

ARTICLE 1 – COPYRIGHT LAW – A PUBLISHER OF COLLECTIVE WORKS IS NOT SHIELDED BY THE § 201 (C) PRIVILEGE FROM CHARGES OF INFRINGEMENT WHEN A FREELANCE ARTICLE CONTRIBUTED TO THE COLLECTION IS PLACED IN AN ELECTRONIC DATABASE WITHOUT THE CONSENT OF THE AUTHOR – *New York Times Company, Inc. v. Tasini*, 533 U.S. 483 (2001).

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I. INTRODUCTION

Article 1, section 8, clause 8 of the United States Constitution promotes creative expression and innovation by giving authors and inventors exclusive rights over their works for a limited period of time.¹ This constitutional provision conferred upon Congress the authority to pass the Copyright Acts of 1909 and 1976.² “The judgment of the constitution is that free expression is enriched by protecting the creations of authors from exploitation by others, and the Copyright Act is the congressional implementation of that judgment.”³ The copyright system is specifically designed to simultaneously reward authors for their contributions and afford the public access to creative works.⁴ Pursuant to the originality requirement set forth in Art. 1, § 8 cl., 8, copyright protection extends to original

¹ U.S. CONST. art. 1, § 8 cl. 8. This section states: “To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.”

² *Bobbs-Merrill Co. v. Straus*, 210 US 339, 346 (1908). “Copyright property under the Federal law is wholly statutory, and depends upon the right created under the acts of Congress passed in pursuance of the authority conferred under U.S. Const. art. I, § 8.” *Id.* In 1955, Congress instituted a copyright revision project to enact new legislation to replace the 1909 Act. CRAIG JOYCE ET AL., *COPYRIGHT LAW* 21 (5th ed. 2000). After 21 years of acquiring reports and conducting extensive hearing the Copyright Act of 1976 was passed. *Id.*

³ *Dallas Cowboy Cheerleaders, Inc. v. Scoreboard Posters, Inc.*, 600 F.2d 1184, 1187 (5th Cir. 1979).

⁴ *Id.* (affirming the preliminary injunction granted by the district court, authorized by the Copyright Act, to prevent further copyright infringement of the plaintiffs’ poster); Josh J. May, *Intellectual Property: A. Copyright I. Acquisition and Ownership a) Collective Works Tasini v. New York Times Co.*, 16 BERKELEY TECH. L. J. 13, 15 (2001).

works of authorship exhibiting only a “minimal” amount of creativity.⁵

In addition to individually authored works, compilations and collections are also subject to the provisions of the Copyright Act.⁶ A collective work is a dis-

⁵ Feist Publ'ns, Inc. v. Rural Tel. Serv. Co., 499 U.S. 340, 358 (1991) (holding that the respondent's white pages were not copyrightable material because they lacked the requisite originality necessary for protection); *CDN Inc. v. Kapes*, 197 F.3d 1256, 1259 (9th Cir. 1999) (affirming a summary judgment motion enjoining defendant from using plaintiff's coin price guide in his calculation of coin prices, where the court found that coin prices in plaintiff's guide were a copyrightable product of creativity). In addition, § 102(a) of the 1976 Act generally describes copyrightable subject matter as follows:

Copyright protection subsists, in accordance with this title, in *original* works of authorship 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. Works of authorship include the following categories: (1) literary works . . .

17 U.S.C. § 102(a) (2000) (emphasis added).

⁶ 17 U.S.C. § 103(a) (2000). Section 103(a) of the Copyright Act of 1976, specifies that the subject matter of copyright includes compilations. *Id.* Pursuant to § 101:

A “compilation” is 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. The term “compilation” includes collective works.

17 U.S.C. § 101 (2000).

Section 103(b) makes clear that the protection in a compilation extends only to the material contributed by the author of such work and does not imply any exclusive right in the preexisting material. *CCC Info. Servs. v. MacLean Hunter Mkt. Rep.*, 44 F.3d 61, 65 (2d Cir. 1994) (holding that a publisher's compendium of its projections of used car values is entitled to copyright protection because the compilation satisfies the minimal originality requirement). Section 103 (b) provides:

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

17 U.S.C. § 103(b) (2000).

tinct copyrighted work separate from the individual copyrighted works forming the collection.⁷ In order to reconcile the competing intellectual property interests between publishers of collective works and the individual freelance authors, Congress specifically distinguished the “copyrights in the collective work from the copyrights in the contributions to that work.”⁸ A collective work is afforded copyright protection provided that the selection, coordination, and arrangement of the preexisting materials constitute an original work of authorship.⁹ A copyright in a compilation only protects the material contributed by the author of the collective work.¹⁰ Therefore, the collective work author does not possess any exclusive rights in the underlying contributions.¹¹

Pursuant to 17 U.S.C. § 201(c) of the Copyright Act, the collective work copyright owner has the right to reproduce and distribute the individual contributions “as part of that collective work, any revision of that collective work and any later collective work in the same series.”¹² This privilege, denoted by § 201(c), effectively shields publishers of collective works from liability for copyright infringement provided that the article contributed to the collective work is reproduced or distributed “as part of” any or all of the three elements listed in the provision.¹³ However, if the owner of the copyright in collective work also possesses the copyrights in the underlying material, this section no longer applies and the copyright holder is entitled to all the exclusive rights set forth in 17 USC § 106.¹⁴ Therefore, a publisher may contract around this ownership provision of

⁷ 17 U.S.C. § 101 (2000). The Copyright Act defines “collective work” pursuant to § 101 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 as a collective whole.” *Id.*

⁸ May, *supra* note 4, at 15.

⁹ § 101; *see supra* note 6.

¹⁰ § 103(b).

¹¹ *Id.* (stating that the copyright in the collective work is “independent of and does not affect or enlarge . . . the ownership, or subsistence of, any copyright protection in the preexisting material”).

¹² 17 U.S.C. § 201(c) (2000).

¹³ *New York Times Co., Inc. v. Tasini*, 533 U.S. 483, 496 (2001); *see supra* text accompanying note 12.

¹⁴ *Id.*

Subject to sections 107 through 121, the owner of copyright under this title has the exclusive

the Copyright Act by obtaining an express transfer of copyright ownership from the freelance author.¹⁵

II. STATEMENT OF THE CASE

In *New York Times Company, Inc. v. Tasini*,¹⁶ the Supreme Court of the United States examined the scope of the § 201(c) privilege in the context of electronic databases.¹⁷ The Supreme Court noted that § 201(c) shields collective work publishers from liability for copyright infringement provided that the publishers reproduce and distribute the contribution as part of or a revision to the original collective work.¹⁸ The Court explained that the freelance articles in dispute were reproduced on the electronic databases as individual copies and, therefore, outside the protection of § 201(c) because they were not part of any revision of the collective work.¹⁹ The Supreme Court held that § 201(c) did not

rights to do and to authorize any of the following:

- (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 (2000).

