

CASE NO. 00-10510-C

IN THE UNITED STATES COURT OF APPEALS  
FOR THE ELEVENTH CIRCUIT

**JERRY GREENBERG and IDAZ GREENBERG,**

Plaintiffs/Appellants,

v.

**NATIONAL GEOGRAPHIC SOCIETY**, a District of  
Columbia Corporation, **NATIONAL GEOGRAPHIC  
ENTERPRISES, INC.**, a corporation, and  
**MINDSCAPE, INC.**, a California Corporation,

Defendants/Appellees.

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On Appeal from the United States District Court  
for the Southern District of Florida

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**BRIEF OF AMICI CURIAE, MAGAZINE PUBLISHERS  
OF AMERICA, INC., NEWSPAPER ASSOCIATION OF  
AMERICA, INC., GANNETT CO., INC., HACHETTE  
FILIPACCHI MAGAZINES, INC., THE NEW YORK  
TIMES COMPANY, TIME INC., TIMES MIRROR CO.,  
AND TRIBUNE COMPANY SUPPORTING DEFENDANTS/  
APPELLEES AND AFFIRMANCE OF THE DECISION BELOW**

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**CERTIFICATE OF INTERESTED PERSONS AND  
CORPORATE DISCLOSURE STATEMENT**

In accordance with Federal Rule of Appellate Procedure 26.1, amici hereby identify themselves; their parent corporations; and all publicly held companies owning 10% or more of their stock:

**Magazine Publishers of America, Inc.** states that it has no parent companies and no publicly held company owns 10% or more of its stock.

**Newspaper Association of America, Inc.** states that it has no parent companies and no publicly held company owns 10% or more of its stock.

**Gannett Co., Inc.** states that it has no parent companies and no publicly held company owns 10% or more of its stock.

**Hachette Filipacchi Magazines, Inc.** states that it is a wholly-owned subsidiary of **Hachette Filipacchi Medias** which is a subsidiary of **Lagardere Group**, a publicly-traded French company.

**The New York Times Company** states that it has no parent companies and no publicly held company owns 10% or more of its stock.

**Time Inc.** states that it is a wholly-owned subsidiary of **Time Warner Inc.**, a public company. Time Inc. has no publicly held subsidiaries. Time Warner Inc. holds interests in the following publicly held companies: **JTS Corporation; USA Networks, Inc.;** and **FortuneCity.com.**

**Times Mirror Co.** states that it has no parent companies and that **Newsday, Inc.** is its subsidiary. Approximately 40% of its stock is owned by **Tribune Company.**

**Tribune Company** states that it has no parent companies and no publicly held company owns 10% or more of its stock.

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**IDENTIFICATION OF AMICI CURIAE AND  
STATEMENT OF INTEREST AND AUTHORITY TO FILE**

*Amicus* Magazine Publishers of America, Inc. is a nonprofit corporation and is the principal trade association for the consumer magazine industry in the United States, representing approximately 200 publishers and more than 1,200 magazines. *Amicus* Newspaper Association of America, Inc. is a nonprofit corporation and is the principal trade association for newspaper publishers, representing more than 1,500 newspapers across the United States. All of the other *amici* are publishing firms which together publish hundreds of magazines, newspapers and newsletters on a wide variety of subjects covering general and special interests of all kinds.

*Amici* agree with the principal arguments advanced by the National Geographic Society and National Geographic Enterprises, Inc. ("the Society") and Mindscape, Inc. in their dispute with Jerry and Idaz Greenberg (the "Greenbergs"). *Amici* submit this brief to emphasize that an adverse decision will affect wider public interests: it would seriously diminish public access to a substantial portion of the historical record compiled by this nation's magazines and newspapers.<sup>1</sup>

Many of the *amici* have published issues of newspapers and magazines that they have made available to researchers, scholars and the general public on the Nexis® service or other databases,

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<sup>1</sup> The Greenbergs have confirmed in writing through counsel that they will not object to *amici* filing this brief provided that *amici* serve the Greenbergs by Federal Express or similar means. *Amici* have fulfilled this condition, as the Certificate of Service confirms.

"CD-ROMs," microfilm or other electronic media — in effect creating a "national library" of history and culture. This library, however, includes contributions from freelance contributors who (as has been traditional in the magazine and newspaper profession) have not made "an express transfer of the copyright or of any rights under it" expressly authorizing such archival publications. Instead, those contributors and amici have relied upon the continued availability and integrity of the "privilege" extended by Congress under 17 U.S.C. § 201(c).

*Amici* have a direct and compelling interest in the enforcement of this Congressionally-authorized privilege. If the decision below is reversed, the represented publishers and countless others may feel compelled to withdraw from circulation some or all of their periodicals from the national library — a consequence that will damage publishers, the public and many freelance contributors.

*Amici* therefore not only seek an affirmance of the decision below; they also ask that this Court, in so affirming, recognize and mitigate the harm that already has occurred as a result of the decision of the Second Circuit Court of Appeals in Tasini II,<sup>2</sup> and the even greater harm that would result from the extension of Tasini II demanded by the Greenbergs and their *amicus*, American Society of Media Photographers, Inc. ("Photographers, Inc.").

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<sup>2</sup> The decision reversed Tasini v. New York Times Company, 972 F. Supp. 804 (S.D.N.Y. 1977) ("Tasini I").

