
No. 05-16964-JJ

**In the United States Court of Appeals
for the Eleventh Circuit**

JERRY GREENBERG, INDIVIDUALLY

Plaintiff-Appellee,

IDAZ GREENBERG, INDIVIDUALLY

Plaintiff,

v.

NATIONAL GEOGRAPHIC SOCIETY, A DISTRICT OF COLUMBIA CORPORATION,
NATIONAL GEOGRAPHIC ENTERPRISES, INC., A CORPORATION,
MINDSCAPE, INC., A CALIFORNIA CORPORATION

Defendants-Appellants.

**On Appeal From The United States District
Court For The Southern District of Florida**

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TABLE OF CONTENTS

Page(s)

| | |
|--|----|
| TABLE OF AUTHORITIES | ii |
| INTRODUCTION..... | 1 |
| ARGUMENT | 2 |
| I. This Court Should Reconsider <i>Greenberg I</i> 's Holding That National Geographic Is Not Entitled To The Privilege Of § 201(c). | 2 |
| II. The District Court Erred By Striking National Geographic's Answer On Remand, And Thereby Precluding National Geographic From Defending Itself Against Liability For Copyright Infringement. | 12 |
| A. The District Court Erred By Holding That <i>Greenberg I</i> Dictated The Entry Of Judgment In Greenberg's Favor On Liability For Copyright Infringement. | 12 |
| B. The District Court Erred By Holding That Defendants' Answers Were Untimely. | 15 |
| III. The Magistrate Judge Erred As A Matter Of Law By Allowing The Jury To Award Damages For "Willful" Copyright Infringement. | 19 |
| A. Defendants Did Not Engage In "Willful" Infringement By Declining To Withdraw The CNG After <i>Greenberg I</i> | 20 |
| B. Defendants Reasonably Relied On The Advice Of Counsel. | 24 |
| CONCLUSION | 28 |

TABLE OF AUTHORITIES

| Cases | Page(s) |
|---|----------------------------------|
| <i>Burton v. City of Belle Glade</i> , 178 F.3d 1175 (11th Cir. 1999) | 8 |
| <i>Cable/Home Comm. Corp. v. Network Productions, Inc.</i> , 902 F.2d 829 (11th Cir. 1990) | 23 |
| <i>Chudasama v. Mazda Motor Corp.</i> , 123 F.3d 1353 (11th Cir. 1997) | 19 |
| <i>Danjaq LLC v. Sony Corp.</i> , 263 F.3d 942 (9th Cir. 2001) | 22 |
| <i>Faulkner v. National Geographic Enters., Inc.</i> , 409 F.3d 26 (2d Cir.), <i>cert. denied</i> , 126 S. Ct. 833 (2005) | 6, 7, 9, 11 |
| <i>Greenberg v. National Geographic Soc’y</i> , 244 F.3d 1267 (11th Cir. 2001) | 1-3, 5-6, 8, 11-14, 16-17, 20-27 |
| <i>Hamil Am., Inc. v. GFI</i> , 193 F.2d 92 (2d Cir. 1999) | 23 |
| <i>Malautea v. Suzuki Motor Co.</i> , 987 F.2d 1536 (11th Cir. 1993) | 19 |
| <i>MCA Television Ltd. v. Feltner</i> , 89 F.3d 766 (11th Cir. 1996) | 23 |
| <i>N.A.S. Import, Corp., v. Chenson Enters., Inc.</i> , 968 F.2d 250 (2d Cir. 1992) | 22 |
| <i>New York Times Co. v. Tasini</i> , 533 U.S. 483 (2001) | 3, 5, 7, 9, 10 |
| <i>Princeton Univ. Press v. Michigan Document Servs., Inc.</i> , 99 F.3d 1381 (6th Cir. 1996) (<i>en banc</i>) | 22 |

| | |
|--|---------|
| <i>RCA/Ariola Int'l, Inc. v. Thomas & Grayston Co.</i> , 845 F.2d 773 (8th Cir. 1988) | 22 |
| <i>Twin Peaks Productions, Inc. v. Publications Int'l</i> , 996 F.2d 1366 (2d Cir. 1993) | 23 |
| <i>Verkuilen v. South Shore Bldg. & Mortgage Co.</i> , 122 F.3d 410 (7th Cir. 1997) | 17 |
| Statutes | |
| 17 U.S.C. § 201(c)..... | 7 |
| Other Authorities | |
| H.R. Rep. No. 94-1476 (1976), reprinted in 1976 U.S.C.C.A.N. 5659..... | 3, 4, 5 |
| Nimmer, Melville B. & Nimmer, David, <i>Nimmer on Copyright</i> (1996)..... | 21 |
| Rules | |
| Fed. R. Civ. P. 12(a)(1)(A) | 16, 17 |
| Fed. R. Civ. P. 12(a)(4) | 18 |
| Fed. R. Civ. P. 12(e)..... | 18 |
| Fed. R. Civ. P. 56(b) | 16 |

INTRODUCTION

Greenberg cannot and does not deny that this lawsuit is about “foreclosing the public’s computer-aided access to [an] educational and entertaining work,” the Complete National Geographic (CNG). *Greenberg v. National Geographic Soc’y*, 244 F.3d 1267, 1276 (11th Cir. 2001) (*Greenberg I*). To the contrary, Greenberg insists that National Geographic acted wrongfully in not foreclosing such access even sooner, before a jury awarded damages on remand in this case. But that argument only highlights the fundamental problem here: this Court in *Greenberg I* erred in construing a statute that strikes a balance between the rights of publishers and freelancers, and the district court only exacerbated that error on remand by precluding National Geographic from raising any other defenses to liability for copyright infringement. It is both necessary and appropriate for this Court now to correct these errors. To do otherwise, as underscored by *amici* the American Library Association *et al.* and the Magazine Publishers of America, Inc., would not only upset the balance set forth in 17 U.S.C. § 201(c) but also undermine the vital public policy of promoting the preservation and diffusion of collective works in a digital age. Accordingly, this Court should reverse the judgment.

