

I.

**Congressional Intent as to the
Presumptive Section 201 (c) Privileges**

**A. The House Committee Report is Explicit in Outlining,
with Respect to Individual Contributions to Collective
Works, What Lies Outside the 201 (c) Privileges**

In its October 26, 2000 Memorandum, the Court directed the parties and amici to discuss the following specific language contained in H.R.Rep. No. 94-1476 with respect to the House committee's intent¹ in drafting Section 201 (c) of the Copyright Act

Under the language of this clause . . . **the publisher could not revise the contribution itself or include it [the contribution] in a new anthology or entirely different magazine or other collective work.**

(Emphasis and bracketed material added by the Court) The Court's use of emphasis in that quotation is appropriate: a publisher has only the narrowest of privileges, and only presumptively. The prohibition against including a contribution in a new collective work emerged from a legislative process that in the early stages limited a reproduction privilege solely to the original work containing the author's contribution, and painstakingly evolved into the still-limited presumptive privileges

¹ The Senate committee report adopted exactly the same language of intent. See 8 Melvin and David Nimmer, NIMMER ON COPYRIGHT, App. 4A-17.

that now appear in Section 201 (c). In the 1963 bill prepared by the House committee, the draft of Section 201 (c) limited the presumptive privilege only to "publishing the contribution in that particular collective work." ASMP Br., Ex. A. at 5.² The bill was altered by the committee in 1964 to read "only the privilege of reproducing and distributing the contribution as part of that particular collective work and any revisions of it." That language was ambiguous, according to one of the author representatives, Harriet Pilpel, who advocated that revisions should be limited to the particular collective work in which the contribution first appeared. *Id.* at 8, 10.

The language that now appears in Section 201 (c) was stated first in the 1965 revision bill, which added the provision "any revision of that collective work [not to the individual contribution] and any later collective work in the same series." (Brackets added.) The excerpt quoted above by this Court from the final committee report provides an explication of the final changes. Any revision or "later collective work in the same series" cannot be used in a "new" collective work or an "entirely different" collective work (both terms appear in the report).

² For convenience, citations to the House report are to pages in Appendix A of the brief filed by *Amicus Curiae*, American Society of Media Photographers, Inc. The appendix contains quotations from relevant portions of the House report.

B. The Complete Geographic Product is "New," "Entirely Different," a "Collective Work," and Thus is Outside the Section 201 (c) Privilege Congress Intended

Each of the 1200+ monthly magazines in the Complete Geographic product satisfies the statutory definition of "collective work" in Section 101 of the Act.³ No one disputes that contention. In the language of Section 101, each monthly issue was "selected, coordinated or arranged" (emphasis added) in such a way that each resulting monthly magazine constituted an original work of authorship. Similarly, the Complete Geographic product is a collection of collective works, which also satisfies the statutory definition in Section 101 by the manner in which the collection was selected, coordinated or arranged. See Initial Br. at 30. (Even if regarded as an anthology of collective works, the definitional statute is still satisfied and the committee's prohibitory language applies to the anthology). Moreover, the Complete Geographic product qualifies as an original work of authorship on other grounds than stated in the definition, as set forth *infra*.

³ Section 101 defines a collective work as "a work formed by the collection and assembling of preexisting materials . . . 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."

The next inquiry is whether the Complete Geographic product is “new” or “entirely different” as Congress intended in its prohibition and as Section 201 (c) states.

The Complete Geographic product, which includes the Greenberg photographs, is not “part of *that* particular collective work” as referenced in Section 201 (c), it is not a “revision of *that* collective work,” as contemplated in that section, and it is not a “later collective work in the same series,” the concluding phrase in Section 201 (c). (Emphasis added.) The “same series” could only contemplate some later single issue of the monthly magazine. The new collection or anthology at issue is not in the *same* series, because such a collection or anthology of 1200+ monthly issues never existed before as part of *any* series.⁴ Whether a work is new is largely an empirical question. The Complete Geographic product is “new” or “entirely

