sociis*), 47.17 (*Ejusdem generis*) (4th ed.1973)); *see also Securities & Exch. Comm'n v. National Sec., Inc.*, 393 U.S. 453, 466, 89 S.Ct. 564, 21 L.Ed.2d 668 (1969) ("The meaning of particular phrases must be determined in context.") (citation omitted). The first clause sets the floor, so to speak, of the presumptive privilege: the collective-work author is permitted to reproduce and distribute individual contributions as part of "that particular collective work." In this context, "that particular collective work" means a specific edition or issue of a periodical. *See* 17 U.S.C. § 201(c). The second clause expands on this, to permit the reproduction and distribution of the individual contribution as part of a "revision" of "that collective work," *i.e.*, a revision of a

particular edition of a specific periodical. Finally, the third clause sets the outer limit or ceiling on what the Publisher may do; it permits the reproduction and distribution of the individual contribution as part of a "later collective work in the same series," such as a new edition of a dictionary or encyclopedia.

The most natural reading of the "revision" of "that collective work" clause is that Section 201(c) protects only later editions of a particular issue of a periodical, such as the final edition of a newspaper. Because later editions are not identical to earlier editions, use of the individual contributions in the later editions might not be protected under the preceding clause. Given the context provided by the surrounding clauses, this interpretation makes perfect sense. It protects the use of an individual contribution in a collective work that is somewhat altered from the original in which the copyrighted article was first published, but that is not in any ordinary sense of language a "later" work in the "same series."

In this regard, we note that the statutory definition of "collective work" lists as examples "a periodical issue, anthology, or encyclopedia." 17 U.S.C. § 101. The use of these particular kinds of collective works as examples supports our reading of the revision clause. Issues of periodicals, as noted, are often updated by revised editions, while anthologies and encyclopedias are altered every so often through the release of a new version, a "later collective work in the same series." Perhaps because the "same series" clause might be construed broadly, the House Report on the Act noted that the "revision" clause in Section 201(c) was not intended to permit the inclusion of previously published freelance contributions "in a new anthology or an entirely different magazine or other collective work," *i.e.*, in later collective works not in the same series. H.R.Rep. No. 94-1476, at 122-23 (1976), *reprinted in* 1976 U.S.C.A.A.N. 5659, 5738.

Moreover, Publishers' contention that the electronic databases are revised, digital copies of collective works cannot be squared with basic canons of statutory construction. First, if the contents of an electronic database are merely a "revision" of a particular "collective work," *e.g.*, the August 16, 1999 edition of *The New York Times*, then the third clause of Section 201(c)--permitting the reproduction and distribution of an individually copyrighted work as part of "a later

collective work in the same series"--would be superfluous. See *Regions Hosp. v. Shalala*, 522 U.S. 448, 118 S.Ct. 909, 920, 139 L.Ed.2d 895 (1998) (Scalia, J., dissenting) ("It is a cardinal rule of statutory construction that significance and effect shall, if possible, be accorded to every word. As early as in Bacon's Abridgment, sect. 2, it was said that 'a statute ought, upon the whole, to be so construed that, if it can be prevented, no clause, sentence, or word shall be superfluous, void, or insignificant.' ") (quoting *Washington Mkt. Co. v. Hoffman*, 101 U.S. 112, 115-16, 25 L.Ed. 782 (1879)). An electronic database can contain hundreds or thousands of editions of hundreds or thousands of periodicals, including newspapers, magazines, anthologies, and encyclopedias. To view the contents of databases as revisions would eliminate any need for a privilege for "a later collective work in the same series."

*168 Second, the permitted uses set forth in Section 201(c) are an exception to the general rule that copyright vests initially in the author of the individual contribution. Reading "revision of that collective work" as broadly as appellees suggest would cause the exception to swallow the rule. See *Commissioner v. Clark*, 489 U.S. 726, 739, 109 S.Ct. 1455, 103 L.Ed.2d 753 (1989) (when a statute sets forth exceptions to a general rule, we generally construe the exceptions "narrowly in order to preserve the primary operation of the [provision]"). Under Publishers' theory of Section 201(c), the question of whether an electronic database infringes upon an individual author's article would essentially turn upon whether the rest of the articles from the particular edition in which the individual article was published could also be retrieved individually. However, Section 201(c) would not permit a Publisher to sell a hard copy of an Author's article directly to the public even if the Publisher also offered for individual sale all of the other articles from the particular edition. We see nothing in the revision provision that would allow the Publishers to achieve the same goal indirectly through NEXIS.

Appellees' reading is also in considerable tension with the overall statutory framework. Section 201(c) was a key innovation of the Copyright Act of 1976. Because the Copyright Act of 1909 contemplated a single copyright, authors risked losing their rights by allowing an article to be used in a collective work. See 3 Melville Nimmer & David Nimmer, *Nimmer on Copyright* § 10.01[A] (1996 ed.) (discussing doctrine of indivisibility).

To address this concern, the 1976 Act expressly permitted the transfer of less than the entire copyright, see 17 U.S.C. § 201(d), in effect replacing the notion of a single "copyright" with that of "exclusive rights" under a copyright. *Id.* §§ 106, 103(b). Section 201(d), which governs the transfer of copyright ownership, provides:

(1) The ownership of a copyright may be transferred in whole or in part....

(2) Any of the exclusive rights comprised in a copyright, including any subdivision of any of the rights specified by section 106, may be transferred as provided by clause (1) and owned separately. The owner of any particular *exclusive right* is entitled, to the extent of that right, to all of the protection and remedies accorded to the copyright owner by this title.

Id. § 201(d) (emphasis added); see also *id.* § 204 (executions of transfers of copyright ownership). Similarly, Section 501, which sets forth the remedies for infringement of copyright, provides in pertinent part that "[a]nyone who violates any of the *exclusive rights* of the copyright owner ... is an infringer." *Id.* § 501(a) (emphasis added). (FN3) Were the permissible uses under Section 201(c) as broad and as transferrable as appellees contend, it is not clear that the rights retained by the Authors could be considered "exclusive" in any meaningful sense.

In light of this discussion, there is no feature peculiar to the databases at issue in this appeal that would cause us to view them as "revisions." NEXIS is a database comprising thousands or millions of individually retrievable articles taken from hundreds or thousands of periodicals. It can hardly be deemed a "revision" of each edition of every periodical that it contains.