ARGUMENT

I. This Court Should Reconsider *Greenberg I*'s Holding That National Geographic Is Not Entitled To The Privilege Of § 201(c).

As a threshold matter, Greenberg asks this Court to reaffirm its holding in *Greenberg I* that the CNG is not protected by § 201(c). See Greenberg Br. 9-27. Greenberg concedes, as he must, that *Greenberg I* drew a dispositive distinction between a “new collective work” and a “revision”: if a work is deemed a “new collective work” (*i.e.*, a work with new, and independently copyrightable, elements), then by definition it cannot be a “revision” within the meaning of § 201(c). See 244 F.3d at 1272-73; *cf.* Greenberg Br. 1 (“*Greenberg I* deemed that the creation of a new collective work is inherently inconsistent with the creation of a revision.”) (internal quotations omitted); *id.* at 18 (“In *Greenberg I*, this Court rightly concluded that the CNG was outside the privilege in Section 201(c) because ... it is a new collective work.”).

Greenberg I thereby erred, because there is no inherent inconsistency between a “revision” and a new collective work—and no statutory “prohibition,” Greenberg Br. 18, of the latter. To the contrary, as noted in National Geographic’s opening brief, a revised encyclopedia may include new and independently copyrightable elements, and thus may be a new and independently copyrightable collective work, but is nonetheless a “revision” protected by § 201(c). See NGS Br. 2, 22. (Indeed, that very example is set forth in the statute’s legislative history.

See H.R. Rep. No. 94-1476, at 122-23 (1976), reprinted in 1976 U.S.C.C.A.N. 5659, 5738.) Even Greenberg himself tacitly disavows *Greenberg I* by conceding that “independently copyrightable works *can* properly be included in a revision.” Greenberg Br. 22 (emphasis added). *Greenberg I* thus erred by holding that the proper analysis under § 201(c) turns on whether new, and independently copyrightable, elements have been added to a pre-existing collective work.

Indeed, that is the lesson of the Supreme Court’s subsequent decision in *New York Times Co. v. Tasini*, 533 U.S. 483 (2001), which makes it both necessary and appropriate for this Court to reconsider *Greenberg I*. *Tasini* explains that the key inquiry under § 201(c) is whether the “context” of the original collective work has been preserved. *See id.* at 487, 488, 499, 501, 502. That approach reflects the statutory balance between the rights of publishers and freelancers: a publisher may exercise its own rights in a collective work as a whole by reproducing that work in new media, as long as the publisher respects freelancers’ rights in their individual contributions by leaving those contributions in their original context. *See Tasini*, 533 U.S. at 502 (endorsing “the concept of ‘media neutrality,’” and accepting as “true” the proposition that “the transfer of a work between media does not alter the character of that work for copyright purposes.”) (internal quotations and brackets omitted). Nowhere did *Tasini* suggest that the § 201(c) analysis hinges on whether

the publisher has added new, and independently copyrightable elements, or created a new collective work.

Greenberg insists, however, that "*Tasini* is distinguishable ... because it dealt with the disassembly of collective works ... and the random scattering of articles from those works in vast databases." Greenberg Br. 7. That point is true, but merely explains why the publishers lost in *Tasini*, whereas they should win here. In this case, in contrast to *Tasini*, the freelancers' individual contributions remain in the context of the original collective works. Greenberg, as he must, freely concedes this point. *See, e.g.*, Greenberg Br. 14 ("Greenberg's photographs, placed over many years in four separate articles in four separate monthly magazines, still appear in that context in the CNG."); *see also id.* at 12 (original magazines remain "intact" in the CNG).

But, according to Greenberg, "context, while significant, is not controlling." *Id.* at 14. In particular, he argues, "[t]he Supreme Court held that context is only one part of the analysis." *Id.* His sole support for that argument is the following passage from *Tasini*:

It would scarcely "preserve the author's copyright in a contribution" as contemplated by Congress, H.R. Rep. 122, U.S. Code Cong. & Admin. News 1976, pp. 5659, 5738, if a newspaper or magazine publisher were permitted to reproduce or distribute copies of the author's contribution in isolation *or* within new collective works.

Id. (quoting 533 U.S. at 497; emphasis added by Greenberg). In Greenberg's view, "[t]hat word 'or' is significant," because it "expressly sa[ys] ... that the issue of a new collective work, as in *Greenberg I*, is fundamentally a different question from the *Tasini* issue of isolation." *Id.*

That is a gross over-reading, if not an outright distortion, of that passage, especially in light of *Tasini*'s context and holding. Rather than establishing a two-prong test (context *or* new collective work), the passage merely echoes the legislative history's admonition that a publisher may not "revise the contribution itself or include it in a new anthology or an entirely different magazine or other collective work." *Tasini*, 533 U.S. at 497 (quoting H.R. Rep. No. 94-1476, at 122-23, 1976 U.S.C.C.A.N. at 5738). It is not *any* "other collective work" (*i.e.*, any "new" work) that is beyond the scope of § 201(c), but a new collective work (whether a "magazine" or "other collective work") that is "entirely different" from the original collective work (*i.e.*, one that removes the disputed contribution from its original context). Indeed, as noted above, Greenberg himself concedes that a publisher may be entitled to the protection of § 201(c) where new, and independently copyrightable, elements have been added to a collective work (and thus a new, and independently copyrightable, collective work has been created). *See Greenberg Br. 22.*

Tasini thus makes clear that *Greenberg I* erred by focusing on the addition of new, and independently copyrightable, elements to a collective work. Where, as here, a publisher leaves an individual freelance contribution in its original context, the publisher is protected by § 201(c) *regardless* of whether new, and independently copyrightable, elements have been added and a new, and independently copyrightable, collective work has been created. As the Second Circuit recognized, *Greenberg I* conflicts with *Tasini* on this score:

Greenberg held that if a subsequent work contains independently copyrightable elements not present in the original collective work, it cannot be a revision privileged by Section 201(c). Several months later, however, the Supreme Court held in *Tasini* that the critical analysis focused on whether the underlying works were presented by the particular database in the context of the original works. ... In our view, the *Tasini* approach so substantially departs from the *Greenberg* analysis that it represents an intervening change in law rendering application of collateral estoppel inappropriate.

