HARVEST OF KNOWLEDGE[1]: WHY THE PUBLIC POLICY BEHIND COPYRIGHT LAW REQUIRES LEGISLATION ENDORSING DIGITAL MEDIA COLLECTIONS AS PRIVILEGED REVISIONS

I. INTRODUCTION: THE TANTALIZING POTENTIAL OF NEW MEDIA TECHNOLOGY

In 2005, the publishers of the *New Yorker* magazine published *The Complete New Yorker*, a collection on DVD-ROM that contained all eighty years of the erudite, iconic journal of American arts and culture.[2] The title is neither hyperbolic nor metaphorical. The collection includes every issue of the magazine published since 1925 (over 4,109 issues),[3] and some of the most important intellectual commentary, arts criticism and short literary works from the twentieth-century. The publishers also promised to issue annual updates, allowing customers to keep their collection complete. For a true *New Yorker* enthusiast, such a collection—which includes every Saul Steinberg cover, every Pauline Kael film review, every "Talk of the Town" column—is an item from a

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1 Harper and Row Publ'g., Inc. v. Nation Enters., 471 U.S. 539, 545 (1985).

2 Alex Beam, *It's a Case of Who Owns the Words*, BOSTON GLOBE, Oct. 4, 2005, at F1.

3 *The Complete New Yorker* originally contained all 4,109 issues of *The New Yorker* from February, 1925 through February, 2005. *The New Yorker* has already compiled a supplementary DVD containing subsequent issues published through April, 2006. The New Yorker Store, http://www.thenewyorkerstore.com (follow "The Complete New Yorker" hyperlink) (last visited Aug. 30, 2006).

fantastical wish list.[4] For any public or private library, however, *The Complete New Yorker* is a tantalizing example of what could and should be.

The Complete New Yorker is compact, easy-to-use and, at about $60,[5] downright cheap. The value of such an affordably priced, comprehensive, and space efficient collection is obvious to librarians, educators, researchers, journalists and virtually anyone else who values access to information. Packaged in earlier technology, such a collection would be exponentially more expensive and cumbersome, requiring hundreds of microfilm rolls or thousands of microfiche cards and large, expensive viewing machines. A complete hard-copy collection of *The New Yorker* would fill a room with thousands of fragile paper volumes, and, as with any of these low-tech options, would cost tens of thousands of dollars.[6] Considering that even a modest collection of periodicals in a public library could easily include scores or even hundreds of titles, the cost differential between new and old media can range from significant to staggering.

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[4] Reader reviews of *The Complete New Yorker* on Amazon.com provide illuminating testament to this proposition: "This collection is addictive and has joined the dog and little else on my short list of things to grab in the event of a fire." Posting of R. Tuckerman to Amazon.com, http://www.amazon.com/gp/product/customer-reviews/1400064740/ref=cm_rev_sort/002-8292035-0431235?customer-reviews.sort_by=%2BsubmissionDate&s=books&x=15&y=10 (Sept. 28, 2005); "I have been obsessively hoarding my NYers for nearly 20 years. Unfortunately, the only available storage space is in the garage—in boxes—which by now are virtually inaccessible. Having the archive on my computer—even with some search glitches—will be thrilling." Posting of L. Greenfield to Amazon.com, http://www.amazon.com/gp/product/customer-reviews/1400064740/ref=cm_rev_next/002-8292035-0431235?ie=UTF8&customer-reviews.sort%5Fby=-SubmissionDate&n=283155&s=books&customer-reviews.start=61 (Oct. 8, 2005); "This is . . . an unbelievable value . . . . [It] comes out to a whopping 1.53 cents (yes cents) an[] issue, or a little less than .80 cents a year! That's right, each issue costs about as much as a bazooka bubblegum." Posting of Robert to Amazon.com, http://www.amazon.com/gp/product/customer-reviews/1400064740/ref=cm_rev_next/002-8292035-0431235?ie=UTF8&customer-reviews.sort%5Fby=-SubmissionDate&n=283155&s=books&customer-reviews.start=71 (Oct. 4, 2005); "As an 85 year old, i.e. even older than the New Yorker . . . I'm very happy with my investment—all I have to do is live long enough to enjoy it." Posting of William Balding "bunyipbill" to Amazon.com, http://www.amazon.com/gp/product/customer-reviews/1400064740/ref=cm_rev_next/002-8292035-0431235?ie=UTF8&customer-reviews.sort%5Fby=-SubmissionDate&n=283155&s=books&customer-reviews.start=11 (Feb. 17, 2006).

[5] *The Complete New Yorker* is available for $59.99. The New Yorker Store, http://www.thenewyorkerstore.com/ (follow "The Complete New Yorker" hyperlink) (last visited Aug. 30, 2006).

[6] *The Complete National Geographic*, a CD-ROM collection of every issue of *National Geographic Magazine* from 1888 (in total, 110 years of the publication) costs less than $100. On microfilm, the same material costs $37,000 and fills 170 rolls of film. Microfiche cards are only available for issues since 1978, and for the 717 issues available on microfiche, the cost is approximately $3,000. Few consumers could or would buy microfilm or microfiche and the expensive machines necessary to read them for home use. "The hard-copy collection of magazines would fill 'an entire room'" and cost thousands of dollars. Jennifer L. Livingston, *Digital "Revision": Greenberg v. Nat'l Geographic Soc'y*, 70 U. CIN. L. REV. 1419, 1435-36 (2002) (quoting the Petition for Writ of Certiorari at 17 n.3, Nat'l Geographic Soc'y v. Jerry Greenberg, 534 U.S. 951 (2001) (No. 01-186)).

The Complete New Yorker, however, is one-of-a-kind. The decision to publish the collection was a calculated risk for *The New Yorker*. Other periodicals seem reluctant to take the same sort of chance and publish digital archives of their periodicals because of the legal gridlock that arose from federal court decisions relevant to digital archiving. The future of *The Complete New Yorker* is uncertain in the current legal landscape. This ambiguity, along with inconsistencies between circuit courts and the reluctance of the Supreme Court to offer further guidance on this important issue, highlights the need for federal legislation clarifying the laws governing digital media collections. Such legislation, which would address unanswered questions in copyright law, is especially necessary in order to bring consistency, fairness and common sense into laws governing digital media collections and to create laws faithful to the underlying objective of the Constitution's copyright clause.[7]

Because digital media collections have nonsensically been interpreted by the Eleventh Circuit[8] to be altogether new works, rather than mere revisions of the original works,[9] publishers have effectively been blocked from producing digital archives of their journals. As a result, the only alternatives for publishers are either to continue producing such collections in the anachronistic format of microfilm and microfiche, or to embark on the cumbersome (and perhaps futile) process of locating each person who contributed to any issue and obtaining permission from each one to create a digital archive. Because under existing case law the task of digital archiving is so cumbersome, the result is drastically reduced availability of information to consumers—for it is simply not reasonable for individual consumers to purchase microfilm viewing machines and several hundred rolls of film per periodical. Many fans of *The New Yorker*, by contrast, have purchased the magazine's DVD-ROM archive to view on their personal computers. As of July 1, 2006, *The Complete New Yorker*

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7 U.S. CONST. art. I, § 8, cl. 8.

8 Nat'l Geographic Soc'y v. Greenberg, 534 U.S. 951 (2001).

9 *See* Greenberg v. Nat'l Geographic Soc'y, 244 F.3d 1267, 1273-75 (11th Cir. 2005). The Copyright Act does not include a definition of "revision" *per se*, but examples of revisions as contrasted with examples of new works were elucidated in House Report 94-1476 as follows:

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

H.R. REP. NO. 94-1476, at 122-3 (1996) (discussing the republication of a contribution to a collective work).

ranked number 2,464 among books sold on Amazon.com.[10]

The Eleventh Circuit's decision in *Greenberg v. National Geographic Society* is most devastating to libraries and their patrons, who are by far the largest consumers of archival collections of periodicals and other journals.[11] This Note explains why public policy demands that Congress enact federal legislation to explicitly classify digital media collections as privileged revisions, so that publishers are free to produce valuable archives, such as *The Complete New Yorker*, without fear of legal retribution. This Note considers this issue from the perspective of libraries, the most prolific purchasers and collectors of periodical collections. Libraries make the most compelling case for the need for such legislation because they serve every sector of the American public, from curious schoolchildren to the researchers that push the frontiers of knowledge.

In an era of evolving technology, federal legislation is necessary to safeguard the future of *The Complete New Yorker* and to release *The Complete National Geographic*, the pioneer of such digital collections, from the legal obstruction imposed by the Eleventh Circuit in its illogical conclusion in *Greenberg v. National Geographic Society*. Such legislation is especially needed to provide the public at large with the most liberal access to information possible. By enriching the resources available to the public, we can vigorously protect the enduring, essential objective of copyright law: "to increase and not to impede the harvest of knowledge."[12]

II. BACKGROUND: COPYRIGHT LAW AND COLLECTIVE WORKS

The United States Constitution authorizes Congress to secure for authors "the exclusive Right to their respective Writings" in order "[t]o promote the Progress of Science and the useful Arts," but only "for limited Times."[13] The logic behind the promotion of progress clause is that without the grant of a limited time monopoly over their works, authors and inventors would not have an incentive to create, and ultimately, society would be deprived of innovation in the arts, the expression of new ideas and the discovery of new information.[14]

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[10] Amazon.com Sales Rank (July 1, 2006), http://www.amazon.com (search for "The Complete New Yorker").

