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SECTION 201(c) of the Copyright Act provides that an owner of the copyright in an individual work—e.g., a photograph or an article—published as part of a collective work—e.g., a newspaper or magazine—retains his or her copyright in the individual work. Section 201(c) also makes clear that the publisher of the collective work enjoys a narrow privilege to reproduce or distribute the individual work as part of the collective work or any “revision” thereof.¹ What is far from clear in this age of ever-evolving technology, however, is the scope of the §201(c) privilege.

The scope of the §201(c) privilege is an issue particularly ripe for debate in the wake of the U.S. Supreme Court’s recent denial of certiorari in *Faulkner v. National Geographic Society*, 409 F.3d 26 (2d Cir. 2005), a Second Circuit decision standing in direct conflict with an Eleventh Circuit ruling, *Greenberg v. National Geographic Society*, 244 F.3d 1267 (11th Cir. 2001). Both cases involved publication in electronic form of past issues of National Geographic magazine.

In *Greenberg*, the U.S. Court of Appeals for the Eleventh Circuit held that, because the work at issue had added new features to the collective work, it did not constitute a privileged revision under §201(c). The Second Circuit in *Faulkner*, by contrast, determined that— notwithstanding the addition of new features to the collective work—the work at issue constituted a privileged revision because it presented the individual contribution in the context of the original collective work.

Prior to the Second Circuit’s ruling in *Faulkner*, the U.S. Supreme Court had spoken on §201(c) in *New York Times Co. v. Tasini*, 533 U.S. 483 (2001), instructing that the proper analysis of whether a work constitutes a

privileged revision must focus on whether the work presents the copyrighted work in the context of the edition in which it was originally printed. Nevertheless, the Court’s silence on *Faulkner* and *Greenberg* leaves the proper breadth of the privilege unsettled and the rights of the respective copyright owners uncertain—

of the issues. The pages of the issues in the CNG appear precisely as they did in the print version of the magazines, including the photographs, text, and advertising, among other items.

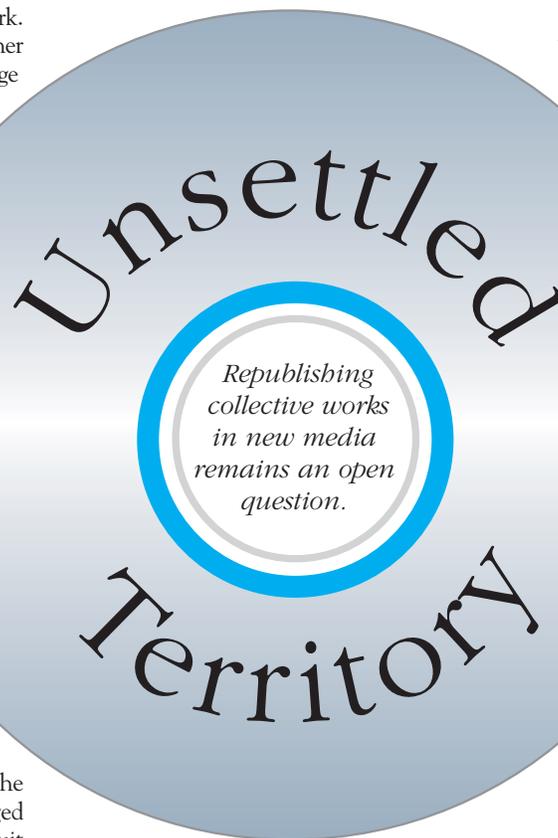
In December 1997, freelance photographers and writers sued National Geographic in federal district courts in New York (*Faulkner*) and Florida (*Greenberg*). Plaintiffs in both actions, who had contributed individual works to National Geographic’s print magazines, alleged that National Geographic infringed their copyrights by failing to obtain authorization to use their works in the CNG. National Geographic argued that the CNG was a privileged “revision” of a collective work under §201(c).