[6][7][8] Moreover, NEXIS does almost nothing to preserve the copyrightable aspects of the Publishers' collective works, "as distinguished from the preexisting material employed in the work." 17 U.S.C. § 103(b). The aspects of a collective work that make it "an original work of authorship" are the selection, coordination, and arrangement of the preexisting materials. *Id.* § 101; see also *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 349, *169 111 S.Ct. 1282, 113 L.Ed.2d 358 (1991) (discussing factual compilations). (FN4)

However, as described above, in placing an edition of a periodical such as the August 16, 1999 *New York Times*, in NEXIS, some of the paper's content, and perhaps most of its arrangement are lost. Even if a NEXIS user so desired, he or she would have a hard time recapturing much of "the material contributed by the author of such [collective] work." 17 U.S.C. § 103(b). In this context, it is significant that neither the Publishers nor NEXIS evince any intent to compel, or even to permit, an end user to retrieve an individual work only in connection with other works from the edition in which it ran. Quite the contrary, *The New York Times* actually *forbids* NEXIS from producing "facsimile reproductions" of particular editions. *See Tasini I*, 972 F.Supp. at 826 n. 17. What the end user can easily access, of course, are the preexisting materials that belong to the individual author under Sections 201(c) and 103(b).

The UMI databases involved in this appeal present a slightly more difficult issue than does NEXIS. One, NYTO, is distinguishable from NEXIS in that it contains articles from only one publisher; the other, GPO, is distinguishable because it includes some image-based, rather than text-based, files. Nevertheless, we also conclude that the Publishers' licensing of Authors' works to UMI for inclusion in these databases is not within the Section 201(c) revision provision.

The NYTO database operates very much like NEXIS; it contains many articles that may be retrieved according to criteria unrelated to the particular edition in which the articles first appeared. Moreover, because the files it contains are provided by Mead pursuant to an agreement between UMI, Mead, and *The New York Times*, no more of the Times' original selection and arrangement is evident or retained in NYTO than is retained in NEXIS. In every respect save its being limited to *The New York Times*, then, NYTO is essentially the same as NEXIS. That limitation, however, is not material for present purposes. The relevant inquiry under Section 201(c), is, as discussed above, whether the republication or redistribution of the copyrighted piece is as part of a collective work that constitutes a "revision" of the previous collective work, or even a "later collective work in the same series." If the republication is a "new anthology" or a different collective work, it is not within Section 201(c). H.R.Rep. No. 94-1476, at 122-23 (1976), *reprinted in* 1976 U.S.C.A.A.N. 5659, 5738. Because NYTO is for present purposes

at best a new anthology of innumerable editions of the Times, and at worst a new anthology of innumerable articles from these editions, it cannot be said to be a "revision" of any (or all) particular editions or to be a "later collective work in the same series."

*170 For the same reason, GPO is not protected by Section 201(c). Although this database contains scanned photo-images of editions of *The New York Times* Sunday book review and magazine, it also contains articles from numerous other periodicals. In this respect, then, it is also substantially similar to NEXIS, and it, too, is at best a new anthology.

We emphasize that the only issue we address is whether, in the absence of a transfer of copyright or any rights thereunder, collective-work authors may re-license individual works in which they own no rights. Because there has by definition been no express transfer of rights in such cases, our decision turns entirely on the default allocation and presumption of rights provided by the Act. Publishers and authors are free to contract around the statutory framework. Indeed, both the Publishers and Mead were aware of the fact that Section 201(c) might not protect their licensing agreements, and at least one of the Publishers has already instituted a policy of expressly contracting for electronic re-licensing rights. *See* note 1, *supra*.

b) *Whitford*

As noted, Whitford entered into an express licensing agreement with Time. That agreement granted, in pertinent part, to Time:

(a) the exclusive right first to publish the Story in the Magazine:

(b) the non-exclusive right to license the republication of the Story ... provided that the Magazine shall pay to [him] fifty percent [] of all net proceeds it receives for such republication: and

(c) the right to republish the Story or any portions thereof in or in connection with the Magazine or in other publications published by [Time], provided that [he] shall be paid the then prevailing rates of the publication in which the Story is republished.

Time subsequently licensed Whitford's article to Mead without notifying, obtaining authorization

New York Times v. Tasini

Supreme Court brief:

Brief for Petitioners

pp. 3 n. 2 and 44-46

IN THE
Supreme Court of the United States

THE NEW YORK TIMES COMPANY, INC.; NEWSDAY, INC.;
THE TIME INCORPORATED MAGAZINE COMPANY; LEXIS/
NEXIS and UNIVERSITY MICROFILMS INTERNATIONAL,

Petitioners,

v.

JONATHAN TASINI; MARY KAY BLAKELY; BARBARA
GARSON; MARGOT MIFFLIN; SONIA JAFFE ROBBINS
and DAVID S. WHITFORD,

Respondents.

ON WRIT OF CERTIORARI TO THE
UNITED STATES COURT OF APPEALS FOR THE SECOND CIRCUIT

BRIEF FOR PETITIONERS

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the copyrights in their

opies"¹ of the periodicals are on microfilm and microfiche. More common and efficient, the periodicals available in formats for archival purposes. Because they are essential for research, the entire editorial content of these, are exact duplicates of the original on a cumulative basis, they can be searched quickly and accurately. A researcher would locate articles in the *Reader's Guide to the New York Times Index* and then check the stacks or the appropriate microfiche of the publications. Now, they can be accessed far more efficiently and accurately on a computer.

Plaintiffs' infringement claim is based on text and legislative history. The court held that the electronic copies of Section 201(c) of the Act, which covers "works," such as periodicals, are not contributions as part of the original editorial content of the works.

The court's decision that conflicts with the structure and purpose of the Copyright Act's principles. The particular case, which in many instances involves the original periodicals' editorial content in its

in which any copyrightable material, as in this case, are "fixed," and can be perceived." 17 U.S.C.

entirety, fit squarely within the congressional grant to publishers set forth in Section 201(c). Congress enacted Section 201(c) to ensure the right of contributing authors to exploit their individual works, *not* to prevent publishers from reproducing or distributing original or revised editions of their periodicals. More generally, it intended to further, not impede, the development of easily accessible electronic libraries and to promote the widespread dissemination of copyrighted works for the public good.

