

Fordham Intellectual Property, Media and Entertainment Law Journal

Volume 14 *Volume XIV*
Number 2 *Volume XIV Book 2*

Article 2

2004

Tasini and Its Progeny: The New Exclusive Right or Fair Use on the Electronic Publishing Frontier?

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Recommended Citation

Lateef Mtima, *Tasini and Its Progeny: The New Exclusive Right or Fair Use on the Electronic Publishing Frontier?*, 14 *Fordham Intell. Prop. Media & Ent. L.J.* 369 (2004).

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Cover Page Footnote

The author would like to thank Reiko Suber and M. Delanee Wijesekera, HUSL '03, Robin Terry and Aisha Williams, HUSL '05, and lead researcher Lyzette Wallace, HUSL '04, for their excellent research assistance in the preparation of this Article. The author would also like to thank his HUSL colleagues Steven Jamar, Warner Lawson, Cynthia Mabry, Laurence Nolan, and Andrew Taslitz; and his practicing colleagues, Sharon Appel and I. Fred Koenigsberg of White & Case, for their many helpful comments on various drafts of this work. Finally, he would like to express his appreciation to HUSL Dean Kurt L. Schmoke, Dean Emeritus Alice Gresham Bullock, and the Howard University School of Law for its financial support.

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Lateef Mtima*

INTRODUCTION	370
I. THE <i>TASINI</i> , <i>GREENBERG</i> , AND <i>RANDOM HOUSE</i> DECISIONS ..	379
A. New York Times Co. v. <i>Tasini</i>	380
1. The Dispute Over the Use of the Freelance Writers' Contributory Articles.....	382
2. Are Digital Re-Publications § 201(c) Revisions? .	383
3. The Supreme Court's Decision	387
B. <i>Greenberg v. National Geographic Society</i>	390
C. <i>Random House, Inc. v. Rosetta Books</i>	392
D. <i>The Right of Digital Re-Publication: To Whom Does It Belong?</i>	395
II. DIGITAL RE-PUBLICATION AND THE COPYRIGHT LAW	396
A. <i>Classifying the "New Use" of Digital Re-Publication</i>	401

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370	<i>FORDHAM INTELL. PROP. MEDIA & ENT. L.J.</i> [Vol. 14:369]	
	B. <i>Fortnightly and Teleprompter: When Cable Television Was a “New Use”</i>	405
	C. <i>Digital Re-Publication: Sui Generis Use or a New Exclusive Right?</i>	409
III.	UNAUTHORIZED DIGITAL RE-PUBLICATION AND § 201(C)....	415
	A. <i>Interpreting § 201(c) in the Wake of Tasini and Greenberg</i>	417
	B. <i>Exact Digital Replicas: Revisions or New Publications?</i>	419
	C. <i>Exact Digital Replicas Are Not § 201(c) Revisions</i>	422
	D. <i>What Constitutes a Revision?</i>	422
	E. <i>Treating Content-Altered Digital Re-Publications as Archive Versions</i>	426
IV.	DIGITAL RE-PUBLICATION AND THE FAIR USE DOCTRINE	428
	A. <i>Fair Use in Tasini and Greenberg</i>	430
	B. <i>Reevaluating Digital Re-Publication Market Impact as a Question of Fair Use</i>	433
	C. <i>Revisiting Application of the Fair Use Factors to Tasini</i>	436
V.	DIGITAL RE-PUBLICATION, PUBLISHING TRADE PRACTICES, AND THE COPYRIGHT ACT	443
	A. <i>Licensing Electronic Use, Establishing Electronic Infringement</i>	444
	B. <i>Emphasizing Exclusive Rights in Drafting and Interpreting Copyright Licenses</i>	449
	C. <i>Applying an Exclusive Rights Emphasis to Tasini, Random House, and Other “New Use” Disputes</i>	452
	D. <i>The Presumption of “Technological Neutrality”</i>	455
	CONCLUSION.....	459

INTRODUCTION

The U.S. Supreme Court’s decision in *New York Times Co. v. Tasini*, which concerned a publisher’s right to use previously published and printed copyrighted material in subsequent

electronic media publications,¹ has stirred publishers, authors, and perhaps most frenetically their attorneys, to review and reassess their standard publishing contracts.² The question on everyone's minds is whether these agreements effectively provide for the use and publication of copyrighted material in the new electronic media formats—and if not, how can they be redrafted to comply with *Tasini*?³ Contrary to the popular presumption, however, *Tasini* does not pronounce upon the application of standard, print media licensing terms to electronic uses of copyrighted material—at least not directly. Indeed, the Supreme Court invalidated the electronic media publications before it on extremely narrow grounds, and went to great lengths to underscore that the scope of the parties' print media license agreements was not an issue before the Court, and therefore was not a factor in its determinations as to the legality of the electronic publications in question.⁴

In this regard, the *Tasini* decision is not atypical. Distilling concrete and comprehensive directives from copyright/new technology litigation disputes has never been easy. Indeed, the development and proliferation of digital publishing technology has led to a number of *Tasini*-type copyright controversies in recent years, many of which have also resulted in very narrow holdings, limited in their application to the larger copyright questions presented in the digital information context.⁵ Interpreting and

¹ 533 U.S. 483, 487 (2001).

² Cf. Robert H. Thornburg, *The Presumption Against Implied Transfer of Electronic Rights in Licenses Under Section 201(c) of the 1976 Copyright Act: A New Right for the Bundle*, 2002 U. ILL. J.L. TECH. & POL'Y 235, 251 (2002) ("With the narrowing of limitations on what constitutes revisions . . . , publishers must replace their traditional handshake agreements with licenses specifically addressing electronic rights. While publishers may wish to receive electronic rights currently known or later developed, freelance authors typically seek to grant limited rights, to take advantage of new markets that will develop in the future." (citations omitted)).

³ Cf. Mark B. Radefeld, Note, *The Medium Is the Message: Copyright Law Confronts the Information Age in New York Times v. Tasini*, 36 AKRON L. REV. 545, 577 n.177 (2003) (noting ways in which authors and publishers have included electronic rights provisions in their agreements).

⁴ See *Tasini*, 533 U.S. at 499–502.

⁵ See generally e.g., *Random House, Inc. v. Rosetta Books LLC*, 150 F. Supp. 2d 613 (S.D.N.Y. 2001) (basing the denial of a preliminary injunction against the publisher of "e-books" on the contract language between the authors and the original publisher), *aff'd*, 283 F.3d 490 (2d Cir. 2002).

adapting copyright canons and license terms developed in connection with traditional uses for copyrighted material, to account for revolutionary technological advances, is an inevitably incremental and iterative process.

Nonetheless, close examination of the pertinent copyright and digital information cases reveals that the stilted progress toward a comprehensive digital information copyright jurisprudence is only partially due to the difficulties inherent in applying traditional copyright mechanisms and policies to technologically advanced uses for copyrighted works. Much of the jurisprudential lethargy can also be attributed to the perennial failure of lawyers and other participants in the publishing trade to harmonize their licensing practices with the express mandates of the copyright statute.

For example, the lack of specific—and in some instances even *written*—license terms and agreements in cases like *Tasini*, and the factually parallel *Greenberg v. National Geographic Society*,⁶ has germinated surrealistic interpretations of the copyright statute by publishers seeking to bring their unauthorized electronic publication activities within the law.⁷ Conceding that their endeavors were not sanctioned by their informal and ambiguous contractual arrangements, the publishers tried vainly to fit their conduct within the “safe harbor” of the obscure § 201(c) of the Copyright Act,⁸ which under very limited circumstances, allows publishers to republish certain kinds of copyrighted works without the author or copyright holder’s permission.⁹ Even in a case such as *Random House, Inc. v. Rosetta Books*, in which the rights of the parties were governed by specific, written license agreements,¹⁰ the dispositive clauses in those agreements were not cast in terms of the express rights provided by the copyright statute. Instead, the operative terms were expressed in ambiguous publishing trade

⁶ 244 F.3d 1267, 1269 (11th Cir. 2001).

⁷ Cf. 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, 297–98 (1998) (arguing that, under the copyright laws, publishers should not be able to reproduce freelancers’ work without their consent).

⁸ 17 U.S.C. §§ 101–1332 (2003).

⁹ See 17 U.S.C. § 201(c) (2003) (discussing ownership of copyrights in collective works).

¹⁰ 150 F. Supp. 2d 613, 615–17 (S.D.N.Y. 2001), *aff’d*, 283 F.3d 490 (2d Cir. 2002).

lingo, which required extensive judicial deciphering in resolving the dispute.¹¹ Thus, efforts by the courts to apply and adapt the body of existing copyright jurisprudence to electronic publication disputes have been hampered by the failure of litigants to adhere to the express provisions of the copyright law in arranging and memorializing their copyright transactions.

In addition to the copyright conundrums innate to rapid technological advancement, exacerbated by the persistently obstructive licensing practices in the publishing trade, there is another important factor that accounts for the lack of comprehensive progress in digital information copyright jurisprudence: the absence of any in-depth analysis of the fair use doctrine in the relevant cases.¹² Given the critical public interest in the proliferation and use of digital technology as a whole, and in electronic publication and dissemination of copyrighted works in particular, fair use seems an appropriate course of expedition. Notwithstanding the vital importance of balancing the competing interests of authors, publishers, and the general public, however, there has been little exploration of fair use as a social engineering solution to the digital information/copyright conflict.

Consequently, much of the current electronic publishing legal landscape remains an unsettled and uncertain frontier. Ambiguities resulting from rapid technological advance and murky licensing practices are unmitigated by publishers resorting to the heretofore unexplored (and ultimately inapplicable) § 201(c) as the primary digital re-publication defensive strategy.¹³ Admittedly, however, the failure to reform licensing practices and litigation strategies is only part of the problem. In a much larger sense, electronic use and dissemination of printed copyrighted material

¹¹ See *id.* at 621–22.

¹² See *N.Y. Times Co. v. Tasini*, 533 U.S. 483, 499–502 (2001); *Greenberg*, 244 F.3d at 1274–75; see generally *Random House*, 150 F. Supp. 2d 613.

¹³ Cf. Michael Landau, *The Importance of Electronic Rights Revisited*, GigaLaw.com, at <http://www.gigalaw.com/articles/2001-all/landau-2001-08-all.html> (Aug. 2001) (“Think of all of the excerpts of magazines or newspapers that are reprinted in books with the legend ‘reprinted with the permission of Publisher X.’ Many of those may infringe, even though permission had been obtained from the magazine or newspaper in which the piece originally appeared, for the original publishers may not have had the right under 201(c) to have authorized reproduction.”).

has yet to be independently assessed, not merely as a problem of authors' rights and publishers' interests, but as a question of the public interest and the principal policy objectives of the copyright law.

This Article will offer a framework for the construction of a more progressive and cohesive copyright jurisprudence in the electronic publishing context, by attempting to address some of the principal issues surrounding unauthorized digital re-publication of printed copyrighted works. Part I will briefly summarize the opinions in *Tasini*, *Greenberg*, and *Random House*, three of the leading decisions that involve digital re-publication disputes. Part I will highlight some of the ways in which these decisions collectively delineate many of the salient issues regarding the interface between the author's exclusive property rights under the copyright law and prevailing mechanisms for the commercial exploitation and mass dissemination of copyrighted material in the electronic media age.

Part II will begin the copyright policy analysis of digital re-publication by challenging a prevailing assumption that underlies digital re-publication assessment and adjudication to date: namely, that digital re-publication constitutes engagement in at least one or more of the author's exclusive rights under the copyright law. This part will propose that while it is reasonable to approach digital re-publication as a simulation, incorporation, or combination of various exclusive rights, it is also reasonable to approach digital re-publication as a wholly *sui generis* activity, one completely distinct from any of its constituent, exclusive right elements. Accordingly, the determination as to what property rights copyright holders should have in connection with digital re-publication is one to be made by Congress, with appropriate consideration given to the concerns of all interested parties, particularly that of the general public.

As an alternative to the analysis set forth in Part II, Part III will accept the "digital re-publication as exclusive rights" premise that underlies the leading decisions in this area. Accordingly, Part III will attempt to lay a digital information jurisprudential framework from this perspective, by addressing some of the principal issues raised but left unresolved by these cases.

For example, in *Tasini* and *Greenberg*, the defendant publishers digitally re-published printed “collective works,” such as newspapers and magazines, by, *inter alia*, disseminating them through an electronic database without first obtaining permission from the authors of the individual articles included in these works.¹⁴ The ensuing litigations between the authors/copyright holders and their publishers ultimately centered on § 201(c), which grants the publisher of a collective work a special “privilege” to publish subsequent revisions of such works, without the permission of the contributing authors to the original publication.¹⁵ Relying upon § 201(c), the publishers sought to characterize their digital re-publications as revisions of the original print publications.¹⁶

The courts in both *Tasini* and *Greenberg* held that the digital re-publications were not revisions with the meaning of § 201(c).¹⁷ There were two principal bases upon which the courts disqualified the digital re-publications from shelter within the special statutory privilege. First, the courts found that in undertaking the digital re-publications, the publishers made certain changes to the content of the contributory articles and/or to each collective work overall, which had the effect of rendering each digital re-publication an entirely new publication or independent distribution of each of its contributory articles, as opposed to an omnibus revision and re-publication of the collective work as a whole.¹⁸ Second, both courts reasoned that such new independent distribution would have a devastating impact upon the commercial market for further publication of the individual contributory articles.¹⁹ In other words, the courts determined that once the contributory articles became electronically available, particularly online, no subsequent publisher was likely to pay to publish any of these articles elsewhere. Each of the foregoing results was held to be inconsistent with the legislative purposes underlying § 201(c), and

¹⁴ See *Tasini*, 533 U.S. at 488–89; *Greenberg*, 244 F.3d at 1269–71.

¹⁵ 17 U.S.C. § 201(c) (2002).

¹⁶ See *Tasini*, 533 U.S. at 492; *Greenberg*, 244 F.3d at 1272.

¹⁷ See *Tasini*, 533 U.S. at 500–02; *Greenberg*, 244 F.3d 1275–76.

¹⁸ See *Tasini*, 533 U.S. at 500–02; *Greenberg*, 244 F.3d at 1272–73.

¹⁹ See *Tasini*, 533 U.S. at 497 n.6; *Greenberg*, 244 F.3d at 1274–75.

therefore disqualified the digital versions of the printed collective works from characterization as revisions under the statute.²⁰

These rulings also raised but left unanswered the question of whether *content-unaltered*, print-to-digital reproductions—that is, full-image, exact digital replicas of printed collective works, with no material added or removed—can qualify as revisions under § 201(c). Part III will address this question, and will contend that full-image, exact digital replicas are also beyond the ambit of § 201(c).

There are at least two reasons why exact digital replicas of printed collective works should not be considered § 201(c) revisions. First, exact digital replicas are not revisions, at least not in the ordinary sense of the term, in that nothing has been revised. Second, exact digital replicas are also outside the narrower, judicially construed parameters of the term revision as enunciated in *Tasini* and *Greenberg*. These courts have held that the principal purpose of § 201(c) is to preserve the market for subsequent commercial exploitation of the individual contributory articles that compose a collective work.²¹ Accordingly, just as the courts found with respect to the content-altered, digital versions in *Tasini* and *Greenberg*, full-image, exact digital replicas of collective works, especially when dispersed into commercial online databases, typically will undermine this objective as well, and thereby impede the legislative intent underlying the statute. Thus, Part III will conclude that § 201(c) is ultimately of little value in addressing the substantive copyright issues presented in the digital re-publication context.

Part IV will explore the fair use doctrine as an alternative defense for unauthorized digital re-publication. An important question implicated by the *Tasini* and *Greenberg* findings regarding the negative commercial impact of unauthorized digital re-publication is whether such negative impact forecloses the defense of fair use. Without regard to whether the unauthorized digital re-publication involves full-image, exact digital replicas, or content-altered versions such as those at issue in *Tasini* and

²⁰ See *Tasini*, 533 U.S. at 505–06; *Greenberg*, 244 F.3d at 1272–73.

²¹ See *Tasini*, 533 U.S. at 497; *Greenberg*, 244 F.3d at 1272–73.

Greenberg, the availability of fair use as an alternative defense is implicated because the impact of an unauthorized use on the commercial market for the subject copyrighted work—in this case, each contributory article in the original collective work—is one of the principal factors weighed in determining whether the unauthorized use should be allowed as a fair use.²² Consequently, the *Tasini* and *Greenberg* assessments regarding negative market impact might seem to limit the availability of the fair use defense in unauthorized digital re-publication cases.

While the findings regarding negative market impact in *Tasini* and *Greenberg* appear portentous, it will be argued in Part IV that they are not dispositive as to the availability of the fair use defense in digital re-publication cases. In evaluating an unauthorized use under the fair use doctrine, a court is obliged to evaluate four separate factors, only one of which is the impact of the unauthorized use on the commercial market for the copyrighted work.²³ Moreover, the purpose and significance of assessing market impact under § 201(c), the primary impetus for the analyses in *Tasini* and *Greenberg*, is not identical to that in evaluating market impact under the fair use doctrine. In the context of § 201(c), it is primarily the limited re-publication interests of commercial publishers that are pitted against the author's exclusive rights and interests in reaping the benefits from the commercial exploitation of his or her work.²⁴ In evaluating a claim of fair use, however, it is the public interest in the broadest dissemination of creative works that is weighed against the author's interest in

²² See 17 U.S.C. § 107. Section 107 states:

In determining whether the use made of a work in any particular case is a fair use the factors to be considered shall include—

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

Id.

²³ See *id.*

²⁴ See *Tasini*, 533 U.S. at 497; *Greenberg*, 244 F.3d at 1275.

obtaining a commercial return for his or her creative endeavors.²⁵ Accordingly, a degree of negative market impact impermissible under § 201(c) might nonetheless be an acceptable impingement upon the author's exclusive property rights as a matter of fair use.

Finally, Part V will explore the significance of *Tasini*, *Greenberg*, *Random House*, and other decisions in developing preemptive measures toward mitigating digital re-publication and similar "new technological use" problems. Each of these cases concerns the right of copyright holders to control electronic publication of their works.²⁶ Section 106 of the Copyright Act, however, enumerates the specific uses of copyrighted material that are exclusive to, and therefore can be controlled or restricted by, the copyright holder.²⁷ Section 201 sets forth the requirements for the effective licensing and transfer of any, or any part of, the copyright holder's § 106 exclusive rights.²⁸ Part V will contend that *Tasini*, *Greenberg*, and *Random House* provide support for the proposition that a license intended to authorize electronic or other media uses of copyrighted material should not only specify the subject media uses at issue, but should also satisfy §§ 106 and 201 by identifying the specific *exclusive rights* appurtenant to the media activities being licensed. This is because the specification of particular media uses alone will render the agreement ambiguous as to the exclusive rights involved, thereby making it difficult to assess the scope of the license with respect to new technological uses developed during its term. By casting a copyright license in terms of the exclusive rights, however, ambiguities regarding the right to engage in a new technological

²⁵ See 17 U.S.C. § 107. Section 107 states:
Notwithstanding the provisions of sections 106 and 106A [providing authors' rights in copyrighted works], the fair use of a copyrighted work, including such use by reproduction in copies or phonorecords or by any other means specified by that section, for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research, is not an infringement of copyright.

Id.

²⁶ See *Tasini*, 533 U.S. at 491–92; *Greenberg*, 244 F.3d at 1270; *Random House, Inc. v. Rosetta Books*, 150 F. Supp. 2d 613, 614 (S.D.N.Y. 2001), *aff'd*, 283 F.3d 490 (2d Cir. 2002).

²⁷ See 17 U.S.C. § 106.

²⁸ See 17 U.S.C. § 201.

use can be resolved directly in accordance with the provisions of §§ 106 and/or 201, and the rights provided thereunder to copyright holders.²⁹

Part V will further contend that the judiciary can and should encourage this exclusive rights emphasis in the drafting and interpretation of copyright licenses and agreements. One means by which this can be accomplished is through the application of a presumption of “technological neutrality” in construing an agreement that explicitly identifies the specific exclusive rights that are the subject of the license conferred. Unless expressly restricted by the terms of the agreement, either through language specifically modifying or limiting the license of an exclusive right, or through the inclusion of an appropriate, general reservation of rights clause, an express license to engage in an exclusive right should be presumed to extend to any and all technological means available to engage in that right. This includes such methods that were not in existence as of the time of the parties’ contracting, but have come into being during the life of the parties’ agreement.

A presumption of technological neutrality is in accordance with copyright policy, which encourages the development and implementation of new technological uses for copyrighted material. Moreover, consistent application of the presumption will provide greater certainty in the interpretation and enforcement of such contracts. Not only will it encourage parties to express their publishing agreements in terms of the exclusive rights, but it will also provide a concrete means by which to construe such agreements in connection with new technological uses for copyrighted material.

I. THE *TASINI*, *GREENBERG*, AND *RANDOM HOUSE* DECISIONS

Tasini,³⁰ *Greenberg*,³¹ and *Random House*³² all concern the relationship between the copyright holder’s exclusive property

²⁹ See 17 U.S.C. § § 106, 201.

³⁰ 533 U.S. 483 (2001).

³¹ 244 F.3d 1267 (11th Cir. 2001).

³² 150 F. Supp. 2d 613 (S.D.N.Y. 2001), *aff’d*, 283 F.3d 490 (2d Cir. 2002).

rights under the Copyright Act and the unauthorized use of copyrighted material in electronic media. The first two cases concern whether the unauthorized digital re-publication³³ of a previously published collective work violates the copyrights of the individual contributing authors to the work or is permissible under the special revision privilege codified at 17 U.S.C. § 201(c).³⁴

A. *New York Times Co. v. Tasini*

The plaintiffs in *Tasini* were all freelance writers who, pursuant to varying publishing agreements, contributed articles to several periodicals, including the *New York Times*, *Newsday*, and *Sports Illustrated*.³⁵ Some time after publishing the plaintiffs' articles as part of their regular print editions, the defendant publishers provided the content therein to LEXIS/NEXIS ("NEXIS") for inclusion in its online, electronic text retrieval database.³⁶ In addition, the *New York Times* also provided its content to University Microfilms International ("UMI") in connection with the production of two CD-ROM products, the *New York Times OnDisc* ("NYTO CD") and *General Periodicals OnDisc* ("GPO CD").³⁷

The format in which the publishers provided their content to NEXIS was electronic text versions of the articles that appeared in their periodicals.³⁸ The *New York Times* also provided such

³³ The term "digital re-publication" is coined herein to distinguish unauthorized electronic publication undertaken by, or at the behest of, the publisher of the original, print publication of a copyrighted work, from wholly unauthorized, third-party electronic publication, such as the uploading of copyrighted material onto the Internet by a private individual. See generally Lateef Mtima, *Trademarks, Copyrights and the Internet*, in TRADEMARKS, COPYRIGHTS, AND UNFAIR COMPETITION FOR THE GENERAL PRACTITIONER AND THE CORPORATE COUNSEL 387 (Apr. 2003) and the cases cited therein (applying traditional intellectual property concepts, including re-publication and fair use, to the Internet).

³⁴ *Random House* does not involve interpretation of § 201(c), but rather concerns the interpretation of standard, print media licensing terms in connection with digital re-publication. See *infra* Part I.C.

³⁵ See *Tasini*, 533 U.S. at 488–89.

³⁶ See *id.* at 489–90.

³⁷ See *id.* at 490.

³⁸ See *id.* at 489.

material to UMI, for use in compiling the NYTO CD.³⁹ Content such as captions, headlines, and graphics, as well as the actual publication layout such as text columns, was not included in the electronic versions provided to NEXIS and UMI, and consequently, was not reproduced in the NEXIS database or on the NYTO CD.⁴⁰

Using either NEXIS or the NYTO CD, a user could review the entire electronic periodical content, or could retrieve the electronic text of individual articles or of a group of individual articles in response to an appropriate search.⁴¹ On the other hand, because material such as photographs and column layouts had been deleted from the electronic versions of the periodical content, the user would not be able to review entire periodicals, or any of their individual articles as they appeared in the original printed versions of the collective works.⁴²

The GPO CD, unlike the NEXIS database or the NYTO CD, was an image-based product, which means that it contained full-image, exact digital reproductions of the *New York Times Book Review* and the *New York Times Sunday Magazine*.⁴³ Accordingly, the GPO CD reproduced both the *New York Times Book Review* and the *New York Times Sunday Magazine* as each originally appeared in hard copy.⁴⁴ In addition, full-image, exact digital reproductions of other periodicals were also included on the GPO CD.⁴⁵ Finally, just as with the NEXIS database and the NYTO CD, when using the GPO CD a single article could be individually retrieved, or retrieved as part of a group of articles, in response to a search.⁴⁶

³⁹ See *id.* at 490–91.

⁴⁰ See *id.* at 490.

⁴¹ See *id.* at 490–91, 499–501.

⁴² See *id.* at 490.

⁴³ See *id.* at 491.

⁴⁴ See *id.*

⁴⁵ See *id.*

⁴⁶ See *id.* at 491, 499–501.

1. The Dispute Over the Use of the Freelance Writers' Contributory Articles

The freelance writers argued that their agreements with the publishers did not grant the publishers the right to publish the authors' works in electronic media formats, such as by including the works in the foregoing databases and CD products.⁴⁷ The writers claimed that the electronic publications were unauthorized and therefore violated several of their exclusive rights under the copyright law.⁴⁸

The publishers countered that, *inter alia*, because the works at issue were collective works, they did not need the freelance writers' permission to re-publish them in electronic form.⁴⁹ The publishers relied upon § 201(c) of the Copyright Act, which permits publishers of collective works to publish revisions of such works, without the permission of the individual contributing authors:

Copyright in each separate contribution to a collective work is distinct from copyright in the collective work as a whole, and [this distinct copyright] vests initially in the author of the contribution. In the absence of an express transfer of [this distinct] copyright . . . 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.⁵⁰

Thus, the central issue in dispute became whether the electronic re-publications constituted revisions within the special statutory privilege.⁵¹

⁴⁷ See *id.* at 491–92.

⁴⁸ The copyright holder's exclusive rights are enumerated at 17 U.S.C. § 106. Among the exclusive rights at issue in *Tasini* were the rights of reproduction, distribution, and public display. See *infra* Part II.

⁴⁹ See *Tasini*, 533 U.S. at 499.

⁵⁰ 17 U.S.C. § 201(c) (2002).

⁵¹ Both sides advanced several additional arguments in the lower court which were not pressed before or ruled upon by the Supreme Court. The freelance writers argued that even if the electronic publications fit within § 201(c), the publishers could not transfer

2. Are Digital Re-Publications § 201(c) Revisions?

The freelance writers in *Tasini* challenged the publishers' characterization of the digital re-publications as revisions with an interpretation of the legislative intent underlying § 201.⁵² According to the writers, Congress' primary purpose in passing § 201(c) was to abolish the doctrine of indivisibility.⁵³ Under that doctrine, once a contributory work was published as part of a collective work, unless the publisher took affirmative steps to secure a separate copyright for the author of the contribution, the publisher obtained the sole copyright, both with respect to the collective work as a whole and the individual contributory works that composed the collective work.⁵⁴

The freelance writers contended that Congress passed § 201(c) in order to restore to authors the individual copyrights in their

their re-publication privilege to third-parties such as NEXIS and UMI. *See Tasini v. N.Y. Times Co.*, 972 F. Supp. 804, 815 (S.D.N.Y. 1997), *rev'd and remanded*, 206 F.3d 161 (2d Cir. 1999), *aff'd*, 533 U.S. 483 (2001). The writers further argued that even if the privilege is transferable to third parties, it is limited to reproduction and distribution, and does not include any privilege to display the individual articles, such as on a computer screen. *See id.* at 816–18. As for the publishers, some of them did contend that the terms of their license agreements extended to electronic publication. *See id.* at 810–12.

⁵² *See Tasini*, 972 F. Supp. at 809.

