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Faulkner V. National Geographic's Effect On Author's Rights In Electronic Transfer

Allison Hundstad
University of Richmond

FAULKNER V. NATIONAL GEOGRAPHIC'S EFFECT ON AUTHOR'S RIGHTS IN ELECTRONIC TRANSFER

*Allison Hundstad**

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I. INTRODUCTION

[1] Technological advances have triggered constant evolution in copyright law.[1] As the Internet and computers have allowed images and written works to be available with the click of a button, Congress and the courts have been faced with the task of reshaping copyright law in order to determine the digital rights of material that already has copyright protection in its print form, with the goal of reducing the uncertainty surrounding the ownership of the right to reproduce these materials in a digital format.

[2] Publication of literary works has been subject to copyright protection in the United States since the inception of the Constitution. The Constitution grants Congress the power "to 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."[2] While the effect of copyright law is to secure rights for the author to profit from his or her work, the Supreme Court has acknowledged that the ultimate aim of copyright law is to provide an incentive to "stimulate artistic creativity" that will benefit the public good.[3] Copyright laws reflect a balance between encouraging and

*University of Richmond, T.C. Williams School of Law, J.D. candidate 2008. The author would like to thank Brian Kirby, Mike Clements, and Professor James Gibson for their thoughts and suggestions during the editing of this article.

[1] Sony Corp. of Am. v. Universal City Studios, Inc., 464 U.S. 417, 430-31 (1984).

[2] U.S. CONST. art. I, § 8, cl. 8 (emphasis added).

[3] Twentieth Century Music Corp. v. Aiken, 422 U.S. 151, 156 (1975).

rewarding the innovation of creative work on one hand and "promoting public availability of literature" and other artistic work on the other.[4] In recent years, this balancing act has focused on how copyright ownership should be treated when transferring original print versions of photographs and articles into new electronic mediums.

[3] In March 2005, the Second Circuit held, in *Faulkner v. National Geographic Enterprises, Inc.*, that publication of a digital archive was a "privileged revision" of the publisher's previously sanctioned print product.[5] The court relied upon the Supreme Court's decision in *New York Times Co. v. Tasini*[6] that section 201(c) of the Copyright Act of 1976[7] allows a revision of a collective work containing a freelance author's work, provided that the work is placed in the same context as it was in the original.[8] This note argues that the Second Circuit, in *Faulkner*, properly interpreted and applied the test set forth by the Supreme Court in *Tasini*.

A. Scope and Purpose

[4] This note will have three main focuses. First, it will survey the historical jurisprudence surrounding copyright law as it pertains to collective works. Second, this note will examine whether the *Faulkner* court used the correct standard for finding whether copyright infringement took place. Finally, the note will conclude by focusing on the broader effect *Faulkner* may have on copyright law in the digital age.

B. A Historical Survey of Copyright Law Governing Collective Works

1. Legislative Definition of "Collective Work"

[5] According to the Copyright Act, a collective work is a "work, such as a periodical issue, anthology, or encyclopedia, in which a number of

[4] *Id.*
[5] Faulkner v. Nat'l Geographic Enters., Inc., 409 F.3d 26, 38 (2d Cir. 2005), *cert. denied*, 126 S. Ct. 833 (2005).
[6] New York Times Co. v. Tasini, 533 U.S. 483 (2001).
[7] Copyright Act of 1976, 17 U.S.C. § 201(c) (2004).
[8] *Faulkner*, 409 F.3d at 35 (citing *Tasini*, 533 U.S. at 488).

contributions, constituting separate and independent works in themselves, are assembled into a collective whole."[9] Most magazines and newspapers qualify as collective works, because, unlike a typical book, they are the product of multiple authors and photographers. The "copyright in each separate contribution to a collective work is distinct from the copyright in the collective work as a whole and [is vested] in the author of the contribution."[10] To constitute a separate contribution to a collective work, "each contribution to the collective work [must be able to] stand apart from the collective work and have some value."[11] Under Section 201(c) of the Copyright Act,[12] unless the owner of the copyright in a contribution and the owner of the copyright in the collective work expressly agree otherwise, the latter is presumed to "only acquire 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."[13] The publisher of a collective work only has a copyright in the original creative elements (i.e., selection, arrangement, editing, etc.) that it adds to the underlying contributions.[14]

[6] Section 201(c) was enacted to reduce the risk of individual authors inadvertently "surrendering all rights in a contribution to a collective work."[15] Congress passed Section 201(c) to expand the rights of authors; "when in doubt, courts should construe the rights of publishers narrowly in relation to those of authors."[16]

