International Copyright Law and the Electronic Media Rights of Authors and Publishers

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by
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Introduction

Imagine that you are a freelance writer in the United States. You sell an article to Popular Magazine, to appear in its January 1998 issue. In May 1998, you are using an online database service to research a new article you are writing on a similar topic. You type in your search terms, and, surprise! There is your very own article, online. Popular Magazine, it turns out, has sold the electronic publication rights to your article, along with all the other articles published in the same issue, to the online database service. Now you are paying a fee to the online database service to read your own article! You are irate, naturally. The on-line database service is making money from your article. Popular Magazine made money selling your article to the online database service. And you are still a starving freelancer, trying to write another article to pay the rent. What can you do? Can you sue Popular Magazine or the online database service for copyright infringement?

While your attorney promises to look into the matter for you, you get back to work on the new article. This time, you go to the public library and search on CD-ROMs for information. Once again, your search terms pull up your very own article for Popular Magazine. Neither Popular Magazine nor the CD-ROM producer ever asked your permission or paid you any money for the re-use of your article. Enraged, you decide to visit Popular Magazine's website and then send them a really hostile e-mail (against your lawyer's advice, of course). What you find at their website, though, is yet another way to read your article in the January issue! What, hostile e-mail aside, can you do? Can you sue Popular Magazine not only for selling your article to the online database service but for selling to the CD-ROM producer and for posting the article on its website? Can you also sue the CD-ROM producer, the company that maintains the website or the Internet service provider?

Now switch sides for a moment and imagine that you are the publisher of Popular Magazine. In addition to publishing an English edition in the United States, you also publish German, French, and Dutch editions in Europe. You now
wish to have the company that maintains your website post all the articles from all the editions on the website so they will be available globally to anyone who wishes to read them for a fee. Furthermore, you would like to contract with an electronic database service and with a CD-ROM manufacturer to allow them to republish Popular Magazine, the English edition as well as the foreign editions. The database service will be available internationally and the CD-ROM manufacturer will market its product through most of the world. Having already paid the freelance journalists for their articles once, you think you should not have to pay them a second time. For one thing, there are so many of them, that tracking them down and getting them to agree to the replications would be time-consuming and difficult. For another, the only reason the database service or CD-ROM producer wants to republish the articles is that they were first published in Popular Magazine. What they are paying for is your magazine’s name attached to the article. Can you go ahead with your plans without fear of lawsuits? Will you be treated the same way legally in the United States as in Europe or need you worry about different legal troubles in different countries?

This article will attempt to answer these questions by looking at recent cases resolving disputes over the electronic media rights of freelance journalists and publishers in the United States and Europe. Part One of this article will examine closely the first U.S. case to analyze electronic media rights under § 201(c) of the Copyright Act of 1976,1 Tasini v. The New York Times Co.² Part Two will contrast the Tasini decision with another very recent case, Ryan v. Carl Corp.,³ which also applied 17 U.S.C. § 201(c) but reached a different conclusion. In Part Three, this article will compare the issues raised by these two U.S. cases with four recent European cases: Freelens v. Der Spiegel⁴ (Germany), Heg, Mulder & Stam v. De Volkskrant⁵ (The Netherlands), General Association of

5. Amsterdam District Court Third Multiple Chamber, Sept. 24, 1997,
Professional Journalists of Belgium v. Central Station (Belgium), and Union of French Journalists v. SDV Plurimedia (France). Finally, Part Four will consider the implications of these conflicting decisions for international electronic trade in copyrighted works and will suggest international solutions that attempt to balance fairly the competing interests of freelancers, publishers, and the new electronic media industries.

I


Section 201 of the 1976 Copyright Act establishes basic principles of copyright ownership in the United States. Section 201(a) states that the source of copyright ownership is the author of the work, or authors in the case of a joint work. Sections 201(b) and 201(c) set out default rules (i.e., rules that apply only when not contracted out of expressly) for copyright ownership in two special situations: works made for hire and contributions to collective works. Section 201(b) deems the employer for whom a work made for hire was prepared to be the author of the work unless the parties have contracted otherwise in writing. The U.S. cases involving the electronic republication rights of journalists concern only freelance journalists because all rights in the contributed


9. See 17 U.S.C. § 201(a) (1994) ("Copyright in a work protected under this title vests initially in the author or authors of the work. The authors of a joint work are co-owners of copyright in the work"). Id. "A joint work" is defined in 17 U.S.C. § 101 of the Copyright Act.

10. See 17 U.S.C. § 201(b) (1994) ("In the case of a work made for hire, the employer or other person for whom the work was prepared is considered the author for purposes of this title, and, unless the parties have expressly agreed otherwise in a written instrument signed by them, owns all of the rights comprised in the copyright."). Id. Section 101 of the Copyright Act defines the term "work made for hire." See 17 U.S.C. § 101 (1994).
works of employee journalists would be owned by the periodical that employs them. Section 201(c) clarifies the rights of non-employee authors of contributed works. Section 201(c) also distinguishes their ownership rights in their contributions from the rights of the copyright owner of the collective work as a whole. The former, unless he or she has expressly transferred rights, retains all rights in the contributed work, except that the copyright owner of the collective work has the privilege of reproducing and distributing the contribution under certain circumstances specified in the statute:

Copyright in each separate contribution to a collective work is distinct from copyright in the collective work as a whole, and vests initially in the author of the contribution. In the absence of an express transfer of the copyright or of any rights under it, the owner of copyright in the collective work is presumed to have acquired only the privilege of reproducing and distributing the contribution as part of that particular collective work, any revision of that collective work, and any later collective work in the same series.

Section 201(d) allows any of the rights belonging to the copyright owner, enumerated in §106, to be transferred and owned separately. However, the Copyright Act guards against the possibility of inadvertent transfers of rights by requiring in §204(a) that a transfer of rights be in writing and signed by the owner of the rights.

Assuming the freelance journalist did not sign a contract with the publisher expressly transferring the right to republication of the article in electronic media or containing a more general clause allowing future re-use of the article in media not yet known, §201(c) on its face appears to say

14. U.S. courts are divided in how they treat such open-ended “new technology” clauses. See Platinum Record Co. Inc. v. Lucasfilm, Ltd., 566 F. Supp. 226, 227 (D.N.J. 1983) (allowing defendants’ release of film American Graffiti on videocassettes where contract conferred right to exhibit film “by any means or methods now or hereafter known”). See also Rooney v. Columbia Pictures Indus., Inc., 538 F. Supp. 211, 223, 228 (S.D.N.Y. 1982) (allowing defendants right to sell videocassettes of films where contract granted right to exhibit films “by any present or future methods or means” and by “any other means now known or unknown.”) But see Tele-Pac, Inc. v. Grainger, 168 A.D.2d 11 (N.Y. App. Div., 1st Dep’t 1991) (holding that a 1964 contract granting right to distribute films “for broadcasting by television or any other similar device
that the publisher, without seeking further authorization from the writer, can only republish the article in a revision or a later issue of its magazine. Is a CD-ROM version of the periodical a “revision”? What about the version included in the online database? Can a revision of a collective work be in a different medium than the original version? How different may a later version be and still be a “revision” and not a new (derivative) work?

The legislative history of § 201(c) offers little additional guidance:

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.

Is a CD-ROM or online database service version of a print magazine article “a new anthology,” “an entirely different magazine,” or other “collective work?”


The *Tasini* plaintiffs were six freelance writers who sold

now known or hereafter to be made known” did not extend to videocassette and videodisc rights to the films).


