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AUTHORS STRIPPED OF THEIR ELECTRONIC RIGHTS IN *TASINI v. NEW YORK TIMES CO.*

MICHAEL SPINK*

INTRODUCTION

In 1991, Jonathan Tasini, freelance writer¹ and National Writers Union president, received a \$100 check from the New York newspaper, *Newsday*.² The back of the check indicated that by signing the check, Tasini would release the electronic republication³ rights of an article he had written for the newspaper.⁴ Although Tasini crossed out the language that indicated a transfer of rights and then deposited the check, he later found his article on the on-line database NEXIS,⁵ as well as on a CD-ROM.⁶ In response, Tasini and several other freelance

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1. Freelance writers are to be distinguished from employees of a publisher. As defined in Section 101 of the 1976 Copyright Act, a "work made for hire" is a work prepared by an employee within the scope of his or her employment." 17 U.S.C. § 101 (1994). As such, Section 201(b) of the Copyright Act grants the employer copyrights in the work product of its employees. *Id.* § 201(b). A freelance writer, however, generally contracts specific pieces of work to publishers, retaining the copyright in his or her work, while the publishers only receive the rights which have been explicitly contracted for. *Tasini v. New York Times Co.*, 972 F. Supp. 804, 807 (S.D.N.Y. 1997).

2. Roslind Resnick, *Writers, Data Bases Do Battle, On-line Distribution Stirs Royalties Dispute*, NAT'L L.J., March 7, 1994, at 1; Carol Ebbinghouse, *Who Gets the Money? (Copyright Issues in Electronic Publishing)*, SEARCHER, Mar. 1, 1996, at 51.

3. Electronic publishing can be described as utilizing computer-aided processes to furnish print publications such as books, newspapers, and magazines in a digital format. Alan J. Hartnick, *Checklist for Lawyers for Multimedia Matters*, N.Y.L.J., Oct. 8, 1993, at 5.

4. Resnick, *supra* note 2, at 1; Ebbinghouse, *supra* note 2, at 54.

5. Databases are collections of information in digital format which may be remotely accessed, and downloaded from, by using a modem and a computer. Ian C. Ballon, *Intellectual Property Protection and Related Third Party Liability*, 482 PRAC. L. INST. / PAT. 559, 567 (1997) [hereinafter Ballon, *Intellectual Property Protection*].

6. Resnick, *supra* note 2, at 1; Ebbinghouse, *supra* note 2, at 54. CD-ROM stands for Compact Disc Read-Only Memory. *Computer Currents On-Line Dictionary*, <<http://www.currents.net/resources/dictionary>>. See *infra* notes 43-47 and accompanying text for a short background of CD-ROMs.

writers, who had similar experiences, joined forces and filed suit against their print publishers.⁷ Additionally included among the defendants were the electronic publishers with whom the print publishers had contracted.⁸ Over three and one-half years later a New York court found for the defendants and held that electronic publication of the periodicals did not infringe the copyrights that the freelance authors held.⁹

The struggle over electronic publication rights between freelance authors and publishers is one of the many copyright issues that computer and communication technology has created.¹⁰ As established case law concerning the digital world continues to develop, many questions remain unanswered.¹¹ Although proposed

7. *Tasini*, 972 F. Supp. at 804. The plaintiffs filed suit on December 16, 1993, in the Southern District of New York. *Id.*

8. *Id.*

9. *Id.* at 827.

10. See generally Pamela Samuelson, *Some New Kinds of Authorship Made Possible by Computers and Some Intellectual Property Questions They Raise*, 53 U. PITT. L. REV. 685 (1992) (describing some of these new issues); Working Group, *Intellectual Property and the National Information Infrastructure: The Report of the Working Group on Intellectual Property Rights* (1995) [hereinafter *White Paper*] <<http://www.uspto.gov/web/offices/com/doc/ipnii.index.html>>, also available at <<http://iitf.doc.gov/>> (discussing the same); I. Trotter Hardy, *The Proper Legal Regime for "Cyberspace"*, 55 U. PITT. L. REV. 993 (1994) (describing other new issues). One recent copyright issue new technology has generated includes whether video taping television programs for subsequent use constitutes copyright infringement. See *Sony Corp. v. Universal City Studios, Inc.*, 464 U.S. 417, 456 (1984) (holding that video taping television programs for future use, as long as it is not for commercial or public use, does not constitute infringement). Another new issue is whether browsing copyrighted material on the Internet constitutes copyright infringement. *Religious Tech. Ctr. v. Netcom On-Line Comm. Servs., Inc.*, 907 F. Supp. 1361, 1383 (N.D. Cal. 1995). Yet another issue is whether temporarily storing copyrighted material in a computer's random access memory (RAM) constitutes copyright infringement. See *MAI Sys. Corp. v. Peak Computer, Inc.*, 991 F.2d 511, 578 (9th Cir. 1993) (holding that an unlicensed user of a computer who turned the computer on, which caused the copyrighted operating system to load into RAM, constituted infringement); see also *Triad Sys. Corp. v. Southeastern Express Co.*, 64 F.3d 1330, 1337 (9th Cir. 1995) (holding that an independent service organization's use of diagnostic software, which was licensed to the organization's customer, constituted infringement). An additional issue is whether computer icons are copyrightable. *Apple Computer, Inc. v. Microsoft Corp.*, 35 F.3d 1435, 1443-44 (9th Cir. 1994). Finally, the issue of whether on-line service providers should be held liable for copyright infringing uploads and downloads by their users is also new. *Playboy Enters., Inc. v. Frena*, 839 F. Supp. 1552, 1557-58 (M.D. Fla. 1993); *Sega Enters. Ltd. v. MAPHIA*, 857 F. Supp. 679, 686 (N.D. Cal. 1994); *Frank Music Corp. v. CompuServe Inc.*, No. 93 Civ. 8153 (S.D.N.Y. 1993); *Religious Tech. Ctr.*, 907 F. Supp. at 1361.

11. See Ron Coleman, *Copycats on the Superhighway*, 81 A.B.A. J. 68, 69-70 (1995) (discussing the plethora of issues raised by the Internet, proposed solutions to these issues, and whether the current laws can adequately resolve these issues, or whether the United States needs to completely revise the

legislation¹² is aimed at resolving some of these issues, many leaders in the copyright community have strongly resisted such legislation.¹³

entire Copyright Act).

12. National Information Infrastructure Copyright Protection Act of 1995 [hereinafter NII Copyright Protection Act of 1995]. Bipartisan bills H.R. 2441 and S. 1284 were introduced on September 2, 1995 in the House and Senate respectively. S. 1284, 104th Cong., 1st Sess. (1995); H.R. 2441, 104th Cong., 1st Sess. (1995). These bills would implement the recommendations contained in the *White Paper*. 141 CONG. REC. S144547-05 at S14550 (daily ed. Sept. 28, 1995) (statement of Senator Hatch while introducing the NII Copyright Act of 1995). The *White Paper* makes several suggestions, including: (1) incorporating "digital transmission" in the exclusive rights by amending the distribution right, found at 17 U.S.C. § 102(3), to include distribution by transmission; (2) changing the definition of "transmit" to include the transmission of a reproduction; (3) amending the definition of "publication" to include the distribution of copies by transmission; (4) making it illegal to tamper with copyright management information to be added to electronic files; and (5) making devices designed to get around the new technological protection for proprietary material illegal. *White Paper* at 11-35.

13. See, e.g., Pamela Samuelson, *The Copyright Grab*, WIRED, Jan. 1996, at 134 <<http://www.hotwired.com/wired/whitepaper.html>>. Professor Samuelson asserts that the bipartisan bills would:

- Give copyright owners control over every use of copyrighted works in digital form by interpreting existing law as being violated whenever users make even temporary reproductions of works in the random access memory of their computers;
- Give copyright owners control over every transmission of works in digital form by amending the copyright statute so that digital transmissions will be regarded as distributions of copies to the public;
- Eliminate "fair use" rights whenever a use might be licensed . . . ;
- Deprive the public of the "first sale" rights it has long enjoyed in the print world . . . because the *White Paper* treats electronic forwarding as a violation of both the reproduction and distribution rights of copyright law;
- Attach copyright management information to digital copies of a work, ensuring that publishers can track every use made of digital copies and trace where each copy resides on the network and what is being done with it at any time;
- Protect every digital copy of every work technologically . . . and make illegal any attempt to circumvent that protection;
- Force online service providers to become copyright police, charged with implementing pay-per-use rules . . . ;
- Teach the new copyright rules of the road to children throughout their years at school.

Id. See also Loundy, *Revising the Copyright Law for Electronic Publishing*, 14 J. MARSHALL J. COMPUTER & INFO. L. 1, 4-5 (1995) (analyzing the *White Paper's* suggested approach to amend the Copyright Act and applying the proposed laws to hypothetical situations); National Writers Union, *National Writers Union Critiques Government White Paper on Intellectual Property and the National Information Infrastructure*, <http://www.eff.org/pub/Intellectual_property/nwu_ipwg_paper.comments> (disagreeing with some proposals of the *White Paper* but focusing their criticism of the *White Paper* on the issues it fails to address). The National Writers Union (NWU) is Local 1981/UAU, AFL-CIO, and represents 4,500 freelance writers. *Id.* For more criticism of

Many of these legal issues have arisen from the increasing simplicity of accessing the Internet,¹⁴ bulletin board services (BBS),¹⁵ and on-line databases.¹⁶ Digitally stored copyrighted works are more susceptible to infringement because they are more easily copied, manipulated, transmitted and accessed than their print counterparts.¹⁷ From virtually anywhere in the world, people can access vast libraries filled with public,¹⁸ private,¹⁹ and government information²⁰ with only a home computer and modem.²¹ Unfortunately, with the same amount of ease, people can impermissibly copy and distribute literary works,²²

the *White Paper* see Gary Chapman, *Copyright Bill Would Infringe on the Internet's Real Promise*, L.A. TIMES, May 20, 1996, at 7.

