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Patrick J. O'Connor

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ON-LINE COMPUTER DATABASES AND CD-ROMS ARE NOT THE ELECTRONIC EQUIVALENT OF MICROFILM: *TASINI V. NEW YORK TIMES CO.*, ELECTRONIC REVISIONS, AND INDIVIDUAL CONTRIBUTIONS TO COLLECTIVE WORKS UNDER THE COPYRIGHT ACT OF 1976

INTRODUCTION

The United States Constitution grants Congress the power to “promote the Progress of . . . [the] useful Arts, by securing for limited Times to Authors . . . the exclusive Right to their respective Writings”¹ To this end, Congress has enacted various laws, the most recent being the Copyright Act of 1976 (the Act),² granting authors exclusive rights³ to their works for limited periods of time.⁴ An interesting and sometimes problematic aspect of this Act allows an individual author to make a contribution to a collective work, which itself can be afforded copyright protection, while at the same time retaining most of the exclusive rights to the individual contribution.⁵

1. U.S. CONST. art I, § 8, cl. 8.

2. 17 U.S.C. §§ 101-1101 (1994); *see also* U.S. CONST. art. I, § 8, cl. 8.

3. The exclusive rights granted to authors are found in § 106 of the Act, and consist of the right:

- (1) to reproduce the copyrighted work in copies or phonorecords;
- (2) to prepare derivative works based upon the copyrighted work;
- (3) to distribute copies or phonorecords of the copyrighted work to the public by sale or other transfer of ownership, or by rental, lease, or lending;
- (4) in the case of literary, musical, dramatic, and choreographic works, pantomimes, and motion pictures and other audiovisual works, to perform the copyrighted work publicly;
- (5) in the case of literary, musical, dramatic, and choreographic works, pantomimes, and pictorial, graphic, or sculptural works, including the individual images of a motion picture or other audiovisual work, to display the copyrighted work publicly; and
- (6) in the case of sound recordings, to perform the copyrighted work publicly by means of a digital audio transmission.

17 U.S.C. § 106(1)-(6) (1994 & Supp. 1997).

4. For works created by a single author after January 1, 1978, these rights endure for the life of the author plus 50 years. *See* Sonny Bono Copyright Term Extension Act, Pub. L. No. 105-298, § 302, 112 Stat. 2827 (1998).

5. *See* 17 U.S.C. § 201(c) (1994).

Section 101 of the Act defines a “collective work” as “a work, such as 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.”⁶ According to the Act, the term “compilation,” which is defined as “a work formed by the collection and assembling of preexisting materials or of data that are selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes an original work of authorship,” includes a “collective work.”⁷

In *Tasini v. New York Times Co.*,⁸ a case of first impression, the United States District Court for the Southern District of New York granted summary judgment to a group of print and electronic publisher defendants who had reproduced on-line and on CD-ROM the plaintiffs’, a group of freelance writers, individual contributions to the print publishers’ collective works.⁹ One of the main issues in the case was whether the print publishers produced revisions of their collective works or infringed upon the contributing authors’ exclusive rights to their individual contributions.¹⁰ Ultimately, the court found that the electronic publishers retained just enough of what made the print publishers’ collective works original to avoid infringement.¹¹ According to the district court, the electronic publishers avoided infringement by keeping the print publishers’ original selection of articles and by identifying the printed source of each article so that the original selection of the print publishers remained apparent when viewing an article electronically.¹² Thus, the district court found the electronic

6. *Id.* § 101.

7. *Id.*

8. 972 F. Supp. 804 (S.D.N.Y. 1997).

9. *See id.* at 806, 827.

10. *See id.* at 812. Had the freelance writers been employees of the publisher defendants, there would have been no question that the print publisher defendants could reproduce the individual contributions. Such contributions would fall under the “work made for hire” provision of the Act. *See* 17 U.S.C. § 201(b) (1994). Under this provision, “the employer or other person for whom the work was prepared is considered the author” of the work and, “unless the parties have expressly agreed otherwise in a written instrument signed by them, [the employer] owns all of the rights comprised in the copyright.” *Id.*

11. *See Tasini*, 972 F. Supp. at 823-25.

12. *See id.* at 825.

versions of the print publications substantially similar to the print versions, allowing the electronic versions to qualify as revisions of a collective work.¹³

Plaintiffs, unsatisfied with the district court's decision, filed a motion for reconsideration with the court.¹⁴ In an unpublished opinion, the court refused to grant any part of the plaintiffs' motion.¹⁵ The plaintiffs appealed.¹⁶

The issues addressed in *Tasini* are real concerns in both American and international publishing.¹⁷ This Comment analyzes the district court's grant of summary judgment to the publisher defendants and discusses the arguments the plaintiffs are pursuing on appeal. Part I of this Comment introduces the parties in *Tasini* and explains the role each is playing in the saga. Part II examines arguments the defendants advanced in district court to support their position that the plaintiffs expressly transferred the electronic rights to their individual contributions; the court rejected these arguments.¹⁸ Part II also examines the district court's analysis of § 201(c) of the Act and how, in the court's view, the Act ultimately allowed the publishers to include the plaintiffs' individual contributions in electronic form. Part III addresses the issues the plaintiffs are pursuing on appeal.

I. THE PARTIES TO THE DISPUTE

A. Plaintiffs

The original plaintiffs in *Tasini* were eleven freelance writers and photographers who contributed to the collective works of the print publisher defendants.¹⁹ By the time the district court granted summary judgment to the defendants, only six of the

13. *See id.*

14. *See Tasini v. New York Times Co.*, No. 93 Civ. 8678(SS), 1997 WL 681314, at *1 (S.D.N.Y. Oct. 31, 1997).

15. *See id.* at *10.

16. *See Tasini v. New York Times Co.*, 972 F. Supp. 804 (S.D.N.Y. 1997), *appeal filed*, No. 97-9181 (2d Cir. Feb. 3, 1998).

17. *See, e.g.*, Tim Naprawa, Comment, *Secondary Use of Articles in Online Databases Under U.K. Law*, 9 TRANSNAT'L LAW. 331 (1996).

18. *See Tasini*, 972 F. Supp. at 810-12.

19. *See id.* at 806; Martin Garbus, *Who Owns Electronic Rights in the New Media?*, N.Y.L.J., Dec. 23, 1994, at 212.

original eleven plaintiffs remained.²⁰ All six plaintiffs are pursuing the appeal.²¹ The named plaintiff, Jonathan Tasini, is President of the National Writers Union (NWU) Local 1981.²² The NWU represents the interests of "approximately 4,500 freelance journalists, book authors, poets, technical writers and editorial cartoonists."²³ The NWU funds the plaintiffs' action.²⁴

*B. Defendants*²⁵

1. The New York Times Company and Newsday, Inc.

Both the New York Times Company (New York Times) and Newsday, Inc. (Newsday) are New York corporations that publish the *New York Times* and *Newsday* newspapers, respectively.²⁶ Twelve of the disputed contributions appeared in the *New York Times*, and eight appeared in *Newsday*.²⁷ Plaintiffs and the publishers of both the *New York Times* and *Newsday* discussed individual contributions on an informal

20. See *Tasini*, 972 F. Supp. at 806. Those remaining plaintiffs were Jonathan Tasini, Mary Kay Blakely, Barbara Garson, Margot Mifflin, Sonia Jaffe Robbins, and David S. Whitford. See *id.* at 804.

21. See Brief of Four Plaintiffs-Appellants, Jonathan Tasini, Mary Kay Blakely, Margot Mifflin and David S. Whitford, *Tasini v. New York Times Co.*, 972 F. Supp. 804 (S.D.N.Y. 1997) (No. 97-9181) [hereinafter *Tasini Brief*]; Brief for Plaintiffs-Appellants Barbara Garson and Sonia Jaffe Robbins, *Tasini v. New York Times Co.*, 972 F. Supp. 804 (S.D.N.Y. 1997) (No. 97-9181) [hereinafter *Garson Brief*].

22. See Amended Complaint for Copyright Infringement, ¶ 6, *Tasini v. New York Times Co.*, 972 F. Supp. 804 (S.D.N.Y. 1997) (No. 93 Civ. 8678(SS)) <<http://www.igc.apc.org/nwu/tvt/tvtcompl.htm>> [hereinafter *Complaint*].

23. Dina Marie Pascarelli, Case Note and Comment, *Electronic Rights: After Tasini Who Owns That, When?* *Tasini v. New York Times*, 8 DEPAUL-LCA J. ART & ENT. L. 45, 47-48 (1997).

24. See Wendy R. Leibowitz, *Revising Copyrights and Wrongs: New Media as Copying Machines*, NAT'L L.J., Sept. 1, 1997. The NWU advocates keeping equipment and fee prices reasonable, applying "copyright principles to electronic marketplaces," public electronic depositories for "digital texts and works of art," development of technologies to inexpensively prevent "bootlegging, plagiarism and unauthorized alterations," and reducing the price consumers pay for obtaining information electronically, while increasing the fees paid to individual authors who create the works utilized electronically. Bruce Hartford, *Ensuring Cyberspace Copyrights*, SAN FRAN. EXAMINER, Nov. 27, 1994, at C5.

