

LAW OFFICES  
ANDREW T. MIRSKY

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TEL: (202) 339-0303 • FAX: (202) 339-0302  
EMAIL: ANDY@MIRSKYLEGAL.COM  
INTERNET: WWW.MIRSKYLEGAL.COM

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**COPYRIGHT AND FREELANCERS**  
**Impact of *National Geographic* Decision Post-*Tasini***  
**Relevance to Publishers of *Grokster* Peer-to-Peer File-Sharing Case**

In the last few years there has been a great deal of litigation under copyright law. For publishers with extensive archives, an important issue has been the ability to electronically republish articles originally written by freelancers before the internet and electronic media age began in the late 1980s. A federal appeals court decision this month involving *National Geographic* ruled in favor of publishers reproducing freelancer articles as part of an electronic archive, if published as part of the full republishing of the magazine issue as originally published. The ruling is powerful for publishers but potentially short-lived.

The big recent case in this area was the *Tasini* case, in 2001, where the Supreme Court ruled for freelancer writers and against publishers. *Tasini* held that electronic reproductions of print articles are not permissible “revisions” under copyright law. Publisher electronic reuses of freelancer articles, without permission, therefore infringed the writers’ copyrights. The case applied only to freelance works that were not expressly “works made for hire” under U.S. copyright laws. (Staff writer contributions are, automatically, “works made for hire” under copyright law.) *Tasini* also would not apply to freelance works covered under author agreements that grant rights to republish in electronic media, as author agreements commonly did starting around the mid-1990s. But the case was unclear about one potentially important point: Whether an article republished electronically but not separated from its original context – for example, a magazine article published electronically as part of an electronic reproduction of the whole original magazine – would be permissible. This was not the situation in the *Tasini* case, where the *New York Times* and other publishers had republished articles as stand-alone articles separated from the full publication in which they were originally published. In other words, this question was not on point in *Tasini*.

Two federal appeals courts have now addressed this question, with conflicting decisions. Both cases involved freelancers (photographers and writers) suing *National Geographic* over NG’s use of their material in a CD-ROM compilation of the entire magazine archives dating back to 1888. As distinguished from *Tasini*, however, the *National Geographic* republications presented images of the magazines in full, rather than compiled by article or title listings. At issue were articles and photographs appearing in the context of original folio spreads in the magazines in which they originally appeared, not stand-alone.

The first of these cases was actually decided before the Supreme Court’s *Tasini* decision, in favor of the writers and photographers. That case, in the 11<sup>th</sup> Circuit Court of Appeals in Atlanta, relied on precedents leading up to *Tasini* (and later endorsed by the Supreme Court in *Tasini*) ruling that electronic reproductions of print articles infringed freelancers’ copyrights where author agreements either were not used or, if used, did not grant rights to electronic or “new” media. The second case, decided just this month in the 2<sup>nd</sup> Circuit Court of Appeals in New York, ruled for *National Geographic*, arguing that *Tasini* had effectively changed the law by distinguishing in-context reproductions from stand-alone reproductions.

The distinction is important, of course, because it is the basis of a powerful – and more recent – legal ruling in favor of publishers. However, for at least two reasons the case seems likely to be reviewed by the Supreme Court: First, although this most recent ruling argued that the earlier *National Geographic* case had been superseded by the *Tasini* case, that is far from certain since *Tasini*'s facts did not involve a full-magazine reproduction and in-context article presentation. This is, then, a conflict of the federal courts that eventually will be resolved. Second, even if a viable legal distinction is to be found in this “in-context” republishing concept, for practical purposes the distinction may not be viable. Technology already easily permits parsing of full databases by the most minute search terms and categories. In reality, regardless of a publisher’s intent to recreate the whole issue and play by the rules of this latest ruling, users may inevitably have the very capability that the Supreme Court found unacceptable in *Tasini* four years ago. What results, as the *New York Times* put it this week in the context of the *Grokster* file-sharing case, is a “permanent war” of technology versus publishers, where “the court can do little to alter the spread of technology or the interests of copyright owners to protect their material.”

In this month’s *National Geographic* case, the appeals court ruled that the CD-ROMs were legally equivalent to microfiche and microfilm uses, which are permissible uses reflecting the concept that a publisher owns copyright to the compilation itself, though not perhaps individual contributions. It would seem to make sense to validate uses analogous to microfiche and microfilm; but again, as with many areas of technology, legal developments may be elbowed aside by technological realities. To see why, note the peer-to-peer file sharing case mentioned above (involving *Grokster*, StreamCast Networks and other peer-to-peer networks) being argued this week in the Supreme Court, a case presenting a similar problem of manufacturer intent versus actual consumer use. The controlling legal precedent in the *Grokster* case is the *Sony Betamax* case from 20 years ago. There, Sony was found not to be contributorily responsible for the infringing activity of Betamax users where the product could be shown to have “substantial noninfringing uses” – copying of television programs for personal playback at a later hour (referred to in the *Sony* case as “time shifting”). The issue is back in the courts as technology has marched ahead and, in the argument of the recording industry in *Grokster*, made the *Sony* distinctions into empty protections for content creators. Almost certainly, the reasoning in the *Grokster* case behind a decision about the contributory infringement of technology providers will impact thinking and business practice in the freelancer publishing context, and the practical meaning of “in-context” reproductions.

For now, publisher uses of full-issue PDFs and other format reproductions of archival materials remain in copyright limbo, although with a slightly improved prognosis after this month’s *National Geographic* decision in New York.

If you have any questions about these developments and how they may impact your business, please contact me at (202) 339-0303 or by email at [andy@mirskylegal.com](mailto:andy@mirskylegal.com). Thank you.

Andrew Mirsky