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An Indian Perspective of *Tasini* and *Greenberg*

“My feeling is the feeling common, I suppose to three-fourths of the reflecting part of the community in our happiest of all possible countries, and that is, that it is better to suffer a great wrong than to have recourse to the much greater wrong of the law. I shall not easily forget the expense and anxiety, and horrible injustice of the Carol case, wherein, in asserting the plainest right on earth, I was really treated as if I were the robber, instead of the robbed. I know of nothing that could come, even of a successful action which would be worth the mental trouble and disturbance it would cost”

These were the words of the renowned novelist and literary genius Charles Dickens describing his struggle to protect his copyrighted works. Even today, the efforts of copyright owners to protect their rights remains an arduous task, not due to lack of legislation to protect these rights, but due to the relatively leisurely pace at which copyright legislations catch up with the technological developments, which incessantly gives new dimensions to these rights. Further, copyright, being a bundle of rights, each of which may be transferred, licensed or owned separately, makes the issues even more intricate.

This article examines, from an Indian perspective, two recent judgements of the American judiciary on the rights of freelance authors vis-à-vis digital/electronic versions of their copyrighted work and, attempts to agitate the issues raised therein. The relevant judgments are *Greenberg v. National Geographic Society* [58 USPQ2D 1267] decided on March 22, 2001 by the US Court of Appeals and *New York Times Co. v. Tasini* [59 USPQ2D 1001] decided on June 25, 2001 by the Supreme Court of United States of America.

New York Times Co. v. Tasini

The issue before the Supreme Court in *Tasini* centered around Section 201 (c) of the US Copyright Act which reads as follows:

“Copyright in each separate contribution to a collective work is distinct from the copyright in the collective work as a whole. In the absence of an express transfer of the copyright or of any rights under

it, the owner of the 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.”

Absent a contract, the owner of a collective work such as a newspaper or magazine publisher in the United States, therefore, possesses a mere privilege to reproduce a freelance author’s contribution:

- (i) as part of that collective work, which is the newspaper or magazine;
- (ii) any revision of such collective work; or
- (iii) any later collective work in the same series

Section 201 (c) of the Act was introduced in the 1976 amendment of the US Copyright Act. Prior to 1976, a freelance author had copyright in her contribution to a newspaper or magazine only when the article was printed with a copyright notice in the author’s name. However, publishers who had superior bargaining powers declined to print such notices. The option for the author to assign only the right of publication in the newspaper or magazine was barred by the doctrine of copyright indivisibility. The author’s copyright was, therefore, under peril. The law prior to 1976 thus compelled an author to transfer her entire copyright to the publisher of a collective work. Whereas 201 (c), introduced by the 1976 amendment, creates the opposite incentive, wherein, in the absence of an agreement to the contrary, the publisher acquires from the author only the three privileges mentioned above.

The litigation was initiated by six freelance authors (the Authors) regarding the contributions they made under contract to the three print periodicals - two newspapers and one magazine - namely, New York Times, Newsday and Sports Illustrated respectively (the Print Publishers). The contracts between the Authors and the Print Publishers in no instance secured consent to placement of their works in an electronic database. During the period between 1990 and 1993, they wrote 21 articles (the Articles) which became the subject matter of the dispute. The Authors had registered copyright in each of these articles and the Print Publishers had registered collective work copyrights in each periodical edition in which these articles originally appeared.

Print Publishers had license agreements with two computer database companies namely LEXIS/NEXIS and UMI. Under the agreements, the Print Publishers regularly provided LEXIS/NEXIS with a batch of all the articles published in each periodical edition. LEXIS /NEXIS was licensed to use the

text of the articles appearing in the three periodicals whereby they could copy and sell any portion of the texts. The consent of the Authors was not taken into account by these licenses.

Subscribers to LEXIS/NEXIS, accessing the system through a computer, may search for articles by author, subject, date, publication, headline, key term, words in text or other criteria. Responding to a search command, LEXIS/NEXIS scans the data base, and informs the user of the number of articles that meets the user's search criteria. The display of each article includes the print publication, date, section, initial page number, headline or title and author. Each article, when viewed, appears as a separate, isolated "story" - without any visible link to the other stories originally published in the same newspaper or magazine edition.