16. 972 F. Supp. 804 (S.D.N.Y. 1997), rev’d, 192 F.3d 356 (2d Cir. 1999) (the opinion of the U.S. Court of Appeals, Second Circuit, was withdrawn at the request of the court. A superseding opinion may be filed at a later date). The district court opinion will hereinafter be referred to as “Tasini I.” The Second Circuit opinion will be referred to as “Tasini II.” Judge Sotomayor has since been elevated to the U.S. Court of Appeals for the Second Circuit.


articles for publication in *The New York Times*, *Newsday*, and *Sports Illustrated*. The publishers of these periodicals, defendants The New York Times Co., Newsday, Inc., and Time, Inc., sold to two electronic service providers, defendants LEXIS/NEXIS and UMI, the right to reproduce their newspapers and magazines in online electronic databases and on CD-ROMs. Plaintiffs alleged that by allowing NEXIS and UMI to publish electronic versions of periodicals containing their articles without first obtaining their permission, the periodicals' publishers and the electronic service providers infringed the copyright each writer held in his or her individual articles. The defendant publishers, in return, argued that the electronic database and CD-ROM versions of the periodicals were permissible "revisions" of collective works under § 201(c), one of the privileges that § 201(c) gives to the owner of copyright in the collective work.

First, Judge Sotomayor determined that the freelance writers had not expressly transferred electronic rights in their articles. The court found no express transfer of rights through legends on the back of checks issued to plaintiffs in payment for their articles. And the court rejected Time,
Inc.'s contention that "first publication" rights, which plaintiffs admittedly did transfer, include the right first to publish an article in any and all mediums; in doing so, the court declined to view the dispute as a new-media issue, that is, as a dispute over whether the electronic media uses were known at the time that the freelancers granted rights in their contributed works to the publishers.\(^{25}\)

\(^{25}\) See id. at 811-12. Time's argument was based on new-media cases such as \textit{Bartsch v. Metro-Goldwyn-Mayer, Inc.}, 391 F.2d 150 (2d Cir. 1968) and \textit{Bourne v. Walt Disney Co.}, 68 F.3d 621 (2d Cir. 1995), cert. denied, 116 S.Ct. 1890 (1996). These cases involved disputes over the scope of licenses which were limited by their terms to a particular medium. The issue in these cases was whether new uses developed at a later time fell within the license's grant of rights in a specific medium. \textit{Bartsch} held that the licensee is entitled to any uses that may reasonably be said to fall within the medium as described in the license and that the burden of framing and negotiating an exception should fall on the grantor. See \textit{Bartsch}, 391 F.2d at 155. Thus, in \textit{Bartsch}, the right to exhibit a motion picture was held to include the right to exhibit the movie on television. See id. in \textit{Bourne}, the court held that motion picture rights could include videocassette rights. See \textit{Bourne}, 68 F.3d at 630. See also \textit{Boosey & Hawkes Music Publ's., Ltd. v. Walt Disney Co.}, 46 U.S.P.Q.2d 1577 (2d Cir. 1998) (reviews prior case law and concludes that "new-use analysis should rely on neutral principles of contract interpretation rather than solicitude for either party."). But see Cohen v. Paramount Pictures Corp., 845 F.2d 851, 854 (9th Cir. 1988) (holding that a license conferring right to exhibit film on television did not include right to distribute videocassettes of film because new media was unknown at time of license, because television and videocassette display "have very little in common," and because the contract lacked a "new technology" clause). The \textit{Tasini I} court found the \textit{Bartsch} line of cases inapposite because they did not involve contracts imposing specific temporal limitations such as "first publication rights" as did the contracts of the freelance-journalist plaintiffs in \textit{Tasini I}. See \textit{Tasini I}, 972 F. Supp at 812. Thus, where the \textit{Bartsch} line of cases concerned contracts with media limitations, the contracts in \textit{Tasini I} did not have media restrictions, only temporal limitations (right to first publication only).

The \textit{Tasini I} court resolved its freelancer-publisher dispute through interpretation of the Copyright Act, rather than through contract interpretation as in \textit{Bartsch}. Nevertheless, the \textit{Tasini I} court engaged in a related type of new-use argument when it rejected plaintiffs' contentions that a § 201(c) "revision" either is limited to the medium in which the work first appeared or could not have been intended by Congress to extend to electronic databases when it drafted § 201(c) in the 1970s. See infra note 43 and accompanying text.

New-media/new-use arguments were also significant in some of the European cases to be discussed in this paper, including the German case, \textit{Freelens v. Der Spiegel} (see text p. 49) and the Dutch case, \textit{Heeg, Mulder & Stam v. De Volkskrant} (see text p. 50). The resolution of new-use disputes and the treatment of "future technology" clauses in copyright licenses varies greatly from one country to another. See Herman Cohen Jehoram, "Netherlands," § 4[1][a][iii], and Adolf Dietz, "Germany, Federal Republic." § 4[2][a] in \textit{Nimmer & Geller, International Copyright Law and Practice} (Paul Edward Geller, eds., 1997); see also \textit{1 Nimmer & Geller, International Copyright Law and Practice}.
Having found no express transfer giving the owners of the collective works rights beyond the § 201(c) "privileges," the court was left to struggle with the meaning of those "privileges" and whether the periodical publishers and electronic service providers stepped beyond them, infringing the copyrights of the individual writers. Plaintiffs first argued that the § 201(c) privileges are nontransferable, nonexclusive licenses, so that even if the electronic versions were permissible revisions, the periodical publishers, without the journalists' permission, could not transfer to the electronic service provider the right to publish such a revision. Not surprisingly, this argument was rejected by the court which held that § 201(c) privileges are transferable and that publishers can contract with others to produce permissible revisions of their collective works. Next, plaintiffs argued that the § 201(c) privileges are limited to the same medium in which the collective work originally appeared. The court also rejected this argument, finding no evidence in the statute, its legislative history, or in the revisions that supports such an interpretation. In fact, as the court pointed out, microfilm editions of defendants' periodicals have long existed and plaintiffs never objected even though microfilm is certainly a different medium than print.

In a third attempt to persuade the court to read the § 201(c) privileges narrowly, plaintiffs argued that the privileges do not extend to public display rights granted in 17 U.S.C. § 106(5). Thus, even if defendants may revise the periodicals

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26. See id. at 814.
27. See id. at 815-16.
28. See id. Plaintiffs argued that § 201(d) provides only for transfer of "rights" not "privileges." See id. The court noted that § 201(d) allows transfer of subdivisions of rights and that the privileges in § 201(c) are a kind of subdivision of an ownership right. See id. The court also noted that Congress's intent in drafting § 201(c)—to repudiate the concept of copyright indivisibility—would not in any way be served by restricting publishers' ability to contract with others to produce versions of their collective works. See id.
29. See id. at 816.
30. See id.
31. See id. at 816 n.7.
32. See id. at 816. Section 106 of the 1976 Copyright Act lists the six exclusive rights that form the "bundle" of rights constituting a copyright. See id. See also 17 U.S.C. § 106 (1994). Section 106(5), which protects the exclusive
containing the plaintiffs' contributions, defendants cannot display the revised collective work on a computer screen without an express transfer of this right. Again the court rejected plaintiffs' argument, and again, it was the long-standing practice of permitting microfilm versions of periodicals to go unchallenged that helped defeat it. If microfilm versions do not infringe display rights by exceeding the scope of § 201(c) rights, why would computer versions? More generally, the court pointed to the meaning that the 1976 Copyright Act gives to "publication." In § 101, "publication" is defined as "offering to distribute copies . . . for purposes of further distribution, public performance, or public display," and it includes a broad, forward-looking definition of "copies" as "material objects . . . in which a work is fixed by any method now known or later developed, and from which the work can be perceived." From such definitions, the court found that the § 201(c) privilege to "reproduce" and "distribute" revised versions of the collective work includes "any incidental display of those individual contributions."

