

Here are a
number of
things for
you and Newman.

Free

TO: Jim Pickerell
FAX: (301) 309-0941
FROM: Emily Bass
FAX: (212) 297-3393
DATE: September 8, 1997
RE: Motion to Reargue in *Tasini v. The New York Times et al.*

Dear Mr. Pickerell:

As promised, I'm enclosing a copy of the Motion for Reargument we served and filed last week.

I welcome your interest in the issues and in exploring both sides of the argument.

If, after wading through this much of the argument, you decide that you would like to see the briefs I *originally* filed in the case, we would be only too glad to provide them.

Sincerely,

Emily Bass

~~EA~~ ~~EA~~

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

-----x
JONATHAN TASINI, MARY KAY BLAKELY,
BARBARA GARSON, MARGOT MIFFLIN,
SONIA JAFFE ROBBINS, and DAVID S.
WHITFORD,

93 Civ. 8678 (SS)

Plaintiffs,

-against-

THE NEW YORK TIMES CO., NEWSDAY INC.,
TIME INC., THE ATLANTIC MONTHLY CO.,
MEAD DATA CENTRAL CORP., and
UNIVERSITY MICROFILMS INC.,

Defendants.
-----x

MEMORANDUM OF LAW IN SUPPORT OF PLAINTIFFS'
MOTION FOR REARGUMENT

On August 13, 1997 the Court granted the motion for summary judgment that had been made by five of the defendants, denied plaintiffs' motion for summary judgment and dismissed the complaint. A Judgment entered in accordance the Court's Opinion and Order was docketed on August 19, 1997.

Plaintiffs now move the Court for reconsideration or reargument of its decision pursuant to Rule 6.3 of the Local Civil Rules. They make this motion in compliance with the time limits set forth in Rule 6(a) of the Federal Rules of Civil Procedure and in Local Civil Rules 6.1 and 6.3. Familiarity with the Court's Opinion and Order (hereinafter referred to as "Opinion") is presumed.

Because the purpose of a motion to reargue is not to revisit facts, issues and arguments that the Court has already considered and rejected -- and the Court in this instance gave extensive consideration to a wide range of issues -- the scope of this motion is necessarily narrow. It is limited to a discrete number of facts, arguments and considerations that plaintiffs believe were inadvertently overlooked.

Plaintiffs raise three points.¹

ARGUMENT

I. Given the Court's Findings of Fact and Conclusions of Law, Plaintiff Whitford Was Entitled to Have Summary Judgment Entered In His Favor Against Time Inc.

It is respectfully submitted that the Court overlooked the fact that § 201 of the Copyright Act applies only "[i]n the absence of an express transfer of the copyright or of any rights under it . . .". 17 U.S.C. § 201. Where a freelancer has entered into an agreement in which he or she has given a publisher any rights, it is the contract that governs rather than the statutory provision.

The language of the statute is clear in this regard. See 17 U.S.C. § 201(c). And, indeed, defendants have conceded the point. See, e.g., Transcript of Oral Argument (hereinafter referred to as "Oral Argument") at p. 14, wherein Mr. Keller stated:

¹ By including only certain facts, issues and arguments that the Court overlooked, plaintiffs do not thereby waive the right on appeal to raise other facts, issues and/or arguments that the Court inadvertently overlooked or indeed any other facts, issues and arguments germane to the appeal, including, without limitation, the argument that plaintiffs are entitled to summary judgment as a matter of law on the issue of substantial similarity. (That issue is discussed in Point II, post.)

Congress said, look, how are we going to treat the relationship between the contributors to periodicals and the periodical publishers *in the absence of an express agreement*. This happens so often that we need to create an automatic default mechanism. They did that in 201(c).

(Oral Arg. at p. 14) (emphasis added). See also, Oral Arg. at pp. 17 and 23.²

In the case of plaintiff Whitford's claim against defendant Time Inc., the default mechanism of section 201(c) does not apply. Plaintiffs and defendants agree that there was an express agreement. See Pltfs' Exh. # 23 (Time Inc.'s Responses to Plaintiffs' Requests to Admit) at paras. 13 and 14, wherein Time Inc. admits that document # T000001-T000002 is the "only" written agreement between David Whitford and Sports Illustrated regarding publication, use, and licensing of the article "Glory Amid Grief" and an authentic copy of the "entire agreement."; Defts' Rule 3(g) Statement of Undisputed Material Facts, dated Feb. 22, 1996, at paras. 104 and 105, wherein the defendants admit that Whitford "had an express written agreement with Sports Illustrated concerning

² At page 23, defendants' attorney stated:

... I understand what ... [the Court is] saying when you reach your second point, which is that if you look at the way industry practices have been arranged, they're very careful to spell out what medium you're going to exercise your rights in. That is the beauty of Section 201(c). It defines the copyright relationship between a contributor and a publisher *in the absence of an express agreement*. It is a very narrow automatic transfer by operation of law to cover the gap.

