

DOCKET NO. 00-10510-C

IN THE
UNITED STATES COURT OF APPEALS
FOR THE ELEVENTH CIRCUIT

JERRY GREENBERG and IDAZ GREENBERG,
Plaintiffs/Appellants

vs.

NATIONAL GEOGRAPHIC SOCIETY, a District
of Columbia corporation, NATIONAL GEOGRAPHIC
ENTERPRISES, INC., a corporation, and
MINDSCAPE, INC., a California corporation,

Defendants/Appellees.

On Appeal from the United States District Court
for the Southern District of Florida

Record Excerpts

Norman Davis
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APPEAL Norman

JG 4/102

NOV 23 1999

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<u>Tasini v. New York Times Co., ___ F. 3d ___,</u> Slip op. 6749-68 (2d Cir. 2000)	<u>Tasini</u>
17 U. S. C. § 201 (c)	Sec. 201 (c)
Reassignments of Rights to Appellant Jerry Greenberg	25-Ex. B
1998 VA Copyright Registration Form (attachment to memorandum)	68-Attach.

WCT CLOSED
APPEAL WCT

U.S. District Court
Southern District of Florida (Miami)

CIVIL DOCKET FOR CASE #: 97-CV-3924

Greenberg, et al v. National Geographic, et al
Assigned to: Judge Joan A. Lenard
Demand: \$0,000
Lead Docket: None
Dkt# in other court: None

Filed: 12/05/97

Nature of Suit: 820
Jurisdiction: Federal Question

Cause: 17:0101 Copyright Infringement

JERRY GREENBERG, individually
plaintiff

Norman Davis
FTS 577-7001
305-577-2988
[COR LD NTC]
David Andrew Aronberg
[COR LD NTC]
Steel Hector & Davis
200 S Biscayne Boulevard
41st Floor
Miami, FL 33131-2398
305-577-2934

IDAZ GREENBEREG, individually
plaintiff

Norman Davis
(See above)
[COR LD NTC]
David Andrew Aronberg
(See above)
[COR LD NTC]

v.

NATIONAL GEOGRAPHIC SOCIETY, a
District of Columbia
corporation
defendant

Edward Soto
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305-577-3177
[COR LD NTC]
Valerie Greenberg Itkoff
FTS 374-7159
[COR LD NTC]
Weil Gotshal & Manges
701 Brickell Avenue
Suite 2100
Miami, FL 33131-2861
305-577-3100

Edward Soto

Docket as of March 8, 2000 2:24 pm

Page 1

Certified to be a true and
correct copy of the document on file
Clarence Maddox, Clerk,
U.S. District Court
Southern District of Florida
By *Clarence Maddox*
Deputy Clerk
Date 3/8/00

Proceedings include all events.

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WCT

Below Address Terminated on 3/20/98

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[COR LD NTC]

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NATIONAL GEOGRAPHIC
ENTERPRISES, INC., a
corporation
defendant

Edward Soto

(See above)

[COR LD NTC]

Valerie Greenberg Itkoff

(See above)

[COR LD NTC]

Edward Soto

Below Address Terminated on 3/20/98

(See above)

[COR LD NTC]

MINDSCAPE, INC., a California
corporation
defendant

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- 12/5/97 (1) COMPLAINT filed; FILING FEE \$150.00; RECEIPT #684935; WCT; A-5 (gz) [Entry date 12/09/97] [Edit date 12/09/97]
- 12/5/97 -- Magistrate identification: Magistrate Judge William C. Turnoff (gz) [Entry date 12/09/97]
- 12/5/97 (2) SUMMONS(ES) issued for National Geographic (gz) [Entry date 12/09/97]
- 12/5/97 (3) SUMMONS(ES) issued for National Geographic (gz) [Entry date 12/09/97]
- 12/5/97 (4) SUMMONS(ES) issued for Mindscape, Inc. (gz) [Entry date 12/09/97]
- 12/9/97 -- FORM AO 121 sent to: Register of Copyrights (gz)
- 12/23/97 (5) AMENDED COMPLAINT by Jerry Greenberg, Idaz Greenberg, (Answer due 1/2/98 for Mindscape, Inc., for National Geographic, for National Geographic) amending [1-1] complaint (rn) [Entry date 12/30/97]
- 12/24/97 (6) RETURN OF SERVICE executed for National Geographic on 12/10/97 Answer due on 12/30/97 for National Geographic (rn) [Entry date 12/31/97]
- 12/24/97 (7) RETURN OF SERVICE executed for National Geographic on 12/10/97 Answer due on 12/30/97 for National Geographic (rn) [Entry date 12/31/97]
- 12/24/97 (8) RETURN OF SERVICE executed for Mindscape, Inc. on 12/10/97 Answer due on 12/30/97 for Mindscape, Inc. (rn) [Entry date 12/31/97]
- 12/30/97 (9) RETURN OF SERVICE executed for Mindscape, Inc. on 12/10/97 Answer due on 12/30/97 for Mindscape, Inc. (ra) [Entry date 01/08/98]
- 1/8/98 (10) JOINT MOTION by Jerry Greenberg, Idaz Greenberg, National Geographic, National Geographic, Mindscape, Inc. to extend time to serve and file response to amended complaint (rn) [Entry date 01/12/98]
- 1/9/98 (11) ORDER granting [10-1] joint motion to extend time to serve and file response to amended complaint on or before 1/30/98 (signed by Judge Joan A. Lenard on 1/9/98) CCAP (rn) [Entry date 01/13/98]
- 1/9/98 (12) ORDER that proof of service and/or answer to complaint having been filed, the parties are directed to comply with Local Rule 16.1.B (signed by Judge Joan A. Lenard on 1/9/98) CCAP (rn) [Entry date 01/13/98]

Begin Vol. 1

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- 1/21/98 (13) MOTION by National Geographic, National Geographic, Mindscape, Inc. for scheduling order (rn) [Entry date 01/26/98]
- 1/26/98 (14) MEMROANDUM IN RESPONSE by Jerry Greenberg, Idaz Greenberg to [13-1] motion for scheduling order (rn) [Entry date 01/28/98]
- 1/27/98 (15) REPLY by National Geographic, National Geographic, Mindscape, Inc. in support of [13-1] motion for scheduling order (rn) [Entry date 01/30/98] *Vol. / Cont'd*
- 1/28/98 (16) ORDER denying [13-1] motion for scheduling order (signed by Judge Joan A. Lenard on 1/28/98) CCAP (rn) [Entry date 01/30/98]
- 1/30/98 (17) PARTIAL ANSWER by National Geographic, National Geographic (Attorney Edward Soto, Valerie Greenberg Itkoff) to amended complaint and AFFIRMATIVE DEFENSES (rn) [Entry date 02/02/98]
- 1/30/98 (18) MOTION by National Geographic, National Geographic, Mindscape, Inc. to dismiss Count II, and to dismiss or for summary judgment on Counts III-V of amended complaint (rn) [Entry date 02/02/98]
- 1/30/98 (19) MEMORANDUM by National Geographic, National Geographic, Mindscape, Inc. in support of [18-1] motion to dismiss Count II, [18-2] motion to dismiss or for summary judgment on Counts III-V of amended complaint (rn) [Entry date 02/02/98]
- 1/30/98 (20) DECLARATION of Thomas Stanton by National Geographic, National Geographic Re: (rn) [Entry date 02/02/98]
- 1/30/98 (21) EXHIBITS "A" to: [20-1] declaration by National Geographic, National Geographic (rn) [Entry date 02/02/98]
- 2/3/98 (22) NOTICE of Filing declaration of Thomas Stanton by National Geographic, National Geographic (rn) [Entry date 02/04/98]
- 2/3/98 (23) Declaration of Thomas Stanton by National Geographic, National Geographic (rn) [Entry date 02/04/98]
- 2/13/98 (24) MOTION with memorandum in support by Idaz Greenberg, Jerry Greenberg for voluntary dismissal of Count IV of amended complaint (rn) [Entry date 02/17/98]
- 2/13/98 (25) MEMORANDUM IN RESPONSE by Idaz Greenberg, Jerry Greenberg to [18-1] motion to dismiss Count II, [18-2] motion to dismiss or for summary judgment on Counts III-V of amended complaint (rn) [Entry date 02/17/98]

See Accordion Folder #1

Proceedings include all events.

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- 2/17/98 (26) CROSS MOTION by Idaz Greenberg, Jerry Greenberg for summary judgment on liability as to Count III of amended complaint (rn) [Entry date 02/19/98]
- 2/24/98 (27) Reply Declaration of Thomas Stanton by National Geographic (rn) [Entry date 02/26/98]
- 2/24/98 (28) RESPONSE by Mindscape, Inc., National Geographic, National Geographic in support of [18-1] motion to dismiss Count II, [18-2] motion to dismiss or for summary judgment on Counts III-V of amended complaint (rn) [Entry date 02/26/98]
- 3/3/98 (29) Scheduling Report of Scheduling Meeting by Mindscape, Inc., National Geographic, National Geographic, Idaz Greenberg, Jerry Greenberg (rn) [Entry date 03/04/98]
- 3/10/98 (30) AGREED MOTION by Mindscape, Inc., National Geographic, National Geographic for Robert G. Sugarman and Naomi Jane Gray to appear pro hac vice (rn) [Entry date 03/12/98]
- 3/10/98 (30) Clerk's receipt. Number: 689061 & 689062 in the amount of \$ 150.00 for admission pro hac vice by Mindscape, Inc., National Geographic, National Geographic (rn) [Entry date 03/12/98]
- 3/10/98 (31) NOTICE of Filing affidavits of Robert G. Sugarman and Naomi Jane Gray by Mindscape, Inc., National Geographic, National Geographic (rn) [Entry date 03/12/98]
- 3/10/98 (32) AFFIDAVIT of Robert G. Sugarman by Mindscape, Inc., National Geographic, National Geographic Re: [30-1] motion for Robert G. Sugarman and Naomi Jane Gray to appear pro hac vice (rn) [Entry date 03/12/98]
- 3/10/98 (33) AFFIDAVIT of Naomi Jane Gray by Mindscape, Inc., National Geographic, National Geographic Re: [30-1] motion for Robert G. Sugarman and Naomi Jane Gray to appear pro hac vice (rn) [Entry date 03/12/98]
- 3/11/98 (34) ORDER granting [30-1] motion for Robert G. Sugarman and Naomi Jane Gray to appear pro hac vice (signed by Judge Joan A. Lenard on 3/11/98) CCAP (rn) [Entry date 03/12/98]
- 3/19/98 (35) ORDER that the parties are directed to file an amended joint scheduling report within twenty (20) days (signed by Judge Joan A. Lenard on 3/19/98) CCAP (rn) [Entry date 03/20/98]
- 4/8/98 (36) Amended Scheduling Report of Scheduling Meeting by Mindscape, Inc., National Geographic, National Geographic, Idaz Greenberg, Jerry Greenberg (rn) [Entry date 04/10/98]

