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Cases of Note-Tasini III and Joe Cartoon v. Zuccarini

Bruce Strauch

The Citadel, strauchb@earthlink.net

Jack G. Montgomery

Western Kentucky University Libraries, jack.montgomery@wkyu.edu

Bryan M. Carson

Western Kentucky University Libraries, bryan.m.carson@gmail.com

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Section Editors: **Bruce Strauch** (The Citadel) <strauchb@citadel.edu>
Jack Montgomery (Western Kentucky University) <jack.montgomery@wku.edu>

Cases of Note — Tasini III and Joe Cartoon v. Zuccarini

by **Bruce Strauch** (The Citadel) <strauchk@earthlink.net>

Copyright - Tasini III - The Supremes Speak.

NYTimes v. Tasini, 121 S.Ct. 2381, 2001 LEXIS 4667, June 25, 2001.

Wow! That grabbed your attention. It's supposed to say Tasini v. NY Times.

Wrong! Times got reversed on the first appeal. So now their name goes first.

Well, the Times lost. As everyone knows.

We've lived with the tension of this for so long that I almost feel like yawning. Bout time for a new crisis. And who the heck remembers all the brou-ha-ha over ... what was it? ... Amoco?

Let's wend our way back to days of yore and review those mills of the law that grind both slowly and exceedingly small.

Tasini et al are freelance writers who sold articles to the *NY Times* that later ended up in LEXIS/NEXIS. Writers sued saying publishers of a collective work could only republish an article in a revision of the original collective work.

District Court (1997): Held for *NY Times*. Said the database was a revision. A "significant original aspect" was preserved by the publisher heaving into the database all the articles from the original collective work. Highlighted the original work by showing author's name, issue and page numbers.

And of course that's what's important to profs — what the high tone journal was and what year. Not the other thematically unrelated articles surrounding it. Indeed, National Geographic or even People Magazine function pretty much the same.

I know. You want the entire *Cosmo Special D.C. Intern Edition*. "Dating That Married Congressman." "Thonging' the Prez and Other Opening Gambits." "Phone Sex Dos and Don'ts." "Black Dog Souvenirs: Keep or Throw-away?" The context is invaluable for the scholar.

Second Circuit (1999): **Reversed**. Said § 201(c) does not permit the publisher to sell

a hard copy of the article. Databases are just a delivery system for this violation instead of the US mail or that Chem Abstracts Kiosk that eggheads are always seeking.

Supreme Court (2001): **Writers win**. LEXIS spits out individual articles — not in the original context — so they're not part of the particular collective work and not a revision and not part of a later collective work in the same series.

So Why Is That?

Prior to 1976, an author could lose all rights when putting an article in a collective work if the publisher refused to print a copyright notice in the author's name. 3 M. Nimmer & D. Nimmer, *Nimmer on Copyright* § 10.01[C][2], p. 10-12 (2001); Copyright Act of 1909, § 18, 35 Stat. 1079. Further, copyright was considered indivisible, making it impossible for an author to assign limited publication rights and necessitating the transfer of the total copyright under a contract that might or might not provide for re-transfer back to the author.

But the publisher presumably would always drag his feet about returning the copyright because he was trying to build a backlist and sell his company to a ravenous conglomerate.

So the 1976 Act created a "bundle of discrete exclusive rights" § 106, each of which "may be transferred ... and owned separately." § 201(d)(2). "Copyright in each separate contribution to a collective work is distinct from copyright in the collective work as a whole."

When an author contributes to a collective work, copyright in his output vests first in him. Copyright in the collective work vests in the publisher. § 201(c) of the Copyright Act

And a single notice of copyright as to

the collective work suffices to protect the author's interest as well. § 404(a).

If the publication of the freelance writer's work stirred interest, the writer could resell the article. This protection for the writer would be compromised if the publisher could sell individual articles or put the article in a new collective work.

If the publisher could sell individual articles out of the collection, the author's bit of the bundle would be worthless. *See Gordon, Fine-Tuning Tasini: Privileges of Electronic Distribution and Reproduction*, 66 Brooklyn L. Rev. 473, 484 (2000).

The publisher's right was limited to publishing the article (a) in the collective work, (b) in a revision, or (c) a later collective work in the same series.

Publishers saw the database as a revision of the collective work. The Court majority fixated on the definition of copyright being in "original works fixed in any medium from which they can be perceived." Open the newspaper and you perceive it on a place on a particular page. Viewing the electronic article from the perspective of a database user, it is now read without graphics, formatting or surrounding articles. As the database expanded to include thousands or millions of files, the user would come to see the article as part of no larger work at all, but rather a stand-alone.