(Oral Arg. at p. 23) (emphasis added). And, again, at p. 17:

... [i]t was meant to deal with a very important situation, how did publishers on a daily basis get these articles without having to sit down and have an individual negotiation every time.

(Oral Arg. at p.17).

the submission of 'Glory Amid Grief' and that agreement "expressly granted Sports Illustrated the right first to publish 'Glory Amid Grief' in Sports Illustrated . . .". See also Oral Arg. at p.89, wherein Mr. Keller acknowledged that plaintiff Whitford is in the "201(c) position" with respect to his contribution to Newsday and "the express contract situation" with respect to his contribution to Sports Illustrated.

Since the Court found that plaintiff Whitford did *not* expressly transfer electronic rights in his article, see Opinion at 18, he was entitled to summary judgment as against defendant Time on the issue of liability.

II. Even Assuming, *Arguendo*, The Validity Of The New Test The Court Has Announced In Those Instances In Which § 201(c) of the Act Applies, Plaintiffs Raised Genuine Issues of Material Fact That Precluded Summary Judgment On The Issue Of Substantial Similarity.

Although plaintiffs respectfully disagree with significant aspects of the Court's interpretation of the Copyright Act and, in particular, of section 201(c) of the Act, they recognize that those issues are only appropriately addressed further on appeal and not here.

We assume, *arguendo*, therefore, for purposes of this motion, that the Court correctly decided that one work constitutes the "revision" of another within the meaning of § 201(c) *if there is "substantial similarity" between the two*. We further assume that the Court correctly decided, in the context of this case, that one of the two ultimate issues presented by the claims against The New York

Times and Newsday³ reduces to the question of whether there is "substantial similarity" between the NEXIS database and UMI CD-ROM disks, on the one hand, and discrete issues of the New York Times and Newsday, on the other.

Since "similarity is in the eye of the beholder," however, see, Kenbrooke Fabrics, Inc. v. Holland Fabrics, Inc., 602 F. Supp. 151, 154 n.2 (S.D.N.Y.1984) (quoting Margaret Wolfe Hungerford, Molly Bawn (1878)), the question then becomes: who is to do "the beholding"? In the Second Circuit, at least – as well as other circuits – the answer is clear: a jury. The test they are to employ is "whether 'the ordinary observer, unless he set out to detect the disparities [between the two works being compared], would be disposed to overlook them, and regard their aesthetic appeal as the same.'" Arca Inst., Inc. v. Palmer, 970 F.2d 1067, 1072 (2d Cir. 1992)(quoting Peter Pan Fabrics, Inc. v. Martin Weiner Corp., 274 F.2d 487, 489 (2d Cir. 1960)(Learned Hand, J.)(material in brackets added); Ideal Toy Corp. v. Fab-Lu Ltd., 360 F.2d 1021, 1022 (2d Cir. 1966).

The jury is to make a visual comparison of the two works in the form in which they are presented to the public, i.e., the form in which they are used. See, e.g., Walker v. Time Life Films, Inc., 784 F.2d 44 (2d Cir.), cert. denied, 476 U.S. 1159, 90 L.Ed.2d 721, 106 S.Ct. 2278 (1986); Warner Bros. Inc. v. American Broadcasting Company, 530 F.Supp. 1187, 1193 (S.D.N.Y.1982)(noting that the proof or disproof of substantial similarity "is in the

³ Assuming the correctness of the Court's position, the other ultimate issue would be whether plaintiffs' contributions were reproduced and distributed "as part of" any revisions that might be found. This, also, in plaintiffs' view, presents an issue of fact for the jury.

viewing"), aff'd, 720 F.2d 231, 239-40 (2d Cir.1983); Peter Pan, 274 F.2d at 489; Soptra Fabrics Corp. v. Stafford Knitting Mills, Inc., 490 F.2d 1092, 1093-1094 (2d Cir. 1974). Depending upon their "spontaneous" and "instantaneous" reaction to the works as so viewed, they are then to decide whether the works are or are not "substantially similar." See Arden v. Columbia Pictures Indus., Inc., 908 F. Supp. 1248, 1258 (S.D.N.Y. 1995); Walker, 784 F.2d at 51.