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- 5/14/98 (37) ORDER denying [18-1] motion to dismiss Count II, granting [18-2] motion to dismiss or for summary judgment on Counts III-V of amended complaint denying [26-1] cross motion for summary judgment on liability as to Count III of amended complaint denying [24-1] motion for voluntary dismissal of Count IV of amended complaint (signed by Judge Joan A. Lenard on 5/14/98) CCAP (rn) [Entry date 05/19/98]
- 6/9/98 (38) ORDER REFERRING DISCOVERY MATTERS and Non Case-Dispositive Motions to Magistrate Judge Turnoff (Signed by Judge Joan A. Lenard on 6/9/98) CCAP (rn) [Entry date 06/10/98]
- 6/9/98 (39) SCHEDULING ORDER setting Calendar call set for 2:00 6/3/99 Jury trial set for 6/7/99 Discovery cutoff 9/15/98 ; Pretrial conference for 2:00 5/11/99 (signed by Judge Joan A. Lenard on 6/9/98) CCAP (rn) [Entry date 06/10/98]
- 6/9/98 (39) ORDER referring case to mediation. 15 days to appoint mediator (signed by Judge Joan A. Lenard on 6/9/98) CCAP (rn) [Entry date 06/10/98]
- 6/22/98 (40) MOTION by Idaz Greenberg, Jerry Greenberg for entry of default as to National Geographic Society (rn) [Entry date 06/25/98] *Vd. 1 Cont'd*
- 6/24/98 (41) VERIFIED RESPONSE by National Geographic to [40-1] motion for entry of default as to National Geographic Society (rn) [Entry date 06/30/98]
- 6/24/98 (42) ANSWER to Count II by National Geographic, National Geographic (Attorney Edward Soto) of amended complaint (rn) [Entry date 06/30/98]
- 6/25/98 (43) NOTICE to Clerk of parties' inability to agree on mediator by Idaz Greenberg, Jerry Greenberg (rn) [Entry date 06/30/98]
- 6/25/98 (44) NOTICE of Withdrawal of request to Clerk for entry of default against National Geographic Society by Idaz Greenberg, Jerry Greenberg (rn) [Entry date 06/30/98]
- 6/25/98 -- WITHDRAWAL of [40-1] motion for entry of default as to National Geographic Society (rn) [Entry date 06/30/98]
- 9/30/98 (45) MOTION by Idaz Greenberg, Jerry Greenberg for summary judgment on liability for Count I and Count II of amended complaint (rn) [Entry date 10/02/98]
- 9/30/98 (46) NOTICE of Filing attached deposition of Warren Cutler in support of plaintiffs' motion for summary judgment by Idaz Greenberg, Jerry Greenberg (rn) [Entry date 10/02/98]

See Large Envelop

Proceedings include all events.

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- 9/30/98 (47) MEMORANDUM with attachments by Idaz Greenberg, Jerry Greenberg in support of [45-1] motion for summary judgment on liability for I and Count II of amended complaint (rn) [Entry date 10/02/98] *See Large Envelope*
- 10/16/98 (48) MEMORANDUM by National Geographic in opposition to [45-1] motion for summary judgment on liability for Count I and Count II of amended complaint (rn) [Entry date 10/19/98]
- 10/21/98 (49) NOTICE of Filing original affidavit of Rock Wheeler by National Geographic (rn) [Entry date 10/23/98]
- 10/21/98 (50) Declaration of Rock Wheeler by National Geographic (rn) [Entry date 10/23/98]
- 10/26/98 (51) REPLY Memorandum by Idaz Greenberg, Jerry Greenberg to response to [45-1] motion for summary judgment on liability for Count I and Count II of amended complaint (nt) [Entry date 10/29/98] *Vol. 1 Cont'd*
- 3/31/99 (52) JOINT MOTION by Idaz Greenberg, Jerry Greenberg, National Geographic to amend [39-1] Scheduling order (rn) [Entry date 04/01/99]
- 4/28/99 (53) EMERGENCY MOTION by Idaz Greenberg, Jerry Greenberg to continue trial and pretrial requirements (rn) [Entry date 04/29/99]
- 6/8/99 (54) ORDER granting in part, denying in part [52-1] joint motion to amend [39-1] Scheduling order, discovery remains closed and an Order setting a new trial date will follow; granting [53-1] motion to continue trial and pretrial requirements; this case is REFERRED to Judge Turnoff (Signed by Judge Joan A. Lenard on 6/8/99) CCAP [EOD Date: 6/9/99] (rn) [Entry date 06/09/99]
- 6/8/99 (55) ORDER granting [45-1] motion for summary judgment on liability for Count I and Count II of amended complaint (Signed by Judge Joan A. Lenard on 6/8/99) CCAP [EOD Date: 6/9/99] (rn) [Entry date 06/09/99] *See Accordion Folder #*
- 7/19/99 (56) NOTICE of Resolution of emergency by Idaz Greenberg, Jerry Greenberg (rn) [Entry date 07/20/99]
- 8/16/99 (57) NOTICE set settlement conference for 10:00 9/27/99 before Magistrate Judge William C. Turnoff (Signed by Magistrate Judge William C. Turnoff on 8/12/99) CCAP [EOD Date: 8/18/99] (nt) [Entry date 08/18/99]
- 9/3/99 (58) JOINT MOTION by National Geographic, National Geographic, Idaz Greenberg, Jerry Greenberg for change in date for settlement conference (rn) [Entry date 09/07/99]

Proceedings include all events.

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- 9/21/99 (59) ORDER granting [58-1] joint motion for change in date for settlement conference reset settlement conference for 10:00 10/25/99 before Magistrate Judge William C. Turnoff (Signed by Magistrate Judge William C. Turnoff on 9/19/99) CCAP [EOD Date: 9/23/99] (rn) [Entry date 09/23/99]
- 10/19/99 (60) MOTION with memorandum in support by Idaz Greenberg, Jerry Greenberg to vacate [37-1] order and for other relief (rn) [Entry date 10/20/99]
- 10/21/99 (61) ORDER directing parties to file a Certificate of Interested Persons and Corporate Disclosure Statement within fifteen (15) days (Signed by Judge Joan A. Lenard on 10/21/99) CCAP [EOD Date: 10/22/99] (rn) [Entry date 10/22/99]
- 10/25/99 -- Settlement conference held before Duty Magistrate (pv) [Entry date 12/15/99]
- 11/2/99 (62) MEMORANDUM by Mindscape, Inc., National Geographic, National Geographic in opposition to [60-1] motion to vacate [37-1] order (rn) [Entry date 11/04/99]
- 11/2/99 (63) AFFIRMATION of Robert G. Sugarman by Mindscape, Inc., National Geographic, National Geographic Re: [62-1] opposition memorandum (rn) [Entry date 11/04/99]
- 11/5/99 (64) *See Accordion Folder #1*
Certificate of Interested Persons by Idaz Greenberg, Jerry Greenberg (rn) [Entry date 11/08/99]
- 11/10/99 (65) Certificate of Interested Persons by National Geographic, National Geographic, Mindscape, Inc. (rn) [Entry date 11/12/99]
- 11/23/99 (66) SUPPLEMENTAL MEMORANDUM by Idaz Greenberg, Jerry Greenberg in support of [60-1] motion to vacate [37-1] order (rn) [Entry date 11/24/99]
- 12/6/99 (67) ORDER set Jury trial for 4/10/00 before Judge Joan A. Lenard, set calendar call for 2:30 4/6/00 before Judge Joan A. Lenard (Signed by Judge Joan A. Lenard on 12/6/99) CCAP [EOD Date: 12/7/99] (rn) [Entry date 12/07/99]
- 12/9/99 (68) MOTION with memorandum in support by Mindscape, Inc., National Geographic, National Geographic to strike [66-1] support memorandum (rn) [Entry date 12/10/99]
- 12/9/99 (69) MEMORANDUM by Mindscape, Inc., National Geographic, National Geographic in support of [68-1] motion to strike [66-1] support memorandum (rn) [Entry date 12/10/99]
- 12/10/99 (70) ORDER denying [60-1] motion to vacate [37-1] order (Signed by Judge Joan A. Lenard on 12/10/99) CCAP [EOD Date: 12/13/99] (rn) [Entry date 12/13/99]

Proceedings include all events.

