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**OWNERSHIP OF ELECTRONIC PUBLISHING
RIGHTS IN COLLECTIVE WORKS:
*NEW YORK TIMES CO. V. TASINI***

Colby B. Springer†

Edited by Melinda K. Stanish‡

I. INTRODUCTION

In a June 25, 2001, 7-2 decision,¹ the United States Supreme Court struck down a long-standing misinterpretation of the copyright laws as applied to collective works. This new interpretation represents a potentially colossal financial windfall for freelance authors, while throwing a time consuming and costly wrench into the gears of the multi-million dollar business that is on-line periodical storage and retrieval.²

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1. *New York Times Co. v. Tasini*, 533 U.S. 483 (2001) (Ginsburg, J.). Justice Stevens authored a dissenting opinion in which Justice Breyer joined.

2. Reed Elsevier, the parent company of on-line database LexisNexis, reported operating profits in excess of the equivalent of \$377 million dollars for its 2001 legal operations, including LexisNexis and Martindale Hubbell. REED ELSEVIER, REVIEW OF 2001 FINANCIAL PERFORMANCE: REVIEW OF OPERATIONS, LEGAL, *available at* <http://www.reedelsevier.com/investors/accounts/2001/annualreport/financial/rfp/review2.htm> (last visited Apr. 14, 2002). The Thomson Corporation, parent company of on-line legal

The Supreme Court held that the New York Times Company and several other print periodical publishers, including Newsday, Inc. and Time, Inc.,³ had infringed upon a litany of the exclusive rights⁴ of the respondent authors by reproducing and distributing the authors' works in electronic storage databases—an action neither authorized nor privileged by any provision of the Copyright Act of 1976.⁵ In reaching this conclusion, the Supreme Court drastically recast the mold that, for decades, had steered an entire industry's interpretation of section 201(c) of the Copyright Act and the boundaries of ownership rights in collective works. Of more importance, however, is the fear that the Supreme Court may have inadvertently "punch[ed] gaping holes in the electronic record of history."⁶

II. FACTUAL BACKGROUND

Between 1990 and 1993, a group of six freelance authors, including the named respondent, Jonathan Tasini, wrote a total of twenty-one articles that became the epicenter of this dispute.⁷ All of the authors worked as independent freelancers with no formal, structured contracts securing the placement of these disputed articles in any electronic database.⁸ Following publication of these articles in

database Westlaw, reported legal revenues for 2001 of \$2.8 billion dollars. Press Release, The Thompson Corporation, Thompson Reports 2001 Full-Year and Fourth-Quarter Results (Feb. 27, 2002), available at <http://thomwww02.completeinet.net/PressRelease/pr173.html> (last visited Apr. 14, 2002). It should be noted that this figure also includes revenues generated by trademark searches and other on-line legal activity. A figure reflecting revenues generated solely by Westlaw was unavailable at the time of publication.

3. The New York Times Company is the publisher of *The New York Times*, Newsday, Inc. publishes *Newsday*, a local newspaper in New York City and Time, Inc. is the publisher of *Sports Illustrated*. Each of these newspapers and periodicals published at least one article of the respondent authors. *Tasini v. New York Times Co.*, 972 F. Supp. 804, 806 (S.D.N.Y. 1997).

4. Among the more relevant rights granted by the Copyright Act of 1976 are those of reproduction, distribution and display. 17 U.S.C. § 106(1), (3), (5) (2001).

5. See *New York Times Co. v. Tasini*, 533 U.S. 483, 506 (2001).

6. *Id.* at 505. Such a fear arises from the fact that thousands of freelance authors have contributed to the tapestry of literary, educational and journalistic history and whose works are currently stored in electronic databases. These authors, in light of this decision, could pursue actions for copyright infringement in addition to forcing the removal of their content from these databases and the annals of history.

7. *The New York Times* published twelve of those articles while another eight found their way into the pages of *Newsday*. *Sports Illustrated* published the remaining article. *New York Times Co. v. Tasini*, 533 U.S. at 488–89.