14. The Internet is the world's largest computer network, and is formed by connecting smaller computer networks and individual users. Ballon, *Intellectual Property Protection*, *supra* note 5, at 565. Currently, the Internet connects over 40,000 interconnected networks, with more than four million servers. *Id.* In *Reno v. ACLU*, the Supreme Court reiterated that approximately 40 million people used the Internet at the time of trial in 1996, and estimated that the number of users will increase to 200 million by 1999. 117 S. Ct. 2329, 2334 (1997). Some have even estimated that over 50 million individual users are currently connected by the Internet. Robert S. Schlossberg & Armand J. Zottola, *Avoiding Intellectual Property Liability*, 468 PRAC. L. INST. / PAT. 363, 386 (1997).

15. Users of an electronic bulletin board enter information (upload) for others to use, or take information (download) from the bulletin board. Jessica R. Friedman, *Copyright*, 64 FORDHAM L. REV. 705, 705 (1995); JAMES A. O'BRIAN, MANAGEMENT INFORMATION SYSTEMS: A MANAGERIAL END USER PERSPECTIVE 646 (1990). Over 100,000 bulletin boards are accessible via the Internet. Rex S. Heinke & Heather D. Rafter, *Rough Justice in Cyberspace: Liability on the Electronic Frontier*, 7 COMPUTER LAW. 1, 1-2 (1994).

16. Benjamin R. Kuhn, *A Dilemma in Cyberspace and Beyond: Copyright Law For Intellectual Property Distributed Over The Information Superhighways of Today And Tomorrow*, 10 TEMP. INT'L & COMP. L.J. 171, 173 (1996) (citing Heinke & Rafter, *supra* note 15, at 5); Mike Godwin, *Cops on the I-Way*, TIME (SPECIAL ISSUE), Spring 1995, at 62. See *infra* notes 51-54 and accompanying text for a description of on-line databases.

17. Pamela Samuelson & Robert J. Glushko, *Intellectual Property Rights for Digital Library and Hypertext Publishing Systems*, 6 HARV. J.L. & TECH. 237, 240 (1993).

18. See, e.g., IPL the Internet Public Library <<http://www.ipl.sils.umich.edu/index.text.html>> (providing a database of information accessible to the public at large).

19. See, e.g., <<http://www.lexis.com/>> (providing a legal database on the internet).

20. See, e.g., <<http://www.usgov.com/>>; <<http://www.fedworld.com/>>; <<http://www.fedlaw.gsa.gov/>>; <<http://www.lib.lsu.edu/gov/fedgov.html>> (providing a database of mostly governmental information on the Internet); see also, e.g., ALLISON, *supra* note 15, at 293-323 (providing a list of "Government Sources of Business and Economic Information on the Internet").

21. A home computer equipped with a modem permits communication with other computers and users. Ballon, *Intellectual Property Protection*, *supra* note 5, at 567.

22. *Religious Tech. Ctr. v. Lerma*, 908 F. Supp. 1362, 1364 (E.D. Va. 1995).

photography,²³ music,²⁴ and software²⁵ to millions of others around the globe.²⁶ Moreover, this can be done anonymously,²⁷ and for a

Lerma took 69 pages of text from copyrighted material owned by Religious Technology Center (RTC), and placed it on the Internet. *Id.* Summary judgment was entered for the Washington Post and its reporters who had published an article on the story. *Id.* Lerma's Internet service provider settled with RTC. *Id.* Summary judgement was then entered for plaintiff RTC. See 40 U.S.P.Q.2d (BNA) 1569 (E.D. Va. 1996) (entering summary judgment for Religious Technology Center against Lerma).

23. See *Playboy Enters., Inc. v. Frena*, 839 F. Supp. 1552, 1561 (M.D. Fla. 1993) (holding a bulletin board operator liable for copyright infringing uploads and downloads by subscribers of scanned photographs from the magazine *Playboy*).

24. See *Frank Music Corp. v. CompuServe Inc.*, 93 Civ. 8253 (S.D.N.Y.) (reaching a settlement in early November of 1995, Frank Music alleged that CompuServe was liable for providing a bulletin board where users uploaded and downloaded Frank Music's copyrighted music).

25. See *United States v. LaMacchia*, 871 F. Supp. 535, 537 (D. Mass. 1994) (dismissing a criminal case against LaMacchia for lack of evidence that LaMacchia profited from the infringement, wherein the defendant provided a bulletin board and fostered the downloading and uploading of copyrighted computer games and software); *Sega Enters. Ltd. v. MAPHIA*, 948 F. Supp. 923, 930 (N.D. Cal. 1996) (granting summary judgement for Sega wherein the MAPHIA bulletin board, operated by Chad Sherman, supported the downloading and uploading of Sega's video games); see also Mike Meyers, *Software Hard Liners*, STAR TRIB. (MINNEAPOLIS-ST.PAUL), Nov. 18, 1994, at 1D (discussing the incidents of software piracy on the Internet and bulletin board systems, and the measures being taken by those in the software industry).

26. See *Reno v. ACLU*, 117 S. Ct. 2329, 2334 (1997) (estimating that there are currently at least 40 million computer owners); Heinke & Rafter, *supra* note 15, at 2 (stating that there are over 100,000 bulletin board systems available to Internet users).

27. See *Reno*, 117 S. Ct. at 2337 (citing the District Court, 929 F. Supp 824, 845 (E.D. Penn. 1996), who made factual findings that the identity of a person cannot always be determined from the email address of that person). The Court noted the decentralized nature of the Internet, lack of any user lists, and the availability of anonymous remailers to the public, as factors permitting anonymity. *Id.* See also *Stratton Oakmont, Inc. v. Prodigy Servs. Co.*, 1995 WL 323710 (N.Y. Sup. Ct. May 24, 1995) (holding, before being overruled by the Telecommunications Act of 1996, that Prodigy was liable for defamation because an anonymous Prodigy subscriber posted defamatory remarks on a bulletin board); Ian C. Ballon, *The Law of the Internet: Developing a Framework for Making New Law*, 482 PRAC. L. INST./PAT. § 1.01[A], at 12 [hereinafter Ballon, *The Law of the Internet*] (discussing online anonymity and the problems it can cause, specifically noting *United States v. Baker*, 890 F. Supp. 1375 (E.D. Mich. 1995)); Mary Holden, *Intellectual Property Disputes Flare on the Electronic Frontier*, CHI. DAILY L. BULL., Apr. 22, 1995, at 1 (discussing the widespread copyright infringement occurring daily on the Internet and the lack of control, due in part to the anonymity of users). An anonymous remailer receives an email from a user wishing to send his/her message anonymously, and forwards the message, leaving no trace of the sender's address or identity. Ballon, *The Law of the Internet, supra*, § 1.01[A], at 13 n.4.

large profit.²⁸

New technology has also allowed publishers to increase their reader base by placing electronic versions of their magazines or newspapers on-line.²⁹ A Kelsey Group/Editor & Publisher survey discovered that almost fifty percent of large daily and weekly newspapers already have on-line services.³⁰ The survey also discovered that eighty-one percent of daily papers that do not currently have an on-line service are planning to produce one.³¹ Additionally, the study found that electronic distribution is increasing for large on-line databases that house multiple publications.³² Some freelance authors, however, complain that these publishers are unjustly exploiting their individual works without compensation.³³ For example, the *Chicago Tribune* was allegedly using a freelance writer's articles on its world wide web site³⁴ without the writer's permission.³⁵

This Comment explores the struggle between freelance authors and publishers over electronic publication rights, and focuses on the recent decision in *Tasini v. New York Times Co.*³⁶

28. The Software Publishers' Association estimated in 1996 that piracy cost the software industry \$15 billion. Chapman, *supra* note 13, at 7. It has also been estimated that illegal copying costs publishers of business software \$7 billion to \$12 billion dollars every year. Meyers, *supra* note 25, at 1D.

29. Richard Raysmand & Peter Brown, *Electronic Data Bases and Rights of Freelancers*, N.Y.L.J., Sept. 9, 1997, at 3. This article discusses the recent case *Tasini v. New York Times Co.*, and notes that the number of print publications now electronically distributed has increased. *Id.*

30. David J. Loundy, *Authors Waging Fight In Brave New World*, CHI. DAILY L. BULL., Mar. 7, 1996, at 6 [hereinafter Loundy, *Authors Waging Fight*]. The word "large" is used to describe newspapers which have circulation's greater than 30,000. *Id.* Loundy discusses the struggle between freelance authors and their publishers for electronic publication rights, particularly in light of *Tasini v. New York Times Co.* *Id.* Loundy goes on to discuss the collective licensing organizations formed to protect freelance authors' rights. *Id.*

31. *Id.*

32. *Id.*

33. *Tasini v. New York Times Co.*, 972 F. Supp. 804, 806-07 (S.D.N.Y. 1997). See also Raysman & Brown, *supra* note 29, at 3; Loundy, *Authors Waging Fight*, *supra* note 30, at 6.

34. A world wide web site is a set of hypertext files found within the Internet at an electronic location, and permits users of different operating systems to display the contents of the hypertext files. Ballon, *Intellectual Property Protection*, *supra* note 5, at 565-66. Hypertext files are made using hypertext markup language (HTML). *Id.* Any number of users can access and display the same file simultaneously. *Id.* HTML files can display text, pictures, and sound, and can be "linked" to other files. *Id.* "Linking" permits a user viewing one file to jump to a different file within the site (or even a completely different site) and display its contents. *Id.*

35. Loundy, *Authors Waging Fight*, *supra* note 30, at 6 (pointing to an article published on Feb. 2, 1996, in *The Reader*, a Chicago based newspaper).

36. 972 F. Supp. 804 (S.D.N.Y. 1997).

Part I discusses the background of electronic publishing, as well as the history leading up to the inception of the present Copyright Act. Part II explains the concepts of copyright law pertaining to electronic publication. Part III analyzes the court's holding in *Tasini v. New York Times Co.*³⁷ Finally, Part IV proposes alternative interpretations of the Copyright Act's application to electronic publishing, proposes needed changes to the Copyright Act, and explains important issues which authors and publishers must address in future licensing agreements.