A revision is a new version of the older work. "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." 121 S. Ct. 2391.

"That each article bears marks of its origin in a particular periodical ... 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." *id.*, 2393, n9,

Other Media

So what about microfilm and microfiche? Aren't they pretty much the same thing as a database? The Court said no, they are a conversion of intact periodicals from one form to another.

Well, they do whack out a lot of the ads.

The dissent (Stevens and Breyer if you're a S. Court groupie) poked an interesting hole in this. A braille version is a revision. So is a foreign language version. And so would be a

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floppy disk with all of one edition of the *NY Times*. And the disk wouldn't have the lay-out, formatting or page-turning pleasure which the majority seemed so committed to preserving.

So then why, they ask, isn't it a revision to heave all of that day's *Times* into a database with yesterday's and tomorrow's?

Yes, why, indeed? Which is what we've been agonizing over for five years.

Public Policy

Yeah, what about that? The purpose of copyright is to have a whole bunch of new knowledge being created because authors will get paid for it. But the objective is the knowledge.

You have to agree that anyone who wants an article will find it easier to go to LEXIS than to track down the Tasinis of this world and ask their price. But *Tasini* never planned on mailing off photocopies of his work with an invoice for five dollars. The right that was being granted him by the 1976 revision was to sell the article to another publisher who would put it in a collective work — *The Best of J. Tasini*.

Has this holding helped him or hurt him? Will it motivate him to write more or less?

The Majority saw the LEXIS sale of individual articles as allowing a reader to evade buying a new anthology or other collective work.

But does it really? *The Omnibus of Boring Scribes & Sundry Hacks* will never be put in print. But if *Tasini* becomes a hot author, readers will want *The Compleat Tasini* on their shelves without having to scrounge up multiple print-outs from LEXIS.

Isn't the real end result the elimination from the historical record of newspapers and other texts going back for decades?

Which of course drives **Chuck Hamaker et al** into a blind rage. See: *Chuck Furibundus, ATG*, Vol. 13-4.

Domain Names - Cybersquatting

Joseph Shields as the Joe Cartoon Company v. John Zuccarini, 254 F.3d 476 (3d Cir); 2001 U.S. App. LEXIS 13288.

For fifteen years, **Joe Shields** has marketed his cartoon hits "Frog Blender" and "Micro-Gerbil" for t-shirts, mugs and other items so vital to the American lifestyle. His "shock" website joecartoon.com gets 700,000 hits a month.

Yes, we're in the wrong business. We should have sent in our money to the Famous Artists' School back when we were twelve.

And of course the Court is aware of Chuck and addressed his concerns in saying the publishers will simply negotiate payments to the authors and referenced models for distributing copyrighted works and remunerating authors. See, e.g. 17 U.S.C. § 118(b); *Broadcast Music Inc. v. Columbia Broadcasting System, Inc.*, 441 U.S. 1, 4-6, 10-12 (1979).

But as Chuck sagely points out, that's a forward looking solution and doesn't address the loss of history. And the forward solution is going to be handled anyway by really vicious contracts rammed down the authors' throats.

Have you seen the ones that reference "all rights anywhere in the Universe"?

Zuccarini is in the domain name "whole-sale" business of registering variations of domain names to surround a website and capture the ham-fingered and unwary. With 3,000 sites with such names as gwenythpaltrow.com and rikymartin.com he has been averaging an income of \$800,000 to \$1,000,000 a year.

Now you know you're really in the wrong business. As you've all fallen victim to this, I don't have to describe in any great detail how
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you get mousetrapped into a nightmare of ads from which there is no escape except shutting off your computer.

Wholesalers became such a national problem, that Congress passed the **Anticybersquatting Consumer Protection Act** making it illegal to register in bad faith a domain name "identical or confusingly similar" to that of another person or company. 15 U.S.C. § 1125(d)(Supp. 2000). Statutory damages may be awarded from \$1,000 to \$100,000 per domain name. 15 U.S.C. § 1117(d) (Supp. 2000).

Zuccarini had bracketed joecartoon.com with multiple variations like joecarton.com. Shields sent cease and desist letters to Zuccarini who promptly labeled his sites as a protest against animal mutilation. Naturally he was doing it "for the children".

On the District Court level, Shields got a summary judgment \$10,000 for each domain name plus \$39,000 and change for attorneys' fees.

On appeal, the court noted that the ACPA was designed to combat "cybersquatting" — profiting from the goodwill associated with trademarks of others.

Not to mention infuriating the oafs who can't spell Britnee Spears or Pamela Amberson properly.