8. While some of the authors had contracts with the publishers regarding payment schedules, royalties, and the surrender of certain rights, the contractual issues had long been disposed of by the time the case reached the Supreme Court and were of no relevance in the decision. See *New York Times v. Tasini*, 533 U.S. at 489 n.1; *Tasini v. New York Times Co.*, 972 F. Supp. at 811–12.

the traditional print medium, the three publishing entities converted the articles to electronic format and delivered the converted material to three providers of electronic print material: LexisNexis (Lexis), the New York Times OnDisc (NYTO) and General Periodicals OnDisc (GPO).⁹

In the case of Lexis, a third-party user can conduct a search of the Lexis electronic database using criteria such as author, subject, date, publication, headlines, or key terms.¹⁰ Following a search of the database, Lexis provides a list of numerous articles that match certain combinations of the aforementioned search criteria; the user can then retrieve the desired articles. “Each article appears as a separate, isolated ‘story’—without any visible link to the other stories originally published in the same newspaper or magazine edition.”¹¹ Articles retrieved from the Lexis database are entirely textual in nature and do not contain pictures or advertisements that may have accompanied the content in the print original nor do they “reproduce the original print publication’s formatting features such as headline size, page placement . . . or location of continuation pages.”¹²

The NYTO, to which the New York Times Company also licensed its newspaper content, works in a similar manner. Articles appear in the NYTO electronic database “in essentially the same way they appear in [Lexis], i.e., with identifying information (author, title, etc.), but without original formatting or accompanying images.”¹³ Unlike Lexis, however, the NYTO contains *only* content from *The New York Times* (*The Times*), whereas Lexis contains content not only from *The Times*, but also from other publications throughout the world.

The third and final database, GPO, differs slightly in its operation from Lexis and NYTO. A user accessing GPO can find content from approximately 200 different publications; the database is image-based, however, as opposed to the text-based systems of NYTO and Lexis.¹⁴ While the manner of searching the GPO is almost identical, the retrieved product is a visually perceptible *burned image* of any particular article. An article retrieved using GPO is displayed “exactly as it appeared on printed pages, complete with

9. See generally *Tasini v. New York Times Co.*, 972 F. Supp. at 807–09.

10. *New York Times Co. v. Tasini*, 533 U.S. 483, 490 (2001).

11. *Id.*

12. *Id.*

13. *Id.*

14. *Id.*

photographs, captions, advertisements, and other surrounding materials.”¹⁵ While entire publications are available via GPO, a search does not necessarily provide the entire publication in response to a query. Rather, a user’s retrieved article is simply presented in the larger context of the page on which it originally appeared in print.

III. PROCEDURAL HISTORY AND THE ROLE OF 17 U.S.C. § 201(c)

Brought by Respondent Tasini and five fellow authors in late 1993, the original lawsuit challenged the appellant publishers’ placement of the freelancers’ articles in electronic, collective databases, like Lexis, NYTO, and GPO, as permitted by section 201(c) of the Copyright Act.¹⁶ The publishers maintained they had not improperly exploited the authors’ individual works because the act of electronic storage fell under the *revisions clause* of 17 U.S.C. § 201(c).¹⁷

Section 201(c) of the Copyright Act provides:

Copyright in each separate contribution to a collective work is distinct from copyright in the collective work as a whole, and vests initially in the author of the contribution. In the absence of an express transfer of the copyright or of any rights under it, the owner of copyright in the collective work is presumed to have acquired only the privilege of reproducing and distributing the contribution as part of that particular collective work, *any revision of that collective work, and any later collective work in the same series.*¹⁸

With the understanding that a *collective work* is “a periodical issue, anthology, or encyclopedia, in which a number of contributions, constituting separate and independent works in themselves, are assembled into a collective whole,”¹⁹ the publishers based their argument upon what constitutes a *revision* under Section 201(c) of the Act. The publishers asserted that it is possible to revise a collective work by changing the *original whole* of a work without

15. New York Times Co. v. Tasini, 533 U.S. 483, 491 (2001).

16. As the district court could not “find that any of the [authors] expressly transferred electronic rights in their articles, the numerous arguments and voluminous record in this case devolve[d] to whether the electronic [publishers] produced ‘revisions,’ authorized under Section 201(c) of the Copyright Act, of the publisher[s] . . . collective works.” Tasini v. New York Times Co., 972 F. Supp. 804, 812 (S.D.N.Y. 1997).

17. *Id.* at 809.

18. 17 U.S.C. § 201(c) (2001) (emphasis added).