Plaintiffs directed their remaining arguments to the crux of Tasini: whether LEXIS/NEXIS's electronic versions and UMI's CD-ROM versions of defendants' collective works are § 201(c) "revisions" of those works. Plaintiffs argued that the "revisions" contemplated by the drafters of the 1976 Copyright Act did not extend to versions created by new technologies. They also argued that the 1976 Act did not contemplate that "revisions" might mean significant alterations in the format of the original collective work. Even if the 1976 Act could be construed to allow the possibility of electronic revisions of collective works, plaintiffs argued,

right "to display the copyrighted work publicly," applies to literary, pictorial and graphic works and the individual images of movies or other audiovisual works. 17 U.S.C. § 106(5) (1994).

33. See Tasini I, 972 F. Supp. at 816.
34. See id. at 816, 816 n. 8.
35. See id.
36. See id. at 816.
39. See id. at 819.
40. See id. at 817-18.
41. See id.
these electronic versions were not revisions because they
dealt in the separate individual contributions, not in the
collective works as a whole, and because so much of what
was distinctive to these collective works—photographs,
captions, page layouts—was missing in the electronic
versions.42

The court responded to all these arguments with a very
broad reading of the term "revision."43 Emphasizing that §
201(c) says "any revision," and that the drafters of the 1976
Copyright Act were well aware of emerging new technologies
and created the Act with media neutrality in mind, the court
found that "any revision" could be an electronic revision.44

To determine whether these electronic versions of The
New York Times, Newsday, and Sports Illustrated were
revisions of the collective works in which the individual works
were first published and not new works, the court relied on
Feist45 and its progeny46 to analyze the collective works as
compilations whose copyrightable originality lay with the
selection and arrangement of the contributing works.47 Thus,
the court asked whether the electronic version preserved a
"defining original element" of the collective work.48 Although
the court acknowledged that the periodicals' arrangements of
the individual contributions were lost in the electronic
versions' omission of page layout, photos, ads, and captions,
it found that the publisher defendants' original selection of
articles was preserved electronically because:

Articles appear in the disputed data bases solely because
the defendant publishers earlier made the editorial
determination that those articles would appeal to
readers . . . . Those technologies copy all of the articles
which are selected to appear in each daily or weekly issue

42. See id. at 821.
43. See id. at 820.
44. See id. at 821-22.
46. See, e.g., Lipton v. Nature Co., 71 F.3d 464 (2d Cir. 1995); CCC Info.
Servs. Inc. v. Maclean Hunter Mkt. Reports, Inc., 44 F.3d 61 (2d Cir. 1994); Key
Publications, Inc. v. Chinatown Today Publ'g Enters. Inc., 945 F.2d 509 (2d Cir.
47. See Tasini I, 972 F. Supp. at 822-23.
48. See id. at 825.
of The New York Times or Newsday or Sports Illustrated.\textsuperscript{49}

Further, no intervening selection of articles was made by UMI or NEXIS that might cause the electronic versions to become "new" collective works.\textsuperscript{50} That the contributions are stored alongside thousands of other articles from other periodicals does not undermine the continued existence of the publishers' "selections" because this "immersion into a larger database" is countered by mechanisms reinforcing the connections between the plaintiffs' articles and the hard copy periodicals in which they first appeared.\textsuperscript{51} Thus, someone using NEXIS could access an article through a data base (or "library") identified by the periodical.\textsuperscript{52} Once the user accesses an article, it appears tagged with the periodical's name as well as the issue and page number of the hard copy version of the article.\textsuperscript{53} This reinforced connection to defendant publishers' periodicals is what gives the articles their value according to the court: "[a]n article appearing in Newsday or The New York Times is instantly imbued with a certain degree of credibility that might not exist in the case of an article never published, or an article published in other periodicals."

Finally, plaintiffs argued that so much of the original collective work was missing, and the electronic versions therefore were so drastically different from the hard copy periodicals, that the electronic versions could not be considered "revisions."\textsuperscript{54} Again, the court read "any revision" to include even revisions with significant alterations. It held that here, although the arrangement of the collective works was lost, the retained selection was enough to make the electronic use of the articles recognizable as versions and therefore § 201(c) "revisions" of the defendant publishers' newspapers and magazines.\textsuperscript{55}

As if the court were not quite confident of its rationale for this holding, in the conclusion of its opinion it made a final

\begin{itemize}
  \item[49.] \textit{Id.} at 823.
  \item[50.] See \textit{id.} at n. 13.
  \item[51.] \textit{Id.} at 823-24.
  \item[52.] See \textit{id.} at 824.
  \item[53.] See \textit{id.}
  \item[54.] \textit{Id.} at n. 14.
  \item[55.] See \textit{id.} at 824.
  \item[56.] See \textit{id.} at 824-25.
\end{itemize}
effort to bolster its holding by turning once again to the Feist-derived compilation analysis.\textsuperscript{57} This time, the court borrowed the "substantial similarity" test used in compilation infringement cases.\textsuperscript{58} Because substantial similarity may exist where original selection is copied even without original arrangement, the court reasoned that an electronic version of a periodical could be a "revision" as it is "substantially similar" in this sense.\textsuperscript{59} However, the court did stop short of claiming the "substantial similarity" test as a fixed rule to demonstrate the existence of a § 201(c) "revision."\textsuperscript{60} Instead, it supplemented "substantial similarity" with a similarity-of-function test, asking whether the electronic versions served the "same basic function" as newspapers and magazines.\textsuperscript{61} The court found that they did: "they are all sources of information on the assorted topics selected by those editors working for the publisher defendant."\textsuperscript{62}

\textsuperscript{57} See id. at 825-26.

\textsuperscript{58} See id. at 825 ["A work that copies either the original selection or the original arrangement of a protected compilation is 'substantially similar' . . . for copyright purposes."]; see also Key Publications, Inc. v. Chinatown Today Publishing Enterprises, Inc., 945 F.2d 509, 514 (2d Cir. 1991).

\textsuperscript{59} See Tasini I, 972 F. Supp. at 825.

\textsuperscript{60} See id. ["The Court does not mean to declare a fixed rule by which a revision of a particular collective work is created any time an original selection or arrangement is preserved in a subsequent creation. In certain circumstances, it is possible that the resulting work might be so different in character from 'that collective work' which preceded it that it cannot fairly be deemed a revision." Id. Here, however, the defendants did "more than merely preserve a defining element of the publishers' collective works." Id. Their electronic versions "serve[d] the same basic function." Id.]

\textsuperscript{61} See id.

\textsuperscript{62} Id. A new anthology, which the House Report on § 201(c) specified as an example of what is not a revision and therefore what a publisher could not do with the individual contributions to its collective work, is likely to pass both the substantial similarity test and the basic function test. See H.R. REP. NO. 94-1476, at 122-23 (1976), reprinted in 1976 U.S.C.C.A.N. 5738. An anthology of American sports writing might include most of the articles from a particular issue of Sports Illustrated. Thus, the periodical's original selection would be preserved, and possibly some of the arrangement of the works in the periodical too, satisfying the substantial similarity test. And arguably a reader would consult the anthology seeking the same information as the reader would seek in Sports Illustrated, thus satisfying the basic function test. But the new anthology would still not be a revision according to the House Report, or according to one's ordinary, everyday understanding of the distinction between a revision and a new anthology. In fact, the new anthology/revision distinction might serve as a better gauge than the basic function test of when a new version has gone beyond a mere revision. Thus, CD-ROMs of a single periodical's back issues would look less like a new anthology (and more like a revision) than
Was the court right in *Tasini*? Common sense might suggest not. Certainly the NEXIS or CD-ROM version of a magazine article is not what most people probably mean when they talk about a "revision" of a magazine. Also, the decision seems quite unfair to the freelance journalists who are not compensated when their works are re-exploited by the electronic publishers. It seems especially unfair to the freelance authors considering that § 201(c) was drafted to protect the rights of authors in their contributions to collective works by limiting the rights of publishers of collective works.