## STATEMENT OF THE ISSUE

Whether this Court should affirm the decision of the district court below, decline to follow Tasini v. The New York Times Co., 206 F.3d 161 (2d Cir. Sept. 24, 1999, amended Feb. 25, 2000) ("Tasini II"), and safeguard the role of electronic archives in our "national library" by holding that under 17 U.S.C. § 201(c), publishers have the privilege of reproducing freelance contributions that appeared in their original periodicals as part of the recognizably "same" periodical (albeit a new edition, issue, or revision of it), regardless of the medium in which those works appear.

## SUMMARY OF ARGUMENT

The increased public access to back issues of newspapers and magazines, made possible through electronic sources such as Nexis® and CD-ROMs, undeniably has advanced the goal of the Copyright Act: to increase the store and the availability of "writings." Twentieth Century Music Corp. v. Aiken, 422 U.S. 151, 156 (1975). The reversal urged by the Greenbergs and Photographers, Inc. runs contrary to this goal. If the plaintiffs in Tasini II are correct, or if this Court expands that decision, it could leave many publishers with no rational choice but to remove freelance contributions (and others not clearly authored by "employees") from electronic and other archives of their libraries of periodicals. As a consequence, electronic libraries would be rendered incomplete, and much national history effectively would vanish, thus damaging the public interest and disserving copyright law.

Reversing the decision below in reliance upon Tasini II not only would make for bad policy, however; it also would make for bad copyright law. As shown below, the Second Circuit has misinterpreted several provisions of the Copyright Act in several respects, including what constitutes an "original work" under Section 102(a); the word "revision" in Section 201(c); and the multitude of "exclusive rights" preserved to authors under that section. The Second Circuit also has confused the standard for direct copyright liability with that of contributory liability in a manner proscribed by Sony Corp. of America v. Universal City Studios, Inc., 464 U.S. 417 (1984).

These errors are so serious as to require a fresh examination of Section 201(c) by this Court. Aiding the Court in this task is the clear language of the section itself, as illuminated through the strong light of a cogent legislative history in which freelancers, through experienced counsel, lobbied long and effectively to obtain the precise language of Section 201(c). The Greenbergs now seek to expand that language. The result they urge, however, would run contrary to the overarching purpose of the Copyright Act: "to increase and not to impede the harvest of knowledge." Harper and Row Publishers, Inc. v. Nation Enterprises, 471 U.S. 539, 545 (1985).

## ARGUMENT

I. A DECISION REQUIRING REMOVAL OF FREELANCE CONTRIBUTIONS FROM ELECTRONIC VERSIONS OF NEWSPAPERS AND MAGAZINES WILL DAMAGE THE PUBLIC INTEREST AND DISSERVE COPYRIGHT LAW.

*Amici* agree with opposing *amicus* about a few things:

Freelance photographers and writers "collectively produce an enormous amount of what we all see, read, hear and learn" (Brief of *Amicus Curiae* American Society of Media Photographers, Inc. in support of Plaintiffs-Appellants" ("Photo. Br.") at 4.)

Moreover, as a result of Congress' decision to recognize the "divisibility" of copyrights, freelancers (unlike "employees") exclusively can exploit the copyrights in their individual works. For example, as opposing *amicus* points out, freelancers have been empowered by Congress to commercially exploit those rights "to clients outside the publishing industry who then use freelancers' work in packaging, advertising and a multitude of other communications media." (*Id.*)

Congress, however, insisted on one limitation: as part of a carefully negotiated Congressional compromise, Section 201(c) provides, in essence, that if a freelance writer or photographer seeks the publication of his or her work in a collective work — such as a magazine or newspaper — then even though the freelancer still retains the "rights" of copyright in the individual contribution, a "privilege" is extended to the magazine or newspaper. That "privilege" is to reproduce and distribute the freelance contribution as part of that magazine or newspaper, in "any revision" of it and in any later collective works in "the same series." 17 U.S.C. § 201(c).

As indicated in more detail below, freelancers, ably represented in Washington by experienced counsel, lobbied long and effectively to obtain the precise language of Section 201(c). A quarter of a century later, they seek to expand that language by judicial decree and through the flood of lawsuits already predicted by the lead victor in Tasini II.

So far, they have been successful. The plaintiffs in Tasini II consider the holding in that case to require publishers of magazines and newspapers to ascertain (often from records that may no longer exist), whether or not particular articles or photos were written by "employees";<sup>3</sup> then track down all independent contractors and unverified "employees"; then calculate reasonable offers of compensation; and finally engage in negotiations for permission. Obviously, this is not only cost prohibitive but all but impossible. Moreover, because *amici* members are not compensated by Nexis® or other database sources for individual articles viewed or downloaded, there is no economic incentive whatsoever for those in the position of *amici* to engage in such an expensive undertaking. Under the circumstances, publishers may have no rational choice but to remove freelance contributions to the extent they are capable of identifying them from their electronic archives.

These electronic archives have created a national library accessible to all Americans. Although Congress long ago foresaw

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<sup>3</sup> Despite clarification of this technical term by the Supreme Court, see CCNV v. Reid, 490 U.S. 730 (1989), litigation over its meaning continues. See, e.g., M.G.B. Homes, Inc. v. Ameron Homes, Inc., 903 F.2d 1486 (11th Cir. 1990).

such a need — requiring most publishers applying for copyright protection to deposit two copies of each published copyrighted periodical for use or disposition by the Library of Congress (see 17 U.S.C. § 407) — neither those two copies nor the additional print copies acquired by schools and libraries across the nation have been adequate to serve its needs for many years. As a result, for several decades, public libraries, colleges and universities, corporations and other institutions have found the acquisition of editions of periodicals on microfilm and microfiche to be a space- and cost-effective way to support the public's needs for such works.