19. 17 U.S.C. § 101.

actually altering the *content* of the individual contributions.²⁰ Then District Judge Sonia Sotomayor agreed, concluding that Congress, in drafting section 201(c), “was willing to permit publishers significant leeway, *i.e.*, the leeway to create ‘any revision’ of their collective works.”²¹ According to Judge Sotomayor, the scope of that permissible revision includes transferring copyrighted content from print to an electronic database format, as was the case here.²²

The district court granted summary judgment in favor of the publishers, finding the transfer of the original collective works into electronic storage, albeit in broken form, did not constitute an infringement as the periodicals manifested an “original selection” of articles and the fact that the originality of that selection was preserved in the transfer rendered the works in electronic format “permissible revisions of the publisher defendants’ collective works.”²³ In making its finding, the court specifically noted that “the electronic technologies not only copy the publisher defendants’ complete original ‘selection’ of articles, [but] tag those articles in such a way that the publisher defendants’ original selection remains evident online.”²⁴

Tasini appealed to the Second Circuit²⁵ and found unanimous favor with a bench that failed to discern a “feature particular to the databases at issue . . . that would cause [the court] to view them as ‘revisions.’”²⁶ The Second Circuit found that electronic databases, like Lexis, were comprised of “thousands or millions of individually retrievable articles taken from hundreds or thousands of periodicals” and that *mere placement* of an individual article from a larger collective work in such a database could “hardly be deemed a

20. See *Tasini v. New York Times Co.*, 972 F. Supp. at 820.

21. *Id.* at 819.

22. *Tasini v. New York Times Co.*, 972 F. Supp. 804, 819–20 (S.D.N.Y. 1997); *cf.* *Tasini v. New York Times Co.*, 972 F. Supp. at 816 n.7 (the authors “undermine their arguments by struggling with the copyright implications of microfilm, a high resolution film which permits users to scroll through entire issues of periodicals . . . [I]f it is ‘possible’ that Section 201(c) permits microfilm reproductions of collective works, it is impossible that Section 201(c) prohibits reproductions in a new medium.”).

23. *Tasini v. New York Times Co.*, 972 F. Supp. at 822.

24. *Id.* at 824. By “tagging” an article, Judge Sotomayor was referring to the “header” that appears at the top of most articles retrieved from an electronic database that indicates the initial publication date, periodical, page number and so forth. See *New York Times Co. v. Tasini*, 533 U.S. 483, 490 (2001).

25. Tasini first presented a motion for reconsideration that was denied. *Tasini v. New York Times Co.*, 981 F. Supp. 841 (S.D.N.Y. 1997).

26. *Tasini v. New York Times Co.*, 206 F.3d 161, 168 (2d Cir. 2000).

'revision' of each edition of every periodical" it contained.²⁷ More important, the Second Circuit noted that electronic databases did "almost nothing to preserve the copyrightable aspects of the Publishers' collective works, 'as distinguished from the preexisting material employed in the work.'"²⁸ The court frowned upon the publishers' assertions as to what constituted a revision and held that the electronic databases were simply reproducing the "preexisting materials that belong to the individual author under Sections 201(c) and 103(b)."²⁹

IV. SUPREME COURT DISCUSSION AND ANALYSIS

With victories for both parties in the lower courts, an appeal to the Supreme Court was inevitable. The Supreme Court, like the district and appellate courts below, elected to focus on the issue of what constitutes a *revision* and to determine whether the storage of individually copyrighted works, once part of a larger collective work, in an electronic database does, in fact, result in their becoming revisions as permitted under Section 201(c) of the Copyright Act. Justice Ginsburg's majority opinion postulated that "[o]ne might view the articles as parts of a new compendium—namely, the entirety of works in the [electronic] Database."³⁰ Just as quickly as the proposition was made, though, it was cast aside; the Court found that the database, under such a theory, "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."³¹ Correcting the district court's initial error, the Court clearly articulated that a revision "denotes a new 'version,' and a version is, in this setting, a 'distinct form of something regarded by its creators or others as one work.'"³²

27. *Id.*

28. *Id.* (quoting 17 U.S.C. § 103(b)); *see also generally* Feist Publ'ns, Inc. v. Rural Tel. Serv. Co., 499 U.S. 340 (1991) (discussing the necessary requirements for copyright protection in a factual listing or similar work, like a compilation).