⁵³ *See id.* at 815; 3-10 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT, §§ 10.01, 10.02 (2002) (“Because the 1909 Act spoke of a single ‘copyright’ to which the author of a work was entitled, and referred in the singular to ‘the copyright proprietor,’ it was inferred that the bundle of rights which accrued to a copyright owner were ‘indivisible,’ that is, incapable of assignment in parts. This notion, which found its historical roots in an early English copyright case and an American patent case, when literally followed renders it impossible to ‘assign’ anything less than the totality of rights commanded by copyright.” (footnotes omitted)).

⁵⁴ *See N.Y. Times Co. v. Tasini*, 533 U.S. 483, 494–95 (“Prior to the 1976 revision, . . . authors risked losing their rights when they placed an article in a collective work. 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. When publishers, exercising their superior bargaining power over authors, declined to print notices in each contributor’s name, the author’s copyright was put in jeopardy. . . . Thus, when a copyright notice appeared only in the publisher’s name, the author’s work would fall into the public domain . . . [o]r . . . a court might find that an author had tacitly transferred the entire copyright to the publisher” (citations omitted)); *see also* WILLIAM F. PATRY, COPYRIGHT LAW AND PRACTICE 386 (1994); NIMMER & NIMMER, *supra* note 53, §§ 10.01 [C][2], 10.02.

contributions to collective works.⁵⁵ Consequently, § 201(c) preserves the contributing authors' options with respect to further publication of their works, beyond their authorization of the initial publication in the collective work.⁵⁶ At the same time, however, § 201(c) permits publishers to retain their autonomy in updating their collective works as a whole, granting them the "privilege" to publish appropriate revisions thereof, without having to obtain the

⁵⁵ Specifically, 17 U.S.C. § 201(c) provides that the copyright to a contributory work resides in the contributing author, whereas the publisher obtains the copyright in the collective work as a whole. *See, e.g.*, James T. Ota, *New York Times Co. v. Tasini: Can Electronic Publications Ever Be Considered Revisions of Print Media?*, 24 U. HAW. L. REV. 843, 846 (2002) ("Under 17 U.S.C. § 201, there are two copyrights vested in [collective work] publications. The first copyright exists in the individual articles themselves and usually vests in the original author of the work. The second copyright exists in the publication as a whole and protects the publisher's original expression in selecting, coordinating, or arranging such articles to create the collective work." (citations omitted)).

⁵⁶ *See* Christine Soares, *Freelance Articles and Electronic Databases: Who Owns the Copyrights?*, 2001 DUKE L. & TECH. REV. 0025 ¶ 9 (2001) ("The 1976 version of the [Copyright] Act eliminated the notion of an indivisible copyright. Subsequently, separate copyrights could be maintained for both the individual article and the collective work. The author retained the copyright over the article, while the publisher maintained the copyright for the collective work as well as a revision privilege detailed in §201(c) of the statute." (citations omitted)); Michael A. Albert & Ilan N. Barzilay, *Copyright Developments Affect Electronic Rights*, 46 BOSTON B.J. 16 (Jan./Feb. 2002) ("In 1976, Congress abolished the doctrine of copyright 'indivisibility,' providing instead that the copyright owner's bundle of exclusive rights 'may be transferred . . . and owned separately.' Rights to an individual article in a collective work (reserved to the author) were separated from rights to the article in the context of the collective work (reserved to the publisher)." (citations omitted)); James K. Reed, *Securing Electronic Rights in a Post-Tasini World*, in 22ND ANNUAL INSTITUTE ON COMPUTER LAW, at 1080-81 (PLI Patents, Copyrights, Trademarks, and Literary Prop., Handbook Series No. G0-00VJ, 2002) ("In the 1976 overhaul of the Copyright Act, Congress replaced the Doctrine of Indivisibility with greater protections for writers. Specifically, Congress separated the copyright in the individual contribution and the copyright in the collective work. The contributed work and the collective work were now considered two different works, the author of the contributed work remained the copyright owner of the contributed work and the magazine publisher remained the copyright owner of the collective work. In addition, Congress gave the publishers the 'privilege' to use the contributed work (a) as part of the collective work, (b) in revisions of the collective work, and (c) in any later collective work in the same series." (citation omitted)); JOHN W. HAZARD, JR., COPYRIGHT LAW IN BUSINESS AND PRACTICE § 4:23 (cumulative Supp. No. 1 2003).

permission of each and every individual contributing author thereto.⁵⁷

Both the U.S. District Court for the Southern District of New York and the U.S. Court of Appeals for the Second Circuit agreed with the freelance writers that Congress' primary objective in revising § 201 was to benefit authors by abolishing the doctrine of indivisibility.⁵⁸ The two courts differed, however, as to the application of the legislative imperative to the facts of the case.

The district court reasoned that the publisher's collective work copyright and its concomitant revision privilege are both substantively grounded in the publisher's creative editorial contribution in arranging the collective work as a whole.⁵⁹ Thus, although the publisher is not permitted to use the contributory works in an entirely new collective work publication,⁶⁰ the district court held that § 201(c) authorizes their use in a subsequent revision that reflects the publisher's creative editorial contributions in arranging the original work.⁶¹ Finding that the electronic

⁵⁷ See *Albert & Barzilay*, *supra* note 56, at 16 ("Publishers could thus reprint, revise or transfer their publications to different media, or archive them in bound volumes or microfilm; and these 'revisions' would not infringe the copyrights belonging to the author of each included article. Publishers did not have to negotiate separately with each author in order to be able to archive or reprint the entire collective work.")

⁵⁸ See *Tasini v. N.Y. Times Co.*, 972 F. Supp. 804, 819–20 (S.D.N.Y. 1997), *rev'd and remanded*, 206 F.3d 161, 167–68 (2d Cir. 1999), *aff'd*, 533 U.S. 483 (2001).

⁵⁹ See *Tasini*, 972 F. Supp. at 820–21 ("In other words, the creators of collective works are entitled to rights in [the contributory] works only to the extent that they have demonstrated creativity in selecting and arranging preexisting materials into an original collective whole. It is this original contribution which gives a collective work its unique character, i.e., which makes it identifiable as 'that collective work.'" (citation omitted)).

⁶⁰ See *id.* at 821 ("Defendants are not permitted to place plaintiffs' articles into 'new anthologies' or 'entirely different magazine[s] or other collective work[s],' but only into revisions of those collective works in which plaintiffs' articles first appeared. If defendants change the original selection and arrangement of their newspapers or magazines, however, they are at risk of creating new works, works no longer recognizable as versions of the periodicals that are the source of their rights. Thus, in whatever ways they change their collective works, defendants must preserve some significant original aspect of those works . . . if they expect to satisfy the requirements of [§] 201(c)." (citation omitted)).

⁶¹ See *id.* at 820 ("Although the 'any revision' language of [§] 201(c) is broad, a new work must be recognizable as a version of a preexisting collective work if it is to be fairly characterized a revision of 'that collective work.' . . . [C]ollective works, even to the extent that they consist entirely of individual original contributions, possess

publications in fact retained this contribution in that, *inter alia*, they continued to reflect the publishers' initial decision to select these specific articles for inclusion in the original work, the district court concluded that the digital re-publications constituted revisions within the meaning of § 201(c).⁶²

The Court of Appeals, however, did not agree that the electronic publications sufficiently reflected the publishers' original editorial contributions so as to qualify as revisions of the original collective works. Instead, the Court of Appeals emphasized the fact that in the electronic transfer of the periodicals' content "a substantial portion of what appears in that particular [collective work] is not made part of [the] file transmitted . . . including . . . formatting decisions, pictures, maps and tables, and obituaries."⁶³ The court found that the deletion of this material diluted the publisher's original editorial contribution to the point that it was no longer sufficiently recognizable in the final electronic products.⁶⁴

Moreover, the court also noted that in the digital formats, the authors' contributions could be retrieved individually, just as if the individual articles had been sold or licensed one at a time, then combined with the contents of other collective works, and finally, compiled into an entirely new work.⁶⁵ The individual redistribution of contributory works, or the use of such works in new collective works are beyond the § 201(c) privilege and accordingly, for all the foregoing reasons, the court held that the

distinguishing original characteristics of their own—i.e., they are greater than the sum of their parts. It is therefore possible to revise a collective work by changing the original whole of that work without altering the content of the individual contributions to that work." (citations omitted)).

⁶² *See id.* at 821–24. As such, the court concluded that the digital re-publications did not deprive the freelance writers of any secondary publication market which Congress had intended them to have. *See id.* at 826–28. The court also concluded that the publisher's privilege to publish revisions is not only transferable to third parties, but that it includes the right to display the collective work and any revision thereof. *See id.* at 815–17.

⁶³ *Tasini v. N.Y. Times Co.*, 206 F.3d 161, 164 (2d Cir. 1999).

⁶⁴ *See id.* at 168–69.

⁶⁵ *See id.* at 169–70.

unauthorized digital re-publications infringed upon the authors' copyrights.⁶⁶

3. The Supreme Court's Decision

The Supreme Court agreed with both lower courts that the 1976 revision of § 201 was primarily intended to benefit authors by disposing of the doctrine of indivisibility.⁶⁷ Consequently, authors of contributions to collective works are free to exploit their works in subsequent venues, and the publisher of the collective work has no right to make any further use of such contributory works, other than its "privilege" to publish a revision of the entire collective work in accordance with § 201(c).⁶⁸

In deciding whether the electronic publications in fact constituted revisions within the meaning of § 201(c), however, the Supreme Court agreed with the Second Circuit that in the subject digital formats, the collective works were effectively disassembled into new and independent publications of the contributory articles that made up the original collective works:

In agreement with the Second Circuit, we hold that § 201(c) does not authorize the copying at issue here. The publishers are not sheltered by § 201(c), we conclude, because the databases reproduce and distribute articles standing alone and not in context, not 'as part of that particular collective work' to which the author contributed,

⁶⁶ *See id.*

⁶⁷ *See* N.Y. Times Co. v. Tasini, 533 U.S. 483, 495 (2001). The Court held that in passing § 201, Congress intended to clarify that the publisher's copyright in a collective work is limited to the collective work as a whole, and is based upon the editorial selection, arrangement, and layout of the work. *See id.* at 495–96. Revised § 201(c) enables the author contributing to the collective work to retain his or her copyright in his or her own creative contribution—that is, his or her individual article. *See id.* *But see* Andrew Snyder, Comment, *Pulling the Plug: Ignoring the Rights of the Public in Interpreting Copyright Law*, 41 WASHBURN L.J. 365, 374–75 (2002) ("The majority failed to recognize the intent of the authors and publishers (and Congress) with regard to 201(c). This important consideration shows authors were concerned about the possibility of publishers altering the content of articles, and not about how or where the articles were displayed. . . . Thus, at the time of the statute's creation, the conflict surrounding 201(c) dealt with changing the content, not with altering the presentation of text in different formats." (citations omitted)).

⁶⁸ *See Tasini*, 533 U.S. at 496–97.

‘as part of . . . any revision’ thereof, or ‘as part of . . . any later collective work in the same series.’ Both the print publishers and the electronic publishers, we rule, have infringed the copyrights of the freelance authors.⁶⁹

Consequently, the Supreme Court ruled that to allow the digital re-publications as privileged revisions would defeat the legislative objective underlying § 201(c).⁷⁰ In effect, the Court found that the development of digital technology has resulted in the creation of a secondary, “stand-alone” market for the individual contributions to collective works and construed that Congress intended that the contributory authors, as opposed to the publishers, be the ones to benefit from such new markets.⁷¹ Given the nature of the electronic products at issue, the Court found that there is no

⁶⁹ *Id.* at 488; see also Soares, *supra* note 56, ¶ 15 nn.41–42 (“[T]he Court determined that the search-and-retrieve method of accessing the articles in the databases made it impossible to consider the databases as revisions of the original periodicals. The majority viewed the databases either as new collective works or simply as a means by which individual articles could be retrieved.” (citations omitted)).

⁷⁰ See *Tasini*, 533 U.S. at 497 n.6 (“In years past, books compiling stories by journalists such as Janet Flanner and Ernie Pyle might have sold less well had the individual articles been freely and permanently available on line. In the present, print collections of reviews, commentaries, and reportage may prove less popular because of the Databases. The Register of Copyrights reports that ‘freelance authors have experienced significant economic loss’ due to a ‘digital revolution that has given publishers [new] opportunities to exploit authors’ works.”); see also Alicia Morris Groos, *Developments in U.S. Copyright Law 2000–2001: From Revising the Old South to Redefining the Digital Millennium*, 10 TEX. INTELL. PROP. L.J. 111, 130 (2001) (“With the evolution of digital technology, the Internet, and massive searchable databases such as NEXIS and WESTLAW, selling and marketing individual stand-alone copies of articles on a wide scale became economically feasible for the first time. For a fee, publishers license copies of their collective works (containing individual articles) to these databases, and the database publishers then allow their paying users to search for, retrieve, download, and print copies of the individual articles. The copyright owner of the individual work is left out of the equation, except for facing a ‘shrunk market for secondary sales of their works.’” (citation omitted)).

⁷¹ See *Tasini*, 533 U.S. at 497. Although the district court differed on the issue of who should benefit from such new markets, all three courts seem to assume the existence of secondary, “stand alone” digital re-publication markets for individual contributory works. See *Tasini v. N.Y. Times Co.*, 972 F. Supp. 804, 826 (“The [district] [c]ourt does not take lightly that its holding deprives plaintiffs of certain important economic benefits associated with their creations.”), *rev’d and remanded*, 206 F.3d 161 (2d Cir. 1999), *aff’d*, 533 U.S. 483 (2001). A reasonable argument can be made, however, challenging whether such secondary markets actually exist. See *infra* Part IV.

practical difference between licensing the contributions to a database individually or as a part of the collective work as a whole,⁷² and thus the secondary, “stand-alone” re-publication market that § 201(c) restores to individual contributing authors had been usurped by the publishers.⁷³ Accordingly, the Court concluded that the digital re-publications were not revisions within the meaning of § 201(c), but rather constituted new publications of the contributory works beyond the statutory privilege.⁷⁴

⁷² See *Tasini*, 533 U.S. at 499–500 (“[T]he three Databases present articles to users clear of the content provided either by the original periodical editions or by any revision of those editions. The Databases first prompt users to search the universe of their contents: thousands or millions of files containing individual articles from thousands of collective works . . . , either in one series (the Times, in NYTO) or in scores of series (the sundry titles in NEXIS and GPO). When the user conducts a search, each article appears as a separate item within the search result. . . . In either circumstance, we cannot see how the Database perceptively reproduces and distributes the article ‘as part of’ either the original edition or a ‘revision’ of that edition.”).

⁷³ See *id.* at 497 (“Essentially, § 201(c) adjusts a publisher’s copyright in its collective work to accommodate a freelancer’s copyright in her contribution. . . . It would scarcely ‘preserve the author’s copyright in a contribution’ as contemplated by Congress if a newspaper or magazine publisher were permitted to reproduce or distribute copies of the author’s contribution in isolation or within new collective works.” (citations omitted)).

⁷⁴ Citing the doctrine of media neutrality, Justice Stevens vigorously challenged this conclusion in his dissenting opinion. See *id.* at 512–15 (Stevens, J., dissenting). As Justice Stevens argued, the attributes of independent retrieval are characteristics inherent to digital media, and to disqualify the digital re-publications as revisions on that basis is to discriminate against electronic media in favor of print media. Cf. 1 MELVILLE B. NIMMER, NIMMER ON COPYRIGHT: A TREATISE ON THE LAW OF LITERARY, MUSICAL AND ARTISTIC PROPERTY, AND THE PROTECTION OF IDEAS § 20.2, at 94 (1976) (“[T]he mere reproduction of a work of art in a different medium should not constitute the required originality, for the reason that no one can claim to have independently evolved any particular medium.”); *CRC Press, LLC v. Wolfram Research, Inc.*, 149 F. Supp. 2d 500, 509–10 (C.D. Ill. 2000) (“Changing the medium in which a copyrightable work is displayed is not a sufficient change to give rise to a derivative work. . . . By moving the content of [a copyrightable] website to [a written encyclopedia], . . . [p]laintiff could not have created a copyrightable derivative work.” (citations omitted)); *L. Batlin & Son, Inc. v. Snyder*, 536 F.2d 486, 491 (2d Cir. 1976). Justice Stevens’ arguments are particularly convincing with respect to the disqualification of *The New York Times*’ full-image GPO CD. While the removal of photographs, captions, and graphics in connection with the other digital re-publications contributed to their characterization as entirely new and independent publications, the only differences between the GPO CD and the original print versions is that the GPO CD is Boolean searchable and combines previously independent editions with other periodicals on a single CD. Arguably, the majority eschewed a direct conflict with the doctrine of media neutrality, because the compilation of originally independent editions onto a single disc is not a feature “inherent” to digital

Finally, the Supreme Court noted that the defendants offered no other arguments in defense of their electronic activities.⁷⁵

Against the Authors' charge of infringement, the Publishers do not here contend the Authors entered into an agreement authorizing reproduction of the Articles in the Databases. Nor do they assert that the copies in the Databases represent "fair use" of the Authors' Articles. Instead, the Publishers rest entirely on the privilege described in § 201(c).⁷⁶

In the absence of any claim of license to engage in the digital re-publications, or the assertion of a copyright defense such as fair use,⁷⁷ once the Court found § 201(c) inapplicable, it held that the unauthorized publications were undertaken in violation of the authors' contributory work copyrights.⁷⁸

B. *Greenberg v. National Geographic Society*

A publisher's use of a printed contributory work in a subsequent digital re-publication was also the basis for litigation in *Greenberg v. National Geographic Society*.⁷⁹ In *Greenberg*, the freelance photographer of a copyrighted photograph brought suit

media. As discussed in Part II, however, if the GPO CDs were limited to a single edition per disc, Justice Stevens' argument seems inescapably cogent.

⁷⁵ See *Tasini*, 533 U.S. at 499.

⁷⁶ *Id.* Although *Newsday* and *Time* had contended before the district court that their publishing agreements with the freelance writers actually authorized electronic publication, the Supreme Court noted that the Court of Appeals had disposed of *Time*'s argument on the merits, and had further ruled that *Newsday* had ultimately waived this defense. See *id.* at 489 n.1. Neither defendant renewed these arguments before the Supreme Court, nor did any of the publishers seek to defend the electronic publications on any grounds other than the assertion of their privilege to undertake revisions under § 201(c). See *id.*

⁷⁷ As discussed in Part III, the publishers may have had a viable fair use defense.

⁷⁸ See *id.* at 506.

⁷⁹ Another important case in which the defendant sought to rely upon § 201(c) in defense of an unauthorized use of previously published copyrighted works is *Ryan v. CARL Corp.*, 23 F. Supp. 2d 1146 (N.D. Cal. 1998). However, that case does not actually involve digital re-publication, in that the defendant was not the publisher of the subject works, but rather, provided something like a document delivery service. See *id.* at 1147. Defendant maintained a database comprising the titles of published articles, and once a user/client indicated a selection therefrom, defendant would physically visit a library that contained a copy of the article, photocopy it, and then send a copy to the user/client. See *id.*

against his publisher, the National Geographic Society (“National Geographic”), when National Geographic re-used his photograph in the production of an image-based, CD-ROM replica of all 1,200 back issues of *National Geographic Magazine* (“NG-CD”).⁸⁰ In addition to the exact digital reproduction of the back issues (“Replica”), the NG-CD also contained an opening animation sequence (“Animation Sequence”), which had been constructed from photographs that had appeared on various covers of the magazine, including plaintiff Greenberg’s photograph.⁸¹ Finally, the NG-CD also contained a software program that enabled, *inter alia*, retrieval of independent back issues and/or the individual articles from within each back issue.⁸²

Just as the defendant publishers in *Tasini*, National Geographic relied upon § 201(c) in defense of its digital re-publication, contending that the NG-CD was merely a revision of its entire archive of collective work back issues.⁸³ The Eleventh Circuit concluded, however, that the use of the contributory work in the Animation Sequence went well beyond any reasonable definition of the term revision:

The Society argues that its use . . . constitutes a “revision” of [its] “. . . collective work”, referring to the [NG-CD] as the compendium of over 1,200 independent back issues Assuming *arguendo*, but expressly not deciding, that 201(c)’s revision privilege embraces the

⁸⁰ See *Greenberg v. Nat’l Geographic Soc’y*, 244 F.3d 1267, 1269 (11th Cir. 2001) (“What the user of the [NG-CD] sees on his computer screen, . . . is a reproduction of each page of the Magazine that differs from the original only in the size and resolution of the photographs and text. Every cover, article, advertisement, and photograph appears as it did in the original paper copy of the Magazine. The user can print out the image of any page of the Magazine, but the [NG-CD] does not provide a means for the user to separate the photographs from the text or otherwise to edit the pages in any way.”).

⁸¹ See *id.* (“The Sequence is an animated clip that plays automatically when any disc from the [NG-CD] library is activated. The clip begins with the image of an actual cover of a past issue of the Magazine. This image, through the use of computer animation, overlappingly fades . . . into the image of another cover . . . and then morphs into another cover image, and so on, until 10 different covers have been displayed. . . . The entire sequence lasts for 25 seconds, and is accompanied by music and sound effects.”).

⁸² See *id.*

⁸³ See *id.* at 1271–72. National Geographic also pursued a fair use defense, the disposition of which is discussed in Part IV.

entirety of the [reproduced 1,200 back issues], we are unable to stretch the phrase “that particular collective work” to encompass the [Animated] Sequence and [the software] Program elements as well.⁸⁴

The court concluded that the Animation Sequence was an entirely new work, independent of the printed collective work in which Greenberg’s photograph had originally appeared.⁸⁵

In layman’s terms, the instant product is in no sense a “revision.” In this case we do not need to consult dictionaries or colloquial meanings to understand what is permitted under § 201(c).

....

... [C]ommon-sense copyright analysis compels the conclusion that [National Geographic] . . . has created a new product (“an original work of authorship”), in a new medium, for a new market that far transcends any privilege of revision or other mere reproduction envisioned in § 201(c).⁸⁶

C. Random House, Inc. v. Rosetta Books

Unlike the *Tasini* and *Greenberg* cases, *Random House, Inc. v. Rosetta Books* did not involve the § 201(c) revision privilege in as much as that dispute did not involve collective works.⁸⁷ Rather, the extent to which publishing and licensing terms, which had been drafted in contemplation of print publication, could be subsequently construed to authorize electronic publication was the principal issue in controversy.⁸⁸ Ironically, however, the plaintiff publisher in this case was not seeking to deploy its publishing license in order to undertake electronic publication, but rather to *enjoin* it.⁸⁹

⁸⁴ *Id.* at 1272.

⁸⁵ *See id.* at 1272–73.

⁸⁶ *Id.*

⁸⁷ 150 F. Supp. 2d 613, 613–15 (S.D.N.Y. 2001), *aff’d*, 283 F.3d 490 (2d Cir. 2002).

⁸⁸ *See id.* at 617–18.

⁸⁹ *See id.* at 614.

In *Random House*, three well-known authors—William Styron, Kurt Vonnegut, and Robert B. Parker—had each entered into separate agreements with Random House to publish certain of their works.⁹⁰ While the terms of the individual agreements differed in various respects, each agreement granted Random House the exclusive right to “print, publish and sell the work in book form.”⁹¹

In 2000 and 2001, each of the authors entered into separate agreements with the defendant Rosetta Books, permitting Rosetta to publish certain of their works as “e-books.”⁹² These works were also the subject of the authors’ prior individual agreements with Random House.⁹³ Upon learning of the Rosetta agreements, Random House commenced litigation alleging, *inter alia*, copyright infringement and sought to enjoin publication of the e-books.⁹⁴ Random House contended that the publication of the e-books would infringe upon the grants of copyrights that it had previously obtained under its agreements with each of the authors.⁹⁵ In short, Random House took the position that its right “to publish in book form” encompassed the right to publish the works in *electronic* book form, and consequently, the Rosetta agreements infringed upon the copyrights that Random House had already obtained from the authors.⁹⁶

⁹⁰ The Styron agreement was entered into in 1961, the Vonnegut agreement in 1967, and the Parker agreement in 1982. *See id.* at 615–16.

⁹¹ *Id.* at 615.

⁹² *See id.* at 614–15 (“Ebooks are ‘digital books[s] that you can read on a computer screen or an electronic device.’ Ebooks are created by converting digitized text into a format readable by computer software. The text can be viewed on a desktop or laptop computer, personal digital assistant or handheld dedicated ebook reading device. . . . Although the text of the ebook is exactly the same as the text of the original work, the ebook contains various features that take advantage of its digital format. For example, ebook users can search the work electronically to find specific words and phrases. They can electronically ‘highlight’ and ‘bookmark’ certain text, which can then be automatically indexed and accessed through hyperlinks. They can use hyperlinks in the table of contents to jump to specific chapters. . . . In addition, users can have displayed the definition of any word in the text. In one version of the software, the word can be pronounced aloud.” (citations omitted)); *see also* Nancy B. Vermylen, *Book Publishing in the Age of the E-Book*, 4 VAND. J. ENT. L. & PRAC. 190, 193 (2002) (explaining various versions of e-books and readers available).

⁹³ *See Random House*, 150 F. Supp. 2d at 615–17.

⁹⁴ *See id.* at 614.

⁹⁵ *See id.*

⁹⁶ *See id.* at 620–21.

In interpreting the prior agreements between Random House and each of the individual authors—some of which were executed more than forty years prior to the Rosetta agreements—the U.S. District Court for the Southern District of New York held that the contracts simply did not contemplate electronic publication.⁹⁷ Although the court readily acknowledged that it was possible for a copyright holder to license the right to use his or her work through technological means not in existence as of the time of the parties' contracting,⁹⁸ the court found that the express language of the parties' agreement indicated that the Random House license did not extend to the new technological application of e-books:

[T]his [c]ourt finds that the most reasonable interpretation of the grant in the contracts at issue to “print, publish and sell the work in book form” does not include the right to publish the work as an ebook. . . . The Random House Webster's Unabridged Dictionary defines a “book” as “a written or printed work of fiction or nonfiction, usually on sheets of paper fastened or bound together within covers”

[Moreover, in the contract] separate grant language is used to convey the rights to publish book club editions, reprint editions, abridged forms, and editions in Braille. This language would not be necessary if the phrase “in book form” encompassed all types of books.⁹⁹

Accordingly, the court's decision did not turn upon a determination as to which of the authors' exclusive rights under the copyright law had been assigned to Random House as part of the overall grant of the right “to print, publish and sell.”¹⁰⁰ Instead, disposition of the dispute turned upon interpretation of the

⁹⁷ See *id.* at 621–22 (holding that “in book form” does not apply to e-books).

⁹⁸ See *id.* at 619; see also generally *Boosey & Hawkes Music Publishers v. Walt Disney Co.*, 145 F.3d 481, 488 (2d Cir. 1998) (“[I]f the broad terms of the license are more reasonably read to include the particular future technology in question, then the licensee may rely on that language.”); *Bartsch v. Metro-Goldwyn-Mayer, Inc.*, 391 F.2d 150 (2d Cir. 1968) (holding that the agreement at issue covered the “new use” of converting the copyrighted motion picture for television use).

⁹⁹ *Random House*, 150 F. Supp. 2d at 620.

¹⁰⁰ See *id.*

publishing trade term “in book form.”¹⁰¹ Once the court found that an e-book does not constitute the production of a printed work “in book form,” the grant of rights under the Rosetta agreements became distinct from the grant of rights under the Random House license, and there was no basis for plaintiff’s infringement claim.¹⁰²

D. The Right of Digital Re-Publication: To Whom Does It Belong?

Tasini, *Greenberg*, and *Random House* each involve the problem of determining who has the right to re-publish printed copyrighted material in electronic formats.¹⁰³ Although the parties and even the courts in each of these cases apparently presumed that right belongs at least initially to the copyright holder, as one might expect, the copyright statute does not expressly refer to such a right in its enumeration of an author’s exclusive property rights, much less designate to whom such a right belongs. In order to understand the basis for the presumption that the digital re-publication right belongs to the copyright holder—and more importantly, to test the validity of that presumption—it is necessary to review briefly the scheme of rights provided for under the copyright law.