[9] 17 U.S.C. § 101.
[10] *Id.* § 201(c).
[11] Blum v. Kline, No. 86-8149 (JFK), 1988 U.S. Dist. LEXIS 4424, at *5 (S.D.N.Y. 1988) (discussing 17 U.S.C. § 201(c)).
[12] 17 U.S.C. § 201(c).
[13] *Id.*
[14] H.R. REP. NO. 94-1476, at 122 (1976), *reprinted in* 1976 U.S.C.C.A.N 5659, 5738; MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 3.04[B][2] (perm. ed., rev. vol. 2006).
[15] Tasini v. New York Times Co., 972 F. Supp. 804, 815 (S.D.N.Y. 1997), *reh'g denied*, 981 F. Supp. 841 (S.D.N.Y. 1997), *rev'd*, 206 F.3d. 161 (2d Cir. 2000), *aff'd*, 533 U.S. 483 (2001).
[16] Ryan v. CARL Corp., 23 F. Supp.2d 1146, 1150 (N.D. Cal. 1998).

2. JUDICIAL AUTHORITY FOR COPYRIGHT LAW GOVERNING COLLECTIVE WORKS

[7] Recently, courts have attempted to determine whether an the author's individual copyright for a contribution is infringed when the publisher revises a collective work or puts it in a new medium. It is clear that copyright infringement takes place when individual articles from a collective work are photocopied because they are not reproduced "as part" of the collective work.[17] Under Section 201(c), it is also undisputed that a publisher has the authority to "reprint a contribution from one issue in a later issue of its magazine . . . ."[18] The public, including publishers, is also free to copy or otherwise use any contribution in a collective work that is in the public domain.[19]

[8] While a publisher is not allowed to include a contribution in an entirely different magazine or other collective work,[20] copyright infringement of an individual contribution becomes harder to identify when an entire collective work is transferred from its original format to a digital database or collection.

A. *GREENBERG V. NATIONAL GEOGRAPHIC SOCIETY*

[9] In 2001, before the *Tasini* decision,[21] the Eleventh Circuit ruled in favor of a freelance photographer in *Greenberg v. National Geographic*

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[17] *Id.* at 1149.

[18] *Id.* at 1149-50 (citing H.R. REP. NO. 94-1476, at 122).

[19] 17 U.S.C. § 103(b) (2004); *see also* Waldman Publ'g Corp. v. Landoll, Inc., 43 F.3d 775, 782 (2d Cir. 1994) (holding that, with regard to derivative work based on underlying work that is in the public domain, only the material added to the underlying work is protected by copyright law).

[20] H.R. REP. NO. 94-1476, at 122-23; *see* Greenberg v. Nat'l Geographic Soc'y, 244 F.3d 1267, 1273 (11th Cir. 2001) (citing H.R. REP. NO. 94-1476, at 122-23).

> Under the language of [§ 201(c)] a publishing company could reprint a contribution from one issue in a later issue of its magazine, and could reprint an article from a 1980 edition of an encyclopedia in a 1990 revision of it; the publisher could not revise the contribution itself or include it in a new anthology or an entirely different magazine or other collective work.

H.R. REP. NO. 94-1476, at 122-23.

[21] *Tasini*, 533 U.S. at 483.

Society[22] on issues strikingly similar to those presented to the Second Circuit in *Faulkner*. Plaintiff Jerry Greenberg was a freelance photographer who had taken pictures for the National Geographic Society (hereinafter "the Society") four times over a period of thirty years.[23] While the terms of Greenberg's original contract for the first three sets of photos gave all rights for the pictures to the Society, the Society reassigned the copyrights to Greenberg in 1985. The contract for the final set of photos returned the copyright to Greenberg sixty days after publication.[24] Beginning in 1996, the Society entered into an agreement with Mindescape, Inc. to develop "The Complete National Geographic" (CNG).[25] The CNG was a collection of every issue of *National Geographic Magazine* from 1888 to 1996 on CD-ROM. The Society scanned every page of the magazine to create the digital format.[26]

[10] Greenberg sued the Society for copyright infringement, alleging that the magazine could not use his copyrighted photographs in the CNG without his permission.[27] The Society claimed that it had a privilege under Section 201(c) to create the CNG as a "revision" of the original version of the Magazine.[28] The Eleventh Circuit disagreed with the Society and held that certain elements of the CNG—namely the introduction to the CD-ROM and the database's search capability—made the digital archive an "entirely different magazine or other collective work" and not a mere revision or reproduction.[29] According to the court, the Society had "created a new product ('an original work of authorship') in a new medium, for a new market that far transcended any privilege of revision or other mere reproduction envisioned in Section 201(c)."[30]

[22] *Greenberg*, 244 F.3d. at 1267.
[23] *Id.* at 1269.
[24] *Id.*
[25] *Id.*
[26] *Id.*
[27] *Id.* at 1270.
[28] *Id.*
[29] *Id.* at 1273-74.
[30] *Id.* at 1273.

