December 1998

Cases of Note - Copyright - Collected Works

Bruce Strauch

The Citadel, strauchb@citadel.edu

Follow this and additional works at: <https://docs.lib.purdue.edu/atg>

Part of the [Library and Information Science Commons](#)

Recommended Citation

Strauch, Bruce (1998) "Cases of Note - Copyright - Collected Works," *Against the Grain*: Vol. 10: Iss. 6, Article 1.

DOI: <https://doi.org/10.7771/2380-176X.3027>

This document has been made available through Purdue e-Pubs, a service of the Purdue University Libraries. Please contact epubs@purdue.edu for additional information.

Cases of Note

by **Bruce Strauch** (The Citadel) <strauchb@citadel.edu>

Copyright - Collected Works

Joan Ryan, et al. v. CARL Corporation,
et al., Order No. C 97-3873 FMS, US District Court (NDCal).

Well, here it is. I have trouble remembering a time before car air conditioning. Or before each Strauch family dinner table conversation held at least a passing reference to document delivery. And now a federal judge has swatted down the entire growing industry.

Oct. 13, 1998, US District Judge **Fern Smith** granted partial summary judgment that construed section 201(c) of the Copyright Act. The four plaintiffs are authors. Each of them had excerpted portions of books and published them in magazines and scholarly journals. **UnCover** is a document retrieval and delivery business that contracts with publishers to copy and sell articles for a fee. **UnCover** is owned by **CARL Corporation** and **Dialog Corporation**. Plaintiffs' articles were sold in this fashion.

At the time of the district court's order, plaintiffs had not yet filed a motion for certification as a class action, although they apparently intended to do so. Where named plaintiffs in a class action lack standing, the Court may allow the action to proceed if the putative class members may have standing. See *U.S. Parole Comm'n. v. Geraghty*, 445 U.S. 388, 398-400 (1980).

201(c) of the Copyright Act holds that owners of collected works have copyright in each bit only "as part" of the collection, a revision or a later collection in the same series...unless the parties have contracted otherwise.

201(c) was put in the Copyright Act of 1976 to overcome the former doctrine of copyright indivisibility. It was the intent of Congress to enlarge the rights of authors. Without a specific agreement, authors would not inadvertently lose all copyright in an article. *Tasini v. New York Times Co.*, 972 F. Supp. 804, 815 (S.D.N.Y. 1997), reconsid. denied, 981 F. Supp. 841 (S.D.N.Y. 1997).

In *Tasini*, authors sued when they learned their articles were included in electronic databases. The authors lost because of the "revision" privilege of 201(c). The original arrangement and formatting might have been lost, but the publishers' selection of the particular group of articles had not.

Can UnCover continue to deliver articles? Yes.

Ward Shaw, CEO, told *ATG* over the phone from Colorado that "nothing in the order prohibits **UnCover** from delivering articles and paying for copyrights, and that is what **UnCover** intends to continue doing."

Current posture of the case—a stay on all Discovery until two issues have been decided: 1. whether the case will be certified for a class action; 2. whether the 9th Cir Ct of Appeals will hear an interlocutory appeal on the 201(c) interpretation.

Assuming the 9th Circuit agrees with the judge's interpretation of 201(c), will sudden largesse pour down on authors? No.

All the judge's order says is that the publisher of a collected work does not have the right to reproduce individual articles...unless the author and publisher contract otherwise.

The National Writers Union concedes that this ruling will merely change the publishers' standard form contract, and any author who balks will simply go unpublished. While the Union talks union tough talk, it faces the same problem as in organizing farmers or dental technicians. Union power is based on the strike—on denying labor to management. To do that, you must have all the writers working in a factory that you can surround and picket. This can happen at a big newspaper. It could possibly happen in Hollywood where writers work in strange barrack-like buildings (or at least they did in a **P.G. Wodehouse** novel I once read).

As to academe—forget it. Union palaver among assistant professors scabbling desperately for tenure is a joke. "I didn't publish enough articles because I have our larger best interest at heart and refused oppressive publishers' contracts." Ooo-kay. Ironically, the need for that medieval guild protection—tenure—becomes the ultimate Yellow Dog Contract on the issue of resisting publishers' contracts.

During the **Charleston Conference**, your egghead *ATG* columnist managed to buttonhole noted iconoclast **Chuck Hamaker** (UNC-Charlotte) in the midst of a major power conference he was having with **Corrie Marsh** (Ethyl Corp).

Chuck said a study they did at **LSU** showed considerable copyright confusion. Many journals routinely contract for first publication rights only. Authors frequently alter copyright agreements despite threats by the publisher not to accept an altered contract, and the article is published anyway. Chuck questioned the ungodly expense of ferreting out all those contracts and figuring out what the authors had signed away. In effect, whatever profit exists in individual article delivery would be eaten up in the expense of determining rights or in litigation if a publisher failed to do so.

UnCover deals with 6,000 publishers and perhaps 6 million authors. **Ward Shaw** notes that seven or eight authors is common in academic articles. It's impossible to get author permission when some are dead, some retired and others not speaking to each other. Shaw says the irony of this ruling is **UnCover** could copy the entire journal and deliver it to you at an unaffordable price and that would be okay.