I. A HISTORY OF INTERACTION: NEW TECHNOLOGY AND THE COPYRIGHT ACT

New technology is constantly forcing copyright law to adapt.³⁸ Developments in technology have also opened new avenues for print publishers. With an estimated 125 million people owning computers³⁹ and at least 40 million people connected to the Internet,⁴⁰ the number of potential readers has exploded past the limitations of print publication.⁴¹ CD-ROMs, electronic databases, and on-line services are very common methods of electronic publication.⁴² Thus, a brief background of this technology is necessary to understanding its importance, both today, and in the future.

A. *Electronic Publishing: CD-ROMs, Electronic Databases, and On-line Services*

1. *CD-ROMs*

Although not used commercially until 1983, CD-ROMs were invented in 1980.⁴³ Initially for the storage of music, computer

37. *Id.*

38. *Sony Corp. v. Universal City Studios, Inc.*, 464 U.S. 417, 430 (1984). See *infra* notes 55-76 and accompanying text for a discussion of the influence technological advances have had on copyright law.

39. George Gilder, *Ethersphere (Telecosm)*, FORBES ASAP: A TECHNOLOGY SUPPLEMENT, Oct. 10, 1994, at 144. This article discusses the rapid growth of the satellite industry in providing electronic communication for users worldwide. *Id.*

40. *Reno v. ACLU*, 117 S. Ct. 2329, 2334 (1997); Schlossberg & Zottola, *supra* note 14, at 386.

41. The requirements for producing one digital copy of a work, which can potentially be accessed and viewed by 50 million or more users, is far simpler than publishing and distributing millions of print copies for every subscriber.

42. See *Computer Currents On-Line Dictionary* <<http://www.currents.net/resources/dictionary>> (listing some common methods in their definition of electronic publication).

43. Sidney A. Rosenzweig, *Don't Put My Article On-line!: Extending Copyright's New-Use Doctrine To The Electronic Publishing Media and Beyond*, 143 U. PA. L. REV. 899, 905 (1995) (citing TONY HENDLEY, CD-ROM AND OPTICAL PUBLISHING SYSTEMS 12 (1987)).

data storage became an important application of CD-ROM technology in 1985.⁴⁴ CD-ROMs gained their popularity because they provide an inexpensive⁴⁵ and consolidated way of storing large amounts of data.⁴⁶ For example, one disc can store a nine volume encyclopedia.⁴⁷

Furthermore, a new form of compact disc is now commercially available, the Digital Video Disc (DVD).⁴⁸ DVDs can store up to thirteen times the amount of information that standard CD-ROMs can hold, permitting storage of even larger amounts of data, such as a full length movie.⁴⁹ This new technology provides a wealth of opportunities for the future of electronic media.⁵⁰

2. On-line Providers/Databases

Like CD-ROMs, computer databases can store collections of information, such as books, articles, maps, and photographs in a digital format.⁵¹ While in the mid-sixties there were under fifty databases, that number exploded to almost 300 databases by the mid-seventies.⁵² Companies such as Reed-Elsevier's LEXIS/NEXIS allow users to remotely retrieve the information contained in their

44. *Id.* (citing HENDLEY, *supra* note 43, at 9).

45. It costs approximately two dollars to manufacture a CD-ROM. See John DeFeo, *Focus on CD-ROMs: The Future of CD-ROM Publishing*, LAW TECH. PROD. NEWS, July 1997, at 42 (discussing the key benefits of CD-ROM technology and its influence on legal research).

46. *Id.*; Fara Daun, *The Content Shop: Toward an Economic Legal Structure for Clearing and Licensing Multimedia Content*, 30 LOY. L.A. L. REV. 215, 223 (1996) (citing Erik Holsinger, *Multimedia 101*, COMPUTER CURRENTS, May 1996, at 33). A standard CD-ROM can hold 650 megabytes of data, which is 464 times larger than a standard floppy disk. *Id.*

47. Roesenzweig, *supra* note 43, at 905 (citing Jean-Loup Tournier, *Authors Rights and New Modes of Exploitation*, 16 COLUM.-VLA J.L. & ARTS 441 (1992)).

48. Rorie Sherman, *Paradigm Shift: Here Come the DVDs*, LAW TECH. PROD. NEWS, Feb. 1997, at 34. Sherman discusses the new successor to CD-ROMs, DVD-ROMs. *Id.* Sherman describes the important role DVD technology will play in the future of storing and presenting digital data. See *Id.*

49. *Id.*

50. *Id.* Sherman notes that DVD-ROM drives are now available for personal computers, and then illustrates how DVD technology permits even grander multimedia presentations than ever before. *Id.*

51. Ballon, *Intellectual Property Protection*, *supra* note 5, at 567; Roesenzweig, *supra* note 43, at 902 (citing ELECTRONIC PUBLISHING - A SNAPSHOT OF THE EARLY 1980S, at 15-16 (Hugh Evison Look ed., 1983); FRAN SPIGAI & PETER SOMMER, GUIDE TO ELECTRONIC PUBLISHING: OPPORTUNITIES IN ON-LINE AND VIEWDATA SERVICES 5-10 (1982)).

52. See Roesenzweig, *supra* note 43, at 902, (citing Tung Yin, *Post-Modern Printing Presses: Extending Freedom of Press to Protect Electronic Information Services*, 8 HIGH TECH. L.J. 311, 315 (1993)); SPIGAI & SOMMER, *supra* note 51, at 3, 24.

databases by using a computer and a modem.⁵³ Although on-line service providers often provide access to their databases, they may also provide access to a variety of other electronic services, such as Internet access, informational services, software, and interactive magazines and newspapers.⁵⁴

Every day these new technologies change the way people work, study and communicate. Our culture has also been greatly influenced by technology from the past. The effects of new and old technology are still visible today, especially in the legal methods employed to protect intellectual property.

B. Technology: Its Relationship with the United States Copyright Act

Since its birth, copyright law has continued to evolve due to technological advances.⁵⁵ The first legal protection afforded authors developed in England in response to Johannes Gutenberg's invention of the printing press.⁵⁶ Parliament enacted the Statute of Anne⁵⁷ that gave authors the exclusive right to create copies of their work for fourteen years.⁵⁸ Similarly, the Framers of the U.S. Constitution desired Congress "to Promote the Progress of Science and the useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries."⁵⁹

53. Ballon, *Intellectual Property Protection*, *supra* note 5, at 567.

54. May Liang, *Intellectual Property and the National Information Infrastructure*, 415 PRAC. L. INST./PAT. 245, 250-60 (1995); Ballon, *Intellectual Property Protection*, *supra* note 5, at 567. A prime example, since 1979 CompuServe Incorporated has offered on-line information services, and in 1996 had over 5.2 million subscribers, earning revenues of nearly \$800 million. Liang, *supra*, at 250; *CompuServe's Annual Report to Stockholders*, <<http://world.compuserve.com/corporate/stockholder/annual/index.asp>> [hereinafter *CompuServe Annual Report*]. CompuServe offers nearly 2000 database and information services. *CompuServe Annual Report*. Each day CompuServe publishes over 10,000 new stories from several news wires. Liang, *supra*, at 250. Additionally, subscribers can electronically shop from a selection of more than 150 stores in their Electronic Mall. *Id.* Amazingly, CompuServe can provide these services to over 90% of the United States population living in areas of 25,000 or more people. *CompuServe Annual Report*.

55. *Sony Corp. v. Universal City Studios, Inc.*, 464 U.S. 417, 430 (1984).

56. *Id.*

57. An Act for the Encouragement of Learning, by vesting the Copies of printed Books in the Authors or Purchasers of such Copies during the Times therein mentioned, 1710, 8 Anne, ch.19. (Eng.), *reprinted in* 8 MELVILLE NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT 7 app. at 7-5 (1990) [hereinafter NIMMER].

58. *See American Geophysical Union v. Texaco, Inc.*, 802 F. Supp. 1, 9 (S.D.N.Y. 1992) (noting that the basis for the United States' copyright law extends back to England and the Statute of Anne).

59. U.S. CONST. art. I, § 8, cl. 8.

Shortly thereafter, the First Congress enacted the Copyright Act of 1790.⁶⁰ Although this Act only protected maps, charts, and books,⁶¹ technological advances soon demanded changes in the Copyright Act. In 1802, Congress amended the Act to include engravings and etchings.⁶² An 1831 revision of the 1790 Copyright Act afforded copyright protection to musical compositions.⁶³ Photographs and negatives became protectable as copyrights in 1865,⁶⁴ and in 1870 Congress finally extended copyright protection to paintings, drawings, chromolithographs and three dimensional works.⁶⁵

In 1909, Congress substantially revised the Copyright Act for what was to be the last major overhaul of the Act for 77 years.⁶⁶ Although the creation of motion pictures forced Congress to amend the 1909 Copyright Act shortly after its inception,⁶⁷ it remained relatively unchanged for many years after the amendment. In 1955 Congress began revising the Copyright Act of 1909;⁶⁸ however, due in part to rapid technological changes,⁶⁹ the revision was not enacted until 1976.⁷⁰ Technology has also incited multiple amendments to the 1976 Act, including: the Semiconductor Chip Protection Act of 1984;⁷¹ the Record Rental Amendment Act of

60. Act of May 31, 1790, ch. 15, 1 Stat. 124 (current version at 17 U.S.C. §§ 101-803).

61. *Id.*

62. Act of Apr. 29, 1802, ch. 36, 2 Stat. 171 (current version at 17 U.S.C. § 102).

63. Act of Feb. 3, 1831, ch. 16, 4 Stat. 436 (current version at 17 U.S.C. §§ 101-803). This was the first of four major revisions to the Copyright Act, beginning in 1831, then 1870, 1909, and 1976. H.R. REP. NO. 94-1476, at 47 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5660.