¹⁵ *Tasini v. NY Times Co.*, 206 F.3d 161, 164 n. 1 (2d Cir. 2000) (stating that the New York Times requires an express transfer of copyright from a freelance writer prior to purchasing a freelance article for publication); Kia L. Freeman, *Tasini v. New York Times: Wrong Issue, Wrong Presumption*, 32 LOY. L.A. L. REV. 841, 876 (1999) (noting that the many members of the newspaper publishing industry currently require express transfers of copyright ownership from freelance authors).

¹⁶ 533 U.S. 483 (2001).

¹⁷ *Id.* at 493.

¹⁸ *Id.* at 488.

authorize the publishers' copying of the freelance articles and, as such, the print and electronic publishers were liable for copyright infringement for reproducing and distributing the freelance authors' articles without their consent.²⁰

FACTS

This dispute centers on 21 articles written between 1990 and 1993 by authors Jonathan Tasini, Mary Kay Blakely, Barbara Garrison, Margot Mifflin, Sonia Jaffe Robbins, and David S. Whitford (hereinafter Authors) for the *New York Times*, *Newsday*, and *Sports Illustrated*.²¹ These individual authors each registered copyrights for their individual articles (hereinafter Article(s)).²² In addition, Times, Newsday, and Time (hereinafter Print Publishers) obtained collective work copyrights for each periodical edition in which an Article initially appeared.²³ The Print Publishers hired the Authors as freelancers or independent contractors pursuant to a contractual agreement.²⁴ However, the contracts between the publishers and freelancers did not include any provision obtaining consent from an Author allowing the Print Publishers to place an article in an electronic database.²⁵

Agreements between the Print Publishers and LEXIS/NEXIS had taken place upon the Articles' publication.²⁶ LEXIS/NEXIS is owner and operator of NEXIS, a computerized database containing hundreds of articles from journals, newspapers and periodicals.²⁷ Pursuant to their agreement, the Print Publishers

¹⁹ *Id.*

²⁰ *Id.*

²¹ *Id.* at 488-89. In particular, Tasini, Mifflin, and Blakely wrote twelve articles for the *New York Times*. The *Times* is the daily newspaper published by the petitioner The New York Times Company (Times). Tasini, Garrison, Robbins, and Whitford contributed eight articles to *Newsday*, another daily New York paper, published by petitioner Newsday, Inc. (Newsday). Whitford wrote one article for *Sports Illustrated*, a magazine published weekly by petitioner Time. *Id.* at 489.

²² *Tasini*, 533 U.S. at 489.

²³ *Id.*

²⁴ *Id.*

²⁵ *Id.*

²⁶ *Id.*

²⁷ *Id.*

licensed the text of the articles published in the three periodicals to LEXIS/NEXIS authorizing LEXIS/NEXIS the right to copy and sell any part of the licensed texts.²⁸

NEXIS subscribers are able to access the individual articles from the system by computer.²⁹ Articles are then retrieved through a search function.³⁰ NEXIS displays each article with its print publication, date, section, initial page number, title or headline, and author.³¹ However, each article “appears as a separate, isolated ‘story’ – without any visible link to the other stories originally published in the same newspaper or magazine edition.”³² NEXIS also does not display pictures and advertisements or duplicate the original publication’s formatting style.³³

In addition to NEXIS, the Times entered into licensing agreements with University Microfilms International (hereinafter UMI) authorizing the duplication of Times’ articles onto two CD-ROM products, the New York Times OnDisc (hereinafter NYTO) and General Periodicals OnDisc (hereinafter GPO).³⁴ NYTO, like NEXIS, is a text-only based system.³⁵ However, unlike NEXIS, NYTO only contains the Times’ articles.³⁶ An additional agreement set forth terms requiring LEXIS/NEXIS to provide UMI with computer files of the articles as transmitted

²⁸ *Tasini*, 533 U.S. at 489. Under the licensing agreement, the publishers regularly provide LEXIS/NEXIS with a group of articles from each periodical edition. The print publisher codes each article to allow for computerized retrieval and then transmits the article to a separate file. Upon further coding, LEXIS/NEXIS then puts the articles in the central discs of the database. *Id.*

²⁹ *Id.* at 490.

³⁰ *Id.* Subscribers may search for a particular article by author, title, subject, date, publication, headline, key word or words in the text. *Id.* The NEXIS system responds to the search criteria, checks the database, and notifies the user with the number of article matches. *Id.* The user may then look at, print, or download any of the articles. *Id.*

³¹ *Id.*

³² *Id.*

³³ *Id.* Formatting style consists of headline size, placement of pages (i.e. beneath or above the newspaper fold), or position of continuation pages. *Id.*

³⁴ *Tasini*, 533 U.S. at 490.

³⁵ *Id.* at 491.

³⁶ *Id.* at 490.

to LEXIS/NEXIS by the Times.³⁷ UMI also provides special codes for each article and compiles an index listing the articles available in NYTO.³⁸ Articles displayed in NYTO are presented in the same manner utilized by NEXIS.³⁹

As compared to NYTO, GPO contains more articles from more publications.⁴⁰ In addition, GPO differs from both NEXIS and NYTO because it is an image-based, not text-based, system.⁴¹ The Times authorized GPO, pursuant to a licensing agreement, to convert the Times' Sunday Book Review and Magazine into a facsimile.⁴² Because UMI "burns" the images from each page onto CD-ROM, the article appears exactly as it does in the printed publication.⁴³ Specifically, the original photographs, advertisements, and captions accompany all the articles.⁴⁴ UMI also offers an index and abstracts for all articles available in GPO.⁴⁵ Moreover, both NYTO and GPO users access articles and utilize the same search criteria system in the same manner as NEXIS.⁴⁶

PROCEDURAL HISTORY

On December 16, 1993, the Authors filed suit in the United States District

³⁷ *Id.*

³⁸ *Id.*

³⁹ *Id.* Like NEXIS, the articles in NYTO include identifying information such as title, author, and date. However, the formatting and original accompanying images are not present. *Id.*

⁴⁰ *Tasini*, 533 U.S. at 491. "GPO contains articles from approximately 200 publications." *Id.*

⁴¹ *Id.*

⁴² *Id.*

⁴³ *Id.* The term "burn" is a process by which a CD-Rom is generated on a specialized writer called a CD-R. PCTechguide, available at, <http://pctechguide.com/glossary>. The actual word "burn" refers to the heat generated by the high-powered laser needed to make the pits, which are indentations in an optical medium such as a CD-ROM. *Id.* "Burning," in layman's terms, refers to the process of copying data.

⁴⁴ *Id.*

⁴⁵ *Id.*

⁴⁶ *Tasini*, 533 U.S. at 491.