Greenberg was decided first. (*Faulkner* was stayed pending the Second Circuit’s decision in *Tasini*.) The *Greenberg* district court ruled in favor of National Geographic, finding that the CNG constituted a “revision” that National Geographic was privileged to make under §201(c). *Greenberg v. National Geographic Society*, Civ. No. 97-3924, 1998 U.S. Dist. LEXIS 18060 (S.D. Fla. May 14, 1998).

In March 2001, the Eleventh Circuit reversed. *Greenberg v. National Geographic Society*, 244 F.3d 1267 (11th Cir. 2001). In considering the issue, the court admonished that the 201(c) privilege is a “privilege” as opposed to a “right,” which fact “militates in favor of narrowly construing the publisher’s privilege when balancing it against the constitutionally-secured rights of the author/contributor.” *Id.* at 1272.

Because National Geographic had “created a new product..., in a new medium, for a new market that far transcends any privilege of revision or other mere reproduction envisioned in §201(c),” the court held that the CNG infringed the photographs’ copyrights. *Id.* at 1273. Central to the court’s conclusion that the CNG did not fall within the privilege was the CNG’s inclusion of new features, specifically the introductory sequence and the search program. *Id.*

At that time, the *Greenberg* plaintiffs were not the only freelancers litigating over the scope of the §201(c) privilege. The Eleventh Circuit’s decision in *Greenberg* was decided just months before the U.S. Supreme Court addressed the issue in *New York Times Co. v.*



placing publishers in a quandary over whether they can republish collective works in new media without infringing the individual contributors’ copyrights.

‘Greenberg’ and ‘Tasini’

At issue in *Faulkner* and *Greenberg* was National Geographic Society’s creation of a CD-ROM set called “The Complete National Geographic” (CNG), a digital replica of all past issues of National Geographic magazine since 1888. The CNG includes not only the content of the past issues, but also an introductory photographic sequence and a program that allows users to search, view and display pages

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Tasini, 533 U.S. 483 (2001). In *Tasini*, freelance writers sued The New York Times and several other publishers and database owners, alleging claims for copyright infringement arising from the republication of their individual articles—previously published in the print versions of the periodicals—in electronic databases.

The Supreme Court affirmed the Second Circuit's ruling that the writers' copyrights had been violated because the electronic databases at issue "present[ed] articles to users clear of the context provided either by the original periodical editions or by any revision of those editions" and, thus, did not "perceptibly reproduce articles as part of the collective work to which the author contributed or as part of any 'revision' thereof." Id. at 499, 501-02.

In reaching its conclusion, the Supreme Court articulated the proper analysis for determining whether a work falls within §201(c)'s privilege. Thus, the Court instructed that "[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." Id. at 504. In other words, the key is whether the challenged database or compilation, as the case may be, presents the copyrighted work in the context of the edition in which it was originally printed. Id.

Crucial to the Court's ruling that the electronic databases in *Tasini* failed that test was the fact that the databases "store and retrieve articles separately"—offering the users "individual articles" disconnected from "their original context" and not "intact periodicals"—thereby depriving the copyright owners of their exclusive right to control the reproduction and distribution of each individual article. Id. at 501-03. Four months after its ruling in *Tasini*, the Court denied National Geographic's petition for certiorari in the *Greenberg* case.

'Faulkner' Ruling

Following the Supreme Court's *Tasini* decision, the district court in *Faulkner* ruled in favor of National Geographic, holding that "the CNG is a revision of the individual print issues" of the magazine. *Faulkner v. National Geographic Society*, 294 F.Supp.2d 523, 543 (S.D.N.Y. 2003). The *Faulkner* plaintiffs appealed and, in March 2005, the Second Circuit affirmed the district court's ruling. In direct contrast to the Eleventh Circuit's decision in *Greenberg*, the Second Circuit—following the teachings of *Tasini*—held that the CNG constituted a privileged "revision" under §201(c) because "the original context of the Magazines is omnipresent in the CNG and because it is a new version of the Magazine...." *Faulkner*, 409 F.3d at 38.