The Second Circuit's contrary ruling turns this clearly expressed congressional intent on its head, because it will require the mass deletion of freelance contributions from those libraries, as well as the outright destruction of media, such as CD-ROM discs, that may contain such contributions. Congress intended precisely the opposite result.

I. The Parties And Works At Issue In This Proceeding.

A. *Petitioners And The "Collective Works" They Publish.* Petitioners are publishers and their licensees. The publishers produce a number of prominent newspapers and special interest magazines, including *The New York Times* (the "*Times*"), *Newsday* and *Sports Illustrated* (collectively, the "Publications"). The Publications are published in print form, on microfilm and microfiche and also electronically. The publishers hold copyrights in each issue or edition of their respective Publications.

Petitioner LEXIS/NEXIS provides the NEXIS service. NEXIS is comprised of hundreds of libraries, each of which contains the contents of a periodical or periodicals.² For example, NEXIS has contained libraries for the *Times* since 1983, *Newsday* since 1988 and *Sports Illustrated* since 1982. NEXIS contains the Publications' complete editorial contents

2. The information contained in the NEXIS service is stored on a series of large interconnected discs housed in computers, or servers. These devices function similarly to library stacks: When an end-user requests information from a particular library within the NEXIS system, the computer locates the information by referencing internal indexing codes, and then retrieves the information from the electronic "stacks" for the end-user.

electronic copies as infringing, a result completely at odds with the plain language of the Act. It also would force users to search each stored periodical sequentially, a requirement that would, of course, defeat the purpose and great utility of electronic media.

Consistent with the media-neutral approach of the entire Act, collective works are therefore defined disjunctively, as consisting of materials “that are selected, coordinated, *or* arranged” to make “an original work of authorship.” 17 U.S.C. § 101 (emphasis added). The Second Circuit improperly replaced the word “or” with “and,” thereby imposing on publishers of collective works an obligation to retain an “arrangement” that is not required by the Act. Preservation of selection alone adequately preserves the original copyrightable aspect of a collective work and paves the way for a permissible revision under Section 201(c) to be stored in a variety of electronic and other media.

III. The Second Circuit’s Contrary Analysis Also Should Be Rejected Because It Conflicts With Fundamental Copyright Principles.

Numerous commentators have warned of the devastating effects of the Second Circuit’s decision and the wholesale deletion of materials from electronic libraries it portends. *See* Cert. Pet. 13-14. This disruption is a function of the fact that the Second Circuit’s decision violates longstanding copyright principles. First, because multiple editions of a periodical are stored together electronically, the Second Circuit incorrectly identified a “new anthology” of multiple

(Cont’d)

L. Rev. 516, 531 (1981) (making the point that, because digital information is stored in bits and bytes scattered throughout the storage medium, it is “senseless to seek . . . a specific, fixed arrangement of data. There is simply a collection of information stored in an electronic memory – information that can be arranged and retrieved in variations limited only by the capabilities of the computer and the sophistication of the retrieval program”).

ult completely at odds also would force users essentially, a requirement pose and great utility

tral approach of the : therefore defined als "that are selected, "an original work of is added). The Second rd "or" with "and," collective works an " that is not required on alone adequately aspect of a collective ssible revision under ety of electronic and

Analysis Also Should s With Fundamental

of the devastating on and the wholesale libraries it portends. is a function of the violates longstanding multiple editions of a nically, the Second thology" of multiple

it that, because digital attered throughout the . . . a specific, fixed llection of information on that can be arranged the capabilities of the eval program").

editions rather than a collection of individual revisions. Cert. App. 17a. Second, because researchers may retrieve individual articles, it regarded the electronic copies as akin to the impermissible exploitation of individual contributions. The Second Circuit thus characterized NEXIS as "comprising thousands or millions of individually retrievable articles taken from hundreds or thousands of periodicals [from which] articles . . . may be retrieved according to criteria unrelated to the particular edition in which the articles first appeared." *Id.* 14a, 16a (emphasis added).

As applied to the electronic copies involved in this case, the Second Circuit's analysis cannot be reconciled with core copyright principles set forth in the Act or with this Court's decisions in *Feist* and *Sony*. In addition to the manifest conflict with the Act's bedrock principle of media neutrality, the Second Circuit's reading of Section 201(c) cannot possibly be correct, because it would deem microfilm and microfiche to be infringing. Individual spools of microfilm routinely store multiple editions of a single periodical (often as much as a month's worth), but this does not convert them into a "new anthology" of individual editions any more than does the binding together of a year's worth of print periodical copies.³¹ Moreover, they are used, just

31. Other examples are easily identified. Although Congress specifically intended, among other things, for a publisher of a volume of "a 1980 edition of an encyclopedia" to be able to "reprint an article" from that edition "in a 1990 revision," H.R. Rep. No. 1476, at 122, J.A. 706a, in the Second Circuit's view the same publisher could not, in order to make that encyclopedia easier to use, publish the revised 1990 copy on a CD-ROM with copies of other volumes comprising the rest of the encyclopedia. Such a revision would constitute a new and infringing collective work, by the Second Circuit's reasoning, because the original contributions in each volume "may be retrieved according to criteria unrelated to the particular [volume] in which the articles first appeared." Cert. App. 16a. Given that in the twelve years since the (Cont'd)

like the copies challenged by respondents, almost exclusively by researchers to locate and copy individual articles. Thus, whether one uses the *Reader's Guide to Periodical Literature* to identify pertinent articles and to access them from paper periodicals or microfilm spools on shelves in a library's stacks or uses the search engine and indices of NEXIS or UMI's CD ROMs, the process and the copyright status of the works and copies used are equivalent in every sense.³² That a given search request may call for searching multiple libraries and produce results from multiple periodicals does not alter the compilation copyright of each individual periodical.

(Cont'd)

first CD-ROM encyclopedia appeared "it has become by far the dominant format and has made encyclopedias far more available," such a result is untenable. Matthew L. Wald, *Reference Disks Speak Volumes*, N.Y. Times, Feb. 26, 1998, at G12. The Second Circuit's analysis creates risks to publishers and the public that are far from theoretical. National Geographic has been sued by freelance contributors for having reissued all of its prior paper copies on 30 CD-ROM discs entitled "The Complete National Geographic 108 Years of National Geographic Magazine on CD-ROM." See *Faulkner (Douglas) v. National Geographic Soc'y*, No. 97 Civ. 9361 (S.D.N.Y.); *Faulkner (Sally) v. National Geographic Soc'y*, No. 99 Civ. 12488 (S.D.N.Y.); *Greenberg v. National Geographic Soc'y*, No. 97-3924-civ (S.D. Fla.).

