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ELECTRONIC RIGHTS AFTER TASINI
An Assessment

by Lawrence Savell

The August 13 decision by United States District Judge Sonia Sotomayor in Tasini v. The New York Times Co. represents an important and deserved victory for editors and publishers in terms of electronic rights to articles by freelance writers. But the Tasini ruling does not eliminate the value and security of having written contracts with freelancers, and of including within those contracts provisions clearly and comprehensively granting publishers the rights they desire.

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The Tasini Decision

In Tasini, the Court ruled that, under federal copyright law, publishers are entitled to place the contents of their periodicals into electronic data bases and onto CD-ROMs without first securing the permission of (or paying additional compensation to) the freelance writers whose contributions are included in those periodicals.

The Court rejected the claims of the plaintiff freelance journalists that such practice infringed the writers' copyrights. Instead, it agreed with the defendant publishers and electronic service providers that they had permissibly reproduced the plaintiffs' articles as part of electronic "revisions" of "collective works" -- the newspapers and magazines in which the articles originally appeared -- under the federal Copyright Act.

The Court thus granted the defendants' motion for summary judgment, dismissing the case without need for a trial.

Analysis

As one would expect, certain of the Tasini plaintiffs and writers' organizations have criticized the ruling against them. According to an August 14 "statement" by lead plaintiff and National Writers Union president Jonathan Tasini posted at the NWU web site (www.igc.apc.org/nwu/tvt/tvtstate.htm), "we feel confident that this decision will be overturned on appeal." Mr. Tasini also alleges that "this decision is quite narrow in its application to different media" and that "this case does not deal with other media such as the World Wide Web."

Although it is true that the plaintiffs' claims as advanced in their complaint were limited to use of their articles on electronic data

bases and CD-ROMs, and that legal decisions are generally limited to their facts, the groundbreaking Tasini ruling has strong publisher-favorable implications as an early test of the economic rights of freelancers and the application of copyright law to electronic publishing. While it is impossible to predict how other courts assessing other uses of freelance material in other circumstances will rule, publishers have clearly won the first round of what will likely be a long and fiercely-fought battle.

It will also likely be the case that both freelance writers and publishers will "mine" the language of the Tasini opinion for "nuggets" supporting their respective positions. For example, publishers seeking to include a particular technological innovation within the scope of a broad grant of rights will point to the decision's recognition that "when contract terms are broad enough to cover a new technological use, 'the burden of framing and negotiating an exception should fall on the grantor'" (in this situation, the freelance author). Freelance writers dealing with common grants of "first publication rights," however, will point to the ruling's subsequent statement that "[t]he right to publish an article 'first' cannot reasonably be stretched into a right to be the first to publish an article in any and all mediums."

Publishers looking to avail themselves of the protection afforded in the Tasini decision should keep in mind the Court's warning that "revisions" of "collective works" must not dramatically change the elements of "originality" the publishers initially contributed to such works. "Defendants are not permitted to place plaintiffs' articles into 'new anthologies' or 'entirely different magazine[s] or other collective works[s],' but only into revisions of those collective works in which plaintiffs' articles first appeared." If publishers "change the original selection and arrangement of their newspapers or magazines, . . . they are at risk of creating new works, works no longer recognizable as versions of the periodicals that are the source of their rights." Because "selecting materials to be included in a newspaper or magazine is a highly creative endeavor," "the subsequent work cannot differ in selection by 'more than a trivial degree' from the work that preceded it." (In Tasini, the electronic versions contained "the complete content of all the articles" from each periodical, although for most the photographs, captions, and page lay-outs were not preserved.) Thus, you should give serious thought before altering the selection (that is, deleting articles) or arrangement of the material in any "revision" of your periodical; the more you preserve such initial selection and arrangement, the more you maximize your protection under copyright law.

On a more positive note, the opinion points out that the relevant provision of the Copyright Act "contains no express limitation upon the medium in which a revision can be created" -- language which arguably opens the door to such forums as Internet web sites.

