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New York Times Co., Inc. v. Tasini: A Rational United States Supreme Court Ruling on the Rights of Freelance Authors?

Mili Kamlesh Vakil*

INTRODUCTION

On June 25, 2001, the United States Supreme Court, in *New York Times Co., Inc. v. Tasini*¹ issued an unequivocal ruling supporting the rights of freelance authors. *Tasini* dealt with parent companies of periodicals that had sold freelance-authored work to electronic databases without providing additional compensation to the freelance authors. The Court found that the companies' actions violated § 201(c) of the Copyright Act of 1976 (the "Collective Work Privilege").² More specifically, the Court held that the Collective Work Privilege does not permit print publishers to provide copies of freelance authors' articles to electronic databases without the prior consent of the freelance authors.³

This Note contends that the Supreme Court correctly applied the Collective Work Privilege in determining freelance authors' electronic distribution rights and highlights the negative implications that the Court's ruling will have on both freelance authors and the electronic media industry. Part I of this Note provides background information on copyright law in the United States, specifically the Copyright Act of 1976 (the "Copyright Act" or the "Act").⁴ Part II

* B.A., 1998, Washington University; J.D. Candidate, 2003, Washington University School of Law. This Note is dedicated to Kamlesh N. Vakil, Malka K. Vakil, Kevin K. Vakil, and Samir J. Sheth for their constant love, support, guidance, and encouragement. Also, much thanks to all those who put in an inestimable amount of time helping me produce this piece.

1. 533 U.S. 483 (2001).

2. 17 U.S.C. § 201(c) (2001); 533 U.S. at 506.

3. 533 U.S. at 506.

4. Copyright Act of 1976, Pub. L. No. 94-553, 90 Stat. 2541 (codified at 17 U.S.C.

examines the *Tasini* case from its inception to the Supreme Court's decision, examining the key facts and the relevant portions of the district court and court of appeals decisions. Part III analyzes the Supreme Court's interpretation of the Collective Work Privilege in *Tasini*. In particular, Part III will discuss the legislative history and the debate that ensued when enacting the Collective Work Privilege as well as the Court's understanding of Congress's purpose in enacting the Collective Work Privilege. Part IV examines the implications of the Court's ruling, specifically the ethical and economic impact the Court's decision will have on the publishing industry, on freelance authors, and on the public. Finally, Part V discusses whether the Supreme Court correctly decided *Tasini*, and to what extent the decision really favors freelance authors' rights. To the extent that the *Tasini* decision may potentially conflict with what it intended to do—that is, favor freelance authors' rights—Part V also addresses ways in which to avoid this conflict.

I. THE GOALS AND PURPOSES OF THE UNITED STATES COPYRIGHT ACT OF 1976

Copyrights are one of the principal modes of intellectual property protection.⁵ Intellectual property protection began with the advent of the printing press, which enabled mass production and distribution of artistic and literary works.⁶ Copyright protection has evolved and developed as a means to not only encourage publishing, but also to encourage learning.⁷ The United States copyright system protects

§§ 101-803 (2000)).

5. See, e.g., ROBERT P. MERGES ET AL., *INTELLECTUAL PROPERTY IN THE NEW TECHNOLOGICAL AGE* 1-2 (2d ed. 2000). Essentially, intellectual property law developed as a means to protect ideas that “exist in the mind and work of humans.” *Id.* at 1.

6. Laurie A. Santelli, Comment, *New Battles Between Freelance Authors and Publishers in the Aftermath of Tasini v. New York Times*, 7 J.L. & POL'Y 253, 257 n.20 (1998) (citing Marshall Leaffer, *Protecting Authors' Rights in a Digital Age*, 27 U. TOL. L. REV. 1, 3 (1995)) (stating copyright protection was not necessary before the invention of the printing press because of the difficulty of copying and mass producing authors' works).