Faulkner v. National Geographic Enters., Inc., 409 F.3d 26, 37 (2d Cir.), *cert. denied*, 126 S. Ct. 833 (2005). *Greenberg* thus errs by asserting that “[t]he *Tasini* analysis does not fit the wholly different set of facts here.” *Greenberg* Br. 14. To the contrary, the *Tasini* analysis governs, and simply leads to a different result on the different facts here.

Curiously, *Greenberg* attempts to use the context point to his advantage, by arguing that the CNG cannot be a “revision” within the meaning of § 201(c) precisely because it leaves the original context intact. *See Greenberg* Br. 16

("[N]othing in any of the original collective works in the CNG was revised.") (emphasis omitted); *id.* ("The Society did not revise any of the underlying collective works by adding updated material or rearranging material in those collective works—the monthly magazines.") (emphasis omitted). That argument is not only unavailing but ironic, since the very reason that National Geographic is entitled to prevail here is that Greenberg's freelance contributions remain in the context of the original collective works.

It is simply not true, as Greenberg asserts, that a "revision" necessarily entails "re-mak[ing] or updat[ing]" a collective work. *Id.* at 24. Rather, as *Tasini* explained, "'Revision' denotes a new 'version,' and a version is, in this setting, a 'distinct form of something regarded by its creator or others as one work.'" 533 U.S. at 500 (quoting Webster's Third New International Dictionary 1944, 2545 (1976)). To put the original paperbound magazines on CD-ROM is to create a "distinct form" (and hence a "revision") of those magazines, *see Faulkner*, 409 F.3d at 38—or alternatively, as National Geographic noted in its opening brief, *see* NGS Br. 18—"th[e] particular collective work" itself in a new medium, 17 U.S.C. § 201(c). Indeed, like the CNG, both microfilm and microfiche (which *Tasini* cited as examples of technologies that comply with § 201(c), *see* 533 U.S. at 501) do not alter a collective work itself, but produce an exact image of every page of the original collective work. Greenberg's interpretation—whereby the word

“revision” *requires* a publisher to alter the context of the original collective work—would essentially read the word out of the statute, by requiring a publisher to do what *Tasini* prohibits.¹

Greenberg strays even further from the statute by arguing that the real problem here is the addition of “elements that were never *essential* to a republication of the monthly magazines themselves.” Greenberg Br. 18 (emphasis modified); *see also id.* (asserting that the CNG’s computer program contains “numerous nonessential features”). As noted above, nothing in § 201(c) negates the privilege where new, and independently copyrightable, elements are added to a collective work, regardless of whether those elements are deemed “essential” or “nonessential” (a point on which no factual record has been established here).²

¹ Greenberg errs by asserting that “the Court in *Greenberg I* rejected the contention that the CNG constitutes a revision under Section 201(c)” because “[t]he only collective works within the CNG are issues of monthly magazines, and not one of them was revised in any way.” Greenberg Br. 2. The *Greenberg I* Court said nothing about the *absence* of changes to the monthly magazines; rather, as noted in text above, the *Greenberg I* Court focused on the *presence* of additional, and independently copyrightable elements, in the CNG. *See* 244 F.3d at 1272-73 & n.12.

² In particular, the repeated assertion in Greenberg’s brief that the CNG includes a “copying feature” and “e-mail forwarding capability,” Greenberg Br. 19; *see also id.* at 22, is both unsupported and untrue. Because this Court held in *Greenberg I* that the § 201(c) privilege did not apply here as a matter of law, no record was developed with respect to any factual issues, and all reasonable factual inferences must be drawn in favor of National Geographic, not Greenberg. *See, e.g., Burton v. City of Belle Glade*, 178 F.3d 1175, 1187 (11th Cir. 1999).

Because the statute does not say that the addition of “nonessential” elements defeats the privilege, this Court need not decide whether the CNG’s computer program (or any particular elements of that program) are “essential” to the operation of a CD-ROM. At bottom, Greenberg’s speculation about “nonessential” features misses the point; what matters here, in light of § 201(c) as interpreted in *Tasini*, is 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.” *Faulkner*, 409 F.3d at 38.

Similarly, Greenberg misses the point by arguing that “the CNG is a new product for a new market.” Greenberg Br. 21; *see also id.* at 19 (“The Society’s historic ‘market’ consisted of Society members,” whereas “the CNG ... opened the market much wider to consumers around the world.”). Nothing in § 201(c) limits the privilege to works in the same “market” as the original collective work (even if some factual record had been established on the contours of any such “market,” which it was not). Indeed, any focus on distinct “markets” inherently conflicts with the bedrock statutory principle of media-neutrality, *see, e.g., Tasini*, 533 U.S. at 502, because different media can be expected to appeal to different “markets.” And Greenberg’s assertion that he is entitled to “benefit ... from the extraordinary demand for the CNG in the global market,” Greenberg Br. 21-22, is mystifying, because any “market” for the CNG is a market for the collective work as a whole

