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TASINI V. NEW YORK TIMES: WRONG ISSUE, WRONG PRESUMPTION

After all, the object of copyright is not only to protect the author's intellectual efforts, but also the distribution of knowledge.¹

I. INTRODUCTION

A freelance author sells first publication rights of an article to a major periodical. Later, he receives an e-mail from an interested reader who found the article in an on-line database. The author subsequently learns that the publisher of the periodical sold the rights to his article to an on-line, computer-assisted text retrieval system similar to LEXIS/NEXIS. The potential readership of the article has thus expanded greatly. However, the author was never compensated for this electronic publication. In accordance with industry standards, the author has a very informal contract with the publisher. Does the author deserve additional compensation? In a much anticipated decision, a federal district court judge ruled "no."²

A photographer sells a publisher the right to include his photograph in an art book. The publisher later puts all of the photographs from the book on its website. Visitors to the website can download any image that appeals to them. Under the same ruling, the photographer may be unable to prevent the publisher's free distribution of his work.³

1. Egbert J. Dommering, *Copyright Being Washed Away Through the Electronic Sieve. Some Thoughts on the Impending Copyright Crisis*, in THE FUTURE OF COPYRIGHT IN A DIGITAL ENVIRONMENT 1, 10 (P. Bernt Hugenholtz ed., 1996).

2. See *Tasini v. New York Times Co.*, 972 F. Supp. 804, 826-27 (S.D. N.Y. Aug. 13, 1997) (*Tasini I*), *reh'g denied*, 981 F. Supp. 841 (S.D.N.Y. Oct. 29, 1997) (*Tasini II*).

3. See generally *id.*

"An increasing number of print publications are distributing their works on the Internet or other electronic media."⁴ Communication via computer networks will soon be, if it is not already, the least expensive and most effective means of communicating with large audiences.⁵ Some believe that the Internet has revolutionized publishing to the same degree as the Gutenberg printing press.⁶

While the National Commission on New Technological Uses of Copyrighted Works envisioned electronic publishing as offering the copyright owner more control over distribution than traditional publishing,⁷ the reverse may actually be true. The crucial question in this regard has now become: Who owns that copyright?

The much anticipated⁸ *Tasini v. New York Times Co.* decision is a triumph for publishers who have been struggling with freelance authors for control of electronic publishing rights.⁹ Relying on a never before interpreted provision of the Copyright Act of 1976, Judge Sonia Sotomayor of the United States District Court for the

4. Richard Raysman & Peter Brown, *Electronic Data Bases and Rights of Freelancers*, N.Y. L.J., Sept. 9, 1997, at 3.

5. See Edward J. Naughton, *Is Cyberspace a Public Forum? Computer Bulletin Boards, Free Speech, and State Action*, 81 GEO. L.J. 409, 413 (1992).

6. See Dean Takahashi, *Paper-Less Publisher*, L.A. TIMES (Orange County ed.), Mar. 2, 1994, at D1.

7. It is now technologically possible to distribute text, data and graphics electronically rather than in traditional printed forms. . . . In addition, more and more textual materials appearing ultimately in printed form exist at some state in the production process in digital form on tapes and disks or other electronic storage devices. The full text of certain legal materials, such as court decisions, can already be displayed on computer terminals from distant data bases.

. . . If the copyright owner possesses material in digital form on tapes or other storage devices and sells access to such material by contracts with users, the copyright owner may have more effective control over unauthorized use than over information distributed in printed form.

U.S. NATIONAL COMMISSION ON NEW TECHNOLOGICAL USES OF COPYRIGHTED WORKS (CONTU), FINAL REPORT, at 196 (July 31, 1978) (2 Copyright L. Rep. (CCH) Aug. 31, 1978).

8. See, e.g., John B. Kennedy & Shoshana R. Dweck, *Publisher, Authors Battle Over Electronic Rights: Debate Over Allocation of Rights and Money Sparks Lawsuits and Birth of the Authors' Registry*, NAT'L L.J., Oct. 28, 1996, at C17.

9. See *Tasini I*, 972 F. Supp. 804, 827 (S.D.N.Y. 1997).

Southern District of New York ruled that publishers are presumed to have the right to include underlying works in any revision of a collective work.¹⁰ Judge Sotomayor further interpreted 'revision' broadly enough to encompass any work that includes the original selection of a specific type of underlying work.¹¹ Authors must now explicitly exclude revision rights in contracts to avoid the statutory transfer of these rights to the publishers.¹²

"[W]hile other district courts are not bound to follow Judge Sotomayor's ruling, the thoroughness of the opinion and the detailed record before the court make it highly persuasive."¹³ Since the decision originates from the publishing hub of New York,¹⁴ the publishing industry may give the decision substantial weight even without additional judicial support.

The ramifications of *Tasini* remain uncertain. The decision can be narrowly interpreted to extend the established publishers' practice of creating archival libraries of periodicals on microfilm to CD-ROM and LEXIS technology.¹⁵ Alternatively, the decision can be broadly interpreted to grant publishers the right to distribute articles on the Internet provided that some rudimentary aspect of the original publication is preserved.¹⁶ The winning defendants are inclined to use the latter broad interpretation as the basis for their business decisions.¹⁷ This threat has sparked the creation of the Publication Rights

10. *See id.* at 824-27.

11. *See id.* at 825.

12. *See Tasini II*, 981 F. Supp. 841, 846 (S.D.N.Y. 1997).

13. Dale M. Cendali & Ramon E. Reyes, Jr., *Freelancers Reeling in Fight over Online Rights: Unless Congress Takes Action, Authors May Be Denied Pay for Electronic Publishing Rights*, NAT'L L.J., Oct. 20, 1997, at C2.

14. *See THE WORLD ALMANAC AND BOOK OF FACTS 1996* 670 (Robert Famighetti ed., 1995).

15. "The Internet and Web are[not], in fact, expressly mentioned even once in the 56-page opinion by U.S. District Court Judge Sonia Sotomayor. [Perhaps the omission is due to the fact that t]he suit was filed in 1993 before the medium took off as a communications phenomenon." *Court Decision Extends to Web: N.Y. Times Exec*, MEDIA DAILY, Aug. 18, 1997, at 5, available in 1997 WL 7731127.

16. *See Cendali & Reyes, supra* note 13.

17. "George Freeman, the [*New York Times*'] assistant general counsel, told *Media Daily* that the newspaper believes Wednesday's court decision extends to 'electronic revisions of the newspaper wherever they may be,' including the Web." *Court Decision Extends to Web: N.Y. Times Exec, supra* note 15.

Clearinghouse,¹⁸ an agency designed to ensure that authors receive their fair share of revenues from the information industry.¹⁹

This Note addresses the implications of *Tasini* with respect to the emerging electronic publishing industry and suggests alternative paths by critiquing the reasoning of the court. Part II summarizes the facts of the case and gives the current procedural history. Part III describes the court's reasoning. Part IV addresses the fundamental issues raised by the case, including: (1) whether statutory transfers of rights should be possible when an express transfer exists; (2) whether plaintiffs must raise a breach of contract claim for a court to find that an express transfer does not include certain rights; (3) whether incidental display rights are an integral part of reproduction or distribution rights; and (4) what analysis should be used to determine if a subsequent collective work qualifies as a revision of the original. Part V concludes that the court overlooked the true issues presented by this case in its eagerness to use existing case law to interpret a never before interpreted section of the Copyright Code. The court should have addressed these novel issues in light of the code without regard to previous unrelated case law; if it had, revision rights would have been more narrowly and reasonably defined.

II. STATEMENT OF THE CASE

In *Tasini*, the plaintiffs were various freelance writers who, between 1990 and 1993, had contributed articles for publication in the periodicals of the defendant publishers.²⁰ The defendants published leading national periodicals including the *New York Times*, *Newsday*, and *Sports Illustrated*.²¹

The writers' agreements with their publishers varied but were all relatively informal.²² The least formal agreements were oral agreements with the *New York Times*.²³ These agreements covered the

18. See Kennedy & Dweck, *supra* note 8.

19. See *National Writers Union and the Uncover Company Create Copyright Model for Electronic Database Industry*, ONLINE LIBRARIES & MICROCOMPUTERS, Apr. 1, 1996, available in 1996 WL 8156502 [hereinafter *National Writers Union*].

20. See *Tasini I*, 972 F. Supp. 804, 806 (S.D.N.Y. 1997).

21. See *id.* at 806.

22. See *id.* at 807.

23. See *id.*

topic and length of the article, the deadline for submission, and the fee; there was no discussion of which rights would be transferred to the *New York Times* with respect to the agreement.²⁴ The agreements with *Newsday* were similar to those with the *New York Times*, except that *Newsday* included some contractual language in the endorsement on the payment checks.²⁵ The endorsements specifically granted *Newsday* the "right to include [plaintiff's articles] in electronic library archives."²⁶ The most formal agreement involved in this case was a written contract with *Sports Illustrated*.²⁷ The contract expressly granted *Sports Illustrated* three rights: (1) "the exclusive right first to publish the Story in the Magazine," (2) the non-exclusive right to republish the article in other publications on the condition that the author be paid additional compensation, and (3) the non-exclusive right to license such republication on the condition that the author be paid additional compensation.²⁸

The controversy arose from agreements under which the periodical publisher defendants (print publishers) sold the contents of their periodicals to the electronic publisher defendants (e-publishers) for inclusion in assorted electronic databases (e-publication). The print publishers and e-publishers entered into these agreements beginning in 1982.²⁹ The e-publishers included MEAD Corporation and University Microfilms Inc. (UMI).³⁰ MEAD owns and operates NEXIS, an on-line electronic text retrieval system.³¹ UMI produces CD-ROM products, such as the *New York Times OnDisc*, which operate like NEXIS but consist exclusively of all articles published in the *New York Times*.³²

The print publishers transmitted computer files containing the full text of all articles appearing in each edition of their periodicals to

24. *See id.*

25. *See id.*

26. *Id.*

27. *See id.*

28. *Id.*

29. *See id.*

30. *See id.* at 806.

