

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

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### Preliminary Statement

In their opening brief, The New York Times Company ("Times Co."), Newsday, Inc. ("Newsday"), Time Inc. ("Time"), The Mead Corporation ("NEXIS") and University Microfilms Inc. ("UMI") established exactly how they acquired, by operation of law, the right to publish plaintiffs' articles in copies of The New York Times, Newsday and Sports Illustrated regardless of format: paper, microfilm, the NEXIS library of periodicals, or CD-ROM. Defendants supported their contentions with specific citations to (a) undisputed facts, (b) the plain language of the Copyright Act, (c) its legislative history and (d) controlling Second Circuit law.

Defendants further made clear, and plaintiffs admit<sup>1</sup>, that this case does not involve new or different uses of their articles, as would be true of a novelization or screenplay based on such articles. Instead, this case involves the reproduction and distribution of non-print copies of the paper editions that appear at newsstands, are delivered to homes and offices, and are found in library stacks. For that reason, this action is controlled by the plain language of Section 201(c) of the Copyright Act, which unambiguously precludes the claims asserted by plaintiffs.

Plaintiffs' response, contained in their 86-page, two-part opening brief, consists essentially of four arguments.

First, based exclusively on the demonstrably false assertion that "information retrieval systems of the type at issue in this litigation . . . had not yet entered the Congressional consciousness" when the 1976 Copyright Act was passed,

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1. Plaintiffs' Memorandum of Law In Support of Their Motion for Summary Judgment, dated March 15, 1996 ("P. Mem.") at 18-19; Affidavit of Emily Bass, dated March 15, 1996 ("Bass Aff.") ¶¶ 18, 39.

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,

plaintiffs' argument is contradicted by the plain language of the statute and its unambiguous legislative history. See infra at 16-19.

Fourth, scattered throughout plaintiffs' submissions is an argument that has no legal or analytical basis. It amounts to an appeal that this Court should rule in their favor because of an alleged unfairness resulting from the Copyright Act's medium-neutral approach. It is difficult to conceive of a more inappropriate request. Plaintiffs effectively seek the unavailable remedy of judicial legislation, after they and their predecessors have failed -- repeatedly -- to convince Congress to enact a more restrictive version of Section 201(c). See infra at 9-12. Authors' groups failed in their efforts in the mid-1960's to delete the phrase "any revision" from Section 201(c) when the Copyright Act was being drafted. Even more damning to plaintiffs' position is that the National Writers' Union (the "NWU"), which organized and funds this action,<sup>2</sup> tried unsuccessfully in the mid-1980's to have Section 201(c) amended. Their proposal would have permitted freelance authors to recapture rights acquired by a publisher under Section 201(c) when, as happened here, authors failed expressly to reserve them. This Court should decline to endorse plaintiffs' strategic effort to achieve an "end run" around Congress.

Simply stated, none of plaintiffs' "medium-restrictive" arguments (i) can be reconciled with the express language of the Copyright Act, (ii) are consistent with its legislative history, (iii) cite, let alone analyze, the Second Circuit case law

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2. Deposition of Jonathan Tasini ("Tasini Dep.") at 87-88; Deposition of Margot Mifflin ("Mifflin Dep.") at 94; Deposition of Sonia Jaffe Robbins ("Robbins Dep.") at 74.

that is dispositive of plaintiff Whitford's contract-based claim or (iv) can be credited, given that plaintiffs' own "union," the NWU, recognized over ten years ago that Section 201(c) needed to be amended and restricted if the arguments plaintiffs advance here were to prevail. The repeated admissions in the record that plaintiffs imposed no express medium-based limitations on the publishers, see D. Mem. at 4, 13-14, and that their articles appear in microfilm, the NEXIS library and CD-ROM formats together with the "full text" of the rest of the editorial contents of the periodical issues in dispute, P. Mem. at 19, Bass Aff. ¶¶ 18, 46, make clear that defendants are entitled to summary judgment and plaintiffs are not.

#### Argument

##### I.

#### THE PLAIN LANGUAGE OF SECTION 201(c) CONTROLS THIS CASE AND REQUIRES SUMMARY JUDGMENT IN FAVOR OF DEFENDANTS.

- A. Plaintiffs' Interpretation Of Section 201(c) As Limited To The Medium Of Paper Publication Is Inconsistent With The Plain Language Of Section 201(c), Its Legislative History, And The CONTU Report.

In the absence of an "express" agreement to the contrary, Section 201(c) plainly and literally authorizes publishers of periodicals containing articles written by freelance authors to, inter alia, reproduce and distribute the articles not only as part of their periodicals, but also as part of "*any revision*" of those periodicals. D. Mem. at 16-19. Nowhere in the Copyright Act is there any limitation on the medium in which a copy of a work may be reproduced or

distributed. Id. at 21-23. To the contrary, the statutory definition of "copies," the concept of "fixation" of a work and the definition of a "literary work," such as a newspaper or magazine, all were deliberately drafted to apply regardless of the format -- machine readable or otherwise -- in which a work may be disseminated to the public. 17 U.S.C. § 101; D. Mem. at 21-23. Thus, (i) the plain language of Section 201(c), which extends to "*any* revision" of the collective work, (ii) the legislative history of Section 201(c), which reflects the rejection of a proposal that publishers be required to obtain by contract permission to publish "revised editions" of their collective works, and (iii) the medium-neutral approach of the core definitions found in Section 101 of the Act, all make it impossible to read a publisher's Section 201(c) rights as limited to paper copies. See D. Mem. at 16-23, 27-29.

Plaintiffs duck the clear language of the statute by arguing that non-paper formats, such as electronic information storage and retrieval systems, cannot possibly have been contemplated by the Copyright Act, let alone Section 201(c), because at the time the Act was "formulated and its language finalized," such systems "had not yet even entered the public consciousness . . . were not yet in use at all or, at least, not yet in general use." P. Mem. at 40-41. These assertions are demonstrably false.