[11] Brief for American Library Ass'n et al. as Amici Curiae Supporting Petitioners at 11-15, Nat'l Geographic Soc'y v. Greenberg, 534 U.S. 951 (2001) (No. 01-186) [hereinafter ALA Brief].

[12] Livingston, *supra* note 6, at 1436 (quoting Harper and Row Publ'g, Inc. v. Nat'l Enters., 471 U.S. 539, 545 (1985)).

[13] U.S. CONST. art. I, § 8, cl. 8.

[14] 1 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 1.03[A] (2001).

In part, therefore, copyright law is designed to bridge the interests of artists and society,[15] to form a middle ground between creators' ownership of their works and the maxim that "information wants to be free."[16] By finding the right balance between these interests, society can benefit from both the economic interests of rights holders and the proliferation of creative ideas. "[J]ust as it's undesirable to underprotect intellectual creations . . . because that will lead to underinvestment in the creation of those new works, it's also undesirable to overprotect creations, which stifles innovation, stifles the sharing of knowledge, and stifles follow-on creativity."[17]

Ultimately, however, copyright law privileges the public's right to ideas over the artist's right to own his work. The primary purpose of copyright law in the United States is not to reward the author, but to secure "the general benefits derived by *the public* from the labors of authors."[18] A keystone of the copyright clause is the economic philosophy and conviction that "encouragement of individual effort by personal gain is the best way to advance public welfare through the talents of authors and inventors in 'Science and useful Arts."[19]

From its seed in the Constitution,[20] additional copyright

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15 The legislative history makes clear that the section was also meant to strike a balance between the rights of contributors and the rights of publishers. H.R. REP. No. 94-1476 (1976).

16 STEWART BRAND, THE MEDIA LAB: INVENTING THE FUTURE AT M.I.T. 202 (1987).

17 Follow-on creation refers to creative works that follow a pioneering first creation, as noted in a 2004 report by the Committee for Economic Development (CED): "Intellectual property law provides a way of allocating the costs associated with creative activity to either the first innovator or to subsequent (or "follow-on") innovators. . . . 'Every artist is a cannibal and every poet is a thief.'" DIGITAL CONNECTIONS COUNCIL, PROMOTING INNOVATION AND GROWTH 15 (Mar. 2004) (quoting U2, *The Fly, on* ACHTUNG BABY (Island 1991)). *See also* Pamela Samuelson, Professor, Univ. of Cal. at Berkeley Sch. of Law and Sch. of Info. Mgmt Sys., Remarks at The Marshall Symposium: The Information Revolution in Midstream: An Anglo-American Perspective at the University of Michigan Rackham School of Graduate Studies (May 30, 1998), *available at* http://www.si.umich.edu/Marshall/docs/p213.htm. The importance of follow-on creativity is aptly explained by the Royal Society of the Arts' Adelphi Charter on Creativity, Innovation and Intellectual Property:

> As we know, creativity and innovation are founded on copying and recombining elements of what already exists and improving upon them. Without that access, it is very doubtful whether classical music could have developed the way that it did. A couple of thousand years of art training based on free copying and mastering of tradition would also never have happened had we had today's laws. By needlessly restricting access, the default terms of copyright law impose economic costs on new creativity and innovation.

Mapping the Issues: Current Problems Facing Creativity, Innovation and Intellectual Property § 5.5, http://www.adelphicharter.org/mapping_the_issues.asp (last visited Aug. 11, 2006).

18 3 1 NIMMER, *supra* note 14, § 1.03[A] (quoting Fox Film Corp. v. Doyal, 286 U.S. 123, 127 (1932)) (emphasis added).

19 *Id.* (quoting U.S. CONST. art. I, § 8, cl. 8).

20 U.S. CONST. art. I, § 8, cl. 8.

legislation has been created, developed and amended for more than two centuries. Successive changes to copyright law have shaped the rights of publishers, authors, the public and artists, and have adapted to new technology and developments in international intellectual property law. Sound recordings, for example, first became eligible for copyright protection in 1972; semiconductor chips became eligible in 1984; and architectural works were not eligible for copyright protection until 1990.[21] The specification of how many years amount to "limited Times," was revised repeatedly by Congress during the twentieth century.[22] Since 1998, the United States Code has defined limited times as creator's life plus seventy years.[23]

The Copyright Act of 1976, which superseded all previous copyright law, was the most comprehensive copyright legislation since 1909 (which had been a "complete revision" of United States copyright laws, urged by members of Congress and President Theodore Roosevelt on the theory that the "law requires adaptation to these modern conditions"[24]). The 1976 Act codified the fair use doctrine,[25] outlined the basic rights of copyright holders,[26] transformed copyright terms from fixed and renewable

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[21] 1 NIMMER, *supra* note 14, § 2.20[A].

[22] *Id.* § 1.05.

[23] 17 U.S.C. § 302 (2006) (applying this definition to works created on or after January 1, 1978). The duration of copyright protection varies based on the type of work at issue. For example, copyright protection of anonymous works, pseudonymous works and works made for hire can endure for up to 120 years. *Id.* § 302. Works created before January 1, 1978, are subject to different term limits. *Id.* §§ 303-304.

[24] House Report 1 on the Copyright Act (1909), *reprinted in* 8 NIMMER, *supra* note 14, at app. 13, 1.

[25] The fair use exception to exclusive rights to a work is delineated in 17 U.S.C. § 107 as follows:

> [T]he fair use of a copyrighted work, including such use by reproduction in copies . . . for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research, is not an infringement of copyright. In determining whether the use made of a work in any particular case is a fair use the factors to be considered shall include—
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> (1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes;
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> (2) the nature of the copyrighted work;
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> (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and
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> (4) the effect of the use upon the potential market for or value of the copyrighted work.
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> The fact that a work is unpublished shall not itself bar a finding of fair use if such finding is made upon consideration of all the above factors.

Id.

[26] The basic rights of copyright holders are stated as:

> [T]he owner of copyright under this title has the exclusive rights to do and to authorize any of the following:

periods to a longer period based on the author's date of death,[27] and incorporated new technology into copyright laws.[28]

Congress drafted the 1976 Act in part to address the issues in copyright law that would be raised in the future by new media forms.[29] As Congress developed the 1976 Act, they were mindful of the innovations in media technology that had swept over American life, including television, radio, motion pictures and the phonograph.[30] They understood that new media forms would continue to have increasing importance in the lives of Americans, and that technology would evolve in both anticipated and unanticipated ways. Even as the drafters developed the new copyright legislation, computer technology advanced rapidly, as mainframes gave way to minicomputers, and the era of the personal computer dawned.[31] On October 2, 1975, Barbara Ringer, register of copyrights, testified before the Subcommittee on Courts, Civil Liberties, and Administration of Justice in the House of Representatives, and discussed major issues that would later be addressed in the finalized version of the 1976 Copyright Act: cable television, library photocopying, fair use and reproduction for educational and scholarly purposes, public and non-profit broadcasting, jukeboxes, mechanical royalty for use of

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> (1) to reproduce the copyrighted work in copies or phonorecords;
> (2) to prepare derivative works based upon the copyrighted work;
> (3) to distribute copies or phonorecords of the copyrighted work to the public by sale or other transfer of ownership, or by rental, lease, or lending;
> (4) in the case of literary, musical, dramatic, and choreographic works, pantomimes, and motion pictures and other audiovisual works, to perform the copyrighted work publicly;
> (5) in the case of literary, musical, dramatic, and choreographic works, pantomimes, and pictorial, graphic, or sculptural works, including the individual images of a motion picture or other audiovisual work, to display the copyrighted work publicly; and
> (6) in the case of sound recordings, to perform the copyrighted work publicly by means of a digital audio transmission.

Id. § 106.

27 The term of protection was extended from a term of fifty-six years after publication under the 1909 Act to the life of the author plus fifty years under the 1976 Act**.** *See id.* §§ 302-304.

28 *See id.* § 102 (subject matter of copyright). *See also* 9 NIMMER, *supra* note 14, at app. 16, 3-4 (providing the comments of Barbara Ringer, Register of Copyrights in the Copyright Office, on the new technologies addressed by the 1976 Act).