64. Act of Mar. 3, 1865, ch. 126, 13 Stat. 540 (current version at 17 U.S.C. § 102).

65. Act of July 8, 1870, ch. 230, 16 Stat. 198 (current version at 17 U.S.C. §§ 101-803).

66. Act of Mar. 4, 1909, Pub. L. No. 60-349, ch. 320, 35 Stat. 1 (current version at 17 U.S.C. §§ 101-803).

67. Act of Aug. 24, 1912, Pub. L. No. 62-303, ch. 356, 37 Stat. 488 (current version at 17 U.S.C. § 102).

68. H.R. REP. NO. 94-1476, at 47 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5660.

69. *See* H.R. REP. NO. 94-1476, at 48 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5661 (noting the advances in cable television, as well as the establishment of the National Commission on New Technological Uses of Copyrighted Works (CONTU) to investigate the use of copyrighted works on computers and other information storage systems); *see also* Sony Corp. v. Universal City Studios, Inc., 464 U.S. 417, 430 n.11 (1984) (citing several cases discussing how copyright law changes as technology advances).

70. Act of Oct. 19, 1976, Pub. L. No. 94-553, tit. I, 90 Stat. 2541 (codified as amended at 17 U.S.C. §§ 101-803).

71. Semiconductor Chip Protection Act of 1984, Pub. L. No. 98-620, tit. III, 98 Stat. 3347, 3347-56 (codified at 17 U.S.C. §§ 901-14).

1984;⁷² the Computer Software Rental Amendments Act of 1990;⁷³ the Visual Artists Rights Act of 1990;⁷⁴ the Audio Home Recording Act of 1992;⁷⁵ and the Digital Performance Right in Sound Recordings Act of 1995.⁷⁶

This long history of revision illustrates that lawmakers must keep abreast of technological change, as it often poses unique questions to the law of copyright.⁷⁷ The proposed NII Copyright Protection Act of 1995 would address many of the questions that are now confronting copyright law because of the dynamic nature of the digital world.⁷⁸ However, until Congress issues some steadfast rules, courts must apply the present Copyright Act to resolve these issues.

II. THE UNITED STATES COPYRIGHT ACT OF 1976: BASIC CONCEPTS AND THEIR APPLICATION TO ELECTRONIC PUBLISHING

A. *Copyright Concepts and Rules*

As the United States Supreme Court explains, the basis of copyright law is the balance between two different interests: “[t]he immediate effect of our copyright law is to secure a fair return for an ‘author’s’ creative labor. But the ultimate aim is, by this incentive, to stimulate artistic activity for the general public good.”⁷⁹ Interpretation of the Copyright Act must keep this underlying tenet in consideration whenever technology renders the Act’s terms unclear.⁸⁰

Title 17 of the United States Code codifies the Copyright Act of 1976.⁸¹ In order to qualify for copyright protection, Section 102 of the current Copyright Act requires that an “original work of authorship”⁸² be “fixed in any tangible medium of expression.”⁸³ To

72. Record Rental Amendment Act of 1984, Pub. L. No. 98-450, 98 Stat. 1727 (amending 17 U.S.C. §§ 109, 115).

73. Judicial Improvements Act of 1990, Pub. L. No. 101-650, tit. VIII, 104 Stat. 5089, 5134-37 (amending 17 U.S.C. § 109(b)).

74. Judicial Improvements Act of 1990, Pub. L. No. 101-650, tit. VI, 104 Stat. 5089, 5128-5133 (amending 17 U.S.C. §§ 101, 106, 113, 301, 501(a)).

75. Audio Home Recording Act of 1992, Pub. L. No. 102-563, 106 Stat. 4237 (codified at 17 U.S.C. §§ 1001-10).

76. Digital Performance Right in Sound Recordings Act of 1995, Pub. L. No. 104-39, 109 Stat. 336 (amending 17 U.S.C. §§ 106, 114, 115, 101, 111, 119).

77. See *supra* note 10 for some unique questions currently confronting copyright law.

78. See *supra* notes 12, 13 for a discussion of the changes to the Copyright Act proposed by the NII Copyright Protection Act of 1995.

79. *Twentieth Century Music Corp. v. Aiken*, 422 U.S. 151, 156 (1975).

80. *Id.* (citing *Fortnightly Corp. v. United Artists*, 392 U.S. 390, 395-96 (1968)).

81. 17 U.S.C. §§ 101-1101. Title 17 was enacted by Act of July 30, 1947, ch. 391, 61 Stat. 652.

82. 17 U.S.C. § 102(a). A “work of authorship” is specifically not defined by

be original, a work must not be copied from another source, and it must possess some degree of creativity.⁸⁴ To be fixed, a work must be sufficiently concrete to permit it to be communicated.⁸⁵ Also, a work must not merely be an idea, but the expression of an idea.⁸⁶

Once a work is copyrightable, the owner has the following exclusive rights: (1) to make copies of the work; (2) to make derivative works based on the work; (3) to distribute copies of the work; (4) to publicly perform the work; and (5) to publicly display the work.⁸⁷ These rights are subject to the doctrine of fair use that permits infringement of certain rights where the purpose of the use is for things such as "criticism, comment, news reporting, teaching . . . scholarship, or research."⁸⁸ Additionally, other

the Copyright Act of 1976. H.R. REP. NO. 94-1476, at 55 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5668. The report explains that this phrase is intended to replace the confusion over the prior term, "all the writings of an author." *Id.* Furthermore, the new term reflects Congress' consciousness of developing technologies which provide authors with new mediums of expression. *Id.* This new term is designed to encompass future technologies by neither limiting copyrightable subject matter to 1976 technologies, nor by permitting unrestricted growth into future technologies. *Id.*

83. 17 U.S.C. § 102(a). The Copyright Act of 1976 lists several categories of copyrightable works, including:

- (1) literary works;
- (2) musical works, including any accompanying words;
- (3) dramatic works, including accompanying music);
- (4) pantomimes and choreographic works;
- (5) pictorial, graphic, and sculptural works;
- (6) motion pictures and other audiovisual works;
- (7) sound recordings; and
- (8) architectural works.

Id.

84. *Feist Pubs., Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345 (1991) (citing 1 NIMMER, *supra* note 57, §§ 2.01[A], [B]).

85. 17 U.S.C. § 101; 1 NIMMER, *supra* note 57, §§ 2.03[B][1], [2].

86. 17 U.S.C. § 102(b); 1 NIMMER, *supra* note 57, § 2.03[D].

87. 17 U.S.C. § 106. For works created after January 1, 1978, these rights end 50 years after the author's death, or, for works made for hire, the earlier of 75 years from the date of first publication or 100 years from the date of creation. 17 U.S.C. §§ 302(a), (c). See *infra* notes 101-04 and accompanying text for a discussion of works made for hire and their treatment under the Copyright Act of 1976.

88. 17 U.S.C. § 107. See also H.R. REP. NO. 94-1476, at 65-66 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5678-79 (stating that Section 107 was the first legislation to recognize the important doctrine of fair use); *Religious Tech. Ctr. v. Netcom On-line Comm. Servs., Inc.*, 907 F. Supp. 1361, 1383 (N.D. Cal 1995) (demonstrating the fair use doctrine as a defense in an infringement case). When determining if the fair use defense can be used, courts consider four factors:

- (1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes;
- (2) the nature of the copyrighted work;
- (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and

limitations and exceptions to these exclusive rights are set out in Sections 108 to 120 of the Copyright Act.⁸⁹

The enumerated rights in Section 106 are personal property rights that are both divisible and transferable.⁹⁰ That is, ownership of one stick in the “bundle of rights”⁹¹ can be given to another, while retaining ownership of the remaining exclusive rights.⁹² Ownership of a subdivision of exclusive rights is also transferable.⁹³ To be valid, an exclusive transfer of rights must be in writing and signed by the owner of the rights conveyed.⁹⁴ However, a non-exclusive transfer of rights need not be in writing to be valid.⁹⁵ For example, the author of a story may orally assign the first North American print rights (implying a non-exclusive right to publication),⁹⁶ while preserving ownership of the

(4) the effect of the use upon the potential market for or value of the copyrighted work.

17 U.S.C. § 107.

89. *Id.* § 106.

90. *Id.* § 201(d)(2).

91. The term “bundle of rights” is commonly used to refer to the exclusive rights granted in 17 U.S.C. § 106. *See, e.g.*, H.R. REP. NO. 94-1476, at 61 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5674 (stating that the five basic rights form the “bundle of rights” that is a copyright); *Stewart v. Abend*, 495 U.S. 207, 220 (1990) (stating that copyright owners have a “bundle of exclusive rights” in their work, while discussing whether an assignment of renewal rights in a copyright is nullified when the assignor dies before the time for renewal, and ownership of the copyright transfers to the assignor’s heirs).

92. 17 U.S.C. § 201(d).

93. *Id.* § 201(d)(2).

94. *Id.* § 204(a). *See also* 3 NIMMER, *supra* note 57, § 10.02[B][5] (noting that exclusive licenses must be in writing to be valid); *Imperial Residential Design, Inc. v. Palms Dev. Group, Inc.*, 29 F.3d 581, 583 (11th Cir. 1994) (citing 3 NIMMER, *supra* note 57, § 10.02[B]).

95. 17 U.S.C. § 204. *See also* 3 NIMMER, *supra* note 57, § 10.02[B][5] (stating that many non-exclusive transfers may be exclusively written or orally implied).