Although the technological tools of microfilm and microfiche have served the nation well, the benefits of Nexis® and CD-ROM clearly make that new technology the favored choice. Indeed, because of the widespread acceptance of the electronic library, it already may be too late to force a return to microfiche and microfilm (assuming that they, too, are not threatened by the implications of Tasini II). Thus, in recent years, many libraries, colleges and universities, seeking to eliminate the expense and difficulties of storing, maintaining and using print, microfilm and microfiche, have opted for subscriptions to Nexis® and the acquisition of CD-ROMs. If the electronic libraries are to be rendered incomplete, much national history effectively may vanish.

The scope of this threat should not be underestimated. Nexis® databases alone contain thousands of different magazines, newspapers and newsletters, a very significant number of which



contain contributions from freelancers. Among the newspapers and magazines on Nexis® are The New York Times, the Atlanta Journal and other periodicals of national and regional interest. Thanks to these offerings, the historian or student who wishes to use the Atlanta Journal to examine the roots and trace the progress of the Civil Rights Movement has not been required to travel from a small town to Atlanta, Birmingham, or Jacksonville to review spools of microfilm or deteriorating (if available at all) paper copies. Instead, he or she has been able to access the Nexis® service or obtain a set of CD-ROMs and work quickly and efficiently from his or her hometown. Tasini II, however, would consign the student, the historian and the general public to microfilm and to paper copies as the only definitive archive.

Some have argued that newspaper publishers from now on should negotiate written agreements, spelling out particular electronic archival "rights." Of course, such a "solution" does nothing to preserve historic electronic archives created before Tasini II in reliance on the traditional understandings. Moreover, the need of newspapers to meet publishing deadlines within days, often within hours, makes such negotiations frequently impractical. Indeed, it was this "real world" recognition that formed the foundation upon which the Section 201(c) compromise rested: Freelancers could retain and exploit their copyright "rights," but if they chose to submit their works to a newspaper or magazine, then a "privilege" to publish and republish would be extended pursuant to Section 201(c).

The Greenbergs and Photographers, Inc. disparage the "privilege," claiming it falls short of a "right." In one way it does. A "right" may be "exclusive" — which is why Tasini II's assumption that freelancers would lose their "exclusive" rights if publishers were allowed to archive their collective works electronically is so unfounded (as discussed in detail at pages 16-18, infra).

In at least one small way, however, the "privilege" exceeds the "rights" retained by the freelancers: the "privilege" of Section 201(c), unlike the "rights" reserved to the author, is nonterminable. Compare the Copyright Act provision for termination of a "grant of a transfer or license" under Section 304(c) (applicable to works created before January 1, 1978, the effective date of the Copyright Act) with Section 203(a), which provides for termination of a "grant of a transfer or license" (applicable to works created on or after January 1, 1978).<sup>4</sup> In explicitly restricting termination only to a "grant of a transfer or license," Congress preserved the "privileges" of Section 201(c) from potential termination, thus allowing the important archival mission to continue for the entire term of copyright (and thereafter as works become part of the public domain). Such an uninterrupted "privilege" not only squares with the purpose of Section 201(c) in securing to later generations access to periodicals and other records of public events and

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<sup>4</sup> Moreover, in this Circuit, the Court has held that the Copyright Act does not preempt state law, and that an implied license may be terminated pursuant to state law — in many cases "at will" when the term is indefinite. See Korman v. HBC Florida, Inc., 182 F.3d 1291 (11th Cir. 1999).

culture; it also implicitly acknowledges that media capable of making that archive accessible must be allowed to develop without the need for "renegotiations" with every iteration of technology.

The increased access to back issues of newspapers and magazines made possible through sources such as Nexis® and CD-ROMs undeniably has advanced the Copyright Act's goal of increasing the store and the availability of "writings." Twentieth Century Music Corp. v. Aiken, 422 U.S. 151, 156 (1975) (ultimate aim of copyright law is "promoting broad public availability of literature, music and the other arts"). Under the circumstances, a reversal of the decision below in reliance upon Tasini II not only would make for bad policy; it would make for bad copyright law.

II. BECAUSE TASINI II IS BUILT UPON MISUNDERSTANDINGS OF FUNDAMENTAL PRINCIPLES OF COPYRIGHT LAW, INCLUDING PRINCIPLES ESTABLISHED BY THE SUPREME COURT AND THIS COURT, IT SHOULD NOT CONSTRAIN THIS COURT.

The Greenbergs and Photographers, Inc. say this Court simply must echo Tasini II because a contrary decision would "wreak havoc in the publishing industry" (See, e.g., Photo. Br. at 26.) That is inaccurate. As Photographers, Inc. well knows, Tasini II **already has done that.** The truth is that the Greenbergs and Photographers, Inc. want this Court to rubber stamp Tasini II because they want the same result here.