7. In essence, copyright protection is afforded to authors in order “[t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.” U.S. CONST. art. I, § 8, cl. 8. See also MERGES ET AL., *supra* note 5, at 352 (stating that the purpose of copyright protection is to “achieve an optimal balance between fostering incentives for the creation of literary and artistic

authors against unauthorized copying of a wide range of artistic and literary expression.⁸

To receive copyright protection, the artistic or literary expression must be original and in a tangible form.⁹ If the expression meets these requirements, 17 U.S.C. § 106 grants the author exclusive rights to the expression.¹⁰ Not only does United States copyright law allow a copyright holder protection against unauthorized copying, but it also entitles the holder to transfer ownership of his copyright,¹¹ make derivative works,¹² and control the sale and distribution of the work.¹³

works and the optimal use and dissemination of such works.”); *Washingtonian Pub. Co. v. Pearson*, 306 U.S. 30, 36 (1939) (stating that copyright protection affords “greater encouragement to the production of literary works of lasting benefit to the world.”).

8. *See, e.g.*, *MERGES ET AL.*, *supra* note 5, at 23, 27. For example, the U.S. copyright system covers everything from books to computer software to artistic portraits. *Id.*

9. *Id.* at 27; Santelli, *supra* note 6, at 260 n.33 (indicating that an example of an expression in tangible form includes an author’s thoughts written on paper).

10. 17 U.S.C. § 106 (2001) states:

[T]he owner of copyright under this title has the exclusive rights to do and to authorize any of the following:

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

Id. However, the owner’s exclusive rights are subject to exceptions such as 17 U.S.C. § 107 (2001) (the “fair use privilege”), which permits the use of copyrighted work “for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research . . .”

11. 17 U.S.C. § 106 (2001). An owner’s exclusive rights are divisible and transferable. *See, e.g.*, Yuri Hur, Note, *Tasini v. New York Times: Ownership of Electronic Copyrights Rightfully Returned to Authors*, 21 *LOY. L.A. ENT. L. REV.* 65, 70 (2000). *See also infra* note 18 and accompanying text.

12. *MERGES ET AL.*, *supra* note 5, at 27. The difference between “derivative works” and “collective works” is crucial to understanding copyright law. 17 U.S.C. § 101 (2001) 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

Prior to the enactment of the Copyright Act of 1976¹⁴ an author risked losing his copyright if he published an article in a collective work.¹⁵ In addition, the doctrine of copyright “indivisibility” prevented an author from assigning the right of publication to a specific periodical.¹⁶ In 1976 Congress addressed these problems by revising the Copyright Act of 1909.¹⁷ The resulting Copyright Act of 1976 eliminated the doctrine of copyright indivisibility and structured an author’s copyright into many exclusive rights that could be owned or transferred individually.¹⁸ The Act also provided that no more than one notice is needed for the collective work to protect a freelance author’s rights.¹⁹

Finally, Congress included in the Act the Collective Work

assembled into a collective whole.” Derivative works, although similar to collective works in that they use preexisting copyrighted works, “differ from collective works . . . in that [they] include an original contribution to one or more of the preexisting works, [thus] transforming or adapting the material to form a new work.” Hur, *supra* note 11, at 72.

13. 17 U.S.C. § 106.

14. 17 U.S.C. § 101-803.

15. For example, if a publisher failed to print a copyright notice in the author’s name when publishing the author’s article in a collective work, the author’s copyright was threatened. *New York Times Co., Inc. v. Tasini*, 533 U.S. 483, 494 (2001) (citing Copyright Act of 1909 § 18, 35 Stat. 107a) (“Pre-1976 copyright law recognized a freelance author’s copyright in a published article only when the article was printed with a copyright notice in the author’s name.”). The Copyright Act defines a “collective work” as one “in which a number of contributions, constituting separate and independent works in themselves, are assembled into a collective whole.” 17 U.S.C. § 101 (2001).

16. Under the doctrine of indivisibility, “when a copyright notice appeared only in the publisher’s name, the author’s work would fall into the public domain, unless the author’s copyright, in its entirety, had passed to the publisher.” 533 U.S. at 494 (citing A. Kaminstein, *Divisibility of Complaints*, Study No. 11, in *Copyright Revision Studies Nos. 11-13*, prepared for the Senate Committee on the Judiciary 86th Cong., 2d Sess., 18 (1960)). An author’s copyright, in its entirety, could pass to the publisher by a contract, but absent an express contract, a court may find that the author “tacitly transferred” the entire copyright to the publisher, and that the publisher “hold[s] the copyright in ‘trust’ for the author’s benefit.” *Id.* at 494-95. See also 3 MELVILLE NIMMER & DAVID NIMMER, *NIMMER ON COPYRIGHT* § 10.01[C][2] (2000).