⁴ The Society’s constant and improper references to microfilm and microfiche (items never placed in the record for comparative analysis) are directly contradictory of the Society’s admissions in its public filing that the Complete Geographic product is new. There is *no evidence* in the record that such archiving materials were used, or were used in a “series,” or could be compared in any way to the Complete Geographic product. The Society placed no such materials in the record, Greenberg never had an opportunity for discovery on the matter, and the district court did not consider such archiving techniques in ruling on the summary judgment motion below. Moreover, as noted in prior briefs, microfilm archiving enjoys express, limited protection in Section 108. In any event, Greenberg contends that such archival reproduction bears no resemblance, legally or factually, to the Complete Geographic product.

different" because it never existed before. The label on the product box, placed there by the Society, says so. The Society admitted under oath, in its registration filing with the U.S. Copyright Office, that the product is new. All of the monthly collective works placed in the product had been published in the year 1996 or earlier. The registration form said that the new work -- the CD-ROM product -- never existed before 1997.

C. **"Originality" in the Infringing Work is Not Required for Infringement to Exist**

At bottom, to prevail in his infringement claim Greenberg does not have to demonstrate that the Society's⁵ new product embodies sufficient originality to be copyrightable (although he has done so), because the copyrightability of the *infringing work*, or lack of it, is not an element of copyright infringement. "[T]o establish infringement, two elements must be proven: (1) ownership of a valid copyright, and (2) copying of constituent elements of the work that are original." Feist Publications, Inc. v. Rural Tel. Serv. Co., 499 U.S. 340, 361 (1991).

Greenberg's ownership of valid copyrights in the photographs at issue is unchallenged, and the copying of all elements of his photographs is undisputed. Section 106 of the Copyright Act reserves to Greenberg the exclusive right to produce

⁵ As in prior briefs, the term "Society" is intended to encompass all of the Defendants/Appellees.

his work and to distribute it. The Act says that “[a]nyone who violates any of the exclusive rights of the copyright owner . . . is an infringer of the copyright” 17 U.S.C. § 501 (a). Greenberg’s rights have been violated here.

An infringer does not evade liability for infringement by demonstrating that his infringing work is copyrightable -- or not copyrightable. It is simply not part of the infringement equation. Infringer Brown in, say, Missouri, may copy the Greenberg photographs into Brown’s new book and sell it openly on the market with no intention of seeking copyright protection for the new book because he simply doesn’t care about such protection. Nonetheless, Brown’s act of copying and distributing the Greenberg photographs without consent constitutes infringement. “Pirate” radio stations infringe copyrighted musical selections with regularity, and with total disregard for the copyrightability of what they do. It is the copying and republishing of protected works by the Society that constitutes infringement.

To be sure, the Copyright Act provides various defenses for what would otherwise be an infringing act. The only defense ever asserted by the Society is that it is privileged under Section 201 (c) to republish the photographs. That defense fails because none of the three privileged avenues of reproduction applies here. The Society has never asserted any other defense -- fair use, license, estoppel, innocent

intent, substantial similarity -- and the Society has thus waived any right to assert any other defense. (None would apply in any event.)

D. Even if "Originality" Were Required in the Complete Geographic Product, It Exists

If the Court should conclude that the Complete Geographic product must contain sufficient originality for copyrightability in order for infringement to exist, the originality is there. The Appellants discuss these elements at length in their briefs, see Initial Brief at 30; Reply Brief at 8, and to minimize repetition those arguments will be condensed here.

The collection of 1200+ monthly magazines is unprecedented and original. The selection and arrangement components are detailed in Greenberg's Initial Brief at 31-32. As for creative components, the product includes a moving logo of a globe with thematic music, an Eastman Kodak advertisement with sound, a multi-media sequence of moving covers (the "Moving Covers Sequence" that is the basis for Greenberg's other claim), and various software programs that serve as a search engine and that provide for interaction with the Society's Internet site. The Society has conceded that these items are separately copyrightable, and defendant Mindscape separately claimed and registered copyright in incorporated software that it created.

All of these creative additions appear to each of the 30 CD-ROM disks in the product, and are visible to a user each time a disk is opened.