29 H.R. REP. NO. 94-1476 (1976), *as reprinted in* 1976 U.S.C.C.A.N. 5659, 5660.

30 *Id.*

31 Otto Friedrich, *Machine of the Year: The Computer Moves In,* TIME MAGAZINE, Jan. 3, 1983, at 14.

music in sound recordings and royalty for performance of recordings.[32]

In addition to the larger objectives of the 1976 Copyright Act, section 201(c) of the Act was developed to address a nagging problem in copyright law: Congress sought to enhance the power of authors, who were frequently forced into unfavorable contracts with publishers who possessed superior bargaining power.[33] Before the 1976 Copyright Act was codified, freelance contributors to publications retained rights to their works only if a notice of copyright in the author's name was published alongside the work. Individual freelancers seeking to have their work published were rarely in a position to demand such an allowance when contracting with publishers; for freelancers, getting their work published usually meant giving up all rights to that work.[34]

The 1976 Act eliminated the disparity of power between struggling contributors and commanding publishing companies by limiting the extent to which authors could sacrifice future rights. After the redrafting, section 201(c) of the Copyright Act stated that unless the contributor expressly transferred additional exclusive copyright entitlements to the publisher, the publisher acquired only the right to reproduce and distribute the collective work as a whole (and the contributor's work as it originally appeared). The contributor retained his or her copyright in the individual piece.[35] The Act thereby

> clarified the scope of the privilege granted to the publisher of a collective work . . . [whereby] absent some agreement to the contrary, the publisher acquires from the author only "the privilege of reproducing and distributing the contribution as

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[32] *The Register of Copyrights on the General Revision of the U.S. Copyright Law 1975 Revision Bill: Hearing on H.R. 2223 Before the Subcomm. on Courts, Civil Liberties and the Admin. of Justice of the H. Comm. on the Judiciary*, 94th Cong. (1975) (statement of Barbara Ringer, Register of Copyrights in the Copyright Office of the Library of Congress), *as reprinted in* 9 NIMMER, *supra* note 14, at app. 16, 3-4.

[33] H.R. REP. No. 94-1476 (1976), *as reprinted in* 1976 U.S.C.C.A.N. 5659. The text of 17 U.S.C. § 201(c) (1978) is as follows:

> Contributions to collective works. 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.

Id.

[34] New York Times Co. v. Tasini, 533 U.S. 483, 494-96 (2001).

[35] The 1976 revision created a presumptive limitation on the rights given away by the author of the contribution to a collective work. Livingston, *supra* note 6, at 1422. Congress intended this change to prohibit publishers of collective works from revising "the contribution itself or includ[ing] it in a new anthology or an entirely different magazine or other collective work." *Id.* at 1435-36 (quoting H.R. REP. NO. 94-1476, at 122-3 (1976)).

> part of that particular collective work, any revision of that collective work, and any later collective work in the same series."[36]

Consequently, section 201(c) of the Copyright Act entitles the publisher to reprint the freelance contribution only in a revision of the entire collective work or in a later collective work in the same series. Thus, the publisher owns only the particular use purchased, not new uses of the author's work. New publications that incorporate the freelancer's contribution are not privileged because they constitute new work, not a revision.[37] Therefore,

> if the *New York Times* licenses an image to be published in its November 1, 2002 issue, and the photographer retains copyright in that image, then the photographer has the right to reproduce that image on T-shirts, coffee mugs, calendars, websites and the like, and in books and other publications. The *New York Times*, on the other hand, has the privilege of using that image in the November 1, 2002 issue of the newspaper, as well as reusing it in revisions of that issue and in later issues of the periodical.
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> That privilege encompasses the reproduction of the image in nonprint iterations of the November 1, 2002 issue, such as microfilm, microfiche, or electronic format, as long as the image is reproduced in the same context in which it appeared in print.[38]

As discussed *infra,* the *Greenberg*, *Tasini* and *Faulkner*[39] cases underscore that the critical issue regarding whether a publisher may reprint a contribution to a collective work is that of "revision." A publisher who has purchased the copyright to a contribution to a collective work may publish that work repeatedly only if the new publication qualifies as a revision of the original collective work. If a new use of the contribution does not qualify as a revision of the original collective work, then the publisher must purchase additional rights to the work. The copyright owned by the publisher does not include new uses of the contribution that do not qualify as revisions of the original collective work.

The question of what qualifies as a protected revision under section 201(c)—including what the definition of a revision encompasses, and whether a revision qualifies as such, regardless

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36 New York Times Co. v. Tasini, 533 U.S. 483, 509 (2001) (Stevens, J., dissenting) (quoting 17 U.S.C. § 201(c) (2000)).

37 *Id.* at 509-11.

38 Naomi Jane Gray, *Reflections on* Tasini *and Beyond: Comment: Analyzing the Publisher's Section 201(c) Privilege in the Wake of* New York Times v. Tasini, 53 CASE W. RES. L. REV. 647, 649 (2003).

39 Faulkner v. Nat'l Geographic Enters., 409 F.3d 26 (2d Cir.), *cert. denied,* Faulkner v. Nat'l Geographic Soc'y, 126 S. Ct. 833 (2005).

of the medium in which it appears—became pivotal in the legal quagmire in which the National Geographic Society found itself, and which *The New Yorker* found itself trying to avoid in the publication of digital archives of their periodicals. The answer to the revision question determines whether digital media collections can legally exist, as is shown by the three landmark cases dealing with collective works of periodicals: *Greenberg v. National Geographic Society*,[40] *Tasini v. New York Times*[41] and *Faulkner v. National Geographic Society*.[42] What qualifies as a revision is the critical issue on which each of the three landmark cases has turned, and ultimately, the answer has enormous implications for the accessibility of information for the American public.

III. *GREENBERG*: A DETOUR OR A DEAD-END FOR DIGITAL COLLECTIONS?

The Complete New Yorker was not the first collection of its kind. From 1995 until 2001, the National Geographic Society sold *The Complete National Geographic*, an unprecedented 30 CD-ROM-set containing a digital reproduction of every issue of *National Geographic* ever published since the magazine was founded in 1888.[43] A virtual tour of the planet and of human history, the collection included a replica of each individual issue, including every photograph, article and advertisement.

The Complete National Geographic covers such salient events of the past century as the liberation of Nazi-occupied Paris,[44] the moonwalks,[45] the renaissance of the American space program in 1981,[46] the aftermath of the Chernobyl meltdown[47] and the devastation of the 1995 Kobe earthquake.[48] It also contains some rather quirky and microscopic stories such as *Nature's Tank*, *The Turtle*[49] and *Porcupines, Rambling Pincushions*.[50] Spanning decades, the issues provide a virtual montage of national histories, including, for example, the modern history of Afghanistan. *National Geographic* published lengthy articles every several years on war-torn Afghanistan, both before and after the Soviet

40 244 F.3d 1267 (11th Cir. 2001).
41 533 U.S. 483 (2001).
42 409 F.3d at 26.
43 Livingston, *supra* note 6, at 1435-36.
44 Frederich Simpich, Jr., *Paris Freed*, NAT'L GEOGRAPHIC, Apr. 1945, at 385.
45 Edwin E. Aldrin, Jr., et al., *Man Walks on Another World,* NAT'L GEOGRAPHIC, Dec. 1969, at 738.
46 John Young et al., *Our Phenomenal First Flight,* NAT'L GEOGRAPHIC, Mar. 1981, at 478.
47 Mike W. Edwards, *Chernobyl-One Year After,* NAT'L GEOGRAPHIC, May 1987, at 632.
48 T.R. Reid, *Kobe Wakes to a Nightmare,* NAT'L GEOGRAPHIC, July 1995, at 112 .
49 Doris M. Cochran, *Nature's Tank, the Turtle,* NAT'L GEOGRAPHIC, Sept. 1952, at 112.
50 Donald A. Spencer, *Porcupines, Rambling Pincushions,* NAT'L GEOGRAPHIC, Aug. 1950, at 247.

occupation. The series began with *The Afghan Borderland Part I: The Russia Frontier*[51] and *Part II: The Persian Frontier* in 1909.[52] It continued with *Every-Day Life in Afghanistan* in 1921,[53] *Afghanistan: Crossroads of Conquerors* in 1968[54] and *Along Afghanistan's War-Torn Frontier* in the June, 1985 issue.[55] The June, 1985 issue featured the magazine's most famous cover photograph: the haunting, sad stare of an Afghan teenage girl with large, round green eyes and a red headscarf.[56]

The Complete National Geographic was a commercial success, and the National Geographic Society released updated versions in 1997, 1998, 1999 and 2000.[57] The pioneering digital collection was pulled from the market in 2001, however, when the Eleventh Circuit held that *The Complete National Geographic* was not a privileged revision of the original works, and, therefore, the National Geographic Society violated the copyrights of its contributors by producing and selling the digital archive.

The case against *The Complete National Geographic*, *Greenberg v. National Geographic Society*, commenced in 1997, when a freelance photographer, Jerry Greenberg, who contributed five assignments to the magazine between 1962 and 1990 challenged the propriety of *The Complete National Geographic*.[58] Greenberg argued that the

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51 Ellsworth Huntington, *The Afghan Borderland. Part I: The Russian Frontier*, NAT'L GEOGRAPHIC, Sept. 1909, at 788.

52 Ellsworth Huntington, *The Afghan Borderland. Part II: The Persian Frontier*, NAT'L GEOGRAPHIC, Oct. 1909, at 866.

53 Frederich Simpich, Jr. and Haji Mirza Hussein, *Every-Day Life in Afghanistan*, 39 NAT'L GEOGRAPHIC, Jan. 1921, at 85.

54 Thomas J. Abercrombie, *Afghanistan: Crossroad of Conquerors,* NAT'L GEOGRAPHIC, Sept. 1968, at 297.

55 Debra Denker, *Along Afghanistan's War-Torn Frontier,* NAT'L GEOGRAPHIC, June 1985, at 772.

56 The April 2002 issue featured an update on the famous green-eyed girl who was now in her thirties when the photographer found her after a relentless search. Alex Chadwick, *'Afghan Girl' Mystery Solved*, NAT'L PUB. RADIO ONLINE (Mar. 13, 2002), http://www.npr.org/programs/morning/features/2002/mar/girl/.