17. Copyright Act of 1909, Pub. L. No. 60-349, ch.320, 35 Stat. 1075, 1081, *superseded by* 17 U.S.C. §§ 101-914 (1982). According to the *Tasini* Court, Congress revised the Copyright Act of 1909 to “clarify and improve [this] confused and frequently unfair legal situation with respect to rights in contributions.” 533 U.S. at 495 (quoting H.R. REP. NO. 94-1476, at 122 (1976), *reprinted in* U.S.C.C.A.N. 5659, 5738).

18. 17 U.S.C. § 201(d) (2001) (addressing the elimination of the doctrine of indivisibility and transfer of ownership); 17 U.S.C. § 106 (2001) (outlining an author’s exclusive rights).

19. 17 U.S.C. § 404(a) (2001).

Privilege, which defines the rights that exist in a collective work.²⁰ Specifically, the Collective Work Privilege provides that a copyright in an individual contribution is discrete from a copyright in a collective work as a whole.²¹ In addition, the Collective Work Privilege provides that in most circumstances, publishers own copyrights in collective works, but not in individual articles.²² As a result, the Copyright Act of 1976 establishes a more equal balance between authors' rights and publishers' rights than did the Copyright Act of 1909.²³

Overall, the United States copyright system provides a means by which the benefits afforded to individual authors eventually lead to significant public gain.²⁴

II. THE *TASINI* FACTS

Tasini is the first Supreme Court ruling relating United States copyright law to electronic publishing.²⁵ In *Tasini*, the lead plaintiff, Jonathan Tasini, along with other authors²⁶ (the "Authors") alleged that their copyrights in twenty-one articles (the "Articles") written for the New York Times Company (the "New York Times"), Newsday,

20. The Collective Work Privilege 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 part of that particular collective work, any revision of that collective work, and any later collective work in the same series.

17 U.S.C. § 201(c) (2001). As a result of the Collective Work Privilege, a "publishing company could reprint a contribution from one issue in a later issue of its magazine, and could reprint an article from a 1980 edition of an encyclopedia in a 1990 revision of it; the publisher could not revise the contribution . . . itself or include it in a new anthology or an entirely different magazine or other collective work." H.R. REP. NO. 94-1976, at 122-23, *reprinted in* U.S.S.C.A.N. 5659.

21. 17 U.S.C. § 201(c).

22. *Id.*

23. H.R. REP. NO. 94-1976, at 122, *reprinted in* U.S.S.C.A.N. 5659.

24. *Mazer v. Stein*, 347 U.S. 201, 219 (1954).

25. Hur, *supra* note 11, at 66 ("*Tasini* was the first case to merge copyright law with electronic publishing and media rights transfers.>").

26. The other authors involved in the case are Mary Kay Blakely, Barbara Garson, Margot Mifflin, Sonia Jaffe Robbins and David S. Whitford. 533 U.S. at 488.

Inc. (“Newsday”) and Time, Inc. (“Time”) (collectively, the “Print Publishers”) had been infringed by the articles’ inclusion in electronic databases.²⁷ At the time of publication, the Authors possessed registered copyrights in each of the Articles, and the Print Publishers had registered copyrights in each edition of the periodical in which the Articles initially appeared.²⁸

When the Articles were published, the Print Publishers had an agreement with LEXIS/NEXIS, an electronic database that stores information in a textual format.²⁹ The agreement granted LEXIS/NEXIS the text of and the right to copy and sell any article that appeared in the Print Publishers’ periodicals.³⁰ Thus, LEXIS/NEXIS places these articles on its electronic database, and a subscriber to LEXIS/NEXIS may perform a computerized search for articles and can then view, print, or download articles.³¹

The New York Times had a separate licensing agreement with University Microfilms International (“UMI”).³² The agreement allowed for the reproduction of *New York Times* articles on two CD-ROM products, the New York Times OnDisc (“NYTO”) and General Periodicals OnDisc (“GPO”).³³

In December 1993, the Authors filed a civil action alleging copyright infringement.³⁴ The Authors claimed that placing their Articles in the LEXIS/NEXIS, the NYTO, and the GPO databases (collectively, the “Electronic Databases”) violated their copyrights.³⁵ LEXIS/NEXIS, UPI (together, the “Electronic Publishers”), and the

27. 533 U.S. at 487.