31. *See id.*

32. *See id.*

the e-publishers.³³ These transmissions included formatting instructions.³⁴ The e-publishers focused on the text of the articles alone.³⁵ Their products did not include the advertisements and photographs from the original print publications.³⁶ The e-publishers preserved the original formatting only to the extent that a header attached to the text of each article identified the title of the article, the author, the periodical, and the page on which it originally appeared.³⁷ In this form, the e-publishers incorporated each article from the original periodicals into their database products.³⁸ The articles became available via the products of the e-publishers approximately one publishing cycle after the original publication.³⁹

Customers could access the NEXIS database on-line.⁴⁰ Users typically accessed the *New York Times OnDisc* via a computer network.⁴¹ Customers of the e-publishers accessed articles within the databases by choosing from libraries of publications and inputting specific search criteria.⁴² Each search resulted in a list of articles that met the selected search criteria.⁴³ The list cited each identified article by its author and title, among other parameters describing the article.⁴⁴ The customers could then, at their discretion, review the full text of any article cited on the list.⁴⁵

The plaintiffs argued that their grant to the print publishers was limited and that the defendants infringed on their copyrights by including their articles in electronic databases and selling the right to

33. *See id.* at 808.

34. *See id.*

35. *See id.*

36. *See id.*

37. *See id.* This statement and the two preceding notes are true with respect to all but one of the e-publishers' products. E-publisher UMI also published *General Periodicals OnDisc*, an image-based reproduction of the *New York Times Book Review* and *Sunday Magazine*. *See id.* at 806. The application of copyright law to *General Periodicals OnDisc*, and similar e-publications, is not the subject of this Note.

38. *See id.* at 808.

39. *See id.*

40. *See id.*

41. *See id.*

42. *See id.*

43. *See id.*

44. *See id.*

45. *See id.*

do so.⁴⁶ The defendants⁴⁷ countered that the plaintiffs expressly contractually granted them the right to use their articles in electronic databases,⁴⁸ that such databases were archival in nature,⁴⁹ that the right of first publication included various media,⁵⁰ and that section 201(c) of the Copyright Act of 1976 statutorily granted them the right to use their articles in electronic database revisions of the original publication.⁵¹

The *Tasini* court found that the plaintiffs did not expressly contractually license the defendants to use the articles in electronic databases⁵² and that the right to first publish was limited to one form of media, not each or all.⁵³ However, the court also found that section 201(c) of the Copyright Act statutorily granted the transferable license to use the articles in any revision of the original periodical to the defendants.⁵⁴ The court held that, since the e-publications qualified as revisions to the original periodicals, the defendants did not infringe on the plaintiffs' copyrights.⁵⁵

The Southern District of New York recently denied the petition for rehearing in a long opinion that purported to clarify its previous ruling.⁵⁶ The plaintiffs' appeal is currently under consideration by the United States Second Circuit Court of Appeals.⁵⁷

III. REASONING OF THE COURT

Part III of this Note describes the reasoning of the court: Section III.A describes the court's analysis of the contracts between the

46. *See id.* at 809.

47. The *Atlantic Monthly*, a former defendant, settled its dispute with the plaintiffs prior to the decision at issue. *See id.* at 806 n.1. *See also* Ross Kerber, *Atlantic Monthly Agrees to Settle Action Over Electronic Publishing*, WALL ST. J., Mar. 29, 1996, at B6.

48. *See Tasini I*, 972 F. Supp. at 809.

49. *See id.* at 811.

50. *See id.* at 811-12.

51. *See id.* at 809.

52. *See id.* at 812.

53. *See id.*

54. *See id.* at 819.

55. *See id.* at 825-26.

56. *See Tasini II*, 981 F. Supp. 841 (S.D.N.Y. 1997).

57. *See Tasini v. New York Times Co.*, No. 97-9181 (2d Cir. filed Feb. 3, 1998).

plaintiffs and defendants; Section III.B describes the court's analysis of the Copyright Act as it applies to the facts of the case; and Section III.C describes the court's application of case law to the facts of the case and recounts the court's holding.

A. Contract Interpretation

The court began by addressing the allegations of *Newsday* and *Sports Illustrated* that the plaintiffs contractually granted them the right to use the articles in electronic databases.⁵⁸ Section 204(a) of the Copyright Act of 1976 provides that "[a] transfer of copyright ownership . . . is not valid unless an instrument or conveyance, or a note or memorandum of the transfer, is in writing and signed by the owner of the rights conveyed."⁵⁹ In light of this rule and the fact that it had only a verbal agreement with the plaintiffs, the *New York Times* declined to claim an express transfer of the exclusive right to use the articles in electronic databases.⁶⁰ The court minimally required that the writing be clear to be effective in transferring copyright ownership.⁶¹

Newsday argued that the legend of the checks made out to the plaintiffs satisfied the writing requirement.⁶² The legend indicated that the plaintiffs' endorsement of the check transferred the right to include the articles in "electronic library archives."⁶³ *Newsday* argued that the legend included the right to use the article in a commercial database.⁶⁴ The court rejected this argument on two grounds. First, the court noted that the plaintiffs did not sign or even receive the checks until after *Newsday* had already transferred the electronic version of the articles to MEAD for inclusion in NEXIS.⁶⁵ Since

58. See *Tasini I*, 972 F. Supp. at 810.

59. *Id.* (quoting 17 U.S.C. § 204(a) (1994)).

60. See *id.* Section 204(a) of the Copyright Act may not exclude the transfer of a non-exclusive license without a writing signed by the author. See MARSHALL LEAFFER, UNDERSTANDING COPYRIGHT LAW § 5.11[A] (2d ed. 1995). Accordingly, since none of the defendants claimed an exclusive right to e-publish the article, any alleged copyright transfer would qualify as a non-exclusive license and may not require a writing to be valid.

61. See *Tasini I*, 972 F. Supp. at 810.

62. See *id.* at 810-11.

63. *Id.* at 807.

64. See *id.* at 810.

65. See *id.*

there was no evidence that the plaintiffs were aware of the legend's terms prior to receiving their checks, the court ruled the check legends did not document a prior oral agreement.⁶⁶ Second, the court noted that *Newsday* maintained its own electronic library archive system, distinct from the commercial databases.⁶⁷ The court explained that the existence of the two types of electronic databases—commercial and archival—made the legend's language ambiguous.⁶⁸

Sports Illustrated's written contract with one of the plaintiffs clearly satisfied the requirement for a writing that records a copyright transfer.⁶⁹ Accordingly, the court concentrated on the issue of whether the contract was properly construed to include e-publication of the article.⁷⁰ *Sports Illustrated* argued that the grant of the right to first publish without any media limitation should cover inclusion of the article in NEXIS.⁷¹ For support, *Sports Illustrated* relied on *Bartsch v. Metro-Goldwyn-Mayer, Inc.* and its progeny, decisions which stand for the proposition that copyright grants should be interpreted broadly in favor of the grantee.⁷² The court, however, called reliance on the *Bartsch* line of authority "misplaced," since none of those decisions dealt with "a contract . . . that imposed specific temporal limitations such as 'first publication rights.'"⁷³ The court then summarily rejected the contention that first publication rights extend to more than one type of media.⁷⁴

66. *See id.* at 811. The 17 U.S.C. § 204(a) requirement for a note or memorandum of transfer can be satisfied by a later writing which confirms the agreement that existed at the time of transfer. *See Eden Toys, Inc. v. Florelee Undergarment Co.*, 697 F.2d 27, 36 (2d Cir. 1982).

67. *See Tasini I*, 972 F. Supp. at 811.

68. *See id.*

69. *See id.* The court implicitly concluded without comment or explanation that a written contract satisfies the requirement for a writing to document the transfer of a copyright.

70. *See id.*

71. *See id.*

72. *See id.* at 811-12 (citing *Bartsch v. Metro-Goldwyn-Mayer, Inc.*, 391 F.2d 150, 154-55 (2d Cir.), *cert. denied*, 393 U.S. 826 (1968)).

73. *Id.* at 812.

74. *See id.* (citing *Harper & Row v. Nation Enters.*, 471 U.S. 539, 564 (1985) (stating "[t]he right of first publication encompasses not only the choice whether to publish at all, but also the choices of when, where, and in what form first to publish a work"))).

In denying a rehearing, the court explained its ruling on the plaintiff's contract with *Sports Illustrated*.⁷⁵ The court emphasized that *Sports Illustrated* invoked only one contract clause in its argument.⁷⁶ It then characterized its original ruling as follows: "the [c]ourt found that the particular contract provision invoked by [*Sports Illustrated*]⁷⁷—the provision extending 'first' publication rights to the publisher—did not authorize the electronic republication of [the plaintiff's] article."⁷⁷ The court noted that "at least two provisions in the contract" could be interpreted to authorize *Sports Illustrated* to publish the plaintiff's article on NEXIS for an additional fee.⁷⁸ The court then concluded that "by declining to press a breach of contract claim" the plaintiff precluded the court from addressing the issue of whether *Sports Illustrated* had exceeded its rights under the contract as a whole.⁷⁹

In sum, the court specifically rejected the defendants' allegations that the plaintiffs had contractually transferred the electronic rights to their articles.⁸⁰ Since the plaintiffs did not contractually license the defendants to use their articles in electronic databases, the question became whether the Copyright Act statutorily authorized the defendants to do so.⁸¹ If the defendants had no statutory authority to e-publish the plaintiffs' articles, then they infringed the plaintiffs' copyrights.⁸²

B. Statutory Construction

The court began its statutory analysis by recognizing that "the pertinent legislative history is notoriously impenetrable."⁸³ Thus, it endorsed a principled approach of viewing each provision of the Copyright Act in the context of the Act as a whole.⁸⁴

75. See *Tasini II*, 981 F. Supp. 841, 843-47 (S.D.N.Y. 1997).

76. See *id.* at 844.

77. *Id.*

78. *Id.* (citing *Tasini I*, 972 F. Supp. at 811-12 n.4).