Congress knew full well, by 1965, not only that publishers of collective works already were able to reproduce and distribute those works on electronic information storage and retrieval systems, but also that the significance of reproduction and distribution on such systems would grow tremendously. The 1965

Report of the Register of Copyrights to Congress, which contained the final language of Section 201(c) as adopted by Congress, stated:

In recent years we have seen, among a multitude of technological developments, the introduction of communications satellites [and] the *tremendous growth in information storage and retrieval devices*. . . . [W]e now find that even our 1961 recommendations were not flexible and forward-looking enough.<sup>3</sup>

The 1965 Report dedicated an entire section to this very issue. Entitled "Use in Information Storage and Retrieval Systems," it recommended against adoption of an "explicit provision" relating to such systems "that could later turn out to be too broad or too narrow." *Id.* at 18. The Report stated:

A much better approach, we feel, is to *state the general concepts of copyright* in language, such as that in section 106(a), which would be general in terms and *broad enough to allow for adjustment to future changes in patterns of reproduction and other uses of authors' works*.

*Id.* (emphasis added). The 1965 Report directly endorsed the media-neutrality of "reproduction" under the proposed Act, acknowledging that

the actual copying of entire works (or substantial portions of them) for "*input or storage in a computer would constitute a reproduction*" . . . *whatever form the "copies" take*: punch-cards, punched or magnetic tape, electronic storage units, etc.

*Id.* (emphasis added). The 1965 Report and related testimony before Congress are replete with references to the then-current and future capabilities of electronic storage

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3. Supplementary Report of the Register of Copyrights on the General Revision of the U.S. Copyright Law: 1965 Revision Bill, 89th Cong., 1st Sess., Copyright Law Revision, Part 6, pp. xiv-xv (H. Judiciary Comm. Print 1965) (the "1965 Report") (emphasis added).

and information systems.<sup>4</sup> There simply is no basis, whether in the context of Section 201(c) or any other statutory reference to the media-neutral rights of reproduction and distribution, to exclude any particular medium.

Eleven years later, in 1976, the House Report accompanying the Copyright Act again noted the "increasing use of information storage and retrieval devices," H.R. Rep. No. 1476, 94th Cong., 2d Sess. 47 (1976), and reaffirmed that one of the purposes of the new Act was to make clear that copies of works could be reproduced in any "form, manner or medium of fixation . . . capable of perception directly or by means of any machine or device 'now known or later developed.'" *Id.* at 52 (citation omitted). Having adopted such a flexible approach to the concept of copies, Congress was able to defer the issue of whether computer technologies required even further changes in the new Act. Accordingly, it authorized a study of that issue by the National Commission on New Technological Uses of Copyrighted Works ("CONTU"). H.R. Rep. No. 1476, 94th Cong., 2d Sess. 116 (1976). When CONTU issued its final report (the "Final Report") on July 31, 1978, it made only

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4. See, e.g., 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. 1146-47 (1965) (Statement of John F. Banzhaf III, President, Computer Program Library, June 17, 1965) (describing ability of computer information storage and retrieval systems to "scan material at an almost unbelievable speed" and to examine material "for key words and symbols"); *Id.* at 1427 (Statement of Bella Linden, American Textbook Publishers Institute, June 23, 1965) (describing types of computer storage and information retrieval systems); Supplementary Report of the Register of Copyrights on the General Revision of the U.S. Copyright Law: 1965 Revision Bill, 89th Cong., 1st Sess., Copyright Law Revision, Part 6, p. 18 (H. Judiciary Comm. Print 1965) (same).



three limited proposals, none of which bear on any issues in this action.<sup>5</sup> To the contrary, the Final Report concluded, precisely because of the broad definitions of copies and of other concepts, that the new Act already had achieved "the desired substantive legal protection for copyrighted works which exist in machine-readable form." *Id.* at 40. In fact, CONTU specifically noted that the "introduction of a work into a computer memory" was to be considered another form of "reproduction of the work" under the Copyright Act. *Id.* In light of this specific conclusion, plaintiffs' arguments about CONTU, P. Mem. at 42-43, which they claim makes "absurd" any interpretation of "reproduction" that covers digital media, are contradicted by the clear and unambiguous language of the Final Report and the Copyright Act.

**B. Over Ten Years Ago, The Organizers Of This Action Recognized That Section 201(c) Rights Cover Microfilm And Digital Formats, Asked Congress To Amend Section 201(c) To Permit Them To Recapture Such Rights, And Failed.**

Reduced to its essentials, plaintiffs' claim represents the latest effort by the NWU and others to limit the scope of Section 201(c). Having failed to achieve their proposed limitations on the "any revision" language of Section 201(c) before the

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5. The Final Report made three narrow recommendations: (1) repealing 17 U.S.C. § 117 as enacted; (2) adding a definition of "computer program" to Section 101 of the Act; and (3) enacting a new Section 117, which provided a copyright safe-harbor for certain copies of a computer program. Final Report at 12. The Final Report considered, but did not recommend, other limitations on the electronic storage and retrieval of copyrighted works. On December 12, 1980, the recommendations of the Final Report were enacted as law. Pub. L. No. 96-517, § 10(b), 96th Cong., 1st Sess., 94 Stat. 3028 (1980).

passage of the Act,<sup>6</sup> they tried again in 1982 and 1983. The significance of these efforts is twofold. First, it belies plaintiffs' current claim that Section 201(c) is to be read as a paper-medium based "exception." P. Mem. at 8 n.3. Second, Congress' refusal to restrict Section 201(c) is consistent with the Copyright Act's policy in favor of the broad dissemination of published works, D. Mem. at 22-23, and undercuts the narrow, restrictive approach urged by plaintiffs.