25. One of the original defendants, the Atlantic Monthly Company, settled the matter out-of-court. See Dan Carlinsky, *The Argument Over Electronic Rights is Settled*, NAT'L L.J., Dec. 9, 1996, at A16.

26. See *Complaint*, *supra* note 22, ¶¶ 17-18.

27. See *Tasini v. New York Times Co.*, 972 F. Supp. 804, 806 (S.D.N.Y. 1997).

basis, but typically the parties did not memorialize any of the agreements in a writing.²⁸ However, the backs of the checks that Newsday sent to its freelancers after their contributions had been published included this endorsement:

Signature required. Check void if this endorsement altered. This check accepted as full payment for first-time publication rights (or all rights, if agreement is for all rights) to material described on face of check in all editions published by *Newsday* and for the right to include such material in electronic library archives.²⁹

Tasini crossed out this endorsement before cashing his two checks from Newsday; the other plaintiffs who submitted contributions to Newsday did not.³⁰

2. *Time, Inc.*

Time, Inc. (Time), a subsidiary of Time-Warner, Inc., is a Delaware corporation and publisher of *Sports Illustrated*, a weekly sports magazine.³¹ Only one plaintiff, David S. Whitford, submitted a contribution to *Sports Illustrated*.³² The relationship between Whitford and Time was more formal than the relationship between the other plaintiffs and the New York Times or Newsday because Whitford had executed a written contract.³³ The contract gave Time “the exclusive right first to publish the Story in the Magazine.”³⁴ It also gave Time the non-exclusive right to license others to republish the work, provided it paid Whitford fifty percent of the net proceeds Time received.³⁵

28. *See id.* at 807.

29. *Id.*

30. *See id.*

31. *See* Complaint, *supra* note 22, ¶ 19.

32. *See Tasini*, 972 F. Supp. at 807.

33. *See id.*

34. *Id.*

35. *See id.* Interestingly, Whitford did not bring a contract claim against Time for authorizing a republication of his article without compensating him. *See id.* at 811-12 n.4. On appeal, Whitford argues that Time is liable for infringement because it violated its express licensing agreement with him and that the district court should have granted his motion for summary judgment. *See Tasini Brief, supra* note 21, at 34-38.

3. Mead Data Central Corporation (LEXIS-NEXIS)

Mead Data Central Corporation, a wholly-owned subsidiary of the Mead Corporation, markets LEXIS-NEXIS (NEXIS), a fee-based electronic information retrieval system.³⁶ Pursuant to agreements between the defendants, the print “publishers provide NEXIS with a complete copy of [the] computer text files” used to make the print publications.³⁷ NEXIS then removes from the files any “photographs, advertisements, and the column format of the newspapers” and magazines.³⁸ NEXIS uses the files to put each article’s contents on-line, adding information including the individual authors’ names as well as the title and page numbers of the print publication in which the article first appeared.³⁹

A subscriber to NEXIS, after gaining access, enters “libraries,” which contain articles from specific publications or groups of publications.⁴⁰ NEXIS subscribers then conduct searches by inputting search terms and connectors to generate “hits,” or articles that contain the selected search terms.⁴¹ If the subscriber selects a particular article, NEXIS displays the full text of the article, along with a header providing the author’s name, the publication from which the article originates, and the number of words the article contains.⁴² It is possible to conduct searches so that NEXIS generates hits of only the articles appearing in one issue of a particular newspaper or periodical.⁴³

NEXIS provides its database subscribers with copies of articles appearing in the *New York Times* and *Newsday* within

36. See Complaint, *supra* note 22, ¶ 21. LEXIS-NEXIS is now owned by Reed Elsevier, a British-French conglomerate. See Reply Brief of Four Plaintiffs-Appellants, Jonathan Tasini, Mary Kay Blakely, Margot Mifflin and David S. Whitford at 8, *Tasini v. New York Times Co.*, 972 F. Supp. 804 (S.D.N.Y. 1997) (No. 97-9181) [hereinafter *Tasini Reply Brief*]. The predecessors to on-line services such as NEXIS have been in existence since the late 1950s. See Sidney A. Rosenzweig, *Don't Put My Article Online!: Extending Copyright's New-Use Doctrine to the Electronic Publishing Media and Beyond*, 143 U. PA. L. REV. 899, 902 (1995). By the early 1980s, services such as NEXIS were widely available. See *id.* at 903. By 1995, the on-line information industry earned an estimated \$13.4 billion per year, and observers expect the industry's growth to continue. See *id.*

37. *Tasini*, 972 F. Supp. at 808.

38. *Id.*

39. See *id.*

40. See *id.*

41. See *id.*

42. See *id.*

43. See *id.*

twenty-four hours after they first print them, while it makes copies of articles appearing in *Sports Illustrated* available within forty-five days of the magazine's printing.⁴⁴ NEXIS has provided its subscribers with the contents of *Sports Illustrated* since 1982, the *New York Times* since 1983, and *Newsday* since 1988.⁴⁵

4. *University Microfilms, Inc. (The New York Times OnDisc and General Periodicals OnDisc)*

University Microfilms, Inc. (UMI), a subsidiary of the Bell & Howell Company, has produced a text-only CD-ROM product entitled *The New York Times OnDisc* since 1992.⁴⁶ UMI also produces *General Periodicals OnDisc*, another CD-ROM product that contains numerous periodicals.⁴⁷ Since 1990, *General Periodicals OnDisc* has included the *New York Times Magazine and Book Review*, a supplement to the Sunday edition of the *New York Times*.⁴⁸

UMI receives the contents of the *New York Times* from NEXIS and then encodes the information to allow for searching.⁴⁹ Like NEXIS, *The New York Times OnDisc* does not include pictures, advertisements, or the column format of the *New York Times*.⁵⁰ Also, like NEXIS, one can conduct a search so that it generates only the articles from a particular issue of the *New York Times*; however, most searches will retrieve articles published in different editions of the newspaper.⁵¹

Unlike *The New York Times OnDisc*, which provides only text, *General Periodicals OnDisc* is an image-based CD-ROM product that digitally scans the contents of the periodicals contained on the discs.⁵² Articles in *General Periodicals OnDisc* appear as they do in print and include pictures and

44. *See id.*

45. *See id.* at 807.

46. *See id.* at 808; Complaint, *supra* note 22, ¶ 22. CD-ROMs were first introduced commercially in 1985 to store data to be retrieved by computer. *See Rosenzweig, supra* note 36, at 905. By 1994, 26.9 million CD-ROM players existed worldwide. *See id.*

47. *See Tasini*, 972 F. Supp. at 806, 808.

48. *See id.* at 807-08.

49. *See id.* at 808.

50. *See id.*

51. *See id.*

52. *See id.*

advertisements.⁵³ Another difference between *General Periodicals OnDisc* and *The New York Times OnDisc* is that the former does not allow searching.⁵⁴ Instead, UMI sells text-based discs, which are searchable, with *General Periodicals OnDisc*.⁵⁵ The text-based discs contain abstracts of each article, allowing users to determine if a particular article is useful before retrieving it from the image-based discs.⁵⁶

II. THE GRANT OF SUMMARY JUDGMENT TO THE PUBLISHERS

In *Tasini*, all of the parties agree that the print publisher defendants' publications constitute "collective works" as defined by the Act.⁵⁷ The dispute focuses on the extent to which the publisher defendants, without an express transfer of rights from the individual authors, can exercise their privileges in their collective works.⁵⁸ Section 201(c) of the Act sets forth the rights that an author (that is, publisher) of a collective work holds.⁵⁹ According to this section, "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."⁶⁰

Plaintiffs contended that by selling the contents of the print publishers' collective works to the electronic publishers, the print publishers exceeded the scope of the limited privileges they hold in their collective works.⁶¹ Rather than producing revisions of the print publishers' collective works, as the defendants maintain, the plaintiffs insisted that the electronic publishers' products exploit the individual contributions contained in the collective works.⁶² The plaintiffs further

53. *See id.* at 808-09.

54. *See id.* at 809.

55. *See id.*

56. *See id.*

57. *See id.*; *see also* 17 U.S.C. § 101 (1994).

58. *See Tasini*, 972 F. Supp. at 809.

59. *See* 17 U.S.C. § 201(c) (1994).

60. *Id.*

61. *See Tasini*, 972 F. Supp. at 809.

62. *See id.* Interestingly, the Internet homepage for LEXIS-NEXIS supports the plaintiffs' argument; the homepage stresses the number of documents and not publications the database holds by stating that "[m]ore than 9.5 million documents are

contended that § 201(c) is medium-restrictive and not intended to permit electronic revisions of printed works.⁶³

The defendants, however, argued that § 201(c) does not prohibit electronic revisions of collective works.⁶⁴ Time and Newsday also argued that the plaintiffs had expressly transferred the electronic rights to their contributions by either signing the contract, as in the case of Whitford and *Sports Illustrated*, or by signing the endorsement on the back of Newsday's checks.⁶⁵

A. Express Transfer Through a Writing

Two of the print publishers, Time and Newsday, insisted that the freelance writers expressly transferred the electronic rights to their respective articles.⁶⁶ Newsday pointed to the endorsements contained on the backs of checks sent to the plaintiffs after each of the contributions had been printed that included language allowing Newsday to include the contribution in "electronic library archives."⁶⁷ Time relied on its contract with Whitford that granted it the right "first to publish," contending that, as this right was not limited to one medium, it could reproduce the article on-line.⁶⁸ The court rejected both defendants' arguments.⁶⁹

Under § 204(a) of the Act, a transfer of copyright ownership is not valid unless accompanied by a writing signed by the owner of the copyright or the owner's agent.⁷⁰ According to prior case law, the writing assigning a copyright does not have to be extremely formal.⁷¹ Indeed, it does not even have to mention the

added each week to the more than 1 billion documents available on LEXIS-NEXIS." LEXIS-NEXIS Homepage (visited Oct. 14, 1997) <<http://www.lexis-nexis.com>> (available in Georgia State University College of Law Library).