¹⁰¹ Although it is easy to perceive how that phrase could be understood to mean “the production of anything that resembles a book,” in the publishing trade, “in book form” has generally been construed to encompass only conventional books. Consequently publications such as comic books have been excluded from the definition. *See, e.g.*, *Field v. True Comics, Inc.*, 89 F. Supp. 611, 614 (S.D.N.Y. 1950); *NIMMER*, *supra* note 53, § 10.14 [C]. As discussed previously, reconciling publishing trade terminology with the express provisions of the copyright statute, regardless of whether any new technological use is involved, is the basis for much publishing license litigation.

¹⁰² *See Random House*, 150 F. Supp. 2d at 624; *see also* *CRC Press, LLC v. Wolfram Research, Inc.*, 149 F. Supp. 2d 500, 506–10 (C.D. Ill. 2000) (discussing whether language assigning all rights to a work includes an assignment of the right to undertake derivative works).

¹⁰³ *See generally* *N.Y. Times Co. v. Tasini*, 533 U.S. 483 (2001); *Greenberg v. Nat’l Geographic Soc’y*, 244 F.3d 1267 (11th Cir. 2001); *Random House*, 150 F. Supp. 2d 613.

II. DIGITAL RE-PUBLICATION AND THE COPYRIGHT LAW

Congressional authority to enact a copyright law is expressly provided for in the Constitution.¹⁰⁴ Pursuant to article I, Congress has the power “[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”¹⁰⁵ In accordance with this constitutional mandate, both Congress and the courts have determined that the “overarching object of copyright law in the United States is to encourage the widest possible production and dissemination of literary and artistic works.”¹⁰⁶ Through widespread production and

¹⁰⁴ See U.S. CONST. art. I, § 8, cl. 8.

¹⁰⁵ *Id.*; see also Ralph S. Brown, *Eligibility for Copyright Protection: A Search for Principled Standards*, 70 MINN. L. REV. 579, 581 (1985) (“Congress has interpreted the term ‘writings’ generously when fulfilling its constitutional mandate. The first copyright statute, of 1790, listed maps and charts ahead of books in its short list of protected ‘writings.’ In the 1976 thorough revision of copyright law, the constitutional protection of ‘writings’ became a protection that ‘subsists . . . 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.’ This language insures that copyright is receptive to new technologies, provided that fixation and communication are possible.” (citations omitted)); Jason S. Rooks, Note, *Constitutionality of Judicially-Imposed Compulsory Licenses in Copyright Infringement Cases*, 3 J. INTELL. PROP. L. 255, 257 (1995) (detailing the derivation of American copyright law from Great Britain’s Statute of Anne, and discussing the establishment of a public domain in creative works).

¹⁰⁶ PAUL GOLDSTEIN, COPYRIGHT § 1.14 (2d ed. 2002); see also Marci A. Hamilton, *Copyright at the Supreme Court: A Jurisprudence of Deference*, 47 J. COPYRIGHT SOC’Y U.S.A. 317, 319 (2000) (“Elements of the [Supreme C]ourt’s . . . interpretation of the Copyright Clause . . . includ[e] an emphasis on the public good that forces author’s rights to be conditioned by the public. . . . From the first case, through the present, the Court has treated copyright law as positive law, the parameters of which are determined by Congress ([as] limited by the Constitution’s strictures.)”); Pierre N. Leval, *Toward a Fair Use Standard*, 103 HARV. L. REV. 1105, 1107 (1990) (“The Supreme Court has often and consistently summarized the objectives of copyright law. The copyright is not an inevitable, divine, or natural right that confers on authors the absolute ownership of their creations. It is designed rather to stimulate activity and progress in the arts for the intellectual enrichment of the public.”); Rooks, *supra* note 105, at 259 (“The Supreme Court . . . has made clear that . . . copyright exists primarily to serve the public interest; authors’ and publishers’ interests are therefore secondary.”). *But see* Alfred C. Yen, *Restoring the Natural Law: Copyright As Labor and Possession*, 51 OHIO ST. L.J. 517, 531 (1990) (“Even though economics became the ostensibly sole basis of copyright, modern copyright somehow evolved along lines similar to those suggested by the natural law. This can be seen most clearly by outlining the basic copyright doctrines of

dissemination, the greatest amount of creative works are likely to reach the largest audience, who will not only benefit from exposure to these works, but who will in turn build upon the ideas advanced therein and produce additional works. Thus, the progress of the arts and sciences is furthered and assured to the greater societal good.¹⁰⁷

In order to achieve such widespread dissemination of creative works, however, there must first be an abundant supply of creative works to disseminate.¹⁰⁸ Consequently, creative artists must have proper incentive to produce these works.¹⁰⁹ As set forth in article I, Congress may provide such incentive by granting authors the

originality and the idea/expression dichotomy and then comparing them to the natural law of property through labor and possession . . . [M]odern American copyright appears to vindicate an author's right to property in the fruits of her labor, but subject to the limits of what can be feasibly possessed.”).

¹⁰⁷ See *Rogers v. Koons*, 960 F.2d 301, 306 (2d Cir. 1992); *Folsom v. Marsh*, 9 F. Cas. 342, 349 (C.C.D. Mass. 1841) (No. 4,901); Leval, *supra* note 106, at 1126 (“Copyright seeks to maximize the creation and publication of socially useful material. . . . Copyright is not a reward for goodness but a protection for the profits of activity that is useful to the public education.”); L. Ray Patterson, *Copyright and “The Exclusive Right” of Authors*, 1 J. INTELL. PROP. L. 1, 41–42 (1993) (“One’s conclusion as to the nature of copyright is determined by one’s view of its source. A coherent and consistent view of copyright requires that the source be Congress, which can grant the author only the right to publish and vend, with only such extensions as do not subordinate constitutional policies to the cause of private profit. The point is that copyright law is more regulatory than proprietary in nature, for only the regulatory concept makes any sense in view of the three policies that the Copyright Clause mandates: promotion of learning, protection of the public domain, and benefit to the author.”).

¹⁰⁸ See *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 429 (1984).

¹⁰⁹ See Justin Hughes, *The Philosophy of Intellectual Property*, 77 GEO. L.J. 287, 299, 330 (1988) (“Locke offers a positive justification for property that buttresses his labor theory. He suggests that granting people property rights in goods procured through their labor ‘increase[s] the common stock of mankind,’ a utilitarian argument grounded in increasing mankind’s collective wealth. . . . Like [Locke’s] labor theory, [Hegel’s] personality theory has intuitive appeal when applied to intellectual property: an idea belongs to its creator because the idea is a manifestation of the creator’s personality or self.”); Scott L. Bach, Note, *Music Recording, Publishing, and Compulsory Licenses: Toward a Consistent Copyright Law*, 14 HOFSTRA L. REV. 379, 396–97 (1986) (“The framers of the Constitution concluded that the most effective way to encourage creative expression is to give exclusive rights to authors for a period of limited duration. Such rights, however, are not Constitutionally guaranteed, but are created in Congress’s discretion.” (citations omitted)).

“exclusive right” to their works.¹¹⁰ By securing to authors property rights in connection with their works, the copyright law provides a means by which authors might profit financially from their efforts and thereby provides them with the necessary inducement to undertake and continue their creative labors.¹¹¹

The specific mechanism through which the Copyright Act provides an author with exclusive property rights might seem complex at first, but it is actually relatively straightforward. Under the copyright law, the uses to which a copyrighted work might be put—such as reading a book, distributing a photograph for sale, or performing a musical composition—are divided into two categories. The first category is comprised of a list of specific uses that are designated as exclusive to authors and are referred to as the

¹¹⁰ See *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 558 (1985) (“The economic philosophy behind the clause empowering Congress to grant patents and copyrights is the conviction that encouragement of individual effort by personal gain is the best way to advance public welfare through the talents of authors and inventors in ‘Science and useful Arts.’” (quoting *Mazer v. Stein*, 347 U.S. 201, 219 (1954))); see generally GOLDSTEIN, *supra* note 106, § 1.14; NIMMER & NIMMER, *supra* note 53, § 8.01[A]; Bach, *supra* note 109, at 383 (“The limited monopoly policy of copyright law arises from . . . the Constitution Underlying the [copyright clause] is the principle that society will be harmed if artists are not given exclusive rights to exploit their works for a limited time, because the lack of such rights would discourage artistic creativity. Thus, granting a limited monopoly in copyright advances the public interest because it encourages artists to create through the prospect of financial gain. The eventual termination of the monopoly assures the public good, because it allows the assimilation of artistic works into society, which is the ultimate objective of copyright law.” (citations omitted)); Rooks, *supra* note 105, at 257 (“Read literally, three fundamental policies are advanced by the [copyright] clause: (1) to promote learning . . .; (2) to benefit authors . . .; and (3) to ensure public access Of these three policies, two benefit the public and one the author; and the benefit to the author is a means to the ends of promoting learning and protecting the public domain.”); Hughes, *supra* note 109, at 291 (“Intellectual property is often the propertization of what we call ‘talent.’”).

¹¹¹ See Michael G. Anderson & Paul F. Brown, *The Economics Behind Copyright Fair Use: A Principled and Predictable Body of Law*, 24 LOY. U. CHI. L.J. 143, 158–59 (1993) (“Copyright law vests a bundle of rights in the creator of certain kinds of intellectual property. . . . Copyright law, both ancient and modern, is founded on the fundamental, though perhaps implicit, notion that adverse economic incentives are created if unrestricted [use] of intellectual products is permitted. When adverse incentives exist, society will not have as much creative innovation as it wishes to encourage. Therefore, the emphasis of copyright law is on the benefits derived by the public from the creative efforts of authors. Reward to copyright owners or authors is a necessary but secondary consideration.” (citations omitted)); cf. NIMMER & NIMMER, *supra* note 53, § 14.03 (discussing the copyright owner’s remedies with respect to the infringer’s profits).

author's "exclusive rights."¹¹² The second category comprises all uses not in the first category; these uses remain freely available to the general public.¹¹³

Under this system, if someone wishes to use a copyrighted work in one of the ways designated as an exclusive right—for example, if one wishes to copy or distribute the work—that person must first obtain the permission of the author of the work.¹¹⁴ When so inclined, the author typically bestows his or her permission in the form of a license, which is granted for a fee.¹¹⁵ Consequently, through the mechanism of exclusive rights, the

¹¹² See, e.g., NIMMER & NIMMER, *supra* note 53, § 2.18; I. Fred Koenigsberg, *Copyrights*, in UNDERSTANDING BASIC COPYRIGHT LAW 2002, at 142–44 (PLI Patents, Copyrights, Trademarks, and Literary Prop. Course, Handbook Series No. G0-010T, 2002); GOLDSTEIN, *supra* note 106, § 1.14.2.3 (“Section 106 of the 1976 Copyright Act prescribes five exclusive rights in copyrighted works: the rights to reproduce, to distribute, to perform, to display and to prepare derivative works based upon the copyrighted work. Taken together these rights reflect Congress’ balanced judgment about the uses that a copyright owner must be able to prohibit in order to appropriate the value of its work through sales or licenses in the market place and about those uses that, in the interests of public access, must not be fettered by copyright.” (footnotes omitted)).

¹¹³ See *Fortnightly Corp. v. United Artists Television, Inc.*, 392 U.S. 390, 393–94 (1968) (“The Copyright Act does not give a copyright holder control over all uses of his copyrighted work. Instead, § 1 of the Act enumerates several ‘rights’ that are made ‘exclusive’ to the holder of the copyright. If a person, without authorization from the copyright holder, puts a copyrighted work to a use within the scope of one of these ‘exclusive rights,’ he infringes the copyright. If he puts the work to a use not enumerated in § 1, he does not infringe.” (footnotes omitted)); *Teleprompter Corp. v. Columbia Broad. Sys., Inc.*, 415 U.S. 394, 399 n.2 (1974) (“Use of copyrighted material not in conflict with a right secured [as an exclusive right] . . . , no matter how widespread, is not copyright infringement. . . . [Public] use short of infringement is to be encouraged.” (citation omitted)).

¹¹⁴ See *ProCD, Inc. v. Zeidenberg*, 86 F.3d 1447, 1454 (7th Cir. 1996) (“Copyright law forbids duplication, public performance, and so on, unless the person wishing to copy or perform the work gets permission . . .”).

¹¹⁵ See *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 546–47 (1985) (“Section 106 of the Copyright Act confers a bundle of exclusive rights to the owner of the copyright. Under the Copyright Act, these rights—to publish, copy, and distribute the author’s work—vest in the author of an original work from the time of its creation. In practice, the author commonly sells his rights to publishers who offer royalties in exchange for their services in producing and marketing the author’s work.” (footnotes and citations omitted)).

author of a copyrighted work gains the opportunity to obtain a financial reward for his or her creative labors.¹¹⁶

In this way, the copyright law fulfills the constitutional objective of the promotion of the arts and sciences. The mechanism of exclusive rights secures authors with property rights in their creative works, and thereby provides them with the opportunity for financial gain, the secular incentive to create.¹¹⁷ This incentive assures an abundance of creative works and “reflects the belief that property rights [in creative works], properly limited, will serve the general public interest in an abounding national culture.”¹¹⁸ Finally, the mechanism of exclusive rights is

¹¹⁶ See NIMMER & NIMMER, *supra* note 53, § 13.01; Yen, *supra* note 106, at 518 (“[C]opyright is necessary because in its absence those interested in using the author’s work would simply copy the work instead of buying it from the author. Authors would then find their economic returns too small to justify the costs of authorship. In such a situation authors might not produce, and social welfare would presumably suffer. To remedy this problem, economic theory supports granting authors copyright in their works. However, those rights are necessarily limited in scope, because copyright imposes costs on society in exchange for the benefits of induced creative activity. . . . [T]he owner of copyright rights will charge a monopoly price for her work [and t]he number of people who gain access to the work will therefore decrease. . . . Thus, the optimal degree of copyright protection is that amount which maximizes the difference between the benefits of induced creative activity and the costs of increased authors’ rights.” (footnotes omitted)).

¹¹⁷ See *SunTrust Bank v. Houghton Mifflin Co.*, 268 F.3d 1257, 1261 (11th Cir. 2001) (“The Copyright Act promotes public access to knowledge because it provides an economic incentive for authors to publish books and disseminate ideas to the public.” (citation omitted)); Leval, *supra* note 106, at 1107–08 (“[C]opyright is intended to increase and not to impede the harvest of knowledge. . . . The rights conferred by copyright are designed to assure contributors to the store of knowledge a fair return for their labors. . . . [The Constitution’s grant of copyright power to Congress] ‘is a means by which an important public purpose may be achieved. It is intended to motivate the creative activity of authors and inventors by the provision of a special reward The monopoly created by copyright thus rewards the individual author in order to benefit the public.’” (quoting *Harper & Row*, 471 U.S. at 545–46) (citations omitted)).

¹¹⁸ GOLDSTEIN, *supra* note 106, § 1.14; see also Jessica Litman, *The Exclusive Right to Read*, 13 CARDOZO ARTS & ENT. L.J. 29, 43 (1994) [hereinafter Litman, *Exclusive Right*] (“This is the central justification for further enhancing the rights in the copyright bundle: without strong copyright protection, there will be no national information infrastructure. The public might believe that what it wants is unfettered access to copyrighted works in return for reasonable royalty payments to authors, but, if we let the public set the freight charges, we risk underproduction of freight. If authors and publishers cannot reliably control their works, they will decline to make them available at all.”); Patterson, *supra* note 107, at 37 (“That copyright is a conditional right means that it is not so much a

“properly limited” or counterbalanced by the fact that outside of the exclusive rights, the public is free to use, enjoy, and build upon an author’s copyrighted work, thereby “allow[ing] others to draw [up]on these works in their own creative and educational activities.”¹¹⁹

A. Classifying the “New Use” of Digital Re-Publication

Each time a new technological advance or development provides a new means by which copyrighted works may be used or exploited, a challenge is presented to the balance between the

reward as it is a *quid pro quo*. The author receives the reward for making his or her original work of authorship accessible to all. Contrary to the common notion, the reward is not for the act of creation, but for distribution to provide public access: public learning comes not from the creation of a work, but from reading and studying it, a truism that copyright owners have apparently managed to hide from courts for many years.”)

¹¹⁹ GOLDSTEIN, *supra* note 106, § 1.14 (“The balance that copyright law strikes between the incentives that authors and publishers need to produce original works and the freedom that they and others need to draw on earlier copyrighted works rests on a judgment about social benefit. To give greater property rights than are needed to obtain the desired quantity and quality of works would impose costs on users without any countervailing benefits to society. To give fewer property rights than are needed to support this investment would give users freer access, but to a less than socially desirable number and quality of works.” (footnote omitted)). Moreover, the mechanism of exclusive rights is not without limitation. When the public interest so warrants, copyright doctrines such as fair use permit a person to engage in the exclusive rights without the copyright holder’s permission. See Sharon Appel, *Copyright, Digitization of Images, and Art Museums: Cyberspace and Other New Frontiers*, 6 UCLA ENT. L. REV. 150, 167 (1999) (“[Exclusive] rights constitute the ‘bundle of rights’ that comprise copyright. Thus, they constitute the core of copyright protection. However, the Copyright Act also sets forth several limitations upon the exclusive rights. The most important of these . . . is the doctrine of fair use, which permits unauthorized use of a copyrighted work where such use, as a matter of public policy, is ‘fair.’ The statutory provision regarding fair use provides that: ‘the fair use of a copyrighted work including such use . . . for purposes such as criticism, comment, news reporting, teaching . . . scholarship or research is not an infringement of copyright.’” (footnote omitted)); Simone A. Rose, *Johnny Can Read, but Can He “Surf”?* *Harmonizing Copyright Law and Internet Ethics*, 1 MINN. INTELL. PROP. REV. 79, 96 (2000) (“At first blush, copyright protection appears to upset the constitutionally mandated balance between individualism and public dissemination of information. It grants long-term exclusive rights in creative expression, without a substantive examination process to evaluate whether the creator has ‘earned’ these rights under the statute. Nevertheless, the trade-off for the longer term is a narrowly defined set of exclusive rights, followed by a series of limitations such as fair use and first sale. These limits set property boundaries that take into account the public’s interest in the free dissemination of information.” (footnotes omitted)); *see also infra* Part IV.

author's incentive/exclusive rights mechanism and the corollary objective of broad public access to creative works.¹²⁰ Initially the courts, and often ultimately Congress, must decide whether the "new use" is one that falls within the category of exclusive rights, or if it is a use that should remain freely available to the public.¹²¹

¹²⁰ See Thornburg, *supra* note 2, at 237 ("Copyright law has always grappled with how to adjust to new mediums of expression. In both the courts and Congress, advances in recording, reproducing, and distributing copyrighted works have always led to tension in fashioning appropriate mechanisms to protect authors without creating an imbalance or unfavorable results. While copyright vests appropriate rights in an author in order to compensate her for her labor, it also seeks to protect the public from unreasonable seizures of works already in the public domain."); Litman, *Exclusive Right*, *supra* note 118, at 39 ("It is difficult for intellectual property laws to keep pace with technology. When technological advances cause ambiguity in the law, courts rely on the law's purposes to resolve that ambiguity. However, when technology gets too far ahead of the law, and it becomes difficult and awkward to apply the old principles, it is time for reevaluation and change. 'Even though the 1976 Copyright Act was carefully drafted to be flexible enough to be applied to future innovations, technology has a habit of outstripping even the most flexible statutes.' The coat is getting a little tight. There is no need for a new one, but the old one needs a few alterations." (quoting H.R. REP. NO. 101-735, at 7 (1990))).

¹²¹ See Jon M. Garon, *Normative Copyright: A Conceptual Framework for Copyright Philosophy and Ethics*, 88 CORNELL L. REV. 1278, 1309–10 (2003) ("The role of the common law and legislature is to balance property and liability interests. . . . If all property is subject to the legal balance between the exclusive owner and the public, then intellectual property is merely the realm in which the balancing is most explicitly acknowledged. . . . The Supreme Court has repeatedly recognized the power of Congress to adjust the balance of rights between authors, publishers, and the public. . . . The normative question is not whether such balancing can take place, but how to create a reasoned framework for setting or shifting the balance." (footnotes omitted)); Wendy M. Pollack, Note, *Tuning in: The Future of Copyright Protection for Online Music in the Digital Millennium*, 68 FORDHAM L. REV. 2445, 2445 (2000) ("Since the advent of the Gutenberg printing press, copyright law and technology have been entangled in an ongoing legal chase. In order to advance the quintessential goal of American copyright law, . . . Congress constantly must balance the law's objectives: to promote widespread dissemination of original creative works, while providing incentives to authors and owners to create such works. New technological advances continuously upset this balance by facilitating the ability to copy works without permission from copyright holders. . . . However, as developments such as radio, television, and video have demonstrated, worries over the demise of copyright protection have been overstated. In fact, such technological developments usually have been met with a ceaseless round of amendments to the United States copyright laws." (footnotes omitted)). *But see* Warner Lawson, Jr., *Paul, Bishop & Meachum—Short-Lived Aberrations or Plagues-on-Developing Due Process-Protections?*, 20 HOW. L.J. 419, 427 (1977) ("Although the institution of property is ancient in comparison with liberty, interests in property appear more fragile and, thus more susceptible to attack. Property is particularly vulnerable in

As has been the case in connection with many prior new uses for copyrighted material, the categorization of the new use of digital re-publication is not a simple task. The copyright holders in *Tasini*, *Greenberg*, and *Random House* each took the position that digital re-publication should be regarded as an activity or use within the realm of the author's exclusive rights.¹²² Although the copyright statute does not specifically refer to digital re-publication as an exclusive right, the plaintiff copyright holders argued that a person who digitally re-publishes copyrighted material is engaging in several of those uses that have been expressly enumerated as exclusive rights, specifically the exclusive rights of reproduction, distribution, and public display.¹²³ Consequently, the copyright holders contended that they were entitled to control and profit from any digital re-publication of their works.¹²⁴

Although the defendants in *Tasini*, *Greenberg*, and *Random House* each asserted defenses in response to the copyright infringement claims interposed against them, they effectively conceded that digital re-publication simulates or incorporates some exclusive rights.¹²⁵ In both *Tasini* and *Greenberg*, the defendants' principal infringement defense was to characterize digital re-publication activities as conduct within one or more of the statutory "exemptions" which permit engagement in the exclusive rights without the copyright holder's permission—in this case the § 201(c) revision privilege.¹²⁶ In *Random House*, where the dispute was between two licensees of the copyright holder, the defendant/subsequent licensee contended that Random House's prior license was limited to the exercise of certain exclusive rights

serving its contemporary purpose—protecting those claims upon which people rely in their daily lives from arbitrary deprivation.”).

¹²² See *N.Y. Times Co. v. Tasini*, 533 U.S. 483, 498 (2001); *Greenberg v. Nat'l Geographic Soc'y*, 244 F.3d 1267, 1272 (11th Cir. 2001); *Random House, Inc. v. Rosetta Books LLC*, 150 F. Supp. 2d 613, 620 (S.D.N.Y. 2001), *aff'd*, 283 F.3d 490 (2d Cir. 2002).

¹²³ See *Tasini*, 533 U.S. at 498; *Greenberg*, 244 F. 3d at 1272 n.9; *Random House*, 150 F. Supp. 2d at 620.

¹²⁴ See *Tasini*, 533 U.S. at 491, 498; *Greenberg*, 244 F.3d at 1270; *Random House*, 150 F. Supp. 2d at 614, 620–21.

¹²⁵ See *Tasini*, 533 U.S. at 499; *Greenberg*, 244 F.3d at 1272; *Random House*, 150 F. Supp. 2d at 621 n.6.

¹²⁶ See *Tasini*, 533 U.S. at 492; *Greenberg*, 244 F.3d at 1272.

in connection with the use of the copyrighted works in print media.¹²⁷ The defendant argued that the copyright holders had legitimately granted the subsequent license, which authorized the defendant to engage in many of the same exclusive rights, but in connection with the use of the works in *electronic* media.¹²⁸ Thus, notwithstanding their substantive copyright defenses, the defendants in all three cases implicitly conceded that digital re-publication falls within the copyright holder's exclusive rights.

The identification of any of exclusive rights simulated by or incorporated within a new use for copyrighted material is a reasonable method by which to determine the appropriate author/exclusive rights versus public/free access classification for that new use. It is not, however, the only reasonable method. Another legitimate approach to the new-use classification problem is to consider the new use as *sui generis*—that is, as an activity unique and distinguishable from any existing uses, including any exclusive rights that may be simulated by or incorporated within the new use.

In deciding which uses of copyrighted material should be relegated to the copyright holder as exclusive rights, Congress has the opportunity to consider a variety of factors, including the nature of each particular use and the effect that removing the use from the public enjoyment is likely to have on the underlying objectives of copyright law.¹²⁹ The fact that a new use simulates or incorporates an existing exclusive right, however, does not obviate the need to engage in the same analysis with respect to the new use. Although a new use may simulate or incorporate one or more existing exclusive rights, that new use may also exhibit other characteristics and may also implicate policy issues independent of

¹²⁷ See *Random House*, 150 F. Supp. 2d at 614.

¹²⁸ See *id.*

¹²⁹ See Garon, *supra* note 121, at 1326–27 (“Congress has the legislative authority to tip the balance in favor of copyright owners or towards the public on a case-by-case basis. Except for possible constitutional limitations, Congress can shape the balance across a wide spectrum of issues.” (footnote omitted)); GOLDSTEIN, *supra* note 106, § 1.14 (“The premise of social benefit imports a value judgment and an empirical judgment. Every time Congress amends the Copyright Act, it makes a value judgment about the quantity and quality of literary, musical and artistic works that are socially desirable and an empirical judgment about the amendment’s probable efficacy in achieving that end.”).

those presented by any of the exclusive rights it might incorporate or resemble. The presence of these additional characteristics and policy issues may compel an entirely different conclusion in the exclusive rights versus public free access assessment.¹³⁰ Accordingly, approaching the new use of digital re-publication as merely a simulation or combination of the exclusive rights of reproduction, distribution, and/or public display is somewhat akin to regarding a cake as merely a serving of eggs, milk, and flour.

B. Fortnightly and Teleprompter: When Cable Television Was a “New Use”

Evaluating digital re-publication as a *sui generis* use notwithstanding its simulation or incorporation of certain exclusive rights is not an entirely new idea. Arguably, this was the approach undertaken by the Supreme Court when it was confronted with the classification question in connection with the then new technological use of cable re-transmission of network television broadcasts in *Fortnightly Corp. v. United Artists Television, Inc.*¹³¹ and *Teleprompter Corp. v. Columbia Broadcasting System, Inc.*¹³²

¹³⁰ See Niva Elkin-Koren, *Cyberlaw and Social Change: A Democratic Approach to Copyright Law in Cyberspace*, 14 CARDOZO ARTS & ENT. L.J. 215, 268 (1996) (“Cyberspace is arguably different from previous technologies that were traditionally covered by copyright law in many respects. . . . The argument that two things are different or alike is relative to a governing principle of relevancy. It is one thing to show that digital technology differs from other technologies in terms of the way the information is represented, in the speed of processing information, and in the shape and costs of processors. It is quite another thing to determine which of these differences is relevant for the assignment of rights in digitized products. . . . [O]ne should focus on the differences that are relevant to the promotion of the constitutional goals of copyright law. The relevant changes created by digital technology are those that affect the balance of power between copyright owners and users.”); Hamilton, *supra* note 106, at 343 (“Congress’s power over copyright law [is] not ‘unlimited’ but rather tethered to the public purposes the [Copyright] Clause identifies.” (footnote omitted)); Peter Jaszi, *Caught in the Net of Copyright*, 75 OR. L. REV. 299, 300 (1996) (“Net user’s understanding of rights and duties, grounded as that understanding is in an ethic of information sharing. . . . [I]nformation is a special kind of property, one which—unlike a ball or a jacket—improves, rather than degrades, with use. . . . [T]he understanding of rights in information which traditionally has characterized American copyright—one in which the public interest in reasonable access to information has been afforded as much weight, in balancing, as the private interest in control.”).