Court for the Southern District of New York alleging infringement of their copyrights by both the Print Publishers and Electronic Publishers (LEXIS/NEXIS and UMI) through the placement of their Articles in the NEXIS, NYTO, and GPO databases.⁴⁷ Upon motions for summary judgment from both parties, the district court granted the motion for the Publishers holding that the § 201(c) privilege permitted the database reproductions.⁴⁸ The district court found that the Publishers reproduced the articles "as part of . . . [a] revision of that collective work" because the databases maintained the Print Publishers "selection of articles" by copying every article placed in the original issues.⁴⁹

The Second Circuit reversed the lower court decision and granted summary judgment for the Authors.⁵⁰ The Court of Appeals held that the Databases were not shielded by the § 201(c) privilege and did not amount to "revisions" of the original periodicals.⁵¹ Because § 201(c) does not "permit a Publisher to sell a hard copy of an Author's article directly to the public even if the Publisher also offered for individual sale all the other articles from the particle edition," the Court of Appeals concluded that § 201(c) does not authorize a Publisher to "achieve the same goal indirectly" through electronic media.⁵²

The Supreme Court granted certiorari to determine whether the privilege accorded to the Print and Electronic Publishers under § 201(c) permitted the reproduction of the freelance articles into electronic databases.⁵³ The Supreme Court affirmed the Second Circuit's decision and held that the § 201(c) privilege does not supersede the individual Authors' copyrights because the electronic databases reproduced the articles in their individual capacity, in a different context from that of the original work, and not "as part of that collective work" or any

⁴⁷ *Id.*

⁴⁸ *Tasini v. N.Y. Times Co., Inc.*, 972 F. Supp. 804, 806 (S.D.N.Y. 1997).

⁴⁹ *Tasini*, 533 U.S. at 492 (quoting *Tasini v. N.Y. Times Co., Inc.*, 972 F. Supp. at 821). The district court noted that there existed a connection between the printed editions and the articles because the electronic databases included the author, periodical title, issue and page numbers for each article. *Id.* Moreover, the district court emphasized that "[t]he electronic technologies not only copy the publisher defendants' complete original 'selection' of articles, they tag those articles in such a way that the publisher defendants' original selection remains evident online." *Id.* (quoting *Tasini*, 972 F. Supp. at 824).

⁵⁰ *Tasini v. N.Y. Times Co., Inc.*, 206 F.3d 161 (2d Cir 1999).

⁵¹ *Id.* at 167-70.

⁵² *Id.* at 168.

⁵³ *Tasini*, 533 U.S. at 483.

revision thereof.⁵⁴ Based on this reasoning, the Court concluded that the storage and retrieval systems of the electronic databases infringed the Authors' exclusive rights under § 106 of the 1976 Copyright Act.⁵⁵

III. PRIOR CASE HISTORY

Copyright law, as applied to collective works in particular, changed as a result of the 1976 amendments to the statute. After the 1976 revision of the Copyright Act, many court decisions reflected "a break with the two-hundred-year-old tradition that has identified copyright more closely with the publisher than with the author."⁵⁶

The Supreme Court addressed the scope of the term "compilation" pursuant to 17 U.S.C. § 101 in *Feist Publications, Inc. v. Rural Telephone Service Co.*⁵⁷ In *Feist*, the Court explained that the term "compilation" including "collective works" was limited to the original "selection, coordination, and arrangement" chosen by the compiler.⁵⁸ The respondent, Rural Telephone Service Company, Inc. ("Rural"), was a public utility that offered telephone service to individuals in Kansas communities.⁵⁹ Rural was required by state law to publish a yearly telephone directory.⁶⁰ Rural's directory included both white pages and yellow pages.⁶¹ The white pages were organized alphabetically by the name of the subscriber along with a listing of subscribers' towns and telephone numbers.⁶² The yellow pages organized business subscribers by their category and was also in alphabetical order.⁶³

⁵⁴ *Id.* at 493.

⁵⁵ *Id.* at 506.

⁵⁶ *Id.* at 496 (quoting Letter from M. Peters to Rep. McGovern, reprinted in 147 Cong. Rec. E182 (Feb. 14, 2001) (quoting Ringer, *First Thoughts on the Copyright Act of 1976*, 22 N.Y.L. Sch. L. Rev. 477, 490 (1977)).

⁵⁷ 499 U.S. 340 (1991).

⁵⁸ *Id.* at 358.

⁵⁹ *Id.* at 342.

⁶⁰ *Id.*

⁶¹ *Id.*

⁶² *Id.*

⁶³ *Feist Publications*, 499 U.S. at 342.

Feist publications, Inc. ("Feist"), petitioner, also published telephone books and continually competed with Rural for yellow page advertisements.⁶⁴ Feist was unable to access subscriber information as easily as Rural because it was not a telephone company.⁶⁵ Feist used the subscribers' information from Rural's white pages without consent because Rural would not agree to license its listings.⁶⁶ Consequently, Rural sued Feist for copyright infringement.⁶⁷

The Supreme Court held that Feist's use of Rural's white pages was not copyright infringement because the white pages did not possess the requisite originality needed for copyright protection.⁶⁸ The Court noted that factual compilations might be entitled to copyright protection provided that the selection, coordination and arrangement of the facts demonstrate a minimal degree of creativity and originality.⁶⁹ However, the Court explained that the selection, coordination, and arrangement of the Rural white pages were not sufficiently original to warrant protection.⁷⁰

In *Stewart v. Abend*,⁷¹ the Supreme Court once again addressed issues involv-

⁶⁴ *Id.*

⁶⁵ *Id.*

⁶⁶ *Id.* at 343.

⁶⁷ *Id.* at 344.

⁶⁸ *Id.* at 364.

⁶⁹ *Feist Publications*, 499 U.S. at 348. As the Court noted:

(1) The compilation author typically chooses which facts to include, in what order to place them, and how to arrange the collected data so that they may be used effectively by readers. (2) These choices as to selection and arrangement are made independently by the compiler and entail a minimal degree of creativity so long as they are sufficiently original that Congress may protect such compilations through copyright laws.

Id. (quoting Nimmer, §§ 2.11[0], 3.03).

The Court also noted that the most crucial part of the definition of "compilation" pursuant to § 101 is the second requirement calling for "the selection, coordination, or arrangement" of the materials. *Id.* at 358. The Supreme Court emphasized that "the principal focus should be on whether [the] selection, coordination, and arrangement are sufficiently original to merit protection." *Id.*

⁷⁰ *Id.* at 364.