63. See *Tasini*, 972 F. Supp. at 809.

64. See *id.*

65. See *id.*

66. See *id.* at 810-12.

67. *Id.* at 810.

68. *Id.* at 811-12.

69. See *id.* at 810-12.

70. See 17 U.S.C. § 204(a) (1994). The full text of § 204(a) states that "[a] transfer of copyright ownership, other than by operation of law, is not valid unless an instrument of conveyance, or a note or memorandum of the transfer, is in writing and signed by the owner of the rights conveyed or such owner's duly authorized agent." *Id.*

71. See *Tasini*, 972 F. Supp. at 810-11; see also *infra* notes 72-73.

term copyright; however, the writing must be clear.⁷² In addition, the writing does not have to be executed at the time of transfer but can be drawn up later to validate a prior oral agreement.⁷³

Newsday argued that the endorsements on the back of its checks satisfied the limited requirements of a writing, but the court disagreed.⁷⁴ Newsday admitted that no prior agreements existed between the parties concerning its placing the contributions on-line.⁷⁵ Newsday claimed, however, that the check ledgers confirmed "its understanding" that plaintiffs had transferred the electronic rights in their articles.⁷⁶ As all the plaintiffs denied sharing this understanding, the court found Newsday unable to rely on the check ledgers as confirming a prior oral agreement.⁷⁷

The court also found the ledgers to be ambiguous, and thus unable to "reflect an express transfer of electronic rights in plaintiffs' articles."⁷⁸ Plaintiffs provided affidavits from experts stating that a commercial database, such as NEXIS, would contain different types of material from that of a non-commercial, archival database.⁷⁹ Also, Newsday admitted that it maintains its own, in-house, non-commercial, electronic archival

72. See *Papa's-June Music, Inc. v. McLean*, 921 F. Supp. 1154, 1158-50 (S.D.N.Y. 1996) (holding that plaintiff failed to state a claim on one count of its complaint because the writing that plaintiff claimed transferred copyright ownership made no mention of a transfer, and the notation on the check stub was susceptible to different interpretations).

73. See *Eden Toys, Inc. v. Florelee Undergarment Co.*, 697 F.2d 27, 36 (2d Cir. 1982). In *Eden Toys*, the court remanded the issue of whether a third party, Paddington and Company, Ltd., the copyright holder of Paddington Bear, had granted plaintiff an exclusive license to market all Paddington Bear products in a market in which the defendant also sold such products. See *id.* The court found that if such a license had been given and confirmed by a later writing, the plaintiff could go forward with the suit against the defendant for any infringement of Paddington Bear's copyrights in the plaintiff's market, without joining Paddington and Company in the suit. See *id.* The court reasoned that the writing requirement was intended to "protect copyright holders from persons mistakenly or fraudulently claiming oral licenses," and that the writing "requirement is satisfied by the copyright owner's later execution of a writing which confirms the agreement." *Id.*

74. See *Tasini*, 972 F. Supp. at 810-11.

75. See *id.* at 811.

76. *Id.*

77. See *id.*

78. *Id.* (citing *Playboy Enter., Inc. v. Dumas*, 53 F.3d 549, 564 (2d Cir. 1995)); see *Papa's-June Music v. McLean*, 921 F. Supp. 1154, 1159 (S.D.N.Y. 1996); *Museum Boutique Intercontinental, Ltd. v. Picasso*, 880 F. Supp. 153, 162 n.11 (S.D.N.Y. 1995).

79. See *Tasini*, 972 F. Supp. at 811.

system.⁸⁰ Thus, the court found it reasonable that the plaintiffs would have assumed that Newsday was referring to its in-house system rather than to NEXIS.⁸¹

Under its contract with Whitford, Time secured the right "first to publish" the article.⁸² Time maintained that because the language of this grant was not restricted to any one medium, the right extended to first publishing the article in NEXIS.⁸³ The court found no merit in Time's argument.⁸⁴

Time relied on the holding in *Bartsch v. Metro-Goldwyn-Mayer, Inc.*⁸⁵ to support its position.⁸⁶ *Bartsch* involved a series of grants from the producers of a German musical play, "Wie Einst in Mai," which eventually was made into the motion picture, "Maytime."⁸⁷ There, the dispute centered around a 1930s grant allowing defendant "to project, transmit and otherwise reproduce the said work or any adaptation or version thereof, visually or audibly by the art of cinematography or any process analogous thereto, and to copyright, vend, license and exhibit such motion picture photoplays throughout the world."⁸⁸ The court considered whether the grant included the right to license a third party to broadcast the motion picture on television.⁸⁹

The *Bartsch* court was confronted with two choices. It could construe the term of the grant either narrowly to include "only such uses as fall within the unambiguous core meaning of the term," or broadly to include "any uses which may reasonably be said to fall within the medium as described in the license."⁹⁰ The court found that the plaintiff, then represented by his widow, was a knowledgeable businessman who knew of the existence and potential of television, even in the 1930s.⁹¹ Therefore, the

80. *See id.*

81. *See id.*

82. *See id.* The specific language of the contract referred to by Time was the clause giving Time "the exclusive right first to publish the Story in the Magazine." *Id.* at 807.

83. *See id.* at 811.

84. *See id.* at 812.

85. 391 F.2d 150 (2d Cir. 1968).

86. *See Tasini*, 972 F. Supp. at 812.

87. *See Bartsch*, 391 F.2d at 151-52.

88. *Id.* at 151.

89. *See id.* at 152.

90. *Id.* at 155 (quoting MELVILLE B. NIMMER, *THE LAW OF COPYRIGHT* §125.3 (1964)).

91. *See id.* at 154.

court construed the grant broadly to include television broadcast rights, thus binding the plaintiff "by the natural implications of the language he accepted when he had reason to know of the new medium's potential."⁹² The court reasoned that "[i]f the words 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."⁹³ The court further noted that its approach "provides a single person who can make the copyrighted work available to the public over the penumbral medium, whereas the narrower one involves the risk that a deadlock between the grantor and grantee might prevent the work's being shown over the new medium at all."⁹⁴

In *Tasini*, the court found Time's reliance on *Bartsch* "misplaced."⁹⁵ The court reasoned that language allowing another the right to publish an article first could not "reasonably be stretched into a right to be the first to publish an article in any and all mediums."⁹⁶ Because Time elected to publish Whitford's article in print, the court determined that the electronic publishing "some forty-five days later" could not also constitute a first publication.⁹⁷

92. *Id.*

93. *Id.* at 155.

94. *Id.* Commentator Sidney A. Rosenzweig would extend the *Bartsch* analysis to new electronic publishing media. See Rosenzweig, *supra* note 36, at 925-26. Rosenzweig believes that the *Bartsch* approach should be applied "in all circumstances in which the contract is silent, the parties' intents cannot be gauged, and no unconscionability is present." *Id.* The right to exploit a copyrighted work in a new medium will be an economic windfall to one party if the new medium was not considered by the parties when drawing up their agreement. See *id.* at 928. Thus, Rosenzweig maintains that equitable principles require that the right to exploit the work in the new medium should fall to the licensee if the new medium was either not in existence at the time of the transfer or not yet fully developed commercially. See *id.* at 928-29. Rather than having the courts retroactively examine each party's knowledge concerning the new medium, Rosenzweig's "analysis presumes that all grantors before a medium's commercialization date have granted their electronic rights to the licensee." *Id.* at 929. Rosenzweig believes that such an analysis would provide "a subsidy to those publishers trying to make content available over new media during the formative years of electronic media development" while at the same time not allowing authors "to deprive society of efficient information distribution." *Id.* at 929-30. In a case such as *Tasini*, however, in which the new technology was fully developed and commercialized at the time of the contract, Rosenzweig maintains that "courts should examine the bargaining process to determine which rights were licensed in the absence of explicit provisions." *Id.* at 930.

95. *Tasini v. New York Times Co.*, 972 F. Supp. 804, 812 (S.D.N.Y. 1997).