29. *See Tasini v. New York Times Co.*, 206 F.3d at 169. Section 103(b) provides, in part, that the copyright in a collective work is "independent of, and does not affect . . . any copyright protection in the preexisting material." With the originality in selection and placement that constitutes a collective work eliminated by the piecemeal placement of collective works in these databases, the only copyright that remained was the authors'—a copyright that by no means had been surrendered.

30. *New York Times Co. v. Tasini*, 533 U.S. 483, 500 (2001).

31. *Id.*

32. *Id.* (quoting WEBSTER'S THIRD NEW INTERNATIONAL DICTIONARY 1944, 2545 (1976)). Recall that Judge Sotomayor found that the conversion of copyrighted content from

The Supreme Court also made short work of the microfilm/electronic database analogy that the publishers had presented in the district court.³³ The Court conceded that although a microfilm roll contains multiple editions of a collective work, such as *The New York Times*, and the user can “adjust the machine lens to focus only on the [a]rticle [he desires], to the exclusion of surrounding material,” the article remains encountered “in context,” for it “appear[s] on the microforms, writ very small, in precisely the position in which the articles appeared in the newspaper.”³⁴ In contrast, the electronic databases were “disconnected from their original context” and did “not perceptibly reproduce articles as part of the collective work to which the author contributed or as part of any ‘revision’ thereof.”³⁵

The Court also dismissed as inapplicable the *media neutrality*³⁶ argument, raised by *The Times* and fellow publishers in a last-ditch defense. While the Court did recognize the media neutrality concept, the current situation did not allow for its appropriate application as the electronic databases were found to “offer users *individual* articles, not *intact* periodicals.”³⁷

Providing a hypothetical to further its analysis, the seven-member majority presented the idea of an imaginary file room that, instead of intact books and periodicals, contained separate copies of each individual article of authorship in separate files that retained the original periodical’s name and date, article headlines, and page numbers.³⁸ At the request of a patron to this file room, the attendant would retrieve desired articles based on the search parameters set forth by the requesting patron. The Court could not, “consistent with ordinary English usage,” claim that the articles in this file room were

print to an electronic medium satisfied the revision standards of section 201(c). *See generally* *Tasini v. New York Times Co.*, 972 F. Supp. 804, 820 (S.D.N.Y. 1997).

33. *New York Times Co. v. Tasini*, 533 U.S. at 501.

34. *Id.*

35. *Id.* at 501–02. The Court did address the interesting difference between the way in which retrieved articles are presented by GPO (visual images) and by Lexis and NYTO (textual files) when it wrote that while a GPO user might view a given article within the context of the rest of the page on which it was originally published (for example, page 26), such context was lacking in that pages 25 or 27, or even the remainder of the magazine, were not immediately present. *See id.*

36. As proposed by the publishers, the doctrine of media neutrality would eliminate any copyright issues with the transfer of a work between different media (e.g., from print to electronic) and where the copyrighted work’s character was not otherwise altered. *New York Times Co. v. Tasini*, 533 U.S. 483, 502 (2001).

37. *Id.* (emphasis added).

38. *See id.* at 502–03.

as part of a revision as described by section 201(c); “[i]n substance . . . the [electronic d]atabases differ from the file room only to the extent they aggregate articles in electronic packages . . . while the file room stores articles in spatially separate files.”³⁹ “Such a storage and retrieval system,” said the Court, “effectively overrides the Authors’ exclusive right to control the individual reproduction and distribution of each Article.”⁴⁰

The Court isolated the ultimate issue surrounding the electronic databases and section 201(c) as “not whether a user can generate a revision of a collective work from a database, but whether the database itself perceptibly presents the author’s contribution as part of a revision of the collective work.”⁴¹ It found that whether a third-party user can *reconstruct* the original work using a database is not in and of itself determinative of whether the database is non-infringing. The Court ultimately denied the appellant publishers safe-harbor under section 201(c) of the Copyright Act as the electronic databases “reproduce and distribute articles standing alone and not in context, not ‘as part of that particular collective work’ to which the author contributed, ‘as part of . . . any revision’ thereof, or ‘as part of . . . any later collective work in the same series.’”⁴² As a result, the Court found the print publishers and electronic publishers to have infringed the copyrights of the freelance authors, affirming the judgment of the Second Circuit Court of Appeals.