In any event, this Court should not follow, much less extend, Tasini II in the manner urged by the Greenbergs and Photographers, Inc. because Tasini II is grounded upon three outcome-determinative misconceptions:

- It relies upon the possibility that third parties may infringe a work as a standard for finding direct infringement liability, contrary to the dictate of the Supreme Court in Sony.
- It erroneously characterizes collective work "originality," which leads to the erroneous conclusion that a database reproduction of a collective work constitutes a "new anthology" if it contains more than a single issue of the collective work.
- It finds (again based on an erroneous understanding of collective work "originality") that a copy of a magazine or newspaper stored digitally must retain the same "arrangement" as a print copy — otherwise it becomes an "original" work, a "new anthology."

These misconceptions, intertwined with the Second Circuit's "unnatural" construction of the word "revision" in Section 201(c), and magnified by its failure to recognize the multitude of "exclusive rights" preserved to authors under that section, so undermine the intellectual infrastructure of Tasini II as to require a fresh examination of Section 201(c) by this Court.

A. Tasini II's Rationalization of Direct Liability on the Assumption that Specific Articles or Photographs Would Be Improperly Retrieved or Reproduced Violates Principles Established by the Supreme Court in Sony.

Claims of "direct" (as opposed to "contributory") copyright infringement — such as those asserted by Tasini II Appellant Jonathan Tasini — cannot be based on infringements that might be committed by others. Sony, 464 U.S. at 446 ("Third party conduct

[is] wholly irrelevant in an action for direct infringement"). Tasini II, the principal case relied on by the Greenbergs and Photographers, Inc., violates this rule by determining the issue of direct liability based on the acts of a hypothetical end user in searching for, retrieving and reproducing freelance contributions apart from the publications in which they appear.<sup>5</sup> This was error. See id. ("Third party conduct would be wholly irrelevant in an action for direct infringement").

Because the infringement claims in Tasini II were based on the acts of publishers in reproducing copies of particular collective works in the Nexis® library, it was the content of those (allegedly) directly infringing copies that should have been examined in Tasini II. The Second Circuit did not do so. Moreover, because of the particular procedural posture of that appeal, the Second Circuit had no opportunity to analyze whether the publishers' databases had "substantial noninfringing uses," see id. at 442, or whether researchers who download articles had a cognizable fair use defense. See id. at 448. These errors in Tasini II also created a conflict with another Second Circuit

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<sup>5</sup> Tasini II focuses heavily, if not exclusively, on the ability of end users to download articles "individually or in combination with other pieces originally published in different editions of the periodical or in different periodicals." Tasini II, 206 F.3d at 165. It characterizes Nexis® as a "database comprising thousands or millions of individually **retrievable articles** taken from hundreds or thousands of periodicals [from which] **articles may be retrieved** according to criteria unrelated to the particular edition in which the articles first appear." Id. at 169 (emphasis added).

panel. See Matthew Bender and Co. v. West Publ'g Co., 158 F.3d 693 (2d Cir. 1998), cert. denied, 119 S. Ct. 2039 (1999).<sup>6</sup>

B. Tasini II's Conclusion that a Database such as Nexis® Is Itself a "New Anthology" (and Therefore Unprivileged under § 201(c)) Violates "Originality" Precepts of the Supreme Court and This Court and Puts at Risk Virtually Every Electronic Database.

Tasini II's view that the Nexis® electronic library and the CD-ROMs distributed by University Microfilms International ("UMI") constitute either "a new anthology of innumerable editions of" the periodicals or "a new anthology of innumerable articles from" each periodical, Tasini II, 206 F.3d at 169, conflicts with the Supreme Court's decision in Feist Publications v. Rural Telephone Service Company, 499 U.S. 340, 362 (1991) and Section 101 of the Copyright Act (defining "compilation," a term which includes a "collective work"). That is, Feist and Section 101 require a measure of "originality" for a collective work to be protectable. See BellSouth Adver. and Publ'g Corp. v. Donnelley Info. Publ'g, Inc., 999 F.2d 1436 (11th Cir. 1993); Warren Publ'g, Inc. v. Microdos Data Corp., 115 F.3d 1509 (11th

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<sup>6</sup> Matthew Bender rejected similar infringement claims that were based on the argument that users could rearrange data on a CD-ROM product to create an infringing configuration. In that case, the Second Circuit Court of Appeals recognized that "CD-ROM technology is different from paper ... because the file-retrieval system allows users to retrieve cases in a variety of ways" that are unrelated to the original arrangement on the CD-ROM copy. Matthew Bender, 158 F.3d at 705. That court refused, however, to take the erroneous next step of concluding that direct copyright infringement arises from a hypothetical user's ability to create an infringing work using "electronic scissors." See id. at 706. In the electronic databases at issue in Tasini II, it was the manipulation of the **retrieval system** — not any revised copy — that allowed articles to be downloaded individually and recombined with other articles. There was, therefore, no directly infringing copy.

Cir. 1997). Tasini II's finding of an outcome-determinative difference in a printed and electronic version of the same periodical simply because the "arrangement" is different (a difference dictated by technology and not by "acts of authorship," see Donnelley, 999 F.2d at 1441, is not the law of "originality" in this Circuit.<sup>7</sup> The mechanical collection of previously published issues of magazines and newspapers into an electronic database with only trivial changes cannot satisfy that requirement. Feist, Donnelley and Warren Publishing require more than the transformation and storage of periodicals from one medium to another.