⁷¹ 495 U.S. 207 (1990).

ing collection works and focused on the balance between an author's exclusive rights to his literary work and the public's right to the timely dissemination of creative material.⁷² In *Stewart*, the Court held that the renewal sections of both the 1909 and 1976 Copyright Act, as well as the subsequent case law interpreting the provisions and the legislative history of the Acts, both indicated that an author is entitled to a "second chance" to receive fair compensation for his creativity.⁷³ Accordingly, the author's family became entitled to a "new estate" in the copyright in the event the author died before the renewal period began.⁷⁴

Upon author Cornell Woolrich's death, his executor assigned the motion picture rights to his stories to Abend, the respondent in *Stewart*.⁷⁵ Despite the fact that Woolrich promised the renewal rights to the petitioner, the author died prior to securing the rights in the renewal term for the petitioner.⁷⁶ As a result, the Supreme Court concluded that the petitioners only received an expectancy in the renewal term from Woolrich and, therefore, his successor, the executor of his will, was permitted to renew the copyright and assign the rights to the respondent.⁷⁷

The Court explained that the goal and policy rationales underlying the Copyright Act guided the decision.⁷⁸ The Copyright Act, the Court noted, was designed to balance the artist's right to control the creative work during the period of copyright protection with society's access to the work.⁷⁹ According to the Supreme Court, the limited copyright monopoly was intended to give authors the opportunity to get a fair price for their creative works ultimately passing into the public domain.⁸⁰ Based on this foundation, the Court explained that "[w]hen an author produces a work which later commands a higher price in the market than the original bargain provided, the copyright statute is designed to provide the au-

⁷² *Id.* at 228-29.

⁷³ *Id.* at 236.

⁷⁴ *Id.* at 220.

⁷⁵ *Id.* at 212.

⁷⁶ *Id.*

⁷⁷ *Stewart*, 495 U.S. at 207.

⁷⁸ *Id.* at 228.

⁷⁹ *Id.*

⁸⁰ *Id.* at 229.

thor with the power to negotiate for the realized value of the work.”⁸¹ Upon comparing the Court’s decision in *Stewart* to the facts at issue in *Tasini*, the *Tasini* Court concluded that a freelance author is entitled to profit from the demand for his article whether in its individual capacity or as part of a new collection.⁸²

In *Ryan v. Carl Corp.*,⁸³ the United States District Court for the Northern District of California, in construing § 201(c) of the Copyright Act, paid particular attention to the meaning of the words “as part” of the collective work.⁸⁴ The plaintiffs in *Ryan* were four authors whose articles were published in magazines and journals.⁸⁵ The defendant, UnCover, was a document retrieval and delivery company who reproduced and distributed these articles at the request of third parties.⁸⁶ The plaintiffs alleged that their individual copyrights were infringed because the defendant only paid the publishers of the collective work for use of the copyrights and not the authors themselves.⁸⁷

In their analysis of § 201(c), the district court acknowledged that a copyright in the collective work as a whole is separate and distinct from the copyright in the individual work contributed to the compilation.⁸⁸ Looking to the plain meaning of § 201(c), the *Ryan* court explained that absent a contractual agreement stating otherwise, “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.”⁸⁹

⁸¹ *Id.*

⁸² *Tasini*, 533 U.S. at 497.

⁸³ 23 F. Supp. 2d 1146 (N.D. Cal. 1998).

⁸⁴ *Id.*

⁸⁵ *Id.* at 1147.

⁸⁶ *Id.* UnCover’s service can be analogized to that of a private interlibrary loan service. *Id.* UnCover operates an internet database which consists of titles from approximately “eight million articles from about seventeen thousand periodicals,” however, the articles appear in the database without the accompanying text. *Id.* UnCover’s customers include libraries as well as individuals. *Id.* UnCover users can search for an article by title, subject, periodical name, and author. *Id.* Upon request for an article, a member from UnCover staff retrieves the article from a library carrying the periodical, copies it, and delivers it to the customer. *Id.*

⁸⁷ *Id.*

⁸⁸ *Id.* at 1149 (citing 17 U.S.C. § 103(b) (2000)).

⁸⁹ *Ryan*, 23 F. Supp. 2d at 1149 (quoting 17 U.S.C. § 201(c) (2000)).

The court focused on the meaning of “as part” and agreed with the plaintiffs’ construction of the terms.⁹⁰ According to both the court and the plaintiffs, the defendants did not copy the articles “as part” of the collective works because the articles were individually reproduced and distributed to the defendants’ customers.⁹¹ The court ultimately rejected defendants’ argument that the publishers were entitled to “reproduce the original work (the ‘part’) as it appears in the collective work, even if the entire work is not reproduced.”⁹² Relying on the legislative intent of § 201(c), the court adopted the plaintiffs’ construction in order to strike a fair and predictable balance of rights between publishers and authors.⁹³ Furthermore, the district court emphasized that “[b]oth the language and the legislative history of § 201(c) suggest that when in doubt, courts should construe the rights of publishers narrowly rather than broadly in relation to those of authors.”⁹⁴

In *Sony Corp. of America v. Universal City Studios, Inc.*, the United States Supreme Court set forth a new defense against copyright infringement by holding that the “sale of copying equipment” does not amount to contributory infringement if the equipment is “capable of substantial noninfringing uses.”⁹⁵ Sony Corp. manufactured video tape recorders (hereinafter VTR) for home use and sold them to the public through retail stores.⁹⁶ Respondents were copyright owners of various television shows.⁹⁷ VTR owners often used the recording de-

⁹⁰ *Id.*

⁹¹ *Id.*

⁹² *Id.*

⁹³ *Id.*

⁹⁴ *Id.* at 1150. The Ryan court noted that § 201(c) specifically states that the holder of the copyright in a collective work is entitled to “only” enumerated rights. *Id.* The court stated that the inclusion of § 201(c), as part of the Copyright Act of 1976, directly targeted the doctrine of copyright indivisibility. *Id.* In addition, the Ryan court emphasized that Congress enacted this section to increase authors’ rights in the context of collective work contributions because prior to 1976, authors risked relinquishing all of their exclusive rights to either the publisher of the compilation or the public domain when contributing articles to collective works. *Id.*

⁹⁵ 464 U.S. 417, 442 (1984).

⁹⁶ *Id.* at 419.

⁹⁷ *Id.* at 419-20.

vice to tape some of respondents' broadcasted programs.⁹⁸ Respondents alleged that VTR users recording the copyrighted works from the commercially sponsored television broadcasts infringed their copyrights.⁹⁹ Moreover, respondents argued that petitioners were contributorily liable for copyright infringement based on their marketing of the VTR system.¹⁰⁰ Ultimately, the Supreme Court found for the petitioners explaining that manufacturers and marketers are not liable for contributory infringement when copying equipment can be used for legitimate, noninfringing purposes.¹⁰¹

IV. *NEW YORK TIMES V. TASINI*: COLLECTIVE WORK PUBLISHERS ARE NOT ENTITLED TO THE § 201 (C) PRIVILEGE PERMITTING REPRODUCTIONS OR DISTRIBUTIONS OF FREELANCE ARTICLES CONTRIBUTED IN ELECTRONIC DATABASES

In the recent decision of *New York Times v. Tasini*,¹⁰² the Supreme Court of the United States analyzed the extent of publisher liability when freelance articles originally contributed to various periodicals were reproduced in electronic databases without the consent of the authors.¹⁰³ Justice Ginsburg, writing the opinion for the majority,¹⁰⁴ held that the Electronic Publishers were not exempt from liability under § 201(c) of the Copyright Act and therefore infringed the freelancers' copyrights by reproducing and distributing the individual articles without the authors' permission.¹⁰⁵ The Supreme Court additionally concluded

⁹⁸ *Id.* at 420.