As long as a fair-minded jury could return a verdict for plaintiffs based on their spontaneous response to such a comparison, summary judgment is inappropriate and the issue should be left to the jury. Churchill Livigstone, Inc. v. Williams & Wilkins, 949 F. Supp. 1045, 1050 (S.D.N.Y. 1996)("as long as reasonable minds could differ on the issue of substantial similarity, summary judgment is inappropriate"). It is only where the issue of substantial similarity is "so clear that a reasonable jury, properly instructed, could find *only one way*," that summary judgment is appropriate. Risdon v. Walt Disney Prod., No. 83 Civ. 6595 (S.D.N.Y. Nov. 2, 1984), Copy. L. Rep. (CCH) p. 25,727(emphasis added); Walker, 784 F.2d at 48 (summary judgment is appropriate when "no reasonable trier of fact could find the works substantially similar"); Warner, 720 F.2d at 239-240(court may determine issue of substantial similarity as a matter of law where "no reasonable jury, properly instructed, could find the two works substantially similar"); Williams v. Crichton, 84 F.3d 581, 587 (2d Cir. 1996)(applied Walker standard).

IMPORTANT!

Plaintiffs respectfully submit either that the Court failed to consider whether the issue of substantial similarity was an issue of fact that should be left to a jury, or, at the very least, that it overlooked the facts referred to below in deciding that the issue of "substantial similarity" could be decided in only one way in this case.

It is not that the Court didn't recite several of these facts in its Opinion. It did. But did it consider these facts in the context of deciding whether reasonable minds could differ as to whether the NEXIS, NYTOD and GPAD databases, on the one hand,⁴ and twenty individual issues of The New York Times and Newsday, on the other, are "substantially similar"?

Plaintiffs respectfully submit that, on the facts in this case, a fair-minded jury could disagree with the Court and find:

. that a database that contains some million or more articles is not substantially similar to an issue of Newsday or The New York Times, each of which contains only some 150 articles;

. that a database that contains news covering a period of some fifteen or more years is not substantially similar to an issue of Newsday or The New York Times, each of which features the news of only one day;

. that a database that is electronically searchable is not substantially similar to an issue of Newsday or The New York Times, neither of which is electronically searchable;

. that a database that permits the user to create new anthologies or collective works by combining any of the million or so articles it contains in new and wondrous ways is not substantially similar to an issue of a periodical, the contents of which is fixed;

⁴ "NYTOD" refers to the "New York Times On Disc" database, and "GPAD" to the "General Periodicals Abstracts" database. Both are sold by UMI on CD-ROM disks.

. that a database that does not contain any photographs, graphics, masthead, captions, weather reports, sports scores (reported in agate), letters to the editor, comics, cartoons and/or a crossword puzzle is *not* substantially similar to an issue of Newsday or The New York Times, each of which does contain those things;⁵

. that an individual article that the ordinary observer can retrieve in full on a computer screen is *not* substantially similar, either in its content, selection or arrangement, to the issue of Newsday or The New York Times in which it originally appeared;

. that even to the extent that he or she can "string" together a series of articles – with an article or two from Newsday or The New York Times being sandwiched in between articles from myriad other periodicals⁶ -- the resulting product is *not* substantially similar to an issue of either Newsday or The New York Times;

. that although there is *one* search that the ordinary observer could perform that would enable him or her to discern or divine the selection of articles that The New York Times or Newsday had made for a particular day's issue of their newspapers,⁷ he or she would have to want to run that *particular* search in order to take advantage of that feature;

. that there are almost an infinite number of *other* searches that the ordinary observer could run that would not result in his gleaning that information; and, finally,

. that, given the fact that, of all of the possible searches available to the ordinary observer, *every single search but one* will generate a selection of articles that is different than the selection of articles that appears in the particular issue of Newsday or The New York Times in which one of the infringed articles appeared, NEXIS, NYTOD and GPAD are not substantially similar to such an issue, even in terms of their selection.

Given that a fair-minded jury could find in this fashion, plaintiffs ask the Court to grant reconsideration and, upon reconsideration, to vacate its entry of

⁵ Newsday contains comics; the New York Times does not.