Legally, the court is correct in its analysis of what is

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63. See Alice Haemmerli, Commentary: *Tasini v. New York Times Co.*, 22 COLUM.-VLA J.L. & ARTS 129, 148 (1998) ("[I]ndividual authors' contributions are disseminated online to millions of users, despite the fact that the authors have never agreed to transfer their electronic publishing rights. While the electronic publisher is well paid by its customers, and the original publisher is well compensated by the electronic publisher, the authors receive nothing. Moreover, they lose future, as well as present, benefit because their prospective ability to license their works is severely compromised by the works' prior distribution to millions of readers or viewers."). So, perhaps in addition to context as a standard to judge whether a version is a "revision" (context both physically and conceptually, as in the "new anthology" test discussed supra note 62), there should be a commercial-similarity test. A version with a vastly different commercial role or potential would not be a revision. This test would allow a court to distinguish between microfilm editions of a periodical and electronic-media versions. Another criterion for distinguishing a revision from a new use is suggested by the court in *Cohen v. Paramount Pictures, Inc.*; the court distinguished the new medium (videocassettes) from the medium in which use was licensed (television) based on the nature of public access to the work in the different media. See 845 F.2d 851 (9th Cir. 1988). Access to videocassettes was far freer and "virtually unlimited" while televised exhibits of the film were constrained by the broadcasting networks. See id. at 853-54. Perhaps a similar distinction could be made between print and electronic versions of periodicals; nature-of-public-access might work as a criterion to distinguish a revision from a new use. A nature-of-public-access criterion would also allow a distinction between microfilm and electronic databases. Clearly a test for "revision" ought to be multi-factored.

64. See *Tasini I*, 972 F. Supp. at 815; see also 1 M. NIMMER & D. NIMMER, NIMMER ON COPYRIGHT § 10.01 [A] at 10-5 (1996).
protected originality in a compilation (including a collective work), but this Feist-derived analysis is not sufficient to determine what a § 201(c) "revision" might be. Further the court fails to offer any additional standards beyond the nebulous "same basic function" test\textsuperscript{65} to judge when an electronic version of a print periodical might or might not be a "revision." Certainly what is original about a collective work is its arrangement and selection of the underlying contributions. But even if that selection is preserved in the electronic versions, that fact alone does not make them "revisions." The "substantial similarity" standard is too broad to help here. Used elsewhere as a mechanism to protect copyright owners' rights by sweeping in as much as possible under the rubric of infringement, and thus preventing plagiarists from escaping by immaterial variations, "substantial similarity" seems like the wrong tool to use to protect authors' rights in contributions to collective works. A test that narrowed the category of permissible "revision" would better serve that purpose, a purpose which was the stated goal of Congress in drafting § 201(c).

What drove the court to a decision so contrary to common-sense and so inimical to authors' rights? The court even seemed uneasy with its own decision, reaching far afield for the "substantial similarity" test to justify its reading of § 201(c)’s “revision,” and further acknowledging that its holding may be inequitable to the journalists (“Congress is of course free to revise [§ 201(c)] to achieve a more equitable result”\textsuperscript{66}). One clue to the court’s motive may be the opinion’s understatement of the commercial nature of NEXIS's and UMI's electronic publications: the court pays little attention to the fact that while the freelance journalists receive no further compensation for their works, the hard copy publishers sell those works to the electronic publishers for large sums of money, and the electronic service providers in turn make enormous profits from user fees. Instead, the court likened these electronic commercial enterprises to "electronic research librar[y]s,"\textsuperscript{67} asserting that they "serve the same basic function as newspapers and magazines; they are all

\begin{itemize}
  \item \textsuperscript{65} See Tasini \textit{i}, 972 F. Supp. at 825.
  \item \textsuperscript{66} \textit{Id.} at 827.
  \item \textsuperscript{67} \textit{Id.} at 825 n.16.
\end{itemize}
sources of information on the assorted topics."68 Bordering on praise for the electronic defendants and revealing more than a little bias, the court noted that the electronic publications not only serve the same archival, information-providing function as the print periodicals, they do it better: "permit[ting] users to consult defendants’ periodicals in new ways and with new efficiency."69 It is as if the court had taken the perspective of the NEXIS users and was supporting their right to access to the newspaper and magazine articles. A fair use argument lurks, as if the court were really valuing the public’s need for access to information (in the form of plaintiffs’ articles) higher than the individual freelancers’ rights, not to mention fearing that the permission requests and payments to individual freelancers would hinder the growth of these new, more efficient technologies. Contrary to its own assertion that the 1976 Copyright Act was forward looking in its adaptability to new computer technologies,70 the court seemed to say that Congress will need to rewrite § 201(c) of the 1976 Copyright Act if it wants to preserve the rights of freelance journalists in the computer age.71

In September 1999, the U.S. Court of Appeals for the Second Circuit, in a unanimous panel decision written by Chief Judge Ralph Winter Jr., overruled the district court, rejecting its broad interpretation of the § 201(c) revision privilege.72 Emphasizing how much of the publishers’ original contributions to their collective works, in terms of selection, coordination, and arrangement, were lost in the electronic NEXIS and UMI versions, and how much of what remained of value was the preexisting material belonging to the individual freelance authors, the Second Circuit viewed the electronic databases as more like "new anthologies" than "revisions" of the periodicals.73 The court declared:

[T]here is no feature peculiar to the databases at issue . . . that would cause us to review them as "revisions." NEXIS is a database comprising thousands or millions of individually retrievable articles taken from hundreds or thousands of periodicals. It can hardly be deemed a "revision" of each

68. *Id.* at 825.
69. *Id.*
70. *See id.* at 818.
71. *See id.* at 827.
72. *See* 192 F.3d 356 (2d Cir. 1999), withdrawn.
73. *See id.*
edition of every periodical that it contains.\textsuperscript{74}

Furthermore, the court saw no relevant distinction between image-based CD-ROMs and text-based NEXIS, nor between electronic databases of multiple editions of many periodicals, finding them all to be "new anthologies" not "revisions."\textsuperscript{75} In a footnote, the Second Circuit criticized the district court's application of a "substantial similarity" test.\textsuperscript{76} That test, the Second Circuit pointed out, applies where two compilation authors are contesting rights to their compilations, where what is at stake is not the underlying factual material which neither author owns but the selection, coordination, and arrangement contributed by the compilation author.\textsuperscript{77} The ability of the New York Times to protect its original selection, coordination, and arrangement is not compromised by the authors' retained rights in their individual contributions.\textsuperscript{78}

Whether a newspaper's website, with links to more than one day's edition, would be a § 201(c) "revision" remains an open question after the Second Circuit's decision. So too is the question of whether, through either U.S. Supreme Court interpretation or Congressional amendments, the Copyright Act should be retooled for an electronic age, with, perhaps, a scheme for collective licensing of the kind proposed by Plaintiff Tasini, who is now president of the National Writers' Union.\textsuperscript{79}

\section*{II}
\textbf{Ryan v. Carl Corp.}

The only other U.S. case focusing on the interpretation of §201(c) is the very recent \textit{Ryan v. Carl Corp.}\textsuperscript{80} This case involved a class-action copyright infringement suit brought

\begin{thebibliography}{80}
\bibitem{74} Id.
\bibitem{75} See id.
\bibitem{76} See id.
\bibitem{77} See id.
\bibitem{78} See id.
\end{thebibliography}
by freelance authors against “UnCover,” a document retrieval and delivery service owned by defendants Carl Corporation and Dialog Corporation. The business consisted of an Internet database listing the titles of approximately eight million articles from seventeen thousand periodicals. Customers searched the database by title, author, periodical title, and subject. If the customer wished to receive a full-text copy of the article, UnCover sent an employee to the library to photocopy the article and then fax it to the customer for a fee. In some instances, UnCover sought the publisher’s permission and sent a copyright payment either to the publisher or to a copyright-payment clearinghouse. But the service did not ask permission of the articles’ authors nor offer to pay them copyright fees.