79. *Id.* at 845.

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

81. See *Tasini II*, 981 F. Supp. at 844-45.

82. See *id.*

83. *Tasini I*, 972 F. Supp. at 812.

84. See *id.*

The court then reviewed the relevant statutory provisions. First, the court had to classify the defendants' work to determine which statutory provisions were relevant. Both parties agreed that the defendants' print publications qualify as collective works under section 101 of the Copyright Act of 1976.⁸⁵ The court explained that a collective work is a type of compilation⁸⁶ and then explored the subject matter of copyright as it concerns compilations.

Section 103(b) of the Copyright Act provides that "[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."⁸⁷ Despite this rule, the court acknowledged that conflicting courts of appeals decisions have raised the possibility of a new property right in an underlying work springing forth and vesting in the authorized user when that user includes the underlying work in a compilation or derivative work.⁸⁸ The new property rights theory gives the author of a compilation the right to use the underlying work in exploiting the compilation.⁸⁹

85. See *id.* at 809. Section 101 of the Copyright Act of 1976 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." 17 U.S.C. § 101 (1994).

86. See *Tasini I*, 972 F. Supp. at 813 n.5. Section 101 of the Copyright Act of 1976 defines a "compilation" 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." 17 U.S.C. § 101.

87. 17 U.S.C. § 103(b) (1994). This provision also says that a copyright in a compilation or derivative work "does not imply any exclusive right in the preexisting material." *Id.* Compilations are distinguishable from derivative works by the fact that a derivative work transforms or adapts the underlying work whereas a compilation does not. See 17 U.S.C. § 101.

88. See *Tasini I*, 972 F. Supp. at 814. Compare *Rohauer v. Killiam Shows, Inc.*, 551 F.2d 484 (2d Cir.) (holding that the authorized creation of a derivative work grants the proprietor of the derivative work a new property right in the underlying work), *cert. denied*, 431 U.S. 949 (1977), with *Gilliam v. ABC*, 538 F.2d 14 (2d Cir. 1976) (upholding an infringement claim based on an unauthorized reuse of the underlying work).

89. See *Tasini I*, 972 F. Supp. at 813. For example, under the new property rights theory, the owner of copyright in a compilation of short stories would have the right to make a movie based on those stories. Under the theory, the author of the compilation acquires copyrights in the underlying stories by virtue of their inclusion in the compilation.

Relying on *Stewart v. Abend*,⁹⁰ the court rejected the new property rights theory and affirmed the plain meaning of section 103(b).⁹¹ Thus, the court concluded that “[u]nder [s]ection 103(b), any unauthorized use of preexisting protected material by the creator of a derivative or a collective work infringes the copyright existing in that preexisting material.”⁹²

Section 201(c) of the Copyright Act regulates the ownership of a copyright as it relates to contributions in collective works.⁹³ Specifically, section 201(c) authorizes the author of a collective work to use preexisting protected material *under specific circumstances*.⁹⁴ The court characterized section 201(c) as expanding “the baseline established in [s]ection 103(b) by extending to the creators of collective works ‘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.’”⁹⁵ The court then defined the critical issue of the case as determining the precise scope of the 201(c) privilege.⁹⁶

Stressing the distinction between ‘rights’ and section 201(c) ‘privileges,’ plaintiffs contended that privileges were not transferable.⁹⁷ Under this argument, the e-publishers had infringed the plaintiffs’ rights, even if their products qualified as revisions to the original collective works.⁹⁸ The court reasoned that the use of the term privileges emphasized the fact that section 201(c) transferred only a subdivision of all available copyright rights.⁹⁹ The court

90. 495 U.S. 207, 223 (1990).

91. *See Tasini I*, 972 F. Supp. at 814.

92. *Id.*

93. *See* 17 U.S.C. § 201(c) (1994).

94. 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.

Id.

95. *Tasini I*, 972 F. Supp. at 814 (quoting 17 U.S.C. § 201(c)).

96. *See id.* at 814.

97. *See id.* at 815.

98. *See id.*

99. *See id.* at 816.

noted that the historical context and legislative history indicate that one of the goals of section 201(c) of the Copyright Act of 1976 was to overcome unfairness resulting from the indivisibility of copyright under prior law.¹⁰⁰ The court then interpreted sections 201(d)(1) and 201(d)(2) together to indicate that a gift, a contract, or the law can transfer “any subdivision” of copyright rights.¹⁰¹ The court concluded that creators of collective works are not limited in how they exercise the rights that they do possess.¹⁰²

The “[p]laintiffs advance[d three] arguments in support of their view that the framers of [s]ection 201(c) intended to limit the creators of collective works to revisi[ons] . . . in the same medium in which those collective works initially appeared.”¹⁰³ First, plaintiffs argued that the failure of section 201(c) to transfer display rights prevented publishers from e-publishing a revision because customers cannot access the revision without an illegal display of the underlying works, such as on a computer screen.¹⁰⁴ The court found that “display of those individual contributions is permissible” provided that it is the “incidental” result of the publisher’s authorized reproduction or distribution.¹⁰⁵ Second, plaintiffs argued that examples of allowable revisions in the legislative history “suggest[] a narrow scope to the term revision.”¹⁰⁶ The court found that it was unwarranted to find a departure from the media neutrality that otherwise characterizes the Copyright Act of 1976 on the basis of these examples. Third, plaintiffs argued that the plain meaning of the term “revision” implied something “nearly identical to the original.”¹⁰⁷ The court countered that by disallowing revisions to individual contributions and allowing “any revision” to the collective work, Congress

100. *See id.* at 815.

101. *Id.*

102. *See id.* at 816.

103. *Id.*

104. *See id.* The fundamental exclusive rights in copyrighted works include the rights to: (1) reproduce, (2) prepare derivative works, (3) distribute copies, (4) perform publicly, and (5) display publicly. *See* 17 U.S.C. § 106 (1994).

105. *Tasini I*, 972 F. Supp. at 817.

106. *Id.*

107. *Id.* at 819.

apparently intended to give publishers "significant leeway" in modifying their own contribution to the collective work.¹⁰⁸ In sum, the court rejected most of the purported limitations on the publishers' section 201(c) privileges.

In denying a rehearing, the court extended its statutory interpretation to an issue not directly addressed in the original opinion. Specifically, the court addressed the plaintiffs' contention that, under the language of the Copyright Act, where an express contract exists, there can be no statutory transfer of copyright.¹⁰⁹ The plaintiffs emphasized the clause "[i]n the absence of an express transfer" that precedes the language providing for a statutory transfer of revision rights to the owner of copyright in a collective work.¹¹⁰ Although the court agreed that the plaintiff's contract with *Sports Illustrated* constituted an express transfer,¹¹¹ it rejected the plaintiffs' contention.¹¹²

The court found that the presumption of a statutory transfer of copyrights where an express contract exists is not inconsistent with the language of the Copyright Act.¹¹³ Section 201(c) states:

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.¹¹⁴

To support its interpretation of the statute, the court focused on the legislators' use of the word "only" in section 201(c):

Instead of using the term "only" to limit those circumstances in which the specified privileges apply, [s]ection 201(c) uses the term "only" to suggest that the specified

108. *See id.*

109. *See Tasini II*, 981 F. Supp. 841, 844 (S.D.N.Y. 1997).

110. *See id.* (quoting 17 U.S.C. § 201(c)).

111. *See id.*

112. *See id.*

113. *See id.* at 845.

114. 17 U.S.C. § 201(c) (1994).

privileges represent a floor—*i.e.*, a minimum level of protection which, if unenhanced by express agreement, publishers are generally presumed to possess.¹¹⁵

Relying on *Bartsch v. Metro-Goldwyn-Mayer, Inc.*,¹¹⁶ the court expounded, “it is an author’s burden to demonstrate that any agreement between the parties limits a publisher to fewer than those [presumed] privileges.”¹¹⁷ The court concluded that the plaintiffs failed to satisfy their burden of proving that the contract with *Sports Illustrated* excluded the statutory transfer of revision rights.¹¹⁸ Thus, the court implicitly found that, unless a transfer agreement expressly excludes it, section 201(c) transfers revision rights to copyright owners of collective works.¹¹⁹

The court acknowledged that “Congress could not have fully anticipated” the effect of section 201(c) on the evolving publishing industry since it could not predict how new technology would affect the value of revision rights.¹²⁰ Remarking that “courts must apply [s]ection 201(c) according to its terms,” the court concluded that Congress was “free to revise that provision to achieve a more equitable result.”¹²¹

The fundamental conclusion of the court’s statutory analysis is that section 201(c) requires that publishers’ later use of individual contributions be part of a work which qualifies as a revision of their original collective work.¹²² The court next analyzed case law to determine if the e-publications qualify as revisions.

C. Application of Case Law to Define Revision

Having concluded that the defendants have the right to use the plaintiffs’ articles in any revision of their collective work, the court began its quest to define “any revision” by adopting the principle that

115. *Tasini II*, 981 F. Supp. at 845.

