Against the Grain

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Legally Speaking-Databases, Tasini and the Information Age

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Dateline 2000—as the century changes, information is readily accessible via databases. Beginning with such tools as Dialog, Lexis-Nexis, and Westlaw in the 1970s, computer research has become an integral part of the research process. This process has been accelerated by the release of the World Wide Web in the 1990s. Articles from newspapers and magazines are readily accessible. The information world is here!

Dateline 2001—The world has changed. Database vendors are notifying their customers that they are unable to provide access to newspaper and magazine backfiles. Only current articles are available. Librarians and publishers are at each other's throats. The information age is in doubt! Why this drastic change? The case of *Tasini v. New York Times Co.*

So what is *Tasini* all about? The case revolves around the definition of "collective works" under the copyright laws. According to copyright law, "A collective work is a work, such as a periodical, reference, or encyclopedia, in which a number of contributions, constituting separate and independent works in themselves, are assembled into a collective whole." Once the collective work is completed, the article writers retain copyright to their work. On the other hand, the entire work itself has a separate copyright, usually owned by the publisher. For example, a magazine might be made up of separate articles by different authors. Copyright in the articles themselves is owned by the individual authors. Copyright for the magazine as a whole is owned by the publisher. The work as a whole is a "compilation" under copyright law. Compilations are formed by collecting and assembling preexisting works together. "The resulting work as a whole constitutes an original work of authorship. The term 'compilation' includes collective works."44

On the other hand, a "derivative work" comes about when one work becomes the basis upon which another one is built. For example, the novel "Gone with the Wind" became the movie "Gone with the Wind." Who owns the copyright? According to the statute, the rights to the movie are owned by the studio, but the rights to the novel are still owned by the estate of Margaret Mitchell. At the same time, Margaret Mitchell does have some measure of rights in the movie version of her book.3

In the *Tasini* case, six free-lance authors sold their works to various newspapers and magazines, including The New York Times, Newsday, and Sports Illustrated.4 The publishers in turn licensed the articles to Lexis-Nexis and to UMI's *New York Times OnDisc.* Since these kinds of transactions have become increasingly common over the last 20 years (leading to the so-called "Information Revolution"), this sounds like a routine transaction that should cause no problems. However, the plaintiffs in the *Tasini* case have pointed out that there are still many unanswered questions.9

The basis of the *Tasini* claim is that the publishers had no right to license their work for database inclusion. According to the authors, only the author of an article may license its subsequent use. The authors claim that the publishers are not authorized to license the authors' work. The authors are freelance writers, and their work does not constitute "work-for-hire."9

The authors are basing their claim on section 103 of the copyright law.10 According to section 103, "The copyright in a compilation or derivative work extends only to 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 such work is independent of, and does not affect or enlarge the scope, duration, ownership, or subsistence of, any copyright protection in the preexisting material."10

The issues in the *Tasini I* case revolved around whether the databases constitute "revisions" of the original works, since both collective works and derivative works are based upon other works that are already copyrighted.13 According to one analysis of the *Tasini I* case, "At issue in this case are the limits of copyright extended to the authors of the constituent parts, and to the author of the collective work, usually the publisher. Juxtaposed between these rights is the impact of "electronic media" on the rights of both authors and publishers."14 Derivative works transform the preexisting works into a new creation. A collective work includes "numerous original contributions which are not altered, but which are assembled into an original collective whole. In both instances, the copyright law accounts for the fact that the larger work—which is entitled to copyright protection—consists of independent original contributions which are themselves protected."15 (Citations omitted) *868 [FN39]

In order for a compilation to become an independent work, the compiler's effort must be more than minimal or trivial. "Originality in the context of compilations can consist of selectivity, or independent original effort in collecting, assembling, selecting, organizing, arranging, and compiling the pre-existing materials."16 For example, "a compilation of selected scenes from movies featuring a particular actor has been held to constitute a protectable work under the Copyright Act, if the extent that the creator exercised skill and creativity in selecting and arranging the scenes."17

The authors' claim is based in part on the legislative history of the 1976 Copyright Act. According to legislative history, "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 re-
print 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.” The authors concede that microform is an acceptable means of displaying the compilation, but maintain that inclusion in an electronic database constitutes an entirely new work which they have not given permission for.

The Tasini I court did not buy this argument. In fact, the court found that the microform concession was particularly damaging to the authors’ case. According to the opinion, the publishers have “reproduction” rights for collective works, and “reproductions result in copies...Copies are material objects...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. 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.

