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Tasini Re Dux

By: Jim Astrachan

In a 2001 landmark decision of critical importance to writers and publishers, the United States Supreme Court held that revision privileges granted to publishers of collective works under Section 201(c) of the Copyright Act did not allow *The New York Times* to republish Jonathan Tasini's articles in an electronic database. Tasini was an independent contractor, or free-lance writer, and he had not assigned the copyright in his written works to his employer.

In pre-Tasini days, a publisher would buy a free-lancer's article and publish it in hard copy and online as a part of the day's newspaper or the month's magazine. That was legal. But many publishers would also place the article in an electronic database such as LexisNexis that was searchable for a fee. A searcher would pay for the article and not the entire newspaper or magazine in which the article appeared. Because under copyright law the copyright to a work created by an independent contractor – a freelance writer – does not belong to his employer unless the copyright is assigned in writing, a publisher-employer must obtain a license from the writer if it uses the free-lancer's work in a way that is beyond the scope of the license granted to the publisher by the free-lancer.

Section 201(c) of the Copyright Act allows a publisher to reproduce a work without any additional permission from the free-lancer in which the article is reproduced if the new work is a "revision to a collective work". Newspapers and magazines are collective works because they contain different works by many different authors. But if a database containing the free-lancer's article reproduces and distributes the article standing alone and not as part of the magazine or newspaper in which the article was first published and to which the author contributed his work, the copying is not authorized and it is considered to be copyright infringement. Or to put it another way, the author owns the copyright to the article and the newspaper owns the copyright to the collective work which comprises the article. Since the author has given the

newspaper a license, by virtue of Section 201(c) to include his article in the collective work, the Copyright Act gives the newspaper the privilege of revising the collective work and including the author's article in the revision. An electronic version of a day's newspaper is a revision.

Recently, the U.S. Court of Appeals for the 11th Circuit reversed and remanded an award in favor of the photographer, Jerry Greenberg, against The National Geographic Society. Greenberg, over the course of a number of years, had contributed his photographs for editions of the Society's well known magazine, *National Geographic*. His license provided that after *National Geographic* published his photo, all other rights in the copyright belonged to him.

The Society then published a collection of 30 CDs containing every issue of *National Geographic* published since 1888. An introductory animated sequence in one of the CDs ran 10 cover images and, unfortunately for everyone, one of those cover images was a photograph taken by Greenberg and earlier published in *National Geographic*.

Greenberg sued the Society, and others, alleging that this use in the introduction and the inclusion of his other photos in the CDs infringed his copyrights. The District Court dismissed Greenberg's suit on grounds that *National Geographic's* use of the photo was a privileged revision of a collective work. The Court of Appeals then reversed the District Court finding that the Magazine's use of Greenberg's photographs in the CDs created a new and infringing work and was not a privileged revision of a collective work under Section 201(c). On remand, the District Court awarded Greenberg judgment for infringement of his copyright.

All of this legal wrangling occurred before the Supreme Court decided Mr. Tasini's case, which decision set forth a little test to be applied by the Courts to determine whether or not a republication is a privileged revision under Section 201(c).

Following Tasini and soon after Greenberg was awarded damages, the Second Circuit decided a case based on facts very similar to the Greenberg – *National Geographic* case and with some or all of the same defendants that Greenberg sued. Applying the test set forth by the Supreme Court in Tasini the Second Circuit held that the CD collection there at issue, very similar in nature to the one published by the Society containing Greenberg's photo, was indeed a privilege revision under Section 201(c).

Greenberg then became one of those unfortunate plaintiffs for whom decisions bear his name and are followed by a Roman numeral. In Greenberg II, the Eleventh Circuit, based on the Second Circuit's decision, overruled Greenberg I, distinguishing the searchable database that Tasini had sued over from *National Geographic's* CD

library, but only so far as the photos were used in the reproduction of the actual issues of the magazines.

Citing *Tasini*, the Court stated that the relevant question was whether the original context of the collective work had been presented in the revision, holding “[c]learly the replica portion of the [collection] preserves the original context of the magazines, because it comprises the exact images of each page of the original magazines.”

The Court would not rule that the introductory sequence of the 10 covers was a privileged revision and remanded the case yet again to the District Court to decide whether the introductory sequence violates Greenberg’s copyright. To Mr. Greenberg’s chagrin, it is likely there will be a *Greenberg III*.

Tasini was hardly the panacea that free-lance writers had hoped for. By making the use of a writer’s articles infringing if added to a database such as LexisNexis, publishers soon enacted stricter rules governing the submission of articles by free-lancers. In many instances those publishers demand that the writer convey the desired rights or the article would not be used. Although I haven’t thought about this for a while, it might be time for me to dust off my columnist’s contract.

James B. Astrachan is the author of The Law of Advertising, published by Matthew Bender-Lexis/Nexis.