96. *Id.*

97. *Id.*

Despite the fact that the district court sided with the plaintiffs and found none of the writings to contain an express transfer of electronic rights by the individual authors to the print publisher defendants,⁹⁸ the court still granted defendants' motion for summary judgment.⁹⁹ At least one commentator suggests that the court's determination that Time's and Newsday's writings did not expressly grant them electronic rights should have carried more weight and allowed a denial of summary judgment as to these two defendants.¹⁰⁰ Relying on § 201(d) of the Act, the court could have found that the plaintiffs transferred only a small part of the exclusive rights found in § 101 to the defendants—the right of a one time reproduction.¹⁰¹ By finding only a one time transfer, the court could have found that the defendants exceeded the scope of the transfer and granted the plaintiffs' motion to summary judgment, or at least found a question of fact as to whether the defendants retained all other exclusive rights in the copyright of their contributions.¹⁰² Rather than reserving this question for trial, the court went on to analyze § 201¹⁰³ and ultimately granted the defendants' motion for summary judgment.¹⁰⁴

B. Collective Works and the Copyright Act of 1976

After determining that neither Newsday's nor Time's writings transferred plaintiffs' electronic rights in their contributions to the defendants, the court examined the rights associated with collective works under the Act.¹⁰⁵ Specifically, the court looked at §§ 103(b) and 201(c) of the Act.¹⁰⁶ Section 103(b) states:

[t]he copyright in a compilation or derivative work extends only to the material contributed by the author of such work, as distinguished from the preexisting material employed in the work, and does not imply any exclusive right in the

98. *See id.*

99. *See id.* at 827.

100. *See, e.g.,* Ryan J. Swingle, Note, *Tasini v. New York Times: The Problem of Unauthorized Secondary Usage of an Author's Works*, 5 J. INTELL. PROP. L. 601 (1998).

101. 17 U.S.C. § 106 (1994 & Supp. 1997); *id.* § 201(c) (1994) (emphasis added).

102. *See id.* § 106(1) (1994 & Supp. 1997); Swingle, *supra* note 100, at 618-19.

103. *See Tasini*, 972 F. Supp. at 812.

104. *See id.* at 827.

105. *See id.* at 812-23.

106. *See id.*

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preexisting material. The copyright in such work is independent of, and does not affect or enlarge the scope, duration, ownership, or subsistence of, any copyright protection in the preexisting material.¹⁰⁷

Section 201(c) of the Act states:

[c]opyright 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.¹⁰⁸

The main issue for the court to decide was whether the defendants' reproductions of plaintiffs' articles constituted revisions of the print publisher defendants' collective works under the Act.¹⁰⁹

1. Section 103(b) and the Rejection of "New Property Rights"

As the court noted in *Tasini*, § 103(b) of the Act was intended to clarify a point "commonly misunderstood" under section 7 of the Copyright Act of 1909—namely, that "copyright in a 'new version' covers only the material added by the later author, and has no effect one way or the other on the copyright or public domain status of the preexisting material."¹¹⁰ The need for such

107. 17 U.S.C. § 103(b) (1994).

108. *Id.* § 201(c).

109. *See Tasini*, 972 F. Supp. at 812.

110. *Id.* at 813 (citing H.R. REP. NO. 94-1476, at 57 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5670). Section 7 of the Copyright Act of 1909 stated, in part:

Compilations or abridgements, adaptations, arrangements, dramatizations, translations, or other versions of works in the public domain or of copyrighted works when produced with the consent of the proprietor of the copyright in such works, or works republished with new matter, shall be regarded as new works subject to copyright . . . but the publication of any such new works shall not effect the force or validity of any subsisting copyright upon the matter employed or any part thereof, or be construed to imply an exclusive right to such use of the original works, or to secure or extend copyright in such original works.

Id. at 813 n.6 (alteration in original) (quoting 17 U.S.C. § 7 (1976) (repealed 1976)).

clarification stemmed from the “new property rights”¹¹¹ approach to derivative works¹¹² in which some courts found that

once a derivative work is created pursuant to a valid license to use the underlying material, a new property right springs into existence with respect to the entire derivative work, so that even if the license is thereafter terminated, the proprietor of the derivative work may nevertheless continue to use the material from the underlying work as contained in the derivative work.¹¹³

The United States Supreme Court put the new property rights approach to rest in *Stewart v. Abend*.¹¹⁴ There, the appellants asked the Court to decide whether the makers of the film “Rear Window,” based in large part on a short story entitled “It Had to be Murder,” could continue to distribute the film even though the author of the story died before securing the renewal rights in the story.¹¹⁵ Because the author died without heirs, the renewal rights fell to a trust.¹¹⁶ The trust, in turn, renewed the copyright to “It Had to be Murder” and assigned the rights to the respondent.¹¹⁷ However, the makers of “Rear Window,” Jimmy Stewart, Alfred Hitchcock, and MCA, continued to license the exhibition of the film in reliance on the new property rights theory.¹¹⁸ The Court found that the new property rights approach was

111. *Id.* at 813.

112. Under § 101 of the Act, a derivative work is defined as “a work based upon one or more preexisting works.” 17 U.S.C. § 101 (1994). Further, “[a] work consisting of editorial revisions, annotations, elaborations, or other modifications which, as a whole, represent an original work of authorship, is a ‘derivative work.’” *Id.* As Professor Nimmer states, “[b]oth collective works and derivative works are based upon pre-existing works that are in themselves capable of copyright. . . . Collective works might well have been regarded as a form of derivative work, but that is not the terminology adopted by the drafters of the current Copyright Act.” MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 3.02 (1996).

113. NIMMER & NIMMER, *supra* note 112, § 3.07[A][1]. *See, e.g.*, Rohauer v. Killiam Shows, Inc., 551 F.2d 484 (2d Cir. 1977); Edmonds v. Stern, 248 F. 897 (2d Cir. 1918); Sunset Sec. Co. v. Coward-McCann, Inc., 297 P.2d 137 (Cal. Ct. App. 1956), *vacated* 306 P.2d 777 (1957).

114. 495 U.S. 207 (1990).

115. *See id.* at 211-12.

116. *See id.* at 212.

117. *See id.*

118. *See id.* at 213.

neither warranted by any express provision of the Copyright Act, nor by the rationale as to the scope of protection achieved in a derivative work. It is moreover contrary to the axiomatic copyright principle that a person may exploit only such copyrighted literary material as he either owns or is licensed to use.¹¹⁹

The Court found no support for the new property rights approach in either the 1909 or the 1976 Copyright Acts.¹²⁰ It made no difference if “the pre-existing work is inseparably intertwined with the derivative work.”¹²¹ Thus, without the new property rights theory to rely on, the defendants in *Tasini* could avoid infringement only if they produced revisions of the print publishers’ collective works.¹²²

2. *Privileges versus Rights*

In *Tasini*, the plaintiffs maintained that the “privilege” to reproduce a contribution in a revision constituted a non-exclusive license.¹²³ According to the terms of § 201(d)(1) of the Act, “ownership of a copyright may be transferred in whole or in part by any means of conveyance or by operation of law.”¹²⁴ In addition, under § 201(d)(2), “[a]ny of the exclusive rights comprised in a copyright, including any subdivision of any of the rights specified by § 106, may be transferred as provided by clause (1) and owned separately.”¹²⁵ Plaintiffs argued that because the defendant print publishers held only the “privilege” of reproducing plaintiffs’ individual contributions in revisions,

119. *Id.* at 223 (quoting NIMMER & NIMMER, *supra* note 112, § 3.07[A]).

120. *See id.* at 223-24.

121. *Id.* at 223 (citing *Gilliam v. American Broad. Cos.*, 538 F.2d 14, 20 (2d Cir. 1976)). In *Gilliam*, a case involving ABC’s airing of three Monty Python skits after substantial unauthorized editing, the court held that “[s]ince the copyright in the underlying script survives intact despite the incorporation of that work into a derivative work [(there, the original British Broadcasting Company’s shows)], one who uses the script, even with the permission of the proprietor of the derivative work, may infringe the underlying copyright.” *Gilliam*, 538 F.2d at 20.

122. *See Tasini v. New York Times Co.*, 972 F. Supp. 804, 820-21 (S.D.N.Y. 1997).

123. *See id.* at 815; Garson Brief, *supra* note 21, at 24-31; *Tasini* Brief, *supra* note 21, at 29-34.

124. 17 U.S.C. § 201(d)(1) (1994).

125. *Id.* § 201(d)(2).

such a privilege did not amount to “[a]ny of the exclusive rights” that could be transferred under § 201(d).¹²⁶

The district court in *Tasini* disagreed, stating that subsections (c), (d)(1), and (d)(2) of § 201 all worked together.¹²⁷ The court noted that subsection (d)(2) allowed for the transfer of any subdivision of an exclusive right found in § 106.¹²⁸ The court concluded that under subsection (d)(1) plaintiffs transferred part of their copyright, the right to republish their contributions in a collective work, to the print publisher defendants.¹²⁹ The print publisher defendants then exercised their ownership rights under subsection (d)(2) and sold them to the electronic publisher defendants.¹³⁰ To the district court, the term privilege did “not indicate that the creators of collective works are limited in exercising those few rights, or ‘privileges,’ that they possess.”¹³¹

3. Display Rights

Plaintiffs also argued that § 201(c) limits the medium of a revision to the original medium in which the collective work first appeared.¹³² Plaintiffs argue that § 201(c) of the Act, while allowing the defendants to reproduce the individual contributions, does not allow the defendants to display these contributions, and, thus, does not allow the defendants to make electronic revisions of their collective works.¹³³ The court noted, however, that in the process of making a revision, the defendants would make copies of the individual contributions.¹³⁴ Section 101 of the Act defines copies as “material objects, other than phonorecords, in which a work is fixed by any method now known or later developed, and from which the work can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device.”¹³⁵ After examining the terms of the Act and its legislative history, the

126. *Tasini*, 972 F. Supp. at 815.