Finding that the authors did not have a material issue of law, the District Court in Tasini I granted summary judgment to the defendants. The Second Circuit reversed the grant of summary judgment. Basically, the Tasini II court felt that aggregation of articles into a database did not comprise a revision of the work. According to the opinion, “If the disputed periodicals manifest an original selection or arrangement of materials, and if that originality is preserved electronically, then the electronic reproductions can be deemed permissible revisions of the publisher defendants’ collective works. If, on the other hand, the electronic defendants do not preserve the originality of the disputed publications, but merely exploit the component parts of those works, then plaintiffs’ rights in those component parts have been infringed.”

The Tasini II court felt that there was no “revision” in the preparation of a database; however, since the original formatting was lost, the database does not constitute a copy of the original publication. It was significant that articles are retrieved “according to criteria unrelated to the particular edition in which the articles first appeared.”

The court relied on 17 U.S.C. § 201(c) for support. The language in 201(c) describes a collective work as including a periodical issue. An article written for one issue can not be included in another issue without a new grant of rights by the author. The court therefore questions why a database is different. Since publishers can’t sell articles directly to the public, even if all the articles from an issue were sold, “We see nothing in the revision provision that would allow the Publisher to achieve the same goal indirectly through NEXIS...II] it is significant that neither the Publishers nor NEXIS evince any intent to compel, or even to permit, an end user to retrieve an individu-
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Where these groups diverge from the authors’ position is on the issue of charging. The authors want a piece of the publishers’ pie, but the database vendors and librarians want materials to be more readily accessible without the high cost of buying re-publication rights. This has especially pitted librarians against publishers. In fact, “Of all the dangerous and dot-complex problems that American publishers face in the near future -- economic downturns, competition for leisure time, piracy -- perhaps the most exploitive one could be libraries. Publishers and librarians are squaring off for a battle royal over the way electronic books and journals are lent out from libraries and over what constitutes fair use of written material.”

According to former Congresswoman Pat Schroeder, who is now the president of the Association of American Publishers (AAP), “Publishers have to figure out a way to charge for electronic material [since] markets are limited. One library buys one of their journals... They give it to other libraries. They’ll give it to others.” The AAP is concerned about such traditional library functions as inter-library loan, lending to patrons, and printing. Libraries respond by saying that printing an e-journal is not any different than photocopying a paper article. Ironically, some of the arguments that librarians use with publishers are the same ones that publishers used in Tansini.

According to Nancy Kranich, president of the American Library Association, “The reason we’re in a bind is that the price of some of the materials has skyrocketed, without any explanation... The publishing community does not believe that the public should have the same rights in the electronic world.” One example that Kranich used was the chemistry journal Tetrahedron Letters, which costs $14,000 a year. Computer databases can be even more expensive.

According to some, the publishers created their own problem when “they forced libraries to purchase online [subscriptions] for the public, keep the paper which still has to be processed and archived, and then had the gall to charge us more if we eliminated the paper copy.”

At this point, it is clear that something needs to be done. The problem is to decide how to make changes that will be acceptable to everyone. Authors need to be paid. Publishers need to be able to re-publish their collective works. Database vendors need materials to present online, while libraries need publications and databases that are affordable and accessible. The U.S. Supreme Court will decide Tansini, but since this is only a request for summary judgment the case could drag on for years.

I don’t have the answers, but hopefully we will find the solution soon. All of the players in the process are talking, and that is the best hope for resolution. After all, we all have a stake in keeping the Information Age going.

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Copyright Corner — Importance of the Public Domain

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What is the public domain and why is it important in copyright law? Nearly everyone has heard the term and has at least a vague notion of why it is important, but a deeper understanding of the value of the public domain is important for librarians, especially as copyright holders try to expand their rights.

A shorthand definition of a “public domain” work is that the work is the opposite of a copyrighted work. Works that are copyrighted have a bundle of rights associated with them. The owner of the copyright has the exclusive right to reproduce and distribute the work, adapt it, publicly perform and display it, and, if the work is a sound recording, to publicly perform it by digital means. If the work is within the public domain, there are no ownership rights associated with the work. It may be said that everyone and no one owns the work. Therefore, anyone may reproduce the work, distribute it, adapt it, etc.

The public domain is particularly important to scholars, researchers and librarians. There is no longer any need to seek permission for any use of the work, so members of the public may freely use public domain works, not only for nonprofit educational and library purposes but also for research, scholarship and even to commercially exploit the work. The statute does not define public domain. Instead, it details the conditions necessary for copyright protection, the types of works that are eligible for protection, the rights of copyright holders and the exceptions to these exclusive rights. Thus, a work not protected by copyright is necessarily a public domain work. One of the major complaints from the scholarly and research communities about term extension was that adding an additional 20 years to the term of copyright for existing works delayed by two decades works passing into the public domain. In fact, it will be 2019 before any...