In support of its conclusion, the court noted that the CNG "presents the underlying works to users in the same context as they were presented to the users in the original versions of the Magazine" and "uses the almost identical 'selection, coordination, and arrangement' of the

underlying works as used in the original collective works." Id. The court rejected the argument that the presence of additional elements in the CNG, such as the introductory sequence of photographs, precluded its privileged status because "these changes do not substantially alter the original context which, unlike that of the works at issue in *Tasini*, is immediately recognizable." Id.

The Second Circuit thus expressly held that "a permissible revision may contain elements not found in the original." Id. (citing the Second Circuit's decision in *Tasini*, 206 F.3d at 167, which noted that §201(c) "protects the use of an individual contribution in a collective work that is somewhat altered.") The court also rebuffed plaintiffs' argument that the Eleventh Circuit's decision in *Greenberg* should be afforded collateral estoppel effect, finding that "the *Tasini* approach so substantially departs from the *Greenberg* analysis that it represents an intervening change

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in law." *Faulkner*, 409 F.3d at 37. Thus, the Second Circuit declared the *Greenberg* analysis to be error because it had focused on the new additions to the digital replica and not—as *Tasini* commanded—on whether the underlying works were presented in the context of the original works.

The *Faulkner* plaintiffs petitioned for certiorari in the U.S. Supreme Court, and National Geographic joined in the request, seeking resolution of the statutory issue on which the Second and Eleventh circuits were in conflict. In support of their petition, the *Faulkner* plaintiffs argued that the Second Circuit erred in its analysis under *Tasini*, because, beyond preserving the original context of the work, the CNG also included new components that changed the collective work, thus barring its status as a §201(c) revision. The Supreme Court, however, denied the petition, allowing the two National Geographic rulings to stand and declining the parties' invitation to address expressly the question of how to handle similar cases going forward.

The Publisher's Predicament

It appears that *Tasini* and *Faulkner* set forth the correct analysis—namely, that §201(c) does not authorize reproduction and distribution of works absent their original context, but additional

elements do not necessarily impact a collective work's status as a privileged revision. But those decisions leave, at best, a standard lending itself to no bright-line application.

Given the rapidly changing state of technology, particularly digital and electronic capabilities, one can easily imagine a situation where the scope of the privilege is once again in flux. What if, for example, a publisher creates an electronic database of collective works whose default is to present those works in their original context, but permits users to retrieve from that context the individual work (such as through a link to a pdf file)? Does the mere possibility that a work may be viewed out of context strip the publisher of its privilege, or does it have to be likely that users will avail themselves of that function?

What happens to the *Tasini* analysis when all users may not perceive the work in the same way? Alternatively, what if many new features are added to the new collective work? In other words, how many new functions are necessary before context is destroyed? Given the elasticity of the analysis fashioned by the Court in *Tasini*, new technology will certainly continue to test its limits.

In the current legal climate, where courts are attempting to balance freelance artists' rights with those of publishers, the Supreme Court in *Tasini* articulated best the most prudent course of action for publishers wishing to avoid a claim of copyright infringement: secure the requisite rights by contract. *Tasini*, 533 U.S. at 505. While, of course, a publisher's desire to use a freelancer's work in what it considers a revision is likely to arise after the initial agreement granting rights was executed, in this arena where many freelancers are likely to seek to work with the publisher in the future, publishers can seek to acquire retroactive rights in a later negotiation with the freelancer.

In sum, with electronic media gaining popularity and increased capabilities at an exponential rate, the scope of §201(c) is likely to be the subject of even greater confusion in the future. Insisting on clear contractual rights will afford publishers more than just the right to reprint photographs or articles of freelancers: It will provide certainty in an otherwise muddled arena.

1. Section 201(c) states: "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." 17 U.S.C. §201(c).