The New York Times also had licensing agreements with University Microfilms International (UMI), authorizing reproduction of its materials on two CD-ROM products, namely, the New York Times OnDisc (NYTO) and General Periodicals OnDisc (GPO). Articles appear in NYTO in essentially the same way they appear in LEXIS/NEXIS. However, GPO is an image-based, rather than a text based system. It shows each article exactly as it appeared on printed pages, complete with photographs, captions, advertisements and other surrounding materials. Articles are accessed through NYTO and GPO much as they are accessed through LEXIS/NEXIS.

In their action, the Authors alleged that their copyrights were infringed when, as permitted and facilitated by the Print Publishers, LEXIS/ NEXIS and UMI ("the Electronic Publishers" hereafter) placed the Articles in the LEXIS/ NEXIS, NYTO and GPO databases ("the Databases" hereafter). The Print Publishers and the Electronic Publishers in their defense relied upon the reproduction and distribution privilege accorded to collective work copyright owners under Section 201 (c) of the US Copyright Act.

The District Court upheld the defense under 201 (c) and held that the Databases reproduced and distributed the Authors' works "as part of [a] revision of that collective work" to which the Authors have first contributed. It pointed out that to qualify as "revisions" the works need only "preserve some significant original aspect of the collective works - whether an original selection or an original arrangement", and this criterion was met because the Databases preserved the Print Publishers' "selection of articles" by copying all of the articles originally assembled in the periodicals' daily or weekly issues. The Court further observed that the Databases highlighted the connection between the articles and the print periodicals by showing for each article not only the author and periodical, but also the print publication's particular issue and page numbers.

On appeal, the US Court of Appeals Second Circuit reversed the findings and held as follows:

- (i) The Databases were not among collective works and specifically, were not “revisions” of the periodicals in which the Articles first appeared;
- (ii) Just as 201 (c) does not “permit a publisher to sell a hard copy of an author’s article directly to the public even if the publisher also offered for individual sale all of the other articles from the particular edition”, it [Section 201 (c)] does not allow a publisher to achieve the same goal indirectly through computer databases. By providing multitudes of “individually retrievable” articles, the Databases effectively achieved this result; and
- (iii) The databases may be described as containing new anthologies of innumerable editions or publications, but do not qualify as “revisions”

The Print Publishers appealed to the Supreme Court which affirmed the findings of the Court of Appeals. The findings of the Supreme Court are summarized as follows:

- (i) The Databases do not reproduce and distribute the Articles as part of a collective work mentioned under 201 (c);
- (ii) Essentially 201 (c) adjusts a publisher’s copyright in a collective work to accommodate a freelancer’s copyright in his contribution to the collective work. If the publisher’s contention that the privilege under 201 (c) is available to them were to be accepted, it would diminish the Author’s exclusive rights in the Articles.
- (iii) The databases do not reproduce and distribute the article “as part of” either the original edition or a “revision” of that edition since they present the articles to the users clear of the context in which they originally appeared. When a user conducts a search, each article appears as a separate item in the search. In LEXIS/ NEXIS and NYTO an article appears to the user without the graphics, formatting or other articles with which the article was originally published. In GPO the article appears with the other materials published on the same page but without any material published on other pages of the original periodical. Hence, the Databases amount to reproduction and distribution of individual articles and cannot be called as “revisions” of the collective works.

- (iv) The database's reproduction and distribution of individual articles, simply as individual articles, would invade the core of the Author's exclusive rights. Further, the fact that the databases store and retrieve articles separately overrides Authors' exclusive right to control the individual reproduction and distribution of each article.
- (v) The Print Publishers' contention is that a person can manipulate the database to produce a non-infringing document by generating search results consisting entirely of articles from a particular periodical edition. This does not mean that the database is not infringing. Under 201 (c) the question is not whether a user can generate a revision of a collective work from a database, but whether the database itself perceptibly presents the author's contribution as part of a revision of the collective work. That result is not achieved by these databases.