The 1980's effort began when, at the request of several groups representing authors, Senator Thad Cochran (R-Miss.) introduced a bill (S. 2044) that would have limited the scope of rights that the publisher of a collective work could obtain from an author. S. 2044, 97th Cong. 2d Sess. §1, 128 Cong. Rec. 649 (1982).<sup>7</sup> That bill was criticized as improperly restricting negotiations among publishers and authors and as impeding publishers from fully disseminating their collective works to the public, including by some of the electronic means plaintiffs now attack.<sup>8</sup> A representative of publishers emphasized that

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6. D. Mem. at 27-32.

7. S. 2044 proposed to eliminate "a contribution to a collective work" from the types of works that could be obtained by publishers as a "work for hire" under Section 101 of the Copyright Act. 128 Cong. Rec. 649; News and Comment, Pat., Trademark & Copyright J. (BNA) ("PTCJ") No. 566 at A-16 (February 11, 1982); Senate Panel Hears Debate On Need To Narrow "Work Made For Hire Doctrine", 24 PTCJ 600 at 599 (October 14, 1982).

8. See Definition of Work Made For Hire in The Copyright Act of 1976: Hearing Before the Committee On the Judiciary, United States Senate, on S. 2044, A Bill To Amend The Copyright Law Regarding Work For Hire, 97th Cong., 2d Sess. (1982) ("Hearing on S. 2044") at 62, 69, 110-13, 116.

[a]s database publishing becomes more common, there should not be impediments to the publisher's flexibility to determine how articles can best be distributed to the public. S. 2044 will only discourage the use of outside articles and will result in a smaller quantity of needed information at a time of rapid technological change.<sup>9</sup>

In 1983, Senator Cochran, with the endorsement of the NWU and other authors' representatives, presented an alternative bill (S. 2138) that went beyond the work for hire issue and proposed directly to amend the language of Section 201(c) and to add a new section -- Section 201(f) -- to the Copyright Act. S. 2138, 98th Cong. 1st Sess.; 129 Cong. Rec. 34,442 (1983).<sup>10</sup> If enacted, these provisions would have permitted a freelance author to bring a federal cause of action to "reform or terminate a transfer" of rights under Section 201(c) where the profits received by the publisher of a collective work "are strikingly disproportionate" to the "compensation" received by the author. S. 2138 § 2(3). The proposed federal cause of action provided that, at any time following a publisher's acquisition of rights under 201(c), a plaintiff could claim that,

taking into consideration all factors including the bargaining position of the parties and their respective contributions to the financial success of the work, the terms of the transfer have proven to be unfair or grossly disadvantageous to the author. The court shall decide the action in accordance with the principles of equity, and shall have discretion to reform or terminate the transfer on whatever terms it considers just and reasonable.

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9. Hearing on S. 2044 at 112-13 (Testimony of American Business Press).
  10. A complete copy of S. 2138 has been submitted herewith as Exhibit 10 in the Appendix to Defendants' Responsive Brief. See also Text of S. 2138 and Introductory Remarks, 27 PTCJ 657 at 127 (December 1, 1983).

Id. This bill, which tracks the arguments plaintiffs offer in favor of their non-literal interpretation of Section 201(c), would have covered the very situation presented in this action. In fact, one of the equitable factors freelancers suggested for consideration in connection with a claim for reformation or termination of a Section 201(c) transfer was whether "*changes in* business practices or *media exploitation*" had proved "disadvantageous to the author." Hearing on S. 2044 at 45 (Supplemental Testimony of The American Society of Magazine Photographers and The Graphic Artists Guild) (emphasis added). Thus, as far back as the 1980's freelancers and their representatives recognized that, if they failed to restrict their publishers' collective work rights at the outset, Section 201(c) needed to be amended if, after the fact, they were to be able to limit the reproduction and distribution of periodical copies in non-paper media. Having failed to accomplish this objective in Congress,<sup>11</sup> the NWU now seeks an impermissible "back door" amendment through this lawsuit.

C. Plaintiffs' Efforts To "Wall Off" Their Performance And Display Rights Was Anticipated, And Precluded, By Congress.

Plaintiffs also claim that Congress never intended Section 201(c) to extend to the publication of periodicals on information storage and retrieval systems because the provision does not refer expressly to "display" and "performance" of contributions to collective works. According to plaintiffs, this means not only that

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11. On June 21, 1984, a bill that was worded identically to S. 2138 was presented in the House of Representatives by Rep. Barney Frank (D-Mass.). See H.R. 5911, 98th Cong., 2d Sess.; 130 Cong. Rec. 17,729 (1984). Neither bill was ever reported out of committee or voted upon by Congress.

display rights are not included, but also that publishers were not "given a reproduction and/or distribution right . . . either." P. Mem. at 38.<sup>12</sup>

That is plainly wrong. As described above, the drafters of the Copyright Act and the CONTU Final Report recognized that the concepts of reproduction and distribution are broad enough to cover copies in digital formats.<sup>13</sup> Moreover, plaintiffs' argument is inconsistent with the express legislative history on this subject. D. Mem. at 33-36. Congress specifically recognized that the five copyright rights identified in Section 106 of the Act "are cumulative" and "may overlap in some cases." *Id.* at 34 (quoting H.R. Rep. No. 1476 at 61). In other words, if a periodical publisher's copies fall within the scope of the reproduction or distribution rights of Section 106, that they also might implicate other Section 106 rights cannot constitute infringement. D. Mem. at 34-35.