96. The right to publish is not a single enumerated right in Section 106, but is a concept which usually comprises the right to reproduce and distribute. 1 NIMMER, *supra* note 57, §§ 4.04, at 4.20, 4.21. *See* 1 NIMMER, *supra* note 57, §§ 4.04-.09 for a more detailed analysis of the term “publication.” A typical freelance agreement grants the right to first publish. *Tasini v. New York Times Co.*, 972 F. Supp. 804, 807 (S.D.N.Y. 1997). The Copyright Act defines a publication as “the distribution of copies or phonorecords of a work to the public by sale or other transfer of ownership, or by rental, lease, or lending.” 17 U.S.C. § 101. A publication occurs when someone proposes “to distribute copies or phonorecords to a group of persons for purposes of further distribution, public performance, or public display.” *Id.* However, a publication does not occur when a public performance or display occurs in isolation. *Id.*; 1 NIMMER, *supra* note 57, § 4.08[A]. The Act clearly indicates that any type of transmission which does not result in a transfer of a material object is not a publication. H.R. REP. NO. 94-1476, at 61 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5674-75.

remaining rights.⁹⁷

In addition to being divisible and transferable, the enumerated rights exist immediately when a work is created in a fixed form.⁹⁸ This copyright protection automatically vests in the creator of the work of authorship.⁹⁹ However, non-authors can claim ownership of a copyright, but they must derive these rights through the author.¹⁰⁰ For example, the 1976 Copyright Act defines a "work made for hire" as "a work prepared by an employee within the scope of his or her employment."¹⁰¹ The Act then grants employers the copyrights in their employees' work product if the definition of "work made for hire" is satisfied.¹⁰² Accordingly, the copyrights for articles that employees contribute are granted to their publishers, unless they explicitly retain the rights in a contract.¹⁰³ Some authors view this as a trade—the copyrights in their work product in exchange for benefits such as health care, a steady salary, and retirement investing.¹⁰⁴

Another copyright concept is that of "collective works."¹⁰⁵ The Copyright Act defines a collective work as "a work, such as a periodical issue, anthology, or encyclopedia, in which a number of contributions, constituting separate and independent works in themselves, are assembled into a collective whole."¹⁰⁶ A collective work is a subset of "compilations," another term having a distinct legal meaning under the Copyright Act.¹⁰⁷

A compilation refers to "a work formed by the collection and

97. Loundy, *Authors Waging Fight*, *supra* note 30, at 6.

98. 17 U.S.C. § 101.

99. *Id.* § 201(a).

100. 1 NIMMER, *supra* note 57, § 5.01[A], at 5-4. See also *Van Cleef & Arpels, Inc. v. Schechter*, 308 F. Supp 674, 676 (S.D.N.Y. 1969) (citing 1 NIMMER, *supra* note 57); *Epoch Producing Corp. v. Killiam Shows, Inc.*, 522 F.2d 737, 743 (2d Cir. 1975) (citing 1 NIMMER, *supra* note 57).

101. 17 U.S.C. § 101. More specifically, the Copyright Act defines a "work made for hire" as:

(1) a work prepared by an employee within the scope of his or her employment; or

(2) a work specially ordered or commissioned for use as a contribution to a collective work, as a part of a motion picture or other audiovisual work, as a translation, as a supplementary work, as a compilation, as an instructional text, as a test, as answer material for a test, or as an atlas, if the parties expressly agree in a written instrument signed by them that the work shall be considered a work made for hire.

Id. See also *supra* note 1 for a discussion distinguishing freelance writers from employees.

102. 17 U.S.C. § 201(b).

103. 1 NIMMER, *supra* note 57, § 5.03[B][1][b], at 5-31.

104. Christina Ianzito, *Who Owns That Online Story?*, 36 COLUM. JOURNALISM REV., May 15, 1997, at 15.

105. 17 U.S.C. § 101.

106. *Id.*

107. *Id.*

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."¹⁰⁸ Compilations are broader than collective works because they can use non-copyrightable works, such as facts or hard data, whereas collective works can only be formed using pre-existing copyrightable works.¹⁰⁹

Derivative works are akin to collective works, because they also use pre-existing, copyrighted works to create new works.¹¹⁰ While collective works combine prior creations without altering them to make a complete new work, derivative works reflect an original contribution to one or more pre-existing creations that transforms or adapts the material into a new work.¹¹¹ Collective works are more similar to derivative works than other types of compilations¹¹² and they both require some degree of originality.¹¹³ Although the necessary amount of originality is comparatively low,¹¹⁴ the editing, arranging or transforming must be more than a "minimal contribution."¹¹⁵

This requirement of originality results in two distinct types of copyright protection afforded to a factual compilation, collective work, or derivative work.¹¹⁶ Copyright protection is granted only to the elements that reflect an original contribution by the compiler or editor.¹¹⁷ Hence, these works reflect the copyrights that individual contributors hold in their works, as well as the compiler or editor's copyright, which protects the editing, arrangement, coordination or selection of the underlying materials.¹¹⁸ Thus, a magazine or newspaper is a compilation, and more precisely, a collective work, because it is made up of copyrighted works by

108. *Id.*

109. *Id.* See also 1 NIMMER, *supra* note 57, § 3.02, at 3-6, 3-7 (commenting that compilations of uncopyrightable works are not of as much legal significance as collective works).

110. 1 NIMMER, *supra* note 57, § 3.02, at 3-7.

111. *Id.* § 3.03, at 3-9. See also *Paramount Pictures Corp. v. Video Broadcasting Sys., Inc.*, 724 F. Supp. 808, 821 (D. Kan. 1989) (quoting 1 NIMMER, *supra* note 57, § 3.03).

112. 1 NIMMER, *supra* note 57, § 3.02, at 3-7.

113. 17 U.S.C. § 101.

114. *Tasini v. New York Times Co.*, 972 F. Supp. 804, 824 (S.D.N.Y. 1997).

115. 1 NIMMER, *supra* note 57, § 3.03, at 3-10. See also *Feist Pubs., Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 348 (1991) (citing 1 NIMMER, *supra* note 57, § 3.03). For example, the legislature has said that combining three one-act plays or adding front matter to a work would not constitute a collective work. H.R. REP. NO. 94-1476, at 122 (1976), reprinted in 1976 U.S.C.A.N. 5659, 5737-38.

116. 1 NIMMER, *supra* note 57, § 3.04[A].

117. *Id.* § 3.04[A], at 3-19.

118. 17 U.S.C. § 201(c). See also 1 NIMMER, *supra* note 57, § 3.04[A] (stating that the copyright protection afforded an owner of a derivative or collective work extends only to those elements that are original to that owner).

freelance authors and photographers. Yet this compilation reflects the publisher's selection and arrangement of those articles and pictures.¹¹⁹

B. Enumerated Rights: Their Role in Electronic Publication

As noted earlier, the digital age has and continues to raise many issues for the 1976 Copyright Act.¹²⁰ Today, the unique nature of computer technology induces such questions as: "Which of the exclusive rights apply to electronic material and its transmission over telephone lines and the Internet?" In their most basic form, computer files are essentially a series of zeros and ones.¹²¹ Computer disks, CD-ROMs or the computer's memory can permanently store this information.¹²² Assuming that a computer file or program represents a work of authorship that is sufficiently original, the file satisfies the requirements of section 102 and is copyrightable because it is sufficiently permanent to be communicated.¹²³

When computers transmit information to other computers, such as on a bulletin board system or the Internet, the physical file itself does not change hands.¹²⁴ Rather, a digital copy is made and sent to the other computer for its use.¹²⁵ Therefore, one could argue that an electronic transmission of proprietary material

119. See, e.g., H.R. REP. NO. 94-1476, at 122 (1976), reprinted in 1976 U.S.C.C.A.N. 5659, 5737-38 (noting examples of collective works, including "periodical issues"). Note, however, that articles incorporated into a periodical which are submitted by employees of the publisher are works made for hire, and as such, are owned by the publisher. 17 U.S.C. §§ 101, 201(b). See *supra* notes 101-04 and accompanying text for a discussion of "works made for hire."

120. See *supra* note 10 and accompanying text for a discussion of recent case law involving novel questions of copyright law due to digital technology.

121. Technically speaking, this is known as binary code. Andrea Sloan Pink, *Copyright Infringement Post Isoquantic Shift: Should Bulletin Board Services Be Liable?*, 43 UCLA L. REV. 587, 588 n.5 (1995); *White Paper*, *supra* note 10, at 27.

122. See *supra* notes 43-54 and accompanying text for a summary of the technical principles involved in this process.

123. See *White Paper*, *supra* note 10, at 38-41 (discussing the fixation of digital data). A computer program stored in ROM is a "work of authorship." *Tandy Corp. v. Personal Micro Computers, Inc.*, 524 F. Supp. 171, 173 (N.D. Cal. 1981); *Apple Computer Inc. v. Franklin Computer Corp.*, 714 F.2d 1240, 1246-48 (3d Cir. 1983). For a detailed discussion on why digital data is a protectable "work of authorship," see Maureen A. O'Rourke, *Proprietary Rights in Digital Data: The Future of Copyright and Contract Law in a Networked World*, 41 FED. B. NEWS & J. 511, 512-14 (1994). This article discusses why digital data can satisfy the Copyright Act's requirements. *Id.*

124. Jane C. Ginsburg, *Putting Cars on the "Information Superhighway": Authors, Exploiters, and Copyright in Cyberspace*, 95 COLUM. L. REV. 1466, 1476 (1995).

125. Ginsburg, *supra* note 124, at 1476. See also *White Paper*, *supra* note 10, at 68-70 (referring to the CONTU Final Report which listed several situations where digital copies are made).

involves the right of reproduction since a digital copy is made.¹²⁶ If a work is made available to the public, such as on a BBS or the Internet, the right of distribution is also implied.¹²⁷ Less clear is the implication that the right to publicly perform and the right to display are components of digital transmission.¹²⁸ The NII Copyright Protection Act of 1995 directly addresses these issues; however, both the House and Senate are still considering the legislation.¹²⁹

Understanding the basic laws of copyright and the nature of electronic transmission permits a discussion of the illustrative case *Tasini v. New York Times Co.*, involving the right to electronically publish magazines and newspapers containing the work of freelance authors.¹³⁰

III. *TASINI v. NEW YORK TIMES CO.*: PRESENTING NEW QUESTIONS FOR THE COPYRIGHT ACT OF 1976

All of the plaintiffs in this case of first impression are freelance authors.¹³¹ The defendants, New York Times and

126. *White Paper*, *supra* note 10, at 68-70; Ginsburg, *supra* note 124, at 1476-80;

127. *White Paper*, *supra* note 10, at 71-74; Ginsburg, *supra* note 124, at 1481-83.