¹³¹ 392 U.S. 390, 393–94 (1968).

¹³² 415 U.S. 394, 399–400 (1974).

In the early efforts to commercially exploit cable television technology, cable network entrepreneurs often erected broadcast receiving antennae in or near remote regions, where residents were unable to receive network television broadcasts using only conventional television sets.¹³³ These antennae were erected for the purpose of capturing network broadcasts being transmitted through the air, which were then re-transmitted via cable to area residents for a fee.¹³⁴

In response to this unauthorized use of their copyrighted broadcasts, the holders of the copyrights in televised programs instigated copyright infringement litigation against the cable entrepreneurs.¹³⁵ The network copyright holders argued that cable re-transmission constituted an unauthorized engagement in one of their exclusive rights, specifically the exclusive right to perform their works publicly.¹³⁶

Although cable re-transmission at least simulated the public performance right,¹³⁷ the Supreme Court refused to evaluate the

¹³³ See *Teleprompter*, 415 U.S. at 399–400 (“The operations of [commercial cable] systems typically involved the reception of broadcast beams by means of special television antennae . . . , transmission of these electronic signals by means of cable or a combination of cable and point-to-point microwave to the homes of subscribers, and the conversion of the electromagnetic signals into images and sounds by means of the subscribers’ own television sets.” (footnotes omitted)).

¹³⁴ See *id.*

¹³⁵ See *id.*; *Fortnightly*, 392 U.S. at 393.

¹³⁶ See *Fortnightly*, 392 U.S. at 395; *Teleprompter*, 415 U.S. at 396–97. In a dissenting opinion in *Teleprompter*, Justice Blackmun argued that cable re-transmission constituted engagement in the exclusive right of reproduction: “A [cable operator] that builds an antenna to pick up telecasts in Area B and then transmits it by cable to Area A is *reproducing* the copyrighted work, not pursuant to a license from the owner of the copyright, but by theft.” 415 U.S. at 417 (Blackmun, J., dissenting). Indeed, it would seem that cable re-transmission could be considered a combination or simulation of three separate exclusive rights: reproduction, distribution, and public performance or display.

¹³⁷ See, e.g., *Playboy Enters., Inc. v. Frena*, 839 F. Supp. 1552, 1556–57 (M.D. Fla. 1993). (“Public distribution of a copyrighted work is a right reserved to the copyright owner The concept of display . . . covers ‘the projection of an image on a screen or other surface by any method, the transmission of an image by electronic or other means, and the showing of an image on a cathode ray tube, or similar viewing apparatus connected with any sort of information storage and retrieval system.’ The display right precludes unauthorized transmission of the display from one place to another, for example, by a computer system. ‘Display’ covers any showing of a ‘copy’ of the work,

new use solely from the perspective of whether the public performance right or any other exclusive rights were simulated by the new use.¹³⁸ Instead, emphasizing the fact that cable re-transmission exhibited both exclusive right and public free access characteristics, the Court evaluated it as a *sui generis* activity.¹³⁹ The Supreme Court ultimately ruled that cable re-transmission is closer in character to uses relegated to the public than it is to the exclusive right of public performance:

[Television b]roadcasters perform. Viewers do not perform. Thus, while both broadcaster and viewer play crucial roles in the total television process, a line is drawn between them. One is treated as active performer; the other, as passive beneficiary.

When [cable re-transmission] is considered in this framework, we conclude that it falls on the viewer's side of the line. Essentially, a [cable re-transmission] system no more than enhances the viewer's capacity to receive the broadcaster's signals If an individual erected an antenna on a hill, strung a cable to his house, and installed the necessary amplifying equipment, he would not be "performing" the programs he received on his television set. . . . The only difference in the case of [cable re-transmission] is that the antenna system is erected and owned not by its users but by an entrepreneur.¹⁴⁰

Although Congress would eventually overrule the Supreme Court and specifically designate cable re-transmission as an

'either directly or by means of a film, slide, television image or any other device or process.'" (citations omitted)).

¹³⁸ See *Fortnightly*, 392 U.S. at 398–400; *Teleprompter*, 415 U.S. at 408 ("When a television broadcaster transmits a program, it has made public for simultaneous viewing and hearing the contents of that program. The privilege of receiving the broadcast electronic signals and of converting them into the sights and sounds of the program inheres in all members of the public who have the means of doing so. The reception and rechanneling of these signals for simultaneous viewing is essentially a viewer function . . .").

¹³⁹ See *Fortnightly*, 392 U.S. at 398–400; *Teleprompter*, 415 U.S. at 408.

¹⁴⁰ *Fortnightly*, 392 U.S. at 398–400 (footnotes omitted); see also *Teleprompter*, 415 U.S. at 408.

exclusive right,¹⁴¹ it did so in a manner that lent credence to the Supreme Court's reluctance to approach cable re-transmission as no more than a simulation or combination of certain pre-existing exclusive rights.¹⁴² On one of the few occasions in the history of the American copyright law, Congress imposed a compulsory license¹⁴³ in connection with its designation of cable re-transmission as an exclusive right.¹⁴⁴ This meant that although Congress granted television network copyright holders the right to profit from the new use of cable re-transmission, it did not grant them the right to control it. Instead, Congress determined that given the nature of cable re-transmission, when considered in light of the underlying objectives of the copyright law, the public should be guaranteed the ability to engage in and enjoy the new use for copyrighted material.¹⁴⁵

¹⁴¹ See 17 U.S.C. § 111; Rooks, *supra* note 105, at 267–68.

¹⁴² Rooks, *supra* note 105, at 267–68.

¹⁴³ See U.S. COPYRIGHT OFFICE, A REVIEW OF THE COPYRIGHT LICENSING REGIMES COVERING RETRANSMISSION OF BROADCAST SIGNALS i, iv (1997) (“A compulsory license is a statutory copyright licensing scheme whereby copyright owners are required to license their works to users at a government-fixed price and under government-set terms and conditions. . . . Compulsory licenses are an exception to the copyright principle of exclusive ownership for authors of creative works, and, historically, the Copyright Office has only supported the creation of compulsory licenses when warranted by special circumstances. With respect to the cable and satellite compulsory licenses, those special circumstances were initially seen as the difficulty and expense of clearing all rights on a broadcast signal.”), available at <http://www.copyright.gov/reports/> (last visited Jan. 26, 2004).

¹⁴⁴ See Baoding Hsieh Fan, *When Channel Surfers Flip to the Web: Copyright Liability for Internet Broadcasting*, 52 FED. COMM. L.J. 619, 629–30 (2000) (“In response to two Supreme Court decisions that had held that cable retransmission of broadcast signals did not constitute copyright infringement under the 1909 Copyright Act, Congress amended the Copyright Act in 1976 to specify that retransmissions of broadcast signals—either local or distant, network or independent—are public performances and, therefore, fall within the exclusive rights granted by copyright protection. Section 111 subjects secondary transmissions by cable systems to copyright liability by means of a compulsory license and payment of statutory license fees for certain retransmissions. Later, in order to facilitate the home satellite dish business, Congress passed the Satellite Home Viewer Act of 1988, which created the satellite carrier compulsory license.” (footnotes omitted)).

¹⁴⁵ See *id.* (“A fundamental principle of copyright is that copyrighted works should not be exploited without the consent of the copyright owners. The cable and satellite compulsory licenses are exceptions to this principle. A compulsory license ‘represents a derogation from the basic copyright principles embodied in the Copyright Act that ensure to copyright owners the right to control the use of their creations.’ The cable and satellite

C. *Digital Re-Publication: Sui Generis Use or a New Exclusive Right?*

In related contexts, other commentators have argued that digital use and dissemination of copyrighted material are quite distinct from any of the traditional uses of copyrighted material.¹⁴⁶

compulsory licenses comprise a statutory copyright licensing scheme whereby copyright owners are required to license their works to cable systems and satellite carriers at a government-fixed price and under government-set terms and conditions.” (footnotes omitted)). For an in-depth discussion of the public interest in the interface between intellectual property dissemination and federal regulation of the telecommunication infrastructure, see Leonard M. Baynes & C. Anthony Bush, *The Other Digital Divide: Disparity in the Auction of Wireless Telecommunications*, 52 CATH. U. L. REV. 351 (2003).

¹⁴⁶ See, e.g., Garon, *supra* note 121, at 1335–36 (“Scholars have described the Internet as ‘a unique and wholly new medium of worldwide human communication.’ The Internet can facilitate an ever expanding range of information flow and entertainment activities that include passive listening and viewing of music, film, and audiovisual works, interactive gaming, instant messaging, file sharing, collaborative authoring, and a host of other activities. . . . Digital storage and transmission also allow for virtually perfect reproduction of [material converted into digital formats], with the ability to copy and transmit each file having essentially no reproduction cost The format of the digital file results in a conflation of ideas, information, and the copyrighted expression, as the ‘computer file’ becomes the unitary metaphor for all three attributes of the work.” (footnotes omitted)); Jessica Litman, *Revising Copyright Law for the Information Age*, 75 OR. L. REV. 19, 19–20 (1996) [hereinafter Litman, *Revising*] (“Our current copyright law is based on a model devised for print media, and expanded with some difficulty to embrace a world that includes live, filmed and taped performances, broadcast media, and, most recently, digital media. That much is uncontroversial. The suitability of that model for new media is much more controversial. . . . [S]ince any use of a computer to view, read, reread, hear or otherwise experience a work in digital form requires reproducing that work in a computer’s memory, and since the copyright statute gives the copyright holder exclusive control over reproductions, everybody needs to have either a statutory privilege or the copyright holder’s permission to view, read, reread, hear or otherwise experience a digital work [This syllogism, however,] neatly avoids addressing the policy question whether copyright should be defined in terms that convert individual users’ reading of files into potentially infringing acts, by insisting that Congress chose to set it up this way when it enacted the current law.” (footnotes omitted)); Pamela Samuelson, *Fair Use for Computer Programs and Other Copyrightable Works in Digital Form: The Implications of Sony, Galoob and Sega*, 1 J. INTELL. PROP. L. 49, 102–103 (1993) (“[There is an] extraordinary array of electronic information tools now available . . . that permit users to experiment with the plastic nature of works in digital form. By plasticity, I mean the ease with which such works can be manipulated, transformed, and/or inserted into other works. Although many authors might prefer for their works to remain as fixed as they have traditionally been in printed form, the genie of plasticity cannot be pushed back into the bottle. Digital manipulation is here to stay, for the manipulability of digital data is one of the key advantages of the digital medium.”

These commentators have emphasized the fact that digital use and dissemination involves attributes and applications far beyond anything contemplated by authors, publishers, and/or legislators when they have considered more traditional methods of reproduction, distribution, and/or public display of copyrighted material.¹⁴⁷ Thus, it seems inappropriate to approach the

(footnotes omitted)); Jed Scully, *Beyond Napster—Is It Just Music? Or Are Judicial Resolutions Ineffective in Digital Commerce?*, 15 *TRANSNAT'L LAW.* 313, 319–20 (2002) (“From the beginning of the digital age and the decision to include digital expressive code as ‘literary works’ under the Copyright Act, there has been a continuing tension between ideas, concepts, systems, and common modes of expression in digital form on one hand, and digital works of authorship expressed in software and embedded in code in hardware on the other. . . . A more basic question remains in asking whether copyright law will work in a digital, untethered, global environment, or whether our understanding of copyright is too bound up with geographic metes and bounds, with paper and pen, Tower Record stores, and multiplex movie houses.” (footnote omitted)); Ivan K. Fong, *Law and New Technology: The Virtues of Muddling Through the Digital Dilemma: Intellectual Property in the Information Age*, 19 *YALE L. & POL’Y REV.* 443, 445, 447 (2001) (book review) (“[M]any of the intellectual property rules and practices that evolved in the world of physical artifacts do not work well in the digital environment’ [U]nlike access to traditional media (reading a book, watching a movie, or listening to a CD), access to digital works inevitably requires the making of a copy, and that, unlike copying traditional works, copying digital works is easy, inexpensive, and produces perfect copies. Add to that the fact that computer networks now make global distribution of that information inexpensive and nearly instantaneous, and one can easily see how existing copyright law, which might have prohibited (or at least tolerated) the individual copying contemplated in the analog world of traditional media, might be ill-suited to deal with the sort of mass copying rendered simple and commonplace on the Internet.”).

¹⁴⁷ See Scully, *supra* note 146, at 319 (“The nature of experimentation and development of derivative works, of criticism, analysis, even hacking for analytical purposes, necessarily involves digital copying to engage in those protected functions in a way unnoticed and beyond the control of rights holders in an analog age.”); Elkin-Koren, *supra* note 130, at 254–55 (“Digitization . . . allows users to easily retransmit materials. Users may use scanners to digitize photos or texts that are published in a traditional form. A digitized copy that was delivered through the network may be downloaded by the user and retransmitted. Retransmission through digitized versions is both easy and inexpensive. Everything digitized may be reproduced in seconds and at low cost. Self-publishing is also available through network communication. . . . Cyberspace integrates the generation and distribution of information. Digital networks provide direct communication between authors and potential readers. . . . Consequently, everyone with access to a computer network may become a publisher. Network distribution creates a continuum that goes from personal writing on one hand, to publication on the other, with many degrees of connectivity and access permissions in between.” (footnotes omitted)); Pollack, *supra* note 121, at 2445 (“Digitization of copyrighted materials permits instantaneous, simplified copying methods that produce nearly perfect copies of originals.

classification of digital re-publication solely on the basis of its simulation or incorporation of these pre-existing exclusive rights.¹⁴⁸

Consistent with the policy objectives that underlie the copyright law, courts typically resist the entreaties of copyright holders to expand the realm of exclusive rights to a “default” classification option, to be invoked when confronted with a new technological use that does not easily fit into the exclusive rights/public free access dichotomy.¹⁴⁹ Indeed, traditional judicial

These copies can be digitally delivered to thousands of Internet users. Decentralization and anonymity in cyberspace have allowed for the widespread dissemination of copyrighted materials without permission from their owners.” (footnotes omitted)).

¹⁴⁸ See Litman, *Revising*, *supra* note 146, at 36–37 (“When the old copyright laws fixed on reproduction as the compensable (or actionable) unit, it wasn’t because there was something fundamentally invasive of an author’s rights about making a copy of something. Rather, it was because, at the time, copies were easy to find and easy to count, so they were a useful benchmark for deciding when a copyright owner’s rights had been unlawfully invaded. . . . They are less useful measures today. . . . By happenstance . . . , control over reproduction could potentially allow copyright owners control over every use of digital technology in connection with their protected works. This is not what the Congresses in 1790, 1870, 1909 and 1976 meant to accomplish when they awarded copyright owners exclusive reproduction rights.”); Samuelson, *supra* note 146, at 53 (“When . . . new technology present[s] an issue that [can] not be readily answered from the copyright statute, the regulatory view of copyright would have courts go back to first principles to determine which result would best achieve the societal purposes of copyright law.” (footnote omitted)); Scully, *supra* note 146, at 322 (“[W]e must acknowledge in the law and in practice that controlling copyright by outlawing or preventing technological change is fruitless and self defeating.”).

¹⁴⁹ See Hamilton, *supra* note 106, at 326 (“ [W]hen new technologies appeared for which there was no existing analogy in the statute, the Court was inclined to deny authors the power to control or benefit from the new technology through copyright law. . . . [I]t took seriously the Copyright Clause’s charge to further the ‘Progress of Science [or knowledge] and useful Arts,’ and interpreted this language to mean that the Clause places the public interest ahead of all others.”); Litman, *Revising*, *supra* note 146, at 22 (“[T]he contours of [the digital technology/copyright] dispute don’t look very different from the shape of very similar disputes that arose in the 1980s, when the gods invented personal computers; or the 1970s, when they invented videocassette recorders; or the 1960s, when they invented cable television; or the 1920s, when they invented commercial broadcasting and talkies. Arguing that Congress already considered a question, and resolved it in one’s favor then, is a common tactic in the history of copyright lobbying because it bypasses the problem of persuading Congress to consider the question and resolve it in one’s favor today.” (footnote omitted)); Fong, *supra* note 146, at 448 (“New technology and new business models for delivering content are almost always greeted with the belief that they will destroy the existing market. In 17th century England, the emergence of lending libraries was seen as the death knell of book stores; in the 20th

construction of American copyright as positive law imposed for the public benefit mandates the rejection of an exclusive rights “default” approach.¹⁵⁰

century, photocopying was seen as the end of the publishing business, and videotape the end of the movie business. Yet in each case, the new development produced a new market far larger than the impact it had on the existing market. Lending libraries gave inexpensive access to books that were too expensive to purchase, thereby helping to make literacy widespread and vastly increasing the sale of books. Similarly, the ability to photocopy makes the printed material in a library more valuable to consumers, while videotapes have significantly increased viewing of movies.” (footnote omitted)).

¹⁵⁰ See *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 580 (1985) (Brennan, J., dissenting) (“The enactment of copyright legislation by Congress under the terms of the Constitution is not based upon any natural right that the author has in his writings . . . but upon the ground that the welfare of the public will be served and progress of science and useful arts will be promoted by securing to authors for limited periods the exclusive rights to their writings.” Congress thus seeks to define the rights included in copyright so as to serve the public welfare and not necessarily so as to maximize an author’s control over his or her product.” (quoting H.R. REP. NO. 60-2222, at 7 (1909)); REPORT OF THE REGISTER OF COPYRIGHTS ON GENERAL REVISION OF THE COPYRIGHT LAW I-5 (1961) (“The enactment of copyright legislation by Congress under the terms of the Constitution is not based upon any natural right that the author has in his writings, for the Supreme Court has held that such rights as he has are purely statutory rights. . . . The Constitution does not establish copyrights, but provides that Congress shall have the power to grant such rights if it thinks best.” (quoting H.R. REP. NO. 60-2222 (1908)); Brown, *supra* note 105, at 592–93 (“The copyright-patent clause is the only one of the enumerated powers of Congress that is prefaced by a statement of purpose: ‘to promote the Progress of Science and useful Arts.’ The clause does not say ‘to maximize the returns to authors and inventors.’ . . . [W]hen one considers the solemnity of the clause, the Supreme Court’s continuing concern for the public good, and the deeply rooted understanding that copyright flows from acts of Congress and not from natural right, one thing seems clear. When Congress legislates and courts fill in the blank spaces, both branches need ways to assess and balance the expected public good and private rewards.” (footnotes omitted)); Garon, *supra* note 121, at 1306–07 (“The power to create a balance between the author and the public may be the most significant philosophical distinction between a natural rights theory of copyright and an economic rationale. Under the natural rights theory, the power over one’s writings is a ‘sacred’ liberty that cannot be limited for the public good, whereas the economic rationale allows for a balancing between the interests of the public in accessing the good and the right of the author to receive an economic reward.” (footnotes omitted)); Patterson, *supra* note 107, at 4 (“[T]he Copyright Clause is specifically a limitation on, as well as a grant of, Congress’s power. The limitations are manifest in three basic policies expressed in the Copyright Clause: the promotion of learning . . . ; the protection of the public domain . . . ; and the benefit for the author The policies are not wholly consistent—protection of the public domain necessarily limits the benefit to the author—and the careful phrasing of the Copyright Clause to include them all indicates a specific purpose: protection against the misuse of copyright. A misuse would occur, for example, if a copyright owner used copyright to inhibit rather than promote learning” (footnotes omitted)); Rooks, *supra*

When the traditional copyright analogues do not satisfactorily apply, it is appropriate for Congress to act.¹⁵¹ Congress is best equipped to determine the appropriate manner in which to interpret, apply, and if necessary, amend the copyright law in order to address a *sui generis* challenge to the constitutional copyright objective and the established copyright framework.¹⁵² It is the

note 105, at 258 (“[T]he monopoly privileges that Congress may authorize are neither unlimited nor primarily designed to provide a special private benefit. Rather, the limited grant is a means by which an important public purpose may be achieved. It is intended to motivate the creative activity of authors . . . and to allow the public access to the products of their genius after the limited period of exclusive control has expired.” (footnotes omitted)).

¹⁵¹ See Daniel J. Gifford, *The Antitrust/Intellectual Property Interface: An Emerging Solution to an Intractable Problem*, 31 HOFSTRA L. REV. 363, 406 (2002) (“[I]n the Digital Millennium Copyright Act, the Congress did legislate specifically with respect to the use of copyright as a tie to control an aftermarket. In its amendments to [§] 117, Congress formulated a more precise policy about the use of copyrighted software as a tying product. Congress, in effect, told us that a copyrighted software program which is activated whenever equipment is turned on may not be leveraged to control the market for maintenance and repair services of that machine.” (footnote omitted)); Litman, *Revising*, *supra* note 146, at 31–32 (“Copyright owners . . . have never been entitled to control all uses of their works. Instead, Congress has accorded copyright owners some exclusive rights, and reserved other rights to the general public. . . . Indeed, it is conventional to argue that copyright holders should receive only such incentives as are necessary to impel them to create and disseminate new works.” (footnotes omitted)); Mtima, *supra* note 33, at 406 (“In 1998 the Digital Millennium Copyright Act (‘DMCA’) became law, amending various aspects of the copyright law to address some of the unique issues presented by advances in digital information technology Among other things, the DMCA virtually extinguishes Internet access provider liability in connection with the misconduct of third parties, such as cybersquatters and bulletin board operators and/or users. In addition, the DMCA generally prohibits the circumvention of encryption and other mechanisms implemented to protect copyrighted material [Yet another] significant change resulting from the enactment of the DMCA . . . concerns . . . RAM copies . . . [—the] ‘copying’ [that] occurs when a computer program is transferred from a permanent storage device to a computer’s random access memory As a result of the passage of the DMCA, [unauthorized] RAM copying [under certain] circumstances no longer constitutes copyright infringement” (citations omitted)).

¹⁵² See, e.g., Litman, *Revising*, *supra* note 146, at 33–34 (detailing previous Congressional provisions for specific technologies); Samuelson, *supra* note 146, at 63 (“Taking a regulatory approach to resolving a hotly contested case involving a new technology issue is particularly appropriate when copyright claimants make unprecedented claims about the reach of their rights”); Fong, *supra* note 146, at 447 (“Further complicating these issues . . . are the wide-ranging and often conflicting interests of multiple stakeholders, which range from intellectual property creators to intellectual property distributors, schools and libraries, the general public, and other consumers and producers of intellectual property (governmental organizations, private

responsibility of Congress to assess whether the overarching goals of the copyright law are best served by designating a new use as an exclusive right, a use as to which the public should be given free reign, or a use that warrants the application of a customized response, such as a compulsory license.¹⁵³

Until the issue of classification of digital re-publication is placed squarely before the courts and/or Congress, however, existing precedent remains based on the premise that digital re-publication simulates, incorporates, or otherwise impinges upon at least some of the copyright holder's existing exclusive rights.¹⁵⁴ From this perspective, a defendant accused of copyright infringement through digital re-publication must either prove possession of an appropriate license, as successfully argued by the

sector organizations, journalists, and standards organizations); Cynthia M. Ho, *Attacking the Copyright Evildoers in Cyberspace*, 55 SMU L. REV. 1561, 1561–62 (2002) (“In the context of copyrights on the Internet, different evildoers are identified, depending on who is asked to identify the evildoers. For example, to most consumers, the evildoers in cyberspace are the copyright owners that have stripped the Internet of its freewheeling nature by removing things such as the file-sharing tool Napster. On the other hand, major copyright owners vilify consumers—and those who assist them—for making copies of copyrighted material with little regard for whether the consumers own original copies. The identification of evildoers implicitly discounts the possibility that parties merely possess differing, but reasonable views. Rather, the current polarized vision of evildoers has created a situation in which consumers are immune to allegations of copyright piracy and content owners rush to create new methods—whether legal or technological—to halt consumer copying.” (footnotes omitted)). Recognizing and reconciling these diverse interests—and the need to view the issues through the lenses of technology, law, economics, psychology and sociology, and public policy—are important first steps in the balancing exercise that is at the heart of the current digital policy debate . . .”).

¹⁵³ See Hughes, *supra* note 109, at 288 (“As our attention continues to shift from tangible to intangible forms of property, we can expect a growing jurisprudence of intellectual property. The foundation for such a jurisprudence must be built from an understanding of the philosophical justifications for property rights to ideas . . .”); Litman, *Exclusive Right*, *supra* note 118, at 33–34 (“[B]efore we succumb to calls for further enhancement of the rights in the copyright bundle, we need to reexamine the intellectual property bargain from the vantage point of the public, on whose behalf, after all, the copyright deal is said to be struck in the first place.” (footnotes omitted)). For example, the compulsory license mechanism seems well suited to address many of the dilemmas presented by digital information technology. I will explore this question as a solution to the problem of copyright infringement through the use of MP-3 technology in a forthcoming article.

¹⁵⁴ See generally *N.Y. Times Co. v. Tasini*, 533 U.S. 483 (2001).

defendant in *Random House*,¹⁵⁵ or must demonstrate that his or her digital re-publication activities qualify for exemption from the requirement that they be conducted with the copyright holder's consent, the strategy pursued by the defendants in *Tasini* and *Greenberg*.¹⁵⁶

As discussed in Part I, the principal argument advanced by the defendants in *Tasini* and *Greenberg* was that their activities were exempt from the requirement of authorization by the copyright holder because they fell within the revision privilege provided by § 201(c). The validity of this position, particularly with respect to exact digital replicas of printed works, is explored in the next section.

III. UNAUTHORIZED DIGITAL RE-PUBLICATION AND § 201(C)

As discussed in Part II, copyright holders are granted certain exclusive property rights in their works. When others encroach upon these rights, the law provides the copyright holder with an action for copyright infringement.¹⁵⁷

A claim of copyright infringement in the electronic media/digital re-publication context involves the same sequential analysis as in assessing infringement claims raised in connection with traditional media. First, the court must determine that the plaintiff has demonstrated ownership of a valid copyright.¹⁵⁸

¹⁵⁵ See *Random House, Inc. v. Rosetta Books LLC*, 150 F. Supp. 2d 613, 614 (S.D.N.Y. 2001), *aff'd*, 283 F.3d 490 (2d Cir. 2002).

¹⁵⁶ See *Tasini*, 533 U.S. at 488; *Greenberg v. Nat'l Geographic Soc'y*, 244 F.3d 1267, 1270 (11th Cir. 2001).

¹⁵⁷ See Appel, *supra* note 119, at 170 ("Copyright infringement is defined as the unprivileged violation of any of the copyright owner's exclusive rights. Thus, reproduction, adaptation, distribution, publication, performance, or public display of a copyrighted work without permission of the copyright owner amounts to infringement unless it falls within one of the exceptions to the copyright owner's exclusive rights." (footnotes omitted)); Pollack, *supra* note 121, at 2456 ("The Copyright Act does not require a showing of intent on the part of a direct infringer, hence, the infringer is liable whether or not he was aware that he was using copyrighted material in an illegal manner. Infringement occurs even when only one copy of a work is made, for example, where a consumer reproduces a copy solely for private purposes." (footnotes omitted)).

¹⁵⁸ A certificate of copyright registration constitutes *prima facie* evidence of the validity of a copyright. See *Lotus Dev. Corp. v. Borland Int'l, Inc.*, 49 F.3d 807, 813 (1st Cir.

Second, the plaintiff must adduce evidence that the defendant has engaged in one or more of the exclusive rights in connection with original constituent elements of the copyrighted work.¹⁵⁹

Where there is no dispute regarding the validity of the plaintiff's copyright, analysis of the infringement claim begins with a determination of whether the unauthorized electronic publication involves one or more of the exclusive rights, and if so, which ones.¹⁶⁰ Once it has been established that the unauthorized electronic activity involves one or more of the exclusive rights, the resolution of the infringement claim will turn on the nature of the defense raised in support of the unauthorized use.¹⁶¹ Unless the infringement defendant asserts some claim of license, he or she must rely instead upon one of the copyright defenses that permit

1995) (citing *Bibbero Sys., Inc. v. Colwell Sys., Inc.*, 893 F.2d 1104, 1106 (9th Cir. 1990)). Unless such *prima facie* validity is affirmatively rebutted by the copyright defendant, the copyright plaintiff need only demonstrate unauthorized copying to establish her cause for infringement. See *Gates Rubber Co. v. Bando Chem. Indus.*, 9 F.3d 823, 831 (10th Cir. 1993).