⁶ Or, similarly, if the observer uses the NYTOD CD-ROM instead of NEXIS and strings together a series of articles – with an article or two from one issue of The New York Times being sandwiched in between 100 or 150 articles from myriad other issues – the resulting product is not substantially similar to a single day's issue of The New York Times.

⁷ The terms for this search would be limited to "the particular publication" and "date" in question.

summary judgment and find that the question of "substantial similarity" is a disputed question of fact that should be left for resolution by a jury.⁸ Continental Distributing Co. v. M/V Sea-Land Commitment, No. 90-4981, 1992 U.S. Dist. LEXIS 8895 (S.D.N.Y. June 22, 1992).

III: **Plaintiffs Did Not Wait Until the Last Minute, As The Court Was Led To Believe, To Argue That The Creation and Distribution of "General Periodicals On Disc" CD-ROM Products Containing Abstracts Of Plaintiffs' Works Violated Their Rights.**

At page 41 of its Opinion, the Court accurately paraphrased one of plaintiffs' central arguments: "In short, plaintiffs complain that defendants not only fail to preserve their collective works, they actively dismantle those works for purposes of electronically exploiting plaintiffs' individuals contributions." The Court then stated the following:

Within this framework, plaintiffs struggle to explain their objections to "General Periodicals OnDisc," which carries photographic images of The New York Times Sunday Magazine and Book Review. *Plaintiffs initially argued that these CD-ROMs do not carry full issues of The New York Times, but only discreet (sic) sections. . . .*

At a December 10, 1996 hearing, plaintiffs turned their attention to the abstracts accompanying the image based discs, arguing that these paragraph length synopses constitute unauthorized derivative versions of plaintiffs' articles. Defendants responded that plaintiffs had not raised this issue in any of their earlier submissions to the Court, and that defendant therefore had not had an opportunity to address the issue in discovery or in argument.

⁸ Plaintiffs further submit that the question *inter alia* of whether plaintiffs' articles have been reproduced and distributed "as part of" the works referred to in section 201(c) is also a disputed question of fact that is appropriately decided by a jury.

(Opinion at 41 n. 12)(emphasis added).

The Court apparently has been misled into believing that plaintiffs 'changed their whole theory of the case'⁹ regarding the CD-ROM technology and, in particular, UMI's "General Periodicals On Disc"¹⁰ at the demonstration that the defendants gave of that technology on December 10, 1996, abandoning an argument that focused exclusively on the "image" part of GPOD¹¹ in favor of an argument that focused exclusively on the "ASCII" part of the product.¹² That is not so. In fact,

plaintiffs raised both the "synopsis" argument and the "less than the entire New York Times" argument¹³ at the same time and raised both *before* the demonstration the defendants gave to the Court on December 10, 1996, and never abandoned either argument,¹⁴

both arguments were dealt with fairly extensively¹⁵ -- albeit in a very fragmented fashion -- at the Oral Argument that was held on October 17, 1996.¹⁶ see excerpts from transcript below;

⁹ The suggestion appears to have been that plaintiffs originally claimed that the "General Periodicals On Disc" product (hereinafter "GPOD") was unlawfully made because it only contained images of the Book Review and Magazine sections of the Sunday *New York Times* as opposed to images of the entire "collective work" and that, on December 10, 1997, plaintiffs switched course and began arguing that the reason GPOD was unlawfully made was because its image database was married to an ASCII text database that contained synopses or abstracts of plaintiffs' works. For ease of reference, plaintiffs shall refer to the first of these arguments as the "not the entire New York Times" argument and the second, as the "synopsis" or "abstracts" argument.

¹⁰ For ease of reference, "General Periodicals On Disc" shall hereinafter be referred to as "GPOD".

¹¹ This is the argument referred to in footnote # 9 as the "not the entire New York Times" argument.

¹² This is the argument referred to in footnote # 9 as the "synopsis" or "abstracts" argument.

¹³ See footnote # 9, *ante*.

¹⁴ Contrary to the impression that the Court apparently had, plaintiffs considered the "synopsis" argument the *more* central and telling of the two arguments and not vice versa, and thought that they had made that clear to the Court. See Oral Arg. at pp. 48, 56 and 58.

¹⁵ The colloquy regarding the GPOD takes up some 10 pages of the transcript.

¹⁶ While I began at page 5 of the Transcript to say that plaintiffs had two points to make regarding the GPOD CD-ROMs, it was not until page 56 of the Transcript that I got to the point of actually being able to make the second point.