57 More than 1.4 million units of *The Complete National Geographic* had been sold when it was pulled from the market, and the product had brought in revenues of at least $75 million. Petitioners' Brief at 14-15, Faulkner v. Nat'l Geographic Enters. 05-490, 2005 U.S. Briefs 490A, 2005 U.S. S. Ct. Briefs LEXIS 1330, 126 S. Ct. 833 (2005). *The Complete National Geographic* continues to be sold, second-hand, on Amazon.com. Amazon.com, http://www.amazon.com/gp/search/1020046522381857 2?%5Fencoding=UTF8&keywords=Complete%20National%20Geographic&rh=i%3Aaps%2Ck%3AComplete%20National%20Geographic&page=2 (last visited Aug. 30, 2006).

58 Greenberg v. Nat'l Geographic Soc'y, No. 97-3924, 1998 U.S. Dist. LEXIS 18060 (S.D. Fla. May 14, 1998). Jerry Greenberg's contributions to *The National Geographic Magazine* as a freelance photographer included photography for the following articles: Charles M. Brookfield, *Key Largo Coral Reef: America's First Undersea Park*, NAT'L GEOGRAPHIC MAGAZINE, Jan. 1962, at 58; Jerry Greenberg, *Florida's Coral City Beneath the Sea*, NAT'L GEOGRAPHIC MAGAZINE, Jan. 1962, at 70 (Greenberg was both author and photographer); Nathaniel T. Kenney, *Wolves of the Sea*, NAT'L GEOGRAPHIC MAGAZINE, Feb. 1968, at 222; Idaz Greenberg, *Buck Island—Underwater Jewel*, NAT'L GEOGRAPHIC MAGAZINE, May 1971, at 677; and Fred Ward, *Florida's Coral Reefs Are Imperiled*, NAT'L GEOGRAPHIC MAGAZINE, July 1990, at 115.

National Geographic Society had violated section 201(c) of the federal Copyright Act, and that inclusion of his work in *The Complete National Geographic* was not a privileged use—in other words, not a revision—of the collective works that had originally been published.

Because Greenberg and other freelance contributors who joined his suit had not expressly granted the National Geographic Society the digital rights to their works—which would have been impossible at the time of their submissions, prior to the existence of CD-ROM technology—they claimed that any digital reproduction of their work was an unauthorized use. Greenberg objected not only to *The Complete National Geographic's* use of an entirely new introductory, audiovisual sequence featuring one of his photographs,[59] but also to the digital replicas of his work within the replicas of the complete journals in which they had originally been published. Greenberg argued that neither use was a revision; each use, therefore, was an entirely new use which violated his copyright.

The National Geographic Society argued that each use of Greenberg's work in *The Complete National Geographic* was a mere revision of the work, reproduced within its original context, and simply transferred to a digital format. Such reproduction of the images in *The Complete National Geographic* was fully within their copyright privilege as it applied to the collective work, *National Geographic*.[60]

For the court, the issue presented a question of first impression.[61] *The Complete National Geographic* was a novel product made possible only by state-of-the-art technology. The Florida district court granted summary judgment to the National Geographic Society.[62] On appeal, the Eleventh Circuit reversed,[63]

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59 A twenty-nine second introductory sequence, which includes a photograph taken by Greenberg, depicts a series of *National Geographic* covers each of which metamorphoses into a subsequent cover image. The cover, featuring work by Greenberg which was included in the sequence, was on the January, 1962 issue. NAT'L GEOGRAPHIC MAGAZINE, Jan. 1962, at 58.

60 Greenberg v. Nat'l Geographic Soc'y, 244 F.3d 1267, 1270 (11th Cir. 2001).

61 *Id.* at 1268.

62 Greenberg v. Nat'l Geographic Soc'y, No. 97-3924, 1998 U.S. Dist. LEXIS 18060 (S.D. Fla. May 14, 1998).

> The Complete National Geographic [is not] more than trivially different from Society's magazines . . . the evidence produced by Defendants indicates that the Complete National Geographic 'retain[s] enough of Defendants' periodicals to be recognizable as versions of those periodicals.' Consequently, The Complete National Geographic constitutes a 'revision' of Society's magazines within the meaning of 17 U.S.C. § 201(c). Defendants therefore did not improperly reproduce or distribute, in The Complete National Geographic, Greenberg's photographs.

Id. at *10 (quoting Tasini v. New York Times Co., 972 F. Supp. 804, 824 (S.D.N.Y. 1997)).

63 *Greenberg*, 244 F.3d at 1267.

holding that the CD-ROM collection was not a privileged revision. "In layman's terms," wrote Judge Stanley F. Birch, Jr., "the instant product is in no sense a 'revision.'"[64]

For Judge Birch, the question of whether the new use was a revision was a relatively simple one:

> We do not need to consult dictionaries or colloquial meanings to understand what is permitted under §201(c). Congress in its legislative commentary spelled it out: . . . . 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.[65]

The decision of whether or not to classify *The Complete National Geographic* as a revision was not as straightforward as Judge Birch made it appear. A media collection is a hybrid. In a legal sense, a collection is both the same as and different from the original work; although it reproduces the original exactly, a collection includes other material that was not present in the original.

Judge Birch, however, saw the National Geographic Society's novel publication as an entirely new work, not because other issues of the magazine appeared adjacent to the issue viewed by the reader, but because each reproduction had been transformed by digital technology. "The [National Geographic] Society characterizes this case as one in which there has merely been a republication of a preexisting work, without substantive change, in a new medium; specifically, digital format," he wrote. "As discussed . . . , however, this case is both factually and legally different than a media transformation."[66] Judge Birch reasoned that the collection could not possibly qualify as a revision of the original contribution that was encompassed by section 201(c) of the Copyright Act, because *The Complete National Geographic* consisted not just of a replication of the original journal. Rather, the collection was a combination of three distinct elements: the digital replica of the magazine, the introductory audiovisual sequence and a software program.[67]

The National Geographic Society argued that the digital medium in which the reproduction appeared was irrelevant. The Society claimed that transferring their magazines from hard copy to a digital version was the same act as transferring the magazines

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64 *Id.* at 1272.
65 *Id.* (citing H.R. REP. NO. 94-1476, at 122-23 (1976)).
66 *Greenberg*, 244 F.3d at 1273 n.12.
67 *Id.* at 1272-73, 1275.

to microfilm or microfiche, a relatively primitive technology in use since the 1930s,[68] which is considered to be a fully privileged revision under 201(c).[69] National Geographic further argued that just as digital reproductions of the magazine on CD-ROM require the use of a computer to view the archived materials, microfilm and microfiche reproductions of a magazine similarly require the use of a mechanical device to view them.

Yet, an all-important difference between a CD-ROM and microfilm, reasoned Judge Birch, was the presence of copyrighted software: "The computer, as opposed to the machines used for viewing microfilm and microfiche, requires the interaction of . . . computer programs [that] are themselves the subject matter of copyright."[70] The addition of software was crucial and transformative: "While the [digital] storage and retrieval system may be 'transparent' to the unsophisticated computer user, it nevertheless is present and integral to the operation and presentation of the data and images viewed and accessed by the user."[71]

Judge Birch's reasoning is based on the concept that the medium in which a work is reproduced may alter that work. The flaw in Judge Birch's analysis, however, is that media neutrality is an essential concept in copyright law. A copy is itself a media-neutral concept, as evidenced by the language of section 101 of the Copyright Act: "'Copies' are 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*."[72] In other words, a copy is a copy, whether fixed on paper or on film or in bytes. Drafted in 1976, at the dawn of a massive acceleration in the progress of computer and media technology, this language clearly accommodates the use of unforeseen methods of reproducing works and of technology and media not yet imagined. Thus, Judge Birch's findings relied on reasoning that conflicts with the statutory language of copyright law itself.

Despite the flaws in Judge Birch's reasoning in *Greenberg*, the Supreme Court denied certiorari.[73] For the National Geographic Society, the effect of *Greenberg* was catastrophic. Bound by the

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68 Thurmond Clarke Memorial Library, Chapman University, Flashback—Library Media, http://www1.chapman.edu/library/flashbackIT/LibraryMedia.html (last visited Aug. 3, 2006).

69 *Greenberg*, 244 F.3d at 1273.

70 *Id.* at 1273 n.12.

71 *Id.* at 1274 n.13.

72 17 U.S.C. § 101 (2006) (emphasis added).

