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04-0475-cv(CON), 04-0318-cv(CON)

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*United States Court of Appeals*  
*for the*  
*Second Circuit*

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DOUGLAS FAULKNER, LOUIS PSIHOS, MATRIX INTERNATIONAL,  
INC., as Agent for ROGER HUTCHINGS, SARA LEEN and RICK RICKMAN,  
*(for continuation of caption see inside cover)*

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ON APPEAL FROM THE UNITED STATES DISTRICT COURT  
FOR THE SOUTHERN DISTRICT OF NEW YORK

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**BRIEF OF AMICI CURIAE**  
**AMERICAN LIBRARY ASSOCIATION, ASSOCIATION OF RESEARCH**  
**LIBRARIES, AMERICAN ASSOCIATION OF LAW LIBRARIES, MEDICAL**  
**LIBRARY ASSOCIATION, SOCIETY OF AMERICAN ARCHIVISTS, and**  
**SPECIAL LIBRARIES ASSOCIATION**  
**In Support of Defendants-Appellees and Affirmance of the Judgment Below**

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JACOBSON, DAVID ROBERT AUSTIN and FRED WARD,  
*Plaintiffs-Appellants,*

– v. –

NATIONAL GEOGRAPHIC SOCIETY, NATIONAL GEOGRAPHIC  
ENTERPRISES, INC., NATIONAL GEOGRAPHIC INTERACTIVE,  
NATIONAL GEOGRAPHIC HOLDINGS, INC., doing business as NATIONAL  
GEOGRAPHIC INTERACTIVE, doing business as NATIONAL GEOGRAPHIC  
ENTERPRISES INC., MINDSCAPE INC., EASTMAN KODAK CO.,  
and DATAWARE TECHNOLOGIES INC.,  
*Defendants-Appellees.*

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## **IDENTITY AND INTERESTS OF *AMICI CURIAE***

This brief *amici curiae* in support of Defendants-Appellees (collectively, “National Geographic”) is submitted by the American Library Association, the Association of Research Libraries, the American Association of Law Libraries, the Society of American Archivists, and the Special Libraries Association (“*Amici*”) to urge that the Court affirm the judgment below.

The **American Library Association** (“ALA”) is a nonprofit educational organization of approximately 65,000 librarians, library educators, information specialists, library trustees, and friends of libraries representing public, school, academic, state, and specialized libraries. ALA is dedicated to the improvement of library and information services and the public’s right to a free and open information society.

The **Association of Research Libraries** (“ARL”) is a nonprofit association of 123 research libraries in North America. ARL’s members include university libraries, public libraries, government and national libraries. Its mission is to shape and influence forces affecting the future of research libraries in the process of scholarly communication. ARL programs and services promote equitable access to and effective uses of recorded knowledge in support of teaching, research, scholarship and community service.

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The **American Association of Law Libraries** (“AALL”) is a nonprofit educational organization with over 5,000 members nationwide. AALL's mission is to promote and enhance the value of law libraries to the legal and public communities, to foster the profession of law librarianship, and to provide leadership in the field of legal information and information policy.

The **Medical Library Association** (“MLA”) is a nonprofit, educational organization comprised of 4,700 health sciences information professionals and institutions. Through its programs and services, MLA provides lifelong educational opportunities, supports a knowledge base of health information research, and works with a global network of partners to promote the importance of quality information for improved health to the health care community and the public.

The **Society of American Archivists** (“SAA”) provides services to and represents the professional interests of 3,700 individual archivists and institutions as they work to identify, preserve, and ensure access to the nation's historic record.

The **Special Libraries Association** (“SLA”) is a nonprofit organization for information professionals and their strategic partners, and serves more than 12,000 members in the information profession, including corporate, academic and government information specialists.

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*Amici* are organizations devoted to representing the interests of institutions and professionals responsible for collecting and preserving historical, scholarly and other records, including periodicals and other collective works, and for making these materials available to researchers and the public at large. These institutions and individuals assist their patrons in researching, retrieving and using these materials in traditional paper media, in microform, in CD-ROM and other multi-media formats, and via online services and the Internet. A significant part of their mission is to make available reliable, accessible, comprehensive repositories of back issues of newspapers, magazines, journals and other periodicals. In furtherance of that mission, they acquire licensed databases and digitized collective works and many are even involved with digitizing public domain works and copyrighted works in



conjunction with copyright owners. Moreover, many institutional and individual members of *amici* use the very CD-ROM product at issue in this case. *Amici* accordingly submit this brief to assist the Court's understanding of the practical implications of the issues at stake in this case.<sup>1</sup>

### SUMMARY OF ARGUMENT

In the proceedings below, the District Court held that Section 201(c) of the Copyright Act (17 U.S.C. §201(c)) confers upon National Geographic the privilege of reproducing and distributing the copyrighted works of freelance contributors as part of a CD-ROM product, *The Complete National Geographic* ("CNG").