⁹⁹ *Id.*

¹⁰⁰ *Id.*

¹⁰¹ *Sony*, 464 U.S. at 442. Examples of noninfringing uses include private time shifting (recording programs at one time in order to watch the program at a different time), recording material without copyright protection, or copying material with consent from the copyright owner. *Id.* at 443.

¹⁰² 533 U.S. 483 (2001).

¹⁰³ *Id.*

¹⁰⁴ *Id.* at 487. Chief Justice Rehnquist and Justices O'Connor, Scalia, Kennedy, Souter, and Thomas joined Justice Ginsburg's majority opinion. *Id.* Justice Stevens, joined by Justice Breyer, filed a dissenting opinion. *Id.* at 506.

¹⁰⁵ *Tasini*, 533 U.S. at 506.

that the Print Publishers committed copyright infringement by authorizing the Electronic Publishers to reproduce the articles and by assisting with the placement of the articles in the Electronic Databases.¹⁰⁶

A. JUSTICE GINSBURG'S MAJORITY OPINION

Justice Ginsburg first considered the § 201(c) privilege, which shields collective works publishers from copyright infringement for reproducing articles contributed to the compilation as part of, or a revision to, the collection.¹⁰⁷ The justice then evaluated the applicability of § 201(c) for these Electronic Database systems by placing special emphasis on the particular format and surrounding contexts of the articles once placed on the database.¹⁰⁸

The majority briefly discussed the history of copyright protection for collective works and their individual contributions under the Copyright Act of 1909 and after the 1976 revisions to the Act.¹⁰⁹ The Court explained that prior to the 1976 amendments, an author's rights were often jeopardized if a collective work publisher refused to attach a copyright notice to the contributed article in the author's name.¹¹⁰ The Court further clarified that, under the 1909 Act, copyright notice placed only in the publisher's name and not in the author's name meant that the article would become part of the public domain unless the publisher received full copyright from the author.¹¹¹ Justice Ginsburg then clarified that the 1976 Act addressed this dilemma by "[r]ecasting the copyright as a bundle of discrete 'exclusive rights,' each of which 'may be transferred . . . and owned separately.'"¹¹²

¹⁰⁶ *Id.*

¹⁰⁷ *Id.* at 488.

¹⁰⁸ *Id.* at 489-91.

¹⁰⁹ *Tasini*, 533 U.S. at 493-98.

¹¹⁰ *Id.* at 496-97.

¹¹¹ *Id.* at 494. Often, publishers with greater bargaining power would refuse to attach notice in the author's name thereby, effectively, forcing an author to sell his entire copyright in the article to the publisher in order to prevent the work from prematurely entering the public domain. *Id.* Under the 1909 Act, the author did not have the option of assigning partial rights to the publisher. *Id.* The doctrine of "indivisibility" prevented an author from granting partial assignments. *Id.* This doctrine required complete transfer of an author's rights in his work. *Id.* at 496. Congress ultimately rejected this doctrine in the Copyright Act of 1976 and made it possible for authors to transfer some of their exclusive rights while reserving others. *Id.*

¹¹² *Id.* at 495-96.

The Court also noted that Congress further protected authors' rights in contributions under § 404(a) and § 201(c) of the 1976 Copyright Act.¹¹³ The Court explained that, pursuant to § 404(a), a single notice for the entire collective work was sufficient notice to preserve authors' individual copyrights.¹¹⁴ In addition, Justice Ginsburg stated that § 201(c) provided for separate copyrights in the collective work and the individual contribution.¹¹⁵ However, the Court noted that § 201(c) also articulates a "privilege" giving a publisher certain rights over an author's contribution to the collection.¹¹⁶ The Supreme Court interpreted § 201(c) to mean that a periodical publisher is permitted to copy or distribute a freelance article only "as part of" any (or all) of the three categories of collective works: (a) 'that collective work' to which the author contributed her work, (b) 'any revision of that collective work,' or (c) 'any later collective work in the same series' "absent a contractual agreement stating otherwise."¹¹⁷ Justice Ginsburg also explained that § 201(c) makes it possible for a freelance author to benefit from an increased demand for her work whether in its individual capacity or as part of a new collection by allowing the author to sell the work to others.¹¹⁸

¹¹³ *Id.* at 496.

¹¹⁴ *Id.*; 17 U.S.C. § 404(a) (2000).

¹¹⁵ *Tasini*, 533 U.S. at 496-97; 17 U.S.C. § 201(c) (2000).

¹¹⁶ *Id.* Section 201(c) provides:

In the absence of an express transfer of the copyright or 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 work, any revision of that collective work, and any later collective work in the same series.

17 U.S.C. § 201(c) (2000).

¹¹⁷ *Tasini*, 533 U.S. at 496-97. Justice Ginsburg mentioned that in accordance with Congressional intent, a publishing company was permitted to do the following:

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.

Id. (quoting H.R. REP. NO. 94-1476, at 122-23 (1976)).

¹¹⁸ *Id.* at 497.

The majority noted that the Authors hold copyrights in their works and maintain certain exclusive rights under § 106 despite the fact that they authorized the Print Publishers to publish their works in various periodicals.¹¹⁹ Moreover, the Court resolved that the Print and Electronic Publishers did, in fact, exercise some of the Authors' exclusive rights.¹²⁰

The Court ultimately rejected the Publishers' defense that § 201(c) shielded them from liability for copyright infringement.¹²¹ Justice Ginsburg analyzed the Publishers' argument that the § 201(c) privilege was applicable because the Publishers copied and distributed the Articles "as part of" a "revision."¹²² In response to that argument, the Court focused on how the Articles were presented to the database customers finding that the Articles in the Databases appeared without the same context present in the original print periodical or any revision thereof.¹²³ The Court further commented that the articles would not be perceived by database users as being part of the original work or any subsequent revision by noting that when a search was conducted, each article "appears as a separate item within the search result."¹²⁴

In evaluating whether the Databases function as a "revision" of the original collective works, the Court dismissed the idea that the Databases formed a new "version" and commented that the Database more accurately represented a "new compendium."¹²⁵ Alternatively, the Court maintained that the Articles were not

¹¹⁹ *Id.* at 498.

