

NATIONAL GEOGRAPHIC BEATS INFRINGEMENT RAP IN NEW YORK

In a stunning rejection of the *Greenberg v. National Geographic Society* decision, a federal District Court judge in New York has ruled that *The Complete National Geographic* CD does not violate the copyrights of several freelance photographers.

The photographers—Douglas Faulkner, Fred Ward, David Hiser, Louis Psihoyos and others—filed infringement claims alleging that the National Geographic Society (NGS) used their work on the CD without permission. The CD reproduces back issues of *National Geographic* page by page.

The infringement claims filed in New York were similar to those filed several years ago in a Miami federal court by photographer Jerry Greenberg. Greenberg recently won a \$400,000 jury award for unauthorized use of his images on the NGS CD.

Greenberg won that award after the 11th Circuit Court of Appeals in Atlanta ruled in March 2001 that the CD was not a revision, but a “new product, in a new medium, for a new market” since it contained a search engine and other features the magazines do not have.

Copyright law allows publishers to issue revisions of published works without permission from contributors, but not new works. The distinction is at the heart of all the NGS lawsuits.

The photographers who sued NGS in New York argued that the CD is a new work, not a revision, and noted that the 11th Circuit ruling on Greenberg already determined that.

But the New York District Court, which is under the jurisdiction of the 2nd Circuit Court of Appeals, isn't bound by 11th Circuit decisions. And the New York judge, Lewis Kaplan, said that a Supreme Court ruling that came after the *Greenberg* decision—*Tasini v. New York Times*—cast doubt on the validity of the *Greenberg* decision. (The *Tasini* ruling was handed down in June 2001, several months after the *Greenberg* decision.)

Kaplan refused to rule automatically in favor of the photographers, and considered the merits of arguments on both sides instead.

NGS has argued all along that its CD is a revision of its magazines since it reproduces articles and photos in their original context. Therefore, says NGS, it doesn't need the permission of freelancers to put their works on the CD. NGS has also maintained that the *Tasini* ruling supports its arguments. Kaplan agreed.

Specifically, the *Tasini* ruling barred publishers from reproducing (without permission) freelancers' works in electronic databases or CDs that strip those works out of their original context. Such uses are not revisions, the court said.

Tasini allows reproductions in electronic media as long as the original context of those works is preserved, Kaplan reasoned. And, he said, “[the NGS CD] is precisely comparable to the microforms to which the Supreme Court referred approvingly in *Tasini*.”

He went on to reject the photographers' arguments (and the 11th Circuit's finding) that a search engine on the NGS CD carried it over the legal line from a revision to a new product. Kaplan said the search engine is just a technological improvement, not unlike compiling back issues of NGS in a stiff-bound volume with a searchable index.

“No one here suggests that the NGS's bound volumes and its addition of indices infringe the copyrights of individual contributors,” he wrote. “The material fact is that the content of the product, whether the [CD] or the indexed bound volumes, that users wish to see is identical to the original print versions.”

Kaplan added, “The fact that more purchasers may be interested because

the package is more attractive than a library full of more than 112 years of monthly copies of the magazine is immaterial.”

Through a spokesperson, NGS praised Kaplan's decision as an exoneration of its position.

The photographers were stunned. Photographer Fred Ward called the decision “chilling,” and vowed to appeal.

Accusing Kaplan of bias and having conflicts of interest, Faulkner and his attorney—Stephen Weingrad—filed a motion for reconsideration. But Kaplan was unpersuaded. “[Faulkner and Weingrad] simply disagree with the decision,” he wrote. “That is a basis for appeal but not for reconsideration.”

Joel Hecker, an intellectual property attorney who is not involved in the case, said Kaplan “is on tenuous ground” with the ruling. “He went through machinations to give himself the right to disagree with the 11th Circuit,” Hecker says.

He continues: “It is some comfort to photographers that the Supreme Court refused to hear an appeal on the 11th Circuit *Greenberg* decision. If the Supreme Court thought the *Greenberg* ruling was wrong in light of *Tasini*, they might have taken the *Greenberg* case.” (The Supreme Court decided not to hear the *Greenberg* case on October 8, 2001.)

Hecker notes that if the 2nd Circuit upholds Kaplan's decision, then two circuit courts will be in conflict about whether the NGS CD is a revision or a new product under copyright law—and the Supreme Court may be forced into the fray after all.

Stay tuned.

—David Walker

THE FIGHTS OVER THE NGS CD-ROM: A TIMELINE

DECEMBER 1997 In *Greenberg v. NGS*, photographer Jerry Greenberg sues National Geographic Society for unauthorized use of his photos on a boxed set of CD-ROMs that re-create every issue of *National Geographic*. The federal court for the Southern District of Florida rules in favor of NGS on two counts of copyright infringement pertaining to the CD-ROMs and grants summary judgement. Greenberg appeals.

MARCH 2001 The 11th Circuit Court of Appeals rules that the NGS CD-ROM is not a revision as defined by copyright law but “a new work,” and therefore infringes the copyright of photographer Jerry Greenberg.

JUNE 2001 In *Tasini v. The New York Times*, the U.S. Supreme Court rules that New York Times Online, LexisNexis and other online databases of newspaper articles are new works, not revisions, and their unauthorized use of articles infringes the copyrights of freelance authors.

OCTOBER 2001 NGS appeals *Greenberg* case to the U.S. Supreme Court, but the Court refuses to hear case. *Greenberg* victory stands.

FEBRUARY 2003 After a ruling by the 11th Circuit Court of Appeals in 2002 sends Greenberg's case back to the lower court, a jury awards the photographer \$400,000 for copyright infringement. NGS files a motion for retrial which is still pending.

DECEMBER 2003 Judge Kaplan rejects photographers' claim, rules that the NGS CD-ROM is a revision, and cites Supreme Court ruling in *Tasini*.