V. THE PRACTICAL EFFECT OF THE TASINI HOLDING ON ELECTRONIC DATABASES AND PRACTICAL GUIDELINES IN LIGHT THEREOF

Since the Supreme Court decided *Tasini* in June 2001, the administrators of many electronic databases have taken remedial measures to address the new interpretation of the Copyright Act’s section 201(c) by removing articles where electronic publishing rights had not been secured. Nonetheless, these content providers remain potentially liable for their past reproduction and distribution of freelance content.⁴³

39. *Id.* at 503.

40. *Id.* at 503–04. *See also* 17 U.S.C. § 106(1), (3) (2001); *cf.* *Ryan v. Carl Corp.*, 23 F. Supp. 2d 1146 (N.D. Cal. 1998) (finding a copy shop not protected by, and in violation of, section 201(c)).

41. *New York Times Co. v. Tasini*, 533 U.S. 483, 504 (2001).

42. *Id.* at 488 (quoting *Tasini v. New York Times Co.*, 206 F.3d 161, 166 (2d Cir. 2000)).

43. The Supreme Court did not address the extent of this prior infringement and the damages related thereto electing to leave the issue “open for initial airing” with the Southern

In particular, *The New York Times* took immediate action, noting that it “suddenly faces potential liability for decades-old publishing practices that an entire industry believed were explicitly sanctioned by the Copyright Act.”⁴⁴ With the risk of liability “too great to allow any other course of action,”⁴⁵ *The Times* has engaged in an on-going process of removing those freelance articles with unsecured rights from electronic archives. At the same time, *The Times* has set up a process for allowing freelance authors to allow their submissions to remain in the electronic archives if they should so desire.⁴⁶

West Group, the publisher of a similar electronic database called Westlaw announced that “[a]s republishers of information, West Group . . . ensure[s] that contractual agreement with the original publishers allow[s] West Group . . . the right to legally redistribute all materials that publisher provide[s].”⁴⁷ The reinterpretation of § 201(c) per the *Tasini* decision was to be “minimal” in its effect on West, as West had obtained “permission for electronic rights in their agreement with authors” before the suit had been filed.⁴⁸ West further covers works in its electronic database “by legal contract between the original publisher and free-lancer,” thus leaving it unaffected by the *Tasini* decision.⁴⁹ As for those articles not covered by contract or other agreement, West has stated that it “will promptly delete all articles written by free-lance writers who request to have their materials removed from [its] databases.”⁵⁰

Lexis, one of the culprits in perpetuating widespread infringement of freelance material, has elected to “support lobbying efforts in Congress that challenge the Supreme Court’s reading of the

District Court of New York. *See id.* at 506. Respondent Jonathan Tasini, who is also president of the National Writer’s Union, intends to request more than \$600 billion in damages, fees and costs when the district court reconsiders the issue. John Greenwald, *Cyber Payback*, TIME, July 9, 2001, at 38, available at 2001 WL 22574619 and <http://www.time.com/time/personal/article/0,9171,1101010709-166020,00.html>.

44. Statement, The New York Times Company, *Tasini v. NY Times*, at <http://www.nytc.com/pressroom/freelance/> (last visited Apr. 14, 2002).

45. *Id.*

46. *See id.*

47. West Group/Thomson Legal & Regulatory Statement in Response to the *Tasini* decision (on file with author, the Santa Clara Computer and High Technology Law Journal, and available by contacting referenceattorneys@westgroup.com).

48. *Id.*

49. *Id.*

50. *Id.*

legislative history of § 201(c) of the Copyright Act, upon which the decision was based.”⁵¹

Fallout from the *Tasini* decision exists aside from the issue of damages and the extensive housekeeping that must occur with these electronic storage databases. Respondent *Tasini*, who also happens to be the president of the National Writers Union, alleged that the Union has come into possession of internal New York Times memoranda that “recommend that the newspaper not engage” certain individuals “to write for the newspaper” on a freelance basis.⁵² Among those named in the so-called *blacklist* are all of the original plaintiffs in the *Tasini* lawsuit.⁵³

There is also the issue of the decision’s effect on the general public—those who buy *The New York Times*, read the articles therein, and use electronic databases such as Lexis to access the articles for research and review. Justice Stevens, in his dissent, felt the decision “unnecessarily subvert[ed] th[e] fundamental goal of copyright law”⁵⁴—“to secure ‘the general benefits derived by the public from the labors of authors’”⁵⁵—“in favor of a narrow focus on ‘authorial rights.’”⁵⁶ Justice Stevens found the authors’ self-serving interpretation of Copyright Act secondary to the greater good and that such “private motivation must ultimately serve the cause of promoting *broad availability* of literature, music, and the other arts.”⁵⁷