32. The Second Circuit further erred by holding that the "any revision" language of Section 201(c) "protects only later editions of a particular issue of a periodical, such as the final edition of a newspaper." Cert. App. 10a. Indeed, even this example of a permissible revision would be infringing under the Second Circuit's insistence on the preservation of arrangements. The "final edition of a newspaper" often alters the "arrangement" of the earlier editions in significant ways, as when a breaking story, placed above the fold, might move an earlier story below the fold, or to a different page entirely.

New York Times v. Tasini

Supreme Court brief:

Brief for Respondents

pp. 1-2, 7 n. 6 and 34-36

No. 00-201

In the
Supreme Court of the United States

THE NEW YORK TIMES COMPANY, INC.;
NEWSDAY, INC.; THE TIME INCORPORATED
MAGAZINE COMPANY; LEXIS/NEXIS and
UNIVERSITY MICROFILMS INTERNATIONAL,

Petitioners,

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JONATHAN TASINI; MARY KAY BLAKELY;
BARBARA GARSON; MARGOT MIFFLIN;
SONIA JAFFE ROBBINS and DAVID S. WHITFORD,

Respondents.

ON PETITION FOR A WRIT OF CERTIORARI TO
THE UNITED STATES COURT OF APPEALS
FOR THE SECOND CIRCUIT

RESPONDENTS' BRIEF

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MICHAEL J. GAYNOR

STATUTORY PROVISIONS INVOLVED

This case requires the interpretation of the Copyright Act of 1976, 17 U.S.C. §101 *et seq.*, and two provisions in particular: § 103(b), which petitioners have, in large part, attempted to read out of the statute, and § 201(c), which they have attempted to reduce to two words. Section 201(c), which governs freelance contributions in collective works, states in full as follows:

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

Section 103(b) and other relevant provisions of the Act are set forth in Appendix II to this brief.

STATEMENT OF THE CASE

There comes a time in the life of an automobile when the vehicle is worth more disassembled than left put together. At that point, the car is taken apart, and its parts are sold off — the engine, the muffler, the bumpers, fenders, doors, the front and back windshields, and even the hubcaps may be sold separately by used-parts suppliers.

The same fate now awaits today's newspaper or magazine and tomorrow's literary or social science journal. Such publications have a short shelf life: They quickly become "yesterday's papers."

But after the publications no longer have any value at the newsstand, they still have plenty of value when they're disassembled and the "parts" — i.e., articles, reviews, op-ed pieces, etc. — are put up for sale.

As a consequence, even before the presses cool, many of the publications' component parts are sent off to LEXIS/NEXIS or the UMI Company, where the parts experience a second life.

Petitioners attempt to avoid the obvious implications of their acts by insisting over and over again that what the print publishers transmitted to the database producers and the latter placed on-line and on-disc were simply "electronic copies" or "revisions" of the print publishers' collective works. No amount of mantric repetition will make a heap of spare parts into a revised Cadillac, or the text of each of the articles in yesterday's *New York Times* into a revised edition of the newspaper.

The record, that is the facts, are to the contrary. The databases contain not "any revisions" of the publishers' collective works, but *discrete articles*. See BA at ¶¶ 11-27, J.A. 72a-84a. *Both courts below so found.* (3a, 4a, 5a, 14a, 102a).

Accordingly, the Court of Appeals' decision in this matter should be affirmed, as the Register of Copyrights herself recently urged in a letter introduced into the Congressional Record. That letter is annexed hereto as Appendix I.

*The Contributions, Collective Works And Databases
At Issue In This Case:*

Respondents, six writers who authored a total of twenty-one freelance articles, sued two sets of petitioners: three print-publishers (*The New York Times*, *Newsday* and Time Inc. Magazine Co.) and two database producers (LEXIS-NEXIS or "Mead" and the UMI Company).

Each of these articles originally appeared in a distinct issue of a newspaper or magazine: twelve in issues of *The New York Times*, eight in issues of *Newsday*, and one in an issue of *Sports Illustrated*. BA Chart, J.A. 68a-69a. Each of these issues appeared in a variety of editions. See *post* at 24-25.

Respondents Garson's and Robbins' articles were written for *Newsday*, which, within 24 hours of publication, provided discrete electronic files — each containing one article — to

“contained” was individual articles. (2a, 4a, 5a, 14a). “NEXIS does almost nothing to preserve the copyrightable aspects of the Publishers’ collective works, ‘as distinguished from the preexisting material employed in the work.’ 17 U.S.C. § 103 (b),” the Court said. (14a). It is significant in this connection “that neither the Publishers nor NEXIS evince any intent to compel, or even to permit, an end user to retrieve an individual work only in connection with other works from the edition in which it ran,” the Court continued. (15a-16a). On the contrary, what they fix in the computer servers, discs and drives and make available to end users are “the preexisting materials that belong to the individual author under Sections 201(c) and 103(b).” (16a). They make these materials available, moreover, not as a unitary or “collective whole,” but in contribution-size bits and pieces. (6a-7a; 4a (“After Mead . . . codes the individual files, the pieces are incorporated in the NEXIS database.”))

As a result, articles that once were an integral and inseparable part of particular print collective works are “now available . . . [to] be retrieved individually or in combination with other pieces originally published in different editions of the [same] periodical or in different periodicals.”⁶ (6a-7a). They are not fixed or stored in any of the databases as part of a fixed copy of a collective work. (4a).

The Court of Appeals also found that the databases did not legally *constitute* any one of the three collective works provided for in § 201(c). Because petitioners claimed only the protection of the second (“revision”) clause of § 201(c), the Court identified “[t]he crux of the dispute” as “whether one or more of the pertinent electronic databases may be considered

⁶ By analogizing to “library stacks” at pages 3-4 of their brief, petitioners inadvertently create the impression that the “libraries” provided for in a search and retrieval program correspond to physical locations on a database. *See also* Pet.Bf. 46 and Database Producers’ Amicus 19. They do not. Libraries are simply “logical groups” of electronic files that share a common sequence in their file numbers. Exh. 34, Petrosino Depo. 28. Files sharing these common file number sequences may be located anywhere.