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12/28/99 (71) STIPULATION AND ORDER dismissing Counts I and II with prejudice and without costs (Signed by Judge Joan A. Lenard on 12/28/99) CCAP [EOD Date: 12/29/99] (rn) [Entry date 12/29/99]

12/28/99 -- CASE CLOSED. Case and Motions no longer referred to Magistrate. (rn) [Entry date 01/04/00]

1/26/00 (72) NOTICE OF APPEAL by Idaz Greenberg, Jerry Greenberg of [71-2] order. EOD Date: 12/29/98, [37-1] order . EOD Date: 5/19/98; Filing Fee: \$ 105.00; Receipt #: 816075; Copies to USCA and Counsel of Record. (nc) [Entry date 01/28/00]

2/4/00 (73) Appeal Information Sheet re: as to Idaz Greenberg, Jerry Greenberg [72-1] appeal. No transcript requested. Appeal Record due on 2/18/00 (sn) [Entry date 02/07/00]

2/4/00 -- NOTICE of Receipt of Transmittal Letter from USCA Re: [72-1] appeal by Jerry Greenberg, Idaz Greenberg USCA NUMBER: 00-10510-C (sn) [Entry date 02/08/00]

Vol. 1 Cont'd

End Vol. 1

U.S.D.C. # 97-3924 cv Leonard
U.S.C.A. # 00-10510C

ITEMIZED LIST OF EXHIBITS ON APPEAL

ITEM NO.	DESCRIPTION
20	(1) Box of National Geographic Magazine
	on CD-ROM

27

FILED BY _____

97 DEC 23 PM 1:00

CARLOS J. MERRITT
CLERK U.S. DIST. CT.
S.D. OF FL. MIAMI

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF FLORIDA

JERRY GREENBERG, individually,
and IDAZ GREENBERG, individually,

Plaintiffs,

CASE NO. 97-3924

CIV-LENARD

Magistrate Judge Turnoff

vs.

AMENDED COMPLAINT

NATIONAL GEOGRAPHIC
SOCIETY, a District of Columbia
corporation, NATIONAL GEOGRAPHIC
ENTERPRISES, INC., a corporation,
and MINDSCAPE, INC., a
California corporation,

Defendants.

Plaintiffs, JERRY GREENBERG and IDAZ GREENBERG (" the Greenbergs"),
pursuant to Rule 15 (a), Federal Rules of Civil Procedure, file and serve this Amended
Complaint against the NATIONAL GEOGRAPHIC SOCIETY ("the Society"), NATIONAL
GEOGRAPHIC ENTERPRISES, INC. ("Geographic Enterprises"), and MINDSCAPE, INC.
("Mindscape"), and allege:

1. This is a complaint for damages and permanent injunctive relief under the Copyright Act, codified at 17 U.S.C. § 101 et seq.

2. The Court has subject matter jurisdiction pursuant to 28 U.S.C. § 1338.

3. The Court has personal jurisdiction over the defendants, who continuously and systematically market, distribute and sell the products addressed herein within this district.

4. Venue is proper in this judicial district in that (1) the plaintiffs' residence and principal place of business is in the district, and (2) the defendants committed a statutory tort in the district, and/or engaged in business activity in the district.

5. The National Geographic Society is a not-for-profit corporation formed in the District of Columbia, and its principal place of business is there. The Society, on its own or through one or more for-profit subsidiaries, engages in multiple ventures, exemplified by the monthly National Geographic magazine, television and film programs, maps and atlases, and CD-ROM packages.

6. On information and belief, National Geographic Enterprises, Inc. is a District of Columbia corporation, and is a wholly-owned subsidiary of the National Geographic Society.

7. Mindscape, Inc. is a California corporation that, among other things, engages in the development and distribution of consumer software and other products.

8. The Greenbergs are creative artists and entrepreneurs, who for decades have published and distributed their original works in books and other products.

9. The Greenbergs have found it necessary to retain legal counsel to pursue their rights and they have agreed to pay fees charged by their counsel for such services.

Factual Allegations

The Educational Insights Product

10. A photograph of a redband parrotfish, taken by Jerry Greenberg, was originally published in a book produced by the plaintiffs titled "The Living Reef" in 1972 (and a subsequent edition in 1979) and was published by the plaintiffs in "The Coral Reef" in 1976 (and a subsequent edition in 1988). Both books contain notice of copyright by the plaintiff(s), and the copyrights were registered with the U. S. Copyright Office.

11. Copies of "The Coral Reef" were provided to the Society by Jerry Greenberg in 1977, and the Society acknowledged receipt of the copies in a letter from its editor.

12. Authorization was never provided to the Society for any use of any kind of the redband parrotfish photograph.

13. A photograph of a stoplight parrotfish, taken by Jerry Greenberg, was originally published in "The Living Reef" and subsequently in "The Coral Reef." Authorization was never provided to the Society for any use of any kind of that photograph.

14. A photograph of a green moray, taken by Jerry Greenberg, was originally published in "The Living Reef," and subsequently was published in "The Coral Reef." Authorization was never provided to the Society for any use of any kind of that photograph.

15. A photograph of a scuba-diver under water, taken by Jerry Greenberg, was originally published in the Society's monthly magazine in January 1962. Copyright as to that photograph, which originally was possessed by the Society, was assigned to Mr. Greenberg by the Society on December 18, 1985, and Mr. Greenberg renewed the copyright in 1989. After the assignment, no authorization was ever provided to the Society for derivative use as artwork.

16. A separate photograph, taken by Jerry Greenberg and showing the Greenbergs' son in scuba gear under water, was originally published in "The Living Reef" and was also published in a poster in 1974 titled "Living Corals of the Tropical Atlantic." The poster also displayed notice of copyright by Jerry Greenberg and Idaz Greenberg. No authorization was ever provided to the Society for any use of any kind of that photograph.

17. In 1995 or 1996, Educational Insights, Inc., a California-based company, began the distribution and sale of a product bearing various titles including "Fish of the Coral Reef" and "Oceans GeoPack." The product otherwise bears identification as Code 2043. The product was sold, and is being sold, within this judicial district and elsewhere. For simplicity, the product is identified hereinafter as "the GeoPack."

18. The GeoPack product bears a logo of the National Geographic Society, and displays the following notice: "© 1995 National Geographic Society."

19. Copies made from the photographs described above in paragraphs 9, 12, 13, 14 and 15 ("the Disputed Images") are included in the GeoPack. The copies were licensed by the Society to Educational Insights, Inc. for commercial purposes.

20. On information and belief, the Society agreed to indemnify Educational Insights, Inc. with respect to the Disputed Images, and the Society agreed to defend any copyright infringement claim related to the Disputed Images that may ensue, although the Greenbergs have not been provided with any documentation of such an agreement.

The Sea Fan Photograph

21. Jerry Greenberg provided to the Society a photograph of a sea fan, taken by him, to appear in the Society's monthly magazine in July 1990. By the terms of a written agreement that encompassed the sea fan photograph, all rights to the photograph, including copyright, reverted to Mr. Greenberg after publication of the article by the Society in 1990. In 1996, without authorization, the Society included the photograph of the sea fan in a color brochure promoting the Society's 1996 Jason Project. When challenged by Mr. Greenberg concerning the use, the Society admitted that it had violated Mr. Greenberg's copyright. The dispute has not been resolved.

The CD-ROM Product: The Complete National Geographic

22. In 1997, the Society began distribution and sale, on its own and through Geographic Enterprises and Mindscape, of a CD-ROM product titled The Complete National Geographic (hereinafter "the Complete Geographic product") that incorporates, among other things, a complete replication of all publications over a span of 108 years of the National Geographic monthly magazine, amounting to more than 1,200 issues of the magazine. The CD-ROM product consists of approximately 30 discs for display through a computer.

23. The Complete Geographic product also contains, among other things, a multi-media logo for the Society, and an in-motion commercial message on behalf of Kodak.

24. The Complete Geographic product displays the following notice: "© 1997 National Geographic Society. All rights reserved." The notice appears on the box containing the 30-disc set, on each box within the boxed set containing a sub-set of discs for each decade, and on each CD-ROM disc.

Amended Complaint
S.P.B.# 39 DEC 23 '97
Docket No. 00-10510-C
Moving pict seq.
© assertion
~~#15~~ THE CDROM Prod

25. The year of first publication of the Complete Geographic product was 1997, as indicated in the notice of copyright.

26. None of the 1200-plus issues of the monthly magazine contained within the Complete Geographic product was first published in 1997.

27. Each computer "page" or display that is downloaded in hard copy displays the 1997 copyright notice.

28. The Society has stated that the Complete Geographic product contains a digital image of every page of every monthly magazine, including advertisements, without any changes, additions, or modifications.

29. The Complete Geographic product was never distributed to the public by sale or other transfer of ownership, or displayed publicly, prior to 1997.

30. The Complete Geographic product is being promoted, marketed and distributed for sale by the Society and/or Geographic Enterprises and/or Mindscape, Inc., in the United States and elsewhere.

31. On information and belief, the Society and/or Geographic Enterprises authorized Mindscape, through a licensing agreement, to transfer its materials to discs, and to supervise the marketing and distribution of the CD-ROM discs.

32. On information and belief, Mindscape transferred all images to the CD-ROM discs.

33. Various monthly issues of the Society's magazine contain more than a dozen photographs created by Mr. Greenberg and provided to the Society for inclusion in particular monthly issues.

34. The Complete Geographic product contains all of the aforesaid photographs.

35. In early 1997, prior to the start of general distribution and sale of the Complete Geographic product, the Society was informed that the photographs described above may not be included in the Complete Geographic product without the Greenbergs' prior written permission. Such permission was never sought, and was never provided.

36. On each CD-ROM disc in the Complete Geographic product, near the beginning of the recorded matter, appears a sequence of moving magazine covers ("the Moving Covers Sequence") -- actually a multi-media sequence -- that serves apparently as thematic introductory material for the product. The sequence consists in part of the front covers of ten particular issues of the Society's monthly magazine. The ten covers are electronically and visually manipulated so that they metamorphose from one to another. Photographs of the sequence, made from a computer monitor to illustrate portions of the sequence, are attached to and incorporated in this Amended Complaint as Exhibit A.

37. One of the ten covers utilized in the Moving Covers Sequence is taken from the January 1962 issue of the Society's monthly magazine. That cover features a photograph of a female diver, using scuba gear, shown swimming among corals and fishes.

38. The photograph referenced in the paragraph above was taken by Jerry Greenberg. The photograph appears on the cover of the January 1962 issue, as well as inside that issue as part of a feature titled "Florida's Coral City Beneath the Sea," which started at page 70 of that monthly issue.