Based on the above findings, the Supreme Court, held that the Electronic Publishers infringed the Authors' copyrights by reproducing and distributing the Articles in a manner not authorized by the Authors and not privileged by S. 201 (c). Further, the Print Publishers infringed the Author's copyrights by authorizing the Electronic Publishers to place the Articles in the Databases and by aiding the Electronic Publishers in that endeavor.

Out of the nine judges, Justices, Stevens and Breyer dissented from the majority opinion. The dissenting judges observed that the Publication of the Authors' works in the Electronic databases is nothing more than reproduction and distribution of the contribution as part of revisions of the original collective works and that a collection of works corresponding to a single edition of a periodical, standing alone, constitutes a revision of that single edition. The dissenting opinion pointed out that one of the hallmarks of copyright policy is the principle of media neutrality and, therefore, the conversion of the text of the overall collective work to separate electronic files should not by itself decide the question of infringement. The dissenting judges felt that the Court appears to back away from the principles of media neutrality when it criticizes the inability of the electronic publishers to reproduce the article in the very same position. They went to the extent of observing that it is up to the user in each case to decide whether to employ the publisher's product in a manner that infringes either the publisher's or the authors' copyright. And to the extent that the user's decision to make a copy of a particular article violates the authors' copyright in that article, such infringing third party behavior should not be attributed to the Database.

The majority's decision was criticized by the dissenting judges as unnecessarily subverting the fundamental goal of copyright, which is dissemination of information to the public, in favor of a "narrow focus" on authorial rights. The decision, they observed, has the effect of forcing electronic archives to purge freelance pieces from their databases.

Greenberg v. National Geographic Society

Greenberg was decided before the Supreme Court decision on *Tasini* was pronounced. Like in *Tasini*, in *Greenberg* also the issue was centered on Section 201 (c).

National Geographic Society ('Society') is one of the world's largest non-profit scientific and educational organizations and is responsible for the publication "National Geographic Magazine ('Magazine'). Jerry Greenberg was one of the many freelance photographers hired by the Society on an independent-contractor basis to complete specific assignments. During the period from 1962 to 1990, Greenberg completed 4 photographic assignments for the Society. At the relevant date of the action, the copyright in all the four assignments belonged to Greenberg.

In 1996, the Society, in collaboration with Mindscape Inc., began the development of a product called "The Complete National Geographic" ("CNG"), which is a 30 CD-ROM library that collects every issue of the Magazine from 1888 to 1996 in digital format. CNG has three components which are relevant to the decision: (i) the moving covers sequence ('Sequence'); (ii) the digitally reproduced issues of the Magazine themselves ("Replica"); and (iii) the computer program that serves as the storage repository and retrieval system for the images ('Program').

To elaborate, the Sequence is an animated clip that plays automatically when any disc from the CNG library is activated. The clip begins with the image of an actual cover of a past issue of the magazine, which, overlappingly fades into the image of another cover, pauses on that cover for approximately one second, and then fades into another cover image, and so on, until ten different covers have been displayed. One of the images used in the Sequence was a picture of a diver taken by Greenberg in 1962.

The Replica consists of a reproduction of each magazine converted into digital format through a process of scanning each cover page of each issue into a computer. A user of the CNG will, therefore, see on his computer, the Magazine as it appeared in the original paper copy of the Magazine. Although the user can print a page, there is no provision for editing the pages or separating the photographs in any way.

The Program is that which enables a user to select, view and navigate through the digital pages of the Replica on the CD-ROM. Without the Program, the Replica could still be stored in a CD-ROM, but individual pages of the Magazine would not be efficiently accessible to the user of the CNG.

The Society applied for copyright registration of CNG as a new 'derivative work'. On the registration form, the Society indicated that the "nature of authorship" included photographs, text and an 'introductory audiovisual montage. No reference was made to, nor was there any disclosure of, the copyrightable Program or the two pre-existing copyrightable sub-programs that it incorporates, all of which are also components of the CNG.