When the creative elements are combined with the editing elements, the level of originality in the Complete Geographic product far exceeds the required threshold.

E. **Conclusion**

The legislative intent expressed in the final report of the House committee, and set forth for the parties by the Court with boldface emphasis, is easily read and understood. The Appellees have infringed Greenberg's photographs by copying them and republishing them in a new collective work, which unquestionably violates Congressional intent as to Section 201 (c).

II.

**The Second Issue Posed by the Court Further Signifies
That the National Geographic Product is a New
Work and Outside the Privileges in Section 201 (c)**

The Court directed the parties and amici to discuss the following issue with respect to the application of Section 201 (c) of the Copyright Act:

Whether a change in the medium (from print to digital) for the collective set of individual issues of the Magazine (each of which constitutes a collective work), integrated together with the Moving Sequence and the Program constitutes a new product, in a new medium, in a new market, that transcends the publisher's privilege in Section 201 (c).

The issue is whether those factors identified by the Court constitute the Complete Geographic product as a new collective work, which Congress said would not be privileged under Section 201 (c). This brief by the Appellants, in Part I, *supra*, contends that the product is unquestionably a collective work, and that it is "new." The Court's inquiry sets forth additional reasons why the product is "new" and is outside the limited publisher's privilege stated in Section 201 (c).

**A. The Copyright Act is "Medium Neutral"
Only for Purposes of Copyrightability**

In order for works of authorship to be eligible for copyright under the Copyright Act, they must be "fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device." 17 U.S.C. Section 102 (a).

Thus it is not important whether the form, manner, or medium of "fixation" be in words, numbers, pictures, or any other graphic method, so long as it is capable of perception directly or by means of any machine or device, in the words of the Act, "now known or later developed." No fixation, no copyrightability.

However, medium neutrality is irrelevant to an analysis of the presumptive privileges afforded in Section 201 (c). Under the undisputed facts of this case, the change in medium and market matter a great deal.⁶

For a very long time, courts have held that unauthorized uses of copyrighted material involving new media and technology are controlled by the language of agreements and the knowledge of the parties at the time of entering into such agreements. In short, a use in a new medium known by the parties at the time of contracting is not infringing; whereas, an unauthorized re-use in a new medium that was inconceivable at the time of contracting is infringing. See, e.g., Rey v. Lafferty, 990 F.2d 1379 (1st Cir. 1993); Murphy v. Warner Brothers Pictures, Inc., 112 F.2d 746 (9th Cir. 1940). Almost always, such issues have arisen in the context of a licensing arrangement between the owner of the copyright and some other party.

Here, no licensing agreement between Greenberg and the Society, with respect to the Greenberg photographs, ever existed, and none of the parties has ever suggested it. Even if such an agreement had existed in the earlier years of the relationship, it was voided by the transfer to Greenberg of all rights in his photographs in the two conveyances executed in 1985 and 1989.

⁶ The very concept of derivative works under the Copyright Act embodies new and different media.

In this case, of course, none of the parties knew about, thought about or even dreamed about CD-ROM technology when Greenberg created and sold his works to the Society. The works were intended to be used only in the magazine issues for which they were created, and no further uses by the Society were anticipated. See Greenberg Affidavit.

**B. The Greenberg Agreements
With the Society Regarding Photographs**

The Court instructed Greenberg to provide, under separate cover, copies of any agreements between Greenberg and the Society "in which Greenberg agreed to permit the Society to use his photographs in National Geographic Magazine." Various documents in response to the directive have been filed separately with the Court. Those documents are identified with particularity in an affidavit by Jerry Greenberg to which the documents are attached.

Greenberg was engaged on four occasions to take photographs that subsequently were published with particular articles in the Society's monthly magazine. The "agreements" as to the first three articles are essentially unilateral statements by the Society to which Greenberg acquiesced. The understandings as to the fourth article, contained in a 1989 agreement, are more detailed and elaborate, particularly as to who would own rights to the photographs to be taken for the

magazine article. Although Greenberg now and then through the years raised concerns regarding ownership and control of his photographs, it is obvious in the filed documents that he was not sophisticated about such arrangements. Greenberg concedes that the Society initially owned all rights to the photographs at issue in this litigation.