(from which the publisher is entitled to benefit), not a market for an individual freelance contribution (from which the freelancer is entitled to benefit). At bottom, the very concept of “markets” is alien to the copyright laws, which (unlike the antitrust laws) do not presuppose commercial activity in a particular “market.” Indeed, it makes no difference for copyright purposes whether a work is distributed in a “market” at all: National Geographic could have created the CNG solely for its own internal historical archive.³

Finally, Greenberg cannot and does not deny that he is asking this Court to create a post-*Tasini* conflict with the Second Circuit. Rather, he simply declares that “[a]ny resolution of the conflict between the two circuits should be left to the Supreme Court.” Greenberg Br. 10 & n.2. The key point here, however, is that

³ It is not true, as Greenberg asserts, that the *Tasini* Court “said that, in converting a publication from print to digital, various additions to the product *would* be acceptable where they were ‘entirely attributable to the nature of the electronic media,’ [but] *would not* be acceptable where they were ‘entirely attributable to ... the nature of the economic market served’ by the product.” Greenberg Br. 19 (quoting *Tasini*, 533 U.S. at 502 n.11). In the quoted footnote, the *Tasini* majority simply rejected the dissent’s suggestion that the challenged databases were privileged because the disaggregation of the original collective works was attributable to a change in media. *See* 533 U.S. at 502 n.11. As the majority explained, there was no basis for concluding as a factual matter that the disaggregation was attributable to a change in media, and in any event the statute did not include a “medium-driven” necessity defense. *See id.* Contrary to Greenberg’s assertion, the footnote does not remotely establish that a work’s appeal to a new “market” precludes application of the § 201(c) privilege.

there is not yet a post-*Tasini* “conflict between the two circuits,” and this Court should not lightly create one.⁴

The Second Circuit in *Faulkner* emphasized that *Greenberg I* preceded *Tasini*, and “did not utilize the *Tasini* analysis in determining whether the CNG was a ‘revision’ under Section 201(c).” 409 F.3d at 36. *Faulkner* carefully considered both precedents, and concluded not only that *Greenberg I*’s analytical framework did not survive *Tasini*, but that the CNG was a privileged “revision” under § 201(c) as a matter of law under *Tasini*. *Id.* at 35-38. Greenberg’s assertion that *Faulkner*’s “analysis ... of the *Tasini* issues was far less detailed and thorough than was the decision in *Greenberg I*,” Greenberg Br. 10, gets matters backwards:

⁴ Oddly, Greenberg accuses National Geographic of “say[ing] ... at page 3 of the Introduction ... [that] *Greenberg I* created a post-*Tasini* conflict with the Second Circuit, which would be quite a feat because *Greenberg I* preceded *Tasini*.” Greenberg Br. 2. National Geographic said nothing of the sort. Rather, National Geographic said that “this Court should now reconsider *Greenberg I* in light of *Tasini*” precisely to *avoid* “creat[ing] a post-*Tasini* conflict.” NGS Br. 3.

In addition, Greenberg erroneously asserts that “[t]he Society ... petitioned the Supreme Court for a writ of certiorari [in *Faulkner*], seeking resolution of the differences between the Second Circuit and the Eleventh Circuit on CNG issues,” and that “[t]he Court denied the petition on December 12, 2005.” Greenberg Br. 10 n.2. Having prevailed in the Second Circuit, the Society did not file any such petition; rather, the *Faulkner* plaintiffs did. To be sure, the Society did not oppose that petition, and urged the Court to grant review to resolve the conflict between *Faulkner* and *Greenberg I*. But of course there was no post-*Tasini* circuit conflict like the one Greenberg is urging this Court to create now. The fact that the Supreme Court did not grant certiorari in *Faulkner* is hardly a reason for this Court to create a post-*Tasini* circuit conflict here.

unlike this Court in *Greenberg I*, the Second Circuit in *Faulkner* actually had the benefit of *Tasini* in deciding “the *Tasini* issues,” *id.* Indeed, the Second Circuit’s *Faulkner* decision was authored by a jurist intimately familiar with “the *Tasini* issues”: former Chief Judge Ralph K. Winter, who also authored the Second Circuit decision affirmed in *Tasini*. The bottom line here is that this Court now should reconsider *Greenberg I* in light of *Tasini*, and conclude (as did the Second Circuit in *Faulkner*) that the CNG is privileged under § 201(c).

II. The District Court Erred By Striking National Geographic’s Answer On Remand, And Thereby Precluding National Geographic From Defending Itself Against Liability For Copyright Infringement.

Greenberg next argues that, wholly apart from the § 201(c) issue, the district court correctly struck National Geographic’s answer upon remand from *Greenberg I*, because (1) this Court’s mandate allegedly precluded National Geographic from raising any other defense to liability for copyright infringement, and (2) the answer was untimely in any event. *See* Greenberg Br. 27-40. Greenberg is wrong on both scores.

A. The District Court Erred By Holding That *Greenberg I* Dictated The Entry Of Judgment In Greenberg’s Favor On Liability For Copyright Infringement.

Greenberg first argues that “[t]his Court’s mandate [in *Greenberg I*] precluded the district court from entertaining any defense to infringement.” Greenberg Br. 28. According to Greenberg, “[f]ollowing the Court’s ruling in

Greenberg I, the Society filed a Petition for Rehearing and Petition for Rehearing En Banc ..., in which, among other things, the Society asked the Court to ‘remand the case for the adjudication of any other factual, legal or equitable defenses to infringement,’ but “[t]his Court denied the petitions, thus determining that no defense remained for the Society.” *Id.* at 29-30; *see also id.* at 5, 8.