39. All rights to the photograph, including copyright, are owned by Mr. Greenberg. The Society never sought, and never obtained, permission to alter or deform the photograph for inclusion in the Complete Geographic product.

Other Photographs and Other Products

40. The Society has in its possession or control hundreds of photographs taken by Mr. Greenberg, or duplicates or electronically-scanned images of those photographs.

41. The Society has acknowledged that, in addition to the Complete Geographic product, the Society and Mindscape have developed and are developing 10 other CD-ROM products, or "titles," to be released in 1997 and 1998.

Count I
(Copyright infringement by the Society)

42. The allegations in paragraphs 9 through 19, and 40-41, are realleged and incorporated herein.

43. The Society had access to the Greenberg photographs.

44. The Disputed Images that appear in the GeoPack product are at least substantially similar to the Greenberg photographs, and an inference is warranted that the Disputed Images are copies.

45. Jerry Greenberg and/or Idaz Greenberg hold valid and exclusive copyright in the Greenberg photographs.

46. The photographs were copied by or for the Society, and provided to Educational Insights, Inc. by the Society for use in the GeoPack product, without the permission of the

copyright owners. Such conduct amounts to infringement by the Society pursuant to the Copyright Act.

47. In July 1996, the Greenbergs advised Educational Insights, Inc. that the copies had not been authorized, and demand was made that use of the copies in the GeoPack product be discontinued. The Society subsequently responded as the apparent licensor by denying the demand, and the continued use of the copies amounts to willful infringement.

WHEREFORE the plaintiffs seek the following relief with respect to Count I:

- (1) Entry of judgment against the Society for copyright infringement.
- (2) An award of statutory damages.
- (3) An award of exemplary damages for willful infringement.
- (4) Entry of a permanent injunction to halt any further use of the Disputed Images in the GeoPack product.
- (5) Entry of a permanent injunction to preclude any use by the Society, or by others with its participation, of the many photographs currently in the possession and control of the Society for which Mr. Greenberg, or the Greenbergs jointly, hold exclusive copyright or other proprietary interest.
- (6) An award of attorneys' fees and costs.
- (7) Such other relief as may be appropriate in the circumstances.

Count II
(Copyright infringement by the Society)

48. The allegations in paragraph 20 are realleged and incorporated herein.

49. The Society had access to the Greenberg photograph of a sea fan, which was delivered by him directly to the Society.

50. The photograph of the sea fan in the color brochure promoting the Society's 1996 Jason Project is identical to the Greenberg photograph.

51. Mr. Greenberg holds valid and exclusive copyright in the sea fan photograph.

52. The sea fan photograph was used by the Society as discussed herein without the authorization of Mr. Greenberg. Such conduct amounts to infringement pursuant to the Copyright Act.

WHEREFORE the plaintiffs seek the following relief with respect to Count II:

- (1) Entry of judgment against the Society for copyright infringement.
- (2) An award of statutory damages.
- (3) Entry of a permanent injunction to halt any further use of the sea fan photograph.
- (4) Entry of a permanent injunction to preclude any use by the Society, or by others with its participation, of the many photographs currently in the possession and control of the Society for which Mr. Greenberg, or the Greenbergs jointly, hold exclusive copyright or other proprietary interest.
- (5) An award of attorneys' fees and costs.
- (6) Such other relief as may be appropriate in the circumstances.

Count III
**(Copyright infringement by the Society,
Geographic Enterprises and Mindscape)**

53. The allegations in paragraphs 21 through 41 are realleged and incorporated herein.

54. The Complete Geographic product is a collection of more than 1,200 separate issues of the Society's monthly magazine, and contains reproductions or copies of the full contents of each issue. In copying those contents, the Society included in the Complete Geographic product more than a dozen photographs created by Jerry Greenberg ("the Greenberg Photographs"), for which he, or the Greenbergs jointly, own exclusive copyright.

55. The Complete Geographic product also includes, among other things, the Moving Covers Sequence, which incorporates a cover photograph by Mr. Greenberg ("the Cover Photograph"). Because the Moving Covers Sequence appears on each of the 30 CD-ROM discs comprising the Complete Geographic product, the Cover Photograph appears in the Complete Geographic product in 30 separate places (beyond its original use in the July 1962 issue of the monthly magazine).

56. Each separate issue of the Society's monthly magazine is a collective work, by virtue of the collection, selection, arrangement and assembly of materials in such a way that the resulting work as a whole -- the monthly issue -- constitutes an original work of authorship.

57. As a collective work, each separate issue of the Society's monthly magazine, at least since adoption of the 1909 Copyright Act, is or has been protected by federal copyright law pursuant to statute.

COUNT III
54. © owned G's
65. © infringement
66. © infr
67. © infr

58. Each separate issue of the Society's monthly magazine bears copyright notice indicating, among other things, the year of first publication.

59. The existence of the Society's copyright in each underlying collective work -- each monthly magazine -- does not undermine or diminish in any way the Greenberg copyrights that apply to Greenberg photographs that appear within particular monthly issues.

60. The Complete Geographic product is not a "further use" of a preexisting collective work, or a "revision" of a preexisting collective work.

61. The Complete Geographic product is a new collective work, by virtue of the collection, selection, arrangement and assembly of materials -- some preexisting, some entirely new -- in a product that as a whole constitutes an original work of authorship.

62. In a copyright sense, no work like the Complete Geographic product ever existed previously.

63. As a new collective work, the Complete Geographic product is copyrightable. The Society has given notice of a 1997 copyright in that work. Any individual screen display derived from the CD-ROM contains 1997 copyright notice on that display when printed in hard copy.

64. Pursuant to the Copyright Act, the date in such notice indicates the year of first publication.

65. The Society and Geographic Enterprises had no right, as a matter of law, to reproduce, copy, display or sell the Greenberg Photographs in the Complete Geographic product, or to reuse the Cover Photograph in altered form, without prior permission. In the absence of

permission, the inclusion of the Greenberg Photographs and the altered Cover Photograph in the new collective work, amounts to infringement of the Greenberg copyrights.

66. Geographic Enterprises and Mindscape are at least vicariously liable for infringement of the aforesaid copyrights because of their roles in producing the CD-ROM discs and in distributing and selling the Complete Geographic product.

67. Prior to the start of general distribution and sale of the Complete Geographic product, the Society was warned not to include, or permit the inclusion of, the protected Greenberg photographs in the new collective work without prior written permission. The Society ignored the demand entirely, never discussed the subject with Mr. Greenberg or his counsel, and never obtained permission for the use of his photographs in the product. The infringement of the Greenberg copyrights addressed in this count was, therefore, willful.

WHEREFORE the plaintiffs seek the following relief with respect to Count III:

- (1) Entry of judgment against the Society, Geographic Enterprises, and Mindscape for copyright infringement.
- (2) An award of statutory damages.
- (3) An award of exemplary damages for willful infringement.
- (4) Entry of a permanent injunction to halt any further use of the protected Greenberg photographs in the Complete Geographic product.
- (5) Entry of a permanent injunction to preclude any use by the Society, or by others with its participation, of the many photographs currently in the possession and control of the Society for which Mr. Greenberg, or the Greenbergs jointly, hold exclusive copyright or other proprietary interest.

- (6) An award of attorneys' fees and costs.
- (7) Such other relief as may be appropriate in the circumstances.

Count IV
(Copyright infringement by the Society,
Geographic Enterprises and Mindscape)

68. The allegations in paragraphs 21 through 41 are realleged and incorporated herein.

69. The Complete Geographic product is a collection of more than 1,200 separate issues of the Society's monthly magazine, and contains reproductions or copies of the full contents of each issue. In copying those contents, the Society included in the Complete Geographic product more than a dozen photographs created by Jerry Greenberg ("the Greenberg Photographs"), for which he, or the Greenbergs jointly, own exclusive copyright.

70. The Complete Geographic product also includes, among other things, the Moving Covers Sequence, which incorporates a cover photograph by Mr. Greenberg ("the Cover Photograph"). Because the Moving Covers Sequence appears on each of the 30 CD-ROM discs comprising the Complete Geographic product, the Cover Photograph appears in the Complete Geographic product in 30 separate places (beyond its original use in the July 1962 issue of the monthly magazine).

71. Each separate issue of the Society's monthly magazine is a collective work, by virtue of the collection, selection, arrangement and assembly of materials in such a way that the resulting work as a whole -- the monthly issue -- constitutes an original work of authorship.

Count IV
80. © infringement
81-82-(1)

72. As a collective work, each separate issue of the Society's monthly magazine, at least since adoption of the 1909 Copyright Act, is or has been protected by federal copyright law pursuant to statute.

73. Each separate issue of the Society's monthly magazine bears copyright notice indicating, among other things, the year of first publication.

74. The existence of the Society's copyright in each underlying collective work -- each monthly magazine -- does not undermine or diminish in any way the Greenberg copyrights that apply to Greenberg photographs that appear within particular monthly issues.

75. The Complete Geographic product is not a "further use" of a preexisting collective work, or a "revision" of a preexisting collective work.

76. The Complete Geographic product is a new derivative work and a product that as a whole constitutes an original work of authorship.

77. In a copyright sense, no work like the Complete Geographic product ever existed previously.

78. As a new derivative work, the Complete Geographic product is copyrightable. The Society has given notice of a 1997 copyright in that work. Any individual screen display derived from the CD-ROM contains 1997 copyright notice on that display when printed in hard copy.

79. Pursuant to the Copyright Act, the date in such notice indicates the year of first publication.

80. The Society and Geographic Enterprises had no right, as a matter of law, to reproduce, copy, display or sell the Greenberg Photographs in the Complete Geographic product.

or to reuse the Cover Photograph in altered form, without prior permission. In the absence of permission, the inclusion of the Greenberg Photographs and the altered Cover Photograph in the new derivative work, amounts to infringement of the Greenberg copyrights.