73 Nat'l Geographic Soc'y v. Greenberg, 534 U.S. 951 (2001) (cert. denied).

Eleventh Circuit's ruling, National Geographic had no choice but to pull *The Complete National Geographic* from the market in 2001.[74]

IV. *TASINI*: THE SUPERLATIVE QUESTION OF CONTEXT

As the Eleventh Circuit released its ruling on *Greenberg*, the Supreme Court was reviewing another digital archiving case, *New York Times Co., Inc., v. Tasini*.[75] The case was factually similar to *Greenberg*; freelance contributors brought suit against their former publishers after the publication of electronic databases that contained journal and newspaper articles that they had contributed to the original print versions. Significantly (and as discussed further, *infra*) on March 22, 2002, when the Eleventh Circuit released its decision on *Greenberg*, the Supreme Court's ruling on *Tasini* was imminent, expected only several weeks later, on June 25, 2001.[76]

In *Tasini v. New York Times*, six freelance contributors filed suit in the Southern District of New York against the New York Times Company, Newsday and Time. Without the plaintiffs' consent, the print publishers had transferred the plaintiffs' works to electronic publishers, LexisNexis (then known as Mead Corporation) and University Microfilms International ("UMI"), for inclusion in digital compilations—electronic databases which users could easily search, using a search mechanism, to retrieve individual articles.[77]

In contrast to *The Complete National Geographic* at issue in *Greenberg*—in which digital compilations were embedded in CD-ROMs containing a century's worth of whole, complete periodicals through which they could browse—*Tasini* centered on electronic archival databases from which users could retrieve individual articles after conducting a search.[78] LexisNexis transformed the

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74 The National Geographic Society spent "millions of dollars" defending its right to publish the collection, with no firm decision. Beam, *supra* note 2.

75 New York Times Co. v. Tasini, 533 U.S. 483 (2001).

76 *Id.*

77 *Id.* at 483.

78 The terms "collection" and "compilation" can sometimes describe the same work, although they have discrete legal meanings under U.S. copyright law. Copyright attaches individually to the discrete parts of a collective work, and copyright attaches to the entirety of a compilation. Section 101 of the Copyright Act defines the terms as follows:

> A "collective work" is a work, such as a periodical issue, anthology, or encyclopedia, in which a number of contributions, constituting separate and independent works in themselves, are assembled into a collective work.
>
> A "compilation" is a work formed by the collection and assembling of preexisting materials or of data that are selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes an original work of authorship. The term 'compilation' includes collective works.

17 U.S.C. § 101 (2006). Thus, *The Complete New Yorker* is both a collection and compilation, but an individual issue of *The New Yorker* is a collection, not a compilation.

freelancers' articles into searchable digital content in the LexisNexis database, which contained hundreds of periodical articles.[79] UMI's products, New York Times OnDisc and General Periodicals OnDisc, were also compilations that allowed users to retrieve articles individually. Users of all three databases viewed the articles they retrieved as individual pieces, or discrete works, and not in the layout in which the article had originally been published.[80]

As in *Greenberg*, the central legal question was whether publication of the articles in the electronic databases was considered a revision or a new work. As a revision, electronic publication would be a privileged use under section 201(c) of the 1976 Copyright Act.[81] If electronic publication did not qualify as a revision, then such publication amounted to infringement of the authors' copyright.[82]

The Southern District granted the publishers' motion for summary judgment.[83] On appeal, however, the Second Circuit reversed, finding that the databases could not qualify as revisions because they had extensively and fundamentally transformed the original work.[84] According to the Second Circuit, the huge databases engulfed the individual articles and periodicals,[85] and did "almost nothing to preserve the copyrightable aspects of the Publisher's collective works."[86]

The publishers petitioned for review by the Supreme Court, and the Court granted certiorari on November 6, 2000,[87] in part to clarify the question of what qualifies as a revision privileged by

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79 The authors had licensed their works for one-time publication in print periodicals. The print publishers subsequently transferred the contents of their periodicals, such as *The New York Times*, *Newsday* and *Time* to electronic publishers like the Mead Corp. (Lexis/Nexis), and the latter distributed the works online. *Tasini*, 533 U.S. at 489-90.

80 *Id.* at 483.

81 17 U.S.C. § 201(c).

82 *Id.*

83 The district court granted summary judgment in favor of the defendants, holding that section 201(c) shielded the defendant publishers from liability because the electronic databases were permissible "revisions" of the original periodicals. Tasini v. New York Times Co., 972 F. Supp. 804, 827 (S.D.N.Y. 1997).

84 Tasini v. New York Times Co., 206 F.3d 161 (2d Cir. 1999).

85 *Id.* at 168.

> [T]here is no feature peculiar to the databases at issue in this appeal that would cause us to view 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 edition of every periodical that it contains.

Id.

86 *Id.*

87 New York Times Co. v. Tasini, 531 U.S. 978 (2000) (cert. granted).

section 201(c).[88] The *Tasini* decision was expected to provide some much-needed and greatly anticipated guidelines for publishers including the National Geographic Society and the New York Times Company, which had expended enormous resources defending themselves against lawsuits brought by freelancers, as well as for courts that were asked to rule on whether a work in question qualified as a revision. The *Tasini* ruling could have been the beginning of a new era of accord between courts, and of clarity in copyright law, at least on the question of revision.

However, Judge Birch issued his *Greenberg* decision[89] in anticipation of the *Tasini* decision, six days before the Supreme Court heard the case.[90] Presumably he may have done so expecting that his findings would echo those of the Supreme Court, or at least share significant points of agreement. Yet, the *Tasini* ruling contrasted sharply with Judge Birch's opinion in *Greenberg* and undermined his reasoning. Rather than provide illuminating and prescient analysis that dovetailed with *Tasini,* Judge Birch's reasoning in *Greenberg* conflicted fundamentally with the Supreme Court's *Tasini* analysis. The *Tasini* opinion, therefore, renders the *Greenberg* opinion, at best, irrelevant.

The Supreme Court affirmed the findings of the Second Circuit in *Tasini*: "[Section] 201(c) does not authorize the copying at issue here," Justice Ginsburg stated, writing for a seven-justice majority.[91] The crux of her reasoning was that although the databases at issue reproduced the individual articles, the databases did not reproduce the context.[92] The articles appeared disembodied from the original layout and separate from the journal or newspaper in which they had originally appeared. Because the articles were retrievable as individual pieces, and not viewable within the context in which they had appeared in the original publication, the use did not qualify as a privileged revision.[93] As a result, the Court found:

> The publishers are not sheltered by [section] 201(c) . . . because the databases reproduce and distribute articles standing alone and not in context, not "as part of that particular collective work" to which the author contributed, "as part of . . . any revision" thereof, or "as part of . . . any later

88 New York Times Co. v. Tasini, 533 U.S. 483 (2001).

89 Greenberg v. Nat'l Geographic Soc'y, 244 F.3d 1267 (11th Cir. 2001). Judge Birch filed his opinion on Mar. 22, 2001. *Id.*

90 New York Times Co. v. Tasini, 533 U.S. 483, 483 (2001).

91 *Id.* at 488.

92 *See, e.g., id.* at 487-89, 501-02, 506, 511.

93 *Id.* at 506.

> collective work in the same series." [Therefore,] [b]oth the print publishers and the electronic publishers . . . have infringed the copyrights of the freelance authors.[94]

The publishers had attempted to de-emphasize the importance of context and argued that the electronic databases constituted revisions of the periodicals and newspapers because they reproduced the particular selection of the articles, even if not the layout of each.[95] However, for the majority, the context in which the revision appeared was essential. "[E]ach article is presented to, and retrievable by, the user in isolation, clear of the context the original print publication presented," wrote Justice Ginsburg.[96] "Each article appears as a separate, isolated 'story'—without any visible link to the other stories originally published in the same newspaper or magazine edition."[97]

"The crucial fact is that the Databases . . . store and retrieve articles separately within a vast domain of diverse texts," Justice Ginsburg reasoned.[98] "Such a storage and retrieval system effectively overrides the Authors' exclusive right to control the individual reproduction and distribution of each Article."[99] Ultimately, "[u]nder 201(c), the question is . . . whether the database itself perceptibly presents the author's contribution as part of a revision of the collective work. That result is not accomplished by these Databases."[100]

The logical implication of the majority's reasoning is that if the articles at issue in *Tasini* had in fact appeared within their full original context—alongside other articles and advertisements—they would have qualified as privileged revisions under section 201(c). *Tasini* therefore undermined Judge Birch's reasoning in *Greenberg*: each article and photograph that made up *The Complete National Geographic* was reproduced in its precise original context, with each periodical appearing exactly as it had when originally published. Because the "database itself perceptibly presents the author's contribution as part of a revision of the collective work,"[101] *The Complete National Geographic* would qualify as a

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94 *Id.* at 488 (quoting 17 U.S.C. § 101 (2000)).

95 Brief of Petitioners at 39-42, New York Times Co. v. Tasini, 533 U.S. 483 (2001) (No. 00-201).

96 *Id.* at 487.

97 *Id.* at 490.

98 *Id.* at 503.

99 *Id.* at 503 (citing 17 U.S.C §§ 106(1), (3) (2006); Ryan v. Carl Corp., 23 F. Supp. 2d 1146 (N.D. Cal. 1998) (holding copy shop in violation of section 201(c)).

100 *Id.* at 504.

101 *Id.* (stating that "[u]nder § 201(c), the question is not whether a user can generate a revision of a collective work from a database" and concluding the print and electronic publishers did not present intact periodicals, thus the author's contribution was not perceptible as part of a revision of the collective work).

privileged revision under section 201(c) as interpreted by the Supreme Court in *Tasini*.