The logic of plaintiffs' argument completely reverses this: they literally contend that because Section 201(c) does not grant publishers *all* Section 106 rights, it does not grant them *any*. P. Mem. at 38. This is an impossible result, given that Congress stated precisely the contrary in the legislative history. Moreover, the construction urged by plaintiffs impermissibly conflicts with Congress' intent to enact a medium-neutral Copyright Act and with the Supreme Court's admonition to

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12. Plaintiffs "performance" rights argument is completely irrelevant to this case. See D. Mem. at 35 n.31. Reproduction in microfilm, NEXIS and CD-ROM editions is not a performance because a work neither is recited, rendered, played, danced or acted when it appears in pure text form. *Id.*; 17 U.S.C. § 101 (definition of "perform a work").

13. See pp. 6-9, *supra*.

interpret the Act to allow for the fullest dissemination of works of authorship. D. Mem. at 36-37.

D. The Copies Of The Periodicals Placed Onto NEXIS or UMI CD-ROMs Are Either The Publishers' Collective Works Or Revisions Of Those Collective Works.

Plaintiffs argue that the publishers of The New York Times, Newsday and Sports Illustrated have "put up for sale" individual articles, P. Mem. at 1-2, and delivered to NEXIS and UMI "individual articles" rather than "collective works." Id. at 37. These claims are contradicted by the undisputed record. There is not a fact in the record that shows any of the publishers ever has offered for sale or delivered any of plaintiffs' articles -- or any other article -- *apart from* the text of *all other articles* that appeared in the same issue of the newspaper or magazine. All of the articles from a single collective work are delivered together to NEXIS and UMI as part of the same transmission and added to the NEXIS library or UMI CD-ROM products on an issue-by-issue basis. D. Mem. at 7-8; Patterson Dec. ¶ 8; Keane Dec. ¶ 13; McDonald Dec. ¶ 7; Petrosino Dec. ¶¶ 5-6, 9-10; Riedel Dec. ¶ 5.<sup>14</sup> Plaintiffs concede, as they must, that issues of the respective periodicals are delivered and

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14. In fact, promotional documents in the record demonstrate that NEXIS and UMI CD-ROM products are marketed as making available issues of periodicals rather than individual articles. See, e.g., Bass Aff. Ex. 49, at MOO3220 (describing NEXIS as "the world's most comprehensive collection of legal, news and business information sources" which "saves you . . . the costs of collecting, storing and archiving trade publications, newspapers, reference data and case law — or the time spent to search hard copy libraries" and consists of "[h]undreds 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").

added to NEXIS and UMI CD-ROM products on an issue-by-issue basis rather than an article-by-article basis. Bass Aff. ¶ 18. The reproduction and distribution of collective works (or revisions of those works) in this manner expressly is authorized by Section 201(c).<sup>15</sup>

Plaintiffs also incorrectly argue, without a single factual citation, that the publishers have gone to great "effort, energy and expense" to "ensure that there is only one article per electronic file." Bass Aff. ¶ 18 n.14; P. Mem. at 37 & n.34. In fact, it is undisputed that both the paper copies of the periodicals at issue and their NEXIS and CD-ROM counterparts are created from exactly the same computer text files. D. Mem. at 7, 9; Patterson Dec. ¶ 8; Keane Dec. ¶ 13; McDonald Dec. ¶ 7; Petrosino Dec. ¶¶ 5, 9; Riedel Dec. ¶ 5; Bass Aff. ¶¶ 11, 18.<sup>16</sup>

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15. This is true whether the acts are done directly by the publisher or by NEXIS and UMI. Plaintiffs' argument that the publishers cannot license their rights with respect to the collective works, P. Mem. at 36, is incorrect. See infra at 19-22. Similarly, the suggestion that unauthorized and infringing copies of articles were made by each of the publishers, NEXIS and UMI during the mechanical process of publishing paper copies, as well as by loading issues of the periodicals onto the NEXIS library and UMI CD-ROM products, P. Mem. at 19-20, 30-32, is an argument that perhaps best characterizes all that is flawed with plaintiffs' interpretation of the Copyright Act. In plaintiffs' view, the publisher of a collective work commits copyright infringement each time in the reproduction and distribution process that an author's article is copied to, for example, create proofs, galley sheets, films, plates, mechanicals or sections of a periodical. If that were the law, a collective work never could be composed or revised. It is safe to say that Congress never intended the right to publish collective works to turn, as plaintiffs claim it does, on a freelancer's interpretation of what constitutes desirable "social policy." Id. at 32.

16. Of course, plaintiffs' objections in this regard are completely untrue as applied to microfilm and image-based CD-ROM copies. Nonetheless, plaintiffs object to these copies as well, alleging that all copies made under authority of

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The essence of plaintiffs' arguments on this issue (which run headlong into these undisputed facts) boils down to their objection to certain revisions to the collective works made before those works are added to the NEXIS library or certain UMI CD-ROM products. See P. Mem. at 2, 37 & n.34 (non-paper formats of newspapers and magazines do not contain "graphic and non-article elements" such as photographs, maps, crossword puzzles, death notices and stock listings). Once again, this argument ignores the plain language of Section 201(c), which authorizes the reproduction and distribution of "any revision" of the collective work. It also ignores the legislative history of Section 201(c), which expressly recognizes that, as a matter of statutory grant, such revisions may include the elimination of selected elements and contributions to the work. D. Mem. at 27-29.<sup>17</sup>

Furthermore, plaintiffs complain about revisions that have nothing to do with their articles. The revisions to which they object are deletions of illustrations or photographs that may have accompanied their work, but to which they have no copyright claim. Because they concede that their articles, whether in microfilm, NEXIS, or CD-ROM copies, contain "wording" identical to the copies "that appeared in print," P. Mem. at 19, the principal concern authors' representatives had over the reference in Section 201(c) to "revisions" is not involved. See D. Mem. at 30;

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16. (...continued)  
Section 201(c) must be printed on paper. Amended Complaint ¶¶ 1, 32, 75, 247, 290, 368, 394, 420 and 446.
17. The uniform, categorical and mechanical nature of the deletions at issue here do not involve any of the editorial or creative judgments required to create "derivative works" under the Copyright Act. See infra at 17-19.