A number of the *amicus curiae* briefs submitted to the Court forewarned of the impact of the *Tasini* decision, as ultimately reached, as potentially devastating. One brief, in particular, made the point that “[t]he efficiency, accuracy, reliability, comprehensiveness and immediacy of access offered by searchable full-text digital archives are but a few of the benefits historians and other researchers

51. Statement of LexisNexis on the Supreme Court’s decision in *New York Times Co. v. Tasini*, in E-mail from Henry Stoeber, Director of Marketing, LexisNexis Academic & Library Solutions, to Tim Jewell, Chair, Academic Universe Content Advisory Committee, International Coalition of Library Consortia (July 3, 2001, 11:05:00 EST) (on file with the Santa Clara Computer and High Technology Law Journal).

52. Press Release, National Writers Union, *The New York Times Blacklist* (Sept. 24, 2001), available at <http://www.nwu.org/tvt/blacklst.htm> (last visited Apr. 14, 2002).

53. *Id.*

54. *New York Times Co. v. Tasini*, 533 U.S. 483, 519 (2001) (Stevens, J., dissenting).

55. *Id.* (quoting MELVILLE B. NIMMER & DAVID NIMMER, *NIMMER ON COPYRIGHT* § 1.03[A] (2001) (quoting *Fox Film Corp. v. Doyal*, 286 U.S. 123, 127 (1932))).

56. *Id.* at 520.

57. *Id.* (quoting *Twentieth Century Music Corp. v. Aiken*, 422 U.S. 151, 156 (1975) (emphasis added by Justice Stevens)).

have reaped from the advancement in the technology of information.”⁵⁸ That efficiency and comprehensiveness is now subject to the reinforced rights of authors under § 201(c).

Justice Stevens’ dissent also found the majority’s decision, and its possible depletion of our culture’s electronic archive of information, “of little, if any, benefit to either authors or readers.”⁵⁹ Analyzing the decision from the standpoint of pure societal benefit, one would tend to agree.⁶⁰ It stands to reason that an author would benefit from the availability of his works via these new electronic forums to a greater extent than would ever be possible solely through the traditional print medium.⁶¹ Furthermore, electronic databases have given other authors a “means to quickly search through scores of complete periodicals,” thereby allowing authors to utilize prior works as references in their own research and writing, ultimately giving recognition to earlier authors as authorities in a given field or subject matter.⁶² It would seem that the value of electronic database works “would be enhanced, not decreased, by the accessibility and readership”⁶³ of the original publication, as would the overall reputation of the author.

Moreover, the Supreme Court’s decision in this case may very well punch holes in the fabric of history, as electronic databases are the apparent future of our literary archives. Not only do these databases provide a streamlined approach to research, and an easily accessible medium in which authors may promote their works, electronic databases also provide a safe and economical means by which to archive literary works. Electronic databases, while unlikely to replace print libraries altogether, are quickly becoming more

58. Brief of Amici Curiae Ken Burns et al. at 8, *New York Times Co. v. Tasini*, 533 U.S. 483 (2001) (No. 00-201), available at <http://www.nwu.org/tvt/sc-burns.pdf> (Jan. 5, 2001) (last visited Apr. 14, 2002).

59. *New York Times Co. v. Tasini*, 533 U.S. 483, 524 (2001) (Stevens, J., dissenting).

60. The United States Constitution gives the Congress the power “[t]o promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries.” U.S. CONST. art I, § 8, cl. 8. The *give and take* of copyright is that authors receive protection and accompanying royalties, for a limited time, while the public receives the general benefit of the authors’ works and contributions. By the majority’s pulling these works out of their existing circulation, this decision benefits only the authors.

61. I am not advocating wholesale usurpation of an author’s right of distribution, but simply questioning at what point a royalty check, in many cases a miniscule one, outweighs the benefits of having one’s work known throughout the subject-matter community.

62. *New York Times Co. v. Tasini*, 533 U.S. at 522 (Stevens, J., dissenting).

63. *Id.* at 521.

comprehensive than their paper-bound brethren. The *Tasini* decision may only curtail this progress.