Contrary to Judge Birch's finding that the addition of separate copyrightable software helped render *The Complete National Geographic* a new work, the *Tasini* Court found that factor irrelevant. The freelance work at issue in *Tasini* was enmeshed with other copyrightable work, having been converted into a readable form and searchable database, but this had no bearing on the Court's finding. On the contrary, the *Tasini* decision firmly endorsed the importance of media neutrality in copyright law: "Invoking the concept of 'media neutrality, the Publishers urge that the 'transfer of a work between media' does not 'alter the character of' that work for copyright purposes . . . That [contention] is indeed true."[102]

In *Tasini*, Justice Ginsberg noted the transfer to a digital medium coincided with a removal of the articles from the context of the complete periodical. "[U]nlike the conversion of newsprint to microfilm, the transfer of articles to the databases does not represent a mere conversion of intact periodicals (or revisions of periodicals) from one medium to another. The Databases offer users individual articles, not intact periodicals."[103] Yet, as demonstrated by *The Complete National Geographic*, this was not necessarily the case with all digital reproductions; it was perfectly possible to reproduce periodical articles within their original layout, complete with facing pages and sidebar advertisements.

Ultimately, therefore, although the Supreme Court ruled against the publishers, it had done so by flatly rejecting Judge Birch's reasoning in *Greenberg*. The qualification of a use as a revision depended not on the medium employed, but on the preservation of the work's context. The *Tasini* reasoning, as applied to *Greenberg*, would possibly have meant a win for National Geographic Society. This implication went unconfirmed, however, when the Supreme Court denied certiorari for *Greenberg*.[104]

For the National Geographic Society, *Tasini* was an empty victory, and denial of the petition for certiorari in *Greenberg* meant no explicit rejection of the reasoning that kept *The Complete National Geographic* out of the marketplace and off library shelves. The *Tasini* decision, therefore, brought only enduring confusion, as it seemed to renounce *Greenberg*, but only implicitly.

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102 *Id.* at 502 (citing Brief of Petitioners at 23, N.Y. Times Co. v. Tasini, 533 U.S. 483 (2001) (No. 00-201)).

103 *Id.* at 502.

104 Nat'l Geographic Soc'y v. Greenberg, 534 U.S. 951 (2001).

V. *FAULKNER*: A HOLLOW VICTORY

In 2002, a lawsuit that had been brought against the National Geographic Society by Douglas Faulkner and other past contributors to the magazine, and which was based on facts very similar to those in *Greenberg*, proceeded in the Southern District of New York.[105] Faulkner, a photographer, and others, sued the National Geographic Society for infringement of copyright for inclusion of their work in *The Complete National Geographic*, which they asserted was a non-privileged use of their work.[106]

The National Geographic Society's first legal success in the case came when the Southern District of New York rejected the freelancers' assertion that the National Geographic Society should be deemed collaterally estopped from its defense because the issues were identical to those presented in *Greenberg*.[107] In evaluating the collateral estoppel claim, Judge Lewis A. Kaplan wrote that "[t]he question pertinent to the collateral estoppel issue . . . is whether *Tasini* so altered the environment as to warrant a fresh look at the Section 201(c) revision issue in this case."[108] Indeed, he found, *Tasini* had constituted a change in law:[109] "The change worked by *Tasini* was substantial by any measure."[110] Despite the similarities in the facts in *Faulkner* and *Greenberg*, after *Tasini*, the legal questions had to be considered anew.

The district court ruled in favor of National Geographic.[111] As Judge Kaplan wrote:

> [*The Complete National Geographic*] is not a new collection . . . . Rather, it is a package that contains substantially everything that made . . . [the *National Geographic* magazine] copyrightable as a collective work—the same original collection of individual contributions, arranged in the same way, with each presented in the same context. It is readily recognizable as a variation of the original. Accordingly, the Court holds that [*The Complete*

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105 Faulkner v. Nat'l Geographic Soc'y, 294 F. Supp. 2d 523 (S.D.N.Y. 2003), *aff'd sub nom.* Faulkner v. Nat'l Geographic Enters., 409 F.3d 26 (2d Cir.), *cert. denied*, 126 S. Ct. 833 (2005). Faulkner had initiated his claim in 1997, within days of Greenberg filing suit in the Southern District of Florida; however, the National Geographic Society was granted a stay pending the outcome of *Tasini*, and thereby the suit did not proceed for several years. Petitioners' Brief at 14-15, Faulkner v. Nat'l Geographic Enters. 05-490, 2005 U.S. Briefs 490A, 2005 U.S. S. Ct. Briefs LEXIS 1330, 126 S. Ct. 833 (2005)).

106 *Id.*

107 *Id.* at 532.

108 *Id.* at 534.

109 *Id.* at 537. The court found that the decision in *New York Times Co. v. Tasini* represented an intervening (post-*Greenberg*) change in law, precluding the application of collateral estoppel, and noted that *The Complete National Geographic* is a revision for section 201(c) purposes. *Id.* at 539, 543.

110 *Id.* at 537.

111 *Id.* at 550.

> *National Geographic*] is a revision of the individual print issues of . . . [*National Geographic*]; it respectfully disagrees with so much of *Greenberg* as held otherwise."[112]

The plaintiffs appealed, and in the fall of 2004, *Faulkner* reached the Second Circuit.[113] In early 2005, the Second Circuit affirmed the district court's ruling, holding that the National Geographic Society owned the right to publish an image-based collection in its original context in any medium, as long as the integrity of the original periodical was preserved.[114]

"[W]e hold that, because the original context of the [m]agazines is omnipresent in [*The Complete National Geographic*] and because it is a new version of the [m]agazine, [*The Complete National Geographic*] is a privileged revision."[115] Because the freelance contributions appeared in the context in which they were first published, the use qualified as a protected revision and not as copyright infringement.[116] The Second Circuit's decision was fully congruent with the *Tasini* decision.

As evidence of the successful preservation of context, the court noted that *The Complete National Geographic*

> uses the almost identical "selection, coordination, and arrangement" of the underlying works as used in the original collective works . . . [and] presents an electronic replica of the pages of [*National Geographic*]. Pages are presented two at a time, with the gutter . . . in the middle, and with the page numbers in the lower outside corners, just as they are presented in the written format. In addition, the contents of [*The Complete National Geographic*], including the authors' contributions, are in the same positions relative to the other contributions.[117]

> [T]here are no changes in the content, format, or appearance of the issues of the magazine . . . . Issues of [*National Geographic*] appear chronologically with the first issue published appearing at the beginning of the first disk and the last appearing at the end of the last disk. The individual images and texts are therefore viewed in a context almost identical—but for the use of a computer screen and the power to move from one issue to another and find various items quickly—to that in which they were originally published.[118]

Furthermore, the Second Circuit affirmed the importance of

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112 *Id.* at 542-43.
113 Faulkner v. Nat'l Geographic Enters., 409 F.3d 26 (2d Cir. 2005) (argued Oct. 27, 2004; decided Mar. 4, 2005).
114 *Id.* at 42.
115 *Id.* at 38.
116 *Id.* at 42.
117 *Id.* at 38 (citing Tasini v. New York Times Co., 206 F.3d 161, 168 (1999)).
118 *Faulkner*, 409 F.3d at 31.

media neutrality, explicitly disagreeing with the reasoning of the Eleventh Circuit: "The transfer of a work from one medium to another generally does not alter its character for copyright purposes." The court cited both section 102(a) of the Copyright Act, which defines the subject matter of copyright in general, and *Tasini* as authority.[119]

Ultimately, however, the *Faulkner* decision provided the National Geographic with another hollow victory. The Supreme Court denied certiorari in *Faulkner*[120] even though it undermined *Greenberg* (and did so with the Supreme Court's *Tasini* language), leaving an enduring, unresolved incompatibility of views between the Second and Eleventh Circuits. Despite its victory in *Faulkner*, the National Geographic suffered enormous losses. The Society spent millions of dollars defending itself in suits and appeals,[121] only to lose in the Eleventh Circuit,[122] and have the Supreme Court decline to review the decision.[123]

As a result of the denial of certiorari, courts interpret and apply the same federal copyright statute differently, and the outcome of a case will depend on where the suit is filed. The law regarding digital media collections remains in limbo.[124] With the Supreme Court's subsequent denial of certiorari in late 2005, only new legislation can resolve the dispute and provide the clarity necessary to guide the publishing industry and copyright law.

VI. AFTER *FAULKNER*: LEGAL LIMBO

Although the National Geographic Society emerged triumphant from *Faulkner*, *The Complete National Geographic* is a legal casualty. The National Geographic Society—and to at least some extent, the publishing industry—is effectively bound by an otherwise impotent Eleventh Circuit decision. In an era of state-of-the-art new archiving technology, the practical effect of *Greenberg* is absurd: The public is limited to using 1930's media and machinery.

After *Tasini*, some publishers were effectively obligated to

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119 *Id.* at 40. "'Copyright protection subsists . . . in original works of authorship fixed in any tangible medium of expression.'" *Id.* (quoting 17 U.S.C. § 102(a) (2006)); New York Times Co. v. Tasini, 533 U.S. 483, 502 (2001)).