B. *NEW YORK TIMES CO. V. TASINI*

[11] The Supreme Court took a dramatic step away from *Greenberg*[31] a few months later in *Tasini*.[32] A group of freelance authors sued the publications to which they had contributed (including the *New York Times*) for violating the Copyright Act by selling their articles to online databases such as LEXIS/NEXIS.[33] LEXIS/NEXIS and other electronic databases entered into licensing agreements with the publishers of numerous magazines and newspapers to create a database from which a reader could search for and retrieve articles.[34] The reader would see the text "in isolation, clear of the context of the original print publication presented."[35]

[12] The *Tasini* Court held that electronic databases that pull articles from multiple periodicals did not constitute a "revision" of a collective work within the meaning of Section 201(c) of the Copyright Act when the articles were retrievable as stand-alone text out of their original context.[36] The Court reasoned that, because the copyright in a collective work only covers the creative material that the publisher adds to the preexisting works,[37] "[the Court could not] see how the Database perceptibly reproduces and distributes the article 'as part of' either the original edition or a 'revision' of that edition."[38] The Court mentioned that merely reproducing the works in a new medium, such as the database, would not de facto constitute infringement; microfilm and microfiche do not infringe on author's rights because they keep the entire periodical intact when converting from one medium to another.[39] Consequently, to avoid a copyright violation, a publisher must reproduce an author's work in the same environment as it appeared in the original publication (i.e.,

[31] *Id.*
[32] New York Times v. Tasini, 533 U.S. 483 (2001).
[33] *Id.*
[34] *Id.* at 489.
[35] *Id.*at 487.
[36] *Id.* at 488.
[37] *Id.* at 494 (citing 17 U.S.C. § 103(b)); Feist Publications, Inc. v. Rural Telephone Service Co., 499 U.S. 340, 358 (1991) (citing 17 U.S.C. § 101) (holding that copyright in 'compilation'—a term that includes 'collective works,'—is limited to the compiler's original 'selection, coordination, and arrangement').
[38] *Id.* at 500.
[39] *Id.* at 501-502.

surrounded by the same advertisements, articles, and photographs) unless it has the author's express permission to reproduce the work differently.[40]

[13] After *Tasini*, electronic databases were required to delete articles that were written by freelance authors for which they did not secure the rights from the individual author.[41] If the article was not removed, the author could recover "statutory damages" and attorney's fees. While each settlement would not be very large, the cumulative effect could be financially disastrous for electronic databases and publishers.[42] Ironically, many freelancers who would want their work in an electronic database are also being removed.[43] It seems that print publishers are barred from reproducing individual articles that have appeared in their publication or authorizing excerpts of the publication to be used elsewhere.[44]

[14] A few years after the Supreme Court seemed to overrule *Greenberg*[45] with its holding in *Tasini*,[46] the Second Circuit, in *Faulkner v. National Geographic*,[47] decided whether it was possible to display a collective work in a digital archive or database without violating the Copyright Act.[48]

II. THE FACTS OF *FAULKNER*

[15] *Faulkner*[49] is based on facts similar to those presented in *Greenberg*.[50] The plaintiffs were a group of freelance photographers and authors who contributed photographs and/or written works to be published in a number of issues of *National Geographic Magazine*.[51] The assembly of photographers and authors sued the magazine for copyright

[40] *See e.g. Tasini*, 533 U.S. 483.
[41] Alexander Lindey & Michael Landau, *The Importance of Obtaining Rights for New Media*, *in* 1 LINDEY ON ENTERTAINMENT, PUBLISHING AND THE ARTS § 1:33 (3d ed. 2006).
[42] *Id.*
[43] *Id.*
[44] *Id.*
[45] Greenberg v. Nat'l Geographic Soc'y, 244 F.3d 1267 (11th Cir. 2001).
[46] New York Times v. Tasini, 533 U.S. 483 (2001).
[47] Faulkner v. National Geographic Enters., Inc., 409 F.3d 26, 29 (2d Cir. 2005).
[48] *Id.*
[49] *Id.*
[50] *Greenberg*, 244 F.3d 1267.
[51] *Faulkner*, 409 F.3d at 29.