28. *Id.* at 489.

29. *Id.* LEXIS/NEXIS is the owner and operator of NEXIS, which contains a variety of articles from numerous periodicals and newspapers dating back many years. *Id.*

30. *Id.*

31. *Id.* (“The display of each articles includes the print publication (*e.g.*, The New York Times), date (September 23, 1990), section (Magazine), initial page number (26), headline or title (‘Remembering Jane’), and author (Mary Kay Blakely).”).

32. *Id.*

33. *Id.* Like LEXIS/NEXIS, NYTO is a text-only system that only contains articles from the Times, and offers an index of these articles. GPO contains articles from approximately 200 publications, and, unlike LEXIS/NEXIS and NYTO, it is an image-based, rather than a text-based system. *Id.* GPO CD-ROMs show each article exactly as it appeared on the printed pages, and also provides an index and abstracts of all the articles in GPO. *Id.* at 490-91.

34. *Id.* at 491-92.

35. *Id.* at 491.

Print Publishers defended the action by asserting the Collective Work Privilege.³⁶ Both parties moved for summary judgment.³⁷

While, the Authors and the Print Publishers agreed that the periodicals, in print form, constituted collective works under the Copyright Act, they disagreed as to whether the articles, as they appeared in electronic databases, were part of a collected work.³⁸ The Authors moved for summary judgment on the basis that the reproduction of the Articles in the Electronic Databases violated their rights under the Copyright Act.³⁹ The Authors argued that the Print Publishers went beyond the narrow scope accorded to them by the Collective Work Privilege when they sold the Authors' articles for reproduction in the Electronic Databases.⁴⁰ In particular, the Authors contended that the Electronic Databases did not legitimately revise the Print Publishers' collective works, but rather improperly used the Authors' individual contributions.⁴¹

The Print Publishers moved for summary judgment on the basis that the Authors had authorized the Print Publishers, through formal contracts, to sell the Authors' individual contributions to the Electronic Publishers.⁴² The Print Publishers further argued that, notwithstanding the formal contracts, their actions were still in compliance with the Copyright Act.⁴³ Specifically, the Print Publishers maintained that they exercised their rights under the

36. *Id.* The Print and Electronic publishers defended the action by asserting that they possessed "the reproduction and distribution privilege accorded collective work copyright owners by [the Collective Work Privilege]." *Id.*

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

38. Jonathan T. Elder, Legal Update, *Supreme Court To Hear Arguments On Electronic Database Copyrights For Freelance Journalists*, 7 B.U. J. SCI. & TECH. L. 406, 407 (2001).

39. 972 F. Supp. at 806.

40. *Id.* at 809.

41. *Id.*

42. *Id.* at 806. Time relied upon "the 'first right to publish' secured in its written contract with plaintiff [David S.] Whitford." *Id.* at 809. "Newsday relie[d] upon the check legends authorizing the publisher to include [the Authors'] articles 'in electronic library archives.'" *Id.*

It is worth noting that that the district court disagreed with the Print Publishers on this matter. 972 F. Supp. at 811. In particular, the court found that "there [was] no basis for holding that the Newsday check legends effected an unambiguous and timely transfer of any significant electronic rights in [the Authors'] articles." *Id.* Because the district court disposed of the issue of express transfer of electronic rights, this Note focuses solely on the Collective Work Privilege and the rights it accords.

43. *Id.* at 806.