The judge herself concedes that societal efficiency is better served by the publisher holding rights of reproduction because the publisher can be located. She even conceded that the result of authors' retained reproduction rights is not particularly equitable. Publishers—particularly in peer-reviewed academic journals—add considerable value. The selection for a journal bestows intellectual credibility, and its value reproduced is nil without citing its location in the publisher's journal.

And if that's true, then why is an individual article ever really separate from the collection it's cited in? Unless it's a theme issue, the other articles around it in a given issue probably have zip to do with its subject matter. What's key about the "collected work" is the status of the journal—tough or feeble peer-review. And any article properly cited always remains "part of the collection" which is the totality of that journal's volumes since its origin.

In our feast of reason, Chuck and I conceived of a kind of **Year One** in electronic reproduction rights when the new hard-nosed publishers' contracts go into effect. A gigantic mass of decades of articles prior to that would be relegated to interlibrary loan ... or perhaps to the dust bin of abandoned knowledge. Is this what academic writers really want in their eternal quest for widespread fame rather than gold? Do researchers want thirty years of knowledge conveyed creakily through interlibrary loan?

continued on page 53

Copyright - Work-for-hire - When is an employee an employee?—Right to authorship credit

Graham v. James, 144 F.3d 229 (2d Cir.1998), 1998 Copr.L.Dec. P 27,783, 46 U.S.P.Q.2d 1760.

Graham dba Night Owl Computer Service markets CD-ROMs, containing compilations of computer programs. Lacking a file-retrieval system, Graham hired **James**, a computer programmer and taxi driver to create one. James built into it a claim of copyright for himself. This led to a row. Graham removed James' copyright claim from the program. Then with the aid of new programmers, he produced new versions of the same system. Of course, next James sold his version to another publisher.

Then, as folks tend to do, **James** and **Graham** sued each other. Graham claimed James was an employee and Night Owl owned copyright under the work-for-hire doctrine.

With the facts of the employment relation disputed, the district court found that James had been contracted on the basis of \$1000 for the system and one dollar for each disk sold. *This is not just a damage question. In a second, you will see it is important that he was not on salary.*

As to Graham's new versions of the system, the district court found them not substantially similar to James' so there was no violation of James' copyright. *Yes, James won the copyright question as to the original program.* The district court found that he held copyright as an independent contractor and enjoined Graham from using the system. Graham appealed and lost.

The Copyright Act says "a work prepared by an employee within the scope of his or her employment" is a work for hire. 17 U.S.C. § 101 (1994). The employer is "the author" and owns copyright unless the parties agree to the contrary in writing. 17 U.S.C. § 201(b). *Okay. But when is a cab-driver/programmer an employee as opposed to an independent contractor?*

We go to the common law of agency. *Community for Creative Non-Violence v. Reid*, 490 U.S. 730, 741, 109 S.Ct. 2166, 2173, 104 L.Ed.2d 811 (1989).

The key element is the "hiring party's right to control the manner and means by which the product is accomplished." This takes us to a check list of: "skill required; source of the instrumentalities and tools; location of the work; duration of the relationship between the parties; whether the hiring party has the right to assign additional projects to the hired party; the extent of the hired party's discretion over when and how long to work; the method of payment; the hired party's role in hiring and paying assistants; whether the work is part of the regular business of the hiring party; whether the hiring party is in business; the provision of employee benefits; and the tax treatment of the hiring party." *Id.* at 751, 109 S.Ct. at 2178-79.

The key elements as identified by the appellate court are underlined above. **James** was a skilled programmer. He received no benefits; no payroll taxes were withheld. His engagement was on a project-by-project basis. **Graham** did little work on the project, and his

instructions to James were vague.

And one other thing. **James** had claimed copyright infringement by **Graham** due to his author's credit being removed from the program. Under a work-for-hire, the author gives up a right to attribution because all copyright is vested in the employer. (see **Cases of Note, ATG**, Nov. 1998) But the author also has no particular right to attribution if he licenses the work unless the parties have agreed by contract. James and Graham had entered into a licensing agreement. That was the one dollar per disk deal.

"The generally prevailing view in this country under copyright law has been that an author who sells or licenses her work does not have an inherent right to be credited as author of the work. In line with that general rule, it has been held not to infringe an author's copyright for one who is licensed to reproduce the work to omit the author's name." 3 Melville B. Nimmer & David Nimmer, *Nimmer on Copyright* § 8D.03[A][1], at 8D-32. 🐼

Without a specific agreement, authors would not inadvertently lose all copyright in an article.

Your specialized source for:

- **International Scholarly and Professional Books**
Canada, Australia, New Zealand and other Pacific Rim countries
- **Government Publications**
United States, Canada, Australia, New Zealand, United Kingdom, Ireland and International/Intergovernmental organization publications
- **Association Publications**
United States, Canada, Australia, New Zealand, United Kingdom and Ireland

ROOTED IN THE TRADITIONAL CONCEPTS OF international bookselling, yet innovatively making the most of the latest developments in electronics, communications and transportation, **Accents Publications Service** has the extensive experience and expertise to blend the old with the new and effectively assist you in your acquisitions of the books and information products in which we specialize.

ACCENTS

Publications Service, Inc.

721 Ellsworth Drive, Suite 203
Silver Spring, MD 20910-4436
USA

Telephone: 301.588.5496
Fax: 301.588.5249
E-Mail: accents@iamdigex.net