infringement for placing their works in "The Complete National Geographic" (CNG), a digital archive of previous issues of the magazine that allows users to search and view pages from the issues.[52] The CNG was produced by digitally scanning each issue of the magazine two pages at a time so that the CNG user could see the magazine in exactly the same way he or she would if looking at the paper version.[53] The digital version included all "text, photographs, graphics, advertisements," etc. that surround the article or photograph.[54] "The individual images and texts are therefore viewed in a context almost identical—but for the use of a computer screen and the power to move from one issue to another and find various items quickly—to that in which they were originally published."[55] A search engine on the CD-ROM allows a user to find articles by searching for "certain words or phrases or a description of the article, such as title, author, date, or subject."[56] The digital archive also allows users to "focus on particular pages or portions of pages."[57] The Society registered the CNG with the Copyright Office stating that the "CNG is a 'compilation of a pre-existing material primarily pictorial' and that additional material added to it is a 'brief introductory audiovisual montage.'"[58] The End User License Agreement allowed users to "modify and publish the Images as [they wished]" and "incorporate any Image(s) into your own original work and publish, display and distribute your work in any media."[59]

[16] The plaintiffs claimed that Section 201(c) of the Copyright Act[60] guaranteed each author or photographer the individual copyright to each of his or her contributions to the magazine, and that the CD-ROM archive was an unauthorized reproduction of those works.[61] As discussed above, Section 201(c) provides that each separate contribution in a collective

[52] *Id.*
[53] *Id.* at 30.
[54] *Id.* at 31.
[55] *Id.*
[56] *Id.*
[57] *Id.* at 38.
[58] *Id.* at 32.
[59] *Id.*
[60] Copyright Act of 1976, 17 U.S.C. §201(c) (2004).
[61] *Faulkner,* 409 F.3d at 34.

work is distinct from the copyright in the collective work as a whole and is vested in the author unless it is expressly transferred.[62]

[17] The trial court found that the CNG was a "privileged revision under Section 201(c)" and the Second Circuit affirmed.[63] The Second Circuit held that, "because the original context of the Magazines is omnipresent in the CNG and because it is a new version of the Magazine, the CNG is a privileged revision."[64] The following section discusses the appellate court's rationale.

III. ANALYSIS

A. THE *FAULKNER* DECISION

[18] The Second Circuit determined whether the district court was correct in applying the *Tasini* rule[65] instead of the *Greenberg* holding.[66] Because *Greenberg* was decided before *Tasini*, the *Greenberg* court did not consider the *Tasini* rule to determine whether the CNG was a privileged revision under Section 201(c).[67] The *Faulkner* court followed *Tasini* because that intervening Supreme Court decision substantially departed from *Greenberg* so as to change the legal landscape.[68] While *Greenberg* held that, "if a subsequent work contains independently copyrightable elements not present in the original collective work, it cannot be a revision privileged by Section 201(c),"[69] the *Tasini* approach focuses on "whether the underlying works were presented by the particular database in the context of the original works."[70]

[19] Applying the standard set out in *Tasini*, the Second Circuit correctly found that copyright infringement did not take place.[71] The court held

[62] *Id.* at 34 (citing 17 U.S.C. § 201(c)).
[63] *Id.* at 30.
[64] *Id.* at 38.
[65] New York Times v. Tasini, 533 U.S. 483 (2001).
[66] *Faulkner*, 409 F.3d at 30.
[67] *Id.* at 36.
[68] *Id.* at 37.
[69] *Faulkner*, 409 F.3d at 37 (citing *Greenberg*, 244 F.3d 1267); 17 U.S.C. §201(c).
[70] *Faulkner*, 409 F.3d at 37 (citing *Tasini*, 533 U.S. 483).
[71] *Id.* at 30.

that, because the original context of the magazine was "omnipresent" in the CNG, it was a new *version* of the magazine and not, as found in *Greenberg*, a new collective work.[72] Consequently, the court held that the CNG was a privileged revision under Section 201(c), and, since the publisher had the right to create a revision of the collective work, copyright infringement did not take place.[73] A permissible revision can contain elements of the individual work at issue, such as the introduction and search capability of the CNG, that are not found in the original publication of the work.[74] Since the CNG is a privileged revision, the freelance authors and photographers are not entitled to additional payment for their works' inclusion in the CD-ROM archive.

[20] The *Faulkner* decision seems contrary to Congress's purpose in creating the Copyright Act of 1976. As the court in *Faulkner* pointed out:

> Prior to the Copyright Act of 1976, authors risked losing all rights in their underlying works when they allowed such works to be used in a collective work. To address this concern, the 1976 Act contained Section 201(c) and, in other provisions, "expressly permitted the transfer of less than the entire copyright . . . ."[75]

As part of the Copyright Act of 1976, Congress enacted Section 201(d), which allows one's copyright to be transferred "*in whole or in part*."[76] Congress intended for the act to do "'nothing to change the rights of the owner of copyright in a collective work' but [to] merely clarify and improve an unfair legal situation by preserving an author's copyright in a contribution."[77] Instead of looking to Section 201(d)(1) to provide more rights to freelance contributors by allowing them to transfer part of their copyright while retaining the rights to the rest, the *Faulkner* court focused