Greenberg sued the Society, National Geographic Enterprises and Mindscape for five counts of copyright infringement, two of which are relevant here: count III addressed the Society's reuse of Greenberg's photographs in the CNG and count V specifically addressed the use of his diver photograph in the Sequence. Society raised the defense under 201 (c) and argued that since it owned the copyright in the original issues of the Magazine in which the photographs appeared it had the privilege under 201 (c) to reproduce and distribute Greenberg's photographs in the CNG. The District Court relied on the opinion of the District Court in *Tasini v. New York Times Co* (which was the prevailing opinion at the time this case was decided and before it was reversed by the US Supreme Court) and held that the CNG constituted a "revision" of the paper copies of the Magazine and, therefore, the acts of the Society fell within the privilege conferred under Section 201 (c). Greenberg Appealed as to counts III and V.

Before the appellate court, the Society argued that its use of Greenberg's photographs constitutes a "revision" of the Magazine, referring to the CNG as the compendium of over 1200 independent back issues. The appellate court felt that although one could assume for the sake of argument that the privilege under 201 (c) embraced the Replica portion of the CNG, it would be difficult to stretch the phrase "that particular collective work" to encompass the Sequence and the Program as well. The clause permits a publisher to reprint a contribution from one issue in a later issue of its magazine, or reprint an article from an older edition of an encyclopedia to a newer revision of it. The language of the section as clarified in the legislative discussions of the Congress shows that *the publisher could not* revise the contribution itself or *include it in* a new anthology or *an* entirely different magazine or *other collective work*. Under these circumstances, the appellate court felt that the CNG is an *other collective work* composed of the Sequence, the Replica and the Program. However it also pointed out that common-sense copyright analysis compels the conclusion that the

Society in collaboration with Mindscape, created a new product, in a new medium for a new market that transcends any privilege of revision or other mere reproduction envisioned in Section 201 (c). The Society had itself admitted to the fact that it is a new work, while responding to the question in the copyright registration form, "Has registration of this work, or for an earlier version of this work, already been made in the Copyright office?", by stating "No".

The Court observed that in creating a new work the Society forfeited any privilege that it *might* have enjoyed with respect to only one component thereof, namely the Replica. The Court used the expression *might* because a persuasive argument can be made that when the Replica portion of the CNG was created by converting text into digital format, the statutory definition of 'derivative work' was not satisfied. In order to qualify as a derivative work the resulting work after transformation must qualify as an original work of authorship. Thus a mere electronic digital reproduction that represents the Replica may not qualify as a derivative work (being a mere reproduction of the original magazines), and thus not violate Greenberg's exclusive right to prepare derivative works (being a new work and not part of the assignment in favour of the Magazine). In any event, the court found that in the present case it was far more than a mere reproduction in another medium.

As regards the Sequence and its unauthorized use of Greenberg's diver photograph, the appellate court found in favour of Greenberg and held that the Society infringed upon his exclusive rights to prepare derivative works based upon his copyrighted photograph because:

- (i) it transformed Greenberg's work into a moving visual sequence that morphs one into the other; and
- (ii) it repositioned Greenberg's photograph from a horizontal presentation of the diver into a vertical presentation.

Manifestly, the court held, this Sequence, an animated, transforming selection and arrangement of pre-existing copyrighted photographs constitutes at once a compilation, collective work and a derivative work.

The Society's defense that its use of Greenberg's diver photograph was fair use was dismissed by the appellate court by observing that it became an integral part of a larger, new collective work and that the inclusion of the same in the Sequence has effectively diminished, if not extinguished, any opportunity Greenberg might have had to license the photograph to other potential users.

The Society raised a further alternative contention that its use of Greenberg's photograph constituted a de minimis use and therefore not actionable. The appellate court opined that in assessing a de minimis defense, what is to be examined is the quality and quantity of the use and held that the subject photograph was both qualitatively and quantitatively significant to admit such a defense. Admittedly, all the 30 CD ROMs had the diver photograph as part of the sequence.

In the result, the appellate court concluded that the unauthorized use of the Greenberg photographs in the CNG compiled and authored by the Society constitutes copyright infringement that is not excused by the privilege afforded to the Society under Section 201 (c). Further, it found that the unauthorized use of Greenberg's diver photograph in the derivative and collective work, the Sequence, compiled by the Society, constitutes copyright infringement and that the proffered de minimis defense is without merit.