81. Geographic Enterprises and Mindscape are at least vicariously liable for infringement of the aforesaid copyrights because of their roles in producing the CD-ROM discs and in distributing and selling the Complete Geographic product.

82. Prior to the start of general distribution and sale of the Complete Geographic product, the Society was warned not to include, or permit the inclusion of, the protected Greenberg photographs in the new derivative work without prior written permission. The Society ignored the demand entirely, never discussed the subject with Mr. Greenberg or his counsel, and never obtained permission for the use of his photographs in the product. The infringement of the Greenberg copyrights addressed in this count was, therefore willful.

WHEREFORE the plaintiffs seek the following relief with respect to Count III:

- (1) Entry of judgment against the Society, Geographic Enterprises, and Mindscape for copyright infringement.
- (2) An award of statutory damages.
- (3) An award of exemplary damages for willful infringement.
- (4) Entry of a permanent injunction to halt any further use of the protected Greenberg photographs in the Complete Geographic product.
- (5) Entry of a permanent injunction to preclude any use by the Society, or by others with its participation, of the many photographs currently in the possession and control of the

Society for which Mr. Greenberg, or the Greenbergs jointly, hold exclusive copyright or other proprietary interest.

- (6) An award of attorneys' fees and costs.
- (7) Such other relief as may be appropriate in the circumstances.

Count V
(Copyright Infringement Against the Society,
Geographic Enterprises, and Mindscape)

83. The allegations in paragraphs 21 through 41 above are realleged and incorporated.

84. The Society had access to the Greenberg photograph ("the Cover Photograph") that is included in the Moving Cover Sequence that appears on each CD-ROM disc comprising the Complete Geographic product.

85. An exact replica of the Cover Photograph has been altered and deformed for utilization in the Moving Cover Sequence.

86. Mr. Greenberg holds valid and exclusive copyright in the photograph.

87. Mr. Greenberg never authorized the defendants to alter and deform the photograph in the Moving Covers Sequence.

88. Inclusion of the Cover Photograph in the Moving Covers Sequence without Mr. Greenberg's prior permission amounts to infringement under the Copyright Act.

89. Geographic Enterprises and Mindscape are at least vicariously liable for infringement of the aforesaid copyright because of their roles in producing the CD-ROM discs and in distributing and selling the Complete Geographic product that contains the Cover Photograph in the Moving Covers Sequence.

Count V
86. © held by G
88. © infringement
89 " 95 " (1)

90. The Society knew that it did not possess a copyright interest in the Cover Photograph, and by altering and deforming the photograph in the Moving Covers Sequence without consent willfully infringed the Greenberg copyright.

WHEREFORE the plaintiffs seek the following relief with respect to Count IV:

- (1) Entry of judgment against the Society, Geographic Enterprises, and Mindscape for copyright infringement.
- (2) An award of statutory damages.
- (3) An award of exemplary damages for willful infringement.
- (4) Entry of a permanent injunction to halt any further use of the Cover Photograph in the Moving Cover Sequence.
- (5) An award of attorneys' fees and costs.
- (6) Such other relief as may be appropriate in the circumstances.

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CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing amended complaint was served by hand delivery on Valerie Itkoff, Esq., Weil, Gotshal & Manges LLP, 701 Brickell Avenue, Suite 2100, Miami, Florida 33131, this 23rd day of December, 1997.



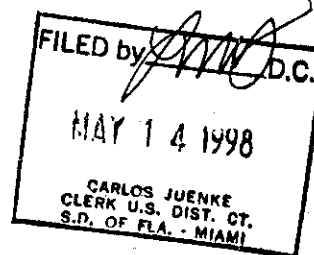
Norman Davis

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF FLORIDA

CASE NO. 97-3924-CIV-LENARD

JERRY GREENBERG, individually,
and IDAZ GREENBERG, individually,

Plaintiffs,



vs.

ORDER GRANTING IN PART AND
DENYING IN PART DEFENDANTS'
MOTION FOR PARTIAL SUMMARY JUDGMENT

NATIONAL GEOGRAPHIC SOCIETY,
a District of Columbia corporation,
NATIONAL GEOGRAPHIC
ENTERPRISES, INC., a corporation,
and MINDSCAPE, INC., a California
corporation,

Defendants.

THIS CAUSE comes before this Court upon Defendants' motion to dismiss and/or for summary judgment (D.E. 18), Plaintiff's cross-motion for summary judgment (D.E. 26), Plaintiff's motion for voluntary dismissal (D.E. 24), and Defendants' motion for oral argument (D.E. 28).

In 1990, Jerry Greenberg (Greenberg) provided National Geographic Society (Society) with a photograph he had taken of a sea fan, for publication in the July 1990 issue of Society's magazine. Without Greenberg's permission, in 1996 Society reprinted the photograph in a promotional brochure. In 1995 and 1996, also without Greenberg's authorization, Society supplied other photographs taken by Greenberg, including those of a redband parrotfish, a spotlight parrotfish, and a green moray, to Educational Insights, Inc. (Insights), which used them in one of its products.

In 1997, Society, through National Geographic Enterprises, Inc. (Enterprises) and Mindscape, Inc. (Mindscape), produced and began to sell a 30 disc CD-ROM set, entitled The Complete National Geographic, which contains every issue ever published of Society's magazine. A number of the magazines published by Society over the years apparently contain photographs taken by Greenberg. At the beginning of each of the 30 discs in the CD-ROM set is an introduction to The National Geographic which consists of a sequence of ten of the magazine's covers. On one of those covers, from the magazine's January 1962 issue, is a photograph, taken by Greenberg, of a woman scuba diving around a coral reef.

On December 5, 1997, Plaintiff Greenberg filed an action in this Court for

37 P.2 ~~bottom~~
to P.3 Dec 5 '97
also action for ©
INFRINGEMENT

copyright infringement against Society, Enterprises and Mindscape. Greenberg alleges that Society infringed his copyright by providing his photographs of a redband parrotfish, a spotlight parrotfish and a green moray to Insights for use in its products (count I), and by reprinting his photograph of a sea fan in a 1996 promotional brochure (count II). Greenberg also alleges that Society, Enterprises and Mindscape infringed his copyright by reproducing a number of his photographs in The Complete National Geographic. On January 30, 1998, Defendants filed a motion to dismiss counts II through V of Greenberg's complaint and, in the alternative, a motion for summary judgment on counts III through V. As Greenberg and Defendants have supplemented their pleadings with evidence, the Court will treat both of these motions as requests for summary judgment.

A motion for summary judgment may be granted only if no genuine dispute exists as to any material fact. Fed. R. Civ. P. 56(c). In deciding whether there is a genuine issue of material fact, the Court must view the pleadings, affidavits and other evidence in the record "in the light most favorable to the non-moving party." Retina Associates, P.A. v. Southern Baptist Hosp. of Florida, Inc., 105 F.3d 1376, 1380 (11th Cir. 1997).

Defendants first contend that counts II through V of Greenberg's complaint

must be dismissed, pursuant to 17 U.S.C. §411(a), because there is no evidence that he registered his copyright in the photograph of the sea fan which Society printed in its 1996 promotional brochure, or in any of the photographs published in Society's magazines, including that of a woman scuba diving around a coral reef. Indeed, "[c]opyright registration is a pre-requisite to the institution of a copyright infringement lawsuit." Arthur Rutenberg Homes, Inc. v. Drew Homes, Inc., 29 F.3d 1529, 1532 (11th Cir. 1994). Greenberg has provided the Court with evidence, however, that on December 18, 1995 Society assigned to him the copyrights in these photographs, and that he subsequently renewed those copyrights prior to the time of their expiration. Exhibit B, 1-3, Plaintiff's Memorandum in Opposition to Defendants' Motion to Dismiss or for Summary Judgment.

proof of assignment
furnished

Defendants next argue, pursuant to 17 U.S.C. §201(c), that counts III through V of Greenberg's complaint must be dismissed because Defendants are permitted to reproduce and distribute, in *The Complete National Geographic*, photographs taken by Greenberg, including his photograph of a woman scuba diving around a coral reef, which were previously published in Society's magazines. Under 17 U.S.C. §201(c):

Copyright in each separate contribution to a collective work is distinct from

copyright in the collective work as a whole, and vests initially in the author of the contribution. In the absence of an express transfer of the copyright or of any rights under it, the owner of copyright in the collective work is presumed to have acquired only the privilege of reproducing and distributing the contribution as a part of that particular collective work, any revision of that collective work, and any later collective work in the same series.

17 U.S.C. §201(c). Defendants concede that the previous issues of Society's magazines in which Greenberg's photographs were published are collective works in which Defendants were permitted to reproduce Greenberg's photographs. They submit, however, that The Complete National Geographic constitutes a 'revision' of that collective work within the meaning of 17 U.S.C. §201(c). Greenberg disagrees.

The Court has only been able to locate one published opinion, Tasini v. New York Times Co., 972 F. Supp. 804 (S.D.N.Y. 1997), in which a court has addressed the issue whether a collective work is a revision within the meaning of this statute. In that case, a number of freelance writers whose articles were published in several widely read periodicals sued those periodicals and two companies to which the periodicals sold the writers' articles, one of which provided its subscribers with the texts of the articles electronically and the other of which distributed the texts on CD-ROM, for copyright infringement. The defendants argued that the electronic databases and the CD-ROM's promulgating

the writers' articles were 'revisions' of the periodicals, collective works, within the meaning of 17 U.S.C. §201(c).

The court observed that:

If defendants change the original selection and arrangement of their newspapers or magazines, however, they are at risk of creating new works, works no longer recognizable as versions of the periodicals that are the source of their rights. Thus, in whatever ways they change their collective works, defendants must preserve some significant original aspect of those works -- whether an original selection or an original arrangement -- if they expect to satisfy the requirements of Section 201(c). Indeed, it is only if such a distinguishing original characteristic remains that the resulting creation can fairly be termed a revision of "that collective work" which preceded it.