116. 391 F.2d 150 (2d Cir.), *cert. denied*, 393 U.S. 826 (1968).

117. *Tasini II*, 981 F. Supp. at 845.

118. *See id.* at 845-46.

119. *See id.*

120. *See Tasini I*, 972 F. Supp. at 827.

121. *Id.*

122. *See id.*

a revision "must be recognizable as a version of a preexisting collective work."¹²³ Relying on *Feist Publications, Inc. v. Rural Telephone Service Co.*,¹²⁴ the court found that selection and arrangement of individual contributions are the only original aspects that copyright holders of collective works might claim as their own protectable contribution.¹²⁵ Thus, the court concluded that the defendants must preserve their original selection or arrangement if they expect their work to qualify as a revision under section 201(c).¹²⁶ "Indeed, it is only if such a distinguishing original characteristic remains that the resulting creation can fairly be termed a revision of 'that collective work' which preceded it."¹²⁷

Plaintiffs argued that the defendants' e-publications "deal in individual articles and not in collective works."¹²⁸ Following *Feist's* approach, the court addressed this allegation by (1) identifying the distinguishing original characteristics of the original collective works and (2) determining whether those characteristics were preserved.¹²⁹

The court inverted an accepted proposition to make existing case law applicable to the never before considered issue.¹³⁰ Under existing case law, a plaintiff proves copyright infringement of a compilation by showing that the selection or arrangement of the offending work is 'substantially similar' to that of the copyrighted work.¹³¹ Without explaining how it reached its conclusion, the court determined that a similar analysis would lead to the opposite result when applied to the issue of this case.¹³² More specifically, the court reasoned that the defendant could prove that the offending work is a permissible revision by showing that the selection or arrangement of the offending work is substantially similar to the protectable selection or arrangement of the original compilation.¹³³ Applying the new

123. *Id.* at 820.

124. 499 U.S. 340 (1991).

125. *See Tasini I*, 972 F. Supp. at 820.

126. *See id.* at 821.

127. *Id.*

128. *Id.*

129. *See id.*

130. *See id.* at 822.

131. *See id.* (citing *Lotus Dev. Corp. v. Borland Int'l, Inc.*, 49 F.3d 807, 813 (1st Cir. 1995)).

132. *See id.*

133. *See id.*

rule to this case, the defendants could prove that the e-publications were permissible revisions that did not infringe the plaintiffs' underlying articles by showing that their selection or arrangement was substantially similar to the protectable selection or arrangement of the original print periodicals.¹³⁴

The court next reviewed case law on infringement of compilation copyrights to determine what qualifies as being substantially similar.¹³⁵ First, the court acknowledged that under *Feist* some compilations do not have sufficiently creative selection or arrangement to be protectable by copyright law.¹³⁶ Without a protectable aspect, a collective work can never be infringed.¹³⁷ Quoting *Lipton v. Nature Co.*,¹³⁸ the court further explained that infringement exists where a subsequent work contains "essentially the same selection" as the original work.¹³⁹ Quoting *Kregos v. Associated Press*,¹⁴⁰ the court affirmed that there is no infringement where a subsequent work "differ[s] in selection by 'more than a trivial degree' from the work that preceded it."¹⁴¹ Finally, the court noted that *CCC Information Services, Inc. v. Maclean Hunter Market Reports, Inc.*¹⁴² held that a computer database infringes the copyright in an original, hard copy, periodical compilation by using the same selection and underlying works.¹⁴³

Returning to the facts in *Tasini*, the court found that the selection of articles for inclusion is a defining original aspect of the original collective work.¹⁴⁴ "[E]ach publisher's selection of articles for inclusion in their collective works reveals significant originality and

134. *See id.*

135. *See id.*

136. *See id.* (citing *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 358-59 (1991)).

137. *See id.*

138. 71 F.3d 464 (2d Cir. 1995).

139. *Tasini I*, 972 F. Supp. at 823 (quoting *Lipton*, 71 F.3d at 471).

140. 937 F.2d 700 (2d Cir. 1991).

141. *Tasini I*, 972 F. Supp. at 823 (quoting *Kregos*, 937 F.2d at 710).

142. 44 F.3d 61 (2d Cir. 1994), *cert. denied*, 516 U.S. 817 (1995).

143. *See Tasini I*, 972 F. Supp. at 824 (citing *CCC*, 44 F.3d at 68 n.8).

144. *See id.*

editorial discretion.”¹⁴⁵ “*The New York Times* perhaps even represents the paradigm, the epitome of a publication in which selection alone reflects sufficient originality to merit copyright protection.”¹⁴⁶

Plaintiffs argued that, even if selection alone makes the collective work protectable, inclusion of the selection in an electronic database, alongside countless other articles from other issues and other periodicals, destroys it.¹⁴⁷ The court stressed, however, that under CCC, “immersion into a larger data[base] does not automatically mean . . . that the defendant publishers’ protected original selection is lost.”¹⁴⁸ Indeed, the court found that the defendant publishers preserved the original selection in two ways: (1) by adding a header to each article’s text file which identifies the page number, issue, and publication in which the article first appeared; and (2) by separating all articles’ text files from a particular publication into a library within the larger database.¹⁴⁹ Hence, the court concluded that the print publishers’ “original selection remains evident online.”¹⁵⁰

The court admitted that the e-publication did not preserve the arrangement of the original print publication, including the photos and page layout.¹⁵¹ However, the court dismissed the differences between the original collective works and the electronic databases, emphasizing that “a revision is identified on the basis of what it retains of a prior work and not on the basis of what it loses.”¹⁵² Citing *Key Publications, Inc. v. Chinatown Today Publishing Enterprises, Inc.*,¹⁵³ the court found that “where a compilation possesses both an original arrangement and an original selection, a substantial similarity persists even where the original arrangement is sacrificed.”¹⁵⁴

145. *Tasini II*, 981 F. Supp. 841, 847 (S.D.N.Y. 1997).

146. *Tasini I*, 972 F. Supp. at 823.

147. *See id.* at 823-24.

148. *Id.* at 824 (citing CCC, 44 F.3d at 68 n.8).

149. *See id.*

150. *Id.*

151. *See id.*

152. *Tasini II*, 981 F. Supp. at 849-50 (citing *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 565 (1985) (stating that “no plagiarist can excuse the wrong by showing how much of his work he did not pirate”)).

153. 945 F.2d 509 (2d Cir. 1991).

154. *Tasini I*, 972 F. Supp. at 825 (citing *Key Publications*, 945 F.2d at 514).

To summarize, the court delineated the rule that where a subsequent work done by an unauthorized copier would infringe an original collective work due to substantial similarity, the same subsequent work done by an authorized copier of the original collective work qualifies as a revision.¹⁵⁵ Applying this rule, the court held that “NEXIS and [the] CD-ROMs carry recognizable versions of the publisher defendants’ newspapers and magazines.”¹⁵⁶ Thus, “[f]or the purposes of [s]ection 201(c), then, defendants have succeeded at creating ‘any revision[s]’ of those collective works.”¹⁵⁷

The court supported its holding in a number of ways. To begin, the court compared two terms of art used in the context of compilation infringement: (1) substantial similarity and (2) any revision.¹⁵⁸ It reasoned that a work that has substantial similarity to an earlier work for some copyright purposes should qualify as a revision of the earlier work under section 201(c).¹⁵⁹

In the opinion denying the motion for rehearing, the court then highlighted two cases cited in the original opinion: *CCC* and *Lipton*.¹⁶⁰ First, the court repeated the rule from *CCC* that “where it is apparent that an entire original selection of materials has been copied into a subsequent work, that work shares a substantial similarity with the work that preceded it, even if the subsequent work includes numerous additional materials, as well.”¹⁶¹ Second, the court recited the rule from *Lipton* that “where it can be established that an original selection of materials has in fact been copied into another work, it is appropriate for a court considering a motion for summary judgment to determine—as a matter of law—that a substantial similarity exists.”¹⁶²

Finally, the court emphasized that substantial similarity between the original and the e-publication was not the only basis for finding that the defendant publishers did not infringe on the plaintiffs’ copyrights.

155. *See id.* at 822.

156. *Id.* at 825.

157. *Id.*

158. *See Tasini II*, 981 F. Supp. at 848.

159. *See id.*

160. *See id.* at 849 n.7.

161. *Id.* at 849 (citing *CCC*, 44 F.3d 61).

162. *Id.* (citing *Lipton*, 71 F.3d 464).

The [c]ourt's holding did not follow automatically from the fact that the electronic systems preserve a significant original aspect of their hard copy counterparts, but was based also upon the [c]ourt's observation that each of the electronic systems could fairly be analogized to a library in which complete issues of hard copy periodicals are made available to researchers interested in locating particular articles of interest. In other words, the electronic systems do not destroy the publishers' collective works; those systems make revisions of those works available—for traditional purposes—in new and advanced ways.¹⁶³

IV. ANALYSIS

The bulk of the *Tasini* court's reasoning is persuasive. The court faltered, however, on certain key points. Part IV of this Note critiques the court's reasoning in four parts: Section IV.A critiques the court's conclusions with respect to the contracts between the plaintiffs and the defendants; Section IV.B critiques the court's statutory construction; Section IV.C critiques the court's application of case law; and Section IV.D goes outside the paradigm identified by the court and suggests alternative analyses for this case which are more straightforward and produce more reasonable results.