With regards to practical suggestions, for those entities that have not secured electronic storage database rights, assuring publishing rights in printed and electronic versions, as well as *any version that may later come into being*, might avoid the difficulties associated with the outcome in *Tasini*.⁶⁴

Section 201(c) implications could also be avoided if all freelance material submitted for publication were subject to the works made for hire provision in section 201(b).⁶⁵ However, to constitute a work made for hire, the freelance work must fall into one of the statutory categories defining a work made for hire in section 101 of the Copyright Act.⁶⁶ While a written agreement can easily be drafted using a fill-in-the-blanks form, recall that the freelance publishing industry has been one based on tradition and handshakes.⁶⁷ Of course, this culture will likely change as the freelance community has

64. See, e.g., *Boosey & Hawkes Music Publishers v. Walt Disney Co.*, 145 F.3d 481 (2nd Cir. 1998). In *Boosey & Hawkes*, the issue arose whether the use of a musical composition that had been licensed for a motion picture was likewise permitted in the later laser disc release. The Second Circuit Court of Appeals cited one of its earlier cases in finding, with regards to license language, “[i]f the words [of the license] are broad enough to cover the new use, it seems fairer that the burden of framing and negotiating an exception should fall on the grantor, at least when the new medium is not completely unknown at the time of contracting.” *Id.* at 486 (quoting *Bartsch v. Metro-Goldwyn-Mayer, Inc.*, 391 F.2d 150, 155 (2d Cir. 1968)). The Second Circuit also found that the issue could have been avoided altogether if the license had included an express provision for “future technologies.” See *id.* at 488. This very Journal has avoided any *Boosey & Hawkes/Tasini* difficulties by adopting contract language to secure for itself a grant to publish in “any medium of expression now known or later created.” Author Agreement, Santa Clara Computer & High Tech. L.J. (on file with the Santa Clara Computer and High Technology Law Journal).

65. Section 201(b) provides that “[i]n the case of a work made for hire, the employer or other person for whom the work was prepared is considered the author for purposes of this title, and, unless the parties have expressly agreed otherwise in a written instrument signed by them, owns all of the rights comprised in the copyright.” 17 U.S.C. § 201(b) (2001).

66. A work made for hire is, first and foremost, “a work prepared by an employee within the scope of his or her employment.” 17 U.S.C. § 101. However, freelance authors are independent contractors, not employees. Therefore, to be statutorily identified as a work made for hire, the original work must be “specially ordered or commissioned for use as a contribution to a collective work” or one of the other eleven specific categories of section 101. See *id.*

67. Cf. *Effects Assocs., Inc. v. Cohen*, 908 F.2d 555 (9th Cir. 1990). In *Effects Associates.*, the court determined what was necessary to satisfy the “writing requirement” for a transfer of ownership under Section 204 of the Copyright Act. Circuit Judge Kozinski made it clear that the parties need only sign “a piece of paper” and that “[i]t doesn’t have to be the Magna Charta; a one-line pro-forma statement will do.” *Id.* at 557. One would assume that the formalities required for designating a work a work made for hire would not be any more complex.

elected to bite the hand that feeds it in seeking expanded rights under the Copyright Act.

Another alternative for electronic database providers is to work with a publishing clearinghouse that will make a work available to any interested party or publisher at a fixed license rate.⁶⁸ Such licenses are more sensible and practical than obtaining individual rights when publishing content that might be reproduced and distributed over time.

For many, the *Tasini* decision begs the peripheral question whether the respondent authors' motivation was clearly to defend their statutory and constitutional rights or an effort to open a previously untapped royalty stream for those of their works now accessible in electronic databases. Regardless, the Supreme Court has revamped the application of § 201(c)—an interpretation with which we are all now forced to live—authors, publishers, and readers alike.

Ultimately, electronic database providers will have to conform their business practices to the *Tasini* decision if they want to avoid a potential barrage of litigation from profit-seeking authors who could emerge from the woodwork. Authorship agreements must and will reflect the inclusion of electronic databases and other advancements in technology, for if any lesson has been learned in this era of groundbreaking copyright litigation, it is that technology is ever changing and a new interpretation of the Copyright Act is little more than a lawsuit away.

68. The Copyright Clearance Center, for example, provides these services. A customer can request individual copies of documents, or purchase a blanket license for all copyrightable material in the clearinghouse library. See generally THE COPYRIGHT CLEARANCE CENTER, INC., COPYRIGHT.COM, at <http://www.copyright.com/>.