Collective Work Privilege in order to produce revised versions of the Authors' contributions.⁴⁴ Thus, the district court decided only whether or not the Electronic Publishers' "revisions" were authorized under the Print Publishers' Collective Work Privilege.⁴⁵

On August 13, 1997, the district court granted the Print Publishers' motion for summary judgment and denied the Authors' motion.⁴⁶ The district court first held that the Collective Work Privilege permits a print publisher to "transfer" a collective work from one medium to another (i.e., from a print format to an electronic format), without violating the Copyright Act.⁴⁷ The district court also held that the Collective Work Privilege provides the Print Publishers with the right to transfer some of their exclusive rights in the Authors' individual contributions to the Electronic Publishers.⁴⁸ Finally, the court held that placing the Articles on the Electronic Databases merely constituted "revisions" of the collective works.⁴⁹

44. In particular, the Print Publishers maintained that the Electronic Databases "merely generate 'revisions of [the Print Publishers'] collective works [as per the Collective Work Privilege],' and therefore do not usurp [the Authors'] rights in their individual articles." *Id.* at 809.

45. *Id.* at 812.

46. *Id.* at 827.

47. The district court reasoned that the Collective Work Privilege "contains no express limitation upon the medium in which a revision can be created." *Id.* at 817. Rather, the court stated that "any revision" of a collective work is permissible, provided it is a revision of "that collective work." *Id.* at 817-18.

48. The district court held that the term "privilege," as used in the Collective Work Privilege, "underscore[s] that the creators of collective works have only limited rights in the individual contributions making up their collective works; the term does not indicate that the creators of collective works are limited in exercising those few rights, or 'privileges,' that they possess." *Id.* at 816. The Court thus concluded, "to the extent that the electronic reproductions qualify as revisions under [the Collective Work Privilege], the [Print Publishers] were entitled to authorize the [Electronic Publishers] to create those revisions." *Id.*

49. The district court reasoned:

Because a collective work typically possesses originality only in its selection and arrangement of materials, it is to be expected that, in a revised version of such a work, either the selection or arrangement will be changed or perhaps even lost. This is precisely what has happened here. Lacking the photographs and page lay out of the disputed periodicals, NEXIS and [NYTO] plainly fail to reproduce the original arrangement of materials included in the [Print Publishers'] periodicals. By retaining the [Print Publishers'] original selection of articles, however, the [Electronic Publishers] have managed to retain one of the few defining original elements of the [Print Publishers'] collective works. In other words, [the Electronic Databases] carry recognizable versions of the [Print Publishers'] newspapers and magazines. For the purposes of [the Collective Work Privilege], then, [the Print and Electronic Publishers]

The Authors appealed the decision to the Court of Appeals for the Second Circuit.⁵⁰

On February 25, 2000, the Second Circuit unanimously reversed the district court decision and remanded the case with instructions to enter judgment for the Authors,⁵¹ holding that the Electronic Databases were not revisions of the Print Publishers' collective works.⁵² The Second Circuit chose not to rule on the issue of the transferability of the Collective Work Privilege,⁵³ holding only that the inclusion of the Articles in the Electronic Databases exceeded the scope of the Collective Work Privilege, and therefore violated the Authors' rights under the Copyright Act.⁵⁴ On June 25, 2001, the United States Supreme Court affirmed the Second Circuit decision.⁵⁵

III. THE SUPREME COURT'S ANALYSIS OF THE COLLECTIVE WORK PRIVILEGE

The Supreme Court, in *Tasini*, held that the Collective Work Privilege helped an author maintain his copyright in his article by regulating the publisher's copyright in its collective work.⁵⁶ While

have succeeded at creating 'any revisions' of those collective works.

Id. at 824-25.

50. *Tasini v. New York Times Co., Inc.*, 206 F.3d 161 (2d Cir. 2000).

51. *Id.* at 172.

52. The court noted that "in reproducing the [Print Publishers'] collective works in the electronic databases, the selection, coordination, and arrangement of the preexisting collection [were] lost, thereby depriving it of 'revision' status." *Id.* at 168-69.

53. *Id.* at 165.

54. *Id.* at 166. *See also* Hur, *supra* note 11, at 88.

55. *New York Times Co., Inc. v. Tasini*, 533 U.S. 483 (2001). *See infra* Part III for a detailed discussion of the Court's analysis.