*Faulkner v. National Geographic Soc'y*, 294 F. Supp.2d 523 (S.D.N.Y. 2003) ("*Faulkner*"). In the CNG, those contributions are perceptibly reproduced and distributed as part of the original collective works, or revisions thereof, in which they first appeared. The District Court decision is therefore consistent with the Copyright Act of 1976, as amended (17 U.S.C. §§101-1332) (the "Act"), and the

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<sup>1</sup> *Amici* submit concurrently herewith a Motion for Leave to File this brief, and a declaration in support thereof pursuant to Fed. R. App. P. 29 and Local Rule 27.

U.S. Supreme Court’s decision in *The New York Times Co., Inc. v. Tasini*, 533 U.S. 483 (2001) (“*Tasini*”).

In the proceedings below and in this appeal, Appellants have sought to rely upon *Greenberg v. National Geographic Society*, 244 F.3d 1267 (11<sup>th</sup> Cir. 2001) (“*Greenberg*”), to preclude National Geographic from litigating whether it lawfully reproduced and distributed Appellants’ copyrighted works as part of the CNG pursuant to Section 201(c). The District Court, however, rejected Appellants’ attempts to foreclose further judicial consideration of this legal issue of substantial public concern, *Faulkner*, 294 F. Supp.2d at 538. It likewise rejected the flawed ruling in *Greenberg* that deemed unlawful what is effectively the mere conversion of intact periodicals from one medium to another. *Greenberg* was wrongly decided because it failed to focus on the Petitioners’ acts of reproducing and distributing the individual contributions “as part of” the original collective works or permissible revisions thereof, and disregarded how the contributions are “presented to, and perceptible by, the user . . . .” *Tasini*, 533 U.S. at 499. Rather, the *Greenberg* court found the CNG impermissible under Section

201(c) because, in essence, it combined digital facsimiles of entire collective works (scanned pages or the “replica” portion of the CNG) with software that enables users to search and perceive them with the aid of a machine or device. *See Greenberg*, 244 F.3d at 1273 n.12. The District Court rejected this reasoning and recognized that digital fixations reproduced and distributed in the CNG are materially the same as the type of analog microfilm collections that the Supreme Court observed (*Tasini*, 533 U.S. at 501-02) are permissible under Section 201(c). *See Faulkner*, 294 F. Supp.2d at 538-43 and n.85.

This Court should affirm the District Court’s ruling. To hold otherwise would not only be contrary to statute and the Supreme Court’s decision in *Tasini*, it would almost certainly have a negative impact on libraries and their patrons for many years to come. Carried to its logical conclusion, the *Greenberg* ruling raises the specter of Section 201(c) being frozen in time, exclusively applying to older, non-digital technology to the detriment of research, scholarship and learning. It inhibits the dissemination of collective works via digital and electronic media that involve combining digital facsimiles of complete collective works with software

that enables users to perceive them. This thwarts broader public availability not only of popular works like those of National Geographic, but also less widely accessible periodicals. Digital and electronic media also have functionality that exceeds traditional analog media and digitization is now one additional reformatting strategy to both preserve and provide access to many library collections. *Greenberg* thus stymies the adoption and evolution of such useful technologies.

Similarly, this Court should affirm the ruling below that the Section 201(c) privilege may be licensed or transferred. *See Faulkner*, 294 F. Supp.2d at 543-46. Were this Court to adopt Appellants' reasoning on this point, the consequences for public availability of collective works could be grave. Collective work owners would not be entitled to authorize others to do things like create and distribute microform versions of periodicals, and entitlement to republish a contribution as part of a collective work would terminate should the collective work or its copyright owner be acquired by another entity. Such an irrational reading of the Copyright Act could eventually choke-off the availability of republications of collective works.

## ARGUMENT

A fundamental goal of copyright law is to promote “broad public availability of literature, music, and the other arts” through a system of private reward to authors. *Twentieth Century Music Corp. v. Aiken*, 422 U.S. 151, 156 (1975). At base, the Supreme Court’s decision in *Tasini* was about fair compensation to individual authors when commercial electronic database publishers, without additional permission, reused articles from previously published collective works to create entirely different collective works and sell articles on an individual basis. Thus, it protected the author’s private reward pursuant to the balance that Congress struck in enacting Section 201(c). The instant case, by contrast, is ultimately about the other side of that balance. It is about the ability of collective work owners to take advantage of new technologies to more broadly distribute their creative works, and ultimately the public’s ability to access and use them. *Amici* believe that the practical consequences of this Court’s decision in this appeal and the Eleventh Circuit’s decision in *Greenberg* may be even more far-reaching than the decision in

*Tasini* in terms of the impact on the public availability of copyrighted works and the development of new media collections.

Although the facts of this case and *Greenberg* are superficially similar to those in *Tasini* (i.e., they address whether publishers are entitled under Section 201(c) to reproduce freelance contributions in certain electronic contexts), there are, as the District Court recognized below, critical differences. The District Court, relying on *Tasini*, rejected the conclusions of *Greenberg* and ruled that the CNG is permissible under Section 201(c). *Faulkner*, 294 F. Supp.2d at 538-43. If this Court were to reverse the District Court's decision and follow the reasoning of *Greenberg*, it is difficult to see how Section 201(c) could apply in a digital environment, even if the product in question otherwise met all the requirements of Section 201(c).