That argument is misleading at best. What Greenberg fails to mention is that, after National Geographic petitioned for rehearing, the panel *sua sponte* issued a “corrected” opinion that specifically *deleted* the direction to enter judgment in Greenberg’s favor on liability for copyright infringement. *Compare RE94-95 with 244 F.3d at 1275-76.* Contrary to Greenberg’s argument, therefore, the Court’s subsequent denial of rehearing in no way suggests that National Geographic was foreclosed from pursuing defenses other than § 201(c) on remand.

Indeed, as explained in the opening brief, any such suggestion would have no basis in law. *Greenberg I* reversed the grant of summary judgment in National Geographic’s favor, and held that the § 201(c) privilege did not apply to the CNG as a matter of law. *See 244 F.3d at 1268.* By reversing the grant of summary judgment on this single ground, this Court had no occasion to consider whether National Geographic might be entitled to any other defense to liability. Indeed, no other defense had then been raised either before the district court or before this Court. Nor was National Geographic required to have raised any other defense

before then: under the Federal Rules of Civil Procedure, a defendant need not plead any affirmative defenses unless and until it files an answer, and National Geographic had not filed an answer before *Greenberg I*. See NGS Br. 41-42 (citing Rules and cases). Rather, National Geographic had raised its § 201(c) defense to Greenberg's copyright infringement claims in a pre-answer motion to dismiss, or in the alternative, for summary judgment. See RE6 (Dist. Ct. Docket No. 18). It is simply not reasonable to construe this Court's mandate in *Greenberg I* to definitively foreclose any and all defenses to copyright infringement, because only one such defense was even at issue in that decision.

It is thus nothing short of stunning for Greenberg to argue that "[i]t is obvious that the Court, in fashioning its decision in *Greenberg I*, rejected any contract defense, as well as any other defense." Greenberg Br. 31. Needless to say, *Greenberg I* could not have "rejected" any defense that had never even been pleaded in the case, much less presented in *Greenberg I* itself. The fact that the parties submitted copies of their various agreements and other documents to the Court, see Greenberg Br. 32-33, in no way establishes that the Court *sub silentio* considered and rejected any defenses that had not yet been pleaded or argued.

The bottom line here is that Greenberg overreached by asking the district court to strike National Geographic's answer on remand from *Greenberg I*, and the district court erred as a matter of law by granting that request. Accordingly, this

Court should reverse the judgment wholly independent of the § 201(c) issue, because National Geographic was improperly denied its day in court on its other defenses to liability for copyright infringement.⁵

B. The District Court Erred By Holding That Defendants' Answers Were Untimely.

In the alternative, Greenberg argues that “the district court had another reason to strike the answers: they were not timely.” Greenberg Br. 38. Remarkably, however, Greenberg argues that defendants’ answers were untimely for a totally different reason than the district court, and makes no attempt

⁵ Greenberg devotes a section of his brief to challenging National Geographic’s other defenses on the merits, arguing that “any actual assertion of defenses would have been futile.” Greenberg Br. 31. That argument is nothing short of remarkable. Having successfully invited the district court into error by moving to strike National Geographic’s answer, Greenberg is in no position now to summarily dismiss the very defenses that he has precluded National Geographic from litigating. National Geographic is entitled to its day in court on those defenses, and Greenberg, if he wishes, can move for summary judgment below.

In any event, Greenberg’s arguments fail to refute the defenses. For example, with respect to the contracts, Greenberg concedes that the initial contracts gave National Geographic all rights in Greenberg’s contributions, but insists that National Geographic subsequently conveyed those rights back to Greenberg in an “absolute” manner. Greenberg Br. 34. That point, however, is vigorously contested by National Geographic. Indeed, Greenberg’s trial testimony only confirmed National Geographic’s understanding, because he conceded (as he now concedes again) that “the Society *could* continue to use the photographs,” *id.* (emphasis added)—a concession manifestly inconsistent with Greenberg’s theory of an “absolute” conveyance of rights. Similarly, Greenberg’s arguments regarding the applicability of the 1909 Copyright Act to some of the works at issue here, and the affirmative defense of laches and estoppel, require law- and fact-specific analysis far beyond the scope of this appeal.

whatsoever to defend the district court's reasoning on this score. As noted in National Geographic's opening brief, the district court asserted that the answers were untimely because "[d]efendants waived the right to file an answer" by moving in the alternative for summary judgment in their original motion to dismiss. RE 134. That assertion is plainly incorrect, because the Federal Rules of Civil Procedure expressly allow defendants to move for summary judgment "at any time," Fed. R. Civ. P. 56(b), either before or after filing an answer, *see, e.g.*, NGS Br. 42 (citing cases). It is thus no surprise that Greenberg declines to defend the district court's reasoning on this score.

Nor is it any surprise that the district court, for its part, declined to adopt Greenberg's timeliness argument. According to Greenberg, defendants were required to file their answers within *five days* after this Court issued the mandate in *Greenberg I*, and missed that alleged deadline by filing 15 days later. *See* Greenberg Br. 38-40. Greenberg's theory is, to put it charitably, convoluted. He begins by assuming that the requirement to serve an answer "within 20 days after being served with the summons and complaint," Fed. R. Civ. P. 12(a)(1)(A), required defendants to serve an answer within 20 days of this Court's mandate in *Greenberg I* reversing the district court's decision granting defendants summary judgment, *see* Greenberg Br. 38-39. He then assumes that this 20-day period was reduced to five days because 15 days of the original response period had elapsed

before defendants sought, and obtained, an extension of time to file their pre-answer dispositive motions. *See id.* at 39. Both of these assumptions are incorrect.