¹²⁰ *Id.* Justice Ginsburg noted that the Print and Electronic Publishers infringed the Authors' exclusive rights by doing the following:

LEXIS/NEXIS' central discs and UMI's CD-ROMs 'reproduce . . . copies' of the Articles; UMI, by selling those CD-ROMs, and LEXIS/NEXIS, by selling copies of the Articles through the NEXIS Database, 'distribute copies' of the Articles 'to the public by sale'; and the Print Publishers, through contracts licensing the production of copies in the Databases, 'authorize' reproduction and distribution of the Articles.

Id. (quoting in part 17 U.S.C. § 106 (1), (3) (2000)).

¹²¹ *Id.* at 499.

¹²² *Id.*

¹²³ *Tasini*, 533 U.S. at 499.

¹²⁴ *Id.* at 500.

¹²⁵ *Id.* The Court describes "compendium" as the "entirety of the works in the Database." *Id.* The Court further clarified that in this new compendium, "each edition of each periodical represents only a miniscule fraction of the ever-expanding database." *Id.* "Revision"

“part of” of a larger work at all, but rather presented only in their individual capacity and, as such, could not be considered a “revision” under §201(c).¹²⁶ In addition, the Court rejected the notion that marks denoting the Articles’ origin indicated that the Articles were still presently part of the original work.¹²⁷

The Supreme Court also disregarded the Publishers’ argument that analogized the Databases to microfiche and microfilm.¹²⁸ Justice Ginsburg explained that, unlike the Databases, microfiche and microfilm preserve the articles context and make various articles readily available to their users.¹²⁹ Moreover, the Court examined the Publishers’ argument that “media neutrality” or the “transfer of a work between media” does not change the character of that work for the purposes of copyright protection.¹³⁰ Agreeing with the Publishers’ assessment, the Court reiterated that by transferring the articles to the Databases, as compared to a transfer to microfiche or microfilm, this new form of media presents the article standing alone and does not preserve the intact periodical or revisions of that periodical.¹³¹ The Court further maintained that this concept of media neutrality should actually protect the Authors’ individual copyrights to the extent that the Authors’ articles are presented standing alone absent the context of original collective work.¹³²

The Court also analogized the Databases to an imaginary library to demonstrate how the Authors’ copyrights were infringed.¹³³ This hypothetical library, the Court stated, would store single articles in a folder in a file room from many different periodicals and would be indexed according to a diverse set of criteria.¹³⁴ According to the Court, the hypothetical librarian would then search the

is defined as a new “version” of the original. *Id.* “Version,” in this context, is defined as a “distinct form of something regarded by its creators or others as one work.” *Id.* (quoting WEBSTER’S THIRD NEW INTERNATIONAL DICTIONARY 1944, 2545 (1976)).

¹²⁶ *Id.* at 500-01.

¹²⁷ *Id.*

¹²⁸ *Id.*

¹²⁹ *Tasini*, 533 U.S. at 501-02.

¹³⁰ *Id.* at 502; *see infra* note 153.

¹³¹ *Id.*

¹³² *Id.*

¹³³ *Id.*

¹³⁴ *Id.*

file room for all the articles satisfying the search criteria and make copies of these articles for the customer.¹³⁵ Comparing the Electronic Databases to this hypothetical library, Justice Ginsburg explained that the Databases only differed from the file room to the extent that the articles are stored in electronic files in the Database and not in separate paper files.¹³⁶ The Court ultimately concluded that, like the hypothetical library, the Database's "storage and retrieval system effectively overrides the Authors' exclusive right to control the individual reproduction and distribution of each Article."¹³⁷

The majority also rejected the Publishers' argument that they were entitled to § 201(c) protection because users could conduct searches that would produce all the articles from one newspaper or magazine.¹³⁸ The Court maintained that § 201(c) is not concerned with whether a user can manipulate the database to create a revision of the original work, but rather, whether the database actually presents the author's work "as part of a revision of the collective work."¹³⁹ To the contrary, Justice Ginsburg articulated that §201(c) does not apply to the databases in this case because they do not meet above the standard.¹⁴⁰

Finally, the Supreme Court dismissed the Publishers' reliance on *Sony Corp. of America v. Universal City Studios, Inc.*¹⁴¹ The Majority explained that *Sony* is inapposite because, in this case, the Electronic Publishers are selling reproductions of the Authors' articles and not simply selling equipment "capable of substantial noninfringing uses."¹⁴² It is the copies of the articles, the Court reiterated, that brings the Publishers beyond the scope of the privilege, thus creating liability for copyright infringement.¹⁴³

¹³⁵ *Tasini*, 533 U.S. at 503.

¹³⁶ *Id.*

¹³⁷ *Id.* at 503-04 (citing 17 U.S.C. § 106 (1), (3) (2000)).

¹³⁸ *Id.* at 504.

¹³⁹ *Id.*

¹⁴⁰ *Id.* The standard for exemption from liability under § 201(c) requires that the database publishers actually represent the author's work "as part of or a revision to" the original collective work. 17 U.S.C. § 201(c) (2000).

¹⁴¹ *Tasini*, 533 U.S. at 504 (citing *Sony Corp. of Am. v. Universal City Studios*, 464 U.S. 417 (1984)).

¹⁴² *Id.* (quoting 464 U.S. at 442).

¹⁴³ *Id.* The majority granted the injunction against the petitioners from including these Articles in their Databases despite concerns that such a holding would create an incomplete

B. JUSTICE STEVEN'S DISSENT

Justice Stevens, joined by Justice Breyer, wrote their dissenting opinion.¹⁴⁴ The Justice did not agree with the majority's interpretation of "revision" pursuant to § 201(c).¹⁴⁵ Justice Stevens contended that the electronic versions of the collections were, in fact, "revisions" of the collective works and that the "aggregation by LEXIS/NEXIS and UMI of the revisions with other editions of the same periodical or with other periodicals within a single database" does not take the Publishers outside the protection of the §201 (c) privilege.¹⁴⁶

The Justice began the dissent by identifying the Congressional rationale for amending the Copyright Act in 1976 with respect to collective works and authors' rights.¹⁴⁷ Justice Stevens agreed with the majority that the 1976 Act attempted to "clarify and improve the . . . confused and frequently unfair legal situation" "that existed under the 1909 Act."¹⁴⁸ However, the Justice argued that a finding for the Publishers was not inconsistent with Congressional intent.¹⁴⁹ Justice Stevens further clarified that the Authors' individual copyrights were not compromised or diminished by the transfer of their Articles to the Electronic Databases because the Articles were not altered and not published in a completely new collective work.¹⁵⁰

electronic record. *Id.* at 506. The Court reasoned that freelance authors and collective works publishers could contract for the transfer of such rights. *Id.* In addition, the majority noted that the potential for future harms is not a sufficient justification to "shrink authorial rights Congress established in § 201 (c)." *Id.*

¹⁴⁴ *Tasini*, 533 U.S. at 506 (Stevens, J., dissenting).