Where the *Tasini* dispute centered on the meaning of § 201(c)’s “any revision,” the UnCover controversy revolved around the meaning of § 201(c)’s “as part,” in the phrase “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.” The freelance authors argued that UnCover’s copying of individual articles was not reproducing them “as part” of collective works. The defendants argued that as long as they reproduced the original work (the “part”) as it appeared in the collective work, they did not need anyone’s permission other than that of the owner of the copyright in the collective work who holds the right to reproduce the work in this fashion under § 201(c). Unlike

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81. See Ryan, 23 F. Supp. 2d at 1146.
82. See id.
83. See id.
84. See id. See also Joanna Glasner, Freelance Reporters Sue Article Search Service, LAW JOURNAL EXTRA! [Website of NATIONAL LAW JOURNAL] (Oct. 31, 1997) <http://www.ljx.com/LJXfiles/freelance.html>. At the time of publication, the NATIONAL LAW JOURNAL URL was inactive. However, this article is available at <http://www.google.com> (visited Sept. 24, 1999) (search for records containing “Joanna Hasner”).
85. See id.
86. See id.
89. See id.
Tasini I, the Ryan court interpreted the language of § 201(c) and its legislative history to mean that doubts should be resolved in favor of authors rather than publishers: "[C]ourts should construe the rights of publishers narrowly rather than broadly in relation to those of authors. . . . When determining the respective rights of publishers and authors under § 201(c), one must bear in mind that Congress passed the section to enlarge the rights of authors."90 The court, while not rejecting Tasini, just notes its inapplicability to the UnCover facts.91 Here, no one claimed UnCover was "revising" the collective works when they sold copies of individual articles.92 Of course, the photocopies retained some of the arrangement of the original collective work, including layout, photographs, and captions, but "[c]alling the reproduction of a single article a 'revision' of a collected work . . . is more strained than even a flexible interpretation can withstand."93

Interestingly, where the Tasini I court, in holding for the defendant publishers, suggested its decision might be inequitable for plaintiffs, the Ryan court, while finding for the plaintiff authors, worried that its decision was inequitable for publishers.94 If authors hold the right to reproduce (or allow others to reproduce) their individual contributions to collective works in most situations, the authors seem to be getting a windfall in the form of all the value added by the publisher though its inclusion of the article in its collective

90. Id. at 1151. Section 201(c) was enacted as part of the 1976 Copyright Act in response to the doctrine of copyright indivisibility. Under this doctrine, individual authors of contributions to collective works risked inadvertently giving up all of their rights in the contribution either to the publisher or to the public. See Tasini I, 972 F. Supp. at 815. Section 201(c) was intended to "clarify and improve the present confused and frequently unfair legal situation with respect to rights in contributions" by "preserv[ing] the author's copyright in a contribution even if the contribution does not bear a separate notice in the author's name, and without requiring any unqualified transfer of rights to the owner of the collective work." H.R. REP. NO. 94-1476, at 122-23 (1976), reprinted in 1976 U.S.C.C.A.N. 5738. The term "privilege" in § 201(c) was meant to emphasize that the publishers—the creators of the collective works—are limited in how they can use the individual contributions, limited to exercising those few rights or privileges that they possess. See Tasini I, 972 F. Supp. at 816.

91. See Ryan, 23 F.Supp. 2d at 1151.

92. See id.

93. Id.

94. See id. at 1151.
work. For example, where the collective work is a peer-reviewed academic journal, "the article gains intellectual credibility from having been selected and approved by the publisher. To be useful to future researchers, the article must be cited according to its location in the publisher's journal. In some magazines, the publisher's addition of illustrations adds substantially to the value of the article."

The broader societal significance of striking the right computer-age balance between publishers' and authors' rights, implicit in Tasini I's concern for NEXIS and CD-ROM users, is addressed in Ryan v. Carl Corp. Claiming (ironically) to be as bound by Congressional intent and § 201(c)'s statutory language in its holding for authors as the Tasini I court did in holding for publishers, the Ryan court noted that "[f]rom the standpoint of societal efficiency, it makes more sense to allocate the right of reproduction to publishers, because publishers are easier to locate... academic use of articles will be made more difficult by the adoption of plaintiffs' construction [of § 201(c)], which will require obtaining permission from both the publisher and the author."

III

European Cases

Given the difficulties U.S. courts have faced in balancing the rights of publishers of collective works, author-contributors, and the information needs of an increasingly computer-literate, computer-wired nation, it should be no surprise that international courts are just as divided over how best to strike the balance. The remainder of this paper will look at four recent cases in Germany, the Netherlands, Belgium, and France that struggle to resolve disputes over

95. See id.
96. Id.
97. See id. at 1150.
98. Id. A different societal-efficiency concern is raised in Itar-Tass Russian News Agency v. Russian Kurier, Inc., 153 F.3d 82, 93 (2d Cir. 1998). Who is better able to protect the contributed works from infringement, the publisher or the individual authors? If the publisher, because of its limited rights in the collective work, can only sue for infringement of the selection, coordination or arrangement of the collective work, can infringers avoid such suits by, for example, altering the arrangement of the works they copy? Will infringers be deterred by the threat of suits by individual authors of contributed works?
the electronic publishing rights of journalist-contributors to print periodicals. After describing the outcome of each case, this paper will attempt to account for the differences in the decisions and will consider the potential consequences of those differences for international commerce in artistic and literary works, especially via the Internet or CD-ROM products.

A. Germany

The 1997 German case, Freelens v. Der Spiegel,99 involved a dispute between freelance photographers and the producer of annual CD-ROM compilations of the magazine Der Spiegel. The CD-ROMs contained the full text and illustrations from the print editions, including plaintiffs' photographs. Under German copyright law transfer of copyright is impossible and no work-for-hire rule exists, but the creator of the work can grant "use rights" or licenses. Because the photographers had not expressly granted permission for the creation of electronic versions of their works, the central issue was whether an implied license had been granted. To decide that issue, the court had to determine whether or not the electronic version was a novel use unknown at the time of granting the license. It held that in 1989 when the licenses were first granted, CD-ROMs were a known use, even if the commercial significance of that use was not then fully apparent. Furthermore, the court, like the court in Tasini I, did not see a significant difference between the older microfilm compilations of Der Spiegel, to which the plaintiffs never objected, and the CD-ROM version. So, again like the Tasini I court, the German court held for the defendant

100. See id. at 178.
103. See id.
104. See id. at 179-80.
105. See id. at 179.
publisher.\textsuperscript{106} It did not appear to concern the court that the CD-ROM version represented commercial potential of an order unthinkable for microfilm, or made plaintiffs' photographs vastly more accessible than the microfilm version of Der Spiegel. What did concern it, however, was the possibility that a ruling requiring CD-ROM producers to obtain permissions and make payments to individual contributing journalists would impede economic and technical progress, creating obstacles to the development of new electronic technologies.\textsuperscript{107}

\textbf{B. The Netherlands}

The other three European cases, in contrast, were all pro-freelance-author decisions. In the 1997 Dutch case, Heg, Mulder & Stam v. De Volkskrant,\textsuperscript{108} the plaintiffs were freelance journalists whose suit had the support of the Netherlands Association of Journalists, the main labor union representing employee and freelance journalists.\textsuperscript{109} The defendant, De Volkskrant, was one of the Netherlands largest newspaper publishers.\textsuperscript{110} Plaintiffs argued that their