**I. *Greenberg* Is Contrary To Section 201(c) And *Tasini*, And It Found Infringement Based On Mere Conversion Of Works Into A Medium Requiring A Machine Or Device To Perceive Them**

**A. The CNG Is Distinguishable From The Products At Issue In *Tasini***

It is permissible under Section 201(c) for the owner of a collective work copyright to reproduce an exact facsimile of the complete collective work, whether in paper or other forms, such as microfilm and microfiche. *See Tasini*, 533 U.S. at 501-02. This would be true even if multiple, exact reproductions were combined into a single package in which several entire issues of a series of collective works would be distributed as a unit (like traditional microfilm). *See id.* at 501. When one distributes the constituent works in this manner, one is both reproducing and distributing them “as part of” the original collective works, as provided for in Section 201(c), including all of the selection, coordination, and arrangement of the original collective works. These practices, which are not problematic under *Tasini* when applied to traditional media, become impermissible under the *Greenberg* analysis if the exact facsimile is in digital form with supporting software. As the

District Court recognized below, this conclusion is not required by or consistent with *Tasini*. *Faulkner*, 294 F. Supp.2d at 539.<sup>2</sup>

In *Tasini*, the Supreme Court was faced with three different electronic database products and held that none of them complied with the requirements of Section 201(c). One product was the NEXIS online database in which millions of articles in electronic file format from thousands of periodicals had been reproduced and made available online to users in effect on an individual basis. *See Tasini*, 533 U.S. at 499-500. The other two were CD-ROM products. One, known as “GPO,” was image-based. It showed each article exactly as it appeared on the printed page,

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<sup>2</sup> The *Greenberg* court assumed, but did not decide, that the “replica” portion of the CNG was permissible under Section 201(c). 244 F.3d at 1272. Appellants, however, claim that even the “replica” portion is impermissible because multiple issues of the magazine are included in one product. Psihoyos Br. at 23; Ward Br. at 23, 25. The District Court also correctly rejected these contentions. *See Faulkner*, 294 F. Supp.2d at 540 and n.85. Reproduction and distribution to the public of multiple issues of a periodical via the same piece of plastic does not diminish the fact that the contributions are reproduced and distributed “as part of” the original collective work, and is highly analogous to the use of microforms.



*but the CD-ROM contained articles from approximately 200 publications or sections of publications. Id. at 491. The other CD-ROM product contained only the New York Times, but it did not have the original formatting or accompanying images from the original publication. Id. at 500. Both of the CD-ROM products in Tasini displayed the articles in such a way that they were not linked to other articles appearing in the original print publications and the user who wished to see other pages of the original collective work could not simply “flip” to them. A new search was required. Id. at 491 n.2. These characteristics destroyed the claim that the reproductions and distributions of the articles therein were “as part of” qualifying collective works.*

In deciding that these products were not permissible under Section 201(c), the Supreme Court’s focus in *Tasini* was on the freelance articles “as presented to, and perceptible by, the user” of the commercial electronic databases before it. *Id. at 499.* The Court’s inquiry was “whether the database itself perceptibly presents the author’s contribution as part of” the collective work or revision thereof. *Id. at 504.* The products in *Tasini* presented freelance articles to users “clear of the context

provided either by the original periodical editions or by any revision of those editions.” *Id.* at 499. The products did not perceptibly reproduce and distribute the freelance articles “as part of” the original periodicals or permissible revisions. *Id.* at 500. Significantly, the products offered users individual articles, not intact periodicals, and did not involve “a mere conversion of intact periodicals (or revisions of periodicals) from one medium to another” as happens with microfilm. *Id.* at 501-02.

Turning to the CNG, this product is fundamentally a mere conversion of intact print periodicals into the medium of CD-ROMs. The freelance contributions alleged to be infringed appear in the CD-ROM versions *in the exact positions* in which they appeared in the original print version of the magazines. *Faulkner*, 294 F. Supp.2d at 527-28, 540; NG Br. at 12. Photographs and articles are presented in the context of the full, original issues (even with original advertising). *Id.* at 13. In addition, a user of the CD-ROM can “flip” to other articles and pages in the digital facsimile of an issue in the same order in which those articles and pages were originally presented in the printed editions. *See id.* at 13-14. Although there are

100 years (or more) of issues reproduced on multiple discs, *National Geographic* is the only periodical that appears in the CD-ROM version. A user encounters very few materials that have been added to the CD-ROMs that are not digital facsimiles of the original magazines or software that permits viewing them<sup>3</sup> and searching them for specific issues and articles.<sup>4</sup> These added materials perceptible to users include (depending on which version of the NGS is at issue) a few short advertising videos, a start-up video montage that lasts for a few seconds, an introductory tutorial, a chronological table of contents, very short article summaries in lists of

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<sup>3</sup> There are minor variations among succeeding versions of the CNG. For instance, later versions of the CNG also apparently include software tools, such as tools to darken text for easier reading, to rotate images, bookmark pages, and similar capabilities. See *Faulkner*, 294 F. Supp.2d at 529 and n.23.