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.<sup>18</sup> 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

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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").<sup>19</sup>

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.<sup>20</sup>

## 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).

covers reproductions and distributions of periodicals in non-paper copies, publishers must exercise that authority directly, not by licenses, because they are given a "privilege" rather than a "right" under the statute. P. Mem. at 17 n.15 and 36. Plaintiffs offer no authority for this novel proposition and nothing in the Copyright Act, its legislative history, or the case law, supports it.

To the contrary, the only significance of the term "privilege" is that it is used several times in the Copyright Act to describe a copyright interest acquired by operation of law, as opposed to by express grant. The Act refers to five such "privileges": the 201(c) "privilege"; the "privileges" of an owner of a lawful copy, which include selling or otherwise disposing of it, 17 U.S.C. § 109(d); the "privilege" of the owner of a derivative work to continue to utilize that work after a license or other grant has terminated, 17 U.S.C. §§ 203(b)(1) and 304(c)(6)(A); and two compulsory licenses, which give the licensee the "privilege" of retransmitting broadcast programs over cable television, 17 U.S.C. § 111(d)(1)(B)(i), or of making an arrangement of copyrighted music for distribution by phonorecords. 17 U.S.C. § 115(a)(2). In fact, in some respects, these "privileges" actually are broader than "rights" because the author has no power to recapture them under the "termination of transfers" provision of 17 U.S.C. § 203(a) (only a "*grant* of a transfer or license of copyright or of any other *right* under a copyright, *executed by the author* . . . is subject to termination").

The legislative history of the Copyright Act also is devoid of any indication that a "privilege" is distinguishable from a "right." From the outset, the

Register of Copyrights, the principal draftsman of Section 201(c), equated the "privilege" under Section 201(c) with a "right" in his original draft of the statute, which provided that the publisher "hold in trust for the author all rights in the author's contribution, except the *right* to publish it in a similar composite work and any other *rights* expressly assigned." Report of the Register of Copyrights on the General Revision of the U.S. Copyright Law, 87th Cong., 1st Sess., Copyright Law Revision, pp. 87-88 (H. Judiciary Comm. Print 1961) (emphasis added). Throughout the rest of the drafting process, other participants also routinely referred to Section 201(c) as establishing "rights":

- At a June 11, 1963 meeting on Section 201(c), E. Gabriel Perle of Time observed that under Section 201(c) publishers "must be presumed to have acquired the *right* to publish" articles in connection with collective works.

Preliminary Draft for Revised U.S. Copyright Law and Discussions and Comments on the Draft, 88th Cong., 2d Sess., Copyright Law Revision, Part 3, p. 267 (H. Judiciary Comm. Print 1964) (emphasis added).

- At the same meeting, Abe A. Goldman, of the Copyright Office legal staff and later Acting Register of Copyrights, also referred to the authority granted by Section 201(c) interchangeably as "rights" and "privileges":

[I]t would be presumed that the copyright owner of the collective work would have acquired only the *privilege* of publishing the contribution in his particular collective work. The only *other rights* he would acquire would be any that were transferred to him expressly.

Id. at 258 (emphasis added).

- Rep. Kastenmeier, a member of the House Judiciary Subcommittee responsible for the Copyright Act and later Chairman of the Subcommittee of the House Judiciary Committee responsible for the copyright laws, in the Congressional Record of Sept. 27, 1966, described Section 201(c) as transferring to the publisher "certain publishing *rights*." 112 Cong. Rec. 24, 066 (1966) (emphasis added).

- It is not surprising, therefore, that when the hearing record of the Act was presented to the House Judiciary Committee in 1975, all understood that under 201(c), "the owner of the collective work obtains only certain limited *rights* with respect to each contribution." Copyright Law Revision: Hearings Before the Subcommittee on Courts, Civil Liberties and the Administration of Justice on H.R. 2223, 94th Cong., 1st Sess. 2077 (1975) (emphasis added).

Even the only arguably relevant copyright case plaintiffs cite in their brief, Playboy Enterprises v. Dumas, 831 F. Supp. 295 (S.D.N.Y. 1993), aff'd, 53 F.3d 549 (2d Cir. 1995), follows this approach. See P. Mem. at 15, 34. In the context of discussing how publishing practices interact with Section 201(c), Judge Tenney drew no rights/privilege distinction, but instead used both terms interchangeably. Dumas, 831 F. Supp. at 304 ("These *rights* included the *privilege* of reproducing and distributing the contribution as part of the collective work . . . . These *rights* were codified as the *rights* available to publishers of collected works under 17 U.S.C. 201(c)") (emphasis added). Aside from lacking any support in the statute, the legislative history or the case law, plaintiffs' reading of the statute simply

does not make sense. Under their reading, for example, publishers would have to operate their own newsstands to distribute periodicals containing freelance contributions and could not authorize third parties to exercise those rights. By operation of law, therefore, the publishers acquired all of the rights necessary to reproduce and distribute, and to authorize the reproduction and distribution of, plaintiffs' articles in copies of their periodicals.

### III.

**AS A MATTER OF LAW, DEFENDANTS CANNOT  
BE FOUND LIABLE FOR VICARIOUS OR CONTRIBUTORY  
COPYRIGHT INFRINGEMENT.**

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Plaintiffs appear to contend that Times Co., Newsday and Time are vicariously or contributorily liable for alleged acts of copyright infringement by NEXIS and UMI. P. Mem. at 26-29. They also allege that because third parties can "search through, access, retrieve, display, download and/or print out" plaintiffs' articles using NEXIS or UMI CD-ROM products (P. Mem. at 23-26), all of the defendants are contributorily liable for any copyright infringement that may occur based on such actions. These twin arguments are wrong for several reasons.

