



## University of Baltimore Law ScholarWorks@University of Baltimore School of Law

All Faculty Scholarship

Faculty Scholarship

3-22-2001

# Law Reviews and Technology: Copyright Law from Noah Webster to Tasini and the Importance of Written Contracts

Lynn McLain

University of Baltimore, [lmclain@ubalt.edu](mailto:lmclain@ubalt.edu)

Follow this and additional works at: [http://scholarworks.law.ubalt.edu/all\\_fac](http://scholarworks.law.ubalt.edu/all_fac)

 Part of the [Law Commons](#)

### Recommended Citation

Lynn McLain, *Law Reviews and Technology: Copyright Law from Noah Webster to Tasini and the Importance of Written Contracts*, (2001). Available at: [http://scholarworks.law.ubalt.edu/all\\_fac/928](http://scholarworks.law.ubalt.edu/all_fac/928)

This Conference Proceeding is brought to you for free and open access by the Faculty Scholarship at ScholarWorks@University of Baltimore School of Law. It has been accepted for inclusion in All Faculty Scholarship by an authorized administrator of ScholarWorks@University of Baltimore School of Law. For more information, please contact [snolan@ubalt.edu](mailto:snolan@ubalt.edu).

**Law Reviews and Technology: Copyright Law  
from Noah Webster to *Tasini* and the Importance of Written Contracts**

© Professor Lynn McLain, University of Baltimore School of Law

**National Conference of Law Reviews  
Baltimore, MD  
March 22, 2001**

- I. The federal Copyright Act of 1976, as amended, is found at 17 U.S.C. §§ 101 *et seq.* (regs. found at 17 C.F.R.). (The 1909 Act still comes into play, however, as to works published before January 1, 1978.)
  - A. Original law review articles are copyrightable as **literary works**, § 102(a)(1).
  - B. Law review issues and volumes are copyrightable as **collective works**, which are **compilations** (selections and arrangements) of other copyrightable works (the articles), §§ 103, 201(c).
- II. The copyright holder has six independent exclusive rights, § 106, five of which are applicable to literary works:
  - (1) The right to **reproduce** the copyrighted work;
  - (2) The right to **prepare a derivative work**, such as an abridgement or adaptation (must be substantially similar to, but contain more than a trivial difference from the original work);  
  
(Subsequent articles by other authors tend to copy only a little from other articles and qualify as “fair use” § 107, rather than as derivative works.)
  - (3) The right to **distribute** copies of the work to the public;
  - (4) The right to **publicly perform** the work; and
  - (5) The right to **publicly display** the work.
- III. Copyright immediately attaches upon fixation of the work in a tangible form. Copyright notice is no longer required in the U.S. Registration with the Copyright Office is not required until one intends to sue. (But both notice and registration are desirable, for various reasons.)

IV. Initial ownership of copyright, duration of the term of protection, and whether an assignment of copyright is subject to termination depend on whether the work is a “work made for hire.”

A. Works for Hire

1. The “employer or other person for whom the work was prepared” automatically owns the copyright to works made for hire, § 201(b) “unless the parties have expressly agreed otherwise in an instrument signed by them.”

2. A work is a work made for hire if it is **prepared by an employee in the course of his or her employment**, § 101(1). This question is resolved by application of the federal common law of agency. *Community for Creative Non-Violence v. Reid*, 490 U.S. 730, 109 S.Ct. 2166 (1989).

\* Student authors are likely “employees” under this analysis. \*

3. A work may also be a work made for hire, § 101(2), if the work is both:

a. **“[S]pecially ordered or commissioned for use as a contribution to a collective work . . .” and**

b. **“[T]he parties expressly agree in a written instrument signed by them that the work shall be considered a work made for hire.”**

\* This route would be advisable to try, if the law review has \* actively “specially ordered or commissioned” a particular article.

B. The copyright to all other works is held by their individual author(s).

V. Duration of the Copyright, § 302

A. Works for hire: copyright usually expires 95 years from first publication of the work (although, if it is not published for at least 25 years after the creation of the work, the copyright will expire 120 years after its creation, no matter how recently or whether it was published).