<sup>4</sup> The CNG has no generalized word search through the contents of *National Geographic Magazine*, and uses instead the same subject matter and name information as the print indices that National Geographic regularly publishes. NG Br. at 14. Section 201(c) and *Tasini* address the manner in which contributions to collective works may be reproduced and distributed by collective work copyright owners; neither, however, precludes the use of more precise finding aids, such as a general word search.

search results, and links to the National Geographic Society website.<sup>5</sup> NG Br. at 12-15; *Faulkner*, 294 F. Supp.2d at 527-29 and n.23.

Thus, the freelance contributions are reproduced and distributed to the public “as part of” the original collective work or revision of the original collective work. The freelance contributions are not being made available on a piecemeal basis or being sold a la carte out of a database that combines multiple periodical titles. *Cf. Tasini*, 533 U.S. at 489, 499-500. The contributions are not stored and retrieved “separately within a vast domain of diverse texts” (*id.* at 503) and thus, the reproduction and distribution of the contributions in the context of digital facsimiles of the original periodicals does not effectively override the contributors’ exclusive right to control the individual reproduction and distribution of each contribution. *Cf. id.* at 503-04. In all material regards, the contributions are perceptibly

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<sup>5</sup> *Amici* submit that for purposes of Section 201(c) these additional elements are merely incidental and of no significance to the status of the CNG as a qualifying reproduction. They do not alter the essence of the digital facsimiles embodied in the CNG and have no separate value to the product’s user. They are of no greater significance than putting a new cover on a book or adding a table of finding aids to the head of a microfilm roll.

reproduced as part of the digital facsimiles of the original *National Geographic* magazines. These CD-ROMs are therefore materially distinguishable from each of the products at issue in *Tasini*.

**B. The Flaws In The *Greenberg* Analysis**

The Eleventh Circuit's decision failed to reflect the relevant distinctions between the product at issue before it (and before this Court) and those at issue in *Tasini*, in part, because that court issued its opinion before gaining the benefit of the analysis articulated in *Tasini*. The *Greenberg* opinion also erroneously suggested that it is impermissible under Section 201(c) for a collective work owner to combine into a single product the digitized text and images of a complete collective work with software that enables users to perceive and search the collective work with the aid of a computer. Under the Eleventh Circuit's reasoning, the addition of search and access software to a product containing digitized periodicals is in effect *per se* impermissible under Section 201(c). The court had claimed in its opinion not to decide that issue. 244 F.3d at 1273 n.12. However, the software issue was clearly the dominant element of its analysis. *Id.* at 1273. Consistently applying the

*Greenberg* reasoning would mean that no publisher could rely on Section 201(c) to release a collection of its works in CD-ROM or digital format because of the use of supporting software. *Amici* believe this analysis to be an error that could materially diminish public access to works and reduce the dissemination of collective works reproduced and distributed in digital form in a manner consistent with Section 201(c) as explained in *Tasini*.

In the CNG, the original collective works that are reproduced in digital facsimiles are not themselves changed by the conversion from paper to CD-ROM. In this regard, there is merely a transformation from analog to digital media. The necessity of using an additional “work”, i.e., another computer program, to view the unchanged collective works should be analytically irrelevant because under the Act, a copy of a work that is perceptible *without* a machine or device stands on equal footing with a copy that is perceptible *with* one. The Act provides that copyright protection adheres to works of authorship “fixed in *any* tangible medium of expression, *now known or later developed*, from which they can be perceived, reproduced, or otherwise communicated, either directly or *with the aid of a machine*

*or device.”* 17 U.S.C. §102(a) (emphasis added). *See also* 17 U.S.C. §101 (“copies” defined 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, reproduced, or otherwise communicated, either directly or *with the aid of a machine or device.”*) (emphasis added).

The CNG embodies digital fixations that are materially similar to the type of analog microfilm collections that the Supreme Court has already observed are permissible under Section 201(c).<sup>6</sup> The freelance contributions are perceptible to the end users of this product “as part of” the original collective works, just as they

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<sup>6</sup> “Microforms typically contain continuous photographic reproductions of a periodical in the medium of miniaturized film. Accordingly, articles appear on the microforms, writ very small, in precisely the position in which the articles appeared in the newspaper.” *Tasini*, 533 U.S. at 501. “True, the microfilm roll contains multiple editions, and the microfilm user can adjust the machine lens to focus only on the Article, to the exclusion of surrounding material. Nonetheless, the user first encounters the Article in context.” *Id.* Although some Appellants claim that microform reproduction and distribution of collective works has never been held to be a lawful exercise of the Section 201(c) privilege, *Psihoyos Br.* at 31 n.20, the aforementioned language in *Tasini*, longstanding use of microform media without challenge, and the utter lack of any basis for a legal challenge to the practice, establish that Appellants’ doubts are entirely without merit.

are to the end-users of a roll of microfilm. The end-user encounters the software component of the product in effect only as part of the “machine or device” that permits the collective work to be perceived. It is functionally analogous to a lens, light, and the knobs on a microfilm viewer. It is not perceptibly presented to the end user as matter that has been added to the original collective works.