Get It In Writing

Despite the victory in Tasini, it is still the case that editors and publishers are best protected by having written contracts that clearly encompass the rights they need. Indeed, Tasini represents a situation where, according to the court, there were no effective contracts between the parties, and the publishers thus had to support their positions by resort to applicable provisions of the copyright law. Publishers looking to maximize their "comfort level" and litigation outcome predictability should strongly consider memorializing their understanding in the form of a written agreement.

Note that both Tasini and the need for such agreements only apply where the works of others than staff writers are involved. As the Tasini decision observed, there "[a]ll the plaintiffs wrote their articles on a freelance basis, and not as employees of the defendant publishers." This is because under the Copyright Act, if a work is created by an employee within the scope of his or her employment, the employer automatically owns all rights in the work. Thus, in such circumstances, no specific grant of rights is necessary.

Where freelancers are involved, editors and publishers can best protect themselves in one of two ways -- both of which usually require the assistance of a lawyer to draft the necessary paperwork.

The first way is to structure the arrangement with the author as a "work made for hire" under the Copyright Act. If an article is specifically ordered or commissioned for use in one of certain ways set forth in the Act, and if the parties agree in writing that the article is a "work made for hire," the person who commissioned the article owns all rights in it.

The second option is to have an agreement with the freelance writer which specifically grants "all rights" to the publisher. Such an agreement can be drafted in a variety of ways. Basically, it should provide that the writer assigns and sells to the publisher, and the publisher purchases from the writer all right, title, and interest in and to the article.

Beyond such broad "all rights" language, the agreement's provisions may also contain "including but not limited to" language, designed to maintain the broad scope but still enumerate certain examples of specific matters subsumed within that broad scope. One useful and comprehensive provision might note that the rights so granted "include but are not limited to" "the exclusive right to exercise, by the publisher or through third parties, the rights granted herein in any and all forms in which the article may be used, published, reproduced, distributed, performed, exhibited, displayed, or transmitted (including, but not limited to, electronic and optical versions and any other media,

including but not limited to microforms, CD-ROMs, on-line networks, bulletin boards, databases, Internet web sites, and any other electronic formats, in connection with any technologies, or through any means or methods, whether now contemplated, known, or existing or hereafter contemplated, known, created, or developed) in whole or in part, whether or not combined with works of others, in perpetuity throughout the universe."

Although such provisions and efforts may sound extreme, they serve a purpose. Bear in mind that the Tasini court, while ultimately ruling in their favor, disagreed with the claims of some of the defendants that, by such means as allegedly less-than-determinative legends stamped on the backs of payment checks and contract language, the plaintiffs had "expressly transferred" the electronic rights to their articles. Also bear in mind that if you're willing to accept less than (or are not willing to pay any demanded premium for) "all rights", you must be very careful and cognizant of how you narrow the scope of what you are purchasing. Before agreeing to a very narrow grant, think carefully about what uses you might want to put the article to down the road, and make sure that you have the right to do so.

Let Your Voice Be Heard

The Tasini plaintiffs have suggested that either in lieu of or in tandem with an appeal they may seek to have Congress (where, according to the Jonathan Tasini August 14 statement, they "have been cultivating allies") amend the Copyright Act to support their position. (Indeed, the Court itself noted the possibility of future Congressional intervention in this area.) Editors and publishers should not be reluctant to similarly exercise their own First Amendment rights -- the right to lobby legislators -- in support of their own position. Bringing the important public policy considerations supporting the Tasini ruling and the publishers' positions to the attention of legislators will help further those goals.

Conclusion

Clearly the Tasini ruling represents a major victory for editors and publishers, and one which should stand the test of appeal, should plaintiffs follow through in their announced intention. Nevertheless, appellate outcomes are never certain, and plaintiffs have indicated they may seek legislative intervention as well. To maximize certainty, publishers may be best served by considering making written contracts with freelancers a matter of course, and including in such agreements terms which confirm that publishers are acquiring all the rights they need for present and future uses. Like many legal matters, an ounce of prevention may well be worth a pound of headaches and lawyer bills.

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