November 2013

Cases of Note-Tasini v The New York Times

Bruce Strauch
The Citadel, strauhb@citadel.edu

Jack G. Montgomery
Western Kentucky University

Anne F. Jennings
Sinkler & Boyd, infofacto_aj@charleston.net

Follow this and additional works at: http://docs.lib.purdue.edu/atg

Part of the Library and Information Science Commons

Recommended Citation
DOI: https://doi.org/10.7771/2380-176X.3732

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 — Copyright
Tasini v. The New York Times

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


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.

Freelance 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 these salaried staff writers are performing “work for hire” and the Gray Lady owns the copyright in '90.

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 continued on page 52

YOUR SPECIALIST FOR ALL PUBLICATIONS FROM

WESTERN EUROPE

(INCLUDING UNITED KINGDOM)

- Experienced, full service subscription agent & bookdealer based in The Netherlands with Liaison Offices all over the world, including North America
- Multilingual, highly educated, dedicated personnel
- Approval plans for material from The Netherlands, Belgium, Luxembourg, France, Scandinavia
- Consolidation services for journal subscriptions
- Automatic claiming, management reports, bibliographic update service
- Electronic access to online database
- Electronic invoicing and prepayment options
- Reduced service charge plans for journal subscriptions
- Monthly publications on new and forthcoming monographs, series, journals and other media

For more information visit our website: http://www.nijhoff.nl

Or contact us at:
HEADQUARTERS
P.O. Box 1853
2700 CZ Zoetermeer
The Netherlands
Phone: +31 79 3684400
Fax: +31 79 3615698
E-mail: csna@nijhoff.nl

LIAISON OFFICE
719 Mohawk Terrace
Clifton Park, NY 12065
Phone: 800 664-1853
Fax: 518 373-0047
E-mail: endres@nijhoff.nl

LIAISON OFFICE
29 Pridemark Lane
Atleboro, MA 02703
Phone: 508 346-3662
Fax: 508 226-1670
E-mail: middeldorp@nijhoff.nl
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. (American Geophysical Union v. Texaco Inc., 60 F.3d 913, 919-21 (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. Bartsh 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. 559, 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 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 into 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 cries 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 rights as long as it's tagged to show its place in the big work. And that it made economic sense 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 print 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? 