Even if the CNG were not to be viewed as embodying mere reproductions of the original collective works, the addition of these software elements to the digital medium could be viewed as the creation of a permissible “revision” under Section 201(c). The concept of a “revision” can encompass some level of addition and/or deletion of copyrightable matter. Neither the Act nor its legislative history suggest otherwise.<sup>7</sup> If the “final” edition of a traditional print newspaper contained additional photographs and text – both qualifying as additional copyrightable works – absent from the “early” edition, this could be fairly characterized as being a permissible “revision.” Likewise, addition of copyrightable matter that is not even



perceptible to end users as matter added to the collective work being viewed, but encountered as part of the “machine or device” that enables them to search and view the collective work, could be fairly deemed to be a “revision” of the collective work.

## **II. Application Of The *Greenberg* Analysis Would Adversely Affect The Library And Archival Communities And Collective Work Users**

The decision this Court will issue on this appeal will have far-reaching implications beyond the parties to this case and its impact will not be isolated to collective work copyright owners and contributors. It will also have profound consequences for the library and archival communities and those who use collective works.<sup>8</sup> For *amici*, the *Greenberg* decision was ominous. Under it, no collective

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<sup>7</sup> See H.R. REP. NO. 94-1476, 94th Cong., 2d Sess. 122-23 (1976), *reprinted in* 5 U.S.C.C.A.N. 5659, 5738 (1976) (under 201(c) a publishing company could reprint an article from a 1980 edition of an encyclopedia in a 1990 revision of it).

<sup>8</sup> Beyond the central issues in this case, Appellants’ briefs reflect no meaningful consideration of the users’ perspective. Indeed, one group of Appellants has asserted that the District Court erred below by considering the public interest (see *Faulkner*, 294 F. Supp.2d at 538) in the outcome of this case at all. “The [District] Court sided with Defendants to ‘serve the public interest’ which is beyond the power of the Court and against the legislative purposes behind the enactment of §201(c).” *Faulkner Br.* at 30. Appellants’ hostility to users’ rights and interests is also evident in the erroneous suggestion that some of the Appellees encouraged

work reproduced or distributed via CD-ROM, online technology, or other new technology requiring additional software to facilitate viewing or searching could, as a practical matter, ever qualify for the Section 201(c) privilege, even if the product met the statutory criteria in all other respects. The ruling therefore inhibits the dissemination of collective works via digital and electronic media. Such products make it much easier to access information resources, and make possible the retrieval and use of data in powerful ways not possible with analog media. They are of enormous value to library patrons, particularly students, scholars and historians, and nothing in Section 201(c) or *Tasini* should be understood to completely deprive these users of such powerful tools.

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users to commit copyright infringement by urging and/or permitting users to print content from the CNG (including Appellants' copyrighted contributions) and/or to use CNG contents in school reports or make other uses of them. See Ward Br. at 12-13, 16. The suggestion that any of the Appellants are at fault for encouraging those who use the CNG to make manifestly fair uses of copyrighted works – such as students including photographs in school reports – is at odds with well-established copyright law doctrines. One has not urged anyone to infringe copyrights by encouraging fair or exempted uses of copyrighted works.

The sweeping implication of the Eleventh Circuit's decision would, particularly if adopted by this Circuit, thwart broader public availability not only of well-disseminated works like those of National Geographic. Access to more obscure, less widely accessible magazines, newspapers, scholarly journals and other periodicals would also be frustrated.<sup>9</sup> These collective works could potentially be made accessible to a broader segment of the population, but not if digital and electronic media compilations of them are effectively *per se* impermissible under Section 201(c), as they appear to be under *Greenberg*.

The strong public and scholarly interest in such periodicals is evidenced by the fact that digital replicas of public domain works, including collective work

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<sup>9</sup> In the context of its discussion of collateral estoppel, the District Court expressed the concern that precluding National Geographic from litigating the Section 201(c) issue in this case could potentially disadvantage it vis-à-vis competing publishers. Should another collective work owner bring analogous products to market, face a legal challenge, and obtain a favorable court ruling that rejects the *Greenberg* analysis, National Geographic would have to compete on an uneven playing field, burdened by a judgment that only it would be bound to follow. *See Faulkner*, 294 F. Supp.2d at 536-37. However, *amici* are even more concerned that the threat of liability under *Greenberg* is likely to chill competing publishers from entering into

periodicals, are being made available online for no fee at an increasingly rapid rate. *See, e.g.*, Library of Congress, *The Nineteenth Century in Print: Periodicals*<sup>10</sup> (listing titles and years of complete digital facsimiles of historic nineteenth century periodicals digitized by Cornell University Library and the Preservation Reformatting Division of the Library of Congress); Bruce Cole, “The National Digital Newspaper Workshops for School Teachers,”<sup>11</sup> (Organization of American Historians and Library of Congress partnership to convert microfilm of historic U.S. newspapers into digital files, to be permanently available through the Library of Congress via the Internet); Brooklyn Public Library, *Brooklyn Daily Eagle Online*<sup>12</sup> (online digital facsimiles of the Brooklyn Daily Eagle from 1841-1902, digitized by the Brooklyn Public Library). There is also substantial demand for,