¹⁵⁹ See *Feist Publ'ns, Inc. v. Rural Tel. Servs. Co.*, 499 U.S. 340, 361 (1991); *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 587 (1985) (Brennan, J., dissenting); *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 433 (1984); *SunTrust Bank v. Houghton Mifflin Co.*, 268 F.3d 1257, 1266 (2001); *Rogers v. Koons*, 960 F.2d 301, 306 (2d Cir. 1992); *SoftMan Prods. Co. v. Adobe Sys. Inc.*, 171 F. Supp. 2d 1075, 1081 (C.D. Cal. 2001); *Religious Tech. Ctr. v. Netcom On-Line Communication Servs., Inc.*, 907 F. Supp. 1361, 1366-67 (N.D. Cal. 1995); Ryan C. Edwards, Note, *Who Said Nothing in This World Is Free?* *A&M Records, Inc. v. Napster, Inc.: Problems Presented, Solutions Explored, and Answers Posed*, 89 KY. L.J. 835, 842-43 (2000/2001); see generally Koenigsberg, *supra* note 112, at 148.

¹⁶⁰ See *Random House, Inc. v. Rosetta Books LLC*, 150 F. Supp. 2d 613, 620-24 (S.D.N.Y. 2001), *aff'd*, 283 F.3d 490 (2d Cir. 2002); *Field v. True Comics, Inc.*, 89 F. Supp. 611, 613; *Koons*, 960 F.2d at 306; cf. *NIMMER & NIMMER*, *supra* note 53, § 13.01 (outlining the necessary elements in an infringement action). Identifying the specific exclusive rights at issue from the outset can be helpful in efficiently evaluating the infringement claim, in as much as analyzing a claim of unauthorized reproduction, for example, is likely to involve different factual issues and evidentiary findings than analyzing a claim of unauthorized production of a derivative work.

¹⁶¹ See generally *e.g.*, *Random House*, 150 F. Supp. 2d at 613 (analyzing the meaning of the contract language, in a case in which the defendant claimed that the authors' licensing agreements with the plaintiff did not grant electronic rights).

engagement in the exclusive rights without the copyright holder's consent.¹⁶²

A. Interpreting § 201(c) in the Wake of Tasini and Greenberg

In *Tasini* and *Greenberg*, the publishers were unable to produce license agreements authorizing their digital re-publication activities.¹⁶³ Instead, they sought refuge in the revision privilege embodied in § 201(c), which permits publishers to use contributory works in revisions without the authorization of the authors of those works.¹⁶⁴

The courts did not agree with the plaintiffs' expansive interpretation of § 201(c). The courts in *Tasini* and *Greenberg* held that the reproduction of a printed collective work into a digital format can result in both the disassembly of the work and the dissolution of the publisher's creative editorial contribution, and thereby constitute an entirely new publication of the contributory works.¹⁶⁵ In such cases, the digital re-publication does not qualify as a revision within the meaning of § 201(c).¹⁶⁶

The principal holding in both *Tasini* and *Greenberg*—that the nature and extent of any alterations made to the original collective work in producing a subsequent version will determine whether that version is a revision of the original or a new work¹⁶⁷—seems

¹⁶² Compare *id.*, with *N.Y. Times Co. v. Tasini*, 533 U.S. 483, 488 (2001). In *Tasini*, unlike *Random House*, the defendant publishers looked to the § 201 "privilege," rather than to any contract language.

¹⁶³ See Alan Gruber, Note, *Interpretation of "Revision" Under the Copyright Act Spells Trouble for Publishers: Greenberg v. National Geographic Society*, 4 TUL. J. TECH. & INTELL. PROP. 223, 229 (2002) ("Over the last twenty years, technological advancements and their rapid emergence and integration into the daily lives of many, caught some off-guard, including publishers. This is demonstrated by the noticeable absence of a clause addressing copyright ownership in electronic databases in *Greenberg's* and other freelancer[s'] contracts."); cf. Vermeylen, *supra* note 92, at 198 ("[In *Random House* the publisher] relied on . . . clauses in its contracts with the authors—clauses that are common in publishing contracts—to advance its argument that the contracts signed by the authors decades ago foreclosed the authors from selling electronic rights to any third party." (footnote omitted)). For further discussion in this area, see Part V.

¹⁶⁴ See *Tasini*, 533 U.S. at 488; *Greenberg*, 244 F.3d at 1272.

¹⁶⁵ See *Tasini*, 533 U.S. at 502–04; *Greenberg*, 244 F.3d at 1272–73.

¹⁶⁶ See *Tasini*, 533 U.S. at 502–04; *Greenberg*, 244 F.3d at 1272–73.

¹⁶⁷ See *Tasini*, 533 U.S. at 496–97; *Greenberg*, 244 F.3d at 1272–73.

in retrospect fairly straightforward. Thus, whether the later version is produced in print, digital format, or some other medium, *Tasini* and *Greenberg* clarify that the § 201(c) revision privilege is a narrow one, which permits only an appropriate updating of the original collective work as a whole, and does not extend to changes to the individual contributory works therein, the use of the contributory works in the creation or assembly of a new collective work, or similar incursions into the author's realm of exclusive rights.¹⁶⁸

Moreover, the Supreme Court in *Tasini* distinguished a publisher's § 201(c) revision privilege from the independent ability of contributory authors to affirmatively license their exclusive rights.¹⁶⁹ The Court explained that the revision privilege should not be construed as a *de facto* license to engage in any of the contributory authors' exclusive rights.¹⁷⁰ Rather, § 201(c) merely provides publishers a limited "privilege" to impinge upon certain rights in order to undertake a specified activity such as updating or revising a collective work.¹⁷¹ Any "non-revision" engagement in the contributory authors' exclusive rights, *electronic or otherwise*, must be specifically licensed by the individual copyright holders and effectuated in accordance with the provisions of the copyright statute.¹⁷²

¹⁶⁸ See *Tasini*, 533 U.S. at 496–97; *Greenberg*, 244 F. 3d at 1272–74. Thus, in a very real sense the opinions in *Tasini* and *Greenberg* have more to do with the clarification of § 201(c) than with the specific application of the copyright law to the new information technologies. Had the works at issue not been collective works, the courts' initial confrontation with the digital re-publication issue would likely have required a broader application of the copyright law, as opposed to the divination of a relatively obscure copyright privilege in connection with a narrow specie of copyrighted material.

¹⁶⁹ See *Tasini*, 533 U.S. at 503–04.

¹⁷⁰ See *id.* at 496–97, 500–01, 503–04.

¹⁷¹ Thus, the revision privilege is distinguished from the publisher's own independent copyright and exclusive rights in the collective work as a whole. The revision privilege merely serves to prevent the restoration of the author's contributory work copyright from becoming a "veto power" against the publisher's ability to revise and update the collective work, which benefits society. See *Tasini v. N.Y. Times Co.*, 972 F. Supp. 804, 815–16 (S.D.N.Y. 1997) (stating that there is "a competing goal of ensuring that collective works be marketed and distributed to the public"), *rev'd and remanded*, 206 F.3d 161 (2d Cir. 1999), *aff'd*, 533 U.S. 483 (2001).

¹⁷² Emphasizing the distinction between the basis for the collective work copyright and the purpose and parameters of the revision privilege also supports the conclusion that

B. Exact Digital Replicas: Revisions or New Publications?

In clarifying the breadth of the revision privilege, however, the *Tasini* and *Greenberg* analyses also raised some unresolved issues specifically pertinent to digital re-publication. In reaching their respective decisions, both courts cited certain attributes inherent to digital media, such as the ability to retrieve individual articles independent of the collective work as a whole and the secondary market impact of such attributes, as among the principal bases for their decisions.¹⁷³ The digital re-publications at issue in *Tasini* and *Greenberg* all reflected changes to the content of the original print versions on which they were based.¹⁷⁴ On the other hand, the cited attributes and market impact ramifications remain an issue where the subsequent version is an exact digital replica of the original. Accordingly, an important question left open by *Tasini* and *Greenberg* is whether a full-image, exact digital replica of a collective work with no additions or deletions to the content of the original print version qualifies as a § 201(c) revision.

As cogently argued by Justice Stevens in his dissent in *Tasini*, the disqualification of a digital re-publication as a § 201(c) revision solely on the basis of attributes unique and inherent to electronic media formats contradicts the doctrine of media neutrality.¹⁷⁵

exact digital replicas are not § 201(c) revisions. The basis for the publisher's copyright is his or her own creative contribution in arranging and editing the collective work. Although a subsequent version of a collective work must reflect the publisher's original editorial contribution in order to qualify as a § 201(c) revision, the fact that it does so does not end the § 201(c) analysis. In addition to the publisher's creative contribution, the subsequent version might contain other features and attributes inconsistent with the purposes of § 201(c). See *Tasini*, 533 U.S. at 502 n.10. Thus, an exact digital replica will obviously reproduce the publisher's original editorial contributions, but does not revise or update the work. Likewise, if a subsequent version of a collective work does not reflect the editorial content of the original version, the original work has not been "revised," but rather an entirely new collective work has been assembled.

¹⁷³ See *Tasini*, 533 U.S. at 497–500; *Greenberg*, 244 F.3d at 1269.

¹⁷⁴ As discussed in Part I, the digital re-publications in *Tasini* were either content-altered electronic versions or full-image compendiums of previously independent editions or works. See *Tasini*, 533 U.S. at 490–91. In *Greenberg*, previously independent issues were collectively reproduced and combined with entirely new material on the NG-CD. See *Greenberg*, 244 F.3d at 1268–70.

¹⁷⁵ See *Tasini*, 533 U.S. at 512–13 (Stevens, J., dissenting) ("No one doubts that the New York Times has the right to reprint its issue in Braille . . . or in microform, even though such revisions might look and feel quite different from the original. Such

Although there were no “absolutely exact” digital replicas at issue in *Tasini*, if the reasoning of the majority is taken to its logical conclusion, Justice Stevens’ arguments prove quixotic. A printed collective work that is updated to include a more recent article falls squarely within § 201(c), so long as the updating is undertaken in print.¹⁷⁶ Under the reasoning of the *Tasini* majority, however, if the updated version is produced in digital format, it would be regarded as a new publication of its contributory works and therefore disqualified as a revision.¹⁷⁷

Although neither *Tasini* nor *Greenberg* actually decides the issue, the two courts appear to have contradictory views of exact digital replicas with respect to § 201(c). The *Greenberg* court observed that if it were dealing only with the Replica portion of the NG-CD, the fact that it is an exact digital replica of the original printed back issues of *National Geographic Magazine* would seem to preclude its characterization as a new work.¹⁷⁸ The court also considered, and ultimately rejected, the option of classifying the Replica as a derivative work—“a work based upon one or more preexisting works, such as a translation, musical arrangement, dramatization, fictionalization, motion picture version, sound recording, art reproduction, abridgment, condensation, or any other form in which a work may be recast, transformed, or adapted.”¹⁷⁹ The court concluded that “in order to qualify as a derivative work, the resulting work . . . after transformation must qualify as an ‘original work of authorship.’ Thus, the mere electronic digital

differences, however, would largely result from the different medium being employed. Similarly, the decision to convert the single collective work newspaper into a collection of individual ASCII files can be explained as little more than a decision that reflects the different nature of the electronic medium. . . . The bare-bones nature of ASCII text would make trying to wade through a single ASCII file containing the entire content of a single edition of the New York Times an exercise in frustration.”). While Justice Stevens’ concerns regarding the doctrine of media neutrality are compelling, recognizing that the reproduction of a printed work into digital format does not result in the creation of a new work does not lead to the conclusion that the digital result is a “revision.”

¹⁷⁶ See 17 U.S.C. § 201(c) (2003).

¹⁷⁷ See *Tasini*, 533 U.S. at 497–500.

¹⁷⁸ See *Greenberg*, 244 F.3d at 1272 (noting that the court was “[a]ssuming *arguendo*, but expressly not deciding, that 201(c)’s revision privilege embraces the entirety of the Replica portion of the [NG-CD]”).

¹⁷⁹ *Id.* at 1274 n.14 (quoting 17 U.S.C. § 101).

reproduction . . . may not qualify as a derivative work”¹⁸⁰ Accordingly, the *Greenberg* court seemed prepared to grant exact digital replicas § 201(c) revision status.

In contrast, certain rulings by the Supreme Court in *Tasini* cast considerable doubt upon the eligibility of exact digital replicas for sanctuary under § 201(c). For one thing, the Court ruled that the *New York Times*’ GPO CD, a full-image replica product, did not qualify as a § 201(c) revision.¹⁸¹ The ruling is not dispositive, however, because the Court appears to have based its ruling in part upon the fact that the GPO CD includes more than one edition of the *New York Times*, as well as digital replicas of other periodicals, all on a single disc.¹⁸² Accordingly, the Court understandably considered this kind of compilation of independent collective works as something other than a *revision* of each of the independent collective works therein.¹⁸³

¹⁸⁰ *Id.*

¹⁸¹ *See Tasini*, 533 U.S. at 500 (“One might view the articles as parts of new compendium—namely, the entirety of works in the Database.”).

¹⁸² *See id.* at 499–502 n.11 (“The dissenting opinion apparently concludes that, under the banner of ‘media-neutrality,’ a copy of a collective work, even when considerably changed, must constitute a ‘revision’ of that collective work so long as the changes were ‘necessitated by . . . the medium.’ We lack the dissent’s confidence that the current form of the Databases is entirely attributable to the nature of the electronic media, rather than the nature of the economic market served by the Databases.” (citation omitted)).

¹⁸³ For certain purposes, it might be appropriate to treat compilations of the same periodical, for example, all editions of the *New York Times* for 1990, differently from a compilation of different periodicals, say a compilation of all national newspapers published in 1990. In any case, while neither a compendium or a compilation constitutes a revision, other commentators have also questioned whether such versions should be considered entirely new works. *See Albert & Barzilay, supra* note 56, at 17 (“Publishers should . . . consider keeping the electronic versions of their publications as similar as possible to their print format. . . . The language in *Tasini* suggests that this format would qualify as a ‘revision’ of the original periodical issue, and thus the rights would belong to the publisher, thereby defeating a *Tasini*-style claim by authors.”); Wendy Gordon, *Fine-Tuning Tasini: Privileges of Electronic Distribution and Reproduction*, 66 BROOK. L. REV. 473, 486 (2000) (“[I]t is hard to imagine that merely collecting several verbatim, full-format issues of [various collective works] on a disk together . . . makes a new ‘version’ that exceeds the [§ 201(c)] privilege, any more than a library infringes a copyright holder’s rights when it binds journal issues together in a hard-cover volume.” (footnote omitted)). As discussed in Part III.D, however, while an exact digital replica should not be regarded as a new work, it should not be considered a “revision” of the original work.

Nonetheless, even if each GPO CD contained no more than an exact replica of only a single edition of the *New York Times*, it does not follow that the *Tasini* majority would allow it as a § 201(c) revision.¹⁸⁴ If the resulting electronic product is amenable to Boolean searches and individual article retrieval, these attributes would present the contributory articles outside the context of the original collective work and would have an impermissible impact on the “stand-alone” secondary market for such works.¹⁸⁵ Consequently, it appears that the *Tasini* majority would regard an exact digital replica as a new publication for the purposes of applying § 201(c).¹⁸⁶

C. Exact Digital Replicas Are Not § 201(c) Revisions

The issue of exact digital replicas crystallizes the tension between the views of the majority and dissent in *Tasini*. It is possible, however, to reconcile these competing views. Indeed, they can be reconciled not only with respect to exact digital replicas, but perhaps also with respect to most content-altered digital re-publications as well. By basing the qualification of a digital re-publication as a § 201(c) revision on the *content* of the digital version, as opposed to its digital media attributes, the conflict with the doctrine of media neutrality can be avoided.

D. What Constitutes a Revision?

There are a variety of changes that can be made to a printed work that go beyond merely revising the work, but fall short of creating an entirely new work or publication. Depending upon the purpose and nature of the changes made to the original version of a work, there are different kinds of versions that will result from these changes.

In general, the label given to each resulting version also signifies the purpose in undertaking the subsequent version.¹⁸⁷ For

¹⁸⁴ See *Tasini*, 533 U.S. at 503.

¹⁸⁵ See *id.* at 497.

¹⁸⁶ See *id.* at 502–04.

¹⁸⁷ See, e.g., NAT G. BODIAN, BODIAN'S PUBLISHING DESK REFERENCE: A COMPREHENSIVE DICTIONARY OF PRACTICES AND TECHNIQUES FOR BOOK AND JOURNAL MARKETING AND BOOKSELLING 3 (1988) (defining abridgment as “[e]limination of

example, when a work is translated into a different language, the resulting version is referred to as a translation; when a new version is undertaken in order to correct significant errors in the original, the result is often referred to as an emendation; when the original version of the work is streamlined to delete nonessential or extraneous matter, the resulting version is sometimes referred to as an abridgment.¹⁸⁸ Indeed, in some cases, in order to properly characterize the result of even a single change to the original version, it might be necessary to know the specific purpose for the change. The removal of material might be an emendation if the material was included in error or an abridgment if the material is subsequently considered non-essential to a particular audience or market for the work.¹⁸⁹

A revision is commonly understood as a purposeful alteration of content undertaken for some substantive reason.¹⁹⁰ Purely cosmetic alterations, such as changing font size or designing a new cover for a work, generally do not result in the production of a substantive revision.¹⁹¹ Likewise where an exact replica of the

sections of a book, or the rewriting of the text in condensed form so as to make the text desirable to a different audience, of to broaden the market for an expensive library work to individuals by price reduction”).

¹⁸⁸ See MERRIAM-WEBSTER'S COLLEGIATE DICTIONARY 4, 377, 1254 (10th ed. 1993) [hereinafter MERRIAM-WEBSTER'S] (defining abridgement as “a shortened form of a work retaining the general sense and unity of the original”; defining emendation as “an alteration designed to correct or improve” and which is usually “textual”; defining translation as “a change to a different substance, form, or appearance: conversion”); see also BODIAN, *supra* note 187, at 3.

¹⁸⁹ See MERRIAM-WEBSTER'S, *supra* note 186, at 377; BODIAN, *supra* note 187, at 3.

¹⁹⁰ According to WEBSTER'S DICTIONARY, to revise is “to alter something already written or printed, in order to make corrections, improve or update.” RANDOM HOUSE WEBSTER'S COLLEGE DICTIONARY 1113 (2d ed. 1997); see also MERRIAM-WEBSTER'S, *supra* note 188, at 1005 (defining revision as an “alteration” or “mak[ing] a new, amended, improved, or up-to-date version”).

¹⁹¹ See DAVID M. BROWNSTONE & IRENE M. FRANCK, THE DICTIONARY OF PUBLISHING 238 (1982) (defining revision as “1. The process of altering a body of written work; for example, alterations made in a manuscript by its author at any stage of manuscript preparation, alterations made in a published work in preparation for issuance of a new edition, or alterations made in a contract being negotiated. 2. A new edition of a previously published work, containing alterations amounting to more than corrections; often including updating materials, as in a textbook or annual. Also called a *revised edition*.”).

original work is produced, the result is not a revision because nothing has been “revised.”¹⁹²

The reproduction of a printed work into a different medium may result in any of the foregoing kinds of versions or even a new work altogether, depending upon the nature of the *changes to its content* that are undertaken in connection with its reproduction. To label an exact digital replica of a printed work a “revision” is to treat that term as being synonymous with the term “version” or even “copy.” It seems more appropriate to characterize an exact digital replica of a printed work as an “archive version” or an “archive copy”—that is, a version or copy made for archival purposes—as opposed to a substantive “revision” of the original printed version or an entirely new work.¹⁹³

Thus, while *Tasini* and *Greenberg* can be interpreted to stand for the proposition that certain changes to a collective work will render the result more than a mere revision of the original work, common sense copyright as well as ordinary custom and usage seem to dictate that where no changes are made to the content of the original version, the subsequent version is not a revision because the collective work has not actually been revised. Indeed, exact digital replicas are particularly amenable to classification as “archive versions,” as opposed to revisions or new works, because in such cases the original work has not been revised or altered in any substantive way.

¹⁹² *See id.*

¹⁹³ The same reasoning applies to printed works reproduced and stored on microfilm. Interestingly, however, each of the *Tasini* and *Greenberg* tribunals which compared the various defendants’ digital re-publications to microfilm seemed to take for granted that microfilm versions would qualify as revisions within § 201(c) and also in the ordinary sense of the term. *See, e.g.,* N.Y. Times Co. v. *Tasini*, 533 U.S. 483, 501–02 (2001); *Greenberg v. Nat’l Geographic Soc’y*, 244 F.3d 1267, 1273 n.12 (11th Cir. 2001). None of the courts explain, however, the basis for this assumption. At least one other commentator has noted a contradiction in this reasoning. *See Thornburg, supra* note 2, at 245–46 (“It remains puzzling that while converting a year’s subscription to a magazine into microfilm is protected under [§] 201(c), a series of digital reproductions of that same year’s subscription burned onto a CD-ROM falls outside such protection when accompanied by a simple computer program that allows for easy searching.”). In the present author’s view, the characterization of full-image microfilm reproductions as § 201(c) revisions is incorrect. Full-image microfilm reproductions are merely *copies made for archival purposes*, i.e., archive versions or archive copies.

In addition to being an “un-revised” archive version or copy, an exact digital replica can also be disqualified as a § 201(c) revision in accordance with the reasoning of the *Tasini* majority. As construed by the Supreme Court, the § 201(c) revision privilege exists to allow for the revising and updating of a collective work while preserving the commercial market for further publication of the individual contributions therein.¹⁹⁴ However, virtually any revision of a previously published printed collective work, even a traditional updating in print, will arguably have at least *some* impact on the market for the individual contributions therein. Therefore, it seems reasonable to refine the definition of an impermissible market impact under § 201(c) to be that of a negative impact that is significantly greater than that which is likely to result from a traditional updating or revising of the original collective work.

The content-altered digital re-publications in *Tasini* and *Greenberg* were held to virtually extinguish any secondary market for the contributory works contained therein, because once available online, there would be little need for alternative access to the works.¹⁹⁵ An exact digital replica of a collective work, particularly when disbursed into an online commercial database, would likely have the same effect. Accordingly, exact digital replicas can be disqualified from § 201(c) revision status on the same market impact grounds as the content-altered digital re-publications at issue in *Tasini*.¹⁹⁶

¹⁹⁴ See *Tasini*, 533 U.S. at 497 (“Essentially, § 201(c) adjusts a publisher’s copyright in its collective work to accommodate a freelancer’s copyright in her contribution.”).

¹⁹⁵ See *id.*; *Greenberg*, 244 F.3d at 1275. Both courts implicitly held that such subsequent digital markets exist. The basis for this assumption is questioned in Part IV.

¹⁹⁶ Professor Gordon advances still another argument as to why a full-image digital replica does not qualify as a § 201(c) revision:

Even if . . . exact full-format digital reproductions fall within the statutory privilege . . . infringement can still occur because freelancers have not only a reproduction right, but also an exclusive right of distribution. . . . [R]egardless of whether [the digital reproduction] infringes the copyright owner’s right of reproduction, a publisher exceeds his privilege of distribution when he allows individual articles to be downloaded because making an individual article available for download is not distributing it as “part of” the whole.

Gordon, *supra* note 183, at 475 (footnote omitted).

It would seem preferable, however, to disqualify exact digital replicas as privileged revisions on the basis of their characterization as archive versions. As a distinction based on content, it avoids conflict with the doctrine of media neutrality. Indeed, this distinction disqualifies all exact replicas from characterization as revisions on the basis of their *content* regardless of the medium in which they happen to be produced.

E. Treating Content-Altered Digital Re-Publications as Archive Versions

The characterization of digital re-publications as archive versions can also be used to reconcile the concerns of the majority and dissent in *Tasini* with regard to content-altered digital re-publications. While deleting illustrations, photographs, or chapter headings from a work would seem to be more than mere cosmetic changes, depending upon the reason for and nature of such changes, they might be more appropriately regarded as relating to the *archiving* of the work, as opposed to the substantive *revision* of the work.¹⁹⁷

The changes to the content of the collective works in *Tasini* were undertaken in connection with the efficient storage, preservation, and further dissemination of previously published material.¹⁹⁸ Arguably, these changes, whether deleting photographs or column layouts, or combining otherwise exact digital replicas with other independent works on a single disc, are not purposefully substantive, but rather incidental to the efficient

¹⁹⁷ In its verb form, archive means “[t]o place or store in an archive; in *Computing*, to transfer to a store containing infrequently used files, or to a lower level in the hierarchy of memories esp[ecially] from disc to tape.” COMPACT OXFORD ENGLISH DICTIONARY 69 (2d ed. 1991). In its noun form, an archive is “[a] place in which public records or other important historic documents are kept. . . . [or a] historical record or document so preserved.” *Id.* *Merriam-Webster’s* defines an archive as “a place in which public records or historical documents are preserved.” MERRIAM-WEBSTER’S, *supra* note 188, at 61.

¹⁹⁸ Given the nature of electronic media, illustrations and photographs in print-to-digital transfers can arguably defeat many of the objectives in transferring the work into digital format. Whereas text can be economically archived in digital format, photographs and illustrations take up enormous amounts of disc space. Thus, the deletion of such material may not be “purposefully substantive” but rather, essential to efficient electronic archiving. See *Tasini*, 533 U.S. at 512–13 (Stevens, J., dissenting).

digital archiving of printed material.¹⁹⁹ Such changes do not rise to the level of substantive revisions and also fall short of creating entirely new works. Once again it seems more accurate to characterize the digital results as archive versions as opposed to substantive revisions or new collective works. Moreover, just as with exact digital replicas, the characterization of content-altered digital replicas as archive versions permits their disqualification as § 201(c) revisions on the basis of their content, as opposed to on the basis of characteristics unique and inherent to electronic media.²⁰⁰

In sum, *Tasini* and *Greenberg* hold that digital re-publication can effectively result in the “dismantling” of a collective work and thereby constitute independent publications of the contributory works therein, or the production of an entirely new collective work.²⁰¹ As discussed above, however, digital re-publication may be more accurately described as resulting in the production of an archive version or archive copy, depending upon the nature, extent, and reasons for any changes made to the content of the original version of the collective work. If limited changes have been made to the original content *primarily* to take advantage of beneficial attributes inherent to digital media, then the digital result should be regarded as an archive version. If no changes have been made to the content of the original version—that is, an exact digital replica has been produced—the result should also be considered an archive version or an archive copy. Moreover, the characterization of digital re-publications as archive versions will generally lead to the same results as those reached in *Tasini* and *Greenberg* in applying § 201(c), but avoids conflict with the doctrine of media neutrality.²⁰²

¹⁹⁹ *See id.*

²⁰⁰ The NG-CD in *Greenberg* is disqualified as a § 201(c) revision for the same reasons. While some of the changes made to the content of the original version, i.e., collecting all of the back issues of *National Geographic Magazine* onto a single disc, may have been undertaken for archival purposes, other changes, such as the creation and inclusion of the Animation Sequence, went beyond archival necessities. *See Greenberg*, 244 F.3d at 1273. Thus, the NG-CD might be both an archive version and a derivative work, but in any case, more than a mere revision.

²⁰¹ *See Tasini*, 533 U.S. at 487; *Greenberg*, 244 F.3d at 1273.