Tasini II — not to mention the extension of it urged by the Greenbergs and Photographers, Inc. — could lead to findings of "new anthologies" whenever two works are placed on the same database.<sup>8</sup> To be safe from the implications of Tasini II, the

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<sup>7</sup> Tasini II found that the technologically-driven "rearrangement" of The New York Times from print to database rendered it "at best a new anthology of innumerable editions of The Times, and at worst a new anthology of innumerable articles from these editions...." Tasini II, 206 F.3d at 169. Piling error on error, Tasini II then concluded that because the electronic version of The New York Times is a "new" (read "original") anthology, it cannot be said to be a 'revision' of any (or all) particular editions or to be a 'later collective work in the same series.'" Id. See discussion at pages 13-14, infra.

<sup>8</sup> Indeed, new and "infringing" anthologies, by Tasini II's reasoning, are created and reside on the hard drive of every personal or laptop computer in a lawyer's office or judge's chambers whenever multiple computer (word processing or spreadsheet) programs, memoranda from clerks to judges, letters or other copyrightable works are stored together. Such a result is invited by Tasini II's insistence that even though a database may contain a complete periodical, it is "at best a new anthology" if it is stored with copies of "other periodicals." Tasini II, 206 F.3d at 169.

database containing a periodical must: (a) contain only a single issue of the periodical; and (b) not be searchable for individual articles — notwithstanding the fact that periodicals in paper form are bound together in volumes, contain tables of contents, and are indexed so that individual articles can be retrieved. Such an outcome ignores the Copyright Act's media neutrality and express embrace of computers (by referring, e.g., to "copies" as "material objects" stored in any medium "now known or later developed" and to "literary works" as works expressed in "words, numbers or other verbal or numerical symbols" such as tapes, disks, or punch cards (as well as books and manuscripts). It also destroys the value of electronic databases as a research tool, a result impossible to reconcile with the ultimate purposes of the Copyright Act. Nor are the harmful implications flowing from Tasini II's misconceptions of copyright law limited to electronic media: the opinion could require each issue of a periodical not only to be reproduced on a separate disk or database, but also on a separate spool of film or microfiche.

Much of Tasini II rests on this erroneous understanding of "originality" in copyright law generally and as applied to collective works in particular. If, as amici argue, the Second Circuit was in error and electronic databases are not really "new" and thus are privileged under Section 201(c), then the scaffolding upon which Tasini II hangs its finding of infringement collapses. As the Southern District of New York correctly found, "NEXIS and UMI's CD-ROMs **carry** recognizable versions of the publisher/defendants' newspapers and magazines"



and "store those versions within something akin to an electronic research library." Tasini I, 972 F. Supp. at 825. This same conclusion was reached by the Second Circuit itself in CCC Information Services, Inc. v. MacLean Hunter Market Reports, Inc., 44 F.3d 61, 68 n. 8 (2d Cir. 1994), where it properly noted that immersion of a work in a larger database does not cause the original work to lose its independent copyright status.

CCC and Tasini I's characterizations are consistent with Congress' understanding in 1976 of how databases like those in dispute would function. Congress was well aware of the prospect of accessing individual articles from books and periodicals stored in exactly the way the Nexis® and CD-ROM products store individual collective works. See, e.g., Copyright Law Revision: Hearings on HR 2223 before the Subcommittee on Courts, Civil Liberties and Administration of Justice, 97th Congress 338 (1975) (testimony of Paul G. Zurkowski, President, Information Industry Association) (Appendix ("App.") at 16-18). There is no suggestion that Congress intended such libraries automatically to constitute new "works" in and of themselves.

To the contrary, under the Copyright Act, Feist, Donnelley and Warren Publishing, the electronic databases in dispute in Tasini II (like the disks at issue here) do not comprise "new anthologies" because the wholesale reproduction of entire books and periodicals (including more than 100 years of National Geographic Magazine) into the digital medium is so "mechanical or routine as to require no creativity whatsoever." See Feist, 499

U.S. at 362.<sup>9</sup> Compare the decision of this Court in Donnelley, which distinguished "acts of authorship" and "techniques for the discovery of facts" and concluded (with respect to the requirement of original "selection" in a purported collective work) that "the protection of copyright must inhere in a creatively original selection of facts to be reported and not in the creative means used to discover those facts." See Donnelley, 999 F.2d at 1441.<sup>10</sup>

C. Tasini II's Insistence that a Collective Work Reproduced on a Digital Copy Must Retain the Same "Arrangement" as the Printed Copy Is Contrary to the Copyright Act, Feist and Donnelley and Imposes Improper Print-Specific Constraints on Electronic Databases.

Tasini II reflects confusion about the Constitutional premise of copyright "originality" in still another aspect, thereby further eroding the underpinnings of the entire decision. As the Second Circuit stated, "[t]he aspects of a collective work that make it 'an original work of authorship' are the selection, coordination, **and** arrangement of the preexisting materials." Tasini II, 206 F.3d at 168 (emphasis added). This citation purports to be to Section 101 of the Copyright Act, but Section 101 defines "compilation" — a term which expressly

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<sup>9</sup> The Copyright Office refuses to register automated databases "where the collection and arrangement" consists solely of "transferring data from hard copy to computer storage." Circular 65, Copyright Registration for Automated Databases 1 (U.S. Copyright Office 1999).

<sup>10</sup> "Arrangement and coordination" fared no better than "selection" where (as is the case with the electronic databases at issue here) the resulting product (telephone "Yellow Pages" in Donnelley) was "entirely typical" of similarly constrained works, resulting in a layout that was "not only unoriginal [but] practically inevitable." Id. at 1442 (citing Feist, 499 U.S. at 362).

includes "collective works" — as "a work formed by the collection and assembling of preexisting materials or of data that are selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes an original work of authorship." 17 U.S.C. § 101 (emphasis added).