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the marketplace with analogous products in the first place, thus exaggerating the adverse consequences of the *Greenberg* decision.

<sup>10</sup> Accessible at <http://memory.loc.gov/ammem/ndlpcoop/moahtml/snctitles.html> (last visited June 25, 2004).

<sup>11</sup> Accessible at <http://www.oah.org/pubs/nl/2004may/cole.html> (last visited June 25, 2004).

and utility to libraries and their patrons from the availability of, digitized replicas of collective works that are still subject to copyright protection and only available with the authority of the collective work copyright owners. *See, e.g.*, JSTOR, The Scholarly Journal Archive<sup>13</sup> (detailed listing of scholarly journal titles and years available; includes public domain and copyrighted material).<sup>14</sup>

It bears noting that although the petitioners in *Tasini* voiced similar public access concerns in that case, the Supreme Court apparently found that those concerns could not override the language of Section 201(c) as applied to the specific products at issue in that case. It rightly recognized that the question of continued

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<sup>12</sup> Accessible at <http://www.brooklynpubliclibrary.org/eagle/index.htm> and <http://eagle.brooklynpubliclibrary.org/Archive/skins/BE/about.htm> (last visited June 25, 2004).

<sup>13</sup> Accessible at <http://www.jstor.org/about/alpha.content.html> (last visited June 25, 2004).

<sup>14</sup> When digital facsimiles of print materials are made accessible via the World Wide Web, the widest range of users have equal access to collections from any location whether they are on- or off-site. A virtual environment of digital files can combine content from many kinds of resources including primary source material, and provide powerful opportunities to integrate materials seamlessly into instruction and course management systems for teaching and learning.

public availability of these works could be addressed in the context of the remedial phase of the case. *Tasini*, 533 U.S. at 504-06. But in this case, the product is distinguishable from those in *Tasini* and a fair application of the statute requires a different outcome. No remedy is needed because the collective work owner has committed no wrong against the freelance contributors. The CNG fully qualifies for the Section 201(c) privilege. Thus, neither the remedial issues nor the public access issues implicated by *Greenberg* need even arise.<sup>15</sup>

The decision in *Greenberg* and the decision that will ultimately issue from this Court will also have an impact on preservation issues, which are closely related to but distinct from access issues. Cultural institutions serve the international community by building, protecting, preserving and ensuring continued access to

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Digitization allows users to create virtual collections that will support new and creative research made possible only in a digital environment.

<sup>15</sup> Despite its flaws, the *Greenberg* opinion contained insightful comments at its close in recognizing that it is appropriate to consider alternatives to injunctive relief, “such as mandatory license fees, in lieu of foreclosing the public’s computer-aided access to this educational and entertaining work.” *Greenberg*, 244 F.3d at 1276. The Supreme Court recognized similar concerns in *Tasini*. See 533 U.S. at 504-06.

diverse collections and resources. The challenges of preserving collections have been addressed in different ways over time. Libraries have used conservation to preserve the original artifact and reformatting strategies, such as microfilm and print facsimiles, to retain content, enhance access, and protect the original from excessive wear. Over the past several years, libraries have moved towards using digitization as an additional, and in some cases, a preferred method for reformatting endangered and fragile paper-based materials to both preserve and provide access to library collections.

Effective use of digitization frequently involves both the creating complete, digital facsimiles of a collective works, and combining the digital facsimiles with computer software (that is itself comprised of one or more separate “works” under the Act) that enables users to view and search the collective works with the aid of a machine or device. Indeed, libraries make significant investments in supporting the development of technologies with the goals of improving both user access and long-term preservation capabilities. Accordingly, the *Greenberg* decision stymies the adoption and evolution of such media to the detriment of the public in both regards.

Along with access and preservation concerns, *amici* institutions face ever-escalating demands on their physical space and economic resources. CD-ROM and online versions of newspapers and magazines now – and eventually other products yet to evolve – can greatly reduce the space requirements of many libraries. Thus, if this Court were to adopt the reasoning of *Greenberg*, such institutions would suffer adverse effects on their space requirements and face potentially huge increases in costs of operation and maintenance. This would have the collateral effect of reducing the amount of material and variety of sources easily available to library patrons. Likewise, a decision that needlessly imposes on collective work copyright owners the obligation to locate, negotiate with, and pay additional compensation to contributors (or their heirs or assigns) could dramatically drive up the ultimate cost of digital resources for libraries and similarly situated institutions.<sup>16</sup> This is not an

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<sup>16</sup> Collective work copyright owners might also choose to forego these additional transaction costs and delete freelance submissions from digitized works, or not produce them at all. Either outcome would harm libraries and their patrons.



outcome that Section 201(c) requires and therefore constitutes an additional, gratuitous harm to libraries and their patrons.