The Copy-Shop Model: The function that Mead and UMI or, indeed, many databases or database producers serve these days is not so very different from that served by Kinko's or the Michigan Document Services Company. At the public's request, they each copy discrete elements of previously published collective works and bring those discrete elements together in new combinations. Just as their conduct constitutes copyright infringement, so does the conduct of the database producers. See generally, *Princeton University Press v. Michigan Document Services, Inc.*, 99 F.3d 1381, 1384-85 (6th Cir. 1996); *Basic Books, Inc. v. Kinko's Graphics Corp.*, 758 F.Supp. 1522 (S.D.N.Y. 1991).

There is, however, a significant difference between the traditional commercial copyshop and the three electronic databases at issue here. Generally, the copyshop takes an intact collective work and selects for copying discrete pages or selections only upon the request of a customer. The electronic databases here, on the other hand, don't copy from still intact collective works because the articles, selections and pages they need for any new assemblage have already been supplied to them — and stored by them — as discrete "documents." BA ¶¶ 9-20, J.A. 72a-81a. Indeed, they have not only already been supplied with discrete documents, but the databases have already logged each document into inventory, given it a unique retrieval number, and electronically tagged it with "keywords" and "term topic identifiers" so that it can be individually retrieved. BA ¶¶ 20-27, J.A. 81a-83a.

Moreover, once in the system, an individual article continues to be reproduced every time NEXIS creates a new generation of its database, BA ¶ 27, J.A. 83a, and every time UMI presses new or additional discs containing the article. It follows that before an end-user ever shows up and requests a particular article, the database producer has already copied it innumerable times (and in the case of UMI, distributed it), as well as taken concrete steps to authorize others to retrieve, display, copy and distribute the work.

Although there are clearly differences between the three databases at issue in this case, those differences are not material. Thus, it doesn't matter that the NYTO database carries articles from different issues and editions of *one* publication, while NEXIS and the GPO databases carry articles from different publications. Similarly, it doesn't matter that NEXIS and the NYTO databases make articles available in a text-only format, while the GPO database makes articles available in a page-view format. The salient feature of each of these databases — and the feature that is material for purposes of § 201(c) — is that they contain fixed copies of individual articles or component parts, but not collective works as a whole.

A database that contained entire issues of periodicals instead of individual articles would not violate a § 201(c) privilege that is properly exercisable in all media. That is the type of database that General Starr has taken pains to describe.²¹ There is no such database in *this* litigation.

The "New Anthology Model": When the database producers take the article-files they receive from the print publishers and incorporate them into their databases, they are making articles that at some point in the past were part of particular editions of a newspaper "part of" new compilations or anthologies: the petitioners' databases. See *A Report on Legal Protection for Databases, A Report Of The Register of Copyrights*, U.S. Copyright Office, August 1997, LVI 427-431 (databases are compilations); *Copyright Office Circular 65*, Copyright Registration for Automated Databases (databases

²¹ While the National Geographic Society may well believe that, in 1997, it created a database that is consistent with the § 201(c) privilege, there is concrete evidence that it just as strongly believed, prior to that time, that UMI's CD-ROMs were *not* copyright-compliant. J.A. 336a. Moreover, there is evidence that other publishers — including UMI itself — joined it in that belief. J.A. 334a-335a.

Two of the publisher petitioners in this case appear to recognize infringing behavior when they see it in others. See "Whither Napster?: The music business must find a way to charge for Internet swaps so creators can benefit," Editorial in *Newsday*, A 30 (Feb. 14, 2001); "A Win for Intellectual Property," Editorial in *The New York Times*, A 30 (Feb. 14, 2001).

are compilations). See also William S. Strong, *Database Protection After Feist v. Rural Telephone Co.*, 41 *Journal of the Copyright Society* 34 (1994) (databases are compilations); Marybeth Peters, *The Copyright Office and Form C Requirements of Registration of Claims to Copyright*, 17 *U. of Dayton L. Rev.* 737 (1992) (databases are compilations); John F. Hayden, *Copyright Protection for Computer Databases After Feist*, *Harvard J. Law & Tech.* 215 (1991).

Since these databases do not constitute editions of *Newsday* or *The New York Times* — but rather a “new anthology” or compilation — the database producers have clearly violated respondents’ copyrights by incorporating respondents’ articles into them. See H.R.Rep. No. 1476 at 122-23, J.A. 706a (where it is noted that section 201(c) was not intended to authorize publishers to include a contribution in “a new anthology or an entirely different magazine or other collective work”).²² Moreover, by providing the article-files containing respondents’ articles to the database producers for such inclusion, the print publishers have made themselves vicariously and contributorily liable for the database petitioners’ infringements.

B. The Case Law Is In Complete Accord

At page 7 of their petition for certiorari, petitioners characterized the Second Circuit’s Opinion in this case as being “remarkable for its fundamental inconsistency with governing precedent of this Court and decisions of other circuits” and “for its inclusion [in the Opinion] of only one citation to a

²² Respondents demonstrated at the CD-ROM demonstration that all of the articles in one of UMI’s discs are contained in one file, known as the “lib.ful” file. (D 40, 48). Although there are no human-readable markers that would enable anyone looking at the organization of the disc to know what articles were originally associated with what issues, the articles can be reorganized on an “issue-by-issue basis” by an end-user, using the date-and-periodical search, if the “user wishes to access the information that way.” KL 7; D 41. Each article is a separately retrievable unit.

A set of the discs that were used at the CD-ROM demonstration were marked as plaintiffs’ exhibits and deposited with the District Court. They appear as item 52 in the District Court record.

New York Times v. Tasini

Supreme Court Decision:

533 U.S. 483 (2001)

pp. 501-04

NEW YORK TIMES COMPANY, INC., ET AL. v. JONATHAN TASINI, ET AL.
No. 00-201

SUPREME COURT OF THE UNITED STATES

533 U.S. 483; 121 S. Ct. 2381; 150 L. Ed. 2d 500; 2001 U.S.LEXIS 4667; 69 U.S.L.W. 4567; 59 U.S.P.Q.2D (BNA) 1001; 29 Media L. Rep. 1865; 2001 Cal. Daily Op. Service 5260; 2001 Daily Journal DAR 6435; 2001 Colo. J.C.A.R. 3509; 14 Fla. L. Weekly Fed. S 414

March 28, 2001, Argued
June 25, 2001, Decided

PRIOR HISTORY: ON WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SECOND CIRCUIT.

