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Cases of Note — Copyright Tasini v. The New York Times

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Tasini v. The New York Times, 972 F.Supp. 804, (S.D.N.Y.1997), reconsideration denied, 981 F.Supp. 841 (S.D.N.Y.1997), 1997 Copr.L.Dec. P27, 672, 43 U.S.P.Q.2d 1801, 25 Media L. Rep. 2057.

Tasini is of parallel interest to the CARL litigation. If any of you copyright junkies get in a lather of excitement over this, go back and read Cases of Note Vol. 10#6.

Free-lance writers sued the *NY Times* and other publishers of collective works for placing their articles in electronic databases and on CD-ROMs without writer permission.

Remember, all those salaried staff writers are performing “work for hire” and the Gray Lady owns the copyright in toto.

Along with the *NY Times*, the distinguished list of defendants included *Newsday*, *Time*, *The Atlantic Monthly*, The MEAD Corporation (LEXIS/NEXIS) and UMI. NEXIS of course is the online, electronic, computer assisted text retrieval system. UMI produces “*The New York Times OnDisc*” which is like NEXIS.

Authors contracted verbally with the *NY Times*. They’d call an editor, pitch an idea, agree on a price and deadline. Likewise *Sports Illustrated* (Time, Inc.) except *SI*’s check contained the language “this check accepted as full payment for first-time publication rights to material.”

As you would guess, the “contracts” were a snarl. Sometimes the checks included “right to include in electronic library archives.” Sometimes, the authors crossed out that part; sometimes not.

Online NEXIS customers buy a package that permits access to the mainframe “libraries.” NEXIS does not imitate the full page layout of the original compilation. There are no photographs or captions. Rather, the customer conducts a Boolean search for individual articles which have citations to the author, date and page in the original compilation.

Defendants moved for Summary Judgment and won.

In a collective work, “a number of contributions, constituting separate and independent works in themselves, are assembled into a collective whole.” 17 U.S.C. § 101. Publisher/author rights are found in 17 U.S.C. § 201(c).

Copyright ownership of an article begins with the author and is transferred to the publisher by contract. Without an express agreement, the publisher acquires only the right to publish and distribute that article as (1) part of the collected work, (2) a revision of it, or (3) a later collective work in the same series.

Plaintiffs argued that the electronic format was not a revision of the collected work.

Defendants argued they were. *But first some other stuff of interest.*

Written Evidence Needed

Defendants *Newsday* and *Time* claimed
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their authors had expressly transferred electronic rights through cashing the checks with the one-line contractual agreement. The need for written evidence of such a transfer is found in § 204(a) of the Act. It requires “an instrument or conveyance, or a note or memorandum ... in writing and signed by the owner of rights conveyed ...”

“[A] writing memorializing the assignment of copyright interests ‘doesn’t have to be the Magna Carta; a one-line pro forma statement will do.’ However, the terms of any writing purporting to transfer copyright interests, even a one-line pro forma statement, must be clear.” *Papa’s-June Music, Inc. v. McLean*, 921 F.Supp. 1154, 1158-59 (S.D.N.Y.1996) (citing Effects Associates, Inc. v. Cohen, 908 F.2d 555, 557 (9th Cir.1990)).

Newsday had put the articles into electronic format before the authors received or cashed the checks. Basic contract law says the parties must have a meeting of the minds on all material elements of a contract. *Newsday’s* one line on the checks was not evidence of any mutual understanding as to rights. They did not validate any prior oral agreement.

Further, the one line was ambiguous in the case of permission to place in “electronic library archives.” Plaintiffs successfully argued that “electronic library archives” and a commercial database like NEXIS serve very different purposes. c.f. *American Geophysical Union v. Texaco Inc.*, 60 F.3d 913, 919 921 (2d Cir.1995). Also, *Newsday* admitted it maintained “electronic library archives” as a storage system without a commercial purpose.

Right of First Publication

Authors gave *Time* a right of first publication and nowhere in the agreement was there a limitation on the form of media. *Bartsch v. Metro-Goldwyn-Mayer, Inc.*, 391 F.2d 150 (2d Cir.) and a series of related cases hold that the burden lies on the grantor to frame any exceptions when new technological uses exist. However, none of the cases deals with a contract containing a “first publication right.”