128. *White Paper*, *supra* note 10, at 74-77; Ginsburg, *supra* note 124, at 1479-81. Ginsburg suggests that the right to display and the right to publicly perform are components of a digital transmission because the definition of these rights, on its face, appears to encompass a digital file made available to the public. *Id.* at 1479-80. A public performance or display of a work is defined as:

(1) to perform or display it at a place open to the public or at any place where a substantial number of persons outside of a normal circle of a family and its social acquaintances is gathered; or

(2) to transmit or otherwise communicate a performance or display of the work to a place specified by clause (1) or to the public, by means of any device or process, whether the members of the public capable of receiving the performance or display receive it in the same place or in separate places and at the same time or at different times.

17 U.S.C. § 101.

129. See *supra* note 12 for a discussion of the NII Copyright Protection Act of 1995.

130. 972 F. Supp. 804 (S.D.N.Y. 1997). The case originally began with eleven plaintiffs and six defendants. *Id.* When the case was decided, only six plaintiffs and five defendants remained. *Id.* See also Ross Kerber, *Atlantic Monthly Agrees to Settle Action over Electronic Publishing*, WALL ST. J., Mar. 29, 1996, at B6 (discussing the settlement of one of the original plaintiffs in the *Tasini* case).

131. For biographies of the plaintiffs, see generally <<http://www.nwu.org/nwu/tvt/tvtbios.htm>>. Jonathan Tasini is president of the National Writers Union (since 1990), and has contributed work to such publications as *Business Week*, *The Washington Post*, and *The Wall Street Journal*. *Id.* Mary Kay Blakely has written critically acclaimed books, as well as articles for *Vogue* and *The New York Times Book Review*. *Id.* Barbara Garson has written plays, books,

Newsday, publish newspapers, while defendant Time Inc. (Time) publishes the popular magazine, *Sports Illustrated*.¹³² These defendant publishers also sell the content of their publications for electronic publication to University Microfilms Inc. (UMI) and The MEAD Corporation (MEAD),¹³³ who operated the electronic database LEXIS/NEXIS (NEXIS).¹³⁴ UMI makes and distributes two CD-ROM products, "The New York Times OnDisc," and "General Periodicals OnDisc."¹³⁵ The first is text based and searchable, much like the database LEXIS/NEXIS, while the latter provides both the text and the images from the original periodicals.¹³⁶

All of the *New York Times* articles in question were orally agreed upon, with no written contract.¹³⁷ Similarly, the *Newsday* articles were orally agreed upon, with the exception that the checks given to the authors included an endorsement stating that acceptance of the check granted the right to include the work in electronic library archives.¹³⁸ The article involved in *Sports Illustrated* was expressly contracted for, but contained no language clearly allocating electronic publication rights.¹³⁹

The publications that NEXIS used are dissimilar from their print versions. NEXIS stores the publications in computer files, each containing only the text of the article, the author's name, the publication, the issue and the page where the article appeared.¹⁴⁰ Original formatting, such as page layout, advertising, and photographs are eliminated in the digital version.¹⁴¹ NEXIS shares these files with UMI, who then produces the "New York Times OnDisc."¹⁴² Both allow Boolean searching and generally retrieve

and articles for many national publications. *Id.* Margot Mifflin regularly contributes articles to such publications as *Entertainment Weekly*, *The Village Voice*, and *The Wall Street Journal*. *Id.* Sonia Jafe Robbins is an adjunct professor of journalism at New York University and also writes book reviews. *Id.* David Whitford has authored several books and is currently a senior writer at *Inc.* magazine. *Id.*

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

133. In October of 1994, after the alleged infringement occurred, MEAD Data sold LEXIS/NEXIS to Reed Elsevier for \$1.5 billion. Compiled from NLJ staff and Associated Press Reports, *Reed Elsevier to Buy Mead Corp.'s LEXIS*, NAT'L L.J., Oct. 17, 1994, at B2.

134. *Tasini*, 972 F. Supp. at 806.

135. *Id.*

136. *Id.*

137. *Id.* at 807.

138. *Id.*

139. *Tasini*, 972 F. Supp. at 807.

140. *Id.* at 808.

141. *Id.*

142. *Id.* The "New York Times OnDisc" is created pursuant to an agreement between the New York Times, NEXIS, and UMI, which permits NEXIS to send their text-only files to UMI, who then transfers the information to CD-ROMs. *Id.*

individual articles from a multitude of different publications.¹⁴³ However, subscribers can use search restrictions to retrieve all of the articles from one issue of a publication.¹⁴⁴

"General Periodicals OnDisc" differs from the previous two methods of electronic publication.¹⁴⁵ Here, the creators do not use the original computer files, instead, they scan the entire publication into digital format.¹⁴⁶ This permits exact reproduction of the publication, in the sense that the pictures, advertisements and page layout are duplicated into the digital form.¹⁴⁷ Moreover, these CD-ROMs are not searchable.¹⁴⁸ UMI sells searchable abstracts of the articles separately for use with the "General Periodicals OnDisc."¹⁴⁹

Both the freelance authors and the print and electronic publishers filed motions for summary judgment.¹⁵⁰ The plaintiffs claimed that the defendants' use of their articles was in violation of their individual copyrights, and not permitted under Section 201(c) of the Copyright Act, which states:

Copyright in each separate contribution to a collective work is distinct from copyright in the collective work as a whole, and vests initially in the author of the contribution. In the absence of an express transfer of the copyright or of any rights under it, the owner of copyright in the collective work is presumed to have acquired only the privilege of reproducing and distributing the contribution as a part of that particular collective work, *any revision of that collective work*, and any later collective work in the same series.¹⁵¹

The defendants asserted that all of the electronic publication constituted permissible revisions of their collective works under section 201(c).¹⁵²

143. *Id.* In this transfer, UMI also codes the articles, making it easier to perform Boolean searches. *Id.* The search processes for the NEXIS database and the New York Times OnDisc are very similar. *Id.*

144. *Tasini*, 972 F. Supp. at 808. The scope of items such as date, author, and publication can be restricted or limited during searches on NEXIS. STEVEN L. EMANUEL, *LEXIS-NEXIS FOR LAW STUDENTS* 2-24 (2d ed. 1995).

145. *Tasini*, 972 F. Supp. at 808-09.

146. *Id.* at 808.

147. *Id.* at 808-09.

148. *Id.* at 809.

149. *Id.*

150. *Tasini*, 972 F. Supp. at 806. These motions indicate that the parties agreed to the facts as pleadand that no material issue of fact existed. *Id.* at 806.

151. *Id.* at 809 (citing 17 U.S.C. § 201(c)) (emphasis added).

152. *Tasini*, 972 F. Supp. at 809. Time and Newsday also argued that electronic publication rights were expressly granted to them. *Id.* Time asserted that the language "first publication rights" in their contract included first electronic publication. *Id.* Newsday further contended that the language on the check indicating the right to use the plaintiffs' article in electronic library archives was clearly a transfer of electronic publication rights. *Id.* The

Unfortunately, there are no cases that have interpreted this section in light of digital technology, and very little case law interpreting section 201(c) at all.¹⁵³ Legislative history and analogies to factual compilations and derivative works¹⁵⁴ are all that are available to provide guidance in resolving the issue.¹⁵⁵

To begin, section 201(c) permits the copyright owner of a collective work to *reproduce and distribute* that work and revisions of that work.¹⁵⁶ The plaintiffs argued that the absence of display rights in the statute precludes the right to electronically publish since computers require that the work be “displayed” on the computer screen.¹⁵⁷ The court dismissed this argument, concluding that the right to reproduce implies the right to display.¹⁵⁸ Reproductions create copies,¹⁵⁹ which section 101 defines as “material objects, other than phonorecords, in which a work is fixed by any method now known or later developed, and from which the work can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device.”¹⁶⁰ Therefore, the right to create copies includes the right to use a computer to “display” the copies on a computer screen, and the lack of the explicit right to display publicly is not fatal to the defendants’ defense of permissible revision.¹⁶¹

court dismissed Time and Newsday’s argument that electronic publication rights were expressly transferred. *Id.* at 810. Newsday had sent the computer files to NEXIS before the plaintiffs had even received their checks, let alone sign them. *Id.* Thus, the lack of a valid signed agreement results in no express transfer. *Id.* Newsday continued by asserting that “a note or memorandum” of transfer can validate prior verbal agreements, but later conceded that there was no evidence of any prior oral agreements. *Id.* at 810-11. Moreover, since Newsday maintains their own electronic archive of articles, and do not use it commercially, the language on the check could not be reasonably interpreted to mean NEXIS’s database over Newsday’s own database. *Id.* Additionally, Judge Sotomayor quickly disposed of Time’s argument by simply stating that “the right to publish an article ‘first’ cannot reasonably be stretched into a right to be the first to publish an article in any and all mediums [*sic*].” *Id.* at 812. The article was first published in print, therefore, any electronic publication was not a “first” publication. *Id.*

153. *Id.* at 812.

154. See *supra* notes 105-19 and accompanying text for a discussion of compilations and derivative works, and their relation to collective works.

155. *Tasini*, 972 F. Supp. at 812.

156. 17 U.S.C. § 201(c) (emphasis added).

157. *Tasini*, 972 F. Supp. at 816.

158. *Id.* at 817.

159. See *id.* (citing 17 U.S.C. §§ 101, 106).

160. *Tasini*, 972 F. Supp. at 816 (citing 17 U.S.C. § 101).