120 Faulkner v. Nat'l Geographic Soc'y, 126 S. Ct. 833 (2005).

121 Beam, *supra* note 2.

122 Greenberg v. Nat'l Geographic Soc'y, 244 F.3d 1267 (11th Cir. 2001).

123 Nat'l Geographic Soc'y v. Greenberg, 534 U.S. 951 (2001).

124 "Given that the Eleventh Circuit ruled in favor of photographer Greenberg and against National Geographic in 1997 . . . 'you have totally divergent views of the same statutory provision' in different courts." Beam, *supra* note 2 (quoting Terry Adamson, Executive Vice President, National Geographic Society). Edward Klaris, the project director of *The Complete New Yorker* and General Counsel for *The New Yorker* believes *Tasini* "fundamentally undermined" *Greenberg*. *Id.*

remove freelance contributions from their digital publications.[125] New freelance contracts now routinely include digital rights, but such contracts may not always reach past agreements; the problems date from the era when new media technology was emerging and specific new media formats were not explicitly anticipated in contributor-publisher contracts. As a result of *Tasini*, the New York Times Company, for example, removed the works of freelance authors who contributed to the paper from 1980 through 1995 from their electronic archives.[126] As Jeffrey Rosen, legal affairs editor of *The New Republic* opined, this result effectively transforms digital archives into "Swiss cheese."[127]

The cost to publishers of locating, contacting and negotiating with every freelance contributor is simply prohibitive, and removing freelance contributions is the surest way to avoid liability for copyright infringement. As Justice Stevens wrote in his dissent in *Tasini*, this result "undermine[s] the principal benefits that electronic archives offer historians—efficiency, accuracy and comprehensiveness."[128]

In one sense, the publishing industry has moved forward, as is evidenced by the publication of *The Complete New Yorker*, a browseable digital collection of *The New Yorker* issues carefully designed to meticulously follow the *Tasini* reasoning.[129] *The Complete New Yorker* software even incorporates a browse mechanism which took its name from the language of *Tasini*, in light of the implicit call in *Tasini* for a periodical's digital revision to be "flippable."[130] Readers access the digital version of each issue in a similar manner as they would the hard-copy version; by leafing through the magazine page by page, or reading the table of contents and then turning to the desired page.

Legal action has not been brought against *The New Yorker*, and *The New Yorker* general counsel Edward Klaris has expressed confidence regarding the future of the collection.[131] Prior to releasing the digital collection, *The New Yorker* contacted past freelance contributors, to promote the value of making their work available in the new medium.[132] Klaris says that the magazine has

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125 Jeffrey Rosen, *The Supreme Court v. Lexis-Nexis,* THE NEW REPUBLIC, July 9, 2001, at 14.

126 *Id.*

127 *Id.*, at 16.

128 New York Times Co. v. Tasini, 533 U.S. 483, 520 (2001) (quoting Brief for Ken Burns et al. as Amici Curiae Supporting Petitioners at 13, New York Times Co. v. Tasini, 533 U.S. 483, 520 (2001) (No. 00-201)).

129 Beam, *supra* note 2.

130 *Id.*; *Tasini*, 533 U.S. at 492 n.2, 514 n.11.

131 Beam, *supra* note 2.

132 Edward J. Klaris, General Counsel, The New Yorker, Lecture at the Benjamin N. Cardozo School of Law on The Complete New Yorker: Digital Archiving and the Law

received no complaints, formal or informal, from its past writers or other contributors.[133]

With the commercial success and no legal challenges thus far to *The Complete New Yorker*, the publishing industry may have found a path for creating a digital collection that could be deemed privileged under *Tasini*, *Faulkner* and section 201(c) of the Copyright Act. Conceivably, other publishers could follow in the wake of *The New Yorker* by creating proprietary software that conforms to the legal guidelines that arose from the *Tasini* decision.

Yet, producing *The Complete New Yorker* was a legal risk, and no other publisher has produced a similar digital media collection. At least in the Eleventh Circuit, a digital collection remains a new, unprivileged use of copyrighted work. Few, if any, publishers are willing, not only to expend the resources necessary to find every single contributor to their periodicals and negotiate compensation agreements with them, but also to take the risk that any unfound contributors would sue the publisher after the digital media collection was released.

This loss is surely evident to consumers impatient for digital collections of such famously collectible journals as *Architectural Digest*, *Playboy*, *Sports Illustrated*, amongst others. Most importantly, however, are the consequences that the shadow of the Eleventh Circuit decision, has on libraries nationwide.[134] Under the current status quo, libraries, educational institutions and archives must continue to use an outmoded, expensive and cumbersome mode of media storage. Under *Faulkner* and *Tasini*, by contrast, all periodicals and newspapers—from law journals to financial news dailies—would be able to catalog their entire archives onto digital formats. Libraries would be able to expand and shrink their collections at the same time, including more periodicals in their collections but at less cost and in less space.

Together, the unjust position in which the National Geographic Society sits, the uncertainty that remains for the publishing industry and the loss for citizens who are unable to

(Nov. 7, 2005).

133 *Id.*

134 The Eleventh Circuit's ruling ostensibly affects only the states within that circuit. However, practically, the ruling stymies publishers in all jurisdictions because of the impracticability of distributing published material in some states and not others. As the American Library Associated asserted in its amicus brief to the Supreme Court in *Faulkner*, most publishers, seeking to avoid any risk of litigation, would simply elect not to publish digital versions of collective works at all (see Part VII, *infra).* ALA Brief, *supra* note 11, at 16 (citing Respondents' Brief at 1, Faulkner v. Nat'l Geographic Enters. 05-490, 05-504, 05-506, 126 S. Ct. 833 (2005)).

access information contained in digital media collections—even with the availability of technology which makes access to information faster, more fluid and economical—are compelling factors that underscore the need for new copyright legislation. The benefits to all that result from progress in media technology mandate that our policies serve the public's needs.

VII. THE SPECIAL CASE OF LIBRARIES

There are 117,000 libraries in the United States, including those located in schools, college and universities, hospitals, law firms, businesses and military installations, and the thousands of public libraries "in almost every community."[135] Libraries are a vital part of the everyday work performed by lawyers, doctors, journalists, university researchers and millions of students. Libraries also play an important role in the lives of the American public, and their resources determine the quality and quantity of information available to the public. Either through an individual's work, or through an individual's reliance on others, almost everyone depends in some degree on access to libraries.

The American Library Association ("ALA") is an organization of 65,000 librarians[136] dedicated to "the public's right to a free and open information society."[137] An ALA-commissioned study found that sixty-two percent of the public has a library card, indicating that they use their public library.[138] Approximately half of those members use the library for educational purposes.[139] Eighty-eight percent "agreed that libraries are unique because . . . [they provide the public] with access to nearly everything on the Web or in print, as well as personal service and assistance in finding it."[140] Eighty-three percent of respondents "believe that libraries and librarians play an essential role in a democracy."[141]

The American Library Association submitted an amicus brief in support of the certiorari petition by The National Geographic Society for the Supreme Court to review the Eleventh Circuit's decision in *Greenberg*.[142] The American Association of Law

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135 American Library Association, Libraries and You, http://www.ala.org/Template.cfm?Section=librariesandyou (last visited Aug. 30, 2006).

136 As well as "library educators, information specialists, library trustees, and friends of libraries representing public, school, academic, state, and specialized libraries." ALA Brief, *supra* note 11, at 1.

137 *Id.*

138 American Library Association, Public Library Use, http://www.ala.org/ala/alalibrary/libraryfactsheet/alalibraryfactsheet6.htm (last visited Aug. 6, 2006).

139 *Id.*

140 *Id.*

141 *Id.*

142 ALA Brief, *supra* note 11.

Libraries (AALL), the Medical Library Association (MLA) and the Special Libraries Association (SLA), an organization of special librarians who work in corporations, academia and government, joined as amici curiae.[143]

The amici asserted that for each organization, "[a] significant part of their mission is to make available reliable, accessible, comprehensive repositories of back issues of newspapers, magazines, journals and other periodicals."[144] Indeed, the amici wrote, "[m]any institutional and individual members of amici use the very CD-ROM product at issue in this case."[145] The library associations urged the Supreme Court to consider the adverse affect that *Greenberg* would have on libraries and the patrons that they serve. If the Supreme Court declined to affirm the Second Circuit's ruling, they warned that *Greenberg* would remain the "'de facto law of the land,'" even outside of the Eleventh Circuit.[146] The library organizations characterized *Greenberg* as a Luddite decision,[147] pointing out that digital and electronic media are far superior to outmoded technology, such as microfiche and microfilm, in terms of their functionality and user-friendliness, allowing searches, retrieval and use of information that were not possible with older equipment.[148] The ALA wrote that "[c]arried 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."[149]

Most detrimentally, the amici argued, *Greenberg* will have a chilling effect that will ripple throughout society, stifling use by the public of ideas and information.[150] Furthermore, the amici contended that *Greenberg* stifled the availability to the public not just of such mass-market periodicals as *National Geographic*, but of more obscure publications, such as scholarly journals. "These collective works could potentially be made accessible to a broader segment of the population, but not if digital and electronic media collections of them are effectively *per se* impermissible under Section 201(c), as they appear to be under *Greenberg*."[151] The library organizations also emphasized that the archiving and

