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New York Times Company, Inc., v. Tasini 121 S. Ct. 2381 (2001)

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CASE SUMMARIES

NEW YORK TIMES COMPANY, INC., V. TASINI

121 S. Ct. 2381 (2001)

I. INTRODUCTION

In *New York Times Company, Inc., v. Tasini*, the United States Supreme Court examined a publisher's ability to license freelance contributions to electronic databases.[1] The case concerns the work of six freelance authors who allege a violation of their respective copyrights in articles produced for a print publisher, and later licensed to an electronic database.[2] The publishers assert the privilege of reproduction and distribution accorded them by 17 U.S.C. § 210(c) of the Copyright Act.[3] Specifically, the publishers argue that as copyright owners of the collective work, a newspaper here, the statute provides them a privilege to reproduce and distribute the author's contribution to that work as a revision of the collective work.[4]

The United States District Court for the Southern District of New York granted summary judgment to the publishers holding that §201(c) shielded the reproduction.[5] The Court of Appeals for the Second Circuit reversed, granting summary judgment for the authors on the ground that the electronic databases were not among the collective works covered by §201(c).[6] The United Supreme Court affirmed the Second Circuit, holding that the electronic databases do not reproduce and distribute the articles as part of a collective work under § 201(c).[7]

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[1] New York Times, Inc., v. Tasani 121 S. Ct. 2381 (2001).
[2] *Id.* at 2384.
[3] *Id.*
[4] *Id.*
[5] *Id.* at 2386.
[6] *Id.*
[7] *Tasani*, 121 S. Ct. at 2387.

II. BACKGROUND

Jonathon Tasini, Mary Kay Blakely, Barbara Garson, Margot Mifflin, Sonia Jaffe Robbins, and David S. Whitford are respondents.[8] The dispute centers on twenty-one articles created individually by these authors.[9] *The New York Times* published twelve of the articles, *Newsday* (another New York daily newspaper) published eight, and *Sports Illustrated* published one.[10] These publishers are represented here as The New York Times Company, Newsday, Inc., and Time, Inc., respectively.[11] Additionally, the three petitioners registered collective work copyrights for each edition that contained the independent articles.[12]

At the time of publication, all three publication petitioners had licensing agreements with petitioner LEXIS/NEXIS, owner and operator of the computer database NEXIS.[13] NEXIS contains articles from hundreds of journals, newspapers, and periodicals, presenting them in a text-only format.[14] The licensing agreement gives LEXIS/NEXIS the authority to copy and sell any portion of the publisher/petitioners' printed text.

Upon receiving the articles from the publishers, NEXIS codes each and places them within the central discs of its database.[15] Subscribers to NEXIS can search for articles by author, subject, date, publication, key term, or other criteria, and then view, print, or download desired articles.[16] Each article appears separate, and the display contains the name of the print publication, date, initial page number, title, and author.[17] The New York Times also had licensing agreements with petitioner University Microfilms

[8] *Id.* at 2385.
[9] *Id.*
[10] *Id.*
[11] *Id.*
[12] *Id.*
[13] *Tasini*, 121 S. Ct. at 2385.
[14] *Id.*
[15] *Id.*
[16] *Id.*
[17] *Id.*

International ("UMI"), authorizing the reproduction of New York Times material on two CD-ROM'S; the New York Times OnDisc ("NYTO") and General Periodicals On Disc ("GPO").[18] NYTO is a text-only database containing only the New York Times, while GPO is an image-based system which shows each article as it appears in the printed pages, including photographs, captions, and advertisements.[19]

The freelance authors filed a civil action in the United States District Court for the Southern District of New York, alleging copyright infringement.[20] Specifically, the authors alleged that LEXIS/NEXIS and UMI, facilitated by the petitioner/publishers, violated their copyrights by placing the articles in NEXIS, NYTO, and GPO.[21] The authors sought declaratory and injunctive relief, and in response, petitioners raised the reproduction and distribution privilege provided collective work copyright owners under 17 U.S.C. § 201(c).[22]