[72] *Id.* at 38.
[73] *Id.*
[74] *Id.* (citing Tasini v. New York Times Co., 206 F.3d 161, 167 (2d Cir. 2000) (holding that Section 201(c) "protects the use of an individual contribution in a collective work that is somewhat altered.")).
[75] *Id.* at 39 (quoting *Tasini*, 206 F.3d at 168); *see* 17 U.S.C. § 201(d).
[76] *Id.* (quoting 17 U.S.C. § 201(d)(1)) (emphasis added).
[77] *Id.* (quoting H.R. REP. NO. 94-1476, at 122 (1976), *reprinted in* 1976 U.S.C.A.A.N. 5659, 5738).

on Section 201(d)(2), which authorizes "owners of '[a]ny of the . . . rights . . . [sic] in a copyright' to transfer such rights. Therefore, publishers may transfer any subdivision of a copyright that they acquire."[78]

[21] After *Tasini* and *Faulkner*, an author will *not* be able to expect extra payment when his or her works are placed in digital archives that retain the context of the original work.[79] However, he or she will be able to insist on payment when the publisher sells his or her work to a digital database (such as LEXIS/NEXIS) that does not retain the context of the original work.[80]

B. THE FUTURE EFFECTS OF *FAULKNER*

[22] Two of the issues in determining the potential impact of *Faulkner* on copyright are (1) the possible effects on the ability of publishers to place contributions to a collective work on new electronic databases, and (2) whether the effects of *Faulkner* can be mitigated through contracts.

1. NEW THREATS IN THE DIGITAL AGE AFTER *FAULKNER*

[23] In *Greenberg*, *Tasini*, and *Faulkner*, courts decided whether authors had to be compensated for placing their works that had previously been published as part of a collective work into digital or online databases.[81] The digital revolution, especially the Internet, has posed new threats to authors' control of their copyrights.

A. GOOGLE PRINT: A NEW ONLINE DATABASE

[24] Since the time of the Ancient Greeks, there has been an age-old desire to create a universal library containing every work ever written.[82] However, "the constant expansion of information has overwhelmed our

[78] *Id.* (quoting 17 U.S.C. § 201(d)(2)); *see* Tasini v. New York Times Co., 972 F. Supp. 804, 815-16 (S.D.N.Y. 1997) (holding subdivisions of copyrights transferable), *rev'd on other grounds*, 206 F.3d 161 (2d Cir. 2000).
[79] *See supra* text accompanying notes 71-75.
[80] *See supra* text accompanying notes 36-41.
[81] *See supra* Parts I, III.A.
[82] *See* Kevin Kelly, *Scan This Book!*, N.Y.TIMES, May 14, 2006, § 6.

capacity to contain it . . . [u]ntil now."[83] In December 2004, Google, operator of the widely used Internet search engine,[84] announced that it would digitally scan books to make them searchable online.[85] The Author's Guild and five large publishers responded to the announcement by suing Google for copyright infringement.[86]

[25] Google has reached contractual agreements with a number of public and university libraries to create digital "archives" of the libraries' book collections through its "Google Print" program.[87] Google Print is also working with publishers to allow searches involving their books.[88] As part of the agreement, Google is permitted to duplicate and retain for its own *commercial use* a digital copy of the libraries' archive.[89] Google then plans to reproduce the works on its website to attract visitors and generate advertising revenue.[90]

[26] On the Google Print website, Google claims that it has partnered with publishers and libraries to create "[a]n online book marketing program designed to help publishers and authors promote their books by showing you a limited number of sample pages."[91] The site allows the user to search book content in a similar fashion to Google.com's search of webpages, returning snippets, sample pages, and/or full book views of books whose content matches the user's search terms.[92] Google Print will allow a viewer to read books from the public domain in their entirety and,

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[83] *Id.*
[84] Google Home Page, http://www.google.com/ (last visited May 28, 2006).
[85] *See* Kelly, *supra* note 82.
[86] *Id.* at 6.
[87] Class Action Complaint ¶ 2, Author's Guild v. Google Inc., No. 05-CV8136, 2005 WL 2463899 (S.D.N.Y. Sept. 20, 2005); *see also* Google Book Search, http://books.google.com/support/bin/answer.py?answer=43740 (providing names of some libraries partnering with Google) (last visited May 28, 2006).
[88] *See* Jonathan Band, *The Google Print Library Project: A Copyright Analysis*, http://www.policybandwidth.com/doc/googleprint.pdf (last visited May 28, 2006).
[89] Class Action Complaint ¶ 2, Author's Guild v. Google Inc., No. 05-CV8136, 2005 WL 2463899 (S.D.N.Y. Sept. 20, 2005).
[90] *Id.* ¶ 4.
[91] About Google Book Search, http://books.google.com/googleprint/about.html (last visited May 28, 2006).
[92] Google Book Search, *supra* note 87.