\textsuperscript{106. See id. at 178. An interesting difference to note here between the two cases and the two countries' legal systems: in the U.S., whether rights were transferred for new media is treated as a contractual issue, and because the \textit{Tasini I} court framed the publisher-freelancer dispute as a matter of copyright-statute construction, it distinguished the \textit{Bartsch} line of new-media cases. In Germany, whether rights were transferred for new media is treated as a copyright issue; applying German copyright law, the \textit{Freelens} court considered whether the new media were known at the time the license was granted and found that they were. For further discussion on the differences between U.S. and German treatments of rights transference for new-media, see \textit{generally 2 Nimmer \& Geller, INTERNATIONAL COPYRIGHT LAW AND PRACTICE} \textsuperscript{\textregistered} \textsection 411[a][ii] (Paul Edward Geller ed., 1998). See also the \textit{Tasini I} court's discussion of the \textit{Bartsch} line of new-media cases, supra note 25.}

\textsuperscript{107. See Landgerich Hamburg, Decision of the Regional Court of Hamburg, August 19, 1997, \textit{translated in 22 Colum.-Vla J.L. \& Arts} 177, 179. "In the opinion of the Court, this view corresponds with the tendency in the decisions of the Bundesgerichtshof [Supreme Court] not to make great demands with regard to the requirement of 'known means' in the sense of section 31(4) of the Copyright Act. For example, for direct satellite transmissions and terrestrial transmissions the Bundesgerichtshof pointed out that section 31(4) of the Copyright Act with its strict legal consequence of invalidity shall not hinder the economic and technical progress of the exploitation of works through the development of new, independently licensable means of utilization." \textit{Id.}}

\textsuperscript{108. \textit{Amsterdam District Court Third Multiple Chamber} 24 (September 1997), \textit{translated in 22 Colum.-Vla J.L. \& Arts} 177, 179 (1998).}

\textsuperscript{109. See Hugenholtz, supra note 101, at 155.}

\textsuperscript{110. See \textit{id}.}
copyrights were infringed by De Volkskrant’s re-use of their contributions in its quarterly CD-ROM compilations and on its Internet website. Unlike Germany, but more like the U.S. and most European countries, the Netherlands allows for transfer of copyright, either in full or in part. The Netherlands also permits authors to retain their moral rights even after transferring their copyright in a work. Finally, Dutch law allows for licenses granting rights in the copyrighted work, and these licenses may be oral, implied by conduct, or written.

The plaintiffs argued that, without any express contracts, what they granted by implied license to the newspaper were only one-time print rights, not the right to re-use their works in electronic media. The defendant publisher countered with a microfilm argument like the one seen in Tasini I and Freelens, claiming that the CD-ROMs and website served the same archival function as the earlier microfilm versions and that the plaintiffs never objected to the microfilm re-use of their works.

In holding for the plaintiff journalists, the Dutch court found that the differences between the print newspaper and its CD-ROM and website versions were too extensive to treat the electronic versions as merely substitutes for microfilm or paper archives. Rather, the court held that the electronic versions represent independent means of reproduction and publication requiring separate permissions from the journalist-contributors. Also, the court found that the electronic uses were not foreseeable in the 1980s when plaintiffs originally granted licenses to the newspaper.

111. See Amsterdam District Court Third Multiple Chamber 24 (September 1997), translated in 22 COLUM.-VLA J.L. & ARTS 177, at 184.
112. See Hugenholtz, supra note 101, at 156.
113. See id.
114. See id. at 157.
115. See Amsterdam District Court Third Multiple Chamber 24 (September 1997), translated in 22 COLUM.-VLA J.L. & ARTS 177, 184.
116. See id. at 184-85.
117. See id. at 185-188.
118. See id.
119. See id. at 187. The Dutch court seemed to apply a combination of copyright and contract law to resolve the new-media issue. Article 2(2) of the Dutch Copyright Code calls for a restrictive interpretation of copyright transfer, limiting the scope of a transfer of rights to those specifically mentioned in the contract or necessarily implied by the nature or purpose of the agreement. See
Interestingly, the defendants in the Dutch case tried to play on the same fears of impeding progress in new technology that were factors in the German and U.S. (Tasini I) courts' pro-defendant decisions. Here, the defendant argued that because the CD-ROM and website were both “in an experimental stage” and “running at a loss,” the plaintiffs were unreasonable to demand compensation and permission-requests. Unlike the Freelens and Tasini courts, the De Volkskrant court was far more concerned with the unauthorized worldwide distribution of plaintiffs' contributions via Internet and CD-ROMs than it was with the possibility that protecting authors' rights would interfere with the economic and technological progress of the new electronic media.

C. Belgium

The 1996 Belgian case, General Association of Professional Journalists v. Central Station, was another win for plaintiffs, here both freelance and employee journalists. The plaintiffs sued Central Station, a consortium of ten Belgian periodical publishers who operated a website through which fee-paying users could access the plaintiffs' articles. The plaintiffs argued that the defendants infringed their copyright because they did not authorize the licensing of their

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Hugenholtz, supra note 101, at 157. Article 6:258 of the Dutch Civil Code is an imprévision rule allowing dissolution of a contract if unforeseen circumstances (e.g., new-media uses) no longer justify continuing the contract under its original terms. See id. Interestingly, Dutch copyright law has a special provision for new modes of exploitation of a film work. If the new modes did not exist or were not reasonably foreseeable at the time the film was produced, the producer or his assignee owe equitable remuneration to the film's authors (any person making a creative contribution to the film). See Herman Cohen Jehoram, "Netherlands," 2 NIMMER & GELLER, INTERNATIONAL COPYRIGHT LAW AND PRACTICE § 4(1)(a)(ii) (Paul Edward Geller ed., 1998). Compare supra notes 25 and 107, on U.S. and German treatments of rights transference for new media. 120. See Amsterdam District Court Third Multiple Chamber 24 (September 1997), translated in 22 COLUM.-VLA J.L. & ARTS 177, 184-85. 121. Id. at 185. 122. Id. 123. See id. 124. See id. at 185-188. 125. Association Generale des Journalistes Professionnels de Belgique v. S.C.R.L. Central Station [1996], High Court of Brussels, translated in 22 COLUM.-VLA J.L. & ARTS 127, 191. 126. See id. at 191.
articles by the individual periodical publishers to the third-party (consortium) website.\textsuperscript{127}

Under Belgian copyright law, there is no works-made-for-hire provision, but there is a presumption that employees have transferred publication rights to the employer periodicals.\textsuperscript{128} The presumption is limited, however, to publication rights falling within the scope of the employment relationship.\textsuperscript{129} The court found that the newspapers, by giving Central Station permission to republish their articles on its website, exceeded the scope of the presumed employee grant of rights.\textsuperscript{130} The court based its holding on the significant degree of difference it found between the print and website versions, particularly the fact that the website made the journalists' works accessible to a global audience.\textsuperscript{131} As for the freelance journalists, the court held that Central Station needed to obtain their written permission to license the website's republication of their work, and since no such written agreement existed, the defendants infringed plaintiffs' copyrights.\textsuperscript{132}

The \textit{Central Station} decision was appealed the following year, in 1997, and the appellate court upheld the decision for plaintiffs but based its holding for the employee journalists on different reasoning.\textsuperscript{133} According to the appellate court, the oral agreement between the employee-journalists and the employer-periodicals created an \textit{intuitu personae} contractual relationship, meaning they had contracted specifically with and toward each other and they could not assign their obligations to a third party, the consortium running the

\begin{thebibliography}{99}
\footnotesize

\bibitem{127} See id. at 191-192


\bibitem{129} See id.

\bibitem{130} See Association Generale des Journalistes Professionnels de Belgique \textit{v}. S.C.R.L. Central Station, High Court of Brussels \textmd{[1996]}, \textit{translated in} 22 \textit{COLUM.-VLA J.L. \& ARTS} 127, at 193-94.

\bibitem{131} See id.

\bibitem{132} See id.

\end{thebibliography}
website. Both the appellate and lower courts in the Belgian case seemed particularly concerned with the journalists' ability to control the context of their works' publication (i.e., with what other articles and newspapers they wish to be ideologically affiliated) and to control the choice of audience (i.e., the specific segment of the public that their periodical reaches as opposed to the vastly larger and possibly ideologically unsympathetic public accessing the works through the consortium's website).