161. *Id.* This argument alludes to a similar argument which the plaintiffs did not raise: section 201(c)’s failure to grant any right to publicly perform the collective work precludes the defendant’s use of the articles in electronic publishing. See *supra* notes 126-28 and accompanying text for a discussion of the enumerated rights implied in electronic publication. Some argue that communication and “display” of computer files involves the right of public

The plaintiffs also disputed the broadness of the term "revision," contending that a revision must be "nearly identical to an original."¹⁶² The court responded by comparing the term "revision" to its meaning in the definition of derivative works.¹⁶³ As noted earlier, a contribution can undergo an "editorial revision" to become a derivative work.¹⁶⁴ Judge Sotomayor then drew the conclusion that if Congress gave the term "editorial revision" the large effect of creating a new and copyrightable work, the term "any revision" in section 201(c) implies a greater opportunity for large changes to a work.¹⁶⁵ Although the validity of this logic is questionable,¹⁶⁶ the court found that the term "any revision" encompassed a wide range of permissible change.¹⁶⁷

Although the term "any revision" may permit large alterations to a collective work, the language, "any revision of *that* collective work," dictates a specific limitation on the word "revision".¹⁶⁸ This requires that the original work is recognizable in a revision of the original work.¹⁶⁹ Furthermore, since revision of the individual contributions is not permitted, only the selection, coordination or arrangement may be altered.¹⁷⁰ Hence, to be valid, a revision of a collective work must keep some degree of its originality to permit the recognition that it is a revision of the original.¹⁷¹ However, the amount of originality a collective work requires is rather minimal, so owners of collective works must use

performance because of its definition, which suggests that transmitting the digital rendition of an article to any member of the public who pays a fee, and displaying that work by means of a computer is a public performance. Ginsburg, *supra* note 124, at 1479-80. The fact that different people display the article on their computer at different times does not make placing the article on a database any less of a public performance. *Id.* Not only does the absence of any express grant of display or public performance rights indicate that the electronic revision here is improper, it implies that § 201(c) is ill equipped to deal with the issues technology raises in connection with electronic publication. *Id.*

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

163. *Id.* at 817. See *supra* notes 110-19 and accompanying text for a discussion of derivative works.

164. See *Tasini*, 972 F. Supp. at 817 (citing 17 U.S.C. § 101) (discussing the change to a derivative work).

165. *Tasini*, 972 F. Supp. at 817-18. As Judge Sotomayor notes, a derivative work must still "borrow substantially" from the contribution(s). *Id.* at 819 n.10 (citing *Eden Toys v. Florelee Undergarment Co.*, 697 F.2d 27, 34 (2d Cir. 1982)).

166. See *supra* notes 162-65 and accompanying text for a discussion of the meaning of the term "any revision."

167. *Tasini*, 972 F. Supp. at 819.

168. *Id.* at 819-20 (emphasis added).

169. *Id.*

170. *Id.* at 820.

171. *Id.*

caution since they have little with which to work.¹⁷²

Thus, the plaintiffs argued that the electronic versions of the publications retained no originality from the collective works.¹⁷³ Pictures, page formatting, and article arrangement were all lost in the electronic versions.¹⁷⁴ Moreover, the electronic search techniques generally retrieve individual articles rather than the publication as a whole.¹⁷⁵ The defendants store the individual articles in files among vast quantities of other files.¹⁷⁶ Thus, the plaintiffs complained that the defendants failed to permissibly revise their collective works and allowed the authors' individual articles to be exploited.¹⁷⁷

The court rejected this argument by first noting that the electronic revisions included at the head of each article, its author, publication, issue, and page number, all indicated where the article had first appeared.¹⁷⁸ This permitted users to recognize that they were viewing an article that had previously been published in print.¹⁷⁹ The court also illustrated that although the arrangement and coordination were lost, the defendants had retained their original selection of articles in the revised collective work.¹⁸⁰ The court concluded that since: (1) Congress intended the term "any revision" to encompass a large amount of change; (2) the defendants retained some minimal originality of the collective work (the selection); and (3) the revision could be identified with its predecessor, the electronic revisions in question were permissible revisions under section 201(c).¹⁸¹

The court further supported its position by comparing its analysis to the analysis prescribed by the U.S. Supreme Court in compilation infringement cases.¹⁸² Relying particularly on *Key Publications, Inc. v. Chinatown Today Publishing Enterprises, Inc.*,¹⁸³ the court noted that when a compilation satisfies the originality requirement utilizing both selection and arrangement, a subsequent work that copies either the selection or the arrangement is "substantially similar" to the compilation and therefore infringing.¹⁸⁴ The court then applied this reasoning used in compilation infringement cases to revisions of collective

172. *Tasini*, 972 F. Supp. at 821.

173. *Id.* at 821.

174. *Id.*

175. *Id.*

176. *Id.*

177. *Tasini*, 972 F. Supp. at 821.

178. *Id.* at 824.

179. *Id.*

180. *Id.*

181. *Id.* at 824-25.

182. *Tasini*, 972 F. Supp. at 825.

183. 945 F.2d 509, 514 (2d Cir. 1991).

184. *Tasini*, 972 F. Supp. at 825 (citing *Key Pubs., Inc.*, 945 F.2d at 514).

works.¹⁸⁵ According to the court, if a revision under section 201(c) retained either the original selection or the original arrangement, it was “substantially similar” to the original as a matter of law.¹⁸⁶ Therefore, the electronic revisions in dispute were “substantially similar” to their respective collective works because they retained the selection of articles.¹⁸⁷ This lends support to the conclusion that the electronic publications were permissible revisions under section 201(c).¹⁸⁸

The court clearly indicated it was not espousing a fixed rule to evaluate permissible revisions under section 201(c) by comparing the situation to compilation infringement.¹⁸⁹ Nonetheless, the court found in the defendants’ favor, upholding their right to revise collective works for electronic publication.¹⁹⁰ The opinion also notes that the right to revise collective works was not perceived to have much economic value in 1976 when the Copyright Act was enacted, but technology has made this right very valuable.¹⁹¹ The court recognized that its holding “deprived plaintiffs of certain important economic benefits associated with their creations,” and claimed the fault was not in the interpretation of the Copyright Act, but rather due to publishing and technological changes.¹⁹²

In conclusion, the court pointed to the legislature, stating that “if Congress agrees with plaintiffs that, in today’s world of pricey electronic information systems, Section 201(c) no longer serves its intended purposes, Congress is of course free to revise that provision to achieve a more equitable result.”¹⁹³

185. *Id.*

186. *Id.*

187. *Id.*

188. *Id.*

189. *Tasini*, 972 F. Supp. at 825.

190. *Id.* at 825-27.

191. *Id.* at 826-27.

192. *Id.*

193. *Id.* On September 3, 1997, the plaintiffs filed a motion for reconsideration with the District Court. *Tasini v. New York Times Co.* 981 F. Supp. 841, 843 (S.D.N.Y. 1997). The court upheld its earlier decision on all grounds. *Id.* Among their objections, plaintiffs claimed that there was a disputed question of fact as to whether the electronic revisions were “substantially similar” and permissible section 201(c) revisions. *Id.* at 848-50. The court stated that when it has been shown that an original selection of articles was copied into the revision, “it is appropriate for a court considering a motion for summary judgment to determine—as a matter of law— that a substantial similarity exists,” because the “ordinary observer” test usually used in infringement cases ignores the special situation in the compilation context. *Id.* at 849.

IV. THE *TASINI* CASE AND SECTION 201(C): ALTERNATIVE INTERPRETATIONS AND SOLUTIONS

On its face, the decision in *Tasini v. New York Times Co.* seems clear and accurate. However, beneath this decision lies many questionable interpretations of the Copyright Act which affected the outcome of the case. First, the *Tasini* court's analogy between infringing compilations and revisions of collective works is debatable.¹⁹⁴ The *Tasini* court stressed that the defendants retained the original selection of articles, and gave this great importance in its decision.¹⁹⁵ Although the selection of articles may account for the commercial success of a periodical, the Copyright Act protects each original element the compiler contributes to a collective work.¹⁹⁶ When an infringing compilation copies a significant part of one element (i.e., the selection or arrangement) the law says it is copyright infringement and calls the infringing work "substantially similar."¹⁹⁷ In *Tasini*, however, the question is different, it is: Did the revision retain enough of the *all* contributed elements that originally made the periodical a collective work?¹⁹⁸ When a revision does not retain the elements of article arrangement, advertisement arrangement, or photograph arrangement, retaining the selection of articles is merely keeping one element out of many that contributed to the copyrightability of a periodical. Moreover, the entire selection was not even retained in this case: the selection of advertisements and photographs were omitted. Even though a revision may be "substantially similar" in an infringement context, the same does not necessarily hold true in the context of a section 201(c) revision.¹⁹⁹

194. See *supra* notes 182-89 and accompanying text for the *Tasini* court's discussion of the analogy between infringing compilations and revision of collective works under section 201(c).

195. *Tasini*, 972 F. Supp. at 823. Judge Sotomayor went so far as to say "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." *Id.*

196. 17 U.S.C. § 103(b). See also 1 NIMMER, *supra* note 57, § 3.04[A] (citing *Durham Indus., Inc. v. Tomy Corp.*, 630 F.2d 905 (2d Cir. 1980); *Eden Toys, Inc. v. Florelee Undergarment Co.*, 526 F. Supp. 1187 (S.D.N.Y. 1981)).

197. *Tasini*, 972 F. Supp. at 825 (citing *Key Pubs., Inc. v. Chinatown Today Publ'g Enters., Inc.*, 945 F.2d 509, 514 (2d Cir. 1991)).