The first two elements of the ACPA claim were easily met. "Joe Cartoon" is a distinctive mark, and Zuccarini's domain names were confusingly close. Joe Cartoon had been around for fifteen years and the web site for five. The *NY Times* had run a page one story on Joe Cartoon. See Andrew Pollack, "Show Business Embraces the Web, But Cautiously," *N.Y. Times*, Nov. 9, 1999, at A1.

I'm just guessing from this, but it looks like he started out with only a single cartoon image of a frog in a blender. Only eight years later did he animate it. Do you realize the money we could make off squashing various critters with a steam roller? We were raised on Wile E. Coyote, by gosh! While we were wasting our time in grad school, Shields was pushing the envelope.

Shields had numerous emails of complaint from his army of fans who had blundered into mousetraps. Zuccarini even admitted to his personal amazement at the number of folks who mistype.

Zuccarini argued the act only outlawed grabbing a site using a famous name, then selling it back to the celebrity — and not "typosquatting" as he persisted in calling it. The court read him the language of the act (*presumably slowly*) and noted the legislative history of cybersquatting which included kiddies typing in

"dosney.com" and finding hardcore pornography.

You can go to Explorer and find 'dosney' later on. Settle down and let's get through this.

The final requirement was to find that Zuccarini acted in bad faith. Zuccarini had never used his sites to sell goods or services or as trademarks. Thus he had no intellectual property rights in the names. § 1125 (B)(i)(I)(II).

Zuccarini had knowingly registered thousands of confusing names for commercial gain. And he admitted to it. Hence bad faith. See *Northern Light Tech., Inc. v. Northern Lights Club*, 236 F.3d 57, 65 (1st Cir. 2001).

Zuccarini claimed he was protesting ger-

bil micro-zapping and he had a First Amendment right to take this needed stand. The district court called his defense a "spurious explanation cooked up purely for this suit." *Shields*, 89 F. Supp. 2d at 640. The Third Circuit agreed and pointed out he had only gone into a protest mode a few hours after been served with the lawsuit.

O.K. I did it. I paused in finishing this in-depth case analysis and checked out joecartoon.com.

It exceeded my expectations.

Twisted-tubbies. Stump the three-legged dog. Beaver Ranger with puns about ... well, you can see for yourself.

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Legally Speaking — Copyright and Distance Education

by **Bryan M. Carson, J.D., M.I.L.S.** (Coordinator of Reference and Instructional Services, Western Kentucky University, Bowling Green, KY 42101; Phone: 270-745-5007; Fax: 270-745-2275) <bryan.carson@wku.edu>

The thing that hath been, it is that which shall be; and that which is done is that which shall be done: and there is no new thing under the sun.¹

Is the Internet "different?" Does the Internet change everything? Or is the Internet merely a new delivery technique for existing resources? These are fundamental questions that go beyond the delivery of library services, creating legal questions and touching the social fabric of our lives.² Today it is possible to obtain a Ph.D. from a regionally accredited institution without ever setting foot on the university's campus.³ Internet-based distance education raises many issues, including a number of legal issues that have implications for librarians and for publishers.

The idea of distance education is not really new. Correspondence courses first became popular in the early years of the twentieth century. The University of South Africa has been a leader in the field, even granting a law degree to **Nelson Mandela** while he was in prison. However, the new delivery format of the Internet has popularized distance education and made it much more common.

The problem of copyright is one of the issues connected with distance education. The current copyright law contains exceptions for the educational use of

materials, but the mode of delivery of distance education raises new issues.

Let's begin by reviewing the status of copyright law in traditional on-campus education. If you are teaching a class on campus, copyright law allows you to make copies of articles for your students. You can show movies in class. You can play music. This is all perfectly legal because of the fair use provisions under section 107 of the copyright law,⁴ and the educational performance exceptions listed in section 110.⁵

I have discussed fair use before in this column, so I will just give a brief summary. According to §107, "the fair use of a copyrighted work, including such use by reproduction in copies or phonorecords or by any other means specified by that section, for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research, is not an infringement of copyright."⁶ Even though the author of the work has the exclusive right to control what is done with his or her work, it is our First Amendment right to criticize, critique, or parody that work. According to **Duke University** law professor **David L. Lange**, the fair use provisions give copyright "breathing space" so that our First Amendment freedom of speech rights are not infringed upon by the copyright laws.⁷

Section 110(1) allows "performance or display of a work by instructors or pupils in the course of face-to-face teaching activities of a nonprofit educational institution, in a classroom or similar place devoted to instruc-

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