²⁰² There is, however, at least one situation under § 201(c) in which conflict with the doctrine of media neutrality seems unavoidable, at least with respect to the *Tasini* market

Thus, § 201(c) is of little value in addressing the problem of digital re-publication. As discussed in the next section, however, the fair use doctrine presents a more viable mechanism for balancing the competing interests at issue in connection with the digital use and dissemination of previously published copyrighted works.

IV. DIGITAL RE-PUBLICATION AND THE FAIR USE DOCTRINE

While § 201(c) offers a safe harbor for the unauthorized use of a contributory work as part of a revision of a collective work, the unauthorized use of any copyrighted work—contributory, collective, or singular—may also be defended by resort to the fair use doctrine.²⁰³ The fair use doctrine is an “equitable doctrine [which] permits other people to use copyrighted material without the owner’s consent in a reasonable manner for certain purposes.”²⁰⁴ The fair use doctrine enables the copyright law to

impact rule. Where the collective work is updated in accordance with the express provisions of the statute, such as when an article is added to the evening edition of a daily newspaper, or a 1990 edition updates a 1980 encyclopedia, then under the reasoning of the *Tasini* majority, if the updated version is produced in digital format, its market impact potential precludes its qualification as a § 201(c) revision. Such a digital update could not be characterized as an archive version, however, because there has been an alteration in content for substantive as opposed to archival purposes. Ironically then, the very kind of content (albeit perhaps not medium) change contemplated by Congress in revising § 201(c) becomes impermissible under the holding in *Tasini*. While this result is consistent with the judicial construction of the legislative objective underlying § 201(c), it does discriminate against electronic revisions in favor of print revisions.

²⁰³ See 17 U.S.C. § 107 (2002); see also *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 549 (“Fair use was traditionally defined as ‘a privilege in others than the owner of the copyright to use the copyrighted material in a reasonable manner without his consent.’ . . . The statutory formulation of the defense of fair use in the Copyright Act reflects the intent of Congress to codify the common law doctrine.” (citations omitted)); Leval, *supra* note 106, at 1105 (“Not long after the creation of the copyright law by the Statute of Anne of 1709, courts recognized that certain instances of unauthorized reproduction of copyrighted material, first described as ‘fair abridgment,’ later ‘fair use,’ would not infringe the author’s rights. In the United States, the doctrine was received and eventually incorporated into the Copyright Act of 1976 . . .”). An example of a fair use of copyrighted material is a limited educational use, such as copying and distributing a newspaper article for use as part of a classroom discussion.

²⁰⁴ *Rogers v. Koons*, 960 F.2d 301, 308 (1992); see also *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 574–77 (1994); *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 448–51 (1984); *Sega Enters. v. Accolade, Inc.*, 977 F.2d 1510, 1522 (9th

account for those situations in which the social utilities to be achieved in permitting a specific use of copyrighted material warrant a limited impingement upon the copyright holder's exclusive property rights.²⁰⁵ The fair use doctrine is one of the principal means by which the underlying policy objectives of the copyright law are attained, including the broadest dissemination of creative works toward the greater public good.²⁰⁶

As it would be unworkable to predetermine a list of all circumstances in which the equitable social utilities outweigh the copyright holder's interest in denying or restricting the use of his or her work, courts instead weigh four factors in evaluating whether an unauthorized use should be permitted as a fair use.²⁰⁷

Cir. 1992); *SunTrust Bank v. Houghton Mifflin Co.*, 268 F.3d 1257, 1264 (11th Cir. 2001); Koenigsberg, *supra* note 112, at 147–48; NIMMER & NIMMER, *supra* note 53, § 13.05; Leval, *supra* note 106, at 1127 (“Fair use was a judge-made utilitarian limit on a statutory right. It balances the social benefit of a transformative secondary use against injury to the incentives of authorship.”).

²⁰⁵ See GOLDSTEIN, *supra* note 106, § 10.2.1 (“At the highest level of generalization, [fair] uses characteristically involve situations in which the social, political and cultural benefits of the use will outweigh any consequent losses to the copyright proprietor, and in which the time and expense of negotiations—or, in [certain cases], the unwillingness of the copyright owner to permit these uses at an acceptable price—will often foreclose a negotiated transaction.”); NIMMER & NIMMER, *supra* note 53, § 13.05[A][1].

²⁰⁶ See Samuelson, *supra* note 146, at 51 (“Fair use has historically served as a flexible and adaptable mechanism for balancing the interests of copyright owners, their competitors or potential competitors, and the public to fulfill the larger purposes of copyright law which have traditionally been understood to be promoting the production and dissemination of knowledge.”).

²⁰⁷ NIMMER & NIMMER, *supra* note 52, § 13.05[A] (“Strictly speaking, Section 107 does not attempt to define ‘fair use.’ Rather, it lists ‘the factors to be considered’ for the purpose of ‘determining whether the use made of a work in any particular case is a fair use.’ It does not, and does not purport to, provide a rule that may automatically be applied in deciding whether any particular use is ‘fair.’” (footnote omitted)); Anderson & Brown, *supra* note 111, at 145–46, 159 (“Congress codified the copyright and fair use case law in the Copyright Act of 1976. Section 107 of the Act governs fair use. The preamble to [§] 107 lists several examples of what might be successful assertions of the fair use defense. Drawing on prior case law, Congress enumerated four factors for determining whether a use qualifies as a fair use. . . . In [these] limited circumstances, fair use permits someone other than the author to [use] a copyrighted work without the author’s permission.”); *Harper & Row*, 471 U.S. at 588 (Brennan, J., dissenting) (“[The] endless variety of situations and combinations of circumstances that can arise in particular cases precludes the formulation of exact rules in the statute’[.]. The statutory factors do, however, provide substantial guidance to courts undertaking the proper fact-

These factors are (1) the purpose and the character of the use, such as whether it is primarily commercial in nature or if it is a transformative use—that is, a use that substantively enhances or builds upon the copyrighted work; (2) the nature of the copyrighted work involved—that is, whether it is primarily a creative work such as a fiction novel or a factual work such as a biography; (3) the amount and substantiality of the work to be used without the author's permission; and (4) the effect that allowing the unauthorized use is likely to have upon the market for the copyrighted work.²⁰⁸ Properly applied, the four fair use factors assist courts in insuring that the author's incentive mechanism of commercial gain through licensing exclusive rights does not override or impede the copyright law's primary goal of "increasing society's stock of knowledge."²⁰⁹

A. Fair Use in *Tasini* and *Greenberg*

Considering the four fair use factors, pursuit of the § 201(c) revision privilege might well seem the more viable defense strategy to publishers in the position of the *Tasini* defendants. The *Tasini* publishers were using the contributory works for commercial gain, and the nature of digital re-publication required

specific inquiry." (second citation omitted) (quoting H.R. REP. NO. 94-1476, at 66 (1976)).

²⁰⁸ See 17 U.S.C. § 107 (2003); see also *Campbell*, 510 U.S. at 579; *Harper & Row*, 471 U.S. at 560 ("The factors enumerated in the [statute] are not meant to be exclusive . . . and each case raising the question must be decided on its own facts." (citation omitted)); *Los Angeles Times v. Free Republic*, 2000 U.S. Dist. LEXIS 5669 (C.D. Cal. 2000); *Religious Tech. Ctr. v. F.A.C.T. Net, Inc.*, 901 F. Supp. 1519, 1525 (D. Colo. 1995); GOLDSTEIN, *supra* note 104, § 10.2 ("[S]ince passage of the 1976 Act, courts typically and systematically apply all four factors. Some courts apply additional factors."); Edwards, *supra* note 159, at 847-48 ("The § 107 fair use factors find their roots in Justice Story's now famous opinion in *Folsom v. March*, which courts frequently cite as the first American case to recognize the doctrine. . . . [N]early one hundred thirty-five years after the *Folsom* decision, in 1976, Congress adopted the § 107 fair use factors employed by courts today, using *Folsom* as its guide." (footnotes omitted)).

²⁰⁹ Hughes, *supra* note 109, at 295; see also NIMMER & NIMMER, *supra* note 53, at 13.05[A] ("[T]he factors contained in Section 107 are merely by way of example, and are not exhaustive enumeration. This means that factors other than those enumerated may prove to have a bearing upon the determination of fair use."). For cases involving the application of the fair use doctrine to unauthorized electronic use of copyrighted works, including unauthorized dissemination on the Internet, see *Mtima*, *supra* note 33, at 317-21.

that the works be used in their entirety. Even the fact that many of the copyrighted contributions were journalistic accounts of public events would be of only limited benefit to the publishers, as the courts have held that such works are not *ipso facto* vulnerable to fair use.²¹⁰ Finally, while the question of market impact is a textured one,²¹¹ in light of the findings of the district court and the Second Circuit with respect to that issue,²¹² it would seem prudent to abandon fair use in favor of a § 201(c) defensive strategy.²¹³

On the other hand, in *Greenberg*, National Geographic did pursue a fair use defense in the trial court and before the Eleventh Circuit.²¹⁴ Although the Eleventh Circuit did not employ a point-by-point analysis of the four fair use factors, its ultimate rejection of National Geographic's fair use defense is consistent with traditional fair use analysis.²¹⁵

With respect to the first fair use factor, there was no dispute that National Geographic's use of Greenberg's photograph was for commercial profit.²¹⁶ Moreover, the photograph was not merely reproduced in the challenged electronic publication, but was actually morphed into a part of the Animation Sequence, a use the court easily concluded resulted in the unauthorized creation of a derivative work:

²¹⁰ See, e.g., *Harper & Row*, 471 U.S. at 555–58.

²¹¹ As discussed in Part IV.C, defining the “digital re-publication market” for contributions to collective works may not be as straightforward a task as it might first appear.

²¹² Notwithstanding the fact that the district court ruled that Congress had not envisioned the development of digital re-publication markets on behalf of contributory authors, both courts found that the publishers' activities were likely to have a detrimental impact on such secondary commercial exploitation opportunities. See *Tasini v. N.Y. Times Co.*, 972 F. Supp. 804, 826–27 (S.D.N.Y. 1997), *rev'd and remanded*, 206 F.3d 161 (2d Cir. 1999), *aff'd*, 533 U.S. 483 (2001); cf. *Tasini v. N.Y. Times Co.*, 206 F.3d 161, 170 (2d Cir. 1999) (“Time subsequently licensed Whitford's article to Mead without notifying, obtaining authorization from, or compensating, him.”), *aff'd*, 533 U.S. 483 (2001).

²¹³ As discussed in Part IV.C, however, the *Tasini* defendants may have abandoned the fair use defense prematurely.

²¹⁴ See *Greenberg v. Nat'l Geographic Soc'y*, 244 F.3d 1267, 1274 (11th Cir. 2001).

²¹⁵ See *id.* at 1274–75.

²¹⁶ See *id.* at 1275.

The Society has selected ten preexisting works, photographs included in covers of ten issues of the Magazine . . . and transformed them into a moving visual sequence that morphs one into the other over a span of approximately 25 seconds. . . . The use of [Greenberg's] photograph far transcended a mere reprinting or borrowing of the work. . . . [I]t became an integral part of a larger, new collective work. . . . The [Animation] Sequence also integrates the visual presentation with an audio presentation consisting of copyrightable music. The resultant moving and morphing visual creation transcends a use that is fair within the context of § 107.²¹⁷

Regarding the second and third fair use factors, the photograph was an artistic creative work, and the work was used in its entirety.²¹⁸ Each of these attributes generally militates against allowing the challenged use as a fair use.²¹⁹

Finally, with respect to the fourth fair use factor, the court concluded that National Geographic's use would have a negative impact on the subsequent commercial market for Greenberg's photograph.²²⁰ Although the court did not cite to any specific facts, it expressly held that "the inclusion of Greenberg's diver photograph in the [Animation] Sequence has effectively

²¹⁷ *Id.* at 1274–75. The creation of a derivative work is a separate exclusive right. *See* 17 U.S.C. § 106 (2003).

²¹⁸ *Cf. id.* at 1269 ("One of the cover images used in the moving covers sequence is a picture of a diver that was taken by Greenberg in 1961.").

²¹⁹ *See* *Bond v. Blum*, 317 F.3d 385, 395 (4th Cir. 2003) ("We next consider the second factor, 'the nature of the copyrighted work.' This factor focuses attention on the extent to which a work falls at the core of creative expression. Thus, for example, a fictional work might be closer to the core of copyright than a factual work." (citations omitted)); *Sega Enters. v. Accolade, Inc.*, 977 F.2d 1510, 1527 (9th Cir. 1992); *SunTrust Bank v. Houghton Mifflin Co.*, 268 F.3d 1257, 1271 (11th Cir. 2001) ("The second factor, the nature of the copyrighted work, recognizes that there is a hierarchy of copyright protection in which original, creative works are afforded greater protection than derivative works or factual compilations."); *Arista Records, Inc. v. MP3Board, Inc.*, 2002 U.S. Dist. LEXIS 16165, *39 (S.D.N.Y. 2002) ("Regarding the second factor, 'the nature of the copyrighted work,' the published creative sound recordings copied are 'close to the core of intended copyright protection,' and, conversely, far removed from the more factual or descriptive type of work that is more amenable to fair use."); *Los Angeles Times v. Free Republic*, 2000 U.S. Dist. LEXIS 5669, *54–*60 (C.D. Cal. 2000).

²²⁰ *See Greenberg*, 244 F.3d at 1275.

diminished, if not extinguished, any opportunity Greenberg might have had to license the photograph to other potential users.”²²¹ Consequently, consistent with the four fair use factors, the court ruled that National Geographic’s use did not qualify as a fair use.²²²

B. Reevaluating Digital Re-Publication Market Impact as a Question of Fair Use

In reviewing the *Tasini* and *Greenberg* decisions, it is difficult to extract a rule for applying the four fair use factors to unauthorized digital re-publication, especially with respect to the market impact factor. As discussed above, the *Greenberg* fair use analysis was somewhat limited, particularly in its market impact assessment.²²³ While the Supreme Court’s market impact analysis in *Tasini* is much more detailed, that analysis was undertaken within the context of § 201(c).²²⁴ Accordingly, the nature and extent of negative market impact resulting from an unauthorized digital re-publication that might be allowable as a fair use is unclear.

Initially, it might seem feasible to utilize the finding of impermissible market impact by the Supreme Court in *Tasini* to buttress the *Greenberg* fair use/market impact analysis. The flaw in such an approach, however, is that it fails to distinguish between the role of market impact analysis under § 201(c) and its purpose in applying the fair use doctrine. Given the differing policy objectives that underlie the revision privilege and the fair use doctrine, there may be a level of market impact resulting from an unauthorized use that is unacceptable under § 201, but nonetheless allowable under § 107.²²⁵

²²¹ *Id.* at 1275. Thus the court seems to presume both the likelihood of further demand for the photograph, as well as a devastating impact on such demand.

²²² *See id.* at 1274–75.

²²³ *See id.* at 1275.

²²⁴ *See* N.Y. Times Co. v. *Tasini*, 533 U.S. 483, 496–97 (2001).

²²⁵ Thus the commentators that have interpreted *Tasini* to foreclose the fair use defense in digital re-publication cases may be premature in their concern. *See, e.g.,* Snyder, *supra* note 67, at 365–66 (“While authors and publishers squared off in [*Tasini*], the public sat on the sidelines. The protection of public access went out the window in *Tasini* with serious consequences. Librarians, researchers and archivists were forced to remove

As construed by the courts in *Tasini* and *Greenberg*, the proper application of § 201(c) balances the right of a contributing author to receive a commercial return for his or her creative endeavors against the interest of the publisher who arranged the collective work in undertaking—and coincidentally profiting from—appropriate revisions of that work.²²⁶ Congress has determined that the publisher's interest in revising a collective work justifies a limited impingement upon the contributing author's pecuniary rights.²²⁷ The *Tasini* and *Greenberg* courts have clarified, however, that the § 201(c) incursion upon the contributing author's exclusive rights is not available for all revisions, but is limited to those revisions that, *inter alia*, do not unduly burden the secondary market for contributory works.²²⁸ This delineation is necessary to

thousands of newspaper and magazine freelance articles from public access after the decisions by the Second Circuit and the United States Supreme Court. . . . By taking the side of authors, the Supreme Court rejected the policy of distribution efficiency and reached a narrow decision that ignored the broad harms to the authors, publishers and public." (footnotes omitted)). Of course, the possibility of differing outcomes under § 201(c) and § 107 does not turn solely upon the issue of market impact. An unauthorized re-publication of a collective work which involves changes beyond those permitted by § 201(c) might also fail to satisfy the first three fair use factors, even though the re-publication may have little or no impact on the secondary market for the contributory works therein.

²²⁶ There is also a public interest in having collective works properly updated, which provides the impetus for granting publishers the revision privilege. *See, e.g.*, John D. Shuff & Geoffrey T. Holtz, *Copyright Tensions in a Digital Age*, 34 AKRON L. REV. 555, 556–57 (2001) ("The publisher's interests are in some ways aligned with and in other ways adverse to, both the author's and the public's. Like the author, the publisher seeks to profit from the sale of the copyrighted works, and thus seeks to limit the means by which the public may consume these works without paying a price. However, like the public, the publisher does not want the author's rights to be so broad that the publisher's ability to reproduce and distribute copyrighted works—and therefore its profiteering capability—is hindered. In a legal dispute, a publisher . . . will thus note the constitutional rationalization of the profit motive, but if the author's and the publisher's interests collide, the latter will likely throw in a 'value-added' theory of economic analysis that emphasizes dissemination over creation of works and justifies occasionally stepping on the author's toes in the name of efficient distribution of the fruits of 'Science and Useful Arts.'").

²²⁷ *See* 17 U.S.C. § 201(c) (2002).

²²⁸ *See Tasini*, 533 U.S. at 497; *Greenberg*, 244 F.3d at 1272–73, 1275. Thus, the Supreme Court has construed that Congress intended to balance the public interest in updated collective works against the copyright holder's pecuniary interests by limiting the revision privilege to revisions that do not devastate the copyright holder's secondary market opportunities.

insure that the publisher's privilege to revise and update a collective work is not transmogrified into a usurpation of all post-publication exploitation opportunities for contributory works.²²⁹

In evaluating fair use claim, however, the interests of the unauthorized revising publisher, particularly those of individual commercial gain, are all but eliminated from the balancing equation—if not weighed *against* allowing the use.²³⁰ Instead, the salient interests at stake are those of the public with respect to the social utility of creative works versus the compensation expectations of the author.²³¹ Given the primacy of the public interest, however,²³² it is conceivable that the interjection of that interest could tip the balance in favor of permitting a detrimental impact upon the copyright holder's commercial interests, notwithstanding the fact that such detrimental impact would be considered unacceptable in applying § 201(c).²³³

²²⁹ See *Tasini*, 533 U.S. at 497.

²³⁰ See *Rogers v. Koons*, 960 F.2d 301, 309 (2d Cir. 1992) (“Knowing exploitation of a copyrighted work for personal gain militates against a finding of fair use.”).

²³¹ See *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 429 (1984) (“[T]he limited grant [of exclusive rights to authors] is a means by which an important public purpose may be achieved. It is intended to motivate the creative activity of authors and inventors by the provision of a special reward, and to allow the public access to the products of their genius after the limited period of exclusive control has expired.”); Samuelson, *supra* note 146, at 56–57 (“Courts have often relied upon fair use to resolve disputes when recognition of broad rights in publishers or authors would have frustrated achievement of the societal purposes of copyright law. In the American tradition, the ultimate purpose of copyright is not the maximization of financial rewards to copyright owners . . . but fostering the creation and dissemination of literary and artistic works in order to enhance the public's access to knowledge. The grant of exclusive rights to authors enabling them to reap a portion of the value derived from their creative contributions is a means to this larger end.” (footnotes omitted)).

²³² See Appel, *supra* note 119, at 174–75 (“The ultimate purpose of American copyright law is plainly stated in the Constitution. The law exists ‘to promote the progress of science and the useful arts’ or, in plain, contemporary English, to promote the advancement of society at large. While the same clause . . . also grants to authors of creative works the right to enjoy the financial fruits of their labors, the plain language of the clause evidences that this grant of monopoly is subservient to the primary goal of promoting the progress of society as a whole. The Patent and Copyright Clause thus reflects a tension between the right of the public to have access to creative works and the right of authors of creative works to benefit financially from their efforts. The plain language of the clause, however, resolves this tension in favor of the public.”).

²³³ See *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 580 (1985) (Brennan, J., dissenting) (“The challenge of copyright is to strike the ‘difficult balance

C. Revisiting Application of the Fair Use Factors to Tasini

In light of the foregoing, it is possible that some of the unauthorized digital re-publications in *Tasini* might be permitted under the fair use doctrine, notwithstanding their disqualification as privileged revisions under § 201(c).²³⁴ Under the first factor, notwithstanding the publishers' commercial objectives, there is also a compelling public interest in digital archiving and dissemination that could outweigh the contributing copyright holder's ancillary commercial interests.²³⁵ Despite the importance

between the interests of authors and inventors in the control and exploitation of their writings and discoveries on the one hand, and society's competing interest in the free flow of ideas, information, and commerce on the other hand." (quoting *Sony*, 464 U.S. at 429); *SunTrust Bank v. Houghton Mifflin Co.*, 268 F.3d 1257, 1261 (11th Cir. 2001) ("The Copyright Clause was intended 'to be the engine of free expression.' . . . To that end, copyright laws have been enacted to achieve the three main goals: the promotion of learning, the protection of the public domain, and the granting of an exclusive right to the author." (quoting *Harper & Row*, 471 U.S. at 558); see also Francesco Parisi & Catherine Sevchenko, *Lessons from the Anticommons: The Economics of New York Times Co. v. Tasini*, 90 Ky. L.J. 295, 309 (2001/2002) ("Copyright is essentially an attempt to capture the benefit that the public derives from a creative literary work . . . and to return that benefit to the author as a way to maintain an incentive for people to make cultural contributions. It is not designed to guarantee the highest remuneration to authors, but is rather a mechanism for balancing between the need for broad public availability of art, literature, and music and finding a way to create incentives for people to produce those goods." (footnotes omitted)).

²³⁴ Leval, *supra* note 106, at 1125 ("Not every type of market impairment opposes fair use.").

²³⁵ Ho, *supra* note 152, at 1573 ("The legal nuances attendant to fair uses in teaching and research are far more complex. Court precedents have banished simplistic assumptions, such as the mythic fair use assumption that all commercial use is impermissible."); *Koons*, 960 F.2d at 309 ("The first factor . . . asks whether the [work was used] in good faith to benefit the public or primarily for the commercial interests of the infringer."); *Los Angeles Times v. Free Republic*, 2000 U.S. Dist. LEXIS 5669, *41 (C.D. Cal. 2000) ("In addition to examining defendants' purpose in copying plaintiffs' articles, the first fair use factor also directs that the court evaluate the 'character' of the use. The mere fact that a use is commercial does not 'give rise to a presumption of unfairness.' Rather, a defendant's commercial purpose is only 'a separate factor that tends to weigh against a finding of fair use.'" (citations omitted)); see also Rose, *supra* note 119, at 110–11 ("Copyright law can reward authors with certain exclusive rights to information placed on the Internet, but cannot enforce these rights to the exclusion of equal access. The Web facilitates global communication. Global communication in turn enhances global knowledge. Having a broad base of technological expertise strengthens the United States both socially and economically. Thus, to remain true to the Constitution, intellectual property law must harmonize itself with the moral obligation of public schools and libraries to provide uniform access to digital information."); Parisi &

of the author's remunerative rights, ensuring digital dissemination of previously published printed works provides a vital public benefit.²³⁶

Sevcenko, *supra* note 233, at 295 ("The [Tasini] case . . . attracted media attention . . . because it appeared to pit the rights of authors to protect their creative works against the nation's need to preserve its historical record."); *see generally* Carla D. Pratt, *Should Klansmen Be Lawyers? Racism as an Ethical Barrier to the Legal Profession*, 30 FLA. ST. U. L. REV. 857, 874 (2003) ("Communitarianism is perhaps the most rational mechanism for reconciling the competing interests of civil liberties and civil rights. Communitarians believe that, in a rights-based society, rights have limits as well as concomitant responsibilities. Underlying the theory of communitarianism is the idea that, as members of a community, we are morally obligated to undertake certain responsibilities, and that these responsibilities may exist without an imminent payback in the form of rights. In other words, communitarianists recognize that individual rights cannot be absolute, but must be tempered by that which is in the best interest of the community." (footnotes omitted)).

²³⁶ *See* Joanne Benoit Nakos, *An Analysis of the Effect of New Technology on the Rights Conveyed by Copyright License Agreements*, 25 CUMB. L. REV. 433, 459–60 (1995) ("Exploitation of old works through new technology has the potential for such profitability that media industries are not likely to find the possible threat of infringement litigation a deterrent. Pursuant to the goals of copyright policy, such industries should be facilitated in their legitimately licensed use of classic works [However, i]t is extremely difficult for organizations with the ability to exploit classic works through the 'information superhighway' to search out outstanding copyright licenses, especially considering the number of works that may constitute components of the final transmission. In addition, these organization must secure their own license for this new use, the rights to which were, in all likelihood, not contemplated by any preexisting license."); Snyder, *supra* note 67, at 377 ("Opponents have said publishers should not receive the windfall from these new income sources. However, this income is just as much of a windfall for the writer who fifteen years ago could have had no real expectation that his article would produce income from an internet or CD-ROM database. When income is not earned or reasonably expected by an author, the windfall should be given to publishers or distributors to encourage greater availability of works to the public." (footnotes omitted)); Colby B. Springer, *Ownership of Electronic Publishing Rights in Collective Works: New York Times Co. v. Tasini*, 18 SANTA CLARA COMPUTER & HIGH TECH. L.J. 341, 341 (2002) ("[The *Tasini* decision] represents a potentially colossal financial windfall for freelance authors, while throwing a time consuming and costly wrench into the gears of the multi-million dollar business that is on-line periodical storage and retrieval."). These considerations also render unauthorized digital re-publication closer in nature to the unauthorized uses at issue in *Sony*, 464 U.S. at 423, and *Recording Industry Association of America v. Diamond Multimedia System Inc.*, 180 F.3d 1072, 1073–75 (9th Cir. 1999) (upholding denial of preliminary injunctions against a company that produced portable music players that could play music downloaded from the internet), than to the unauthorized uses in *A&M Records, Inc. v. Napster, Inc.*, 239 F.3d 1004, 1011 (9th Cir. 2001) and *UMG Recordings, Inc. v. MP3.com, Inc.*, 92 F. Supp. 2d 349, 350 (S.D.N.Y. 2000). In *Tasini*, *Sony*, and *Diamond*, the primary purpose and benefit of each unauthorized use is arguably that of space-shifting and/or archiving,

If NEXIS or some similar online database has become the predominant digital archive for previously published material, the public interest in complete digital libraries, when weighed against the transaction costs in locating and negotiating with every contributing author, seems to tip the balance in favor of allowing digital re-publication as a fair use.²³⁷ Accepting the alternative—conceding absolute dominion over digital re-publication to individual freelance authors—could impede the ultimate objectives of the copyright law.²³⁸

whereas the primary purpose of the unauthorized uses in *Napster* and *MP3.com* is that of distribution, with a concomitant impact upon the commercial market for the copyrighted works. See, e.g., *Napster*, 239 F.3d at 1019. Although digital re-publication also has distribution characteristics, as discussed below, the absence of a genuine electronic publication market for individual contributory works, combined with the public benefit derived from digital re-publication, distinguishes digital re-publication from unauthorized peer-to-peer online music distribution for the purpose of assessing fair use.