As an initial matter, the Rules do not specify any particular time period for filing an answer after an appellate ruling reversing a district court decision granting a pre-answer dispositive motion. Rather, as noted above, the Rules simply require a defendant to file an answer within 20 days after being served with a complaint, *see* Fed. R. Civ. P. 12(a)(1)(A), unless the defendant files “another appropriate document such as a motion to dismiss, or a motion for extension of time.” *Verkuilen v. South Shore Bldg. & Mortgage Co.*, 122 F.3d 410, 411 (7th Cir. 1997). Here, defendants took the latter course, moving for an extension of time, and then filing a pre-answer dispositive motion, which the district court granted (and this Court reversed). Contrary to Greenberg’s assumption, nothing in the Rules suggests that the 20-day requirement of Rule 12(a)(1)(A) magically springs back to life upon appellate reversal of a district court order granting a pre-answer dispositive motion.

In any event, defendants here actually filed their answers within 20 days of the issuance of the mandate in *Greenberg I*, *see* RE101-19, so Greenberg’s theory ultimately hinges on the proposition that 15 days of that period already had elapsed. That is so, Greenberg asserts, because defendants waited 15 days before seeking and obtaining an extension of the 20-day deadline, and the order granting

the extension “tolled the *remaining* time.” Greenberg Br. 39 (emphasis in original); *see also id.* at 39 n.18 (“[A]fter the complaint was served, 15 days of the 20-day response period [was] used up.”).

That assertion is baseless. Once defendants requested and received an extension of time to file their pre-answer dispositive motions, the original 20-day deadline for filing was *gone*, not “tolled.” It is irrelevant how many days had elapsed before defendants filed their motion for an extension of time; all that matters is that defendants requested and received such an extension, and concededly filed their pre-answer dispositive motions on time. Tellingly, Greenberg fails to cite a single case in the history of American law holding that an order granting a request for an extension of time merely “tolls” the remaining time under the original deadline.⁶

In any event, Greenberg’s implausible timing theories ultimately miss the point, because the district court would not have been entitled to invoke the “extreme” sanction of striking defendants’ answer (and thereby precluding

⁶ Greenberg argues in the alternative that “[t]he answers were also late if Rule 12(a)(4) were applied, with its 10-day response period.” Greenberg Br. 40. Why Greenberg thinks Rule 12(a)(4) might apply here is a mystery. That Rule specifies the time period for filing an answer after a district court either (1) denies (or postpones resolution of) a pre-answer dispositive motion, or (2) grants a motion for a more definite statement under Rule 12(e). Here, the district court did neither of these things; rather, it granted a motion for summary judgment. Accordingly, Rule 12(a)(4) has no bearing here.

defendants from defending themselves against liability on the merits) *even if* the answer had been filed 15 days late. *Chudasama v. Mazda Motor Corp.*, 123 F.3d 1353, 1366 (11th Cir. 1997); *see also Malautea v. Suzuki Motor Co.*, 987 F.2d 1536, 1542 (11th Cir. 1993) (striking answer “appropriate only as a last resort, when less drastic sanctions would not ensure compliance with the court’s orders”). The Federal Rules of Civil Procedure do not establish (indeed, they affirmatively reject) a regime of “gotcha” litigation, whereby a single technical pratfall can doom a party’s case. There is nothing mandatory or jurisdictional about the time period for filing an answer. Given that Greenberg has never even attempted to show that the 15-day delay was anything other than inadvertent (even assuming that the answer was untimely in the first place, which it was not), or that he was prejudiced by that delay, the district court certainly had no basis for the ultimate sanction of striking defendants’ answers on timeliness grounds.

III. The Magistrate Judge Erred As A Matter Of Law By Allowing The Jury To Award Damages For “Willful” Copyright Infringement.

Finally, Greenberg defends the magistrate judge’s decision to allow the jury to impose damages for “willful” infringement. *See Greenberg Br.* 41-48. In this regard, Greenberg first argues that defendants “flout[ed] th[e] law” by declining to withdraw the CNG *after Greenberg I*. *See id.* at 44; *see also id.* at 45 (accusing the Society of “indifference to *Greenberg I*”). Greenberg next argues that defendants’

“reliance on legal counsel was not reasonable” *before Greenberg I*. *Id.* (capitalization modified). Greenberg is wrong on both scores.

A. Defendants Did Not Engage In “Willful” Infringement By Declining To Withdraw The CNG After *Greenberg I*.

The key point here is that *Greenberg I* did not order defendants to withdraw the CNG; to the contrary, *Greenberg I* strongly suggested that such a drastic remedy would be inappropriate. *See* 244 F.3d at 1276 (“In assessing the appropriateness of any injunctive relief, we urge the court to consider alternatives, such as mandatory license fees, in lieu of foreclosing the public’s computer-aided access to this educational and entertaining work.”). Greenberg’s argument thus boils down to the proposition that defendants “ignored the law fostered by this Court’s decision,” *Greenberg Br.* 43, by declining to inflict on themselves a drastic remedy (withdrawing the CNG) that this Court strongly suggested was unnecessary and inappropriate.

With all due respect, that proposition makes no sense. Defendants could not have engaged in “willful” infringement as a matter of law by declining to take action that this Court specifically suggested they did not need to take. Indeed, on remand from *Greenberg I*, Greenberg himself did not even *move* for an injunction for more than a year, until November 2002 (almost five years after he filed the lawsuit). *See* Motion (11/27/02) (Dist. Ct. Docket No. 159). Given that Greenberg himself apparently did not think his copyrights were being “willfully” infringed (or

at least did nothing to stop it), he can hardly complain that defendants themselves did not withdraw the CNG. And when Greenberg finally did move for an injunction, it was not granted; rather, it was postponed until after the trial. *See* Order on Pending Motions (2/20/03) (Dist. Ct. Docket No. 243); Joint Status Report (11/2/05) (Dist. Ct. Docket No. 316). Given that this Court suggested that an injunction may not be appropriate, and that the district court expressly declined to enter an injunction when Greenberg finally got around to asking for one, National Geographic certainly cannot be faulted for failing to enjoin itself. Indeed, Greenberg himself quotes the relevant testimony by the Society's President and CEO stating that "the number one reason we didn't" withdraw the CNG in light of *Greenberg I* was this Court's suggestion that an injunction would be unnecessary and inappropriate. *See* Greenberg Br. 43 n.23 (quoting 3/3/03 Tr. 92 (Fahey)); *see also* 3/4/03 Tr. 50 (Adamson).