B. Individual authors: copyright lasts until 70 years after the author’s death.

C. Two or more (joint) authors: copyright lasts until 70 years after the death of the last surviving author.

D. All terms expire on December 31 of the applicable year.

VI. Assignment or License Possible; Termination of Either Possible

- A. Copyright owners may assign their copyright (or 1 or more of their § 106 rights) to another, § 201(d). **Assignments must be in writing and signed by the owner**, § 204(a). Certificates of acknowledgment, § 204(b), and recordation in the copyright office, § 205, are not necessary, though they have advantages.
- B. Copyright owners also may license others to make particular uses of their works. Licenses may be exclusive or nonexclusive.
1. **Exclusive licenses** (only the licensee may make the permitted use).
  2. **Nonexclusive licenses** (the copyright owner also may license others to make the permitted use).
- C. **“In the absence of an express transfer of the copyright or of any rights under it, the owner of copyright in [a] collective work [such as a law review] 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 collective work in the same series,”** § 201(c) (nonexclusive license).
- D. Unless the work is a work for hire, assignments and licenses may be terminated by the author or his or her heirs within a window between 35 and 40 years after the date of execution of the grant, § 203.

VII. Alternatives as to What to Seek in Written Contracts

A. **Assignment of copyright to law review**

- \* **This is simplest for you!** The law review then can publish, republish, \* permit copying, etc., without the author’s permission.

If the author has assigned the copyright, the author must seek permission to prepare and publish a derivative work. See Attachment A.

B. Three cases pending regarding what happens in the event there is **no express transfer of rights**

1. *New York Times Co. v. Tasini* (pending before U.S. Supreme Court) (cert. granted, 121 S.Ct. 425 (2000)) (Docket No. 00-201) (argument scheduled for March 28, 2001).
  - Publishers of newspapers and magazines (collective works) were sued by free-lance authors for putting their articles on-line and on CD-ROMs without their permission (§§ 106(1) and (3)).

- Publishers licensed defendant Mead Data Central to put articles on NEXIS and defendant University Microfilms to put articles on CD-ROMs. Articles are tagged so that they may be retrieved individually, and with other works on the same subject, rather than as part of the collective works.
  - Articles were first published between 1990-93, before this technology was contemplated.
  - Most free-lancers had signed no written contracts transferring any copyright rights. (One author had entered into an express licensing agreement with “Time” magazine, permitting republication in return for payment; he was held not to have authorized this uncompensated use.)
  - Question: **Was this permissible under § 201(c) as “reproducing and distributing the contribution as part of that particular collective work, any revision of that collective work, and any collective work in the same series”?**
  - 972 F. Supp. 801 (S.D.N.Y. 1997) held yes. But
  - 206 F.3d 161 (2d Cir. 1999, amended 2000) reversed; in an opinion by Chief Judge Winter, 2d Cir. held that this use did not qualify as “a revision of that collective work.” The publishers conceded that it did not fit the other two permitted uses.
  - For a summary of the briefs, see 61 BNA Pat., Trademark & Copyright J. 456-59 (Mar. 16, 2001). Argument is scheduled for March 28, 2001.
2. *In re Literary Works in Electronic Databases Copyright Litigation* (S.D.N.Y., M-21-90 (GBD), Mar. 5, 2001) (full text at <http://pub.bna.com/ptcj/2190.pdf>) (class action suit by freelancers, some with and some without written agreements; stayed, pending Supreme Court’s decision in *Tasini*).
  3. *Greenberg v. National Geographic Society*, No. 00-10510-C (argued 11th Cir., Oct. 3, 2000).
    - Freelance photographer sued National Geographic Society for producing and selling a 30-disk CD-ROM set, “The Complete National Geographic,” which contains every issue ever published of the Society’s magazine, including Greenberg’s photographs, without his permission.

- S.D.Fla., May 14, 1998, 1198 U.S. Dist. LEXIS 18060, \*10, held Nat'l Geog. OK under § 201(c), even though the medium involved was not expressly included in the licensing agreement, because the medium did not exist at the time of the agreement.
- Eleventh Circuit decision pending.

\* Bottom line: **at the least, obtain a written agreement to publish.** \*  
**Be sure to cover all electronic rights, CD-ROMs, and new technologies.**

For an example of a document providing an exclusive license for a limited term and then a nonexclusive license covering electronic media, see Attachment B.