Tasini, 972 F. Supp. at 821. In order to determine whether the electronic databases and CD-ROMs constituted a 'revision' of the periodicals, the court explained that a two-pronged inquiry is necessary. First, a court must identify any original selection or arrangement of materials in the collective work. Second, if the court concludes that the collective work possesses any such original selection or arrangement of materials, it must determine whether these characteristics are preserved electronically. Tasini, 972 F. Supp. at 821. The Tasini court then concluded that:

If the disputed periodicals manifest an original selection or arrangement of materials, and if that originality is preserved electronically, then the electronic reproductions can be deemed permissible revisions of the publisher defendants' collective works. If, on the other hand, the electronic

defendants do not preserve the originality of the disputed publications, but merely exploit the component parts of those works, then plaintiffs' rights in those component parts have been infringed.

Tasini, 972 F. Supp. at 822. This Court finds the Tasini Court's reasoning sound and therefore adopts the legal framework developed by that court to analyze the legal question currently before this Court.

Society indisputably selected and arranged the articles and photographs in each issue of its magazines. The question therefore arises whether this original selection and arrangement is preserved in The Complete National Geographic. In order to answer this question in the affirmative, the Tasini court noted that the electronic work "cannot differ in selection by more than a trivial degree from the work that preceded it." Tasini, 972 F. Supp. at 823.

As evidence that The Complete National Geographic does not differ by more than a trivial degree from Society's magazines, Defendants have supplied the Court with the declarations of Thomas Stanton, Society's Director of CD-ROM Product Management, who states that: (1) The Complete National Geographic contains an "exact image of each page as it appeared in the Magazine;" (2) The Complete National Geographic draws from the northeastern edition of Society's magazine; (3) the 30 to 40 regional editions of the magazine which Society publishes are identical except for the advertisements; and (4) at the

Stanton
deposits
affidavit

beginning of each CD-ROM in The Complete National Geographic, there is a short display of images from ten different magazine covers, including the January 1962 cover showing the picture taken by Greenberg of a woman scuba diving around a coral reef. Declaration of Thomas Stanton, ¶ 5 - 7; Reply Declaration of Thomas Stanton, ¶ 4. Greenberg has not adduced any evidence to contradict Stanton's statements.

He submits, however, that the image display and Society logo at the beginning of each disc, the credit display at the end of each disc, and Society's selection of one edition of the many editions of the magazine, render The Complete National Geographic more than trivially different from Society's magazines. This Court disagrees, and concludes that the evidence produced by Defendants indicates that the Complete National Geographic "retain[s] enough of [D]efendants' periodicals to be recognizable as versions of those periodicals." Tasini, 972 F. Supp. at 824. Consequently, The Complete National Geographic constitutes a 'revision' of Society's magazines within the meaning of 17 U.S.C. §201(c). Defendants therefore did not improperly reproduce or distribute, in The Complete National Geographic, Greenberg's photographs.

Accordingly, it is hereby ORDERED AND ADJUDGED that:

(1) Defendants' motion to dismiss and/or for summary judgment as to count

II, be DENIED;

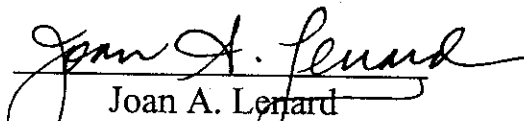
(2) Defendants' motion for summary judgment as to counts III, IV and V, be GRANTED. Counts III, IV and V are therefore DISMISSED with prejudice.*

(3) Plaintiff Greenberg's cross-motion for summary judgment as to count III, be DENIED;

(4) Plaintiff Greenberg's motion to voluntarily dismiss count IV, be DENIED as MOOT; and

(5) Defendants' request for oral argument, be DENIED.

DONE AND ORDERED in Chambers, at Miami, Florida on this 14 day of May, 1998.


Joan A. Lenard
United States District Judge

cc: Valerie Itkoff, Esq.
Norman Davis, Esq.

*Defendants also contend that counts III through V should be dismissed because their use in the image display at the beginning of each disc of The Complete National Geographic of Greenberg's 1962 cover photograph of a woman scuba diving around a coral reef is: (1) de minimus; and (2) fair use within the meaning of 17 U.S.C. §107. In light of its conclusion that Defendants are permitted to use the cover photograph at issue pursuant to 17 U.S.C. §201(c), the Court need not entertain these arguments.

TASINI

[AMENDED OPINION]
UNITED STATES COURT OF APPEALS
FOR THE SECOND CIRCUIT

August Term, 1998

(Argued: April 26, 1999

Decided: September 24, 1999

Amended: February 25, 2000)

Docket Nos. 97-9181, 97-9650

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

Plaintiffs-Appellants,

BARBARA BELEJACK; DANIEL LAZARE; JOAN OLECK
and LINDSY VAN GELDER,

Plaintiffs,

—v.—

THE NEW YORK TIMES COMPANY, INC.; NEWSDAY, INC.;
THE TIME INCORPORATED MAGAZINE COMPANY; MEAD
DATA CENTRAL CORP. and UNIVERSITY MICROFILMS
INTERNATIONAL,

Defendants-Appellees,

THE ATLANTIC MONTHLY COMPANY,

Defendant.

Before:

WINTER, *Chief Judge*,
MINER, and POOLER, *Circuit Judges*.

Appeal from a grant of summary judgment entered in the United States District Court for the Southern District of New York (Sotomayor, *J.*). Appellants are authors who own copyrights to individual articles previously published in periodicals. They claim infringement by appellee publishers and owners of electronic databases who made the articles available on the electronic databases. The district court held that appellees are protected by the privilege afforded the publishers of "collective works" under Section 201(c) of the Copyright Act. We reverse and remand with instructions to enter judgment for appellants.

EMILY M. BASS, Gaynor & Bass, New York, New York (Linda A. Backiel, Michael J. Gaynor, Nicole M. Zeiss, Joanna Kyd, Gaynor & Bass, on the brief; Alice Haemmerli, Columbia University School of Law, New York, New York, of counsel), *for Plaintiffs-Appellants Barbara Garson and Sonia Jaffe Robbins*.

PATRICIA A. FELCH, Peterson & Ross, Chicago, Illinois (Anthony L. Abboud, Joshua L. Smith, Peterson & Ross, of counsel; Jordan Rossen, Detroit, Michigan, of counsel), *for Plaintiffs-Appellants Jonathan Tasini, Mary Kay Blakely, Margot Mifflin and David S. Whitford*.

BRUCE P. KELLER, Debevoise & Plimpton, New York, New York, (Lorin L. Reisner, Peter Johnson, of counsel), *for Defendants-Appellees*.

Stanley Rothenberg, Moses & Singer, New York, New York (David Rabinowitz, Eric P. Bergner, Elizabeth A. Corrandino, Moses & Singer, on the brief; Jerry S. Birenz, Sabin, Bermant & Gould, New York, New York, of counsel), *for Amici Curiae in Support of Defendants-Appellees*.

Victor S. Perlman, Princeton Junction, New Jersey, *for Amici Curiae American Society of Media Photographers, Inc. et al.*

WINTER, *Chief Judge*:

Six freelance writers appeal from a grant of summary judgment dismissing their complaint. The complaint alleged that appellees had infringed appellants' various copyrights by putting individual articles previously published in periodicals on electronic databases available to the public. On cross motions for summary judgment, the United States District Court for the Southern District of New York held that appellees' use of the articles was protected by the "privilege" afforded to publishers of "collective works" under Section 201(c) of the Copyright Act of 1976 ("Act" or "1976 Act"), 17 U.S.C. § 201(c). We reverse and remand with instructions to enter judgment for appellants.

BACKGROUND

Appellants are freelance writers (individually, "Author" and collectively, "Authors") who write articles for publication in periodicals. Their complaint alleged that certain articles were original works written for first publication by one of the appellee publishers between 1990 and 1993. None of the articles was written at a time when its Author was employed by the particular periodical; nor was any such article written pursuant to a work-for-hire contract. The Authors registered a copyright in each of the articles.

The appellee newspaper and magazine publishers (collectively, "Publishers") are periodical publishers who regularly create "collective works," *see* 17 U.S.C. § 101, that contain articles by free lance authors as well as works created for-hire or by employees. With respect to the free lance articles pertinent to this appeal, the Publishers' general practice was to negotiate due-dates, word counts, subject matter and price; no express transfer of rights under the Author's copyright was sought.¹ As to one article alleged in the complaint, however, authored by appellant David S. Whitford for Sports Illustrated, a publication of appellee The Time Incorporated Magazine Company ("Time"), a written contract expressly addressed republication rights. We address Whitford's claim separately below.

¹ Newsday contended in the district court that a legend on the checks it used to pay for freelance pieces made those checks, once endorsed, express transfers of copyright pursuant to Section 204(a) of the Act. The district court rejected this argument, relying on reasoning with which we substantially agree. *See Tasini v. New York Times Co.*, 972 F. Supp. 804, 810-811 (S.D.N.Y. 1997). In any event, Newsday does not cross-appeal.

We note also that The New York Times has since updated its policy to require freelance writers to execute an express transfer of their copyrights. *See id.* at 807 n.2.

Appellee Mead Data Central Corp. owns and operates the NEXIS electronic database. NEXIS is a massive database that includes the full texts of articles appearing in literally hundreds of newspapers and periodicals spanning many years. Mead has entered into licensing agreements with each of the Publishers. Pursuant to these agreements, the Publishers provide Mead with much of the content of their periodicals, in digital form, for inclusion in NEXIS. Subscribers to NEXIS are able to access an almost infinite combination of articles from one or more publishers by using the database's advanced search engine. The articles may be retrieved individually or, for example, together with others on like topics. Such retrieval makes the article available without any material from the rest of the periodical in which it first appeared.