Would Tasini and Greenberg have won the case in an Indian court?

The issue common to both *Tasini* and *Greenberg* was the interpretation of Section 201 (c) of the US Copyright Act vis-à-vis electronic reproduction of their individual copyrighted works in what the defendants claimed as "*part of that collective work*" or "*revision of that collective work*" as the case may be. On a pure dissection of the facts of both the cases, one would concur with the finding of the US Supreme Court and the Court of Appeals that the acts of the defendants were not covered under the privilege under Section 201 (c) of the US Copyright Act.

On facts, in both the cases, the work in dispute was held to be a new work (a derivative work in the *Greenberg* case and a new use of the work in *Tasini*), and, therefore, not covered by the privilege under Section 201 (c). Had the facts been different, or in other words, had the defendants in these two cases used the electronic medium to reproduce the exact replica of the collective works, be it the newspapers or the National Geographic Magazines devoid of any other copyrighted works or additions or frills, and assuming that the respective contracts gave the defendants rights to publish them in the electronic medium, the plaintiffs would have lost. May be they would never have sued! This is by virtue of the privilege conferred under Section 201 (c) of the US Copyright Act, which balances a publisher's copyright in a collective work to accommodate a freelancer's copyright in his contribution to the collective work.

Freelancer's copyrights under Indian law

Does the Indian Copyright Act, 1957 ("the Act") have a similar provision which balances a freelancer's copyright in his contribution to a collective work with that of the publisher's copyright in the collective work? The Act does not define a 'collective work'. However, it seems that such work being a compilation would fall within the meaning of "literary work" under section 2 (o) of the Act. Section 17 of the Act states that the author of a work shall be the first owner of the copyright therein. However, proviso (a) of Section 17 of the Act states as follows:

"in the case of a literary, dramatic or artistic work made by the author in the course of his employment by the proprietor of a newspaper, magazine or similar periodical under a contract of service or apprenticeship, for the purpose of publication in a newspaper, magazine or similar periodical, the said proprietor shall, in the absence of any agreement to the contrary, be the first owner of the copyright in the work in so far as the copyright relates to the publication of the work in any newspaper, magazine or similar periodical, or to the reproduction of the work for the purpose of its being so published, but in all other respects the author shall be the first owner of the copyright in the work"

The said proviso (a) relates to contracts of service and the operative parts of the proviso in this context are "*the said proprietor shall, be the first owner of the copyright in the work in so far as the copyright relates to the publication of the work in any newspaper, magazine or similar periodical, but in all other respects the author shall be the first owner of the copyright in the work*". The Act is peculiarly and inexplicably silent about contracts for service vis-à-vis works other than works of photograph, painting, portrait, engraving or a cinematograph film [proviso (b)]. The only consolation available to freelance authors would be the main section 17. This leaves the question of ownership in other categories of works to be determined by way of contractual assignment. It would be interesting to note that under the current UK law, the basic rules as to authorship have been clearly demarcated between commissioned works and works created in the course of employment extending across all categories of works.

An analysis of proviso (a) to Section 17 would, therefore, indicate that a contributor of a work to a newspaper, magazine or periodical shall be the owner of copyright in such work except in relation to the publication of the work in such newspaper, magazine or periodical or to the reproduction of the work for the purpose of its being so published. It is, therefore, seen that, in a very limited way, the Act balances the copyright of an author

(who is not a freelancer) in a contribution to a newspaper, magazine or periodical with the copyright of the publisher in such newspaper, magazine or periodical.