56. The Court stated:

Essentially, [the Collective Work Privilege] adjusts a publisher's copyright in its collective work to accommodate a freelancer's copyright in her contribution. If there is demand for a freelance article standing alone or in a new collection, the Copyright Act allows the freelancer to benefit from that demand; after authorizing initial publication, the freelancer may also sell the article to others.

Id. at 497 (citing *Stewart v. Abend*, 495 U.S. 207, 229 (1990)). The Court also noted that the congressional purpose in preserving an author's copyright in his contribution would not be satisfied "if a newspaper or magazine publisher were permitted [by the Court] to reproduce or distribute copies of the author's contribution in isolation or within new collective works." *Id.* at 497. *See also* H.R. REP. NO. 94-1976, at 122.

the Print and Electronic Publishers in *Tasini* argued that the reproduction and distribution of the Authors' Articles in the Electronic Databases fell within the Collective Work Privilege,⁵⁷ the Court disagreed, stating the Publishers' actions diminished the Authors' exclusive rights under section 107 of the Copyright Act.⁵⁸

To determine whether the Authors' Articles were part of a revision of a collective work, the Court focused on the Articles "as presented to, and perceptible by, the user of the [Electronic] Databases."⁵⁹ The Court found that the Electronic Databases failed to plainly reproduce and distribute the Authors' Articles either "as part of" its original edition or as a "revision" to that edition.⁶⁰ The Court defined "revision" to mean a new version as within the scope of the Collective Work Privilege.⁶¹ The Court urged that the Articles may be viewed as parts of a "novel compendium,"⁶² and stated that each version of the periodical in that novel compendium only corresponded to a small portion of the expanding database.⁶³ Thus,

57. 533 U.S. at 499.

58. *Id.* at 499. *See also* 17 U.S.C. § 107.

59. *Id.* (citing 17 U.S.C. § 102(a) (2001)) ("Copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device . . .").

60. 533 U.S. at 499-500 (reasoning that the Electronic Databases "present[ed] articles to users clear of the context provided either by the original periodical editions or by any revision of those editions").

61. *Id.* at 500 (citing WEBSTER'S THIRD NEW INTERNATIONAL DICTIONARY 1944, 2545 (1976)) ("Revision" denotes a new 'version,' and a version is, in this setting, a 'distinct form of something regarded by its creator or others as one work.'). *But cf.* 972 F. Supp. at 819-20, 24 (using broader "substantially similar" test to define "revision"). *See also* Josh J. May, *Tasini v. New York Times Co.*, 16 BERKELEY TECH L.J. 13, 22-23 (2001) (providing an example that criticizes the district court's interpretation of revision).

The district court's use of the substantial similarity test to define the revision presented an unfair burden to freelance authors because it did not consider that while many authors were not compensated for their work, the Electronic Publishers compensated the Print Publishers. *See generally* Irene Segal Ayers, *International Copyright Law and the Electronic Media Rights of Authors and Publishers*, 22 HASTINGS COMM. & ENT. L.J. 29, 42 n.63 (1999). To overcome this burden, some have suggested an additional test to the substantial similarity used by the district court in order to define revision. *Id.* (citing Alice Haemmerli, *Commentary: Tasini v. New York Times Co.*, 22 COLUM.-VLA J.L. & ARTS 129, 148 (1998) (suggesting the use of "commercial-similarity" and "nature-of-public-access tests").

62. 533 U.S. at 500. The Court defined compendium as the "entirety of works in [an] [Electronic] Database." *Id.*

63. *Id.*

the Court concluded, “[t]he massive whole of the [Electronic] Database is not recognizable as a new version of its every small part.”⁶⁴

In determining whether the Authors’ Articles were part of a collective work, the Court examined whether, on the Electronic Databases, the Authors’ Articles could be perceived as individual articles.⁶⁵ The Court held if the Authors’ Articles could be viewed as individual articles this infringed upon the Authors’ exclusive rights under § 106 of the Copyright Act.⁶⁶ The Print and Electronic Publishers urged that transferring work to a different form of media does not alter the character of that work.⁶⁷ However, the Court found that the transfer of the Authors’ Articles from periodicals to the Electronic Databases did not characterize a “mere conversion”⁶⁸ because an Electronic Database user may not perceive the Authors’ Articles as part of a collective work.⁶⁹ The Print and Electronic Publishers also contended that the Collective Work Privilege protects them because the users of an Electronic Database can fashion their search query to retrieve all the articles from a specific periodical edition.⁷⁰ The Court, however, also dismissed this argument,⁷¹ concluding that the Collective Work Privilege did not protect the electronic and print publishers from copyright infringement.⁷²

64. *Id.*

65. *Id.*

66. *Id.* at 500-01. *See also* 17 U.S.C. § 106.