127. *See id.*

128. *See id.*

129. *See id.*

130. *See id.*

131. *Id.* at 816.

132. *See id.*

133. *See id.*

134. *See id.* at 820.

135. 17 U.S.C. § 101 (1994).

court concluded that both “reveal a design to extend display rights, in ‘certain limited circumstances,’ to the creators of collective works.”¹³⁶

4. Court’s Analysis of “The Updated Encyclopedia”

By examining the legislative history of § 201(c) of the Act, the *Tasini* plaintiffs also argued that the defendants’ revision should be limited to the same medium as the original.¹³⁷ The plaintiffs focused on the following passage from the House Report:

Under the language of this clause a publishing company could reprint a contribution from one issue in a later issue of its magazine, and could reprint an article from a 1980 edition of an encyclopedia in a 1990 revision of it; the publisher could not revise the contribution itself or include it in a new anthology or an entirely different magazine or other collective work.¹³⁸

The plaintiffs focused on the encyclopedia example as the outer boundary for revision, “one not contemplating new technologies or significant alterations of format and organization.”¹³⁹

The court, however, disagreed with the plaintiffs and accepted the defendants’ argument that the Act was “plainly crafted with the goal of media neutrality in mind.”¹⁴⁰ The court noted that many of the terms defined in the Act allowed for new technologies, and nothing in the Act limited copyright protection to technologies in existence at the time the Act was implemented.¹⁴¹ The court concluded by stating that it was “unwarranted” for plaintiffs to assume that one example in the condensed legislative history amounted to a “radical departure” from an otherwise medium-neutral statute.¹⁴²

136. *Tasini*, 972 F. Supp. at 817.

137. *See id.*

138. *Id.* (quoting H.R. REP. NO. 94-1476, at 122-23 (1976), reprinted in 1976 U.S.C.A.N. 5738).

139. *Id.*

140. *Id.* at 818.

141. *See id.*

142. *Id.* at 818-19.

5. Revisions and Revising "That Collective Work"

Plaintiffs' final argument was that the publisher defendants did not engage in the process of revising collective works, but instead dismantled those collective works and exploited plaintiffs' individual contributions.¹⁴³ Plaintiffs pointed out that the electronic publishers added codes to the individual contributions to allow searching, stored the contributions in separate files next to contributions not originating from the same collective work, and added headers identifying the author, the publication, and page numbers of the original collective work.¹⁴⁴ However, the court found that the electronic works qualified as revisions of the print publishers' collective works because the electronic publisher defendants copied all of the contributions in each collective work and, through headers added to each file, identified the print publishers' original selection of contributions.¹⁴⁵

To reach its conclusion, the court first examined which elements of the print publishers' collective works qualified for copyright protection separate from the individual contributions.¹⁴⁶ In this examination, the court utilized the test for originality in factual compilations found in *Feist Publications, Inc. v. Rural Telephone Service Co.*¹⁴⁷ The court next used the substantial similarity test found in *Key Publications, Inc. v. Chinatown Today Publishing Enterprises*.¹⁴⁸

In *Feist*, the Supreme Court decided whether the petitioner infringed upon the respondent's copyright in the contents of a telephone directory when petitioner copied entries from the respondent's telephone directory into its own directory without authorization.¹⁴⁹ The Court reiterated the "well-established propositions" that copyright protection did not exist for facts, but that it could exist for the compilation of facts.¹⁵⁰ Because respondent's work was a compilation of facts, copyright protection could only extend to the elements "original to the

143. *See id.* at 821.

144. *See id.*

145. *See id.* at 824-25.

146. *See id.* at 821-22.

147. 499 U.S. 340 (1991); *see Tasini*, 972 F. Supp. at 821-22.

148. 945 F.2d 509 (2d Cir. 1991); *see Tasini*, 972 F. Supp. at 825.

149. *See Feist*, 499 U.S. at 342-44.

150. *Id.* at 344-45.

author.”¹⁵¹ The Court noted that the originality requirement simply meant that the work was not copied and that it possessed “some minimal degree of creativity. To be sure, the requisite level is extremely low; even a slight amount will suffice.”¹⁵² To determine whether infringement occurred, the Court focused on whether “the selection, coordination, and arrangement [of the facts] are sufficiently original to merit protection.”¹⁵³ When considering respondent’s selection, coordination, and arrangement of facts, the Court concluded that respondent’s work “utterly lacks originality.”¹⁵⁴ The Court found that respondent’s “selection of listings could not be more obvious”¹⁵⁵ and its claim to original coordination and arrangement merely listed “subscribers in alphabetical order[,] . . . an age-old practice . . . that . . . has come to be expected as a matter of course.”¹⁵⁶ Thus, the Court decided that petitioner’s use of respondent’s facts was not copyright infringement.¹⁵⁷

Relying on the analysis from *Feist*, the *Tasini* court reasoned that “[i]f the disputed periodicals manifest an original selection or arrangement of materials, and if that originality is preserved electronically, then the electronic reproductions can be deemed permissible revisions.”¹⁵⁸ The court found that “[o]ne of the defining original aspects of the publisher defendants’ periodicals is the selection of articles included in those works.”¹⁵⁹ The court noted that the electronic publishers copied all of the articles that appeared originally in print, and that the print publishers originally selected these articles for publication by using their editorial discretion.¹⁶⁰

The court further decided that the electronic publisher defendants took “numerous steps to highlight the connection between plaintiffs’ articles and the hard copy periodicals in

151. *Id.* at 345 (citing *Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 547-49 (1985)).

152. *Id.*

153. *Id.* at 358.

154. *Id.* at 364.

155. *Id.* at 362.

156. *Id.* at 363.

157. *See id.* at 364.

158. *Tasini v. New York Times Co.*, 972 F. Supp. 804, 822 (S.D.N.Y. 1997).

159. *Id.* at 823.

160. *See id.* at 824.

which they first appeared.”¹⁶¹ Despite recognizing that “much of what is original about the disputed publications is not evident on line or on disc,”¹⁶² the court nonetheless reasoned that by keeping the original selection of articles, the electronic publishers had “managed to retain one of the few defining original elements of the publishers’ collective works.”¹⁶³ Because of this retention, the court found that the electronic publishers had “succeeded at creating ‘any revision[s]’ of those collective works.”¹⁶⁴

The court also decided that the electronic publications were “substantially similar” to the print publications.¹⁶⁵ A finding of substantial similarity without authorization normally leads to a finding of copyright infringement.¹⁶⁶ In *Tasini*, however, the print publishers permitted the electronic publishers to make revisions to the print publications.¹⁶⁷ In finding the two publications to be substantially similar, the court concluded that it made no sense to hold that the electronic publications were not revisions of the print publications.¹⁶⁸

III. THE APPEAL

All six *Tasini* plaintiffs appealed the district court’s decision granting the defendants summary judgment.¹⁶⁹ Two of the plaintiffs, Barbara Garson and Sonia Jaffe Robbins, are represented by the law firm that argued the case before the district court, while the other four plaintiffs, including lead plaintiff *Tasini*, collectively have retained other counsel.¹⁷⁰

161. *Id.*

162. *Id.*

163. *Id.* at 825.

164. *Id.* (alteration in original).

165. *Id.* (quoting *Key Publications, Inc. v. Chinatown Today Publ’g Enters.*, 945 F.2d 509, 514 (2d Cir. 1991)).

166. *See Key*, 945 F.2d at 515 (“If the Galore Directory is substantially similar to the 1989-90 Key Directory with regard to that arrangement of categories or that selection of businesses, then a finding of infringement can be supported.”).

167. *See Tasini*, 972 F. Supp. at 806.

168. *See id.* at 826.

169. *See Garson Brief, supra* note 21; *Tasini Brief, supra* note 21.

170. *Compare Complaint, supra* note 22, *with Garson Brief, supra* note 21, *and Tasini Brief, supra* note 21.

A. *Whitford's Agreement with Time*

On appeal, Whitford alleges that the district court committed reversible error when it did not find, as a matter of law, that appellee Time infringed his copyright when it failed to pay him a portion of the proceeds it received from the electronic publishers.¹⁷¹ Whitford alleges that the court should have found that Time's breach of its licensing agreement with him "is tantamount to copyright infringement."¹⁷² The agreement between the parties granted Time a non-exclusive right to republish Whitford's article provided it paid him the then-prevailing rate for republication in a Time publication or fifty percent of the net proceeds for republication in any other publication.¹⁷³ Whitford argues that because there was an express transfer of copyright, or at least some of the rights under it, the privilege found in § 201(c) does not apply to Time.¹⁷⁴ Further, Whitford argues that because Time failed to compensate him for its allowing NEXIS to republish his article, the district court should have found Time liable for copyright infringement, even without his raising a breach of contract claim.¹⁷⁵ Whitford maintains that Time or any publisher's "material breach of a licensing agreement involving copyrights provides the copyright owner with the right of rescission and, thus, the concomitant right to sue for copyright infringement."¹⁷⁶

171. See Tasini Brief, *supra* note 21, at 37.

172. *Id.*

173. See *id.* at 34.

174. See *id.* at 34-36; see also 17 U.S.C. § 201(c) (1994) (stating, in pertinent part, that "[i]n 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") (emphasis added)).