The District Court granted summary judgment for the publishers, holding that § 201(c) protected the reproduction in electronic databases.[23] The court held the original privilege to be transferable from the print publishers to the electronic database publishers.[24] The court then determined that the electronic databases had reproduced and distributed the articles as a revision of the collective work.[25] The court reasoned that in order to qualify as a revision, the electronic work would have to preserve a significant aspect of the original collective work.[26] Specifically, the court found that by copying all of the articles originally assembled in the print periodical, the electronic databases had preserved the selection of articles in the collective work.[27]

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[18] *Tasini*, 121 S. Ct. at 2386.
[19] *Id.*
[20] *Id.*
[21] *Id.*
[22] *Id.*
[23] *Tasini*, 121 S. Ct. at 2386.
[24] *Id.*
[25] *Id.*
[26] *Id.* at 2387.
[27] *Id.*

Highlighting this preservation, the court thought, was the fact that the electronic databases not only displayed the author and title of each article, but also the print publication's original issue and page number.[28]

The authors appealed and the Court of Appeals for the Second Circuit reversed.[29] The court held that the electronic databases were not collective works covered by § 201(c), and specifically, that they were not revisions of the original printed collection.[30] Instead of a revision of the original collection, the court found that the electronic database contained millions of individual articles.[31] The court did not reach the question of whether the privileges under § 201(c) were transferable.[32] Subsequently, the Supreme Court affirmed the ruling of the Second Circuit, holding that the databases do not reproduce and distribute the articles part of a collective work under §201(c).[33]

III. LEGAL ANALYSIS

When a freelance author contributes an article to a collective work, the Copyright Act recognizes two distinct copyrighted works. "Copyright in each separate contribution to a collective work is distinct from copyright in the collective work as a whole."[34] Section 201(c) of the Act states, "In the absence of an express transfer of the copyright or of any rights under it, the owner of the 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, and any later collective work in the same series."[35] The court found this allows

[28] *Id.*
[29] *Tasani,* 121 S. Ct. at 2387.
[30] *Id.*
[31] *Id.*
[32] *Id.*
[33] *Tasini,* 121 S. Ct. at 2387
[34] 17 U.S.C.A §201(c).
[35] *Id.*

a newspaper or magazine publisher to reproduce or distribute an article as a collective work in three instances: "(a) 'That collective work' to which the author contributed her work; (b) any revision collective work, or (c) any later collective work in the same series."[36]

Petitioners contend that the distribution of each article by the databases lies within the privilege of reproducing and distributing articles as part of a revision of a collective work.[37] The United States Supreme Court does not agree.[38] Initially, the court presents a general argument outlining why the databases are not revisions of the collective work.[39] The court then addresses petitioners' arguments, specifically that the § 201(c) privileges extend to the databases via "media neutrality," and "contributory infringement."[40]

IV. DISCUSSION

The first issue the court raises in determining whether the articles have been reproduced and distributed as part of a revision of the collective work is the perception of the database user. The court states that the database presents articles to users clear of the context provided by the original publishing periodical.[41] The user is invited to search thousands of millions of articles, and each article that satisfies a given search is listed individually.[42] Furthermore in NYTO and NEXIS, each article is presented to the user without graphics, formatting, or other articles with which the article was originally published.[43] In the case of GPO, the court notes, articles are presented with other materials published on the same page, but without information published on other pages

[36] *Tasini*, 121 S. Ct. at 2389.
[37] *Id.* at 2390.
[38] *Id.*
[39] *Id.* at 2391-2392.
[40] *Id.* at 2391-2393.
[41] *Id.* at 2391.
[42] *Tasini*, 121 S. Ct. at 2391.
[43] *Id.*

within the original periodical.[44] The court held that, according to the perception of the database user, the articles within the database are not presented as part of a revision of the original publication.[45] It stated, "we cannot see how the Database perceptibly reproduces and distributes the article 'as part of' either the original edition or a 'revision' of that edition."[46]