. both were dealt with -- as the transcript shows and my memory confirms -- because the Court specifically inquired about the "GPOD";

. my impression was that the Court specifically inquired about the "GPOD" because the "abstracts argument" or "synopsis argument" had been raised in my brief, but not elaborated upon at length due to page limitations;

. I, therefore, *thought* that in laying out the two points that plaintiffs had to make that were peculiar to the GPOD I was doing what the Court wanted and being responsive to its questions;

. By the same token, just at the point that I began discussing the creation and distribution of the abstracts *most* directly, see Oral Arg. at 56, the Court suggested that what it really wanted was *not* further argument, but a hands-on session with the technology. See Oral Arg. at 56. Rightly or wrongly, I took this to mean that if there were in fact a demonstration, further explication with respect to those points was in order;

. Moreover, I made the same points regarding synopses and abstracts that Mr. Reisner objected to my making on December 10, 1996 not only on October 17, 1996, *without objection* from defendants' counsel (i.e., Mr. Keller), but also in my affidavit and opening brief, again without objection. (Affidavit of Emily Bass, dated March 15, 1996 at ¶¶ 53 and 54 and p. 14 n.8; Plaintiffs' Memorandum In Support of Summary Judgment at p. 19 n.19).

We now turn to the portions of the transcript of oral argument where plaintiffs either made or attempted to make the "abstracts" argument, only to be stopped, interrupted or diverted. The portions are numerous. And, while examples of the latter are more numerous than the former, there is absolutely no question but that plaintiffs *made* the "abstracts" argument at the *same time* that they made the "less than the entire New York Times" argument, that they represented to the Court that they thought that the fact that the ASCII database contained abstracts was "important" -- indeed "critical" -- to an understanding of why the GPOD product infringed their rights, and that this position was neither

raised for the first time on December 10, 1996 nor represented a change in plaintiffs' position. Far from something that plaintiffs only thought to raise for the first time at the defendants' GPOD demonstration on December 10, it is clear from the transcript of the oral argument that plaintiffs began to *attempt* to lay out the "abstracts" argument to the Court during the opening exchanges in the argument. See Oral Arg at p. 4, line 9. This occurred, no doubt, because the Court opened the oral argument by asking about the GPOD technology:

THE COURT: "Someone explain to me the CD-ROM technology. I understand Nexis (sic) fairly well, but I don't understand the CD-ROM.

MR. KELLER: Your Honor, Bruce Keller. It is effectively the same thing as Nexis if you're talking about the ASCII type version, which I hold in my hand right here. It's a CD like a musical CD. When you put it in the CD-ROM player, it allows you to retrieve the articles that appear in an issue of the New York Times or other publications just like you can retrieve it off of the microfilm.

THE COURT: That is my question. I am retrieving the entire image of the New York Times, correct?

MR. KELLER: It depends. There's two types of CD-ROM. One is the ASCII version which I hold in my hand. Then it looks very much like what Nexis does to you when you're on line with Nexis. There is the image base which looks exactly like the page of the New York Times or a page that you pull up from the microfilm reader.

THE COURT: UMI is the microfilm reader version is what you're saying?

MR. KELLER: Correct. In any case, Your Honor, they are all the same in that the entire text of any given issue of the New York Times, to use our New York Times example, is there and can be retrieved. It could

be retrieved from this CD-ROM, which is ASCII text based, and it can be retrieved from the image base of the CD-ROM.

THE COURT: Do the CD-ROMs require the creation of a computer database in the same way Nexis does? That is why I was asking about the CD technology. Is the CD-ROM merely a scanner the way a microfilm takes a picture and creates a picture back, or does the technology create a computer database in the same way Nexis does.

MS. BASS: If I may, Your Honor, there are two types of CD-ROMs that are at issue in this litigation. One has been referred to – they both, by the way, are manufactured and distributed by UMI. That's University Microfilms, Inc.

The first CD-ROM is what we have referred to, I believe UMI refers to as New York Times on Disk. That is the one that is essentially equivalent to Nexis. It is a text-only database in which somebody sits down at a UMI work station –

THE COURT: That is the ASCII system?

MS. BASS: That's the ASCII system.

MR. KELLER: Correct, Your Honor.

MS. BASS: The other CD-ROM that is at issue here is called General Periodicals On Disk. That CD-ROM is not a pure image CD-ROM or pure image product. It is what is in effect a part text, part image CD-ROM product.

THE COURT: Please explain that difference to me.