175. See Tasini Brief, *supra* note 21, at 36-37.

176. Tasini Reply Brief, *supra* note 36, at 21 (citing *Schoenberg v. Shapolsky Publishers, Inc.*, 971 F.2d 926, 929-30 (2d Cir. 1992)).

Rescission will be permitted where an assignee or licensee fails to pay royalties due to his assignor or licensor Upon such rescission, the assignment or license is terminated and the copyright proprietor may hold his former grantee liable as an infringer for subsequent use of the work. Failing such rescission, by contrast, the grant continues in place, thus precluding infringement liability until such time as the copyright owner exercises his entitlement to rescind.

MELVILLE B. NIMMER & DAVID NIMMER, *NIMMER ON COPYRIGHT*, § 10.15[A] (1998). The parties' briefs do not make clear whether Whitford rescinded his contract with Time. See

Time, in its responsive brief, argues that Whitford has effectively waived his contract claim on appeal because he failed to raise it below.¹⁷⁷ However, if the court considers such a claim, Time contends that Whitford knew of the existence of electronic databases such as NEXIS as early as 1990, had used such a database as early as 1991, and, therefore, had the duty to “carve[] out any rights he sought to reserve in addition to those he specifically negotiated.”¹⁷⁸ Relying on the holding in *Bartsch*, Time argues that “where the words of a contractual grant of rights ‘are broad enough to cover the new use . . . the burden of framing and negotiating an exception should fall on the grantor.’ ”¹⁷⁹

B. Whether the Print Publishers’ Privilege is Transferable

On appeal, both groups of appellants contend that the district court was simply wrong when it determined that the privilege found in § 201(c) could be licensed to third parties.¹⁸⁰ The original authors assert that the print publishers’ admissions that appellants retained the right to license their works to other publishers establishes that the print publishers were only granted a non-exclusive license in the contributions, and that a non-exclusive license, by definition a license without a property interest, is not transferable.¹⁸¹ The Tasini appellants also point out that under § 103(b), publishers obtain no rights in preexisting material used in a collective work and that in each case appellants’ individual contributions were all created before

Brief for Defendants-Appellees, at 70, *Tasini v. New York Times Co.*, 972 F. Supp. 804 (S.D.N.Y. 1997) (No. 97-9181(L)) [hereinafter Appellees’ Brief].

177. See Appellees’ Brief, *supra* note 176. The district court recognized that Whitford’s contract with Time gave Time the non-exclusive right to “license the republication of the Story . . . in other publications, provided that the Magazine [paid Whitford] fifty percent (50%) of all net proceeds it receive[d] for such republication.” *Tasini*, 972 F. Supp. at 807. However, the court noted that Whitford had not advanced a breach of contract claim against Time. See *id.* at 811-12 n.4.

178. Appellees’ Brief, *supra* note 176, at 72.

179. *Id.* at 73 (alteration in original) (emphasis in original) (quoting *Bartsch v. Metro-Goldwyn-Mayer, Inc.*, 391 F.2d 150, 155 (2d Cir. 1968)).

180. See Garson Brief, *supra* note 21, at 24-32; *Tasini* Brief, *supra* note 21, at 28-34; *Tasini* Reply Brief, *supra* note 36, at 19.

181. See Garson Brief, *supra* note 21, at 28; *Tasini* Brief, *supra* note 21, at 32-33; *Tasini* Reply Brief, *supra* note 36, at 18.

the print publishers' collective works.¹⁸² Additionally, both the Tasini and Garson appellants maintain that under the definition of "transfer of copyright ownership" found in § 101, no transfer of ownership occurs under a grant of a non-exclusive license.¹⁸³

The Tasini appellants also assert that a privilege is different from a right by pointing out that the term "privilege" is used in the Act only three times.¹⁸⁴ In two of these three instances, §§ 109(d) and 111(d) of the Act, the term refers to a non-exclusive license that cannot be transferred without the express permission of the copyright owner.¹⁸⁵ As support for their argument that the term "privilege" in § 201(c) should be read in the same manner as these sections, the Tasini appellants point to the legislative history of the Act.¹⁸⁶ In comparing the 1961 and 1963 drafts of § 201(c), the Tasini appellants point out that the 1961 draft allowed the publisher to hold in trust for authors any rights not expressly assigned to the publisher when they included a contribution in a collective work.¹⁸⁷ The 1963 draft, however, eliminated the trust provision and stated that in the absence of an express transfer of copyright or any of the § 106 rights, the publisher of a collective work only has a privilege of publishing the contribution in its collective work.¹⁸⁸ The Tasini appellants argue that the privilege language in § 201(c) is a

182. See Tasini Brief, *supra* note 21, at 33.

183. See *id.* at 32-33 (citing the § 101 definition of "transfer of copyright ownership," which specifically states that a transfer is "an assignment, mortgage, exclusive license, or any other conveyance, alienation, or hypothecation of a copyright or of any of the exclusive rights comprised in a copyright, whether or not it is limited in time or place of effect, *but not including a nonexclusive license*") (emphasis in original); Garson Brief, *supra* note 21, at 27 (quoting the same language as the Tasini appellants, with the same emphasis).

184. According to the *Tasini* appellants, the term "privilege" appears in §§ 109(d), 111(d)(1)(B)(i), and 201(c). See Tasini Brief, *supra* note 21, at 29-30.

185. See *id.* at 29-30. Section 109(d) states, in part, that "privileges prescribed by subsections (a) and (c) do not, unless authorized by the copyright owner, extend to any person who has acquired possession of the copy or phonorecord." 17 U.S.C. § 109(d) (1994). Section 111(d)(1)(B)(i) refers to the fee that a cable system must pay for the "privilege" of retransmitting conventional television broadcasts. See *id.* § 111(d)(1)(B)(i).

186. See Tasini Brief, *supra* note 21, at 31-32; see also Alice Haemmerli, *Commentary: Tasini v. New York Times Co.*, 22 COLUM.-VLA J.L. & ARTS 129, 135-40 (1998) (discussing legislative history of § 201(c) and term "privilege"). Haemmerli is counsel to two appellants in *Tasini*, Barbara Garson and Sonia Jaffe Robbins. See *id.* at 129.

187. See Tasini Brief, *supra* note 21, at 31-32 (citing Register of Copyright for the House Comm. on Judiciary, 87th Cong., 1st Sess. (1961)).

188. See *id.* (citing Staff of House Comm. on Judiciary, 88th Cong., 2d Sess. (1963)).

fallback position when there is no express transfer of copyright or subdivision of copyright in an individual contribution to a collective work.¹⁸⁹ Thus, the Tasini appellants contend that the district court should have found that the privilege granted to publishers in § 201(c) is a non-exclusive license that cannot be transferred to a third party.¹⁹⁰

The Garson appellants analogize to patent law, in which the holder of a non-exclusive license does not receive an ownership interest in the patent, but “mere[ly a] waiver of the [licensors’] right to sue.”¹⁹¹ They point out that under patent law a non-exclusive patent license is nontransferable as a matter of law.¹⁹² Further, the Garson appellants maintain that the district court’s reading of § 201(c) “may well have rendered § 103(b) meaningless.”¹⁹³ Finally, the Garson appellants suggest that if Congress had wished to grant publishers a transferable right, rather than a non-exclusive, nontransferable privilege, all Congress “had to do was use the same word in § 201(c) that it had used scores of times in the statute—*i.e.*, the word ‘right.’ ”¹⁹⁴

Appellees counter appellants’ nontransferability assertion by arguing that under appellants’ reading of § 201(c), microfilm reproductions produced by UMI would infringe the appellants’ copyright in their individual contributions “because they were created under a non-transferable reproduction ‘privilege.’ ”¹⁹⁵ The Tasini appellants maintain that UMI’s microfilm is very different from its CD-ROM products in that microfilms “contain photographic replicas of the original periodicals” while the electronic publications contain “a commingling of chopped-up, segregated, print-only, article-by-article files.”¹⁹⁶ Appellees also point to the legislative history of the Act’s passage; however, they claim it illustrates that the drafters of the Act “all

189. *See id.* at 31.

190. *See id.* at 34.

191. Garson Brief, *supra* note 21, at 29.

192. *See id.*

193. *Id.* at 31; *see also* 17 U.S.C. § 103(b) (1994) (stating, in pertinent part, that “copyright in a compilation or derivative work . . . does not imply any exclusive right in the preexisting material. The copyright in such work is independent of, and does not affect or enlarge the scope, duration, ownership, or subsistence of, any copyright protection in the preexisting material”).