A. Examination of the Court's Contract Interpretation

The main problem with the court's contract interpretation is its refusal to do more.¹⁶⁴ Nonetheless, the court made a few rulings in its contract interpretation that are difficult to criticize: (1) without a prior agreement to the effect, authors do not transfer rights to additional media to publishers by endorsing their paychecks,¹⁶⁵ (2) electronic databases are not necessarily "archives,"¹⁶⁶ and (3) a transferred right "to first publish" is limited to one form of media.¹⁶⁷

163. *Id.* at 848 n.6.

164. *See infra* Section IV.B.

165. *See Tasini I*, 972 F. Supp. 804, 811 (S.D.N.Y. 1997).

166. *See id.*

167. *See id.* at 812.

B. Examination of the Court's Statutory Construction

"[T]he *Tasini* case was the first to interpret [section] 201(c) of the Copyright Act."¹⁶⁸ The court's statutory construction of that section goes awry when it considers the plaintiffs' positions on statutory transfers of display rights and on statutory transfers in conjunction with express contracts.

1. Incidental display rights

Upon fixation¹⁶⁹ of an article, the Copyright Act vests the author with five exclusive rights in the work: reproduction, preparation of derivative works, distribution, performance, and display.¹⁷⁰ Section 201(c) does not transfer display rights from the author of a contributing work to the publisher of a collective work.¹⁷¹ In fact, section 201(c) transfers only reproduction and distribution rights.¹⁷² Therefore, the defendant publishers have no right to display the plaintiffs' articles under section 201(c).

The plaintiffs argued that projection of a text file on a computer screen is an unauthorized display and that such a display is an essential part of the defendants' e-publication.¹⁷³ The Copyright Act defines the "display" of a work as "show[ing] a copy of it, either directly or by means of a film, slide, television image, or any other

168. Wendy R. Leibowitz, *Revising Copyrights and Wrongs: New Media as Copying Machines*, NAT'L L.J., Sept. 1, 1997, at B9.

169. 'Fixation' is one of the basic requirements for copyright protection under the Act.

Copyright protection subsists [only in] . . . works [which are] *fixed* in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device.

17 U.S.C. § 102(a) (1994) (emphasis added).

170. *See* 17 U.S.C. § 106 (1994).

171. 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.

17 U.S.C. § 201(c) (1994) (emphasis added).

172. *See id.*

173. *See Tasini I*, 972 F. Supp. 804, 816 (S.D.N.Y. 1997).

device or process.”¹⁷⁴ The e-publishers in this case projected copies of the plaintiffs’ articles on computer screens for their customers.¹⁷⁵ Although computer screens and television monitors are so similar that they can be used interchangeably, the court refused to accept the plaintiffs’ characterization of that showing as a display.¹⁷⁶ Showing a copy by means of a computer screen should certainly qualify as showing by means of “any other device or process.”¹⁷⁷

Instead, the court inexplicably found that “display of those individual contributions is permissible” provided that it is “incidental” to the publisher’s authorized reproduction or distribution.¹⁷⁸ This ruling is clearly at odds with section 106, which distinguishes between the right to display and the right to reproduce or distribute.¹⁷⁹ Furthermore, the ruling sets a bad precedent under which *incidental* infringement of the exclusive rights in copyrighted works is permissible, even if one who would otherwise be expected to pay for the right intentionally infringes. Finally, it is important to note that showing copies on computer screens is a vital, not incidental, phase in the process of e-publication.

2. Presumption of statutory transfer of revision rights

The clause, “[i]n the absence of an express transfer of the copyright or of any rights under it,” notably precedes the clause in section 201(c) which creates the presumption of a transfer of revision rights

174. 17 U.S.C. § 101 (1994).

175. *See Tasini I*, 972 F. Supp. at 807-09.

176. *See id.* at 816-17.

177. In addition to the direct showings of a copy of a work, “display” would include the projection of an image on a screen or other surface by any method, the transmission of an image by electronic or other means, and the showing of an image on a cathode ray tube, or similar viewing apparatus connected with any sort of information storage and retrieval system.

H.R. REP. NO. 94-1476, at 64 (1976).

178. *Tasini I*, 972 F. Supp. at 817.

179. *See* 17 U.S.C. § 106 (1994). Section 109(c) additionally authorizes “the owner of a particular copy . . . to display that copy publicly, either directly or by the projection of no more than one image at a time, to viewers present at the place where the copy is located.” 17 U.S.C. § 109(c) (1994). The narrow drafting of this right and the doctrine of *expressio unis* both suggest that more remote or extensive display, even by the legal owner of a copy, is not authorized by the Copyright Act of 1976.

to the owner of a copyright in a collective work.¹⁸⁰ Accordingly, the plaintiffs contended that where an express transfer exists, there is no such presumption.¹⁸¹ The plaintiffs took the position that there is no presumption of a statutory transfer of revision rights where an express transfer exists.¹⁸² The court took the opposite position—that the presumption arises even where there is an express transfer of some portion of a copyright.¹⁸³ Moreover, the court reinforced its presumption by requiring the plaintiffs to raise a breach of contract claim before it would consider whether an express transfer rebutted the presumption.¹⁸⁴

Neither party alleged that the written contract between *Sports Illustrated* and plaintiff Whitford did not include all of the terms of their agreement.¹⁸⁵ The contract did not mention e-publishing or revision rights by name, but did include three provisions that transferred some of the author's rights to *Sports Illustrated*.¹⁸⁶ The plaintiff took the position that the rights at issue were clearly outside the scope of the transfer and therefore brought a copyright infringement claim, rather than a breach of contract claim, against *Sports Illustrated*.¹⁸⁷ *Sports Illustrated* raised only one of the contract provisions as a defense against the infringement claim.¹⁸⁸ Since neither

180. 17 U.S.C. § 201(c) (1994).

181. See *Tasini II*, 981 F. Supp. 841, 844 (S.D.N.Y. 1997).

182. See *id.*

183. See *id.* at 845-46.

184. See *id.* at 846 (“[W]here a writer attempts to deny a publisher certain of the [s]ection 201(c) privileges, . . . that writer must defeat the statutory presumption by demonstrating an express transfer reflecting the desired limitations.”). In the court’s interpretation, the limiting phrase—“[i]n the absence of an express transfer of the copyright or of any rights under it”—means that the section 201(c) presumption that revision rights are transferred applies in the absence of an express transfer of *more* rights. See *id.* at 845-46.

185. See generally *Tasini I*, 972 F. Supp. at 809.

186. See *id.* at 807.

187. See *Tasini II*, 981 F. Supp. at 845.

188. See *id.* at 844. One of the other provisions conditionally granted *Sports Illustrated* “the right to republish the Story or any portions thereof in or in connection with the Magazine or in other publications published by Time Inc. Magazine Company, its parents, subsidiaries or affiliates.” *Id.* (italics omitted). The court noted that the contract provision that was not raised as a defense by *Sports Illustrated* “appears explicitly to authorize the republication of [plaintiff’s] article as part of a revised version of [*Sports Illustrated*] . . . pro-

the plaintiff nor *Sports Illustrated* alleged that other contract provisions had transferred the rights exercised by the publishers, the court refused to examine the contract in its entirety. The court found that, since the plaintiff “declin[ed] to press a breach of contract claim, . . . the [c]ourt could not make any conclusive determination as to whether [*Sports Illustrated*] had in fact exceeded the full extent of its rights under the contract.”¹⁸⁹

Thus, although the court recognized that an express transfer of some portion of the copyright had transpired, the court declined to examine the contract to determine whether *Sports Illustrated*'s use of the plaintiff's article exceeded the scope of its grant and therefore constituted copyright infringement. Instead, “the [c]ourt resorted to the [s]ection 201(c) presumption extending certain limited privileges to publishers.”¹⁹⁰ In contraposition to the language of section 201(c), the court applied the presumption in the *presence* of an express transfer. Further, the court refused to determine whether the express transfer negated its presumption in the absence of a breach of contract claim.¹⁹¹

The court's position that revision rights are presumptively transferred to publishers of collective works by operation of section 201(c) presents two problems. First, the court goes too far in minimizing the significance of the introductory clause in the sentence that allows for the possibility of a statutory transfer. The court effectively interprets the statutory language “[i]n the absence of an express transfer” to mean *unless expressly negated by a contract at issue in a breach of contract suit*.¹⁹² Since parties to a copyright transfer can contractually void a statutory presumption without this statutory permission,¹⁹³ the introductory clause is essentially meaningless under the court's interpretation. Thus, the court's

vided that [plaintiff] is paid.” *Id.* at 844-45. The plaintiff's position was that the noted provision “in no way implicated electronic rights.” *Id.* at 845.

189. *Id.*

190. *Id.*

191. *See id.* at 845-46.

192. *See id.* at 844-45.

193. A “presumption” is an inference in favor of a particular fact which can be overcome by evidence to the contrary. *See* BLACK'S LAW DICTIONARY 1185 (6th ed. 1990).

construction violates the primary rule of legal interpretation—interpret the whole so that each clause has an effect.¹⁹⁴

Second, the court's position that revision rights are presumptively transferred to publishers of collective works by operation of section 201(c) contravenes public policy. The court's presumption encourages publishers of collective works to enter into incomplete contracts with contributing authors. Publishers who fail to address the issue of revision rights in their contracts with authors benefit from the section 201(c) presumption that the author has granted them revision rights. Further, under *Tasini*, authors cannot rebut the presumptive transfer of revision rights without raising a breach of contract claim.¹⁹⁵ Thus, there is a strong disincentive for publishers to negotiate with authors on the transfer of revision rights. Contrary to the intent of the legislature in enacting the Copyright Act of 1976, authors will have difficulty dividing up the bundle of exclusive rights which constitute a copyright and transferring a limited portion of the whole.¹⁹⁶

The court's requirement that a copyright owner allege breach of contract before an express transfer can rebut the statutory presumption presents an additional problem. The problem is simple—a breach of contract claim is usually distinct from a copyright infringement claim. A copyright owner must determine that his contractual rights, not his statutory copyright rights, were violated in order to properly bring a breach of contract claim. For example, where no contract exists between the parties, the copyright owner clearly has no breach of contract claim against an alleged infringer. Similarly, where the copyright owner has granted a licensee a subset of his copyright rights—such as the right to distribute the work—and the licensee has chosen to exercise a distinct subset of those rights—such as the right to reproduce the work, the copyright owner clearly has a claim for copyright infringement but no claim for breach of

194. See Karl N. Llewellyn, *Remarks on the Theory of Appellate Decision and the Rules or Canons About How Statutes Are to Be Construed*, 3 VAND. L. REV. 395, 404 (1950).