MS. BASS: It is a marriage between two databases, between a text-only database and an image database. So that when an end user sits down at the computer console or a work station, they conduct a search very much like they would conduct a search with the text-only CD-ROM or Nexis. They input search words. *They get back abstracts from the text-only*

database. It is only after they have done their search in the text-only database part of the CD-ROM produce and they decide that they actually want an image of an article that they then give the computer console an instruction to print that article¹⁷ and an image of the full page of that New York – I shouldn't say – it's not exactly a full page of the New York Times. It's only a full page of one or two sections of the New York Times. (emphasis added).

THE COURT: Frankly, whether it's currently one or two sections, if I were to rule that image reflective CD-s were fine whether they gave them a piece or the whole, they would just go out and give them the whole New York Times. I am not sure that that's a distinction with any meaning, that it is a piece or not, although it might be. Because what you are then saying is that they're using a piece of collective work as opposed to the whole, and that's why they're in violation now.

MS. BASS: Right. We make essentially two distinctions with respect to the CD-ROM, Your Honor . . .

(Oral Arg. at pp. 2-5).

I make the first point, that is, that the creation of the image database is unlawful because "it's not the whole issue that is incorporated into the CD-ROM," but only pieces. I neither get to make the second point, i.e., that the creation of the ASCII text database is *also* unlawful nor answer the question the Court posed at page 3 as to whether the GPOD CD-ROM requires the creation of a computer database in the same way that NEXIS does. That is, I don't get to

¹⁷ It would probably have been more accurate, in a descriptive sense, to say "display" rather than print.

make that point or answer that question at that time.¹⁸ Mr. Keller stands and the takes the floor. (Oral Arg. at pp. 5 - 31).

At page 31 of the Transcript, the Court returns to the CD-ROM image product and redirects its attention to me:

THE COURT: Counsel, take the challenge. I have not understood the analytical difference between microfilm and your CD imaging.

No sooner does the Court ask the question, however, and I agree to answer it, then we veer off on a tangent because I have suggested to the Court that I don't believe that NEXIS is a collective work within the meaning of the Act. The Court asks why and I explain. We don't return to the earlier question of "microfilm and how analytically you draw a distinction between that and the CD-ROM imaging" until the bottom of page 40 of the transcript. I begin, on page 41, to explain to the Court that, theoretically, I can see an argument that would permit a publisher to *lawfully* "make microfilm editions of a publication or a periodical" under the rubric of § 201(c) and to display the images on the microfilm spool in strict accordance with the provisions of § 109(c):

MS. BASS: . . . The distinction that I draw is this, Your Honor: when you make a microfilm edition of the New York Times or a microfilm copy of the New York Times, what you are doing is reproducing and distributing the entire collective work and everything in the collective work, and you are only reproducing and distributing individual contributions as part of that collective work and not as separate and apart from it.

¹⁸ I subsequently get to answer the question at page 49, and to explain why the creation of the ASCII database half of the GPOD product is unlawful at pages 56-58 of the transcript.

(Oral Arg. at p. 41).

No sooner do I mention § 109, however, than naturally enough there is a further digression into the ramifications vel non of that section.

At page 45 of the Transcript, the Court opines that it is not sure how what I've been speaking about "is different" from the image product CD-ROM:

THE COURT: . . . According to Mr. Keller, they've gotten the article, you can see the article, you can see a copy of the article on the CD-ROM. So either this gives public display rights –

MR. KELLER: Yes, Your Honor. Let me address this briefly. I think 109(c) proves our case.

THE COURT: I understood that. I am asking Ms. Bass to explain why not. I don't need your argument. I understand yours. I want her to explain why not.

MS. BASS: For two essential reasons, Your Honor. If what we were talking about was a pure image product on a pure image CD-ROM in this case, then I might . . . concede the point. I think under those circumstances a pure CD-ROM product that had an image of the entire issue of the New York Times and could be displayed as is provided for under 109(c) would probably for all intents and purposes be equivalent to the microfilm that we are talking about.

There are two differences, however, with respect to the product that we are talking about in this litigation because it is not a pure image CD-ROM. It is, as I described before, Your Honor, a marriage between two databases. It has a text-only database and it has an image database that is linked to that text-only database.

(Oral Arg. at pp. 45-46).

Once again, I describe the problem with the image database – i.e., that it only contains images of pages from sections of the Sunday Times, not the entire paper or collective work – and, once again, I do not get to the second point before the Court interjects, on page 47 of the Transcript:

THE COURT: Then you have to address this. He says the sections that you have at issue here are different collective works, that there are separate copyrights between – that is your point, isn't it, Mr. Keller? That you have separate collective works in the book review and in the magazine section?