for books that are still under copyright, Google will let publishers decide which portion of the book users will be able to view.[93] Google states that the search is a free online book-marketing and sales program that will get authors' books in the hands of interested readers so that they can purchase them.[94] Google protects the books by not allowing users to copy, save, or print the content.[95]

[27] The Author's Guild, an organization of book authors that, among other things, works to protect literary copyrights, has filed suit to challenge the venture.[96] The Guild claims that by reproducing and using a copy of books that are not in the public domain, Google is infringing upon the rights of the copyright holders.[97] The plaintiffs argued that Google is violating Section 101 of the Copyright Act, which requires anyone wishing to reproduce digital copies of a work to obtain authorization from the holders of the copyrights.[98]

[28] In its answer to the complaint, Google stated that (1) it has a fair use defense under Section 107 of the Copyright Act because it is only displaying a small portion of the books, and (2) it has received licenses to scan, copy, and/or display some or all of the various authors' work.[99] The fair use doctrine allows, among other things, reproduction for the purpose of "criticism, comment, news reporting, teaching…scholarship or research."[100] The Guild argued that it is infringement because, while Google Print only shows small portions of a book, the search technology cannot function properly without a digital copy of the entire work.[101]

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[93] Kelly, *supra* note 82.
[94] Google Print Partner Program, http://books.google.com/googlebooks/publisher.html (last visited May 28, 2006).
[95] *See id.*
[96] Class Action Complaint ¶ 1, Author's Guild v. Google Inc., No. 05-CV8136 (S.D.N.Y. Sept. 20, 2005), 2005 WL 2463899.
[97] Class Action Complaint ¶ 3, Author's Guild v. Google Inc., No. 05-CV8136 (S.D.N.Y. Sept. 20, 2005), 2005 WL 2463899.
[98] Class Action Complaint ¶ 5, Author's Guild v. Google Inc., No. 05-CV8136 (S.D.N.Y. Sept. 20, 2005), 2005 WL 2463899 (citing 17 U.S.C. § 101 (2000)).
[99] Answer, *Author's Guild v. Google, Inc.*, No. 05-CV8136, 2005 WL 3309666, ¶ 53 (S.D.N.Y. 2005); *see also* Tim O'Reilly, *Search and Rescue*, N.Y. TIMES, Sept. 28, 2005, at A27.
[100] 17 U.S.C. § 107 (2000).
[101] O'Reilly, *supra* note 99.

[29] Google Print is not the only online program that allows a user to search the content of books. In October 2003, Amazon, an online retailer, unveiled "Search Inside the Book."[102] Using this program, anyone can search and view the *full* text of over 120,000 books.[103]

[30] While the possible decision in *Author's Guild v. Google* and any litigation based on "Search Inside the Book" are outside the scope of this casenote, their possible effects on collective works are not. While Google Print does not yet accept magazines,[104] it is possible that it will in the future, creating a digital archive similar to the one at issue in *Greenberg* and *Faulkner*. In accordance with Section 106 of the Copyright Act, Google Print claims that those authorizing the posting of the books must be the copyright holders and that they can rescind their consent at any time.[105] In *Tasini*, the Supreme Court held that placing just the text of an article into an electronic database violated a freelance author's copyright ownership rights.[106] Following *Faulkner*, a publisher can authorize reproduction of the print version of its magazine into a digital format as long as the information remains in its original context.[107] Therefore, a publisher may be able to authorize reproduction of articles from their magazine on Google Print without permission of the individual authors, provided that the articles remain in their original context in Google Print.

[31] Google Print has the potential to have the same search capability as the Complete National Geographic, but with every magazine available and as a free service. Such a program would further reduce authors' ability to control their copyright if their publishers authorize Google Print to make whole articles available, which they would have to do in order to keep the

[102] Jonathan Kerry-Tyerman, *No Analog Analogue: Searchable Digital Archives and Amazon's Unprecedented Search Inside the Book Program as Fair Use*, 2006 STAN. TECH. L. REV. 1.
[103] *Id.*
[104] Google Book Search Help Center, http://books.google.com/support/partner/bin/answer.py?answer=18625&topic=322&hl=en_US (last visited May 28, 2006).
[105] 17 U.S.C. § 106 (2000) (stating that the owner of the copyright has the *exclusive* right to reproduce copies of or publicly display the copyrighted work); Google Book Search Help Center, *supra* note 87.
[106] New York Times Co. v. Tasini, 533 U.S. 483, 506 (2001).
[107] Faulkner v. Nat'l Geographic Enterps., 409 F.3d 26, 38 (2d Cir. 2005).

articles in full context, which is a requirement for Section 201(a) revisions under *Tasini* and *Faulkner*.