**III. The Privilege May Be Exercised By Or Under Authority Of The Owner Of The Collective Work Reproduction And Distribution Rights, And Transferred With Those Collective Work Copyright Interests**

Appellants and their supporting *amici* assert and/or imply that the Section 201(c) privilege may only be exercised by a collective work's author, and that the privilege may not be transferred to a third party. Ward Br. at 50-60; Psihoyos Br. at 57-58; Faulkner Br. at 46-47, 52-54, Auscape Br. at 21-22. This stance is flatly inconsistent with the text of the Copyright Act and congressional intent as expressed in Section 201 as a whole. Its adoption by this Court would have devastating consequences on the availability of collective works for years to come. The District Court rightly rejected Appellants' position in favor of Judge Sotomayor's analysis in the original district court opinion in *Tasini*. *Faulkner*, 294 F. Supp.2d at 545-46. The relevant language of Section 201(c) simply defines the presumptive scope of how the collective work copyright owner, be that the collective work's author or a subsequent copyright owner, may use separately

copyrightable contributions to the collective work. It permits collective work copyright owners to authorize others to do the very things they themselves are entitled to do within the bounds of the privilege, and permits transfer of the privilege along with the relevant collective work copyright interests.

The Act vests ownership of copyright in a work in the work's authors. 17 U.S.C. §201(a)-(b). Upon creating a work, an author acquires the exclusive rights of a copyright owner that are defined principally in Section 106 of the Act. It provides, in pertinent part, that "the owner of copyright under this title has the exclusive rights *to do and to authorize* any of the following . . . ." 17 U.S.C. §106 (emphasis added). Those exclusive rights include the rights "to reproduce the copyrighted work in copies," "to distribute copies" to the public, and "to prepare derivative works based upon the copyrighted work." *Id.*<sup>17</sup>

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<sup>17</sup> Although Section 201(c) does not expressly mention derivative work rights, a collective work copyright owner's rights and privileges relating to revisions and/or later collective works in the same series necessarily implicates latitude to issue limited types of derivative works incorporating contributions to the original collective work.

Although authors are the initial owners of the exclusive rights listed in Section 106, the statute does not limit copyright ownership to authors or define ownership in terms of authorship. A copyright owner, “with respect to any of the exclusive rights comprised in a copyright, refers to the owner of that particular right.” 17 U.S.C. §101. That ownership may come about by authorship, or may be acquired by transfer from an author or subsequent copyright owner. A “transfer of copyright ownership” is

an assignment, mortgage, exclusive license, or any other conveyance, alienation, or hypothecation of a copyright or of any of the exclusive rights comprised in a copyright, whether or not it is limited in time or place of effect, but not including a nonexclusive license.

*Id.* Transfers of copyright ownership, unless by operation of law, must be in writing and signed by the owner of the rights conveyed. *Id.* §204(a).<sup>18</sup>

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<sup>18</sup> Appellants assert that the existence of an agreement between a contributor and a publisher concerning a contribution renders the privilege inoperable. *Faulkner Br.* at 39-40; *Auscape Br.* at 20-21. However, Section 201(c) is operative absent “an express transfer of the copyright” in the contribution “or of any rights under it,” 17 U.S.C. §201(c), and not all agreements constitute a copyright ownership “transfer” as defined by Section 101.

As with other works, ownership of copyright (i.e., the exclusive rights to do and authorize the activities listed in Section 106) in a collective work vests with the author or authors of that collective work.<sup>19</sup> As with other works, ownership of copyright in a collective work “may be transferred in whole *or in part* by any means of conveyance or by operations of law,” 17 U.S.C. §201(d)(1) (emphasis added), and any of the exclusive rights comprised in that copyright, “including *any subdivision* of any of the rights specified by section 106, may be transferred as provided by [Section 201(d)(1)] and owned separately.” 17 U.S.C. § 201(d)(2) (emphasis added).

Section 201(c) dovetails with these provisions by spelling out the presumptive relationship between the rights of a compilation copyright owner and those of a contributing author. It bestows the privilege upon “the *owner of copyright* in the collective work . . . .” 17 U.S.C. §201(c) (emphasis added). As

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<sup>19</sup> See 17 U.S.C. §201(a)-(b); see also 17 U.S.C. §101 (defining the terms “compilation” and “collective work”); 17 U.S.C. §103(a) (compilations are part of the subject matter of copyright); and 17 U.S.C. §103(b) (scope of compilation copyright vis-à-vis preexisting material).

discussed above, the term “owner of copyright in the collective work” is essentially shorthand for the compound concept of the person (or persons) owning exclusive rights “to do and to authorize” others to reproduce, distribute, etc., the collective work. Contrary to Appellants’ position (see Ward Br. at 55, 59; see also Auscape Br. at 22), nothing in the statute limits the owners of those rights only to the “doing” of, nor prohibits them from the “authorizing” of others to do, the enumerated acts.