MR. KELLER: Yes. In this connection I have two points. That is one of them. The other is since we are on 109(c), let's not get hung up on the image-based CD-ROM. 109(c) is what we are talking about . . .

At page 48 of the transcript, I resume the train of thought that I had begun, but not been able to finish, on page 5 of the transcript:

MS. BASS: . . . I wanted to go back to the point that what we have in this litigation – let me make two points.

One, as an exhibit that we have appended to our motion for summary judgment makes clear, the New York Times magazine and the Book Review section of the Sunday New York Times, neither of those are separately copyrighted. The copyright office has given us an affidavit, a certified affidavit I believe in the litigation, which we have appended to our papers, saying that neither of those is separately copyrighted separate and apart from the entire Sunday issue of the New York Times.

I go on to say, on page 48, however:

MS. BASS: ***Let's put that issue aside because I think the more fundamental issues here are that, again, you have . . . two databases.*** If you only had a pure image product that was created by a process of scanning an entire edition of the New York Times and

placing an image of the entire New York Times on a CD-ROM disk and then displaying that disk as provided for under 109(c), then I might agree that that was analogous to a microfilm process.

What 109(c) provides, however, is that for you to get the limited display right . . . provided for in that provision the copyright must be *lawfully* made.

(Oral Arg. at p. 48).

I then explain to the Court, on page 49, that there are two respects in which the ASCII part of the UMI image-product is not lawfully created. My first point is that:

MS. BASS: . . . "the database . . . was not lawfully made because the text part of the CD-ROM product, [t]he text-only database was constructed in the same fashion and derives from the same reproductions and contributions as created the Nexis database and the New York Times on Disk database." (Oral Arg. at p. 49).

My second point is that the defendants have created "*derivative work[s]*" from that information and used the derivative works "*as the text database part of the General Periodicals On Disk.*" (Oral Arg. at p. 50).

I repeat this second point in no unmistakable terms in response to a question from the Court as to whether I consider NEXIS and NYTOD works that are derivative of plaintiffs' articles, on pages 54-56:

MS. BASS: ***The only respect in which we have argued that derivative works of the individual contributions are made here is when we're talking about synopses or abstracts of the works.***

THE COURT: OK.

MS. BASS: *What we are calling derivative works, Your Honor, is the taking the individual author's article, creating an abstract, creating a synopsis, creating a very detailed concordance, perhaps creating a searchable lead. If I didn't make that clear in my papers –*

THE COURT: It's been a while since I've used it. Nexis doesn't create synopses or –

MS. BASS: They do with some, Your Honor. Both Nexis and New York Times on Disk have what they call segments, and to some extent they create little synopses. *Where it becomes more important and becomes critical to the functions of the CD-ROM product is actually in the part-text, part-image CD-ROM product, what we call General Periodicals on Disk, because there they create abstracts or synopses that are searched and that come up on line and are viewed by the end user.*

(Oral Arg. at pp. 54-56) (emphasis added).

At that point the Court concluded that it wanted access to copies of the CD-ROM disks so that it could work with them to see how they functioned:

THE COURT: Could I have one or more of you, that is, the side who has greatest access to this, I have Nexis on computer so I have access to it. Could someone get me the two CD-ROMs, not to give me to keep, but give me as court exhibits the two examples of the two CD-ROM mechanisms so that I can use my –

MR. KELLER: We will arrange for that, Your Honor.

(Oral Arg. at p. 56).

After some back and forth as to whether the Court should simply be given the disks, which plaintiffs were in favor of, or whether there should be a more formal hearing or demonstration, which defendants proposed, the colloquy

returned to the substantive issues. At that point, I summed up my previous point:

MS. BASS: [We have talked about the defendants] . . . "infringing the author's copyright by creating derivative works . . . by creating these four things, and that's the synopsis, the abstract, the detailed concordance, and perhaps the searchable lead.

They become very important in terms of the UMI image product that is part-text part-image product. Because the first thing that happens is that the text-only part is searched and comes up and it is available to the viewer, and it is only subsequently that what's printed out at the¹⁹

THE COURT: It looks like the newspaper.

MS. BASS: Looks like the newspaper. . . .

(Oral Arg. at pp. 57-58)(emphasis added).