We briefly describe the process by which an issue of a periodical is made available to Mead for inclusion in NEXIS. First, an individual issue of the paper is stripped, electronically, into separate files representing individual articles. In the process, a substantial portion of what appears in that particular issue of the periodical is not made part of a file transmitted to Mead, including, among other things, formatting decisions, pictures, maps and tables, and obituaries. Moreover, although the individual articles are "tagged" with data indicating the section and page on which the article initially appeared, certain information relating to the initial page layout is lost, such as placement above or below the fold in the case of The New York Times. After Mead further codes the individual files, the pieces are incorporated into the NEXIS database.

Appellee University Microfilms International ("UMI") markets, *inter alia*, CD-ROM database products. Pursuant to an agreement with The New York Times and Mead, UMI produces and markets the "NY Times OnDisc" ("NYTO")

CD-ROM, which contains the full texts of articles from The New York Times. It also produces and markets a "General Periodicals OnDisc" ("GPO") CD-ROM, which contains selected New York Times articles and thousands of other articles. Pursuant to its agreement with Mead and The New York Times, UMI incorporates the files containing Times articles into its NYTO database. UMI uses a somewhat different methodology to incorporate articles from the NY Times Sunday book-review and magazine sections onto its GPO CD-ROM. As to these pieces, UMI scans them directly onto "image-based" files. The image-based files are also abstracted and included on the text-based CD-ROM; the abstracts facilitate access to the image-based disk.

The gist of the Authors' claim is that the copyright each owns in his or her individual articles was infringed when the Publishers provided them to the electronic databases. Appellees do not dispute that the Authors own the copyright in their individual works. Rather, they argue that the Publishers own the copyright in the "collective works" that they produce and are afforded the privilege, under Section 201(c) of the Act, of "reproducing and distributing" the individual works in "any revision of that collective work." 17 U.S.C. § 201(c). The crux of the dispute is, therefore, whether one or more of the pertinent electronic databases may be considered a "revision" of the individual periodical issues from which the articles were taken. The district court held that making the articles available on the databases constitutes a revision of the individual periodicals and that appellees' licensing arrangements were protected under Section 201(c). *See Tasini v. New York Times Co.*, 972 F. Supp. 804 (S.D.N.Y. 1997) ["Tasini I"]. It therefore granted appellees' motion for summary judgment. After a motion for reconsideration was denied, *see Tasini v. New York Times Co.*, 981 F. Supp. 841 (S.D.N.Y. 1997) ["Tasini II"], appellants brought this appeal.

DISCUSSION

We review *de novo* the grant or denial of summary judgment and view the evidence in the light most favorable to the non-moving party. See *Turner v. General Motors Acceptance Corp.*, 180 F.3d 451, 453-54 (2d Cir. 1999). Summary judgment is appropriate only if the pleadings and evidentiary submissions demonstrate the absence of any genuine issue of material fact and that the moving party is entitled to judgment as a matter of law. See *id.* at 453.

The unauthorized reproduction and distribution of a copyrighted work generally infringes the copyright unless such use is specifically protected by the Act. To reiterate, each Author owns the copyright in an individual work and, save for Whitford, *see infra*, has neither licensed nor otherwise transferred any rights under it to a Publisher or electronic database. These works were published with the Authors' consent, however, in particular editions of the periodicals owned by the Publishers. The Publishers then licensed much of the content of these periodicals, including the Authors' works, to one or more of the electronic database providers. As a result, the Authors' works are now available to the public on one or more electronic databases and may be retrieved individually or in combination with other pieces originally published in different editions of the periodical or in different periodicals.

In support of their claim, the Authors advance two principal arguments: first, Section 201(c) protects only the Publishers' initial inclusion of individually copyrighted works in their collective works does not permit the inclusion of individually copyrighted works in one or more of the electronic databases; and, second, any privilege the Publishers have under Section 201(c) is not a transferrable "right" within the meaning of Section 201(d) and hence may not be invoked by the electronic database providers. The district court rejected

both arguments, reasoning that the "privilege" under Section 201(c) is a "subdivision" of a right that is transferrable under Section 201(d)(2), 972 F. Supp. at 815, and that the scope of the "privilege" was broad enough to permit the inclusion of the Authors' pieces in the various databases, *see id.* at 824-25. We hold that Section 201(c) does not permit the Publishers to license individually copyrighted works for inclusion in the electronic databases. We need not, and do not, reach the question whether this privilege is transferrable under Section 201(d).²

a) *The Section 201(c) Presumption (or, simply, "Section 201(c)")*

Section 201 of the Act provides, *inter alia*, that as to contributions to collective works, the "[c]opyright in each separate contribution . . . is distinct from copyright in the collective work as a whole, and vests initially in the author of the contribution." 17 U.S.C. § 201(c). Correspondingly, Section 103, which governs copyright in compilations and derivative works, provides in pertinent part that:

The copyright in a compilation or derivative work extends only to the material contributed by the author of such work, as distinguished from the preexisting material employed in the work, and does not imply any exclusive right in the preexisting material.

17 U.S.C. § 103(b). Section 101 states that "[t]he term 'compilation' includes collective works." 17 U.S.C. § 101. It further defines "collective work" as "a work, such as a periodical issue, anthology, or encyclopedia, in which a number of contributions, constituting separate and independent works in themselves, are assembled into a collective whole." *Id.*

² We also do not consider the issue of assignability. Rather, we assume for purposes of this decision only, that the Publishers had the right to assign the articles in question to Mead and UMI.

Publishers of collective works are not permitted to include individually copyrighted articles without receiving a license or other express transfer of rights from the author. However, Section 201(c) creates a presumptive privilege to authors of collective works. Section 201(c) creates a presumption that when the author of an article gives the publisher the author's permission to include the article in a collective work, as here, the author also gives a non-assignable, non-exclusive privilege to use the article as identified in the statute. It provides in pertinent part that:

In the absence of an express transfer of the copyright or of any rights under it, the owner of copyright in the collective work is presumed to have acquired only the privilege of reproducing and distributing the contribution as part of that particular collective work, any revision of that collective work, and any later collective work in the same series.

17 U.S.C. § 201(c).

Under this statutory framework, the author of an individual contribution to a collective work owns the copyright to that contribution, absent an express agreement setting other terms. *See id.* The rights of the author of a collective work are limited to "the material contributed by the [collective-work] author" and do not include "any exclusive right in the preexisting material." 17 U.S.C. § 103(b). Moreover, the presumptive privilege granted to a collective-work author to use individually copyrighted contributions is limited to the reproduction and distribution of the individual contribution as part of: (i) "that particular [*i.e.*, the original] collective work"; (ii) "any revision of that collective work"; or (iii) "any later collective work in the same series." 17 U.S.C. § 201(c). Because it is undisputed that the electronic databases are neither the original collective work—the particular edition of the periodical—in which the Authors' articles were published nor a

later collective work in the same series, appellees rely entirely on the argument that each database constitutes a "revision" of the particular collective work in which each Author's individual contribution first appeared. We reject that argument.

We begin, as we must, with the language of the statute. *See Lewis v. United States*, 445 U.S. 55, 60 (1980). The parameters of Section 201(c) are set forth in the three clauses just noted. Under ordinary principles of statutory construction, the second clause must be read in the context of the first and third clauses. *See General Elec. Co. v. Occupational Safety & Health Review Comm'n*, 583 F.2d 61, 64-65 (2d Cir. 1978) ("the meaning of one term may be determined by reference to the terms it is associated with" (citing 2A Sutherland, *Statutory Construction* §§ 47.16 (*Noscitur a sociis*), 47.17 (*Ejusdem generis*) (4th ed. 1973)); *see also Securities & Exch. Comm'n v. National Sec., Inc.*, 393 U.S. 453, 466 (1969) ("The meaning of particular phrases must be determined in context.") (citation omitted). The first clause sets the floor, so to speak, of the presumptive privilege: the collective-work author is permitted to reproduce and distribute individual contributions as part of "that particular collective work." In this context, "that particular collective work" means a specific edition or issue of a periodical. *See* 17 U.S.C. § 201(c). The second clause expands on this, to permit the reproduction and distribution of the individual contribution as part of a "revision" of "that collective work," *i.e.*, a revision of a particular edition of a specific periodical. Finally, the third clause sets the outer limit or ceiling on what the Publisher may do; it permits the reproduction and distribution of the individual contribution as part of a "later collective work in the same series," such as a new edition of a dictionary or encyclopedia.

The most natural reading of the "revision" of "that collective work" clause is that Section 201(c) protects only later

editions of a particular issue of a periodical, such as the final edition of a newspaper. Because later editions are not identical to earlier editions, use of the individual contributions in the later editions might not be protected under the preceding clause. Given the context provided by the surrounding clauses, this interpretation makes perfect sense. It protects the use of an individual contribution in a collective work that is somewhat altered from the original in which the copyrighted article was first published, but that is not in any ordinary sense of language a "later" work in the "same series."

In this regard, we note that the statutory definition of "collective work" lists as examples "a periodical issue, anthology, or encyclopedia." 17 U.S.C. § 101. The use of these particular kinds of collective works as examples supports our reading of the revision clause. Issues of periodicals, as noted, are often updated by revised editions, while anthologies and encyclopedias are altered every so often through the release of a new version, a "later collective work in the same series." Perhaps because the "same series" clause might be construed broadly, the House Report on the Act noted that the "revision" clause in Section 201(c) was not intended to permit the inclusion of previously published freelance contributions "in a new anthology or an entirely different magazine or other collective work," *i.e.*, in later collective works not in the same series. H.R. Rep. No. 94-1476, at 122-23 (1976), *reprinted in* 1976 U.S.C.A.A.N. 5659, 5738.