195. See *Tasini II*, 981 F. Supp. at 845-46.

196. See H.R. REP. NO. 94-1476, at 123 (1976); 17 U.S.C. § 201(d)(1) (1994) (stating that “[t]he ownership of a copyright may be transferred . . . in part”).

contract.¹⁹⁷ Thus, where no contract violation has occurred, a copyright owner may be barred from contesting the presumption even when the express transfer clearly would not encompass revision rights. Courts should not require authors to raise a breach of contract claim in order to protect their exclusive rights under the Copyright Act.¹⁹⁸

C. Examination of the Court's Application of Case Law to Define Revision

Case law establishes the prima facie elements of a copyright infringement claim: (1) the existence of a valid copyright, (2) copying of the copyrighted work, and (3) unlawful appropriation.¹⁹⁹ In *Tasini*, the defendants admitted to copying the plaintiffs' copyrighted works and did not contest the validity of the plaintiffs' copyrights.²⁰⁰ Thus, the critical issue was whether the defendants unlawfully appropriated the plaintiffs' work.

There are several approaches to determining whether an unlawful appropriation has occurred. The "substantial similarity" test finds unlawful appropriation where the allegedly infringing work is substantially similar to the allegedly infringed work.²⁰¹ The "ordinary observer" test finds unlawful appropriation when an ordinary observer would tend to overlook the differences between the works and consider their appeal the same.²⁰² The *Tasini* court explicitly rejected the ordinary observer test.²⁰³ An "abstraction, filtration, and comparison" test also exists.²⁰⁴ In practice, the abstraction, filtration, and comparison test is basically the same as the substantial similarity

197. "[W]hen a license is limited in scope, exploitation of the copyrighted work outside the specified limits constitutes infringement." 3 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 10.15[A] (rev. ed. 1998) (citing *S.O.S., Inc. v. Payday, Inc.*, 886 F.2d 1081, 1087-88 (9th Cir. 1989)).

198. The Copyright Act of 1976 neither includes breach of contract in its definition of copyright infringement nor requires a breach of contract as a prerequisite for an infringement remedy. See 17 U.S.C. §§ 501-511 (1994).

199. See LEAFFER, *supra* note 60, § 9.2, at 285.

200. See *Tasini I*, 972 F. Supp. 804, 809 (S.D.N.Y. 1997).

201. See LEAFFER, *supra* note 60, § 9.6[C], at 297.

202. See *id.* § 9.6[B], at 296.

203. See *Tasini II*, 981 F. Supp. 841, 849 n.7 (S.D.N.Y. 1997).

204. See LEAFFER, *supra* note 60, § 9.5[F], at 295.

test.²⁰⁵ The court considers the defendants' original collective works in the abstract, filters out those elements—such as the plaintiffs' contributions—for which the defendants cannot claim copyright protection, and compares the remainder to the alleged revision using substantial similarity as the test for unlawful appropriation.²⁰⁶

1. Critique of the court's premise

There is a twist in the *Tasini* case. Whereas courts have always used the substantial similarity test only to prove unlawful appropriation—the final element of copyright infringement—the *Tasini* court used the test to prove *no* unlawful appropriation and, hence, no copyright infringement.²⁰⁷ The court delineated the rule that, where a subsequent work by an *unauthorized* copier would infringe an original collective work due to substantial similarity, the same subsequent work by an *authorized* copier of the original collective work qualifies as a revision.²⁰⁸ The advantage of this premise is that where no guiding case law previously existed, now suddenly, a plethora of such exists.

The court, however, ignored the infirmity of this premise. The court overlooked the function of the substantial similarity test, which is to distinguish between infringement and acceptable use of copyrighted work, to discriminate between 'lawful' and 'unlawful' appropriation.²⁰⁹ No matter how courts describe the process, at its core it is a subjective judgment of what behavior should be unlawful. In making this judgment, a court necessarily considers the specific context of the behavior. However, the *Tasini* court goes beyond mere application of precedent defining unlawful appropriation to new and different contexts. The *Tasini* court tries to apply the inverse of the case rulings.²¹⁰ In essence, the court applied rulings deeming uses *unlawful* in one context as examples to define uses that

205. *See id.*

206. *See id.*; *Tasini II*, 981 F. Supp. at 849 n.7.

207. *See Tasini I*, 972 F. Supp. at 826.

208. *See id.* at 822.

209. *See* LEAFFER, *supra* note 60, § 9.6[C], at 297.

210. *See Tasini I*, 972 F. Supp. at 822-23.

are lawful in another context.²¹¹ That much wringing will squeeze the wisdom out of any legal precedent.

In the words of Monty Python, “affirmatives can only be partially converted: all of Alma Cogan is dead, but only some of the class of dead people are Alma Cogan.”²¹² It is easy when inverting an affirmative statement to fall into an invalid syllogism.

2. Critique of the application of the court’s premise

“[I]t is only if . . . a distinguishing original characteristic [such as selection] remains that the resulting creation can fairly be termed a revision of ‘that collective work’ which preceded it.”²¹³ The selection of what to include is a defining and protectable characteristic of the original print periodicals.²¹⁴ Even accepting, *arguendo*, the court’s premise that the defendants acquired revision rights to the plaintiffs’ underlying works, each e-publication does not necessarily qualify as a revision within the meaning of section 201(c).

First, the e-publications do not preserve the selection of the original periodicals. Magazines and newspapers consist of more than just the raw text of articles. Traditional periodicals, as a rule, include pictures, advertisements, and other elements in addition to articles. The selection of which of those other elements to include is a large part of the selection of materials that define a periodical. The court admitted that the e-publications do not preserve the selection of photographs and advertisements.²¹⁵ Under the theory that an original selection alone is sufficient to define a collective work,²¹⁶ the court dismissed these materials as part of the arrangement of the periodicals.²¹⁷ Nonetheless, the court proclaimed that “[i]n order to preserve an original selection of materials, . . . a subsequent work must

211. *See id.* at 822-26.

212. MONTY PYTHON, *The Logician’s Discussion, on THE ALBUM OF THE SOUNDTRACK OF THE TRAILER OF THE FILM OF MONTY PYTHON AND THE HOLY GRAIL* (Mr. and Mrs. Zambesi transcribers, visited Jan. 25, 1999) <<http://www.mwscmp.com/movies/grail/g-logic.htm>>.

213. *Tasini I*, 972 F. Supp. at 821.

214. *See id.* at 823.

215. *See id.* at 824.

216. *See id.* at 825 (citing *Key Publications, Inc. v. Chinatown Today Publ’g Enters., Inc.*, 945 F.2d 509, 514 (2d Cir. 1991)).

217. *See id.*

copy more than a 'certain percentage' of those materials."²¹⁸ The court is splitting hairs by claiming that the e-publications preserved the print periodicals' original selection of articles when the selection of photographs, advertisements, and other elements is obviously not preserved. At best, the e-publications preserve a 'certain percentage' of the total selection that defines the original periodicals.

Second, even assuming that the e-publications preserved the original selection of the periodicals, the selection of the e-publications is not substantially similar to the original selection of the periodical. Most people would agree that a selection of millions is profoundly different from a selection of three. The court, however, stresses that under *CCC*, "immersion into a larger data[]base does not automatically mean, however, that the defendant publishers' protected original selection is lost."²¹⁹ The court then found that the e-publishers preserved the original selection in two ways: (1) by adding a header to each article's text file which identifies the issue, page number, and publication in which the article first appeared and (2) by separating all articles' text files from a particular publication into a library within the larger database.²²⁰ For support, the court cites the rule from *Lipton* that copying an original selection into another work is sufficient alone for a finding of substantial similarity.²²¹

The court based its finding on a mischaracterization of *CCC*. *CCC* did not hold that a "computer data[]base provider infringed [the] plaintiffs [sic] copyright in [a] book of used car valuations by including [the] same selection of vehicles and [the] same price estimates into [sic] [a] larger online system."²²² Rather, *CCC* held that the defendant, who happened to be a computer database provider, infringed the plaintiff's copyright by using the plaintiff's protected car valuations; the fact that the defendant used the plaintiff's valuations

218. *Id.* at 823 (citing *Worth v. Selchow & Righter Co.*, 827 F.2d 569, 573 (9th Cir. 1987)).

219. *Id.* at 824 (citing *CCC Info. Servs., Inc. v. Maclean Hunter Mkt. Reports, Inc.*, 44 F.3d 61, 68 n.8 (2d Cir. 1994)).

220. *See id.*

221. *See Tasini II*, 981 F. Supp. at 849 (citing *Lipton v. Nature Co.*, 71 F.3d 464 (2d Cir. 1995)).

222. *Id.* (citing *CCC*, 44 F.3d 61).

in a computer database was not material to the decision.²²³ Thus, immersion in a larger database *may* automatically destroy the original selection.