²³⁷ See Garon, *supra* note 121, at 1350–51 (“The Internet will replace the paper file and the fax as the document repository and transfer mechanism. Offices will not be paperless, but most official files will be stored in digital archives.”); Thornburg, *supra* note 2, at 247 (“Publishers argue that their development of new electronic formats serves the public good in providing access through the Internet as well as other formats, like CD-ROMs and databases. Creating a variety of both traditional and electronic formats . . . allows greater access and ability to search for information, which directly aids academics, researchers, and students. Furthermore, unlike traditional formats that are bulky, the development of alternative electronic media has allowed for the ease of storage and greater ability to retrieve such information. Both computer databases and CD-ROMs serve the same public function as regular print periodicals, as these are all sources of information selected and arranged to form valuable compilations by publishers.” (footnotes omitted)). The problem of locating freelance authors, however, could stymie this technological evolution. See *N.Y. Times Co. v. Tasini*, 533 U.S. 483, 519 (Stevens, J., dissenting) (“[T]he difficulties of locating individual freelance authors and the potential of exposure to statutory damages may well have the effect of forcing electronic archives to purge freelance pieces from their databases. ‘The omission of these materials from electronic collections . . . undermines the principal benefits that electronic archives offer historians – efficiency, accuracy and comprehensiveness.’” (footnote and citation omitted)); Parisi & Sevcenko, *supra* note 233, at 297, 300 (“[The *Tasini* case] is, from the law and economic perspective, a classic anticommons situation in which asymmetric transaction costs are complicating the implementation of the easiest solution: some form of retroactive compensation to the authors for use of their work. . . . [T]he core of the problem is that the *New York Times* does not have an easy way to track down the freelancers who contributed to the paper over the last ten to fifteen years and renegotiate the terms of the article with each of them.”).

²³⁸ See Raymond T. Nimmer, *Licensing in the Contemporary Information Economy*, 8 WASH. U. J.L. & POL’Y 99, 145 (2002) (hereinafter Nimmer, *Licensing*) (“A person who controls information may elect not to distribute the information Unless mandatory

With regard to the second fair use factor, because the contributory works in *Tasini* were primarily journalistic accounts of factual events, the balance tends to weigh in favor of allowing the use.²³⁹ Further, given the nature and purpose of digital republication, it is necessary that the entire work be used, and hence the third factor is not afforded the same weight as in cases in which the relevant social utilities can be achieved by allowing only a partial use of the work.²⁴⁰

Finally, in so far as the fourth fair use factor is concerned, notwithstanding the findings in *Tasini* and *Greenberg*, the

disclosure laws govern, the law protects that decision.”); Jaszi, *supra* note 130, at 300 (“Copyright is changing or is in the process of changing. . . . [A]s things stand now, the network environment is at risk of being swept up in a general restructuring of American copyright law which has been taking place, . . . over the past few years. This process, to begin with, had little if anything to do with new information technology, but it now threatens to prevent that technology from achieving its full cultural and economic potential.”); Parisi & Sevchenko, *supra* note 233, at 310–11 (“In an anticommons situation, multiple owners have veto powers over the use of a resource, thereby increasing the chances that it will not be used. Competition among the owners prompts exercise of exclusion rights, even if one party could use the resource to create social benefits. . . . The anticommons application in *Tasini* is clear: each of the authors now retains control over the copyright to the work that was published in the *New York Times*. The paper is currently either unwilling, or unable, to negotiate with each one of these writers for the rights, so that the information they have provided will no longer be readily available in electronic format. An important resource, therefore, will be underutilized, given the growing reliance that people are placing on immediate electronic access to information.” (footnotes omitted)); *see also* Springer, *supra* note 236, at 351–52 (“[T]he Supreme Court’s decision in [*Tasini*] may very well punch holes in the fabric of history, as electronic databases are the apparent future of our literary archives. Not only do these databases provide a streamlined approach to research, and an easily accessible medium in which authors may promote their works, electronic databases also provide a safe and economical means by which to archive literary works. Electronic databases, while unlikely to replace print libraries altogether, are quickly becoming more comprehensive than their paper-bound brethren. The *Tasini* decision may only curtail this progress.”).

²³⁹ *See Koons*, 960 F.2d at 310 (“Where the original work is factual rather than fictional the scope of fair use is broader.”); *Basic Books, Inc. v. Kinko’s Graphics Corp.*, 758 F. Supp. 1522, 1533 (S.D.N.Y. 1991); *see also* Anderson & Brown, *supra* note 111, at 168–69; Edwards, *supra* note 159, at 849; Peter Jaszi, *Toward a Theory of Copyright: The Metamorphoses of “Authorship”*, 1991 DUKE L.J. 455, 501 (1991) [hereinafter Jaszi, *Toward a Theory of Copyright*] (“[I]n light of the Romantic ‘authorship’ construct, with its implicit recognition of a hierarchy of artistic productions . . . art contains greater value if it results from true imagination rather than mere application, particularly if its creator draws inspiration directly from nature.”).

²⁴⁰ *See, e.g.,* *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 586–89 (1994); *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 449–50 (1984).

existence or extent of stand-alone digital re-publication markets²⁴¹ for individual contributory works remains debatable. Prior to the development and proliferation of digital information technology, the market for re-publication of contributory works was limited,²⁴² with the possible exception of the demand for works of famous authors and freelance writers. The advent of digital information technology, however, does not create any actual new demand for individual contributory works. As Justice Stevens argued in his dissent in *Tasini*, the advent of digital databases has created a new market for the digital re-publication of *complete archives* of well-known periodical publications and similar collective works:

[E]ven if one accepts the . . . characterization of the Electronic Databases as collections of freestanding articles, demand for databases like NEXIS probably does not reflect a “demand for a freelance article standing alone[.]”

Instead, it seems far more likely that the demand for the Electronic Databases reflects demand for a product that will provide a user with the means to quickly search through scores of complete periodicals. . . .

Users . . . do not go to NEXIS because it contains a score of individual articles by Jonathan Tasini. Rather, they go to NEXIS because it contains a comprehensive and easily searchable collection of (intact) periodicals. (“The efficiency, accuracy, reliability, comprehensiveness and immediacy of access offered by searchable full-text digital archives are but a few of the benefits historians and other researchers have reaped from the advancement in the technology of information”).²⁴³

²⁴¹ See *Tasini*, 533 U.S. at 497 (“If there is a demand for a freelance article standing alone or in a new collection, the Copyright Act allows the freelancer to benefit from that demand . . . (‘when an author produces a work which later commands a higher price in the market than the original bargain provided, the copyright statute . . . is designed to provide the author the power to negotiate for the realized value of the work’)” (citations omitted)).

²⁴² See Shuff & Holtz, *supra* note 226, at 559.

²⁴³ *Tasini*, 533 U.S. at 522–24 (Stevens, J., dissenting); see also Parisi & Sevchenko, *supra* note 233, at 311–12 (“A database’s worth . . . lies in the fact that it is comprehensive. Writers would know this and therefore demand premium licensing

It is likely that few if any of the contributory articles in many popular collective works have any digital re-publication market beyond their role in making a digital archive complete.²⁴⁴ A reasonable argument can be made that in the case of an online database such as NEXIS, the objective is not to re-publish the individual articles found within collective works, but rather, to compile digital archives of collective works that are complete, without regard to whatever specific contributory articles the digitized collective works might happen to contain.²⁴⁵

If there is no genuine stand-alone market for digital re-publication of certain contributory articles, then the fourth fair use factor weighs in favor of allowing digital re-publication of those articles as part of the collective works in which they appear, lest the public interest in digital archives be denied to preserve an illusory interest on the part of freelance copyright holders.

Under [the fourth factor] a balance must be struck between the benefit gained by the copyright owner when the [use] is found [to be] an unfair use and the benefit gained by the

compensation, knowing that electronic database services . . . would have to comply in order to maintain their market value.”).

²⁴⁴ Indeed, disallowing digital re-publication/archiving seems more likely to deprive the public of electronic access to freelance contributory works than it is to force the issue of royalties for freelance writers. *See, e.g., Snyder, supra* note 67, at 378 (“After *Tasini*, authors will possess less bargaining power. Publishers will be cautious of buying stories in which they have only limited rights since new technology for information distribution constantly develops. Publishers will likely ask for a prospective author to sign all of his rights away, leaving him with the same amount of rights enjoyed in the early part of the last century: none.”); Andrew Albanese, *Despite Discord, Aggregators Remain Upbeat After Tasini*, *LIBR. J.*, Aug. 1, 2001, at 14 (“The Times’s action creates the blacklist of the Internet age,” [Jonathan] Tasini said. “. . . No one who tries to enforce the Supreme Court’s decision will be able to write for the Times ever again. That’s a blacklist.”); Reed, *supra* note 56, at 1089–90 (“Publishers . . . see [*Tasini*] as creating a lose-lose scenario for all parties. In order to stop the infringement, the publishers are removing those writers’ articles from the electronic databases, thereby taking those writers’ works out of the public eye and also weakening the integrity of those databases as complete records. The alternative is to go back through twenty years of articles, identify all of the freelancer articles, contact the writers and have them all sign copyright transfers, a task that many see as simply impossible to complete in any thorough fashion.”).

²⁴⁵ Thus, an electronic archive of “random freelance articles previously published in *The New York Times*,” or for that matter, “all staff-written articles previously published in *The New York Times*” is of limited value. The value of any database stems from the fact that it is comprehensive and complete, whatever its specific content.

public when the use is held to be fair. The less adverse impact on the owner, the less public benefit need be shown to sustain non-commercial fair use. It is plain that where a use has no demonstrable impact on a copyright owner[‘s] potential market, the use need not be prohibited to protect the artist’s incentive to pursue his inventive skills.²⁴⁶

As an equitable doctrine, fair use has yet to be definitively explored in the digital information context.²⁴⁷ Given the important public interest at stake and the significance of market impact as a fair use factor,²⁴⁸ genuine market impact in connection with unauthorized digital re-publication should be concretely established. Regardless of whether dispersing contributory works into a digital database results in their individual re-publication and distribution or merely a digital archive version of the original collective work, there in fact may be little or no digital market for the contributory works on a stand-alone basis, and therefore no

²⁴⁶ *Rogers v. Koons*, 960 F.2d 301, 311–12 (2d Cir. 1992); *see also* *Greenberg v. Nat’l Geographic Soc’y*, 244 F.3d 1267, 1272 (stating that the absence of any genuine stand-alone secondary digital market may also militate against finding in favor of contributory authors under § 201. However, given the nature of the competing interests at issue under § 201—i.e., publisher versus Author—any doubts as to the extent of such stand-alone markets should be resolved in favor of the copyright holders. “[T]he [copyright] statute’s language contrasts the contributor’s ‘copyright’ and ‘any rights under it’ with the publisher’s ‘privilege.’ This is an important distinction that militates in favor of narrowly construing the publisher’s privilege when balancing it against the constitutionally-secured rights of the author/contributor.”).

²⁴⁷ *See generally* *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 560 (1985) (“[Since] the doctrine is an equitable rule of reason, no generally applicable definition is possible, and each case raising the question [of fair use] must be decided on its own facts.” (citation omitted)); *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 449–50 (1984) (“[S]ection [107] identifies various factors that enable a court to apply an ‘equitable rule of reason’ analysis to particular claims of infringement.”); Samuelson, *supra* note 146. As discussed above, a key policy issue is determining the most propitious application for the revenues derived from digital re-publication. Arguably if such revenues are directed toward the publishers, it will likely insure digital re-publication, in that publishers have control over and access to the entire content of the original collective works. If the revenue is directed to the contributing authors, it may enhance authors’ exclusive rights and further support the objectives underlying § 201, but it may not prove an effective means by which to assure digital archiving, given the transaction costs in locating and obtaining permission from each author.

²⁴⁸ *See* 17 U.S.C. § 107 (2002).

genuine issue of negative market impact for purposes of fair use. Thus, notwithstanding the decision in *Greenberg*²⁴⁹ or the findings in *Tasini*, fair use remains a viable defense for many unauthorized, collective-work digital re-publications.²⁵⁰

V. DIGITAL RE-PUBLICATION, PUBLISHING TRADE PRACTICES, AND THE COPYRIGHT ACT

In Parts III and IV, the legitimacy of unauthorized digital re-publication was analyzed in the context of copyright infringement

²⁴⁹ See *Greenberg*, 244 F.3d 1267. The situation in *Greenberg* remains distinguishable. Whatever the public interest in the digital production of the National Geographic Replica (arguably an archive version), there does not appear to be any compelling public interest in the unauthorized use of Greenberg's photograph, an artistic work, in the production of the Animation Sequence, a new and derivative work. Thus, even without exhaustive evidence of negative market impact, the balance weighs in favor of disallowing the unauthorized use.

²⁵⁰ See Jaszi, *supra* note 130, at 300–01 (“[C]opyright should operate to assure the existence of a robust, constantly replenished public domain—an informational commons on which we are all free to draw in our research and teaching, and for our various creative projects. Accordingly, the special structures of copyright doctrine which exist to assure a reasonable level of public access even where copyrighted works are concerned, such as the doctrine of fair use, should be preserved and nurtured.” (footnotes omitted)); Parisi & Sevchenko, *supra* note 233, at 323 (“The tragedy of the anticommons demonstrates that fair use remains valuable even in the digital context of automated rights management. . . . In light of the anticommons insight, fair use doctrine retains a valid efficiency justification even in a zero transaction cost environment. Fair use defenses can be regarded as justifiable and instrumental in minimizing the welfare losses occasioned by the strategic behavior of the copyright holders.” (footnotes omitted)); Samuelson, *supra* note 146, at 116 (“When enacting the Copyright Act of 1976, Congress expressed an expectation that the fair-use doctrine would—and should—evolve to deal with challenging questions concerning the application of copyright law posed by new technologies. . . . The strict property-rights view of copyright . . . was rejected by the Court, which instead seemed to view copyright law as more of a regulatory regime aimed at achieving a balance among the interests of copyright owners, the consuming public and other commercial participants in the marketplace, such that the rights granted to authors under the statute should be construed as reaching no further than Congress has intended to achieve this balance.”); Shuff & Holtz, *supra* note 226, at 566 (“The question remains of how best to ensure that the vast library of individual articles that have been published remains available to the public while the rights of the authors of these articles is [sic] respected. After all, if distribution of these articles is halted altogether, the authors will enjoy no benefit, and the public will certainly suffer. Is requiring prior permission from each author feasible? . . . The transaction costs of obtaining such [permission] could outweigh the technological advances that have allowed millions of such articles to be made available and economically sold on an individual basis in the first place.”).

defenses that permit the use of copyrighted material without the copyright holder's consent. In many cases, however, there may be a legitimate dispute as to whether the user has a contractual right to make use of the subject work in electronic media.²⁵¹ In such cases, it will be necessary to scrutinize the terms of any agreements between the parties, in order to determine whether the copyright holder has licensed digital re-publication and other electronic media use of his or her work.

A. Licensing Electronic Use, Establishing Electronic Infringement

Although the copyright law bestows the exclusive rights upon the author of the copyrighted work, § 201 of the Copyright Act provides that “[a]ny of the exclusive rights comprised in a copyright, including any subdivision of the rights specified by section 106, may be transferred . . . and owned separately.”²⁵² In addition, § 204 requires that assignments and transfers be made in writing.²⁵³ Thus, the copyright holder is free to transfer or license some, all, or any part of his or her exclusive rights, by executing an appropriate license agreement.²⁵⁴

Unfortunately, participants in the publishing industry typically do not effectuate or memorialize their copyright licenses and agreements in terms that mirror the enumeration of exclusive rights in § 106, or for that matter, through contractual mechanisms that ostensibly comply with § 201.²⁵⁵ License agreements between publishers and authors are often quite informal, indeed even

²⁵¹ See, e.g., *Random House, Inc. v. Rosetta Books LLC*, 150 F. Supp. 2d 613, 617 (S.D.N.Y. 2001), *aff'd*, 283 F.3d 490 (2d Cir. 2002).

²⁵² 17 U.S.C. § 201(d)(2) (2002); NIMMER & NIMMER, *supra* note 53, §§ 10.01, 10.02.

²⁵³ See 17 U.S.C. § 204(a). “A transfer of copyright ownership, other than by operation of law, is not valid unless an instrument of conveyance, or a note or memorandum of the transfer, is in writing and signed by the owner of the rights conveyed or such owner’s duly authorized agent.” See *id.*

²⁵⁴ See 17 U.S.C. § 201(d).

²⁵⁵ See, e.g., Jane C. Ginsburg, *Authors as “Licensors” of “Informational Rights” Under U.C.C. Article 2B*, 13 BERKELEY TECH. L.J. 945, 949–54 (1998); Santelli, *supra* note 7, at 278; Sidney A. Rosenzweig, Comment, *Don’t Put My Article Online!: Extending Copyright’s New-Use Doctrine to the Electronic Publishing Media and Beyond*, 143 U. PA. L. REV. 899, 906 (1995).

oral.²⁵⁶ And even when in writing, standard publishing agreements typically reference terms and rights that have specific and significant meanings in the publishing trade, such as the right to “publish” or to “print” a work, but which are not set forth as exclusive rights in the copyright statute, such as the right to reproduce, distribute, and prepare derivative versions of a copyrighted work.²⁵⁷

Given some of the licensing jargon in the publishing trade, even in those instances in which the parties intend to license a particular kind of conduct or even specific exclusive rights, it is not

²⁵⁶ See generally *Greenberg v. Nat’l Geographic Soc’y*, 244 F.3d 1267, 1269 (11th Cir. 2001); *Tasini v. N.Y. Times Co.*, 972 F. Supp. 804, 807 (S.D.N.Y. 1997), *rev’d and remanded*, 206 F.3d 161 (2d Cir. 1999), *aff’d*, 533 U.S. 483 (2001); *Mellencamp v. Riva Music Ltd.*, 698 F. Supp. 1154, 1161–67 (S.D.N.Y. 1988) Ginsburg, *supra* note 253, at 954 n.41; *Matthew Hoff, Tasini v. New York Times: What the Second Circuit Didn’t Say*, 10 ALB. L.J. SCI. & TECH. 125, 128 (1999) (stating that “publishers . . . once accepted a freelance author’s work on little more than a handshake”); *Rosenzweig*, *supra* note 255, at 905–06 (“Although publishers ordinarily have the rights to use preexisting content produced by their staff writers under the work-made-for-hire doctrine, the usage of works by freelancers is subject solely to interpretation of the underlying contract between the two parties. Historically, however, parties have been lax in creating written, let alone unambiguous, contracts. Until recently, magazines and newspapers bought articles ‘simply on the basis of oral agreements,’ and the freelance contracts that did exist did not expressly address the parties’ rights in electronic media.” (footnotes omitted)).

²⁵⁷ See, e.g., *Reed*, *supra* note 56, at 1106–08 (“An ‘all-rights’ contract does what it says; it transfers to the publisher every possible right the author may have in her work. . . . [By contrast t]he book publishing industry [also] recognizes the concept of ‘Primary Rights,’ which, in the United States, generally entails the exclusive right to publish a work in print in English throughout North America (or even worldwide). The analogous right in the periodical publishing industry may be the ‘first publication rights,’ which give the periodical publisher the right to publish the work in their publication before it is published elsewhere. . . . Subsidiary Rights are the rights that are not Primary Rights. As evidenced in *Random House*, obtaining the Primary Rights to publish a book in print does not necessarily include the right to publish that book electronically.”). In addition to the foregoing categories, other “rights” recognized in the publishing industry, but not individually enumerated in the copyright statute, include Serial Rights, Reprint Rights, Braille Rights, Audio Rights, Foreign Language Rights, Anthology Rights, and Book Club Rights. See *id.* at 1108; see also *Rey v. Lafferty*, 990 F.2d 1379, 1387 (1st Cir. 1993); *Nakos*, *supra* note 236, at 433–49; *NIMMER & NIMMER*, *supra* note 53, § 26.02; *Thornburg*, *supra* note 2, at 251; cf. generally *Tele-pac, Inc. v. Grainger*, 570 N.Y.S.2d 521 (N.Y. App. Div. 1991) (holding that broadcast rights for motion pictures do not confer rights to distribute videocassettes); *Cohen v. Paramount Pictures Corp.*, 845 F.2d 851 (9th Cir. 1988); *Bartsch v. Metro-Goldwyn-Mayer, Inc.*, 391 F.2d 150, 150–53 (2d Cir. 1968) (upholding dismissal of the copyright holder’s claim against the assignee of rights to the motion picture which licensed the movie rights for television).

always apparent from the express terms of the parties' contract which exclusive rights are being licensed or the scope of the license conferred.²⁵⁸ Consequently, precisely which of the copyright holder's *exclusive rights* are being licensed or assigned, and whether there are qualitative, durational, geographic, and/or media restrictions limiting the grant of exclusive rights, are often difficult to ascertain from the express terms of the parties' agreement.²⁵⁹ In the face of a claim of a contractual right to engage in a particular use of a copyrighted work, the court is typically required to not only confirm the existence of the claimed license, but also to define its scope.²⁶⁰

Tasini, *Random House*, and similar cases illustrate how some of the license interpretation problems that arise in connection with digital re-publication and other new technological uses for copyrighted works are only partially the result of rapid technological development. The question of precisely which exclusive rights were encompassed within the parties' license agreements was one of the principal issues raised in *Tasini*.²⁶¹ While the plaintiff freelance writers essentially conceded that their agreements licensed the exclusive rights of reproduction and distribution, they contended that the agreements did not license the exclusive right of display, more specifically, the right to display

²⁵⁸ See *Boosey & Hawkes Music Publishers, Ltd. v. Walt Disney Co.*, 145 F.3d 481, 485–88 (2d Cir. 1998); *Bartsch*, 391 F.2d at 152–54; *Random House, Inc. v. Rosetta Books LLC*, 150 F. Supp. 2d 613, 621 (S.D.N.Y. 2001), *aff'd*, 283 F.3d 490 (2d Cir. 2002); *Field v. True Comics, Inc.*, 89 F. Supp. 611, 614 (S.D.N.Y. 1950); NIMMER & NIMMER, *supra* note 53, § 26.02 [B] (“[A] grant of the right to ‘reproduce the work in all media now known or hereafter developed’ does not necessarily include the right to distribute, exhibit, or perform the work (which are separate rights under copyright law) in all future media.”).

²⁵⁹ See, e.g., *Boosey & Hawkes*, 145 F.3d at 485–88; *Bartsch*, 391 F.2d at 152–54; *Random House*, 150 F. Supp. 2d at 621; *Field*, 89 F. Supp. at 614; *cf.* NIMMER & NIMMER, *supra* note 53, § 10.14 [C] (discussing difficulties with the term “book form”).

²⁶⁰ See *Nimmer, Licensing*, *supra* note 238, at 119–22 (“A license is a contract. Its subject matter is information and rights in information. The contract gives rights to a licensee to use information or resources that the licensor controls or to which it controls access. License agreements also often cover issues concerning the quality, availability, and use of the information. . . . [T]he main function of the license centers on permissions or agreements associated with the use of or access to informational assets, along with a licensee’s promise not to exceed agreed limitations on use.”).

²⁶¹ See *Tasini*, 972 F. Supp. at 806–08.

their works on a computer screen.²⁶² Consequently, in part because the parties' agreements were not cast in terms of the exclusive rights, the *Tasini* tribunals were confronted with a bifurcated issue of statutory construction and license interpretation. First, the courts had to decide whether the copyright holder's exclusive right of display extends to computer screen display, and if so, whether the parties' license agreements extended to the display right, as it apparently extended to the rights of reproduction and distribution.²⁶³

Inconsistencies between publishing trade licensing practices and the express provisions of the copyright statute were at the very heart of the controversy in *Random House*.²⁶⁴ Instead of casting

²⁶² See *id.* at 808. Numerous courts have previously wrestled with the question of whether computer screen display is conduct within the exclusive display right, with differing results. See, e.g., *MAI Sys. Corp. v. Peak Computer, Inc.*, 991 F.2d 511, 518 (9th Cir. 1993); *Sega Enters. v. MAPHIA*, 948 F. Supp. 923, 927 (N.D. Cal. 1996); *Religious Tech. Ctr. v. Lerma*, 1996 U.S. Dist. LEXIS 15454, *2-*5 (E.D. Va. 1996); *Playboy Enters. v. Frena*, 839 F. Supp. 1552, 1556-57 (M.D. Fla. 1993) ("The concept of display . . . covers 'the projection of an image on a screen or other surface by any method, the transmission of an image by electronic or other means, and the showing of an image on a cathode ray tube, or similar viewing apparatus' The display right precludes unauthorized transmission of the display from one place to another, for example, by a computer system." (citations omitted)); *State v. Perry*, 697 N.E.2d 624, 628 (Ohio 1998) ("Posting software on a bulletin board where others can access and download it is distribution. Unauthorized distribution is a use which is governed by the copyright laws. Unauthorized posting may also be viewed as facilitating unauthorized downloading or copying by a third party and as such is also a violation of the exclusive right of reproduction under the copyright laws. Posting also implicates the display rights of copyright owners." (citations omitted)).

²⁶³ Both questions were implicated because even if the subject agreements do not license the display right, plaintiffs must still demonstrate that the display right has been infringed in order to establish copyright infringement. Once the publishers failed to assert their license agreements in defense of their digital re-publications, however, they effectively conceded that they had no authorization to engage in *any* of the exclusive rights, be it that of display, or those of reproduction and distribution. Consequently, once the Court ruled the § 201(c) privilege inapplicable, there was no question that the publishers had at least infringed upon plaintiffs' reproduction and distribution rights. "Satisfied that the Publishers exercised rights § 106 initially assigns exclusively to the Author, we need resolve no more on that score. Thus, we do not reach [the question as to whether] the Databases publicly 'display' the Articles . . ." *N.Y. Times Co. v. Tasini*, 533 U.S. 483, 498 n.8 (2001). Whether the publishers had also impinged upon the display right was rendered surplusage—the case for copyright infringement had already been made.

²⁶⁴ *Random House, Inc. v. Rosetta Books LLC*, 150 F. Supp. 2d 613, 619-22 (S.D.N.Y. 2001), *aff'd*, 283 F.3d 490 (2d Cir. 2002).

their agreements in terms of the exclusive rights, the parties executed written licenses that authorized the publisher to “to print, publish and sell” the subject works and to do so “in book form.”²⁶⁵ Consequently, there were legitimate issues not only as to which exclusive rights were licensed by the agreements, but also as to the scope of the grants—i.e., the meaning of “in book form.”²⁶⁶

Thus, the perennial failure of the publishing trade to harmonize its licensing terms and practices with the express provisions of the copyright statute renders legal disputes and maneuverings such as those that occurred in *Tasini*, *Random House*, and similar cases inevitable.²⁶⁷ In a dispute over the right to engage in a new technological use, both licensor and licensee genuinely may believe that the right belongs to him or her. Moreover, because publishing licenses typically make no reference to the enumerated exclusive rights, which are the only uses of copyrighted material that the copyright holder can legally control, the courts have little guidance as to which of the copyright holder’s actual property rights are the subject of the agreements.²⁶⁸ When a dispute arises

²⁶⁵ See *id.* at 614.

²⁶⁶ See *id.* at 620. The parties might also have litigated the issue as to whether the display right is included in a license “to print, publish and sell.” Instead, the litigation focused on deciphering the meaning of the trade term “in book form” and whether an “ebook” is a work “in book form.” See *id.*

²⁶⁷ See Springer, *supra* note 236, at 352 (“While a written agreement can easily be drafted using a fill-in-the-blanks form, recall that the freelance publishing industry has been one based on traditions and handshakes.”); Vermeylen, *supra* note 92, at 192 (“The business of publishing books has historically been slow moving, driven more by relationships and passion for the process than by bottom lines. Liberal arts majors, literature students, and generalists of all sorts seek jobs in the industry in part for this reason—books do not change and the business of making them changes only begrudgingly.”).

²⁶⁸ For an excellent review of the various judicial approaches to new use disputes, see Nakos, *supra* note 236, at 443–55, which discusses the predominant methods for resolving such disputes, particularly the “preferred” and “strict” approaches. Under the preferred approach, the new use is deemed to be within the scope of the license if it can be reasonably construed to fall within the stated description of the explicitly licensed activity. See *id.* at 444. Under the strict approach, only uses specifically provided for in the express license terms are deemed within the scope of the license. See *id.* at 446.