Our plaintiffs’ articles first appeared in print. Next they appeared in electronic form in NEXIS. First publication right cannot mean a right to publish “first” in each and every format available. *Harper & Row, Publishers, Inc. v. Nation Enterprises*, 471 U.S. 539, 564, 105 S.Ct. 2218, 2232, 85 L.Ed.2d 588 (1985). (“The right of first publication encompasses not only the choice whether to publish at all, but also the choices of when, where, and in what form first to publish a work.”)

Revision or Not?

201(c) allows publishers to reproduce an article “as part of ... any revision” of the collective work in which it initially appeared.

They may not place them in new anthologies, entirely new magazines or other collective works. See *Quinto v. Legal Times of Washington, Inc.*, 506 F.Supp. 554 (D.D.C.1981) (law school newspaper could not authorize a separate newspaper to reprint an article).

Plaintiffs used the analogy of a revised encyclopedia to insist that revisions must be minor. *In the closest thing I’ve ever seen to a judicial quip*, the Court pointed out that the Copyright Act of 1976 was a “revision” of the 1909 Act and yet completely changed copyright law.

Still, the original work must be recognizable. Change the original selection and arrangement and you have created a new work. Significant original aspects of the collective work must be preserved. Otherwise, the publisher is exploiting the component parts.

Feist holds that little originality is required to trigger copyright protection to a compilation. However, great care must be given in preserving the original selection or arrangement in the revision.

What original characteristics must be preserved?

More than a “certain percentage” of the original work must be copied. *Of course you’re saying, “How much?” And you guessed it. The Court doesn’t say. But it doesn’t matter because...*

The *NYTimes* selects “all the news that’s fit to print.” This editorial determination is a task with a more than ample element of creativity to provide copyright protection. This selectivity is preserved in feeding the articles into the database. And all of the articles are fed into the database. Not just a “certain percentage.” NEXIS does no selection of its own that might create a separate collective work.

Plaintiffs argued that the articles were immersed in a sea of countless articles from other periodicals. The Court found this solved by the highlighted connection—publication, issue, and page number—between an article and the hardcopy periodical where it first appeared. This tagging of the articles made the original selection evident.

Plaintiffs analogized this to chopping up a car engine and selling its individual parts. They said the compilation was disassembled to create value in each article. *They described the car as a wrecked car, I guess meaning it had no more value as a collective work.*

The Court noted that much of the value of an article—its credibility—is derived from it appearing in a particular periodical—indeed in its being published at all. *In other words, the car is not wrecked?*

Much originality—photographs, captions and page lay-out is indeed lost when you pour articles in NEXIS. Remember, though, a revision is a changed version. It only must be recognizable as a version of the original.

Originality in a compilation exists in (1) selection and (2) arrangement. In a revision one of these will be changed or entirely lost. The NEXIS format loses arrangement but keeps selection.

The Court reasoned that NEXIS and CD-ROMs serve the same purpose as a hardcopy newspaper. By using electronic format, they permit access with a new efficiency. A newspaper may be read on a bus, or it may end up in the stacks of a library. Researchers may dredge up the Jan. 1, 1999 edition of the *NY Times* from the stacks or from a CD-ROM, but it’s still the Jan. 1, 1999 *NY Times*.

Okay. Now distinguish this from UnCover selling individual articles. Exploiting the parts of a collective work cry the authors! You’re ripping it into its component bits and not selling it “as part” of the whole. Not a revision!

Wrong! reply the document delivery services. Selection is preserved by tagging the source of the articles. And since it’s a direct photocopy, much of the arrangement is preserved. Selection plus much of the arrangement equals originality which equals a revision. Kind of.

Except you’ve feverishly checked Vol 10 #6 and discovered UnCover didn’t argue that. It asserted that the individual articles sold were still part of the collective work. Since owners of copyright in a book are entitled to authorize copying of part of the book, owners of collective works should logically have the same right as long as it’s tagged to show its place in the big work. And that it made economic nonsense to sell a photo of the entire journal at high cost rather than one article at low cost.

Much ado about nothing? Written contracts with authors will solve the whole problem.

*And one day soon, technology will permit NEXIS to reproduce a visual reproduction of the *NY Times* replete with photos and headlines.*

*And now that you’ve strained your brain to the point of exhaustion, a small voice of reason is saying “What the ...?” *NY Times* sells articles through a third party—NEXIS. Scholarly journals sell individual articles through a third party—UnCover.*

What on earth did Congress intend by 201(c)? That authors and collected works publishers would have simultaneous rights to authorize copying of an individual article? That each could exploit it financially? 🐻

“Feist holds that little originality is required to trigger copyright protection to a compilation.”