If the Appellants’ position were taken to its logical conclusion, even the original compilation author would violate a contributor’s exclusive rights were it to delegate to third parties responsibility for reproducing and/or distributing even the original issuance of the collective work. Other absurd outcomes would follow, such as the inability of a newspaper to authorize a third party to reproduce its daily papers in microform versions and distribute them to libraries.<sup>20</sup>

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<sup>20</sup> See also *Tasini*, 533 U.S. at 509 n.4 (Stevens, J. dissenting) (statute does not prevent publisher from farming out printing or distributing its collective work).

More problematic still is Applicants' claim that the privilege is not transferable. Ward Br. at 50-60; Psihoyos Br. at 57-58; Faulkner Br. at 46-47, 52-54, Auscape Br. at 21-22. The statute does not limit exercise of the privilege to the collective work's *author* (i.e., the original copyright owner), as Appellants and their supporting *amici* imply. See Ward Br. at 59; Faulkner Br. at 46-47; Auscape Br. at 21. A collective work author or subsequent collective work copyright owner is entitled to transfer copyright ownership interests in the collective work and any the rights and privileges that flow from such ownership. Nothing in the statute or its legislative history is to the contrary. The language and logic of Section 201(c) simply indicate that the "privilege" is appurtenant to the relevant copyright interests in the collective work, and may only be exercised by one who owns a relevant copyright interest in the collective work, or one who has the authorization of such an owner. It does not restrict who may become such an owner (or obtain the owner's authorization).

The adverse consequences of Appellant's position for public access to collective works cannot be overstated. The duration of a copyright is now very long. For works created by individuals, the term is life of the author plus seventy years. 17 U.S.C. §302(a). For a work made for hire, the term is ninety-five years from the date of first publication (or 120 years from the date of the work's creation, whichever comes first). *Id.* §302(c). During these staggeringly long terms, it is almost inevitable that copyrights in collective works initially owned by their original publisher-authors will change hands to other entities that acquire them. Local newspapers will be bought out by larger media companies, who will then merge with still other companies, perhaps spin off their interests in the original newspaper, and so on. Copyrights in collective works authored by individuals will *by definition* eventually pass by operation of law, will, or bequest, to their heirs for the seventy year remainder term upon the deaths of those authors.<sup>21</sup>

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<sup>21</sup> See 17 U.S.C. §201(d)(1) (copyrights may be bequeathed by will or pass as personal property by laws of intestate succession).

If Appellant's position were correct, entitlement to republish a contribution as part of a collective work would terminate with the first corporate acquisition, or upon the death of the collective work's author. Such an irrational reading of the Copyright Act would likely eventually choke-off the availability of republications of collective works, regardless of the scope of the privilege vis-à-vis digital media. Congress could scarcely have intended to visit such harm upon libraries, archives, scholars, and the public at large when enacting Section 201(c). It certainly cannot be inferred that Congress intended with the single, undefined term "privilege," to undo or undermine the broad transferability of collective works that it established in Section 201(d). *See generally, Tasini v. New York Times Co.*, 972 F. Supp. 804, 815-16 (S.D.N.Y. 1997) (privilege is transferable; holding otherwise would

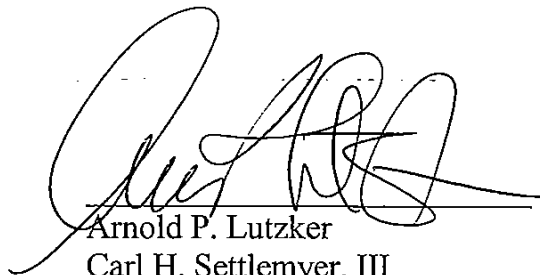


undermine goal of ensuring that collective works be marketed and distributed),  
*rev'd on other grounds*, 206 F.3d 161 (2d Cir. 2000), *aff'd*, 533 U.S. 483 (2001).

### CONCLUSION

For the foregoing reasons, this Court should affirm the judgment of the  
district court.

Dated: Washington, DC  
June 25, 2004

A handwritten signature in black ink, appearing to be "Arnold P. Lutzker", written over a horizontal line.

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Dated: Washington, DC  
June 25, 2004

  
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## CERTIFICATE OF SERVICE

I hereby certify that two true and correct copies of the Brief of Amici Curiae American Library Association, Association of Research Libraries, American Association of Law Libraries, Medical Library Association, the Society of American Archivists, and the Special Libraries Association in Support of Defendants-Appellees was sent, postage pre-paid, via U.S. Mail on June 28, 2004 to the following:

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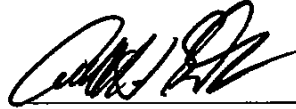
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