On November 15, 1985, Greenberg wrote to ask the Society to assign to him copyrights in all photographs taken by him that had been published in the magazine (at that time, in three articles). In the letter, Greenberg said that the copyright assignment would have no effect on the Society's re-use of the published photographs, because Greenberg believed that any re-use would involve a re-printing of a particular monthly magazine. See Greenberg Affidavit, ¶ 9. Moreover the original contracts with the Society "did not even remotely consider digital reproduction in a for-profit marketplace." Id. On only two occasions did the Society re-print in the Magazine a Greenberg photograph from one of the four published articles, and on both occasions Greenberg consented and was paid. Id.

On December 18, 1985, the Society effected the transfer. The notarized assignment document was executed by the Corporate Counsel, and it assigned "all

right, title and interest, including copyright" to Greenberg. The transfer of rights was unconditional. No right of any kind was reserved by the Society.⁷

In 1989, Greenberg and the Society executed an agreement regarding photographs he would take for an article that eventually was published in the April 1990 issue of the monthly magazine. In paragraph 5 of the agreement, the parties agreed that the Society initially would own all rights to the photographs. However, in paragraph 5 (a), the agreement provided that, after publication in the monthly magazine, all rights to the published photographs would automatically transfer to Greenberg, subject to certain conditions that were unrelated to the substance of the conveyance. The transfer was unconditional. The agreement document contains no reservation of any right by the Society to re-use any of the photographs. The two conveyance documents were placed in the record of this case at an early stage. The Society has never challenged the validity of the documents or the ownership of copyright in the Greenberg photographs. The Society's only position with respect to the photographs is that it was privileged under Section 201 (c) to republish them in the Complete Geographic product.

⁷ Principles of contract law generally control copyright assignments. NIMMER, *supra* at § 10.08. "The distinguishing feature of a partial assignment is a manifestation of intention to make an immediate transfer of part but not all of the assignor's right . . ." Restatement, Contracts 2d § 326, Comment b. The Society's 1985 assignment manifested no such intention.

Thus, whatever initial understandings may have existed as to the Society's use of the Greenberg photographs were negated by the 1985 and 1989 transfers to Greenberg.

C. Because The Complete Geographic Product is a New Product, in a New Medium, in a New Market, It is a New Collective Work and the Inclusion of Greenberg's Photographs is Not Privileged

That the Society is exploiting a new market is clear. There is no question that the Complete Geographic product is in a new medium. It is digitalized, interactive, with moving-fading-morphing elements, music, and searching capability that never existed in any of the monthly Magazines. There is no question that it was intended for a new market: the public (distinguished from a members-only tradition) and the for-profit market.

The Society that Greenberg dealt with, from 1960 to 1990, regarding his photographs that were used in the magazine, was a different institution. Staunchly not-for-profit, the Society in those days was in effect subsidized in its efforts by American taxpayers.

Today, Greenberg's photographs are swept away in unknown (to Greenberg) licensing arrangements, in a digital medium that no one can seriously believe was in his remotest contemplation when he signed-on to shoot photographs for the Society's

magazine, and in a retailing and Internet-oriented marketplace that marks a truly revolutionary departure from what the Society could have dreamed of two or three or four decades ago.⁸

D. Conclusion

As discussed in this brief and earlier ones, Greenberg contends that the Complete Geographic product, for a host of reasons, is a "new" collective work exactly as comprehended by Congress when its legislative intent was explained. The changed medium and marketplace reflected in the Court's directive to the parties amplifies the "new" and "entirely different" character of the product. Apart from the fact that the Society has no rights at all to the photographs, all of the factors manifesting a "new" collective work transcend the Society's privilege under Section 201 (c).

⁸ The First Circuit's discussion of "new uses" in Rey v. Lafferty, *supra* at 1387-89, is useful for this analysis.