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143 *Id.* at 2.
144 *Id.*
145 *Id.*
146 ALA Brief, *supra* note 11, at 15.
147 Luddite is defined as "one who is opposed to especially technological change." MERRIAM-WEBSTER'S COLLEGIATE DICTIONARY 739 (11th ed. 2003).
148 *Id.*
149 ALA Brief, *supra* note 11, at 3.
150 *Id.* at 11.
151 *Id.* at 13-14.

preservation of works for future generations would suffer a significant setback unless the Supreme Court overruled *Greenberg*, as libraries had begun turning to digitization as an economical and practical way to preserve the information contained in fragile paper-based resources.[152]

Outmoded technology not only consumes libraries' economic resources, as microfiche and microfilm are more expensive than new media, but perhaps worse, these old technologies consume considerable amounts of valuable space. The ALA urged that the physical resources necessary to store microfilm, and the cumbersome machines necessary to view it, could instead accommodate far more CD-ROM collections and even personal computers.[153] Amici institutions face ever-escalating demands on their physical space and economic resources; as the library organizations explained:

> 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 [*Greenberg*] stands, it would have serious, adverse effects on space requirements of such institutions and potentially increase their costs. This has the collateral effect of reducing the amount of material and variety of sources available to library patrons. It is not an outcome that Section 201(c) requires and therefore constitutes an additional, gratuitous harm to libraries and their patrons.[154]

The library organizations proposed a best case scenario if *Greenberg* and *Faulkner* were both allowed to stand, by default, should the Supreme Court deny certiorari to both:

> If the "best case" result of the present circuit split would be that students, scholars, and other library patrons in Albany, Georgia will not have access to the same resources that are available to those in Albany, New York, this would clearly be at odds with the goals of the federal copyright laws.[155]

As the amici foresaw, the denial of certiorari has yielded the result that the vast majority of publishers will avoid the litigation risk altogether and choose not to bring digital versions of their collective works to the marketplace. Even the most careful distribution model might still subject a publisher or its distributors to being hauled into court in Alabama, Florida, or Georgia and

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152 *Id.* at 14.
153 *Id. at* 11.
154 *Id.* at 16.
155 *Id.*

held liable under the flawed standard of *Greenberg*.[156] As National Geographic stated, they cannot "realistically publish a work that is lawful in three States but unlawful in three others."[157]

Ultimately, as the amici library associations asserted in their brief, "the 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."[158] Because the Supreme Court denied certiorari to both *Greenberg*[159] and *Faulkner*,[160] the adverse affects feared by the library organizations have come to fruition. Relief can come only from the federal legislature.

VIII. A PROPOSAL FOR NEW LEGISLATION

To "increase and not impede the harvest of knowledge,"[161] to bring clarity to publishers who would produce digital media collections, and to release the National Geographic Society from the state of legal limbo in which it seems otherwise destined to remain, Congress should enact legislation targeted at solving the problems previously discussed which appear to have no other solution.

Legislation that would adapt United States copyright law to the realities of the current age of new media technology is overdue and reverberates with another need for intellectual property legislation: Congress has failed to pass database legislation that addresses the concerns of its proponents, despite having a strong example to follow in the directive passed by the European Union.[162] As a result, in the United States, database developers precariously rely on outdated laws that were developed prior to the advent of internet-based databases and are unable to protect many current products which are increasingly available, primarily or exclusively, on the Internet.[163] Under *Feist Publications v. Rural Telephone Service*,[164] a Supreme Court decision from 1991, the Court held that copyright law protects particular expression,

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156 *Id.* (citing Respondents' Brief at 1, Faulkner v. Nat'l Geographic Enters. 05-490, 05-504, 05-506, 126 S. Ct. 833 (2005)).

157 *Id.* (quoting Nat'l Geographic Soc'y v. Greenberg, 534 U.S. 951 (2001), Respondents' Brief, at 1).

158 *Id.* at 3 (quoting Twentieth Century Music Corp. v. Aiken, 422 U.S. 151, 156 (1975)).

159 Nat'l Geographic Soc'y v. Greenberg, 534 U.S. 951 (2001).

160 Faulkner v. Nat'l Geographic Soc'y, 126 S. Ct. 833 (2005).

161 Livingston, *supra* note 6, at 1435-36 (quoting Supplemental Brief of Amici Curiae Magazine Publishers of America, Inc., et al. at 14 (No. 00- 10510-C) (quoting Harper and Row Publ'g, Inc. v. Nat'l Enters., 471 U.S. 539, 545 (1985)).

162 Council Directive 96/9, 1996 O.J. (L 77) (EC).

163 Piper Rudnick, LLP, The IP Report, *The Continuing Battle Over Federal Database Legislation (And What Database Owners Can Do About It)* (May 12, 2004), http://www.envoynews.com/piperrudnick/e_article000252456.cfm.

164 Feist Publ'ns, Inc. v. Rural Tel. Serv. Co., 499 U.S. 340, 349 (1991).

but not the underlying factual information: "only the compiler's selection and arrangement may be protected; the raw facts may be copied at will."[165]

This ruling adequately protected hard-copy databases, such as the telephone directory, which could be copied only laboriously, by hand. However, digital databases can be copied and misappropriated instantly.[166] Proponents of new legislation that would provide *sui generis* protection to digital databases, as does the 1996 European Union directive, have lobbied Congress intensely. These proponents are primarily concerned that lack of legal protection will eliminate incentives for publishers to produce digital databases.[167] However, Congress has repeatedly failed to pass legislation that provides new protection for digital databases.[168]

This Note proposes legislation that explicitly recognizes digital reproductions by publishers of periodical archives, digital reproductions of books and reproductions of other literature, as privileged revisions under section 201(c) of the Copyright Act. Such legislation should include a provision whereby, in the case of freelance contracts entered into prior to the advent of digital archiving, the publisher's rights to produce revisions of the work include the right to produce digital archives in which those works appear, with the caveat that contractual language specifically limiting the publisher's rights in this regard would circumvent the provision.

Second, the legislation should state that new reproductions of the original work made possible by future, currently unknown, technology would carry a presumption of validity that CD-ROM archives never enjoyed.

For freelance contributions made prior to the development of CD-ROM technology (and therefore prior to any possibility that the relevant contracts anticipated digital rights), these rights should be incorporated retroactively into the contractual agreements, giving publishers rights to digital reproductions. Thus, under these circumstances, publishers would have the full right to make digital revisions of those works, just as they have the full right under section 201(c) of the Copyright Act to make revisions that reach the consumer as hard-copy versions. Far from being a departure from the history of copyright law, enacting such legislation would promote the very purpose of the Constitutional

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165 *Id.* at 350.
166 Piper Rudnick, *supra* note 163.
167 *Id.*
168 *Id.*

Copyright Clause, which exists to "promote the Progress of Science and the useful Arts."[169]

Third, the new legislation should provide further clarity by precisely defining a revision. In accordance with *Tasini*, the legislation should define "revision" as a reproduction of the original work that includes the creative context in which the original appeared.[170] Thereby, the legislation would explicitly reject Judge Birch's reasoning in *Greenberg* and fully endorse the *Tasini* and *Faulkner* depiction of revision. *Greenberg*, *Tasini* and *Faulkner* grappled with the definition of a revision and while a predominant understanding has emerged, the decisions in the Eleventh Circuit illustrate that there is still some uncertainty. Rather than allow judges to decide on a case-by-case basis and retroactively define "revision" in each new context, legislation can establish guidelines that define a revision in clear terms, presenting a list of qualities inherent to a revision, regardless of whether that revision appears as a "hard" or "soft" copy.

Fourth, the legislation should promote the concept of media neutrality by explicitly stating that the definition of "copy" provided in Title 17, section 101, is controlling for purposes of interpreting section 201, and that reproductions of original works made in any medium are valid as long as they otherwise qualify as privileged revisions. As technology continues to advance, the absence of support for media neutrality in copyright law can create future conflicts and lawsuits, as evidenced by *Greenberg*, *Tasini* and *Faulkner*. Without a definitive statement that a revision of a creative work qualifies as a revision regardless of the media form in which it is presented, conflicts about this issue will continue to arise. Without a sound policy of media neutrality, the growth of better, more cost effective technology will be impeded, undercutting the fundamental goal behind copyright law, which is to increase the availability of information.

IX. CONCLUSION

If the philosophical underpinning of our copyright laws is the importance of allowing the public to benefit from, access and use information and ideas—a philosophy that also sustains public libraries[171]—then public policy requires that a statutory revision be made to the Copyright Act to allow for the compilation of digital archives by periodicals. As technology continues to rapidly evolve, making possible new media forms and further revisions to

169 U.S. CONST. art. I, § 8, cl. 8.
170 *Tasini,* 533 U.S at 509.
171 *Id.* at 512.

compiled works that are unanticipated by current freelance contracts, the public is in need of federal legislation that provides explicit protection to revisions produced in these new media. Indeed, our legislators have an obligation to serve the public by maximizing the availability of information and to "increase the harvest of knowledge."[172] Such legislation would restore the integrity of our copyright laws, widely increase the availability of information to all and promote the democratic ideals to which we aspire.

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[172] Harper and Row Publ'g., Inc. v. Nat'l Enters., 471 U.S. 539, 545 (1985).

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