198. See *infra* note 201 for a more complete discussion of this question.

199. To further illustrate the point, suppose the total originality reflected in a collective work can be broken into 50% for selection and 50% for arrangement. When another work copies a substantial portion of the selection and differs in arrangement, the second work still infringes the collective work and is "substantially similar" as a matter of law. If a revision of the collective work also retains a substantial portion of the selection and eliminates the arrangement, the *Tasini* court would say the revision is "substantially similar." However, the revision of the collective work would retain less than 50% of the originality that permitted the collective work to be copyrighted in

Additionally, the court's interpretation of the term "any revision" was critical to its finding that the defendants, by retaining the original selection of *articles* and inserting front matter, published permissible revisions of their periodicals.²⁰⁰ The court drew the conclusion that if Congress had given the term "editorial revision" the power to create a new and copyrightable work, then the term "any revision" implied a greater opportunity for change.²⁰¹ Extending this argument, however, indicates that the degree of change in a permissible revision under section 201(c) could reach an extent where a derivative work is formed, based on the collective work. Thus, under this analysis, section 201(c) has the potential to grant the copyright holder of a collective work ownership of a new derivative work if sufficiently revised. Yet this new copyright would exist without the original contributors' consent, a paradox which Congress could not have intended.²⁰²

the first place. Thus, the small amount of originality kept in the revision could hardly be called "substantial." Additionally, the standard for retaining a substantial portion has been called copying more than a "certain percentage" of an original element in the compilation infringement context. *Tasini*, 972 F. Supp. at 823. The court in *Worth v. Selchow & Richter Co.*, 827 F.2d 569 (9th Cir. 1987) relied upon *Litchfield v. Spielberg*, 736 F.2d 1352 (9th Cir. 1984), to establish the recognized standard for "substantial similarity" between infringing compilations. *Worth*, 827 F.2d at 572. This standard is known as the "intrinsic" test and asks "whether 'an ordinary reasonable person' . . . would find that the 'total concept and feel' of the works showed substantial similarity." *Id.* Since the alleged infringing compilation did not copy the arrangement and only partially copied the selection, the court found that there was not a "substantial similarity." *Id.* at 573. The court, when comparing the similarities together to the combined dissimilarities, and evaluating the overall "concept and feel," declared that there was not enough similarity. *Id.*

200. See *supra* notes 162-67 and accompanying text for a discussion of the court's interpretation of "any revision."

201. *Tasini*, 972 F. Supp. at 819. As Judge Sotomayor notes, a derivative work must still "borrow substantially" from the contribution(s). *Id.* at 819 n.10 (citing *Eden Toys v. Florelee Undergarment Co.*, 697 F.2d 27, 34 (2d Cir. 1982)).

202. 1 NIMMER, *supra* note 57, §§ 3.04[A], 3.05, 3.06. The right to prepare derivative works is an enumerated right granted by section 102. 17 U.S.C. § 102. Congress did not grant this right in section 201(c), it granted only the rights to reproduce and distribute. *Id.* § 201(c). If Congress desired to grant collective work owners the right to prepare derivative works, it could have expressly done so, rather than relying on the term "any revision" to grant such a right. Furthermore, it is sound principle that:

[t]he aspects of a derivative work added by the derivative author are that author's property, but the element drawn from the pre-existing work remains on grant from the owner of the pre-existing work. So long as the pre-existing work remains out of the public domain, its use is infringing if one who employs the work does not have a valid license or assignment for use of the preexisting work. It is irrelevant whether the pre-existing work is inseparably intertwined with the derivative work.

Stewart v. Abend, 495 U.S. 207, 233-34 (1990) (citations omitted). Since the owner of a collective work who derives his or her rights through section 201(c)

Moreover, technological advances in the search capabilities which NEXIS and "New York Times OnDisc" use further indicate that the electronic publication here was not a permissible revision under section 201(c). Individual articles are more likely to be retrieved than a complete list of articles from a single publication.²⁰³ The text of one, or even a few articles from one periodical does not reflect the arrangement of articles, advertisements, and photographs, nor does it reflect the selection of a group of articles. A user of these systems sees the work and creativity of an individual author, and at best must imagine the majority of original elements contributed by the publisher of a periodical.²⁰⁴

The amount of originality retained by defendants in this case, particularly in the light of digital technology, was insufficient to warrant the court's finding of a permissible revision under section 201(c) of the Copyright Act. The *Tasini* court's interpretation of the term "any revision" undermines the foundation of its finding, and indicates that Congress intended a stricter interpretation of the term. Merely retaining an original selection of articles and allowing those articles to be accessed individually cannot satisfy a stricter standard of permissible revision. While the "General Periodicals OnDisc" would nonetheless appear to be a permissible revision since it retained both the selection and arrangement of *all* the underlying copyrighted works, the "New York Times OnDisc" and NEXIS, in transforming the periodicals, kept an insufficient amount of original elements to retain the status of a protectable collective work.

The uncertainty digital technology causes in determining what qualifies as a permissible revision indicates that Congress must clarify the language in section 201(c). Congress simply could not have foreseen in the 1970s that the computer technology of the 1990s would permit collective works to be broken into their

would not have a valid license or assignment to use the contributors' work in preparing derivative works, interpreting the term "any revision" to include this enumerated right would be inconsistent with the Copyright Act.

203. *Tasini*, 972 F. Supp. at 821.

204. These technologies result in users viewing individual articles on a computer screen, and printing out copies of individual articles. It is clear that neither Congress nor the *Tasini* court would allow publishers to distribute hard copies of individual articles, even if photocopied directly from the original periodical. In fact, print publishers have a history of complaining about the individual photocopying of their copyrighted materials. 2 GOLDSTEIN, COPYRIGHT, § 5.2.2, at 5:45 n.117 (2d ed. 1996) (citing U.S. Copyright Office, *The Report of the Register of Copyrights, Library Reproduction of Copyrighted Works* (17 U.S.C. § 108) (1983), which gives an account of this history). In a recent example, *American Geophysical Union v. Texaco Inc.*, a group of publishers prevailed in their claim of copyright infringement against Texaco for permitting its researchers to photocopy eight individual articles. 60 F.3d 913 (2d Cir. 1994).

individual parts and distributed so easily to users.²⁰⁵ Congress recognized its inability to see into the extended future and wrote the 1976 Copyright Act with a media-neutral approach in mind.²⁰⁶ Copyrights should be protected whether a work is in print, microfilm, motion picture, or computer file.²⁰⁷ Likewise, a revision under section 201(c) should be permitted to change mediums.²⁰⁸ However, when the nature of new media makes terms of the Copyright Act ambiguous, the Act must be interpreted with its most basic and important principles in mind.²⁰⁹

Therefore, Congress should revise the term "any revision" in section 201(c) of the Copyright Act, whereby a standard is set for the amount of originality that must be retained in a revision of a collective work. A revision by a collective work owner must be "substantially similar" and retain a "certain percentage" of every contributed element.²¹⁰ Additionally, a permissible revision under section 201(c) cannot result in the formation of a new derivative work. These suggestions follow the basic purpose of copyright law by balancing the right of collective work owners to explore new media, yet setting reasonable standards for the degree of change permitted when revising a collective work in the same or a new medium, thus protecting the authors' rights.²¹¹

While the proposed NII Copyright Act of 1995 indirectly addresses some of the issues involved in *Tasini*,²¹² publishers and freelance authors must proceed until Congress or courts offer further guidance. Freelance authors must be aware of the legal ramifications when contracting with publishers. Since section 201(c) only applies in the absence of express language allocating the rights in collective works,²¹³ authors can protect themselves by

205. *Tasini*, 972 F. Supp. at 826-27 (citing Arthur R. Miller, *Copyright Protection For Computer Programs, Databases, And Computer Generated Works: Anything New Since CONTU?*, 106 HARV. L. REV. 977, 979 (1993)) (stating that "Congress was aware of such technologies, but did not fully understand their implications . . .").

206. *Tasini*, 972 F. Supp. at 825 (citing Register's Report on the General Revision of the U.S. Copyright Law (1961), included in 5 NIMMER, *supra* note 57, 14 app. at 14-8; *Copyright Law Revision: Hearing on H.R. 4347, 5680, 6831, 6835 Before Subcommittee No. 3 of the House Committee on the Judiciary*, 89th Cong. 57 (1965)). See also *supra* note 82 for a discussion of a "work of authorship."

207. *Tasini*, 972 F. Supp. at 818.

208. *Id.* at 817-18.

209. See *supra* notes 79-80 and accompanying text for a discussion of an interpretation of the Copyright Act.

210. See *supra* note 199 for more information on these standards.

211. "General Periodicals OnDisc" would satisfy this standard since every original element of the collective work is retained in the revision. Moreover, the lack of direct searchability precludes the exploitation of individual articles.

212. See *supra* notes 12-13 for a discussion of the NII Copyright Act of 1995.

213. 17 U.S.C. § 201(c). See *supra* text accompanying note 151 for the exact language of section 201(c).

retaining the electronic publication rights of their articles in their contracts. To combat the unequal bargaining power between lone authors and large publishers, the National Writers Union has created the Publication Rights Clearinghouse (PRC).²¹⁴ PRC is a collective licensing agency that aids authors in receiving royalties for the electronic publication of their articles.²¹⁵ By seeking legal advice and participating in collective licensing agencies, freelance authors can gain some protection from the unauthorized electronic publication of their works.

CONCLUSION

Changes in technology have raised, and continue to raise, unique issues for copyright law, computer and communications technology being no exception. The *Tasini* case illustrates some of these issues in the context of electronic publication. Unfortunately, while the court's interpretation of the Copyright Act is highly questionable, it is an important first step in clarifying the new issues raised by electronic publication. Regardless, the United States Copyright Act has evolved to keep pace with changing technology, and will continue to do so in the future. Until Congress and future case law provide further guidance, freelance authors and publishers must operate within the current framework of the law to provide their own solutions.

214. Irvin Munchnick, *Protecting Writers' Rights On-line*, 13 MACWORLD No. 7, July 1, 1996, at 236; National Writers Union, *The Publication Rights Clearinghouse the National Writers Union Solution* (last modified Aug. 14, 1997) <<http://www.nwu.org.nwu/tvt/tvtprc.htm>>.

215. Munchnick, *supra* note 214 at 236; National Writers Union, *supra* note 214. The Publication Rights Clearinghouse is very similar to the music industry's American Society of Composers, Authors and Publishers (ASCAP). *Id.* UnCover, the world's largest database of periodical articles, provides a fax reprint service and became PRC's first licensee. *Id.* PRC made its first royalty distribution in May 1996 to a group of authors, totaling \$15,000. *Id.* For more information on the National Writers Union and PRC, visit their web site at <<http://www.nwu.org/>>. For more information relating to the legal principles important when contracting proprietary materials, see Jerry S. Birenz, *Some Practical New Media Issues of Which Publishing Lawyers Should Be Aware*, 480 PLI 309 (1997) and The National Writers Union, *Statement of Principles on Contracts Between Writers and Electronic Book Publishers* (visited Sept. 8, 1997) <http://www.eff.org.pub/IntellectualProperty/Legal/epub_contract.principles>.