First, the publishers cannot be contributorily or vicariously liable for the reproduction and distribution of their periodicals on NEXIS and CD-ROM by the "Data Base Defendants," P. Mem. at 27, because the copies of the periodicals placed on NEXIS and UMI CD-ROM discs are not infringing. As demonstrated in Section I, the NEXIS computerized library of periodicals and the UMI CD-ROM products at

issue contain the "collective work", or a "revision" of the collective work, in a manner expressly permitted pursuant to Section 201(c). Because the publishers enjoy the right, directly or through licensees, to reproduce and distribute their periodicals and revisions thereof in any medium, plaintiffs have failed to demonstrate any direct infringement in this action. Accordingly, plaintiffs' ancillary claims of contributory and vicarious liability fail as a matter of law because to support either such claim, there must be an underlying act of direct infringement. R&R Recreation Products Inc. v. Joan Cook Inc., 25 U.S.P.Q.2d 1781, 1784 (S.D.N.Y. 1992) ("without direct infringement there is no cause of action for contributory infringement").

As for use by third parties, plaintiffs' claims of contributory and vicarious liability also fail, as a matter of law, based on applicable Supreme Court precedent. Where, as here, the NEXIS library and UMI CD-ROM discs are "capable of substantial noninfringing uses," there can be no vicarious or contributory infringement based on possible improper uses by third parties. Sony Corp. of America v. Universal City Studios, Inc., 464 U.S. 417, 442 (1984) ("[i]ndeed it need merely be **capable** of substantial noninfringing uses") (emphasis added).<sup>21</sup> It is

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21. In Sony, the Supreme Court held that Sony, which manufactured Betamax video recorders, could not be held liable if third parties used the product to make unauthorized copies of copyrighted material, because the product could be used for "time-shifting" of television programs, a non-infringing fair use of copyrighted material. Sony, 464 U.S. at 454-55. Since Sony, the Supreme Court has continued to emphasize that the fair use provisions of Section 107 of the Copyright Act require "courts to avoid rigid application of the copyright statute when . . . it would stifle the very creativity which that law is designed to foster." Campbell v. Acuff-Rose Music, Inc., \_\_\_ U.S. \_\_\_, 114 S.Ct. 1164, 1170 (1994) (citation omitted). Although not presented to this Court on (continued...)



undisputed that the NEXIS computerized library and UMI CD-ROM products are not only capable of, but actually are used for, non-infringing purposes. Petrosino Dec. ¶¶ 11-13; Riedel Dec. ¶¶ 9-10. Indeed, in this regard, uses of microfilm, NEXIS and CD-ROM copies to provide access to the respective periodicals presents an even simpler and more powerful example of non-infringement than presented in Sony, because Section 201(c) expressly authorizes such reproduction and distribution as a matter of law.

That a user of the NEXIS library or a UMI CD-ROM disc can view either an entire collective work or individual articles does not change this result. For many years, researchers have been able to view individual articles from periodicals by searching through topic headings in the Readers' Guide to Periodical Literature and retrieving an article from a back issue of a periodical existing either in paper copies shelved in the stacks of a library or on spools of microfilm that can be displayed on a microfilm viewer. Using the NEXIS computerized library or UMI CD-ROM products for this purpose is the modern functional equivalent of these well-established research methods.<sup>22</sup> What previously had required two steps -- searching the

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21. (...continued)  
summary judgment, Sony and similar cases make absolutely clear that the overwhelming majority of uses of the copies of the periodicals on NEXIS and UMI CD-ROM products would constitute fair uses.
  22. Although several of the plaintiffs contended at their depositions that retrieval of their articles on microfilm constituted copyright infringement, see Tasini Dep. at 112; Garson Dep. at 76; Mifflin Dep. at 26-27; Robbins Dep. at 45, they may have abandoned that claim, recognizing that it is unsupported as a matter of law. Nonetheless, were their interpretation of Section 201(c) to be  
(continued...)

Readers' Guide and then locating the article itself -- now only requires a single search. Improvements in the research process cannot transform the authorized reproduction and distribution of defendants' collective works into a copyright infringement of the plaintiffs' articles.<sup>23</sup> Indeed, the Readers' Guide itself now is available online and in CD-ROM format. Keller Dec. Ex. H. Plaintiffs' model would require a researcher, having located the citation of an article on a particular topic from the Readers' Guide online, to rely solely on the paper form of the collective work in order to read the text of that article. As courts have recognized for years, such a Luddite-like approach is completely inconsistent with both the language of, and policy underlying, the copyright law. For example, as far back as 1903, the Third Circuit held that it was not necessary to separately register for copyright each frame of a motion picture as a photograph simply because motion pictures were not specified as copyrightable subject matter. Edison v. Lubin, 122 F. 240, 242 (3d Cir. 1903), appeal dismissed, 195 U.S. 624 (1904). Plaintiffs, however, would turn the clock back by decades -- to the public's extreme detriment and irretrievable loss.

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22. (...continued)  
adopted, all non-paper reproductions and distributions would be infringing.
23. To the extent plaintiffs suggest that a user of NEXIS or a UMI CD-ROM is unable to retrieve and view other articles that appeared in "the same newspaper or magazine issue," Bass Aff. ¶ 38, that simply is false. To the contrary, as plaintiffs subsequently concede, Bass Aff. ¶ 39, the full text of all articles from each of the respective periodicals at issue appears in and can be retrieved from the NEXIS library. D. Mem. at 7-9. Similarly, the same can be done with the full text of all articles from the relevant issues of The New York Times on UMI CD-ROM products. Id.