V.T. Thomas v. Malayala Manorama Co. Ltd, Cochin (AIR 1988 Ker 291)

Unfortunately, there is dearth of case law in India on the scope and ambit of Section 17, in particular, proviso (a) to section 17. One case which is of relevance is the judgement of the High Court of Kerala in *V.T. Thomas v. Malayala Manorama Co. Ltd, Cochin*. This case was concerned with the rights of the cartoonist, Toms, employed by Malayala Manorama for drawing cartoon strips for their magazine Manorama. The cartoon characters 'Boban' and 'Molly' were conceived by Toms even before he took up employment with Malayala Manorama in 1961. After Toms left the magazine's employment in 1987, he started drawing cartoon strips for a rival magazine and Malayala Manorama sued him for copyright infringement on the basis that they, as employers, had copyright in the cartoon created. At the first instance Toms was enjoined by the District court vide an ex parte ad interim order from publication of the cartoons in the rival magazine. On appeal, the High Court of Kerala (per K. Sukumaran, J.) reversed the order of the District court and held that the plaintiff magazine could not claim any copyright on the cartoons created by Toms after the termination of his employment with the plaintiff magazine.

It was, however, observed by the High Court that if Malayala Manorama were to make a compilation of the cartoons drawn by Toms during his employment with them, it was permissible. This observation was made while confirming a similar view by the District court. It is submitted that the said observation is an incorrect interpretation of proviso (a) to section 17 of the Act. As explained before, the operative part of the proviso states that "the said proprietor shall, be the first owner of the copyright in the work in so far as the copyright relates to the publication of the work in any newspaper, magazine or similar periodical", leaving the author employee the freedom to deal with and exploit other rights in the work as owner thereof. This would cover the right to issue a compilation of cartoons as a right different from and independent of those vested in the proprietor newspaper.

Definition of "adaptation" under Indian law

One of the meanings of "adaptation" under Section 2(a) (v) of the Act is as follows:

“in relation to any work, any use of such work involving its rearrangement or alteration”

It is important to note that section 2(a) (v) refers to “any use of such work”. Section 2 (a) (v) was introduced in the 1994 amendment of the Act.

Copyright in the adaptation of a work vests in the owner of a literary, dramatic or musical work, (not being a computer program) and an artistic work by virtue of the provisions of Section 14 of the Act. Further, the exclusive acts conferred upon a copyright owner under section 14 in respect of such works include the right to reproduce the same in any material form including the storing of it in any medium by electronic means and the same meaning of reproduction is applicable to adaptations.

In other words, the publisher of a magazine or a Newspaper (which would be a literary work) has the right under Indian law to rearrange or alter the work since such acts would be permitted under Section 2(a) (v) of the Act as an adaptation and publish the same in any form including electronic medium.

What does it entail?

Would it mean that the publisher of a newspaper (in the absence of any contract to the contrary) can rearrange or alter the arrangement (like in the *Tasini* case) of the articles contributed to it by its employees or freelancers who have assigned their rights therein for purposes of publication in the newspaper? Would it further mean that the publishers can reproduce the articles in electronic medium since the section permits “any use of such work”? Well, a reading of Section 2(a) (v) with Section 14 of the Act seems to suggest that it is possible. Looked in that light, the plaintiffs in *Tasini* and *Greenberg* would have won their suits before an Indian court since what they did would be likely to be interpreted as a mere use of the work involving a re-arrangement or alteration. As owners of copyright in the literary work which is the newspaper or the magazine as the case may be, they are permitted to do so under Section 14 of the Act by virtue of being owners of the same.

Conclusion

With the advent of Internet and electronic medium, the power of authors of copyrighted works to control their creations has become ineffectual thereby reducing their creations to a free-for-all status. The story of technology versus law is being repeated here except that this time the pace and the effect are unprecedented. There is a section of academicians and jurists who believe that the need of the hour is for copyright to take a back seat

and let the dissemination of information to proceed uninterrupted. The unintended aftermath of *Tasini* in the US is that a large portion of articles from databases have been eliminated thereby forcing interested readers to search for libraries that still have paper copies of the articles.

Should copyright take a back seat in this race of law and technology? If not, how to protect electronic rights of authors of literary, dramatic and artistic works? Should we have collective administration societies to administer such rights (since universally collection societies were established as a solution to authors who were unable to control the unauthorized use of their copyrighted works)? These would be just a few disturbing concerns of rights holders in the electronic context. It is time to plug the loopholes in the Indian Copyright Act, 1957. Till then Indian authors, especially freelancers will have to look to judicial precedents in other jurisdictions to protect their rights.

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