Next, the court addresses petitioners' arguments. First, the petitioners invoke the concept of media neutrality; essentially that the transfer of a work from one media to another does not alter the character of the work for copyright purposes.[47] To this end, petitioners draw an analogy between the databases and the transfer of printed materials to microform/microfiche.[48] The court rejects this analogy, however. It notes that articles on microform/fiche appear miniaturized, in the same position, within the entire original edition.[49] In other words, the court states, "the user first encounters the article in context."[50] To the contrary, the databases offer individual articles, not intact periodicals.[51] Articles appear disconnected from the original context, and in the cases of NEXIS and NYTO, apart for the rest of the original page.[52] The court suggests a different analogy: an imaginary library.[53] Here, the library would store folders containing individual articles in a file room, and an "inhumanly speedy" librarian could provide copies of articles that fit a patrons search requirements.[54] The court states that one viewing this library could not reasonably conclude that these individual files were revisions of the original edition of publication.[55] Petitioners counter argument is that § 201(c)

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[44] *Id.*
[45] *Id.*
[46] *Id.*
[47] *Id.* at 2391- 2392
[48] *Tasini,* 121 S. Ct. at 2391-2392.
[49] *Id.* at 2391.
[50] *Id.*
[51] *Id.* at 2392.
[52] *Id.* at 2391.
[53] *Id.* at 2392.
[54] *Tasini,* 121 S. Ct. at 2392.
[55] *Id.*

protects the databases because users can manipulate a search to generate all of the articles from a particular periodical edition.[56] In other words, if the request was made properly, the librarian could retrieve the entire original edition from the individual article files.[57] The court disagrees with this argument, stating, "the fact that a third party can manipulate a database to produce a noninfringing document does not mean the database is not infringing."[58]

Next, petitioners argue that their databases could be liable only under a theory of contributory infringement, which the authors did not plead.[59] To this end, they cite *Sony Corp. of America v. Universal City Studios, Inc.*, where the court held that the sale of copying equipment does not constitute contributory infringement if the equipment is capable of substantial noninfringing uses.[60] The court found that the electronic publishers were not only selling equipment, but also copies of articles.[61] The court states, "it is the copies themselves . . . that fall outside the scope of the § 201(c) privilege."[62]

The court also addresses the ramifications of its decision on the future of electronic databases. The publishers argue that "a ruling for the authors will have 'devastating' consequences," and will "punch gaping holes in the electronic record of history."[63] The court rejects this prognosis, however, stating that their finding of infringement does not necessarily warrant an injunction against the inclusion of freelance articles in electronic databases.[64] Instead, the court notes that the parties "may enter into an agreement allowing continued electronic reproduction of the Author's works."[65] The court concludes that, "speculation about future

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[56] *Id.* at 2393.
[57] *Id.*
[58] *Tasani* 121 S. Ct. at 2393.
[59] *Id*
[60] *Id.* at 2393 quoting *Sony v. Universal,* 464 U.S. 417.
[61] *Id.*
[62] *Id.*
[63] T*asini,* 121 S. Ct. at 2393, quoting Brief for Petitioners at 49.
[64] *Id.* at 2393.
[65] *Id.*

harms is no basis . . . to shrink authorial rights Congress established in § 201(c)."[66] The court does not discuss the appropriate remedy specifically, instead leaving the decision to the District Court.[67]

V. CONCLUSION

In all, The United States Supreme Court held the electronic databases do not reproduce and distribute the freelance articles as part of a collective work under § 201(c).[68] The court found that in terms of the perception of the user, the articles are not presented as part of a revision of the original collective publication.[69] Additionally, the court rejected the arguments that the electronic database reproduction was merely a change in medium, and that the electronic databases could only be liable under a theory of contributory infringement.[70] Finally, the court discussed the policy implications of its decision. It stated that an injunction against reproduction was not explicitly called for in the this case, and seems to urge the parties to strike a bargain in lieu of its holding.[71]

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[66] *Id.* at 2394.
[67] *Id.*
[68] *Id.* at 2384.
[69] *Tasini,* 121 S. Ct. at 2391.
[70] *Id.* at 2392-2393.
[71] *Id.* at 2394.