B. INTERNET SITES FOR NEWSPAPERS AND MAGAZINES

[32] With the increasing popularity of the Internet, newspapers, such as the *New York Times*,[108] and magazines, such as *TIME*,[109] have created websites that allow users to read the content of their publications. While *Tasini* and *Faulkner* restrict publishers' ability to sell their content to electronic databases, the next court battle between freelancers and publishers is likely to be over the Internet.[110] The Internet version of a work does not meet the *Tasini* test if it fails to show the work in its original context.[111] The Internet version of a newspaper or magazine may include articles, pictures, and/or advertisements that are not found in the original collective work, and sound and video can be added to the Internet version that were not part of the print version.[112]

[33] Once the article is in a digital form, it "no longer possesses boundaries" and can be copied and distributed through, inter alia, e-mail and postings.[113] While the Internet is intended to cultivate creativity by providing vast amounts of information, copyright holders need to be compensated when their works are viewed or used.[114]

c. CONTRACTS

[34] Contract law plays an important role in determining whether the licensee or assignee of a copyright has the right to distribute an author's

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[108] *The New York Times*, http://www.nytimes.com/ (last visited May 28, 2006).
[109] *TIME*, http://www.time.com/time/ (last visited May 28, 2006).
[110] Laurie A. Santelli, Notes and Comments, *New Battles Between Freelance Authors and Publishers in the Aftermath of Tasini v. New York Times*, 7 J.L. & POL'Y 253, 298 (1998).
[111] *Id.* "The publication of a periodical on the Internet or the Web does not constitute a 'recognizable . . . version of [the] preexisting collective work' as required by the Tasini court to be a Section 201(c) revision privilege." *Id.* (quoting Tasini v. New York Times Co., 972 F.Supp. 804, 820 (S.D.N.Y. 1997)).
[112] *Id.* at 299.
[113] Thomas K. Landry, *Columbia-VLA Journal of Law & the Arts Roundtable on Electronic Rights*, 20 COLUM.-VLA J.L. & ARTS 605, 624 (1996).
[114] *See id.* at 660.

work using a new technology. In *Bartsch v. Metro-Goldwyn-Mayer*, the Second Circuit held that a "licensee may properly pursue any uses which may reasonably be said to fall within the medium as described in the license."[115] Courts are not oblivious to the fact that "unlike real property and other forms of personal property, [a copyright] is by its very nature incapable of accurate monetary evaluation prior to its exploitation."[116] However, in *Boosey & Hawkes Music Publishers v. Walt Disney Co.*, the Second Circuit stated:

> 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.[117]

Therefore, while courts recognize the fact that an author stands to profit from new technologies, they also acknowledge that he or she can lose that right through contracts.

[35] In *Tasini*, the Supreme Court addressed the fear that its ruling would create an injunction against the inclusion of freelance authors' works in electronic databases and "punch gaping holes in the electronic record of history."[118] The Court's solution was to allow authors and publishers to enter into contracts that allow the publisher to electronically reproduce the authors' works because Section 201(c) governs only in the absence of an express agreement between the parties.[119] An author can agree to assign or license the digital rights to his or her publisher, so that the publisher would have the right to reproduce and distribute the copyrighted work by

[115] Bartsch v. Metro-Goldwyn-Mayer, Inc., 391 F.2d 150, 155 (2d Cir. 1968) (citing MELVILLE B. NIMMER, THE LAW OF COPYRIGHT § 125.3 (1964)).
[116] MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 9.02 (2006).
[117] Boosey & Hawkes Music Publishers, Ltd. v. Walt Disney Co., 145 F.3d 481, 487 (2d Cir. 1998).
[118] New York Times Co. v. Tasini, 533 U.S. 483, 505 (2001).
[119] *Id.*

copying it to an electronic database.[120] Authors can also use contracts to protect their copyrights. One photographer's contributions to *The National Geographic* were not included in the district court's ruling, because there was "contractual language expressly denying [the] N[ational] G[eographic] S[ociety] any electronic rights."[121] Congress could also step in and modify the Copyright Act to vest ownership of the electronic rights of a work in an entity other than the work's author in the absence of an express agreement.[122]