¹⁴⁵ *Id.*

¹⁴⁶ *Id.* at 507 (Stevens, J., dissenting).

¹⁴⁷ *Id.* Justice Stevens reiterated the rationales, previously mentioned by the majority, for enacting § 404 (a) and §201 (c) and how each of these provisions enhanced freelance authors' rights in their collective contributions. *Id.*; *see supra* notes 112-115.

¹⁴⁸ *Id.* at 510 (Stevens, J., dissenting) (quoting H.R. REP. No. 94-1476, at 122 (1976)). The unfair situation referred to deals with the fact that freelance authors risked losing their copyright protection in their contributions to collective works because, in conjunction with the doctrine of indivisibility which made it impossible to transfer partial rights, powerful publishers often refused to attach copyright notice in the author's name thereby placing the work in the public domain unless the author transferred total copyright to the publisher. *Id.*

¹⁴⁹ *Id.* at 511 (Stevens, J., dissenting).

¹⁵⁰ *Tasini*, 533 U.S. at 511 (Stevens, J., dissenting).

Justice Stevens first analyzed whether a group of articles from one edition of a newspaper is a "revision" of the original periodical.¹⁵¹ Like the majority, the dissent focused on the "context" surrounding the articles and urged that sufficient context was present to establish that the Articles were part of a revision because every article on the Databases appeared with its title, headline, byline, section, and page number as present in the original editions.¹⁵² Furthermore, Justice Stevens invoked the principle of media neutrality on behalf of the Publishers and emphasized that the transfer of the Articles to the Electronic Databases was no different than a transfer of the Articles to microfilm.¹⁵³ In comparing the electronic databases to microfilm, Braille, and foreign language translations, Justice Stevens maintained that the electronic databases still constituted a "revision" of the collective work even though the revisions looked and felt different from the original.¹⁵⁴ Furthermore, the dissenting opinion argued that the principle of media neutrality implies that "the New York Times, reproduced as a collection of individual ASCII files, should be treated as a 'revision' of the original edition, as long as each article explicitly refers to the original collective work and as long as substantially the rest of the collective work is, at the same time, readily accessible to the reader of the individual file."¹⁵⁵

The Justice explained that the electronic files contain both the appropriate labeling (i.e. title, headline, periodical name, etc.) as well as the full editorial content of the original periodical necessary to preserve the original editors' selec-

¹⁵¹ *Id.*

¹⁵² *Id.* at 511-12 (Stevens, J., dissenting).

¹⁵³ *Id.* at 513 (Stevens, J., dissenting). Media neutrality refers to the principle that transferring a work between media does not change or alter the actual character of the work for the purposes of copyright infringement. *Id.* at 502-03. The concept of media neutrality would allow publishers to reprint collective work into different media forms, such as Braille, foreign languages, and microfilm, without incurring liability for copyright infringement. *See id.* at 512-13. Justice Stevens concluded that pursuant to the concept of media neutrality, a reproduction of a collective work still constitutes a "revision" of the collective work, even when the work is significantly altered, provided that the alterations were "necessitated by . . . the medium." *Id.* at 513-14. Justice Stevens explained that the conversion of a single intact periodical into a "collection of individual ASCII files can be explained as little more than a decision that reflects the different nature of the electronic medium." *Id.* at 513. Justice Stevens highlighted that just as the New York Times made the choice to separate its paper periodical into "sections" and "pages" in order to assist the reader with sifting through the newspaper, "the decision to subdivide the electronic version of that collective work into individual article files facilitates the reader's use of the electronic information." *Id.*

¹⁵⁴ *Id.*

¹⁵⁵ *Id.* at 514 (Stevens, J., dissenting).

tion.¹⁵⁶ Accordingly, Justice Stevens maintained that the individual Article existed as “‘part of’ a collection of articles *containing all the editorial content of that day’s New York Times*” and therefore should be subject to the § 201 (c) privilege.¹⁵⁷ Moreover, the dissent criticized the majority for placing too much emphasis on formatting features, which cannot be duplicated by the ASCII files, and too little attention on the actual context selection, which is preserved through the transfer.¹⁵⁸

Next, Justice Stevens critiqued the majority’s reasoning that the data transferred by the Times could not be considered “revisions” based on the systems the Databases used to store the data and make it publicly available.¹⁵⁹ The dissent explained that there was no reason to reject the applicability of § 201(c) based on the fact that the Databases also included additional periodicals and other editions because “[e]ach individual file still remind[ed] the reader that he [was] viewing ‘part of’ a particular collective work.”¹⁶⁰ In addition, the dissent highlighted the fact that the complete editorial content was still accessible to the reader.¹⁶¹

Even though the Articles may exist “as part of” of larger collective work, Justice Stevens contended that this fact did not change the relationship between the original article and the smaller revision.¹⁶² For example, the Justice noted that a microfilm from a particular date was still a revision of the collective even though it is stored with other periodical editions on the same roll from the same or, even different, newspapers.¹⁶³

Referring to copyright policy, Justice Stevens acknowledged that the interpre-

¹⁵⁶ *Tasini*, 533 U.S. at 514 (Stevens, J., dissenting).

¹⁵⁷ *Id.* at 514-15 (Stevens, J., dissenting) (emphasis in the original).

¹⁵⁸ *Id.* at 515-17 (Stevens, J., dissenting). Justice Stevens provided an example to illustrate the point that the electronic databases constituted a revision. The Justice argued that Publishers’ behavior is no different than if the New York Times placed all its articles from one day’s paper on a single floppy disk, labeled the disk as “New York Times, Day XXX” and sold the disk as an electronic version of the periodical. Justice Stevens explained that the disk would still be a “revision” under § 201(c) even though all the original formatting and contextual background was missing because the editors’ selection was maintained. *Id.*

¹⁵⁹ *Id.* at 516 (Stevens, J., dissenting).

¹⁶⁰ *Id.* at 517 (Stevens, J., dissenting).

¹⁶¹ *Id.*

¹⁶² *Tasini*, 533 U.S. at 517 (Stevens, J., dissenting).