DISPOSITION: 206 F.3d 161, affirmed.

CASE SUMMARY:

PROCEDURAL POSTURE: Petitioners, print and electronic publishers, challenged the judgment of the United States Court of Appeals for the Second Circuit that they infringed on the copyrights of respondent freelance authors by placing authors' articles in electronic databases. Publishers asserted they were protected by the reproduction and distribution privilege accorded collective work copyright owners by 17 U.S.C.S. § 201(c).

OVERVIEW: The Supreme Court held that the databases reproduced and distributed articles standing alone and not in context, not as part of the collective work to which the author contributed, or as part of any revision thereof, or as part of any later collective work in the same series under § 201(c). The authors had registered the copyrights for each article, while the print publishers registered collective work copyrights in each periodical edition in which an article originally appeared. The electronic publishers' databases did not reproduce and distribute the articles as part of either the original edition or a revision of that edition. An article's mark of origin did not mean the article was reproduced or distributed as part of the periodical. Unlike microforms, the databases did not reproduce articles as part of the collective work or as part of any revision. Media neutrality protected authors' rights to the extent the articles were presented individually within the databases. The storage and retrieval systems effectively overrode authors' exclusive rights. The electronic publishers were not selling equipment; they sold copies of the articles.

OUTCOME: The judgment of the court of appeals was affirmed.

CORE TERMS: database, publisher, revision, edition, periodical, user, electronic, print, reproduction, magazine, freelance, collection, reproduce, freelancer, newspaper, contributed, copyrighted, microfilm, distribute, distributing, reproduced, medium, authorial, Copyright Act, inclusion, copyright law, notice, headline, anthology, media

LexisNexis(R) Headnotes

Copyright Law: Derivative & Collective Works: Collective Works
Copyright Law: Rights: Reproduction Rights
[HN1] See 17 U.S.C.S. § 201(c).

Copyright Law: Subject Matter: Original Works of Authorship
[HN2] See 17 U.S.C.S. § 102(a).

533 U.S. 483, *, 121 S. Ct. 2381, **;
150 L. Ed. 2d 500, ***; 2001 U.S. LEXIS 4667

[***LEdHR1F] [1F][***LEdHR8B] [8B]One might view the articles as parts of a new compendium -- namely, the entirety of works in the Database. In that compendium, each edition of each periodical represents only a miniscule fraction of the ever-expanding Database. The Database no more constitutes a "revision" of each constituent edition than a 400-page novel quoting a sonnet in passing would represent a "revision" of that poem. [HN11] "Revision" denotes a new "version," and a version is, in this setting, a "distinct form of something regarded by its creators or others as one work." Webster's Third New International Dictionary 1944, 2545 (1976). The massive whole of the Database is not recognizable as a new version of its every small part.

[***LEdHR1G] [1G]Alternatively, one could view the Articles in the Databases "as part of" no larger work at all, but simply as individual articles presented individually. That each article bears marks of its origin in a particular periodical (less vivid marks in NEXIS and NYTO, more vivid marks in GPO) suggests the article was previously part of that periodical. But the markings do not mean the article is currently reproduced or distributed as part of the periodical. The Databases' reproduction and distribution of individual Articles -- simply as [*501] individual Articles -- would invade the core of the Authors' exclusive rights under § 106. n9

-----Footnotes-----

n9 The dissenting opinion takes as its starting point "what is sent from the New York Times to the Electronic Databases." See post, at 6-11. This case, however, is not ultimately about what is sent between Publishers in an intermediate step of Database production; it is about what is presented to the general public in the Databases. See supra, at 14. Those Databases simply cannot bear characterization as a "revision" of any one periodical edition. We would reach the same conclusion if the Times sent intact newspapers to the Electronic Publishers.

-----End Footnotes-----

[***LEdHR1H] [1H][***LEdHR8C] [8C]The Publishers press an analogy between the Databases, on the one hand, and microfilm and microfiche, on the other. We find the analogy wanting. Microforms typically contain continuous photographic reproductions of a periodical [***517] in the medium of miniaturized film. Accordingly, articles appear on the microforms, writ very small, in precisely the position in which the articles appeared in the newspaper. The Times, for example, printed the beginning of Blakely's "Remembering Jane" Article on page 26 of the Magazine in the September 23, 1990, edition; the microfilm version of the Times reproduces that same Article on film in the very same position, within a film reproduction of the entire Magazine, in turn within a reproduction of the entire September 23, 1990, edition. True, the microfilm roll contains multiple editions, and the microfilm user can adjust the machine lens to focus only on the Article, to the exclusion of surrounding material. Nonetheless, the user first encounters the Article in context. In the Databases, by contrast, the Articles appear disconnected from their original context. In NEXIS and NYTO, the user sees the "Jane" Article apart even from the remainder of page 26. In GPO, the user sees the Article [***2392] within the context of page 26, but clear of the context of page 25 or page 27, the rest of the Magazine, or the remainder of the day's newspaper. In short, unlike microforms, the Databases do not perceptibly reproduce articles as part of the [*502]collective work to which the author contributed or as part of any "revision" thereof. n10

-----Footnotes-----

n10 The Court of Appeals concluded NEXIS was infringing partly because that Database did "almost nothing to preserve the copyrightable aspects of the [Print] Publishers' collective works," i.e., their original "selection, coordination, and arrangement." 206 F.3d 161, 168 (CA2 1999). We do not pass on this issue. It suffices to hold that the Databases do not contain "revisions" of the Print Publishers' works "as part of" which the Articles are reproduced and distributed.