Tasini II's erroneous use of the conjunctive "and" rather than the disjunctive "or" has consequences; on that faulty pillar rests Tasini II's conclusion that the "copyrightable aspects" of periodicals vanish when they are reproduced in digital copies because some of the periodical's content "and perhaps most of its arrangement are lost." Tasini II, 206 F.3d at 169. Yet Feist, Donnelley and the Copyright Act recognize that if a collective work demonstrates the requisite originality in its selection, coordination or arrangement, it may manifest the necessary "copyrightable aspects" to qualify for protection. Tasini II's implication that a collective work must possess all three or lose its initial copyrightable aspects — whereupon it becomes a "new anthology" unprotected by Section 201(c) — is thus a significant error.

In sum, Tasini II stands for the erroneous and contradictory proposition that technology-driven rearrangements of data evince enough "originality" to produce a copyrightable "work," yet too much "originality" to be a "revision" of the initial work or another work "in the same series."<sup>11</sup>

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<sup>11</sup> It is conceivable that certain "rearrangements" might result in a "new work" to the extent they are not necessitated by technology. The impossibility of reproducing page layouts or photographs in digital copies on ASCII text, however, does not constitute the sort of creative, original "arrangement" necessary

D. Because *Tasini II* Itself Is "In Considerable Tension With the Overall Statutory Framework" of the Copyright Act, Its "Unnatural" Reading of the "Revisions" Privilege in Section 201(c) Must Be Rejected.

Tasini II states that "[t]he most natural reading of the 'revision' of 'that collective work' clause is that Section 201(c) protects only later editions of a particular issue of a periodical, such as the final edition of a newspaper." Tasini II, 206 F.3d at 167. If that were what Congress had meant, it would have enacted the following instead of Section 201(c):

In the absence of an express transfer of the copyright or of any rights under it, the owner of copyright in a 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]~~ **any later edition of that collective work**, and any later collective work in the same series.

Obviously, Congress went further, permitting publishers to make "any revision of that collective work." 17 U.S.C. § 201(c).

In fact, far from limiting a Section 201(c) "revision" to later editions of newspapers, the legislative history shows the "revision" privilege was added to make clear that "a volume containing only half" of the material found in the initial publication also was within the scope of what publishers are

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to qualify as a "work." On the contrary, those "rearrangements" are "entirely typical," the "inevitable" rearrangements that necessarily appear in many electronic databases. See Donnelley, 999 F.2d at 1442 (citing Feist, 499 U.S. at 362). Tasini II's implication that such a rearrangement "does almost nothing to preserve the copyrightable aspects of [*amici*'s and their members'] collective works" ignores the fact that Congress was aware in 1976 that print arrangements could be reproduced electronically, yet nevertheless determined that reproduction in "electronic storage units" and "computer punch cards" maintained a work's copyrightability. See 17 U.S.C. § 101 (defining "literary works").

permitted to distribute without further negotiations with freelancers. Moreover, this concept was added in direct response to concerns, raised by textbook publishers, over a prior, and narrower, version of Section 201(c). Compare Preliminary Draft for Revised U.S. Copyright Law and Discussions and Comments on the Draft, 88th Cong., 2d Sess., Copyright Law Revision, Part 3 (H. Judiciary Comm. Print 1964), at 15, 261 ("Copyright Law Revision, Part 3") (App. at 7, 10) with 1964 Revision Bill with Discussions and Comments, 89th Cong., 1st Sess., Copyright Law Revision, Part 5 (H. Judiciary Comm. Print 1965), at 9 ("Copyright Law Revision, Part 5") (App. at 12). There is, therefore, neither logical nor legislative history support for the Second Circuit's "natural" reading.<sup>12</sup>

Based upon its erroneous interpretation of "revision" the Tasini II panel proceeded to find the explanation of "revision" advanced by Appellees in that case "in considerable tension with the overall statutory framework" of the Copyright Act. Tasini II, 206 F.3d at 168. But the Tasini II panel's efforts to

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<sup>12</sup> Tasini II thus errs in its unfounded presumption that Congress wanted the last three phrases of Section 201(c) to be read as an ascending hierarchy of privileges, with the first phrase as the "floor"; the second phrase "expand[ing]" on the first; and the third phrase "set[ting] the outer limit or ceiling on what the publisher may do." Tasini II, 206 F.3d at 167. Based on the hierarchy, the Court rejects a rational interpretation of "revision" and effectively imprisons the term between the first (the "floor") and third (the "ceiling") privileges. Of course, because the Appellees in Tasini II were said to have relied "entirely" on the second phrase (that each database constituted a "revision" of the particular collective work), id. at 166, the Second Circuit's characterization of the meaning of the first and third phrases is mere dicta.

justify this conclusion are no more convincing than the conclusion itself. Tasini II speculates that "were the permissible uses under [Section] 201(c) as broad and transferable as Appellees contend, it is not clear that the rights retained by the author could be considered 'exclusive' in any meaningful sense." Id. Yet this simply is not the case.