In fact, plaintiffs' format-over-substance distinction has been rejected since at least 1899. Even then -- under a prior copyright statute -- the Supreme Court refused to endorse what it viewed as an artificial distinction between the publication of a series of articles on a weekly basis in magazines versus the appearance of all of those articles in one complete bound volume. Holmes v. Hurst, 174 U.S. 82, 88-89 (1899). In language that foreshadowed the media-neutral approach of the Copyright Act of 1976, the Court stated:

*It is the intellectual production of the author which the copyright protects and not the particular form which such production ultimately takes, and the word "book" as used in the statute is not to be understood in its technical sense of a bound volume, but any species of publication which the author selects to embody his literary product.*

Id. at 89 (emphasis added). Plaintiffs, however, push for an approach to copyright law that has been rejected by the Supreme Court because they misinterpret the current Copyright Act as making everything format specific.<sup>24</sup> That approach is wrong as a matter of policy and as a matter of simple statutory construction. The copyright law cannot, and should not, be read to restrict publishers of periodicals such as The New York Times, Newsday and Sports Illustrated from disseminating their newspapers and magazines by modern forms of communication so that they are widely available to the public, the primary intended beneficiary of the Copyright Act. See D. Mem. at 36-37.

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24. In plaintiffs' view, for example, the sale of a collective work in a loose-leaf binder could subject a publisher to vicarious or contributory infringement because a reader may remove an article and use it separately in any number of potentially infringing ways. This highlights the danger inherent in confusing change in format of a collective work with substantive changes in a work.

Finally, and significantly, plaintiffs provide no factual support for their claim that third parties have retrieved their articles on NEXIS or CD-ROM products or used them in an infringing manner. Instead, plaintiffs ask the Court to rule in a vacuum, requesting what is essentially an advisory opinion based entirely on hypothetical facts.<sup>25</sup> See Olin Corp. v. Consolidated Aluminum Corp., 5 F.3d 10, 17 (2d Cir. 1993) (courts must give "specific relief," rather than "advising what the law would be upon a hypothetical state of facts") (citation omitted); see also Fletcher v. Atex, Inc., 68 F.3d 1451, 1456 (2d Cir. 1995) ("a party may not 'rely upon mere speculation or conjecture . . . to overcome a motion for summary judgment'") (citation omitted). Not only is this Court constitutionally prohibited from rendering such an opinion, the policies underlying the Copyright Act should make it extremely reluctant to do so. Reading the Copyright Act to prevent placement of periodicals on NEXIS and CD-ROM products because third parties hypothetically may use the technology in an infringing manner would contradict the fundamental purpose of the Copyright Act: to increase public access to works of authorship. See Twentieth Century Music Corp. v. Aiken, 422 U.S. 151, 156 (1975) (the "ultimate aim" of the copyright law is "to stimulate artistic creativity for the general public good"); D. Mem. at 36-37.

Because including plaintiffs' articles as part of defendants' collective works placed on NEXIS and CD-ROM products is not infringing, and plaintiffs have

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25. Plaintiffs' entire submission on this point is a hypothetical argument, set forth at ¶¶ 28-42 in the Bass Aff., that does not even involve a single one of the articles involved in this case.

failed to provide evidence of unlawful copying by third parties or any supportable theory of third-party liability, summary judgment in their favor is impossible, and should be granted in favor of defendants. See Repp v. Lloyd Webber, 858 F. Supp. 1292, 1300 (S.D.N.Y. 1994) ("In copyright infringement cases, courts have regularly granted summary judgment where it is clear that the plaintiff cannot make out the elements of the claim.")

#### IV.

**PLAINTIFFS' ARGUMENTS CONCERNING WHITFORD'S  
CONTRACT AND THE NEWSDAY CHECK ENDORSEMENTS  
FAIL AS A MATTER OF LAW AND ARE  
IRRELEVANT FOR PURPOSES OF SUMMARY JUDGMENT.**

**A. Whitford's Media-Neutral Contract Cannot Be  
Read, Under The Law Of This Circuit, To  
Exclude The Right To Publish In Non-Paper  
Formats.**

The parties are in accord that the contract governing the publication of Whitford's article "Glory Amid Grief" in Sports Illustrated contains no reference to any medium-based limitations on Time's right to publish the magazine (P. Mem. at 11-12; D. Mem. at 38). They are, however, diametrically opposed as to the legal consequences of this silence. Whitford argues that Time was required expressly to obtain electronic rights to his article, P. Mem. at 11-13, while Time argues that Whitford's failure expressly to retain those rights is fatal to his subsequent infringement claims. D. Mem. at 38-43. The law of this Circuit -- applied to the undisputed facts -- squarely supports Time's analysis of the effect of Whitford's contract.

The record is crystal clear that when Whitford entered into the contract with Sports Illustrated in April 1991, he was well aware of the state of electronic publishing and, in particular, knew that publishers of periodicals already had begun to use electronic archival systems and had begun to publish their periodicals online. Whitford Admissions ¶ 13. The record is equally clear that Whitford was aware that he had the right to -- and actually did -- engage in negotiations with Time concerning important aspects of the agreement. Whitford Admissions ¶ 2(d); Whitford Dep. at 44-45. Whitford makes no effort to dispute these essential facts.