-----End Footnotes-----

***LEdHR9] [9]Invoking the concept of "media neutrality," the Publishers urge that the "transfer of a work between media" does not "alter the character of" that work for copyright purposes. Brief for Petitioners 23. That is indeed true. See 17 U.S.C. § 102(a) (copyright protection subsists in original works "fixed in any tangible medium of expression"). But unlike the conversion of newsprint to microfilm, the transfer of articles to the Databases does not represent a mere conversion of intact periodicals (or revisions of periodicals) from one medium to another. The Databases offer users individual articles, not intact periodicals. In this case, media neutrality should protect the Authors' rights in the individual Articles to the extent those Articles are now presented individually, outside the collective work context, within the Databases' new media. n11

-----Footnotes-----

n11 The dissenting opinion apparently concludes that, under the banner of "media-neutrality," a copy of a collective work, even when considerably changed, must constitute a "revision" of that collective work so long as the changes were "necessitated by . . . the medium." Post, at 9. We lack the dissent's confidence that the current form of the Databases is entirely attributable to the nature of the electronic media, rather than the nature of the economic market served by the Databases. In any case, we see no grounding in § 201(c) for a "medium-driven" necessity defense, post, at 9, n. 11, to the Authors' infringement claims. Furthermore, it bears reminder here and throughout that these Publishers and all others can protect their interests by private contractual arrangement.

-----End Footnotes-----

LEdHR11] [11][LEdHR10A] [10A]For the purpose at hand -- determining whether the Authors' copyrights have been infringed -- an analogy to an [*503] imaginary library may [***518] be instructive. n12 Rather than maintaining intact editions of periodicals, the library would contain separate copies of each article. Perhaps these copies would exactly reproduce the periodical pages from which the articles derive (if the model is GPO); perhaps the copies would contain only typescript characters, but still indicate the original periodical's name and date, as well as the article's headline and page number (if the model is NEXIS or NYTO). The library would store the folders containing the articles in a file room, indexed based on diverse criteria, and containing articles from vast numbers of editions. In response to patron requests, an inhumanly speedy librarian would search the room and provide copies of the articles matching patron-specified criteria.

-----Footnotes-----

533 U.S. 483, *; 121 S. Ct. 2381, **;
150 L. Ed. 2d 500, ***; 2001 U.S. LEXIS 4667

[***LEdHR10B] [10B]

n12 The Publishers have frequently referred to their products as "electronic libraries." We need not decide whether the Databases come within the legal coverage of the term "libraries" as used in the Copyright Act. For even if the Databases are "libraries," the Copyright Act's special authorizations for libraries do not cover the Databases' reproductions. See, e.g., 17 U.S.C. § 108(a)(1) (reproduction authorized "without any purpose of direct or indirect commercial advantage"); § 108(b) (reproduction authorized "solely for purposes of preservation and security or for deposit for research use"); § 108(c) (1994 ed., Supp. V) (reproduction "solely for the purpose of replacement of a copy or phonorecord that is damaged, deteriorating, lost, or stolen, or if the existing format in which the work is stored has become obsolete").

-----End Footnotes-----

[***LEdHR11] [11] Viewing this strange library, one could not, consistent with ordinary English usage, characterize the articles "as part of" a "revision" of the editions in which the articles first appeared. In substance, however, the Databases differ from the file room only to the extent they aggregate articles [***2393] in electronic packages (the LEXIS/NEXIS central discs or UMI CD-ROMs), while the file room stores articles in spatially separate files. The crucial fact is that the Databases, like the hypothetical library, store and retrieve articles separately within a vast domain of diverse texts. Such a storage and retrieval system effectively overrides the Authors' exclusive [*504] right to control the individual reproduction and distribution of each Article, 17 U.S.C. §§ 106(1), (3). Cf. *Ryan v. Carl Corp.*, 23 F. Supp. 2d 1146 (ND Cal. 1998) (holding copy shop in violation of § 201(c)).

The Publishers claim the protection of § 201(c) because users can manipulate the Databases to generate search results consisting entirely of articles from a particular periodical edition. By this logic, § 201(c) would cover the hypothetical library if, in response to a request, that library's expert staff assembled all of the articles from a particular periodical edition. However, [HN12] the fact that a third party can manipulate a database to produce a noninfringing document does not mean the database is not infringing. Under § 201(c), the question is not whether a user can generate a revision of a collective work from a database, but whether the database itself perceptibly presents the author's contribution as part of a revision of the collective work. That result is not accomplished by these Databases.

The Publishers finally invoke *Sony Corp. of America v. Universal City Studios, Inc.*, 464 U.S. 417, 78 L. Ed. 2d 574, 104 S. Ct. 774 (1984). That decision, however, does not genuinely aid their argument. Sony held that the "sale of copying equipment" does not constitute contributory infringement if the equipment is "capable of [***519] substantial noninfringing uses." *Id.* at 442. The Publishers suggest that their Databases could be liable only under a theory of contributory infringement, based on end-user conduct, which the Authors did not plead. The Electronic Publishers, however, are not merely selling "equipment"; they are selling copies of the Articles. And, as we have explained, it is the copies themselves, without any manipulation by users, that fall outside the scope of the § 201(c) privilege.

IV

[***LEdHR1J] [1J][***LEdHR12A] [12A] The Publishers warn that a ruling for the Authors will have "devastating" consequences. Brief for Petitioners 49. The Databases, the Publishers note, provide easy access to [*505] complete newspaper texts going back decades. A ruling for the Authors, the Publishers suggest, will punch gaping holes in the electronic record of history. The Publishers' concerns are echoed by several historians, see Brief for Ken Burns et al. as Amici Curiae, but discounted by several other historians, see Brief for Ellen Schrecker et al. as Amici Curiae; Brief for Authors' Guild, Jacques Barzun et al. as Amici Curiae.

**Defendants' Memorandum in Support of
Motion for Judgment on the Pleadings in**

Egilman v. Keller and Heckman, LLP

pp. 17-19 and n. 15

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLUMBIA

DAVID EGILMAN,

Plaintiff,

v.

KELLER and HECKMAN LLP, et al.,

Defendants.

No. 1:04-CV-876-HHK

MEMORANDUM OF POINTS AND AUTHORITIES IN SUPPORT OF
MOTION OF DEFENDANTS KELLER AND HECKMAN LLP AND DOUGLAS J.
BEHR FOR JUDGMENT ON THE PLEADINGS

Defendants Keller and Heckman LLP (“K&H”) and Douglas J. Behr (“Behr”) (“Defendants”) submit this memorandum in support of their motion, pursuant to Rule 12(c) of the Federal Rules of Civil Procedure, for judgment on the pleadings dismissing the Verified Complaint (“Ver. Compl.”) filed by plaintiff David Egilman (“Egilman”).