67. 533 U.S. at 502 (citing Brief for Petitioners at 23).

68. *Id.*

69. *Id.* at 502-03 (analogizing the Electronic Databases to an imaginary library that has individual copies of articles, rather than intact periodicals). *See also* 17 U.S.C. § 106.

70. *Id.* at 504.

71. The Court reasoned that:

The fact that a third party can manipulate a database to produce a noninfringing document does not mean the database is not infringing. Under [the Collective Work Privilege], the question is not whether a user can generate a revision of a collective work from a database, but whether the database itself perceptibly presents the author’s contribution as part of a revision of the collective work. That result is not accomplished by these [Electronic] Databases.

Id.

72. *Id.* at 504-06.

IV. ETHICAL AND ECONOMIC IMPLICATIONS OF THE COURT'S DECISION

The Court's decision in *Tasini* will have far reaching effects on the publishing industry, freelance authors, and the public both retroactively and in the future.⁷³ First, because of the Internet's quick and easy access to a wealth of information, the Court's decision will complicate some of the purposes and goals of the publishing industry,⁷⁴ such as providing Internet users with a comprehensive library on the Internet.⁷⁵ In order to avoid copyright infringement suits by authors or to avoid royalty payments to authors, publishers may choose to remove articles from electronic databases, thus depriving the public of a thorough electronic record.⁷⁶

Second, the Court's decision in *Tasini* will not only inevitably cost many print and electronic publishers large sums of money, but it will also lead to increased social costs. Although print and electronic publishers will withdraw from electronic databases any material that may violate the Collective Work Privilege, or any other section of the Copyright Act, they will not avoid all copyright infringement liability,⁷⁷ as they may be liable to freelance authors for copyright infringement that took place prior to the Court's decision.⁷⁸ In addition, many innocent parties, such as libraries, will have to endure a greater burden and pay a higher price than they did in the past.⁷⁹

73. See generally Hur, *supra* note 11, at 90-91.

74. See, e.g., Charles S. Sims & Matthew J. Morris, *Tasini and Archival Electronic Publication Rights of Newspapers and Magazines*, 18-WTR COMM. LAW. 9, 14 (2001).

75. See Hur, *supra* note 11, at 92-93 (noting that the *Tasini* decision will affect Internet users expecting to find website archives and will affect the use of electronic information worldwide).

76. See *id.* at 93; Sims & Morris, *supra* note 74 at 15 (predicting the harm of "wholesale deletions" on the public, which would result if the Supreme Court affirmed the Second Circuit decision). But cf. Wendy J. Gordon, *Fine-Tuning Tasini: Privileges of Electronic Distribution and Reproduction*, 66 BROOK. L. REV. 473, 483-83 (stating that "although some excision from the electronic record is possible, the extent of such losses is easily exaggerated").

77. See Gordon, *supra* note 76, at 494 n.94.

78. See Hur, *supra* note 11, at 92 (relying on Jason Williams, *Court Decision for Freelancers Could Leave Gaps in Archives*, EDITOR & PUBLISHER, Oct. 2, 1999, at 5) ("[*Tasini*] could potentially cost publishers millions of dollars by rendering them liable to freelance authors. This potential liability results largely from the authors' retroactive claims of infringement on articles posted in electronic archives.")