194. Garson Brief, *supra* note 21, at 32.

195. Appellees’ Brief, *supra* note 176, at 42-43.

196. Tasini Reply Brief, *supra* note 36, at 9-10.

understood that under § 201(c), 'the owner of the collective work obtains only certain limited *rights* with respect to each contribution.'¹⁹⁷ Appellees also point to the case law surrounding *Harry Fox Agency, Inc. v. Mills Music, Inc.*,¹⁹⁸ in which the federal district court, intermediate appellate court, and the United States Supreme Court, considering whether a license was transferable, found that "the relevant history established that the 'privilege' was a 'right' that could be 'licensed.'¹⁹⁹ The appellees conclude that nothing in the legislative history as elaborated in the *Mills Music* cases "suggest[s] any intent by Congress to treat 'privileges' granted under the Copyright Act as distinct from 'rights' by making the former non-licensable."²⁰⁰

The Garson appellants claim that appellees' reliance on the *Mills Music* cases is misplaced²⁰¹ and maintain that in these cases, the courts were not deciding whether the privilege was transferable, but were determining the original holder of the privilege.²⁰² The Garson appellants contend that a contractual arrangement in the *Mills Music* cases allowed the privilege to be transferred and that the courts would not have found the privilege transferable absent contractual terms.²⁰³

C. Appellants' "New Anthology" Argument

The district court noted that the original author appellants did not specifically advance the argument that the electronic publications qualify as independent collective works.²⁰⁴ On

197. Appellees' Brief, *supra* note 176, at 44-45 (quoting Copyright Law Revision: Hearings on H.R. 2223 Before the Subcomm. on Courts, Civil Liberties, and Admin. of Justice of the House Comm. on the Judiciary, 94th Cong., 1st Sess. (1975)) (emphasis in original).

198. 543 F. Supp. 844 (S.D.N.Y. 1982), *rev'd* 720 F.2d 733 (2d Cir. 1983), *rev'd sub nom. Mills Music, Inc. v. Snyder*, 469 U.S. 153 (1985).

199. Appellees' Brief, *supra* note 176, at 47 (citing the *Mills Music* cases, 469 U.S. at 174-75 n.42; 720 F.2d at 741; 543 F. Supp. at 854-55).

200. *Id.* at 48-49.

201. See Reply Brief for Plaintiffs-Appellants Barbara Garson and Sonia Jaffe Robbins at 18, *Tasini v. New York Times Co.*, 972 F. Supp. 804 (S.D.N.Y. 1997) (No. 97-9181(L)).

202. *See id.* at 18-20.

203. *See id.* at 21-22.

204. *See Tasini v. New York Times Co.*, 972 F. Supp. 804, 823 n.13 (S.D.N.Y. 1997). The court, in a footnote, stated that "there is no intervening original selection of articles that might render NEXIS or UMI's CD-ROMs separate collective works. . . . Plaintiffs have not, in any event, contended that NEXIS and the disputed CD-ROMs would qualify as

appeal, however, appellants and their amici allege that the defendants' electronic publications are separate collective works, specifically "new anthologies," and that the electronic publishers are prohibited from including the individual contributions in these new anthologies without the appellants' express permission.²⁰⁵ Appellees counter that the court should reject the appellants' "'new collective work' argument . . . as inconsistent with the facts and the plain language of the Act."²⁰⁶ Appellees also assert that the court "need not reach the question of whether NEXIS and UMI CD[-]ROMs are new works for two additional reasons: (i) not only did Appellants not make that argument below, but (ii) they adduced no evidence sufficient to decide it."²⁰⁷

Appellants and their amici point out that § 201(c) of the Act gives the print publisher appellees only the privilege of reproducing appellants' individual contributions to their collective works "as part of that particular collective work, any revision of that collective work, and any later collective work in the same series."²⁰⁸ Appellants cite the House report containing the legislative history of the Act,²⁰⁹ which states:

Under the language of [§ 201(c)] a publishing company could reprint a contribution from one issue in a later issue of its magazine, and could reprint an article from a 1980 edition of an encyclopedia in a 1990 revision of it; the publisher could not revise the contribution itself or include it in a new

such." *Id.* (citations omitted).

205. See Garson Brief, *supra* note 21, at 43-47; Tasini Brief, *supra* note 21, at 20-28; Brief of American Society of Media Photographers, Inc. et al. as Amici Curiae in Support of Plaintiffs-Appellants at 27-28, *Tasini v. New York Times Co.*, 972 F. Supp. 804 (S.D.N.Y. 1997) (No. 97-9181(L)) [hereinafter Amici Brief]. The amici are 20 organizations of freelance authors who claim "that [the] decision grants publishers the right to reuse valuable copyrighted works created and owned by freelance authors without paying for that right." *Id.* at 6. The Garson appellants do not believe that the electronic publications qualify as collective works and only argue that the electronic publishers' works are new anthologies if the appellate court is inclined to find that these works are collective works. See Garson Brief, *supra* note 21, at 47.

206. Appellees' Brief, *supra* note 176, at 10 n.9.

207. *Id.* at 66 n.52.

208. Tasini Brief, *supra* note 21, at 15 (quoting 17 U.S.C. § 201(c) (1994)). See generally Amici Brief, *supra* note 205; Garson Brief, *supra* note 21.

209. See Tasini Brief, *supra* note 21, at 20.

anthology or an entirely different magazine or other collective work.²¹⁰

Appellants contend that the physical construction and uses made of the electronic publications transform each electronic publication into a new anthology of collective works, and, as stated in the legislative history, that the print publishers are expressly prohibited from including the authors' individual contributions in a new anthology.²¹¹

Appellants attack the physical properties of the electronic publications, with the Tasini appellants contending that "after their original publication, [a]uthors' articles were deconstructed and reconstructed so that they could be commingled into vast repositories of articles already included in electronic databases"²¹² The Garson appellants focus on this aspect as well as the fact that users of the electronic publications create new anthologies each time they conduct a search on a given topic.²¹³ Appellants focus on the physical transformation—the stripping of column format, pictures, and advertisements—of each individual contribution as it is "revised" from print into electronic form.²¹⁴ The Tasini appellants allege that because of this transformation, "[t]he only originality retained in the databases is the author's own copyrighted expression."²¹⁵ Finally, appellants contend that the electronic publications in question qualify as new anthologies and become new anthologies each time the publishers add a new batch of

210. H.R. REP. NO. 94-1476, at 122-23 (1976), *reprinted in*, 1976 U.S.C.C.A.N. 5738.

211. See Garson Brief, *supra* note 21, at 43; Tasini Brief, *supra* note 21, at 18-21; see also *Cover Connection: Customer Profile: Managing Research for the World's Largest Media Company* (visited Sept. 30, 1998) <http://www.umi.com/hp/connection/S1996/time_pr1.htm> (available in Georgia State University College of Law Library) (quoting statement by Lany McDonald, Time Warner, Inc.'s Library Director that because Time uses *General Periodicals OnDisc*, "we do not have to store as many back issues. We also are getting a lot of periodicals we didn't include in our collection before we subscribed to the UMI product. Overall, we have streamlined our periodicals list based on what we can get through ProQuest").

212. Tasini Brief, *supra* note 21, at 18.

213. See Garson Brief, *supra* note 21, at 43.

214. See *id.*; Tasini Brief, *supra* note 21, at 19-20.

215. Tasini Brief, *supra* note 21, at 19; see also Garson Brief, *supra* note 21, at 46 (using the words of a UMI representative to demonstrate that even the electronic publishers understand that the only information presented to their users is the copyrighted expression of the individual authors, and that all copyrighted expression of the print publishers cannot be viewed in the electronic products).

articles.²¹⁶ Thus, appellants argue that the Act, by its plain terms and legislative history, prohibits publishers from including authors' individual contributions in new anthologies without the authors' express permission.²¹⁷

Amici American Society of Media Photographers also maintain that the electronic publications in question are entirely new collective works or anthologies.²¹⁸ They, too, focus on the fact that the appellants' individual contributions are combined in electronic databases and placed along with hundreds of other individual contributions not associated with the original print publication.²¹⁹ Amici also attack the district court's conclusion, that the electronic publications are merely revisions of the print publications, by maintaining that there is no way one can reasonably believe that including a print publication in an electronic database composed of hundreds of other print publications constitutes a revision.²²⁰

D. The Feist Test and New Collective Works

While the appellants and amici have persuasive arguments that the electronic publications qualify as new anthologies, there may be an even more straightforward argument that these publications are entirely new collective works. Despite appellees' assertions to the contrary, appellants provided the district court with enough evidence to decide if the electronic publications qualify as a form of collective works entirely different from the collective works of the print publishers.²²¹ If the appellate court considers the issue, it could find that the electronic publications are entirely new collective works by using the same test for originality that the Supreme Court adopted in *Feist*.

The Garson appellants point out that databases were not considered to be collective works either by the Copyright Office, commentators or legal scholars, the district court, or the parties

216. See Garson Brief, *supra* note 21, at 43-46; Tasini Brief, *supra* note 21, at 19-20.

217. See Garson Brief, *supra* note 21, at 43-46; Tasini Brief, *supra* note 21, at 21.

218. See Amici Brief, *supra* note 205, at 14.

219. See *id.* at 15.

220. See *id.* at 16. Amici contend that "[i]t would take a master of Orwellian double-think to view unillustrated *Sports Illustrated* as a mere 'revision' of *Sports Illustrated*." *Id.* at 16-17.