The authors in Tasini II — just like the Greenbergs and those represented by Photography, Inc. — retain an extraordinary bundle of exclusive rights. To take just a few examples, under Section 106(1) (the exclusive right of reproduction), the Greenbergs may license their photographs **exclusively** for use in a computer game; for inclusion in a movie; for affixation on calendars, stationery and postcards; for illustrations in textbooks about photography and natural history; on coffee cups and dormitory posters and on album covers for records, tapes and compact disks — not to mention the **exclusive** right under Section 106(3) to "sell" their photographs (including to resell the same photographs to a completely different periodical) in countless media and products; the **exclusive** right under Section 106(5) publicly to "display" those photographs in museums, on college campuses or in television programs; or the **exclusive** right under Section 106(2) to prepare innumerable "derivative works" based upon or derived from the copyrighted photographs. Because each of these rights may be licensed **exclusively** on a temporal basis (for thirty days; for six years) and may be further subdivided geographically (in the United States; in France; in Florence, Italy but not in Rome), the

monopoly rights retained by the authors, contrary to the speculation of the panel in Tasini II, are indeed "exclusive" in an all but infinite number of ways.

It is therefore Tasini II's reading of the Copyright Act that is "in considerable tension" with the law. *Amici* respectfully submit that the plain and "natural" reading of the "revision" privilege in Section 201(c) fully embraces the uses made by the Society in this case and by many of the *amici* under the facts of Tasini II. If, however, there is any ambiguity in the "revision" privilege, the legislative history strongly supports *amici's* reading of the term, not the reading found in Tasini II.

An early draft of Section 201(c) gave publishers the right to publish freelance contributions in the original periodicals or "a composite work like that of the publisher...." Discussion and Comments on Report of the Register of Copyrights on the General Revision of the U.S. Copyright Law, 88th Cong., 1st Sess., Copyright Law Revision, Part 2 (H. Judiciary Comm. Print 1963), at 385 (App. at 5). This language led Harriet Pilpel, an experienced literary property attorney who represented freelance authors, to worry that the section, as drafted, was "less favorable than the present law," presumably because it could allow Newsday, for example, to sell one of its articles for later publication in The New York Times, arguably a "like" composite work. See id. at 151-152 (App. at 2-3). Responding to this concern, the Register of Copyrights agreed to clarify the language to refer to "that particular composite work" and no

Harriet Pilpel  
Lit. Prop. Att'y

other. Id. at 153 (App. at 4). Section 201(c) thus was rephrased to grant only the privilege "of publishing the contribution in that particular collective work." Copyright Law Revision, Part 3, at 15 (App. at 7).

In response to this new language, however, publishers observed that this draft of Section 201(c) might not allow them to republish revisions of their collective works, selecting and discarding freelance contributions as they chose. Id. at 261 (App. at 10). The Register of Copyrights agreed that the "particular collective work" language was too restrictive, and that the core privilege to which publishers were entitled should include the privilege of distributing freelance contributions of "that collective work and any revisions of it." Copyright Law Revision, Part 5, at 9 (App. at 12).

Harriet Pilpel then argued that it "should not be the law" that a publisher could revise individual contributions (as opposed to the collective work) without permission. Id. at 152 (App. at 13). In response, the Register of Copyrights refashioned Section 201(c) to make clear that the "any revision" language authorized any changes to the "particular collective work" as a whole, but not to the individual contribution. Supplementary Report of the Register of Copyrights on the General Revision of the U.S. Copyright Law; 1965 Revision Bill, 89th Cong., 1st Sess., Copyright Law Revision, Part 6 (H. Judiciary Comm. Print 1965), at 69 (App. at 15). This final compromise yielded the present language of Section 201(c).

"should not be the law" that publishers add REVISIONS AND PERMISSION. Id. at 152 (App. at 13) BUT NOT to individual contribution PILPEL



To clarify the compromise further, Congress provided the following examples of what publishers can and cannot do under Section 201(c):

Under the language of this clause a publishing company could reprint a contribution from one issue in a later issue of its magazine [what Tasini II wrongfully construes to be the only and "natural" meaning of "revision"], **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.

"could not revise the contribution itself or include it in a new anthology" -  
Diner/Adhcer - REVISED  
and included in the advertising section CDK

H.R. Rep. 94-1476, at 122-123 (1976), reprinted in 1976

U.S.C.C.A.N. 5659, 5737 (emphasis added) (App. at 20-21). In other words, if a publisher uses a freelance contribution in the recognizably "same" publication (albeit a new edition, issue, or **revision of it**), the privilege attaches, regardless of the media (print, microfilm, microfiche, electronic database, CD-ROM). If, however, a publisher uses a freelance contribution from one of its publications in a "new" anthology or an "entirely different magazine," the privilege does not attach, regardless of the fact that both collective works might be in the same media.

Congress has had several opportunities to revisit Section 201(c). In 1983, for example, one Senator introduced a bill that proposed to add a Section 201(f) to the Copyright Act. S. 2138, 98th Cong. 1st Sess.; 129 Cong. Rec. 34,442 (1983) (App. at 22-27). That section would have permitted a freelancer to bring a federal cause of action to "reform or terminate" the privilege under Section 201(c) where the profits received by the publisher of a collective work "are strikingly disproportionate" to the "compensation" received by the freelancer. S. 2138 § 2(3) (App.

at 26). The proposed cause of action provided that, at any time following the creation of the privilege under Section 201(c), a plaintiff could claim that the terms of the transfer had proven to be unfair or grossly disadvantageous to the freelancer. That Senator proposed to throw the resolution of the "unfairness" issue to the courts, where it was to be decided "in accordance with the principles of equity." Id. The bill failed.