[36] Publishers can avoid the *Tasini* ruling by using "all rights" contracts that include coverage for all possible new technologies.[123] "All rights" contracts require a writer to surrender all of his or her copyrights for the work to the publisher.[124] The *New York Times*, for example, requires all freelance contributors to give the newspaper all rights to his or her work by an express written agreement.[125] Publishers can also use "time period" contracts to secure the exclusive right to copy a work for a given period of time, after which the copyright is returned to the author.[126] During the time period covered by the contract, the publisher can reproduce the work online or sell the work to an electronic database without obtaining the author's permission.[127] For example, in *Greenberg*, the fourth contract that the freelance photographer negotiated with the National Geographic Society qualified as a time period contract because all rights in the work returned to Greenberg 60 days after publication.[128] Finally, publishers can use "payment contracts" to compensate freelance contributors for past, present and future electronic uses.[129]

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[120] *See* 17 U.S.C. § 106 (2000); *see also* Robert P. Merges, *Contracting into Liability Rules: Intellectual Property Rights and Collective Rights Organizations*, 84 CAL. L. REV. 1293 (1996) (providing conceptual guidance for intellectual property rights).
[121] Faulkner v. Nat'l Geographic Enterps., 409 F.3d 26, 41 (2d Cir. 2005) (citing Faulkner v. Nat'l Geographic Soc'y, 294 F. Supp. 2d 523, 531 n.30, 549 (S.D.N.Y. 2003)).
[122] *See* Frank H. Smith, Comment, *Tasini v. New York Times Co.: A Copyright, or a Right to Copy?*, 32 NEW ENG. L. REV. 1093, 1125 (1998).
[123] *See* Michael A. Forhan, Note, *Tasini v. New York Times: The Write Stuff for Copyright Law?*, 27 CAP. U. L. REV. 863, 883-84 (1999).
[124] Santelli, *supra* note 110, at 278.
[125] Tasini v. New York Times Co., 972 F. Supp. 804, 807 n.2 (S.D.N.Y. 1997)
[126] Santelli, *supra* note 110, at 280.
[127] *Id.*
[128] *See* Greenberg v. Nat'l Geographic Soc'y, 244 F.3d 1267, 1269 (11th Cir. 2001).
[129] Santelli, *supra* note 110, at 280.

[37] Assigning electronic rights through a contract can disadvantage writers by subjecting them to adhesion contracts that do not allow for negotiation with the publishers.[130] Writers might go along with the terms that the publisher provides, because they fear it is the only way to be published and paid.[131] Therefore, publishers can avoid the *Tasini* decision by using contracts to secure the right to republish an author's work in a new medium up front.

IV. CONCLUSION

[38] During a 2000 Senate hearing on the effect of the Internet on music copyright, Senator Orrin Hatch stated:

> [Copyright protection of works over the Internet] . . . must be secured in a manner which is mindful of the impact regulation can have on the free flow of ideas that a decentralized, open network like the Internet creates. We must protect the rights of the creator, but we cannot, in the name of copyright, unduly burden consumers and the promising technology that Internet presents to all of us.[132]

Although this quote refers to the electronic dissemination of music, its application extends to providing print copyrighted works in digital format. While it is important to reward those who produce creative works by giving them protective copyrights, the true purpose of copyright is to promote public availability. The holding in *Tasini* left the door open for a future court to find that a publisher could create an electronic database of a collective work containing work from freelance authors and photographers, provided that the works were placed in the same context as they were in the original print version.

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[130] Forhan, *supra* note 123.

[131] *Id.* at 884; *see* Santelli, *supra* note 110, at 279-80. "Ultimately, freelancers must choose between signing the agreement and receiving a paycheck or asserting their rights and going hungry. That these two choices sit at such extremes illustrates the freelancers' lack of contract bargaining power with publishers." *Id.*

[132] *Music on the Internet: Is There an Upside to Downloading?: Hearing Before the S. Comm. on the Judiciary*, 106th Cong. 2 (2000) (statement of Sen. Orrin Hatch, Chairman, S. Comm. on the Judiciary).

[39] Since the Second Circuit decided *Faulkner* by correctly following the Supreme Court's test for finding copyright infringement, the case provides a guide for future litigation based on electronic databases like Google Print and Search Inside the Book. Publishers who wish to have the right to place their collective works into electronic databases have several options. First, freelancers and publishers can negotiate contract terms that include turning over electronic rights to the publisher, so that publishers do not have to consider *Faulkner* or *Tasini* when authorizing the use of a collective work in a database. Second, publishers can also compensate authors for putting their works in an electronic database. Finally, publishers can follow the Complete National Geographic example in *Faulkner* and copy entire pages into the database for context, thus escaping any liability under *Tasini*.

[40] Although the holding in *Faulkner* does shrink authors' rights to control their contributions to collective works, it also furthers the ultimate goal of copyrights – to provide information to the public in order to promote progress.