221. See *Tasini v. New York Times Co.*, 972 F. Supp. 804, 807-09 (S.D.N.Y. 1997).

to *Tasini*.²²² The Garson appellants believe that the district court should not have used the *Feist* “substantial similarity” test because it is traditionally applied to factual compilations and not periodicals and newspapers.²²³ They argue in the alternative that if the appellate court is inclined to find that the district court properly used this test, the district court, nonetheless, applied the test incorrectly.²²⁴ The Garson appellants assert that, unlike factual compilations that only need to show substantial similarity between either selection *or* arrangement, the district court should have required the print and electronic publishers to show substantial similarity of selection *and* arrangement between their publications.²²⁵ The Garson appellants maintain that the appellees cannot show such similarity because regardless of how the appellees manipulate the language, electronic publications are in no way substantially similar to the daily or weekly editions of the print publications.²²⁶

Notwithstanding that many in the legal community consider databases to be compilations and not collective works,²²⁷ § 101 states that “[t]he term ‘compilation’ includes collective works.”²²⁸ Thus, one can argue that the electronic publications in question are independent collective works, and that inclusion of the appellants’ contributions in these collective works violates § 201(c).²²⁹ Since the originality requirement for compilations is low—all that is required for protection is originality in selection, coordination, and arrangement—the electronic publisher defendants’ publications arguably qualify as collective works.²³⁰ Even a lay person should be able to find that the electronic publishers exercise original selection,

222. See Garson Brief, *supra* note 21, at 45-46.

223. See *id.* at 50.

224. See *id.*

225. See *id.* at 51.

226. See *id.* at 54-57.

227. See *id.* at 45-46.

228. 17 U.S.C. § 101 (1994).

229. See *id.* §§ 101, 201(c).

230. See *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345, 358 (1991) (holding that originality requirement for compilations is “extremely low” and that most compilations will qualify for copyright protection if one can find that the author showed originality in “selection, coordination, and arrangement” of the materials contained in them).

coordination, and arrangement in the periodicals they choose to include in their publications.²³¹

Appellees cannot argue that NEXIS and *General Periodicals OnDisc* contain no original selection because the electronic publishers have added various print periodicals or pieces of periodicals to their publication at different times in their history.²³² The district court even noted that NEXIS did not contain *Sports Illustrated* until 1982, the *New York Times* until 1983, and *Newsday* until 1988.²³³ Likewise, *General Periodicals OnDisc* only includes the *New York Times Magazine and Book Review*, not all editions of the *New York Times*, and it has done so only since 1990.²³⁴ One may conclude, therefore, that the compilers of these publications exercised original selection in the contents of their electronic publications.²³⁵

Once selected, these publications, or more correctly the individual contributions from the print publications, presumably had to be molded into the existing structure of the databases, thus showing original coordination and arrangement.²³⁶ By definition, then, the electronic publications are collective works.²³⁷ If the electronic publications qualify as collective works, then the print publishers exceeded the scope of their privileges by including the appellants' individual contributions to their collective works in another "entirely different" collective work without the plaintiffs' express permission.²³⁸ Because the print publishers lacked the right to include the appellants' individual contributions in an entirely different collective work, regardless of whether the print publishers could license their privilege, the print publishers could not grant the right to include the individual contributions to the electronic publishers.²³⁹ Since the electronic publishers

231. *See id.* at 358.

232. *Cf., e.g., id.* at 340.

233. *See Tasini v. New York Times Co.*, 972 F. Supp. 804, 807 (S.D.N.Y. 1997).

234. *See id.* at 807-08.

235. *Cf., e.g., Feist*, 499 U.S. 340.

236. *Cf. id.*

237. *See* 17 U.S.C. § 101 (1994) (defining collective work as "a work, such as 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").

238. H.R. REP. NO. 94-1476, at 122-23 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5738.

239. *See Gilliam v. American Broad. Cos.*, 538 F.2d 14, 21 (2d Cir. 1976) ("[A] grantor may not convey greater rights than it owns.").

did not have the permission of the individual authors and could not rely on the grants from the print publishers, they too would be liable for copyright infringement of the appellants' contributions.²⁴⁰

E. Electronic Microfilm

The least credible of appellees' arguments is their repeated claim that electronic publications are analogous to microfilm reproductions that are allowed under the Act.²⁴¹ While most researchers presumably enjoy the convenience and ease of information retrieval provided by electronic publications in comparison to more traditional indexes and microfilmed reproductions, it does not follow that electronic publications qualify as "electronic microfilm," giving full consideration to the medium non-restrictiveness of the Act.²⁴² Not only are the uses of the electronic publications and microfilm different, but so are the rights associated with making copies for personal use.²⁴³

Section 108 of the Act, which permits libraries to make copies of individual contributions to periodicals, sets forth two requirements that libraries must meet.²⁴⁴ First, the library or archives must ensure that the "reproduction or distribution is made without any purpose of direct or indirect commercial advantage."²⁴⁵ Second, the "collections . . . [must be] (i) open to the public, or (ii) available not only to researchers affiliated with the library or archives or with the institution of which it is a part but also to other persons doing research in a specialized field."²⁴⁶

240. *See id.*

241. *See "It is a Fascinating Case, and I Have No Idea How I am Going to Rule" Excerpts from Arguments Before Judge Sonia Sotomayor in the Tasini v. NYT case, INFO. L. ALERT: IOMA REP. (Nov. 8, 1996), available in 1996 WL 8913699 (stating that the defendants regard their electronic reproductions as "essentially exactly the same as taking back issues of the New York Times and putting them in big binders and sticking them on a library shelf. And you can analogize precisely for purposes of the Copyright Act to a huge library shelf with lots of issues right next to each other"). See generally Memorandum of Law in Support of Defendants' Motion for Summary Judgment, Tasini v. New York Times Co., 972 F. Supp. 804 (S.D.N.Y. 1997), reprinted in Westlaw, 480 PLI/Pat 175, at *195-96 [hereinafter Defendants' Memorandum]; Appellees' Brief, supra note 176, at 51-56.*

242. *See Tasini Reply Brief, supra note 36, at 9-13.*

243. *See id.* at 11-12.

244. *See* 17 U.S.C. § 108(a)(1)-(2) (1994).

245. *Id.* § 108(a)(1); *see also* Tasini Reply Brief, *supra* note 36, at 11-12.

246. 17 U.S.C. § 108(a)(2) (1994); *see also* Tasini Reply Brief, *supra* note 36, at 12.

Under either clause, NEXIS's reproduction would certainly not qualify. Not only is NEXIS's main purpose commercial, but its database is restricted to subscribers with a commercial agreement with NEXIS.²⁴⁷ As appellees correctly point out, services such as NEXIS and CD-ROMs such as *General Periodicals OnDisc* have made the "process of periodicals research much more efficient."²⁴⁸ These services, however, do not provide this efficiency to all who wish to access the information or operate without a profit-driven motive for allowing users to retain a copy.²⁴⁹

CONCLUSION

While some in the publishing community express the belief that the *Tasini* decision extends to the World Wide Web and allows publishers to include individual contributions to collective works on-line, others are not sure.²⁵⁰ Despite the publishing community's great expectations, the grant of summary judgment to the *Tasini* publishers should be reversed as it rests on a "bizarre interpretation of the copyright law," subject to a different outcome on remand or appeal.²⁵¹ The plain terms of § 201(c) support the original authors' arguments that a privilege is different than a right and that the electronic publications cannot be revisions of the daily or weekly editions of the periodicals in question.²⁵² Because the appellees admit that they were granted only a non-exclusive license, they are not permitted to transfer their privilege to third parties, and by so doing, they have violated original authors' copyrights in their individual contributions.²⁵³

While the court correctly found that none of the print publisher defendants secured the plaintiffs' permission to put their individual contributions in electronic "revisions," clear and unambiguous contractual agreements remain the best way for

247. See *Tasini Reply Brief*, *supra* note 36, at 12.

248. Defendants' Memorandum, *supra* note 241, at *195.

249. See *Complaint*, *supra* note 22, ¶¶ 42-47.

250. See *Court Decision Extends to Web: N.Y. Times Exec*, *MEDIA DAILY* (Aug. 18, 1997), available in 1997 WL 7731327.

251. *Id.* (quoting statement by plaintiff *Tasini*, NWU President).

252. See 17 U.S.C. § 201(c) (1994).

253. Garson Brief, *supra* note 21, at 28.

freelance writers to retain, and for publishers to secure, any rights they wish.²⁵⁴ An interesting question is why the print publisher defendants did not secure the electronic rights from the authors through writings and, thus, eliminate any threat of litigation. After all, the print publishers knew that they were going to include the collective works in the electronic publications when they first decided to print the contributions.²⁵⁵

If the Second Circuit Court of Appeals reverses the district court's grant of summary judgment, a fair solution suggested by the *Tasini* appellants to this sticky issue would be to create a clearinghouse in which the publishers pay a fair price for including individual authors' works in electronic databases.²⁵⁶ The clearinghouse, in turn, distributes the income to the appropriate copyright holder.²⁵⁷ Clearinghouses of this type are currently used to collect and distribute copyright royalties from compulsory licenses and public performances in the music industry and for libraries.²⁵⁸ The individual authors in *Tasini* do not claim that their works should not be available in the new electronic databases, only that they, as creators of the information, should be compensated just as the print publishers are compensated by the electronic publishers.²⁵⁹ Rather than demanding a windfall for themselves, the publishers should find a solution in which everyone gains, especially the independent authors without whom the publishers would have little to print.

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254. See Carlinsky, *supra* note 25, at A16.

255. See discussion, *supra* Part I.

256. See *Tasini* Reply Brief, *supra* note 36, at 13-14.

257. See *id.*

258. See *id.*

259. See *id.* at 1.