D. France

Finally, in the 1998 French case, *Union of French Journalists v. SDV Plurimedia*, the court found for the plaintiffs, print and television journalists, and against their employers, a newspaper publisher and a television broadcaster. The employers had licensed a third-party website to republish the print and audiovisual works of the plaintiffs. Applying labor law as well as copyright law, the court declared that the employers, without express consent from the journalists, could not authorize the republication of their works in a new mode of exploitation such as an Internet website.

134. *See id.* at 196-97.

135. *See id.* "[T]he newspapers differ from each as much as a matter of ideology, philosophy, morals or politics, as a matter of the quality of the authors of their articles . . . . the journalist writes for the largest public possible but within the scope of the newspaper or magazine that publishes his/her work (his/her newspaper or his/her magazine); whereas his/her article is inserted among articles written by his/her colleagues, who work, within the context of the same edition, within the same stream of ideas and in the same publication . . . . [the journalist's ideas are] expressed in his/her articles for a specific publication in a specific newspaper or magazine, imposing on the Publishing Company . . . an obligation of destination." *See id.; see also Association Generale des Journalistes Professionnels de Belgique v. S.C.R.L. Central Station [1996], High Court of Brussels, translated in Symposium, Symposium on Electronic Rights in International Perspective, 22 COLUM.-VLA J.L. & ARTS 127, 191, 193 (1998).*


137. *See id.* at 199.

138. *See id.* at 200-01.
IV
International Implications of the Conflicting Decisions

Not surprisingly, the European courts demonstrate greater concern than their U.S. counterparts with the moral rights of the journalists, especially with journalistic integrity. Thus the European courts' opinions generally give greater emphasis to the journalists' right to choose the medium in which the work appears, and thereby to choose the political or ideological context in which it will appear, as well as the size, location, and political leanings of its intended audience. In the U.S., even the pro-plaintiff Ryan decision was unconcerned with moral rights.139 In fact, the Ryan court was not even sure it liked its own decision in plaintiffs' favor; the court suggested that it felt constrained by the statute and its legislative history to protect the author over the publisher.140

The two pro-defendant decisions, Freelen141 (Germany) and Tasini142 (United States), both seem driven by the courts' interest in protecting the nascent electronic media industries. Thus, the journalists' rights in electronic media re-use of their work are viewed as obstacles to the technological progress and commercial expansion of the newly-emerging computer businesses. Interestingly, the two countries with arguably the strongest twentieth-century traditions of industrial and technological strength are far more worried about the fragility of young cyber-businesses than they are about the rights of individual authors or the social value of preserving the livelihoods of independent freelance journalists. Perhaps one explanation is that both aging industrial giants have recently seen Asian countries gain the lead in the new electronic commerce. Perhaps both are reacting to their competitive disadvantage by behaving more like developing countries, giving reduced intellectual property protection (here, reduced copyright protection to freelance journalists). Or perhaps they are protecting their own

139. See Ryan, 23 F. Supp. 2d at 1149-51.
140. See id.
electronic publishing businesses by reallocating intellectual property rights, making cyber-publishers' commercial transactions faster and cheaper by putting the burden of transactional costs on authors instead.

Paradoxically, even though the U.S. and German courts are the ones most protective of cyber-industries, and most biased in favor of the potential growth and value of the new industries (recall Tasini I's praise of services like NEXIS), they nevertheless try to mask their bias by glossing over the radical differences between CD-ROMs and electronic database services on one hand and more traditional media such as print and microfilm on the other. Countries like France, Belgium, and the Netherlands, while offering less protection to the new electronic media than to authors, are the ones more willing to admit cyber-media's revolutionary nature and its immeasurable commercial potential. Those opinions acknowledge the differences in function and format between electronic media and traditional print and microfilm and acknowledge the vastly larger, more global audience they can reach.

The divergence of these national decisions on the electronic media rights of freelance journalists may pose legal problems for international trade in copyrighted works.143 Suppose the U.S. Supreme Court were to uphold Tasini I's broad interpretation of the § 201(c) revision privilege, or suppose Congress were to amend the Copyright Act to codify that broad reading. Under such a hypothetical, should NEXIS be able to make its New York Times database available to French, Belgian and Dutch users, if that means they would be accessing articles for which the freelance authors' consent had not been obtained? Under Tasini such consent is not required although it is under French, Belgian, or Dutch law. Could Plurimedia re-broadcast France 3 television programs without the telejournalists' consent, if the viewers were all U.S. Internet users, because U.S. law might permit such electronic re-use as § 201(c) "revisions"?

If there were full territoriality in copyright law, so that the laws of the country where protection is claimed govern all aspects of copyright, then NEXIS would be in trouble in

France, but the coast would be clear under the hypothetical above for Plurimedia Internet re-broadcasts in the U.S. The Berne Convention does not specify a choice of law rule for determining copyright ownership. However, exceptions already exist to the principle of territoriality in the Berne Convention, limiting national treatment where issues related to copyright ownership are being adjudicated. Professor Ginsburg proposes that copyright ownership be determined by the source country (the country of origin, where the work was first published). Thus not having electronic rights to the France 3 programs under French law, Plurimedia could not broadcast them for Internet reception in the U.S. if the Tasini court's reading of § 201(c) were codified in an amended Copyright Act. On the other hand, NEXIS could make its New York Times database available in the Netherlands because NEXIS's rights to the freelance authors' articles would be determined under U.S. law. A similar result would be obtained by following the choice of law rule applied by the Court of Appeals for the Second Circuit in Itar-Tass Russian News Agency v. Russian Kurier, Inc. Relying on the Restatement (Second) of Conflict of Laws § 222, the Court of Appeals for the Second Circuit treated copyright as any other form of property, determining ownership by the law of the jurisdiction with the most significant relationship to the property and the parties.

Under Ginsburg's proposal, limiting territoriality by having source-country law determine copyright ownership means that if Plurimedia could find a way to claim the U.S. as its country of origin, it could then claim the § 201(c) "revision" privilege with respect to freelance journalists' works under the aforementioned hypothetical and proceed to

144. See id. at 168 ("it is generally true that the Berne Convention does not resolve the question of the law applicable to copyright ownership"). See also Itar-Tass Russian News Agency v. Russian Kurier, Inc., 153 F.3d 82, 89 n.8 (2d Cir. 1998) (the Berne Convention's principle of national treatment "is really not a conflicts rule at all").


146. See Ginsburg, supra note 143 at 169.

147. 153 F. 3d at 89 n.8.

electronically republish them all over the world. In practice, such exploitation of copyright law conflicts is less likely to occur because pro-freelance-journalist jurisdictions like France may decline to give effect to the § 201(c) privilege if it were to be broadly construed, either judicially or legislatively.149 According to Professor Jane C. Ginsburg, such jurisdictions already limit the rights a foreign grantee or its local licensee have received even where the grantee bargained for the transfer of rights in the source country.150 These jurisdictions justify such limitations on transferred rights when the transfer is governed by their substantive copyright law (as opposed to contract law), or when the transfer of rights conflicts with a strongly held public policy.151 Thus, "it seems all the more unlikely that those host country jurisdictions would credit a more expansive exercise of rights than local law would allow when the publisher has not bargained for the rights, but has simply received them by operation of a source country 'privilege.'"152 Ginsburg recommends that courts in such international conflict-of-copyright-law situations be flexible in applying international rules regarding national treatment and, if necessary, subordinate such rules to the principle of favor auctoris, choosing the law that would be more favorable to authors.153 This approach is consistent with the Berne Convention's primary objective, which is "to protect, in as effective and uniform a manner as possible, the rights of authors in their literary and artistic works."154

Professor Ginsburg explains how this approach would work in practice:

[while the starting point for analysis of the choice of law
governing copyright ownership should be the law of the

149. See Ginsburg, supra note 143. The Second Circuit's approach to choice of law would make such exploitation of conflicts more difficult than Ginsburg's proposed source-country-determines-ownership rule. Where it might be possible to manipulate points of attachment to a country of origin, it would be harder to feign "'the most significant relationship' to the property and the parties." See Itar-Tass, 153 F.3d at 90.
150. See Ginsburg, supra note 143 at 174.
151. See id. at 173.
152. Id.
153. See id. at 174-75 and 175 n.38.
source country (or of the contract), nonetheless where the host country's legislation or caselaw expresses a strongly author-protective public policy, it is likely that the host country will decline to give effect to the otherwise applicable law. This means, for example, that the host country that seeks to protect authors against improvident grants might recognize the transfer of fewer rights than the author conveyed under the law of the source country. By contrast, host country courts should look to the law of the source country in order to ensure that application of the host country's law will not result in giving the transferee more rights than the author could convey in the source country.155

However, subordinating both national laws and international conflicts-of-law rules to a “higher” supranational pro-author principle creates new problems. First, this fails to recognize the extent to which Tasini-like disputes involve dueling authors. The 1976 Copyright Act, by granting rights in collective works and other types of compilations, acknowledges that there is original authorship in the selection and arrangement of such works. A decision contrary to Tasini, giving all electronic republication rights to contributions to collective works back to the original contributors, takes the added value created by the author (publisher) of the collective work and presents it as a kind of bonus to the contributor-author. So, a supranational principle of favor auctoris poses the question of which author to favor: the author of the collective work or the author of the contributed work?

Second, although § 201(c) was created in order to improve protection of authors' rights in contributed works, in application the U.S. Copyright Act does not consistently place authors' rights first. Rather, it strives to achieve an instrumentalist balance between access and incentive. The imposition of a uniform principle of favor auctoris, however, would destroy this balance.

Third, the supranational principle approach is uncertain and unpredictable. It seems risky to base one's international commerce on the willingness of countries to subordinate both their own laws and traditional conflict-of-law rules to a principle as broad and subject to multiple interpretations as favor the author.156

155. See Ginsburg, supra note 143, at 175.
156. See 1 NIMMER & GELLER, INTERNATIONAL COPYRIGHT LAW AND PRACTICE §
One solution, a sort of quick-fix approach, would be for the U.S. Supreme Court to affirm the Second Circuit's narrow reading of the § 201(c) "revision" privilege. A judicially developed test for a "revision" can take into consideration the legislative history's distinctions between hard-copy revisions and new uses like anthologies by looking at the physical and conceptual context in which the contributed work appears. And, consistent with the Copyright Act's overall goal of balancing access and incentive, a judicially-developed test for a "revision" ought to be multi-factored, including additional criteria such as commercial similarity and similarity in the nature of public access to the work. Alternately, the U.S. Congress could amend the 1976 Copyright Act to circumscribe the applications of § 201(c), or Congress could add to the Act a new § 106 exclusive right: the right to transmit work over a computer network or through other electronic media. Either way, the effect would be to achieve the same protection for freelance journalists in the U.S. as they receive in many European countries and thus avert the conflict-of-law problems described earlier. Amending or re-interpreting U.S. law in obtaining the same rights for freelance journalists that some European nations provide might also pressure pro-publisher countries like Germany into conforming their laws to the international trend. This solution, however, does not prevent the same problem from occurring when other countries around the world adjudicate disputes over electronic republication rights.

Certainly the differences in the European and U.S.

62[c][i] (Melville B. Nimmer and Paul Edward Geller eds. 1997) ("In most civil-law jurisdictions, courts only exceptionally set aside normal choice-of-law rules in the light of overriding considerations of public interest that are optimally international in scope").

157. See supra notes 63 and 64.

158. Although individual countries might reach this result through very different laws, by either applying copyright principles or contract law or labor law, the laws would not conflict. There is no true conflict of law where there is a uniformly compelled result. See 1 NIMMER & GELLER, INTERNATIONAL COPYRIGHT LAW AND PRACTICE § 62[c][i] (Mellville B. Nimmer & Paul Edward Geller, eds. 1997);

[the threshold inquiry is to determine whether a court faces a true or false conflict. Suppose the jurisdictions whose laws might arguably apply to a case all have interests compelling to one and the same result in the case. In that event, there is no need for the court precipitously to evaluate such interests, much less any choice of law: it may simply reach that uniformly compelled result.}
decisions demonstrate how difficult it would be to harmonize the substantive laws. For example, some countries resolve the publisher-journalists' disputes by applying copyright law, others by applying contract law and others applying a mixture of the two. Furthermore, some are more concerned with how electronic publication affects authors' moral rights in their works while others care more about how electronic publication might alter the balance between economic incentives to create works and the public's need for access to the works.

Another short term solution would be to harmonize choice-of-law rules. If all nations adopted the Court of Appeals for the Second Circuit's approach of separating copyright ownership from infringement issues and choosing laws to determine the former based on the "most significant relationships" test, publishers would be less able to exploit international conflicts of laws to evade laws protecting freelancers' electronic republication rights.\(^{159}\)

Probably a better long range solution would be to include in a future international copyright treaty a provision granting to freelance journalists (or other non-employee contributors to collective works) the electronic republication right to their works.\(^{160}\) The fear in *Tasini I* and *Freelens*, that a pro-freelancer position would hinder the newly-emerging computer industries, seems unfounded. Traditional-media publishers together with electronic-media publishers are financially strong enough to bargain for these rights with freelancers. Although there is something of a windfall in giving the publisher-added-value in the contributed work to the freelancer, the bargaining power of the two (publisher and freelancer) is so disparate that the publisher could easily buy back that windfall at little cost.

Of course, the treaty solution works better with respect to

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160. Another possibility would be an international treaty provision concerning new-media uses of a work. The provision could give authors the reserved rights to all new-media uses of their work that did not exist or were not reasonably foreseeable at the time they transferred rights, unless the authors expressly contracted out of this right through a "new technology" clause in the contract transferring rights. Or, like the Dutch copyright provision for film works, *see supra* note 120, the provision could instead require the transferee to pay equitable remuneration to the author for the new-media use.
yet-unpublished works still to be bargained over than for works already published. What if a newspaper wished to create a CD-ROM of all its issues for the past ten years? Would there just be gaps where certain authors withheld the right to republish their works? Would the publisher be forced to pay exorbitant fees to these hold-outs so that the CD-ROM could claim completeness? And how marketable would it be otherwise?

This hold-out problem could be solved through an international treaty provision for mandatory licensing of freelance-authored contributed works published prior to the treaty. Although mandatory licensing would somewhat diminish the significance of those authors' right to the electronic republication of their works, it might be a fair trade-off considering the windfall to the author of all the value added to the work by its publication in the collective work.

V

Conclusion

In conclusion, the divergent international cases on the electronic media rights of freelance journalists reflect the difficulties of balancing the rights of authors against those of publishers (who are also authors, of the collective works) in the context of fostering rapidly-growing new electronic media businesses. Providing U.S. freelancers with the same effective protection they would receive in France, Belgium and the Netherlands may be the best short-term solution. A legislative or judicial narrowing of § 201(c) offering freelancers protection of their electronic-media rights in their contributed works comparable to what the laws of France, Belgium, and the Netherlands provide might also pressure contrary countries like Germany to conform to the international trend. Another short-term solution would be to harmonize choice-of-law rules, with all nations adopting an approach like that of the Second Circuit, choosing the law governing copyright ownership based on the “most significant relationships” test. In the long term, however, the legal certainty and predictability that international trade depends on would best be promoted through a new international copyright treaty that grants electronic republication rights to freelance journalists while providing mandatory licensing for pre-treaty
freelance works that have already been published.