Problems accompany either the preferred or strict approach . . . and arguments have been made that each theory puts one party in an unfair position. One problem lies in ascertaining the definition of the medium or mediums described in the license, because a use may simply constitute an improvement on a previous medium rather than an entirely new means of exploitation This

in connection with a new technological use, courts are therefore limited in determining the intent or reasonable expectations of the parties, not only as a question of basic contract interpretation, but as an issue of substantive copyright as well.²⁶⁹

B. Emphasizing Exclusive Rights in Drafting and Interpreting Copyright Licenses

The problem of construing pre-existing license terms in light of new technological applications for copyrighted works is to some extent inescapable.²⁷⁰ No matter how carefully drafted, virtually every license is vulnerable to ongoing technological development and the consequential dilemma of determining which party has the right to engage in a use or application that did not exist when the license was executed.²⁷¹

situation is especially problematic when applying the preferred approach because the licensor's carefully drafted, narrow, and unambiguous grant may later become ambiguous in light of advanced technology.

Id. at 448–49 (footnotes omitted).

²⁶⁹ *See id.* at 435–36 (“[An important] issue [in publishing license disputes] is what uses are covered by the rights transferred to the licensee when the license agreement does not cover all possible contingencies, such as the invention of a new mode of presenting the work or making the work available to the public. The problem is particularly perplexing because the area is one where no controlling law is available to aid in placing the rights with whom they belong. Courts have diverged in their attempts to resolve the situation using basic contract interpretation principles as well as copyright policy; as a result, no universally adopted rule has emerged.”); *see generally* Rosenzweig, *supra* note 255 (suggesting that courts should generally interpret contracts to grant rights to publishers to exploit future technologies, because the publishers can best exploit the new technologies).

²⁷⁰ *See* Nakos, *supra* note 236, at 434 (“[These] dispute[s] inevitably arise[] whenever a new use for a certain work is developed or invented subsequent to the execution of the license agreement. Licensees argue that the new use is contained in the definition of a medium in the agreement. But licensors . . . counter that a new use could not be contemplated by such an agreement. Because the use of the work did not exist at the time the license agreement was drafted, courts must resolve the issue of to whom new uses belong.”).

²⁷¹ *See id.* at 436 (“[Disputes over the scope of the license have] repeatedly occurred with the invention of popular new mediums. The resulting issues include the following: . . . whether broadcasting rights include television when only radio existed at the time of contracting, whether motion picture rights include rights to televise, whether television and movie rights include videocassette distribution rights, and, currently, whether the right to publish a book includes the right to make books on tape or transfer the contents on-line.” (footnotes omitted)).

Although it may be impossible to compose license terms that will account for every new technological use, the problem can be mitigated through the use of consistent terminology and rules of interpretation in the drafting and judicial construction of copyright licenses.²⁷² As discussed in Part II, whatever the particular use to which a copyrighted work is to be put, that use can only be precluded, restricted, or for that matter, effectively *licensed* by the copyright holder if it involves an exclusive right.²⁷³ Consequently, even if a license unambiguously sanctions a specific use of copyrighted material²⁷⁴ as a matter of the copyright law, the license will be ambiguous as to the extent to which the copyright holder can restrict or limit the activities of his or her licensee.²⁷⁵

Unless the grant of rights is described in terms of the exclusive rights, the scope of the licensee's ability to engage even in a

²⁷² See Thornburg, *supra* note 2, at 255 (“[C]ontract law remains the sole mechanism to bring both freelance authors and publishers to a common ground to create the exchange of electronic rights for appropriate compensation. The traditional handshake agreements between these parties have come to an abrupt end, with contract negotiations serving society's interest in promoting and encouraging freelance creations to enrich our cultural needs.”).

²⁷³ See *supra* Part II.

²⁷⁴ This may include a license to publish a written work in digital format, if the license is not equally specific with respect to the attendant exclusive rights—that is, explicitly referencing the rights of reproduction and distribution (and possibly the right of display).

²⁷⁵ See, e.g., *Cohen v. Paramount Pictures Corp.*, 845 F.2d 851, 854 (9th Cir. 1988) (“Perhaps the primary reason why the words ‘exhibition by means of television’ in the license cannot be construed as including the distribution of videocassettes for home viewing is that VCRs for home use were not invented or known in 1969, when the license was executed. . . . [T]he original licensee could not have bargained for, or paid for, the rights associated with videocassette distribution. . . . [T]he license reserved to the grantor ‘all rights and uses in and to said musical composition, except those herein granted to the licensee . . .’ This language operates to preclude uses not then known to, or contemplated by the parties.” (citations omitted)); *Rose*, *supra* note 119, at 95 (“A critical issue for Internet transmissions is whether they constitute ‘reproductions,’ ‘distributions,’ or both. The original electronic file is typically not erased when a copy is transmitted. Because the original from which the copy is generated remains intact, Internet communications arguably infringe both reproduction and distribution rights. Indeed, for bulletin board or website operators the query remains whether downloading from a bulletin board or website is a ‘reproduction’ by the Internet user, or merely a ‘distribution’ by the operator.” (footnotes omitted)); *Vermynen*, *supra* note 92, at 198 (“[E]ven in the age of the e-book, it seems that the definition of ‘book’ is limited. As the [*Random House*] court concluded, the rights to the *content* of a work itself are independent of the right to publish it in a given form.”).

specifically designated activity will be unclear, especially when new technological uses are introduced. If the parties cast their agreements in terms of the exclusive rights, however, when confronted with a new technological use dispute, the parties and the courts will have a concrete point of reference from which to undertake the copyright allocation analysis: a comparison of the new technological use with the exclusive rights expressly referenced in the parties' license agreement.

An "exclusive rights emphasis" would therefore require that copyright licenses be expressed in terms of the enumerated exclusive rights, and the presence or absence of such express terms would be subject to uniform rules of construction. In this way, the expression of a copyright license in terms of the exclusive rights will provide greater certainty for the parties thereto and concrete guidance for the courts when confronted with the problem of allocating a new technological application for copyrighted material.

Participants in the publishing trade could be encouraged to adopt an exclusive rights emphasis in their drafting practices if courts begin to interpret the inclusion or omission of exclusive rights terms in a consistent manner.²⁷⁶ Both licensors and licensees would soon realize that the use of exclusive rights terminology would lead to predictable judicial construction of their agreements. This would not only result in routine reference to the exclusive rights in publishing licenses, but would also engender the

²⁷⁶ Reconstructing legal canons and mechanisms to address actual trade or market conditions is by no means a new idea. See, e.g., Steven D. Jamar, *A Lawyering Approach to Law and Development*, 27 N.C. J. INT'L L. & COM. REG. 31, 33-34 (2001) ("[A lawyering] approach to law and development . . . relies not upon an arcane sociological theory, but rather upon the lawyer's consummate practical skill of problem-solving. The lawyering approach involves professionalism, working for and with the client (including active client participation in decision-making), and problem-solving. It takes as its starting point the need to define what problems need to be addressed. Then a practical analysis of each problem is undertaken with an aim of developing and implementing practical solutions to those problems. . . . [T]he lawyering approach focuses . . . narrowly; it assesses actual human needs based on actual conditions. . . . After needs are determined, a lawyering approach requires developing strategies to address needs revealed by the assessment, but without prejudging the utility of any particular structure or set of laws. . . . Under the lawyering approach the reformer's palette is not monochromatic." (footnotes omitted)).

development of a more uniform “new technological use” jurisprudence.

C. Applying an Exclusive Rights Emphasis to Tasini, Random House, and Other “New Use” Disputes

An exclusive rights emphasis could have proved useful in resolving some of the issues raised in *Tasini* and *Random House*.²⁷⁷ For example, in *Tasini* specific exclusive rights were referenced in some of the licenses at issue.²⁷⁸ With respect to such agreements, where the new technological use or application involves an exclusive right other than those expressly referenced in the license agreement, the licensee would be hard pressed under an exclusive rights emphasis to argue that he or she has a license to engage in the additional exclusive right and the concomitant new technological use. Thus, as in *Tasini*, where the written license agreements expressly referenced the rights of reproduction and distribution, the licensee has no exclusive display right and is also precluded from engaging in activities that infringe upon that right.²⁷⁹

In the situation in which the license agreement is expressed both in terms of a specific application for the work and specific exclusive rights, the reference to exclusive rights will control. For example, in *Random House*, the license agreement authorized reproduction and distribution of the subject works “in book form.”²⁸⁰ Under an exclusive rights emphasis, the license does not grant any right exclusive rights beyond reproduction and

²⁷⁷ In *Greenberg*, National Geographic relinquished all contractual rights in the copyrighted photograph prior to the events that gave rise to the litigation, hence the problem of interpreting a license was not an issue in that case. See *Greenberg v. Nat’l Geographic Soc’y*, 244 F.3d 1267, 1269 (11th Cir. 2001).

²⁷⁸ See *Tasini v. N.Y. Times Co.*, 972 F. Supp. 804, 807 (S.D.N.Y. 1997), *rev’d and remanded*, 206 F.3d 161 (2d Cir. 1999), *aff’d*, 533 U.S. 483 (2001).

²⁷⁹ Consequently, had the Supreme Court reached the issue in connection with such license agreements, under an exclusive rights approach the Court would have only to determine whether computer screen display is an activity subsumed within the copyright holder’s exclusive display right. If so, the publishing licensees could not engage in unauthorized digital re-publication without infringing upon the contributory author’s exclusive rights.

²⁸⁰ See *Random House, Inc. v. Rosetta Books LLC*, 150 F. Supp. 2d 613, 615 (S.D.N.Y. 2001), *aff’d*, 283 F.3d 490 (2d Cir. 2002).

distribution. Thus, if computer screen display is eventually determined by the courts to be an activity within the exclusive display right, then the production of e-books is beyond the scope of the license. The license only grants the exclusive rights to reproduce and distribute the work “in book form,” and because an e-book would involve the right of display, an e-book is essentially “a form of book” outside the scope of the license.

Where the license agreement makes no reference to any exclusive rights whatsoever, an exclusive rights emphasis would require that assessment of the scope of the license begin with a determination of which of the enumerated exclusive rights are absolutely *essential* to any method for undertaking the application or activity described in the parties’ agreement.²⁸¹ In as much as the parties obviously intended that the licensee engage in the specified activity, it is only reasonable to construe the license to permit the licensee to engage in those exclusive rights that are necessary to undertaking that activity.²⁸² Otherwise, the licensee could not engage in the licensed activity under any circumstances, and the license would be rendered a nullity.²⁸³

On the other hand, there may also be alternative methods available for engaging in the activity described in the license, whether existing as of the time of the parties’ contracting or developed subsequently during the license term. To the extent that such alternative methods involve “*non-essential*” exclusive

²⁸¹ For example, different electronic publication methods or products can involve different exclusive rights. If a specifically designated electronic use can be undertaken through a method or methods which involve only certain exclusive rights and without involving other exclusive rights, the court should construe the electronic use license to encompass only the narrowest range of exclusive rights—that is, only those exclusive rights essential to every method for engaging in the specified electronic activity.

²⁸² See, e.g., *Random House*, 150 F. Supp. 2d at 621; *Field v. True Comics, Inc.*, 89 F. Supp. 611, 613 (S.D.N.Y. 1950).

²⁸³ This rule would also be of use in a variation of the situation in which the license has been expressed in terms of a particular kind of use and also specific exclusive rights, such as a license to reproduce and distribute a written work in digital media. Obviously the rights of reproduction and distribution have been licensed, but what happens if the courts eventually determine that computer screen display encroaches upon the exclusive display right? In as much as computer screen display is essential to all methods of digital media use, the license would be construed to extend to the display right, at least to the extent necessary to avoid nullification of the parties’ agreement.

rights—that is, exclusive rights that must be exercised in conjunction with some, but not all methods for undertaking the licensed activity—such non-essential exclusive rights/alternative methods are beyond the scope of the license.²⁸⁴ Because the parties failed to express their license agreement in terms of the exclusive rights, and because a license of any of the exclusive rights must be express in order to be effective, the license should be narrowly construed to extend to only those exclusive rights necessary to avoid the complete nullification of the parties' agreement. The lack of an express reference to the non-essential exclusive rights should therefore be construed as a reservation of such rights, as well as of any concomitant new technological uses, on the part of the copyright holder.²⁸⁵

²⁸⁴ See *Cohen v. Paramount Pictures Corp.*, 845 F.2d 851, 853 (9th Cir. 1988); Nimmer, *Licensing*, *supra* note 238, at 127 (“One can license any of the [exclusive] rights, while retaining control of the others. One can license or transfer such rights on an exclusive or a non-exclusive basis. Similarly, one can subdivide any of the rights through limitations in a license. . . . [T]he important point is that a contract that grants one right (or part of it) does not imply that any other right is granted under the license. Indeed, in the absence of other indicia of a broader agreement, a license conveys only what was expressly granted or what can reasonably be inferred from that express grant. There is no assumption that a transferor (rights owner) grants all rights except those it expressly withholds.” (footnotes omitted)).

²⁸⁵ See Jaszi, *Toward a Theory of Copyright*, *supra* note 239, at 462 (“[A]lthough it is traditional to view copyright doctrine as a battle between the interests of copyright owners . . . and copyright users, in practice, those interests are remarkably congruent. Both sellers and buyers have a considerable stake in the maintenance of an orderly market with plentiful supplies of new works at reasonable prices.”); Nakos, *supra* note 234, at 445–46 (“[I]f a technology did not exist when a licensing agreement was made, how can a court construe the agreement to have granted any rights in that technology . . . ? While it strains reason to allow a court to randomly assign a rule in situations where certain uses, whether existing or new, are not addressed by the parties to the agreement, the line is crossed when uses not specifically reserved to the grantor are [construed as having been] transferred to the grantee.” (footnote omitted)). Thus, describing the license in terms of specific uses for a work as opposed to specific exclusive rights increases uncertainty and the possibility of a windfall to one side. The right to engage in subsequently developed methods for undertaking the specifically licensed activity would belong to the licensee, so long as such methods do not require engagement in any additional, i.e., “non-essential” exclusive rights. On the other hand, new technological uses that require any non-essential exclusive rights would be deemed as reserved to the copyright holder.

D. The Presumption of “Technological Neutrality”

One final new technological use canon of construction that would promote the expression of copyright license agreements in terms of the exclusive rights is a presumption of “technological neutrality.” Such a presumption would mandate that the express license of an exclusive right be construed to extend to all technological means available to engage in that right, including those methods not in existence when the parties entered into their agreement, but have come into existence during the license term.

In granting a license of an exclusive right, if the copyright holder wishes to limit the grant to specific or presently existing methods of engagement, he or she can state such restriction explicitly in the agreement.²⁸⁶ This can be easily accomplished by expressly limiting the license to methods currently in existence or through the use of some other appropriate reservation of rights language.²⁸⁷

²⁸⁶ See *Boosey & Hawkes Music Publishers, Ltd. v. Walt Disney Co.*, 145 F.3d 481, 487 (2d Cir. 1998) (“[The words of the] license are more reasonably read to include than to exclude a motion picture distributed in video format [W]e conclude that the burden fell on [the copyright holder] to exclude new markets arising from subsequently developed motion picture technology, [and] to insert such language of limitation in the license, rather than on [the licensee] to add language that reiterated what the license already stated.”); Vermeylen, *supra* note 92, at 194–95 (“Publishing contracts also traditionally contain a provision dealing with the license of electronic rights or rights in the work derived from ‘technologies not yet known’ or ‘other media.’ . . . As these technologies become ‘known’ rather than ‘not yet known’ and prove profitable, authors begin to reserve the right to license these rights in their works. This reservation typically takes the form of either an express clause in the contract or a clause limiting the grant of rights to only those traditional print forms listed in the contract” (footnotes omitted)).

²⁸⁷ See *Boosey & Hawkes*, 145 F.3d at 487–88 (“[S]ignificant jurisprudential and policy considerations confirm . . . our view [that construing a general grant of rights to include new use technologies] is more consistent with the law of contract than the view that would exclude new technologies even when they reasonably fall within the description of what is licensed. Although contract interpretation normally requires inquiry into the intent of the contracting parties, intent is not likely to be helpful when the subject of the inquiry is something the parties were not thinking about.”); see also Michael R. Fuller, *Hollywood Goes Interactive: Licensing Problems Associated with Re-Purposing Motion Pictures into Interactive Multimedia Videogames*, 15 LOY. L.A. ENT. L.J. 599, 612 (1995) (“If the words . . . are broad enough to cover the new use, it seems fairer that the burden of framing and negotiating an exception should fall on the grantor”). *But see* Nakos, *supra* note 236, at 455–57 (arguing in favor of a strict interpretation approach, such that

Placing upon the copyright holder the responsibility of reserving a technological limitation on the express license of an exclusive right is an approach consistent with the provisions of the Copyright Act as well as copyright public policy.²⁸⁸ Moreover, a presumption in favor of technological neutrality is not a bias in favor of publishing licensees. It merely preserves the parties' actual bargain, or perhaps more accurately, it resolves issues the parties failed to address in a manner consistent with traditional contract canons and copyright policy objectives.²⁸⁹

We acknowledge that a result which deprives the author-licensor of participation in the profits of new unforeseen channels of distribution is not an altogether happy solution. Nonetheless, we think it more fair and sensible than a result that would deprive a contracting party of the rights reasonably found in the terms of the contract it negotiates. This issue is too often, and improperly, framed as one of favoritism as between licensors and licensees. Because licensors are often authors—whose creativity the copyright laws intend to nurture—and are often impecunious, while licensees are often large business organizations, there is sometimes a tendency in copyright scholarship and adjudication to seek solutions that favor licensors over licensees. . . .

any use not expressly provided for in the license would be considered reserved by the licensor).

²⁸⁸ Copyright protection is afforded to appropriate works upon fixation in any medium, "now known or later developed." 17 U.S.C. 102(a) (2003); see *Boosey & Hawkes*, 145 F.3d at 488 n.4 ("[A]n approach to new-use problems that tilts against licensees gives rise to antiprogressive incentives. [For example, motion picture producers would be reluctant to explore and utilize innovative technologies for the exhibition of movies if the consequence would be that they would lose the right to exhibit pictures containing licensed works."].

²⁸⁹ See *Bartsch v. Metro-Goldwyn-Mayer, Inc.*, 391 F.2d 150, 152–55 (2d Cir. 1968) ("In the end, decision must turn . . . on a choice between two basic approaches [to dealing with new technological uses] more than on an attempt to distill decisive meaning out of language that very likely had none." (citation omitted)); *NBC v. Copyright Royalty Tribunal*, 848 F.2d 1289, 1294 (D.C. Cir. 1988) ("[Copyright] ownership is itself dependent on the contractual terms [between the parties]; it cannot be settled without reference to those terms.").

In our view, new-use analysis should rely on neutral principals of contract interpretation rather than solicitude for either party. . . . If the contract is more reasonably read to convey one meaning, the party benefitted [sic] by that reading should be able to rely upon it. . . . This principle favors neither licensors nor licensees. It follows simply from the words of the contract.²⁹⁰

A presumption of technological neutrality equally favors and disfavors both licensor and licensee.²⁹¹ As described above, the presumption would enable licensees to engage in subsequently developed methods for undertaking expressly licensed exclusive rights. On the other hand, a new technological use that incorporates exclusive rights other than those referenced in the agreement, for example, a new method of reproduction that also utilizes the right of distribution, would be deemed beyond the scope of the license, if only the right of reproduction is referenced in the license.²⁹²

While the new technological use of digital re-publication presents a novel challenge to the traditional copyright framework, it also provides an opportunity to address the nettlesome inconsistencies between the business of copyright licensing and the

²⁹⁰ *Boosey & Hawkes*, 145 F.3d at 487; see also *Random House, Inc. v. Rosetta Books LLC*, 150 F. Supp. 2d 613, 622–24 (S.D.N.Y. 2001), *aff'd*, 283 F.3d 490 (2d Cir. 2002).

²⁹¹ See *Nakos*, *supra* note 236, at 443 n.49 (“At the heart of the controversy over the rights to exploit a work in a new medium is the potential revenue that this medium may generate to whomever possesses those rights. When a new use surfaces, it does not alter the original rights conveyed by the contract. Instead, a case typically ‘involves circumstances so changed that the deal looks less attractive now than when struck.’” (quoting *Rooney v. Columbia Pictures Indus.*, 538 F. Supp. 211, 229 (S.D.N.Y. 1982))).

²⁹² See *Nakos*, *supra* note 236, at 434 (“In the case of a licensing agreement that fails to place the rights to newly developed means of exploitation of the licensed work, any ambiguity should be construed in favor of the licensor: a strict approach to interpreting copyright licensing agreements, reserving all uses not expressly granted to the licensor, is the best approach.”). While resolving *any ambiguity* in favor of the licensor goes too far, the basic argument that copyrights must be expressly transferred is of course sound. However, when a copyright owner expressly licenses an exclusive right *and does so without any explicit reservation or restriction*, construing the license to include all methods for engaging in that right that are (or become) available during the license term merely implements the express provisions of the license, as well as copyright policy.

mandates of the copyright law.²⁹³ Other than when the entire copyright is being assigned, traditional publishing boilerplate has proven an inadequate means by which to authorize new and sometimes even traditional uses of copyrighted material, or to license any exclusive rights essential or incidental to such activities.²⁹⁴ By expressing the license in terms of the exclusive rights, the parties make clear which of the copyright holder's actual property rights are the subject of the their agreement, and also provide a roadmap for the resolution of any disputes that might arise in connection with the development of new technological application relevant to their agreement.²⁹⁵

²⁹³ See Jamar, *supra* note 276, at 41–44 (“The core attributes of a lawyering approach are: (1) professionalism, (2) client-centeredness, and (3) problem-solving. . . . When the three core elements of the lawyering approach are considered together, one is forced into a process-oriented approach. . . . Client centeredness and client involvement in the problem-solving process ensure an emphasis on inclusion and process rather than exclusion and fiat.” (footnotes omitted)).

²⁹⁴ See J. Michael Huget & Sarah K. Fisher, *Put It in Writing: The Extent of Rights Acquired on a Copyrightable Work Should Be Agreed upon Ahead of Time*, 80 MICH. B.J. 50, 51 (Nov. 2001) (“The difficulty that arose in *Tasini* is that the publishers did not obtain copyright ownership for the articles at issue; as a result, they merely had a license to publish the articles in their publications. Given that the license did not address the issue of electronic databases, the publishers were at the mercy of judicial interpretation. . . . Thus, the lesson from *Tasini* is simple . . . : it is imperative for any person or company hiring an independent contractor to create a copyrightable work to agree in writing, before the work is begun, on the extent of the rights to be acquired from the independent contractor. The lack of a written agreement will ensure that the independent contractor will retain the copyright ownership, along with the right to license and further exploit the work.”).

²⁹⁵ See *NBC*, 848 F.2d at 1293 (“[C]opyrights, or any of their individual constituent parts, are freely alienable. . . . The Copyright Act aids commercial exploitation of copyrights by allowing the sale of particular rights—such as movie rights or rights to perform a popular song—or of the entire bundle. The intent of the parties, as expressed in their contracting, therefore can determine who enjoys copyright protection for certain rights. . . . Only reference to the parties’ intent can indicate the *relevant* owner. The goals of the alienability and divisibility of copyrights would, of course, be subverted if private contracts were not enforced properly.” (citations omitted)); see also *Boosey & Hawkes*, 145 F.3d at 484–91; *Bartsch v. Metro-Goldwyn-Mayer, Inc.*, 391 F.2d 150, 154–55 (2d Cir. 1968); *Random House*, 150 F. Supp. 2d at 617–22; NIMMER & NIMMER, *supra* note 53, § 26.02[C][1]–[2]; Ginsburg, *supra* note 255, at 954–73; Rosenzweig, *supra* note 255, at 908–18.

CONCLUSION

The copyright issues presented by digital re-publication affect virtually every existing printed work not in the public domain. Whether regarded as an entirely *sui generis* activity or a combination of existing exclusive rights, digital re-publication is fast becoming the principal means for archiving printed works. The advent of digital re-publication not only eliminates the need for possession of individual copies of specific works, but facilitates their dissemination to larger audiences than ever.

As *Tasini* and its progeny demonstrate, however, relatively few existing works have been published pursuant to agreements that encompass their use in electronic media. Consequently, the legal mechanisms through which digital re-publication is accomplished will continue to be a source of conflict in the publishing industry. Publishers are likely to continue to utilize their superior bargaining leverage to secure digital re-publication rights without paying additional compensation to most copyright holders.²⁹⁶ For their part, authors and authors' organizations will work to devise accessible writer compensation mechanisms, whereby cooperative publishers might easily pay digital re-publication royalties to copyright owners. Various writers' groups have already organized "copyright clearinghouses" to collect and distribute digital re-publication royalties, borrowing from methods employed in the recording industry for decades.²⁹⁷

²⁹⁶ See Springer, *supra* note 236, at 349 ("With the risk of liability 'too great to allow any other course of action,' *The Times* has engaged in an on-going process of removing those freelance articles with unsecured rights from electronic archives. At the same time, *The Times* has set up a process for allowing freelance authors to allow their submissions to remain in the electronic archives if they should so desire.").

²⁹⁷ See, e.g., Thornburg, *supra* note 2, at 253 ("In addition to individual contracts between freelance authors and publishers, two payment systems are currently employed to compensate authors directly for the use of their work in electronic media. 'The Authors Registry is a non-profit organization formed to help expedite the flow of royalty payments and small re-use fees from publisher to author,' and includes over 100 literary agencies and represents 50,000 writers. In addition, the Publication Rights Clearinghouse, which was formed by the National Writers Union, 'pays a copyright fee of 30% of its delivery price,' deducting a twenty percent administration cost for union members. The clearinghouse mostly secures royalties in the fields of full-text databases, Web sites, and other similar electronic media.'" (footnotes omitted)); see also Albanese,

In those cases in which publishers and authors remain at a digital re-publication impasse, however, the fair use doctrine provides an appropriate method for balancing the competing interests in a socially responsible manner. Indeed, the availability and application of the fair use doctrine may well foster the development of consensual mechanisms for digital re-publication. Given that the question of fair use is extremely fact sensitive, both publishers and authors alike have a powerful incentive to work toward non-judicial resolutions of their digital re-publication disputes.²⁹⁸

Moreover, many a digital re-publication standoff will present attractive broker/mediator opportunities for third-party electronic re-publishers. Entities such as NEXIS can not only bring additional resources to the negotiation table, but may also have the most to gain from the expeditious resolution of digital re-publication conflicts.²⁹⁹

Finally, with respect to both new and existing works, the widespread adoption of an exclusive rights emphasis in copyright licensing would aid in facilitating digital re-publication as well as other new technological uses for copyrighted works. The consistent demonstration of a judicial preference for an exclusive rights construction/allocation approach to new technological use disputes would assist authors and publishers in evaluating their respective positions under existing publishing contracts, and also encourage participants in the publishing trade to improve and conform current licensing practices. This would diminish the

supra note 244, at 14; Reed, *supra* note 56, at 1106, 1110–11; Soares, *supra* note 56, ¶¶ 24–25.

²⁹⁸ See, e.g., Anderson & Brown, *supra* note 111, at 144 (“Many who have looked at the relationship between copyright protection and the fair use defense have concluded that finding a fair use is, at best, a matter of balancing hard-to-define equitable considerations, or at worst, a matter of luck. Additionally, for those of the orthodox school, obtaining a fair use exception in court is simply a matter of marshalling more emotionally appealing equities *for* fair use than the creator of the work can offer *against* fair use. Most of the copyright commentators have argued that the fair use case law is largely unprincipled and unpredictable.” (footnotes omitted)).

²⁹⁹ For example, in a typical digital re-publication dispute, electronic publishers such as NEXIS could offer to negotiate independent arrangements with writers’ groups, while presenting lucrative re-publication opportunities to both sides that could only be obtained through author/publisher cooperation.

2004]

TASINI *AND ITS PROGENY*

461

number and complexity of such disputes, as well as the need for judicial intervention in such matters. Such progress will assure widespread digital re-publication and increased digital dissemination of printed copyrighted works, all to the greater public good.