79. See Gordon, *supra* note 76, at 494 n.98; Hur, *supra* note 11, at 90-91 ("*Tasini*

Finally, the *Tasini* decision may lead to a power imbalance between publishers and freelance authors.⁸⁰ The Court's decision mandates that print and electronic publishers obtain some kind of permission from the freelance authors to publish the authors' articles in an electronic database.⁸¹ Additionally, the freelance authors could demand from the print and electronic publishers hefty compensation for their contributions.⁸²

V. ARE THE FREELANCE AUTHORS REALLY BETTER OFF THAN BEFORE *TASINI*?

Despite the asserted potential negative effects on the print publishing and electronic publishing industries,⁸³ these effects are exaggerated. The Court in *Tasini* correctly interpreted the Collective Work Privilege, and therefore correctly decided the issue in favor of the Authors. Having affirmed the Second Circuit's judgment in favor of the Authors, the Court remanded the case to the district court to determine remedies available to the Authors.⁸⁴

Thus far, the district court has not provided the Authors with any relief for the Electronic and Print Publishers' copyright violations. Since the district court has broad discretion in granting relief to the Authors, it should exercise extreme caution in determining the appropriate remedies. The district court should necessarily grant the Authors damages for the profits earned by the Print and Electronic Publishers as a result of the copyright infringement.⁸⁵ The district

significantly impacts digital products, web sites, or electronic databases created by reference books and encyclopedia publishers").

80. See, e.g., Mark R. Kravitz, *Developments in the Second Circuit: 1998-1999*, 32 CONN. L. REV. 949, 995-96 (2000) ("It remains to be seen what licensing arrangements a publisher will, as a practical matter, be able to obtain given the newly-found clout of freelance authors and journalists."); Santelli, *supra* note 6, at 268-70. *But cf.* Gordon, *supra* note 76, at 494-95 n.98.

81. Hur, *supra* note 11, at 94 ("In order for publishers to continue their electronic publishing of freelance works, they must first obtain permission from authors.")

82. See *id.* at 94; May, *supra* note 61, at 31.

83. See *supra* Part IV.

84. 533 U.S. at 496. The Copyright Act remedies for copyright infringement include injunctions, impounding and disposition of infringing articles, damages, and profits. 17 U.S.C. §§ 501-510 (2001).

85. 17 U.S.C. § 504 (2001).

court, however, should not grant an injunction⁸⁶ that halts the use or distribution of the Authors' articles. If the district court grants an injunction, it may lead to an ironic situation in which freelance authors would have to give up some of their rights in order to grant the Publishers permission to use or distribute their articles.⁸⁷ Unfortunately, if a permanent injunction is granted, the freelance authors will be confronted with a "Hobson's Choice,"⁸⁸ which will ultimately defeat the Constitutional and Congressional purpose in enacting the Copyright Act.⁸⁹ Essentially, an injunction will deplete the public's access to information because it is relatively easy and cost-free to delete or discontinue use of freelance authors' articles from electronic databases.⁹⁰ An injunction will also thwart a freelance author's publication opportunities, thereby leading to significant professional and financial costs. Clearly when the purposes of copyright protection were elucidated in the Constitution and in the Copyright Act, neither our Framers nor our Congressmen intended for anyone to be confronted with this kind of situation.

CONCLUSION

The Court in *Tasini* is the first to correctly interpret the Collective Work Privilege with respect to freelance authors' contributions to parent companies who subsequently sell the contributions to electronic databases. The Court obviously favors freelance authors' rights in their artistic and literary expressions. However, the remedies that the district court may provide the freelance authors with may or may not favor these rights. The district court could remedy the wrong by awarding damages to the Authors, while it could worsen the

86. 17 U.S.C. § 502 (2001).

87. After the Court's decision in *Tasini*, the New York Times notified all of its published freelance authors that if the *Tasini* decision affected any of them, those affected authors must release the New York Times from financial liability arising out of the *Tasini* copyright infringement suit. *Tasini v. New York Times Company, Inc.*, 184 F. Supp. 2d 300, 352-53 (S.D.N.Y. 2002).

88. In this scenario, an author must decide between compromising the protection of his or her artistic or literary expression or compromising the public's ability to obtain information from new technologies. *Id.* at 553.

89. See discussion *supra* Part I.

90. See *Sims & Morris*, *supra* note 74, at 15.

situation for the Authors by granting an injunction, because an injunction would negatively affect freelance authors' rights and would hamper the public's access to information.