Notwithstanding this legislative history and the resulting clarity of Section 201(c), the Greenbergs and Photographers, Inc., drawing on the faulty premises of Tasini II, argue on appeal that if a collective work contains the modicum of originality to qualify for copyright protection, it also necessarily becomes an "entirely different" publication, thus removing its publisher from the protection of Section 201(c). But putting aside the multiple infirmities of Tasini II, the argument finally proves no such thing. Nothing in the legislative history suggests that the "slight" originality necessary to qualify a "work" as "original" exceeds the boundaries of a "natural" reading of the term "revision." Indeed, this is made clear by the legislative history example mentioned above, sanctioning use of an article "from a 1980 edition of an encyclopedia in a 1990 [and obviously "original" for copyright purposes] revision of it."<sup>13</sup>

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<sup>13</sup> If anything could be more contrary to the spirit and purposes of the Copyright Act than the Hobson's choice of negotiating with thousands of authors and photographers (or their estates and assigns) or electronically "scissoring" freelance contributions from the nation's libraries, it is the prospect of the publishers having to retain dozens of copyright lawyers to advise on

## CONCLUSION

This Court need not and should not rubberstamp an opinion as riddled with fundamental error as Tasini II. *Amici* respectfully request this Court to decline to follow Tasini II; to affirm the case below; and to take an all-important first step toward restoring to the public the complete access to its national historical record that was contemplated by Congress when it drafted Section 201(c).

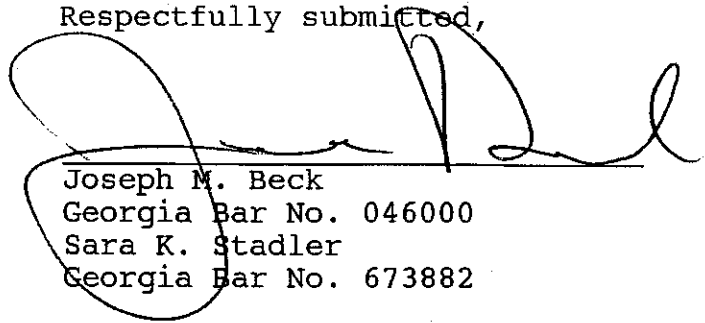
After all, the touchstone of copyright law — and the surest guide to interpretation of its otherwise unclear sections — is its overarching purpose "to increase and not to impede the harvest of knowledge." Harper and Row Publishers, Inc. v. Nation Enterprises, 471 U.S. 539, 545 (1985). Compare L. Ray Patterson & Judge Stanley F. Birch, Jr., Copyright and Free Speech Rights, 4 J. Intell. Prop. L. 1, 3 (Fall 1996) ("Our thesis in this Article is that the proprietary copyright has a major — and adverse — impact on the right of the people to know and that this impact has increased with extension of a copyright that was historically limited to the printed word to modern communications technology"). As the Second Circuit itself once observed, "courts in passing upon particular claims of infringement must occasionally subordinate the copyright holder's interest in a maximum financial return to the greater public interest in the development of art, science and industry." Berlin v. E.C. Publishers, Inc., 329 F.2d 541, 544 (2d Cir. 1964).

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questions of "originality" as a precondition to deciding whether to negotiate or censor.

Dated: April 26, 2000.

Respectfully submitted,



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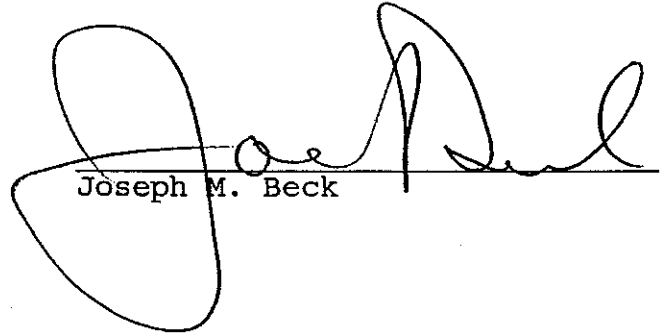
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CERTIFICATE OF COMPLIANCE

I, Joseph M. Beck, attorney for *amici curiae*, hereby certify that this brief complies with the limitations contained in Federal Rules of Appellate Procedure 29(d) and 32(a)(7)(B), in that the portions of the brief for which word counts are required together contain less than 7,000 words.



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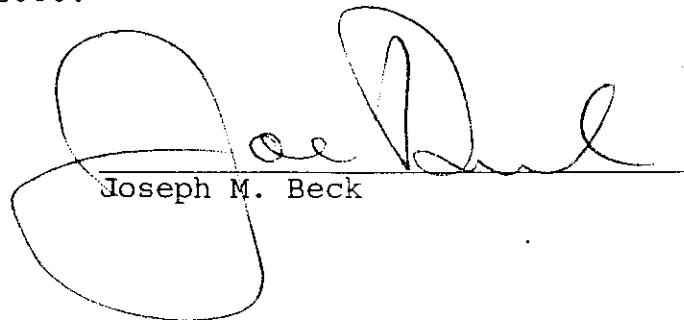
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This is further to certify that I have this day served two (2) true and correct copies of the foregoing document via Federal Express overnight delivery addressed to:

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This 26th day of April, 2000.

  
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