On this record, well-established Second Circuit authority compels summary judgment for Time. Since 1936, the Second Circuit has on three occasions reviewed contract disputes in which a copyright holder has granted another the right to exploit a work in a particular medium without expressly retaining such rights in other media, and has thereafter sought to limit the grantor's right with regard to media not specifically referred to in the contract. As detailed in defendants' opening brief, the Court on each occasion has applied a rule of construction that allows the grantee to exploit the copyrighted work in any medium not inconsistent with the contractual language, so long as the grantor was aware of the medium at the time the contract was entered into. See Bourne v. Walt Disney Co., 68 F.3d 621 (2d Cir. 1995); Bartsch v. Metro-Goldwyn-Mayer, Inc., 391 F.2d 150 (2d Cir.), cert. denied, 393 U.S. 826 (1968); L.C. Page & Co. v. Fox Film Corp., 83 F.2d 196 (2d Cir. 1936). Thus, just as is true statutorily under Section 201(c) (which applies in the absence of an express agreement), case law places the burden of contractually

retaining the right to publish in particular media squarely on Whitford's shoulders.

Judge Friendly explained the rationale behind the rule:

If the words are broad enough to cover the new use, it seems fairer that the burden of framing and negotiating an exception should fall on the grantor; if [the grantor] had desired to limit "exhibition" of the motion picture to the conventional method where light is carried from a projector to a screen directly beheld by the viewer, [the grantor] could have said so. A further reason favoring the broader view in a case like this is that it provides a single person who can make the copyrighted work available to the public over the penumbral medium, whereas the narrower one involves the risk that a deadlock between the grantor and the grantee might prevent the work's being shown over the new medium at all.

Bartsch, 391 F.2d at 155. Courts in this district consistently have applied the approach required by the Second Circuit, and have awarded summary judgment on that basis. See, e.g., Rooney v. Columbia Pictures Indus., 538 F. Supp. 211, 228 (S.D.N.Y.), aff'd, 714 F.2d 117 (2d Cir. 1982), cert. denied, 460 U.S. 1084 (1983) (awarding summary judgment); Landon v. Twentieth Century-Fox Film Corp., 384 F. Supp. 450, 455-56 (S.D.N.Y. 1974) (Lasker, J.) (awarding summary judgment).<sup>26</sup>

Plaintiffs disregard these cases, relying instead on cases that are completely inapposite. See P. Mem. at 12. Stewart v. Abend, 495 U.S. 207 (1990), for example, dealt exclusively with assignment of copyright renewal rights to the owner of a derivative work; Wolff v. Institute of Electrical and Electronics Engineers, Inc., 768 F. Supp. 66 (S.D.N.Y. 1991), addressed whether an advertisement

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26. As is true of Whitford, the plaintiff in Landon successfully sought to reserve certain contractual rights unrelated to the issue of media, prompting Judge Lasker to observe that "[s]uch reservations are themselves strong evidence that if [plaintiff] had intended to reserve the right to make and exhibit filmed television versions of the property, she [and her agents] knew how to do so." 384 F. Supp. at 454.

B. The Newsday Check Endorsements Bind Plaintiffs And Only Further Support Summary Judgment In Favor of Newsday.

Plaintiffs concede that each of them who sold an article to Newsday was paid with a Newsday check containing a printed legend that expressly confirmed Newsday's acquisition of the right to include the articles in electronic media. P. Mem. at 10, 14-15 & n.8. In an attempt to overcome the obvious effect of having signed and negotiated the legended checks, plaintiffs Garson and Robbins claim that they "never even noticed and/or read the legend," while Tasini and Whitford claim that they "were not sure what it meant." Id. at 14 n.13.

One look at the checks in the record exposes these claims as untenable. As is obvious from the checks themselves, the legend is printed directly (approximately 1/4 inch) above a printed signature line on which each of the plaintiffs signed his or her name, and states in clear, straightforward prose that Newsday has acquired the "right to include [the article] in electronic library archives." See Keller Dec. Ex. E-1 – E-4. It would have been impossible to sign the check but miss the legend, or to read the legend without comprehending its obvious meaning.<sup>28</sup> Accordingly, on this basis, Newsday is entitled to summary judgment in its favor.

See Argus Inc. v. Eastman Kodak Co., 801 F.2d 38, 45 (2d Cir. 1986) (plaintiffs'

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28. Indeed, Writer's Market, the book referred to by plaintiffs as authoritative on issues affecting freelance writers, see Mifflin Supp. Dep. at 13; Plaintiffs' 3(g) Statement with Respect to Times Co. ¶ 58, specifically notifies freelance writers about the use of check legends of the sort used by Newsday in this case and advises them to check carefully to ensure that the legend is consistent with the understanding of the grant. Glenda Tennant Neff, ed., 1991 Writer's Market at 28.



claims were "thoroughly implausible" and could not survive a motion for summary judgment), cert. denied, 479 U.S. 1088 (1987). If, however, the Court were to credit these claims that there was no "meeting of the minds" and the Newsday articles were not analyzed as a matter of contract, summary judgment in favor of Newsday still should be granted because the resulting analysis would be governed by Section 201(c), which permits publication of the articles in electronic formats for the reasons set forth in Sections I through III above.

Plaintiffs' assertion that the alleged infringement occurred before they received the Newsday checks, thus nullifying the effect of the legends, is specious. It is well-settled that a subsequent written confirmation validates a grant ab initio. See Eden Toys, Inc. v. Florelee Undergarment Co., 697 F.2d 27, 36 (2d Cir. 1982); Kenbrooke Fabrics, Inc. v. Soho Fashions, Inc., 690 F. Supp. 298, 301 & n.2 (S.D.N.Y. 1988). Even crediting plaintiffs' argument that Newsday's written confirmation was not in effect at the time of publication, in the absence of a writing, Section 201(c) would govern and defendants would be entitled to summary judgment for the reasons set forth above. Plaintiffs arguments thus are both wrong as a matter of law, and irrelevant for purposes of the present motion.

Conclusion

For the foregoing reasons, defendants respectfully request that summary judgment be entered dismissing the Complaint in its entirety as against all defendants.

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Respectfully submitted,

DEBEVOISE & PLIMPTON

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