Greenberg insists, however, that willfulness is a question of fact, not law. *See* Greenberg Br. 41. But the dispute here is not about the facts; it is about the legal significance attached to those facts. National Geographic does not deny that it did not withdraw the CNG before the jury trial on damages; the key question presented here is whether a reasonable factfinder could conclude that it was unreasonable not to have withdrawn the CNG before then. *See, e.g.*, 3 Melville B. Nimmer & David Nimmer, *Nimmer on Copyright* § 14.04[B][3] (1996) ("[O]ne

who has been notified that his conduct constitutes copyright infringement, but who reasonably and in good faith believes the contrary, is not 'willful' for these purposes."); *see also Danjaq LLC v. Sony Corp.*, 263 F.3d 942, 957-58 (9th Cir. 2001); *N.A.S. Import, Corp., v. Chenson Enters., Inc.*, 968 F.2d 250, 252 (2d Cir. 1992); *RCA/Ariola Int'l, Inc. v. Thomas & Grayston Co.*, 845 F.2d 773, 779 (8th Cir. 1988). Thus, as the Sixth Circuit has explained, "'reasonableness,' in the present context, is essentially a question of law," because the underlying judgment is a legal one. *Princeton Univ. Press v. Michigan Document Servs., Inc.*, 99 F.3d 1381, 1392 (6th Cir. 1996) (*en banc*). Here, as a matter of law, the underlying judgment not to withdraw the CNG in light of *Greenberg I* was not unreasonable.

As National Geographic explained in its opening brief, *see* NGS Br. 52-53, the *Princeton* decision is instructive on this score. The *en banc* Sixth Circuit there held that a defendant could not be held liable for "willful" infringement as a matter of law given the unsettled nature of the legal issue, even though the only court to rule on the issue had ruled against the defendant's position (and the Sixth Circuit itself affirmed a judgment of copyright infringement). *See* 99 F.3d at 1392. Greenberg tries to distinguish *Princeton* on the ground that the case involved the "fair use" doctrine, whereas this case does not. *See* Greenberg Br. 44. But that is a distinction without a difference. At all relevant times here, the proper application of the § 201(c) privilege to an exact, image-based reproduction of a collective

work in a new medium was at least as “unsettled” as the proper application of the “fair use” doctrine in *Princeton*. Little wonder, then, that Greenberg in effect ultimately asks this Court to create a circuit conflict with the Sixth Circuit over the proper standard for “willfulness.” *See id.* (“It does not follow that ... other circuit courts would reach a similar conclusion” to the Sixth Circuit’s conclusion in *Princeton*).⁷

Greenberg also argues that, even if National Geographic could reasonably have decided not to withdraw the CNG in the wake of *Greenberg I*, it could not reasonably have decided not to withdraw the CNG in the wake of the district court’s subsequent decision striking defendants’ answers. *See Greenberg Br.* 45.

⁷ Greenberg asserts that infringement can be “willful” not only where a defendant knows or has reason to know that his conduct violates the law, but also “where the infringer recklessly disregarded a plaintiff’s copyrights.” *Greenberg Br.* 42 (citing *Hamil Am., Inc. v. GFI*, 193 F.2d 92, 97 (2d Cir. 1999); *Twin Peaks Productions, Inc. v. Publications Int’l*, 996 F.2d 1366, 1382 (2d Cir. 1993)). As underscored by Greenberg’s failure to cite any Eleventh Circuit authority for that proposition, this Court has never so held. To the contrary, this Court has repeatedly stated that “‘willfully’ means with knowledge that the defendant’s conduct constitutes copyright infringement.” *MCA Television Ltd. v. Feltner*, 89 F.3d 766, 768 (11th Cir. 1996) (quoting 3 Melville B. Nimmer & David Nimmer, *Nimmer on Copyright* § 14.04[B], 14-58-60 (1990)); *see also Cable/Home Comm. Corp. v. Network Productions, Inc.*, 902 F.2d 829, 851 (11th Cir. 1990) (“‘Willfully,’ ... means that the defendant knows his actions constitute an infringement.”) (internal quotation omitted). Ultimately, however, this Court need not decide whether “reckless disregard” as well as knowledge satisfies the standard for “willful” infringement, because defendants here did not “willfully” infringe under *any* standard.

That argument likewise misses the mark. Nothing in that decision suggested that the proper remedy was to withdraw the CNG; to the contrary, as noted above, plaintiffs did not even move to enjoin the CNG until almost a year later, in November 2002 (and even then the injunction was not granted). Because National Geographic was reasonably entitled to conclude, in light of this Court's admonition in *Greenberg I* "urg[ing] the [district] court to consider alternatives" to an injunction, 244 F.3d at 1276, that it was neither necessary nor appropriate to withdraw the CNG, the decision not to withdraw the CNG cannot be deemed "willful" infringement as a matter of law.

B. Defendants Reasonably Relied On The Advice Of Counsel.

Greenberg next challenges the Society's reliance on the advice of counsel before *Greenberg I*, see Greenberg Br. 45-48, but it is unclear what he thinks he is achieving by that challenge. As noted above, in order to establish "willful" infringement, a plaintiff must establish that the challenged conduct was legally unreasonable, *i.e.*, unreasonable in light of the state of the law at the time. Greenberg makes no effort in his brief to argue that it was legally unreasonable for defendants to produce the CNG before *Greenberg I*, and does not analyze (or even mention) the state of the law at that time. That omission is not surprising: as National Geographic explained in its opening brief, the law on this issue was at best unsettled at that time. See NGS Br. 48-49 & n.8.