Plaintiffs also preserved this argument in their opening papers. It is a straightforward argument that does not require much elaboration. Specifically, counsel's affidavit, which gathered together the evidence in the case regarding the manner in which the databases at issue were constructed, clearly stated that:

¶ 53. Unlike the "New York Times On Disc" CD-ROM, the "General Periodicals On Disc" CD-product is created by means of an electronic microform duplication process. (Pltfs' Exh. 31 at 68). The New York Times delivers copies of its Sunday Book Review and Sunday Magazine sections to UMI and UMI takes photographs of each printed page of these sections. (Pltfs' Exh. 31 at 66-68). These photographs are then electronically "scanned" and converted into electronic images. (Pltfs' Exh. 31 at 68).

¹⁹ Or, after switching disks, what is displayed on the screen.

¶ 54. Once the pages of the 200 or so periodicals whose material is represented in general Periodicals OnDisc . . . have been electronically scanned and converted into electronic images, "the electronically scanned images" are then "*link[ed] . . . to an index and abstract database on compact disc.*" (Pltfs' Exh. 50 at U007550).

Affidavit of Emily Bass, dated March 15, 1996 at ¶¶'s 53 and 54.

Likewise, although plaintiffs' opening brief in this matter doesn't devote *separate* sections to the NYTOD and GPOD databases, it clearly articulates the position that the creation and distribution of these databases (or, at least, the text portion of these databases), are every bit as much an infringement of plaintiffs' rights as the creation of the NEXIS database. See Plaintiffs' Memorandum of Law In Support Of Their Motion For Summary Judgment On The Issue Of Liability at p. 19, note 19, wherein plaintiffs state:

IMPORTANT NOTE: Because the "New York Times OnDisc" CD-ROM is principally a disk that contains the New York Times articles and data files available on-line from Mead (on "NEXIS"), any analysis of the manner in which Mead has violated plaintiffs' exclusive rights applies with equal force to UMI. . . . (citation omitted) . . . By the same token, since either this same data *or an abstracted or derivative work based on this data forms the searchable part of UMI's "image product,"* the analysis also applies to the "General Periodicals OnDisc" CD-ROMS. This is so whether the ASCII data that is incorporated into "General Periodical OnDisc" comes from Mead or directly from The New York Times."

Plaintiffs' Opening Mem. at p. 19 n. 19 (emphasis added). In footnote 8 on page 14 of the Bass Affidavit, plaintiffs explained how the New York Times "*prepared abstracts*" for many of its articles and transmitted those abstracts on to Mead.

Note 19 is the only note in all of plaintiffs' papers and, indeed, in the entirety of what the Court has referred to as the voluminous record in this case, to be denominated an "Important Note." That legend was emblazoned on the footnote in order to call the Court's attention to the points made within the note and to ensure their preservation.

In sum, while plaintiffs certainly acknowledge that the "abstracts" argument was never made the centerpiece of the litigation, and counsel acknowledges that it was never treated in discursive fashion in the papers, it simply cannot be said that plaintiffs blindsided either the Court or defendants with this argument on December 10, 1996. Conversely, and more importantly, plaintiffs respectfully submit that they took sufficient steps to preserve the issue and made it an appropriate subject of consideration. Contrary to the defendants' assertion, they simply cannot be said to have been deprived of an opportunity to address this argument – either in Argument or on the papers – or to have been denied a meaningful opportunity to engage in discovery on the question.²⁰

Wherefore, plaintiffs respectfully request that the Court grant reconsideration on this issue and that it decide whether the creation, duplication

²⁰ Since it is the defendants who prepared the abstracts and created the abstracts database, plaintiffs are at a loss to understand how the defendants could have been deprived of any meaningful discovery regarding them. What discovery? Of whom?

Moreover, since plaintiffs inquired about the abstracts database during discovery, *see*, Pliffs' Exh. # 31 (Deposition of UMI representative Patrick Guiant) at pp. 50-52, there is no reason that the defendants couldn't have done likewise.


and distribution of the "ASCII database" that is used both in conjunction with the GPOD -- and as a stand alone product -- infringes plaintiffs' rights.

CONCLUSION

For the reasons stated, plaintiffs respectfully request that the Court grant their motion for reargument or reconsideration in its entirety, that it vacate the judgment that it previously entered in defendants' favor, that it enter summary judgment in Plaintiff Whitford's favor against Defendant Time, Inc., and that it determine whether the General Periodicals Abstracts database infringes plaintiffs' rights.

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Respectfully submitted,


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