Furthermore, the court's reliance on *Lipton* to support its position is misplaced. *Lipton* did not hold that "where it can be established that an original selection of materials has in fact been copied into another work, it is appropriate for a court considering a motion for summary judgment to determine—as a matter of law—that a substantial similarity exists."²²⁴ Rather, *Lipton* specifically held that a selection of seventy-two terms of venery²²⁵ is substantially similar to an original selection of seventy-seven such terms where seventy-one of the seventy-two terms were copied from the original selection of seventy-seven.²²⁶ Contrary to the court's characterization, *Lipton* tends to support the position that a subsequent work which copies the selection of an original work is only substantially similar when the selections of the two compared as a whole are almost identical.

Third, *Lipton* implies that when trying to determine if two collective works are substantially similar, it is more appropriate to compare all of the protectable elements from the original collective work to those of the subsequent work.²²⁷ *Feist* provides some guidance in this endeavor. One interpretation of *Feist* is that "selection of a whole universe is not creatively original."²²⁸ Under this interpretation, the selection that most computer databases embody may not be protectable by copyright law.²²⁹ Assuming, nonetheless, that the

223. Original aspects of Red Book's ordination and arrangement were inextricably present whenever CCC copied and republished any Red Book valuation, because each valuation incorporated the Red Book editors' original judgment concerning the predicted value of that automobile, as well as their judgment as to geographic consistency within a region.

CCC, 44 F.3d at 68 n.8.

224. *Tasini II*, 981 F. Supp. at 849 (citing *Lipton*, 71 F.3d 464).

225. A "term of venery" is an archaic hunting term. THE RANDOM HOUSE DICTIONARY OF THE ENGLISH LANGUAGE 2111 (2d ed. unab. 1987). An example of a term of venery is a "pride of lions." See *Lipton*, 71 F.3d at 467 n.2.

226. See *Lipton*, 71 F.3d at 471.

227. See *id.*

228. Bruce G. Joseph, *Copyright Protection of Software and Compilations: A Review of Significant Developments 1991-1998*, in ADVANCED SEMINAR ON COPYRIGHT LAW 175, 300 (Richard Dannay chair, 1998).

229. See *id.*

selection is protectable, we would consider what quality makes the selection valuable. The value of the original print periodicals is at least partially derived from their selectivity.²³⁰ In contrast, “[t]he value of most computer data[]bases is their completeness—the selection and inclusion of the ‘whole’ universe, not subsets of it.”²³¹ While consumers value the selection of materials in the original print periodicals partially for what is excluded, they value the selection of material in the electronic databases primarily for what is included. Furthermore, “[e]lectronic databases generally arrange data to enhance [their] electronic search and retrieval functions, rather than to improve communication with humans.”²³² As *Feist* declares in discussing the arrangement of a typical compilation, such as the original periodicals, “[t]he compilation author typically chooses . . . how to arrange the collected data so that they may be used effectively *by readers*.”²³³ Thus, the arrangement of the original periodicals, which readers valued at some level for how well they can directly process the materials presented in their entirety, is fundamentally different from the arrangement of the electronic databases, which users value mostly for the speed at which they allow a computer to locate files that meet the user’s selection criteria. In sum, a comparison all of the original distinctive elements of the print periodicals with all of the original distinctive elements of the e-publications should fail to qualify the e-publications as revisions of the print periodicals.²³⁴

230. See *Tasini I*, 972 F. Supp. at 823.

231. Joseph, *supra* note 228, at 300.

232. *Id.* at 301. “Frequently, multi-periodical databases such as Nexis are searched for specific topics within a large collection of works, not because of a desire to take advantage of an editor’s particular selection of articles.” David J. Loundy, *Electronic Database Providers Collect Court Decisions*, CHI. DAILY L. BULL., Oct. 9, 1997, at 6.

233. *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 348 (1991) (emphasis added).

234. Because of the removal of context—coupled with the frequent compilation of multiple periodicals into one database for search purposes, as well as the different audience for the original and the electronic products—it seems disingenuous to say that a Nexis database is merely a revision of *The New York Times*.

Loundy, *supra* note 232.

Finally, the Second Circuit's subsequent, twin decisions in *Matthew Bender & Co. v. West Publishing Co.*²³⁵ may reinforce this conclusion. In the first case, the West Publishing Company argued that four specific changes it makes to judicial opinions before incorporating them into its published compilations are protectable by copyright. Those changes are as follows:

(i) rearrangement of information specifying the parties, court, and date of decision; (ii) addition of certain information concerning counsel; (iii) annotation to reflect subsequent procedural developments such as amendments and denials of rehearing; and (iv) editing of parallel and alternate citations to cases cited in the opinions in order to redact ephemeral and obscure citations and to add standard permanent citations (including West reporters).²³⁶

Since facts are not protectable,²³⁷ West clearly had no protectable interest in the underlying facts, and could only claim an interest in the selection or arrangement of those facts.²³⁸ The appellate court affirmed the district court's finding that West's selection and arrangement are not protectable under the Copyright Act.²³⁹ It reasoned that, "[i]n light of accepted legal conventions and other external constraining factors, West's choices on selection and arrangement can reasonably be viewed as obvious, typical, and lacking even minimal creativity."²⁴⁰

Applying similar reasoning to the *Tasini* facts, the issue, page number, and publication in which an article was originally published can similarly be viewed as unprotectable facts. Adding this information to the raw text of the plaintiffs' articles can be viewed as obvious, typical, and lacking even minimal creativity in light of the constraining factors involved, such as the NEXIS database organization.

235. 158 F.3d 674 (2d Cir. 1998) (West I); 158 F.3d 693 (2d Cir. 1998) (West II).

236. *West I*, 158 F.3d at 677.

237. *See Feist*, 499 U.S. at 344.

238. *See West I*, 158 F.3d at 677.

239. *See id.*

240. *Id.*

In the second, and perhaps more pertinent case, West argued that its competitors' use of star pagination in their CD-ROMs to indicate the issue and page location of the text of judicial opinions in West's published compilations infringed West's arrangement.²⁴¹ West relied on the fact that a "user who manipulates the data on the CD-ROM discs could at will re-sequence the cases . . . into the West arrangement."²⁴² The court was unconvinced, however, concluding that "a copyrighted arrangement is not infringed . . . if a machine can perceive the arrangement only after another person uses the machine to re-arrange the material into the copyright holder's arrangement."²⁴³

Applying similar reasoning to the *Tasini* facts, the publisher's selection—which the court found to be critical—may not be retained if it can be perceived only after another person uses a machine to re-create it from among a much more extensive selection and compilation of materials.

D. *Thinking Outside the Box*

1. Rejecting the copyright paradigm

The *Tasini* court may have inappropriately defined the issue at stake in the case. The issue according to the court was whether the defendants' use of the underlying article qualifies as a revision of the original collective work.²⁴⁴ The issue according to the plaintiffs was quite different. The plaintiffs' primary concern was whether a freelance author, by selling an article for publication in a periodical, loses the right to receive compensation for additional access to the article.²⁴⁵

Leading copyright scholars have concluded that the Copyright Act of 1976 is ill-suited to resolving issues which arise in connection

241. *See West II*, 158 F.3d at 700.

242. *Id.* at 702.

243. *Id.* The court declined to follow the Eighth Circuit's opinion that found that star pagination did infringe West's arrangement. *See id.* at 707 (citing *West Publ'g Co. v. Mead Data Cent., Inc.*, 799 F.2d 1219 (8th Cir. 1986)). The court explained that the Eighth Circuit had relied on the "sweat of the brow" doctrine, which has since been rejected by *Feist*. *See id.* at 708.

244. *See Tasini I*, 972 F. Supp. 804, 812 (S.D.N.Y. 1997).

245. *See Loundy*, *supra* note 232.

with digital networks such as the Internet.²⁴⁶ They note that “the most important property rights [in digital technology] are the rights to control access to and use of information resources,”²⁴⁷ and further state that “[t]he terminology of copyright as applied in this field of commerce merely distracts from the basic issues.”²⁴⁸ In other words, “[n]o need or reason exists to rely on traditional copyright concepts of expression, originality, copying, or public performance and display.”²⁴⁹ On the contrary, the application of traditional copyright law principles tends to distort the key issues of cases involving digital networks.²⁵⁰ To guide the formulation of rights in information networks, the scholars quoted herein advocate the principle that “privileges to access and use [of copyrighted information] should depend on the type of use and the degree of harm to the information resource owner.”²⁵¹ This principle is crucial because “[a]uthors . . . often earn much of their income from additional sales of their printed pieces subsequent to the work’s initial publication.”²⁵² Publishers’ on-line distribution decreases the commercial benefit that authors can derive from their work because on-line distribution increases the distribution and accessibility of their work. E-publication may consequently harm the author not just by depriving the author of compensation for the publisher’s additional use, but also by preventing sales to other publishers by satisfying the market demand for the article.

2. Access to digital text as new property right

Professor Ejan Mackaay states that “[l]aw specifies the boundaries between neighbouring property rights only to the extent that conflicts have actually arisen between neighbours.”²⁵³ Professor

246. See, e.g., Raymond T. Nimmer & Patricia Ann Krauthaus, *Copyright on the Information Superhighway: Requiem for a Middleweight*, 6 STAN. L. & POL’Y REV. 25, 25-26 (1994).

247. *Id.* at 26.

248. *Id.*

249. *Id.* at 37.

250. See *id.*

251. *Id.* at 38-39.