Greenberg nonetheless insists that defendants engaged in “willful” infringement even before *Greenberg I* by challenging their reliance on the advice of counsel. See Greenberg Br. 45. But reliance on the advice of counsel is a *defense* to willfulness. Greenberg cannot carry his burden of proving willfulness simply by trying to poke holes in that defense; rather, he must affirmatively establish that the challenged conduct was legally unreasonable at the time. Because he makes no effort to carry that burden, his attack on the advice-of-counsel defense before *Greenberg I* misses the mark.

With respect to the period *after Greenberg I* (when, as noted above, Greenberg *does* contend that it was legally unreasonable for defendants not to withdraw the CNG), Greenberg says not a word about National Geographic’s advice-of-counsel defense. By that silence, Greenberg essentially concedes that it was reasonable, at the very least, for National Geographic to rely on the advice of counsel in deciding not to withdraw the CNG in the wake of *Greenberg I*. As explained in the opening brief, National Geographic sought the advice of inside and outside counsel at that time, and was advised that it was not necessary to withdraw the CNG. See NGS Br. 51-52 (citing, *inter alia*, 3/4/03 Tr. 47-48 (Adamson); 3/4/03 Tr. 86-87 (Collins)); *see also* 2/28/03 Tr. 194-95 (Fahey). Indeed, reasonable counsel could hardly have concluded otherwise, given

Greenberg I's strong suggestion that an injunction was neither necessary nor appropriate. *See* 244 F.3d at 1267.

In any event, Greenberg's attack on the Society's reliance on the advice of counsel even before *Greenberg I* fails on the merits. Greenberg does not deny that the Society consulted expert attorneys, but argues that "the Society was committed to proceed with the CNG product by the time it began to seek and receive copyright guidance from its counsel." Greenberg Br. 46. That argument is unsound as a matter of both fact, *see* 2/28/03 Tr. 168-69 (Fahey); 3/3/03 Tr. 143 (Dupre), and law. Indeed, that argument would essentially render the "advice of counsel" defense a nullity, because a plaintiff could always avoid that defense by simply arguing that the defendant would have infringed anyway regardless of the advice.

Nor is there any evidence to support Greenberg's argument that "the 'advice of counsel' was obtained only after the act of infringing occurred." Greenberg Br. 46. To the contrary, the record is undisputed that National Geographic consulted inside and outside counsel *before* launching the CNG. *See, e.g.*, 2/28/03 Tr. 177-82 (Fahey); 3/3/03 Tr. 135-37, 139-41 (Dupre); 3/4/03 Tr. 80-81, 90 (Collins). Indeed, the issue was addressed by the Society's Board of Trustees, most directly including former Third Circuit Judge A. Leon Higginbotham, Jr., who became intimately involved in reviewing the legal issues and opinions before the final

decision to launch the CNG. See 2/28/03 Tr. 174-75 (Fahey); 3/3/03 Tr. 139-40 (Dupre). Greenberg tries to avoid this point by asserting that “unauthorized copying can be infringing,” Greenberg Br. 46 (emphasis in original), but defendants here were not held liable for “unauthorized copying”; rather, they were held liable for distributing the CNG. Greenberg’s speculation regarding unlawful “copying,” thus, provides no basis for affirming a judgment based on a separate offense.⁸ At the end of the day, Greenberg’s arguments fail to establish that defendants were not entitled to rely on the advice of counsel *before Greenberg I*, much less *after Greenberg I*.

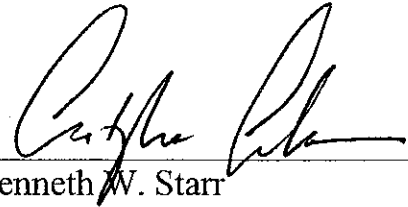
Accordingly, at the very least, the magistrate judge erred by allowing the jury to impose damages for “willful” infringement, and this Court should remit the damages award.

⁸ Nor is there any evidence to support Greenberg’s repeated assertion that “the legal guidance obtained was unreliable in light of information not provided to the lawyers by the Society.” Greenberg Br. 46. Tellingly, Greenberg never identifies any such “non-disclosed” material information. The closest he comes is to argue that one lawyer (1) “never saw the CNG product on which he was asked to opine,” and (2) did not know that “the CNG would be marketed primarily to consumers, rather than institutions.” *Id.* at 47. Neither of these points, however, has any factual or legal bearing on the § 201(c) analysis. The opinion in question did not “express[] grave reservations about the legality of the product,” *id.*, but simply recognized that the “legal risks” had increased.

CONCLUSION

For the foregoing reasons, and those set forth in the opening brief, the judgment should be reversed.

Respectfully submitted,



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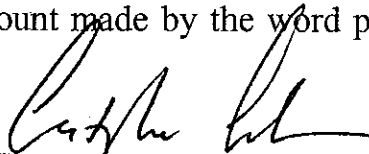
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CERTIFICATE OF BRIEF LENGTH

Pursuant to Fed. R. App. P. 32(a)(7)(B) and (C), I hereby certify that this brief contains 7,000 words, on the basis of a count made by the word processing system used to prepare the brief.

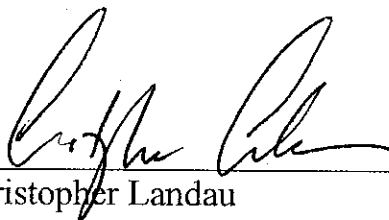


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CERTIFICATE OF SERVICE

I hereby certify that on this 8th day of August 2006, I served two true and correct copies of the foregoing Brief of Appellant by Federal Express on the following counsel:

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