¹⁶³ *Id.* at 517-18 (Stevens, J., dissenting).

tation of “revision” under § 201(c) reflected the demand that “ ‘private motivation (incentive for authors to create) must ultimately serve the cause of promoting *broad public availability* of literature, music, and the other arts.’ ”¹⁶⁴ In addition, the dissent admonished the majority for discounting the consequences its ruling would have on the availability of comprehensive electronic databases.¹⁶⁵

Justice Stevens further expressed that the dissent did not injure Authors’ rights in their respective works.¹⁶⁶ Moreover, the Justice pointed out that demand for freelance articles did not necessarily equate to demand for electronic databases.¹⁶⁷ For example, the Justice explained that, after 1995, the Times required freelance authors to transfer their “electronic rights,” yet this additional contractual provision did not subsequently increase the freelancers’ compensation.¹⁶⁸ The dissent explained that allowing the transfer of the Articles to the Databases as a revision under § 201(c) would actually benefit the Authors because it would increase the value of the Authors’ copyright in its remaining uses by increasing readership.¹⁶⁹

In conclusion, the dissenting opinion commented that the District Court’s holding was both reasonable and consistent with the aims of copyright law.¹⁷⁰ Justice Stevens, not only emphasized that the purpose of § 201(c) is to strike a

¹⁶⁴ *Id.* at 520 (Stevens, J., dissenting) (quoting *Twentieth Century Music Corp. v. Aiken*, 422 US 151, 156 (1975) (emphasis in the original)).

¹⁶⁵ *Id.* Justice Stevens stated that the majority’s holding could prevent electronic databases from including freelance articles for fear of being subject to statutory damages. *Id.* As a result, these gaps in the record created by the refusal to include certain freelance articles would diminish the accuracy and completeness of the entire database. *Id.* Additionally, the Justice mentioned that the decision could force publishers to require a complete transfer of the author’s exclusive rights before accepting a freelance piece as part of a collective work. *Id.* at 521. Consequently, authorial rights would virtually be placed in the same predicament as they were prior to the 1976 amendments to the Copyright Act. *Id.*

¹⁶⁶ *Id.* at 521 (Stevens, J., dissenting).

¹⁶⁷ *Id.* The dissent mentioned that the demand for the electronic databases reflects the customer’s desire for a product that produces fast results and easy searches for a wide array of periodical articles. *Id.*

¹⁶⁸ *Tasini*, 533 U.S. at 522 (Stevens, J., dissenting).

¹⁶⁹ *Id.*

¹⁷⁰ *Id.* at 524 (Stevens, J., dissenting). The general aim of Copyright law is to balance the creation of new works by providing authors with a limited monopoly and certain exclusive rights without undermining public accessibility to these new works. See U.S. CONST. art 1, § 8 cl. 8.

balance between the rights of authors and collective publishers, but also reiterated that the goal of copyright policy, in general, is to induce authorial incentive without sacrificing the public interest.¹⁷¹

V. CONCLUSION

Tasini v. New York Times is the first Supreme Court decision to address the scope of freelance authors' electronic rights in their individual articles after publishers purchase the work to be part of larger collective works. This decision is important because it acknowledges how existing copyright law is directly affected, and often manipulated, by the advances in electronic media. Today, technology makes it possible to reproduce and distribute information and articles more efficiently and faster. However, these technological developments, while beneficial in one respect, may threaten the delicate balance crafted by the framers of the Constitution in the Copyright Clause to simultaneously provide incentive for authors while promoting public dissemination of creative works.¹⁷²

Although criticized by the dissent for potentially creating gaps in the electronic libraries, the majority's opinion in *Tasini* does achieve the main objective of the Copyright clause by maintaining the necessary balance among authors, publishers and society for the creation and distribution of creative works.¹⁷³ Because the *Tasini* decision can impose liability on publishers and database owners

¹⁷¹ *Id.*

¹⁷² John D. Shuff & Geoffrey T. Holtz, *Copyright Tensions in a Digital Age*, 34 AKRON L. REV. 555, 569 (2001). Shuff and Holtz argued that freelance authors' copyrights in electronic publications should be managed under an analogous system adopted by the music industry through ASCAP (the American Society of Composers, Authors and Publishers) and BMI (Broadcast Music, Inc.). *Id.* at 567. ASCAP and BMI are "clearinghouses for musical compositions." *Id.* Composers or owners of the copyrighted musical piece register the work with these organizations and, in essence, grant the organizations a non-exclusive license thereby making the music available to radio stations that have negotiated for a blanket license to play the registered music. *Id.* The benefit of the ASCAP and BMI system is that these organizations are able to keep records of how frequently the musical compositions are played and can manage and secure payment to the copyright owners so that each licensee is not forced to separately negotiate with the many individual composers, performers, and publishers. *Id.* The authors of this article maintain that the quality and availability of musical compositions would not have reached the level that has today if a system for compensating composers and performers was not established. *Id.* at 569. Moreover, they contend that just as the advances in recording and radio technologies disrupted the copyright balance before the introduction of the ASCAP and BMI systems originated to "restore the equilibrium," Internet advances and electronic development tend to undermine the balance among publishers, authors, and the public. *Id.*

¹⁷³ *Tasini*, 533 U.S. at 524 (Stevens, J., dissenting); see *supra* notes 110-116.

retrospectively for previously reproduced and distributed electronic versions of the freelance work, it is possible that some articles will be removed from the electronic systems if the authors so choose.¹⁷⁴ Yet, the amount of work that may become completely unavailable on these databases is not nearly significant enough to justify the publishing industry's encroachment on freelance authors' exclusive rights. At the very worst, the deletion of some articles from the electronic databases does not translate into total removal from the public domain. These articles are still accessible in libraries in their original hard-copy format. In addition, the National Writers Union has offered a copyright clearance center to provide publishers and database owners with the necessary licenses to maintain the electronic records.¹⁷⁵

Although some critics, like the dissent, may argue that the holding in *Tasini* will reduce access to creative works by producing the potential for holes in the electronic databases, the reality is that authors' rights must be protected from blatant infringement in order to ensure the creation of the works in the first place. It is critical to remember that the purpose of Article 1, Section 8, Clause 8 is two-fold; this Constitutional provision is designed to both provide the public with creative works and inventions and equally encourage creativity and innovation by compensating the authors and inventors with limited monopolies.¹⁷⁶ There is no evidence that this decision will deplete the electronic libraries or even make it more difficult for electronic publishers to acquire the necessary licenses to publish the work legally. *New York Times v. Tasini* ultimately preserves the delicate balance of the Copyright clause. The Supreme Court adheres to the fundamental principles established in the Constitution by safeguarding the exclusive rights of authors without jeopardizing the creation and accessibility of the works to the public.

¹⁷⁴ Wendy J. Gordon, *Fine-Tuning Tasini: Privileges of Electronic Distribution and Reproduction*, 66 BROOK. L. REV. 473, 493 (2000). In light of the *Tasini* decision, authors whose articles were sold to electronic databases by collective works publishers can now elect to remove these articles from the databases by refusing to license. *Id.*

¹⁷⁵ *Id.* at 494 (citing Publication Rights Clearinghouse, available at <http://www.nwu.org>.)

¹⁷⁶ See U.S. CONST. art. 1, § 8 cl. 8.