FACTS

Egilman has sued the law firms of Jones Day and Keller and Heckman, along with K&H partner Behr, for allegedly violating two federal statutes and committing common law torts, including trespass.¹ The three counts pled by Egilman arise out of a

¹ The federal statutory claims are 18 U.S.C. § 1030, the Computer Fraud and Abuse Act (“CFAA”) (Ver. Compl. ¶¶ 25-28), and 17 U.S.C. § 1201, et seq., the Digital Millennium Copyright Act (“DMCA”) (*Id.* at ¶¶ 29-32). An unspecified common law claim is asserted under the laws of the District of Columbia, Massachusetts and Texas, while that of trespass to Egilman’s computer is asserted under the law of no particular jurisdiction. *Id.* at ¶¶ 33-35.

extent that such act has been done “without the authority of the copyright owner.” 17
U.S.C. §1201(a)(3)(A).¹⁴

It is clear that neither K&H nor Behr engaged in any unlawful circumvention under the DMCA. Egilman does not and may not allege that Defendants “descrambled” or “decrypted” anything because his purported protection did not rely on scrambling or encryption. Nor, by entering a working username/password combination, did Defendants “remove,” “impair” or “deactivate” the protection Egilman used to protect his website.¹⁵

¹⁴ In addition to the defendant having circumvented without authority, a violation of section 1201(a)(1) requires two predicate elements. First, the work at issue must be properly protected by copyright. Second, the technological measure “circumvented” by the defendant must “effectively control” access to that copyrighted work. Egilman alleges that his website “provides access to numerous copyrighted works” authored by him and stored on his computer (Ver. Compl. ¶ 10) and, similarly, that the works on his computer were adequately protected by copyright. Ver. Compl. ¶¶ 31 and 32. He also alleges that he used “technical [sic] measures” to restrict access to his website (Ver. Compl. ¶¶ 11 and 31), but he does not allege that these measures were at all “effective” in actually restricting such access. Although this motion does not turn on the sufficiency (or not) of those allegations, Defendants do not, for purposes of this motion or otherwise, concede that the facts, as alleged, satisfy these two elements of that claim.

¹⁵ In the words of the Committee on the Judiciary, the “act of circumventing a technological protection measure put in place by a copyright owner to control access to a copyrighted work is the electronic equivalent of breaking into a locked room in order to obtain a copy of a book.” H.R. REP. No. 551, pt. 1, 105th Cong., 2d Sess. at 17-18 (1998). The analogy between the act of circumvention and “breaking and entering” was endorsed by the Copyright Office soon after the introduction of the bill that became the DMCA. *See* Hearing Before the House Subcomm. on Courts and Intellectual Property on H.R. 2180 and H.R. 2281, 105th Cong., 1st Sess. (“Libraries, for example, typically purchase a physical copy such as a book to make available on-site The bill would continue this basic premise, allowing a copyright owner to keep a work under lock and key and to show it to others selectively. Section 1201 therefore has been analogized to the equivalent of *a law against breaking and entering.*”) (statement of Marybeth Peters, Register of Copyright, at 49) (emphasis

Most important, entering a valid username and password does not constitute “otherwise” “avoiding” or “bypassing” a “technological measure” that “effectively controls” access to a password-protected website. In fact, this argument was expressly rejected in *I.M.S. Inquiry Mgmt. Sys., Ltd. v. Berkshire Info. Sys., Inc.*, 307 F. Supp. 2d 521, 532 (S.D.N.Y. 2004). The court’s analysis in *I.M.S.*, although arising out of circumstances where the password was obtained from an authorized user, is directly applicable:

We agree that plaintiff’s allegations do not evince circumvention as that term is used in the DMCA. Circumvention requires either descrambling, decrypting, avoiding, bypassing, removing, deactivating or impairing a technological measure *qua* technological measure. In the instant matter, defendant is not said to have avoided or bypassed the deployed technological measure in the measure’s gatekeeping capacity. The Amended Complaint never accuses defendant of accessing the e-Basket system without first entering a plaintiff-generated password.

More precisely and accurately, what defendant avoided and bypassed was *permission* to engage and move through the technological measure from the measure’s author. Unlike the CFAA, a cause of action under the DMCA does not accrue upon unauthorized and injurious access *alone*; rather, the DMCA “targets the *circumvention* of digital walls guarding copyrighted material.”

* * *

Defendant is alleged to have accessed plaintiff’s protected website without plaintiff’s authorization. Defendant did not surmount or puncture or evade any

added). Egilman’s Complaint alleges, at best, that the Defendants used the right key to open the door to Egilman’s website, or used the right combination for a combination lock, not that they broke the lock. That act – the use of a username/password combination that worked – simply is not the sort of “circumvention” prohibited by the DMCA.

technological measure to do so; instead, it used a password intentionally issued by plaintiff to another entity.

Id. at 532-33. (emphasis in original; footnotes omitted).

That the Defendants did not obtain the “Brown/student” combination from an authorized user does not distinguish this case from *I.M.S.*¹⁶ Egilman had, in fact, allowed anyone using those two words to enter into his website. He did not make any attempt to ensure that the combination could only be known to or used by individuals who were his actual students enrolled at Brown University. Moreover, the words, both by themselves and in combination, are so obvious that even someone without any technical expertise or circumvention device could deduce them. Given the precise language of section 1201(a)(1) and the persuasive holding in *I.M.S.*, Egilman’s DMCA claim also fails.

III. Egilman Has No Cause Of Action For Trespass Or For Any Other Common Law Tort.

his computer has been damaged or diminished in condition or value, or that his (or anyone else’s) use of his computer has been impaired in any way. To the contrary, he contends now, as he did in the overlapping Texas Action, that it was the false statement he, himself, posted on his website, once brought to the Colorado court’s attention, that “damage[d] . . . his reputation” (Ver. Compl. ¶ 34). This alone affected his future ability

¹⁶ The lack of *authorization* to use a username/password combination is irrelevant with respect to whether Defendants engaged in any of the proscribed *acts* of circumvention. To violate the statute, as set out in section 1201(a)(3)(A), a defendant must have (1) “descrambled, decrypted, etc.” *and* (2) done so without the authorization of the copyright owner.