252. David J. Loundy, *Authors Waging Fight in Brave New World*, CHI. DAILY L. BULL., Mar. 7, 1996, at 6.

253. Ejan Mackaay, *The Economics of Emergent Property Rights on the Internet*, in THE FUTURE OF COPYRIGHT IN A DIGITAL ENVIRONMENT 13, 19 (P. Bernt Hugenholtz ed. 1996).

Mackaay notes that copyright law traditionally breaks works down into categories that correspond to the controls used to protect the assets.²⁵⁴ Mackaay likens such protection to a fence. He states that “the Internet amplifies the corrosion of the older fences and creates the appearance of an open field in which all take whatever they can click their mouse on.”²⁵⁵

Tasini is the first case that has called upon the court to interpret the term revision as it is used in United States copyright law.²⁵⁶ Thus, following Professor Mackaay’s reasoning, it is an inappropriate time for new legislation on this issue.²⁵⁷ The only way to discover the proper boundaries of new property rights is through trial and error.²⁵⁸ Professor Mackaay instead suggests that new controls be developed through the following two-step process. First, parties who are interested in protecting potential assets for which there is no established or effective control create their own method of control “using whatever devices and techniques are available to them and making contractual arrangements.”²⁵⁹ Professor Mackaay theorizes that experimentation of this type is actually occurring on the Internet.²⁶⁰ Second, after interested parties make the first moves, the law intervenes and recognizes the method of control.²⁶¹ Recognition should occur only after a control creating a new property right has been developed and proven practical through experience.²⁶² Such restraint is a necessary part of the realism of law.²⁶³

This approach to developing new property rights may not be successful when parties interested in protecting their potential new property right—access to digital text in this case—do not have the power to create a new control. The Publication Rights Clearinghouse, an agency created to collectively bargain on behalf of free-

254. *See id.* at 18.

255. *Id.*

256. *See* Wendy R. Leibowitz, *supra* note 168.

257. *See* Mackaay, *supra* note 253, at 18-19, 21.

258. *See id.* at 20-21.

259. *Id.* at 20.

260. *See id.* at 21.

261. *See id.*

262. *See id.*

263. *See id.*

lance authors,²⁶⁴ may represent the kind of experimental control that Mackaay had in mind. Indeed, the agency may effectively create the desired new property right if it gains the power needed to successfully negotiate with the publishers.²⁶⁵

Arguably, contracts are a form of control available to all because contracts allow parties to establish their own rules to control a particular transaction. On the other hand, society also recognizes that unequal bargaining power can create unconscionable contracts.²⁶⁶ In *Tasini*, individual freelance authors were dealing with powerful publishing corporations.²⁶⁷ The *New York Times* did not negotiate with contributing authors regarding the rights to their articles.²⁶⁸ *Newsday* attempted to create adhesion contracts with the plaintiffs by including an endorsement to that effect on their payment checks.²⁶⁹ Given the publishers' methods, freelance authors may lack the power and the tools necessary to create their own controls, despite being

264. See *National Writers Union*, *supra* note 19. The National Writers Union created Publication Rights Clearinghouse (PRC) to collect online royalties for freelance writers. See National Writers Union, *Welcome to Publication Rights Clearinghouse* (last modified Jan. 11, 1997) <<http://www.nwu.org/prc/prchome.htm>>. More specifically, PRC licenses secondary rights for members' previously published articles to UnCover, a fax reprint service. See *id.*

265. Currently, the National Writers Union describes PRC as a pilot project. See National Writers Union, *Frequently Asked Questions About PRC* (last modified Oct. 23, 1998) <<http://www.nwu.org/prc/prchome.htm>>. The National Writers Union expresses hope that PRC's deal with UnCover and other efforts will enable it to negotiate similar deals with other companies and turn the PRC model into the industry standard. See *id.*

266. "Unconscionability has generally been recognized to include an absence of meaningful choice . . ." *Williams v. Walker-Thomas Furniture Co.*, 350 F.2d 445, 449 (D.C. Cir. 1965).

267. See *Tasini I*, 972 F. Supp. at 804.

268. See *id.* at 807.

269. An "adhesion contract" is "a take-it-or-leave-it proposition . . . under which the only alternative to complete adherence is outright rejection." E. ALLAN FARNSWORTH, I FARNSWORTH ON CONTRACTS § 4.26 (2d. ed. 1998). The *Newsday* check legends read:

Signature required. Check void if this endorsement is altered. This check accepted as full payment for first-time publication 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.

Tasini I, 972 F. Supp. at 807.

interested parties. Nonetheless, courts should respect authors' attempts to develop controls.

The court claimed that its position that publishers are presumed to have acquired revision rights by operation of section 201(c) is not inconsistent with the language of the Copyright Act.²⁷⁰ However, its position is inconsistent with the principle of freedom of contract between the parties, particularly where the court refused to allow the existence of an express contract to rebut the presumption without a breach of contract claim. The court should apply the presumption only where *required* by the Copyright Act: "in the *absence* of an express transfer of the copyright or of any rights under it."²⁷¹ This situation arises when parties fail to discuss or describe which rights, conferred on the author by copyright law, are transferred under their agreement.²⁷² Conversely, when an agreement between the parties expressly specifies which copyright rights are transferred, the court should apply the standard rules of contract interpretation and not apply the presumption. Alternatively, the court could still apply the presumption in such a case *but* allow the express transfer to rebut the presumption. Either approach—no presumption where there is an express transfer or a presumption that is truly rebuttable—gives an agreement between the parties its proper authority. Recognizing that an agreement between parties can override a statutory presumption allows interested parties to develop their own controls. Using standard contract interpretation techniques allows the parties to test the effectiveness of their controls.

270. *See* Tasini II, 981 F. Supp. 841, 845 (S.D.N.Y. 1997).

271. 17 U.S.C. § 201(c) (1994) (emphasis added). Section 201(c) does not address the situation in which there is an express transfer of the copyright or of any rights under it. *See id.* Black's Law Dictionary defines "express" as follows: "Declared in terms; set forth in words. Directly and distinctly stated. Made known distinctly and explicitly, and not left to inference." BLACK'S LAW DICTIONARY 580 (6th ed. 1990). Thus, either an oral or a written transfer agreement would qualify as an express transfer. In short, where the agreement between the parties specifies in words the copyright or portion thereof that is transferred, the section 201(c) presumption should not apply.

272. The parties may, for example, only discuss the price, target length of the work, and delivery date.

E. Interpretation of the Decision

The full ramifications of *Tasini* remain uncertain. On the one hand, *Tasini* can be read narrowly to extend the recognized allowance for publishers to put their periodicals on microfilm to CD-ROM and NEXIS technology only. *Tasini* addresses only the use of CD-ROM and NEXIS technology; the Internet is never mentioned in the decision.²⁷³

On the other hand, *Tasini* can be read broadly to sanction virtually any new method of distribution for collective works provided that some aspect of the original collective work's selection, coordination, or arrangement is preserved. The court's reasoning seems to apply to common Internet uses. The *Tasini* court's high valuation of the e-publishers' attribution of the article may represent a minor limitation. *Tasini* may be construed to allow dissemination of collective works via the Internet, provided that a note describing the context of its original publication accompanies each individual contribution.

V. CONCLUSION

The court's analysis of the *Tasini* case under the Copyright Act of 1976 was flawed. The court interpreted revision privileges available to owners of a collective work under section 201(c) too broadly. Under the court's broad analysis, it is hard to imagine what type of use of the underlying works would not in some way qualify as a revision.

More importantly, the court misperceived the true issue of the case. The court failed to understand and address the plaintiffs' true concerns. The plaintiff authors brought the case to ensure that they would receive their fair share of revenues from the use of their work as a commodity in the information industry.²⁷⁴ Recognizing that the presumptive conference of broad revision rights on publishers of collective works may not be equitable,²⁷⁵ the court nonetheless twisted case law to define previously uninterpreted statutory language.

273. See generally *Tasini I*, 972 F. Supp. at 806, 826-27.

274. See *National Writers Union*, *supra* note 19.

275. See *Tasini I*, 972 F. Supp. at 826-27.

Intellectual property scholars note that copyright law is not well suited to the challenges of protecting intellectual property in a digital age.²⁷⁶ Courts should be cautious in approaching new copyright issues and consider the implications of their interpretation of statutory language and case law before reaching a conclusion. The Second Circuit Court of Appeals should consider the realities of the new digital age when it defines the statutory term revision.

This Note recommends that courts strive to imbue each phrase in section 201(c) of the Copyright Act with meaning. Section 201(c) states:

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.²⁷⁷

Accordingly, if the parties have made an express transfer of the copyright or of any rights under it, then the section 201(c) presumption should not apply.²⁷⁸ The presumption, which amounts to a statutory transfer of some of the rights included in a copyright, should only apply in the absence of an express transfer. Where an express transfer exists, courts should use standard contract interpretation techniques to determine what rights were transferred. This approach encourages parties to negotiate and clarify which copyright rights are transferred by contract.

In the alternative situation, where no express transfer exists, courts should focus on the basic question. The basic question is not: Is the alleged revision substantially similar to the original collective work? Rather, the basic question is: Considering the original contributions of the author of the collective work, is the underlying work being used in a revision of that collective work or in an entirely different collective work? Application of this standard to the *Tasini* case suggests that the publishers may have the right to use the

276. See Nimmer & Krauthaus, *supra* note 246, at 25.

277. 17 U.S.C. § 201(c) (1994).

278. However, under contract law, the industry practice may indicate that the presumption is an appropriate starting point in determining the intent of the parties.

plaintiffs' articles in CD-ROM collections of a magazine, such as *New York Times OnDisc*, but do not have the right to include the plaintiffs' articles in the LEXIS/NEXIS database.

*Kia L. Freeman**

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