Moreover, Publishers' contention that the electronic databases are revised, digital copies of collective works cannot be squared with basic canons of statutory construction. First, if the contents of an electronic database are merely a "revision" of a particular "collective work," *e.g.*, the August 16, 1999 edition of *The New York Times*, then the third clause of Section 201(c)—permitting the reproduction and distribution of an individually copyrighted work as part of "a

later collective work in the same series"—would be superfluous. *See Regions Hosp. v. Shalala*, 522 U.S. 448, 118 S. Ct. 909, 920 (1998) (Scalia, J., dissenting) ("It is a cardinal rule of statutory construction that significance and effect shall, if possible, be accorded to every word. As early as in Bacon's Abridgment, sect. 2, it was said that 'a statute ought, upon the whole, to be so construed that, if it can be prevented, no clause, sentence, or word shall be superfluous, void, or insignificant.' ") (quoting *Washington Mkt. Co. v. Hoffman*, 101 U.S. 112, 115-16 (1879)). An electronic database can contain hundreds or thousands of editions of hundreds or thousands of periodicals, including newspapers, magazines, anthologies, and encyclopedias. To view the contents of databases as revisions would eliminate any need for a privilege for "a later collective work in the same series."

Second, the permitted uses set forth in Section 201(c) are an exception to the general rule that copyright vests initially in the author of the individual contribution. Reading "revision of that collective work" as broadly as appellees suggest would cause the exception to swallow the rule. *See Commissioner v. Clark*, 489 U.S. 726, 739 (1989) (when a statute sets forth exceptions to a general rule, we generally construe the exceptions "narrowly in order to preserve the primary operation of the [provision]"). Under Publishers' theory of Section 201(c), the question of whether an electronic database infringes upon an individual author's article would essentially turn upon whether the rest of the articles from the particular edition in which the individual article was published could also be retrieved individually. However, Section 201(c) would not permit a Publisher to sell a hard copy of an Author's article directly to the public even if the Publisher also offered for individual sale all of the other articles from the particular edition. We see nothing in the revision provi-

sion that would allow the Publishers to achieve the same goal indirectly through NEXIS.

Appellees' reading is also in considerable tension with the overall statutory framework. Section 201(c) was a key innovation of the Copyright Act of 1976. Because the Copyright Act of 1909 contemplated a single copyright, authors risked losing their rights by allowing an article to be used in a collective work. *See* 3 Melville Nimmer & David Nimmer, *Nimmer on Copyright* § 10.01[A] (1996 ed.) (discussing doctrine of indivisibility). To address this concern, the 1976 Act expressly permitted the transfer of less than the entire copyright, *see* 17 U.S.C. § 201(d), in effect replacing the notion of a single "copyright" with that of "exclusive rights" under a copyright. *Id.* §§ 106, 103(b). Section 201(d), which governs the transfer of copyright ownership, provides:

(1) The ownership of a copyright may be transferred in whole or in part

(2) Any of the exclusive rights comprised in a copyright, including any subdivision of any of the rights specified by section 106, may be transferred as provided by clause (1) and owned separately. The owner of any particular *exclusive right* is entitled, to the extent of that right, to all of the protection and remedies accorded to the copyright owner by this title.

Id. § 201(d) (emphasis added); *see also id.* § 204 (executions of transfers of copyright ownership). Similarly, Section 501, which sets forth the remedies for infringement of copyright, provides in pertinent part that "[a]nyone who violates any of the *exclusive rights* of the copyright owner . . . is an infringer." *Id.* § 501(a) (emphasis added).³ Were the per-

³ It is worth noting that Section 201(c) grants collective works authors "only" a "privilege," rather than a "right." Each of these terms connotes specialized legal meanings, and they were juxtaposed by Congress in the same sentence of Section 201(c).

missible uses under Section 201(c) as broad and as transferrable as appellees contend, it is not clear that the rights retained by the Authors could be considered "exclusive" in any meaningful sense.

In light of this discussion, there is no feature peculiar to the databases at issue in this appeal that would cause us to view them as "revisions." NEXIS is a database comprising thousands or millions of individually retrievable articles taken from hundreds or thousands of periodicals. It can hardly be deemed a "revision" of each edition of every periodical that it contains.

Moreover, NEXIS does almost nothing to preserve the copyrightable aspects of the Publishers' collective works, "as distinguished from the preexisting material employed in the work." 17 U.S.C. § 103(b). The aspects of a collective work that make it "an original work of authorship" are the selection, coordination, and arrangement of the preexisting materials. *Id.* § 101; see also *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 349 (1991) (discussing factual compilations).⁴ However, as described above, in placing an edi-

⁴ In arguing that NEXIS is a "revision," an analogy might perhaps be made to cases involving factual compilations and applying a "substantial similarity" test. *Tasini I*, 972 F. Supp. at 825 n.15 (analogizing to factual compilation cases). Although the "selection and arrangement" analysis of factual compilation cases is clearly relevant to this case, "substantial similarity" analysis is inapposite. In factual compilation cases, an infringement action is brought by one compilation author against another compilation author. Because neither author—indeed, no one—owns a copyright in the underlying factual material comprising each collective work, the inquiry in such cases is whether the latter compilation is "substantially similar" in selection or arrangement to the former; no claim exists as to unauthorized use of the facts. See *id.* at 821-22. Here, by contrast, the compilations are "collective works" that contain individually copyrighted material, and the infringement action is brought by the author of the individual work. Because Sections 103(b) and 201(c) make clear that the author of the individual contribution retains all rights in his or her piece, the author clearly may bring an infringement action for unauthorized republication of the

tion of a periodical such as the August 16, 1999 New York Times, in NEXIS, some of the paper's content, and perhaps most of its arrangement are lost. Even if a NEXIS user so desired, he or she would have a hard time recapturing much of "the material contributed by the author of such [collective] work." 17 U.S.C. § 103(b). In this context, it is significant that neither the Publishers nor NEXIS evince any intent to compel, or even to permit, an end user to retrieve an individual work only in connection with other works from the edition in which it ran. Quite the contrary, The New York Times actually *forbids* NEXIS from producing "facsimile reproductions" of particular editions. *See Tasini I*, 972 F. Supp. at 826 n.17. What the end user can easily access, of course, are the preexisting materials that belong to the individual author under Sections 201(c) and 103(b).

The UMI databases involved in this appeal present a slightly more difficult issue than does NEXIS. One, NYTO, is distinguishable from NEXIS in that it contains articles from only one publisher; the other, GPO, is distinguishable because it includes some image-based, rather than text-based, files. Nevertheless, we also conclude that the Publishers' licensing of Authors' works to UMI for inclusion in these databases is not within the Section 201(c) revision provision.

The NYTO database operates very much like NEXIS; it contains many articles that may be retrieved according to criteria unrelated to the particular edition in which the articles first appeared. Moreover, because the files it contains are provided by Mead pursuant to an agreement between UMI, Mead, and The New York Times, no more of the Times' original selection and arrangement is evident or retained in NYTO than is retained in NEXIS. In every respect save its

work. This is so, moreover, even if the author of the collective work in which the individual contribution was published might also have an infringement action against the person who republished the contribution.

being limited to The New York Times, then, NYTO is essentially the same as NEXIS. That limitation, however, is not material for present purposes. The relevant inquiry under Section 201(c), is, as discussed above, whether the republication or redistribution of the copyrighted piece is as part of a collective work that constitutes a "revision" of the previous collective work, or even a "later collective work in the same series." If the republication is a "new anthology" or a different collective work, it is not within Section 201(c). H.R. Rep. No. 94-1476, at 122-23 (1976), *reprinted in* 1976 U.S.C.A.A.N. 5659, 5738. Because NYTO is for present purposes at best a new anthology of innumerable editions of the Times, and at worst a new anthology of innumerable articles from these editions, it cannot be said to be a "revision" of any (or all) particular editions or to be a "later collective work in the same series."

For the same reason, GPO is not protected by Section 201(c). Although this database contains scanned photographs of editions of The New York Times Sunday book review and magazine, it also contains articles from numerous other periodicals. In this respect, then, it is also substantially similar to NEXIS, and it, too, is at best a new anthology.

We emphasize that the only issue we address is whether, in the absence of a transfer of copyright or any rights thereunder, collective-work authors may re-license individual works in which they own no rights. Because there has by definition been no express transfer of rights in such cases, our decision turns entirely on the default allocation and presumption of rights provided by the Act. Publishers and authors are free to contract around the statutory framework. Indeed, both the Publishers and Mead were aware of the fact that Section 201(c) might not protect their licensing agreements, and at least one of the Publishers has already instituted a policy of

expressly contracting for electronic re-licensing rights. See note 1, *supra*.

b) *Whitford*

As noted, Whitford entered into an express licensing agreement with Time. That agreement granted, in pertinent part, to Time:

(a) the exclusive right first to publish the Story in the Magazine:

(b) the non-exclusive right to license the republication of the Story . . . provided that the Magazine shall pay to [him] fifty percent [] of all net proceeds it receives for such republication: and

(c) the right to republish the Story or any portions thereof in or in connection with the Magazine or in other publications published by [Time], provided that [he] shall be paid the then prevailing rates of the publication in which the Story is republished.

Time subsequently licensed Whitford's article to Mead without notifying, obtaining authorization from, or compensating, him.

In response to Whitford's infringement action, Time contended that its "first publication" rights under clause (a) permitted it to license Whitford's article to Mead. The district court rejected this argument. See *Tasini I*, 972 F. Supp. at 811-12. Nevertheless, it granted summary judgment in favor of Time on this claim. Upon appellants' motion for reconsideration, the district court explained that because Whitford's contract appeared to grant republication rights broad enough to cover Time's agreement with Mead, his remedy under the circumstances was a breach of contract claim against Time. See *Tasini II*, 981 F. Supp. at 845. Such a

contract claim would be based on the fact that Time had licensed Whitford's piece to Mead without compensating Whitford pursuant to their agreement. Whitford's failure to raise such a claim, in the court's view, undermined his infringement claim. *See id.* The court also explained that the privilege afforded collective-works authors under Section 201(c) operates as a "'presumed' baseline." *See id.*, 981 F. Supp. at 846. Because Whitford's agreement failed to limit Time's rights to less than those otherwise afforded under Section 201(c), Time was presumed to have rights to Whitford's piece to the full extent of Section 201(c). *See id.* Having already determined that Section 201(c) protected the defendant newspapers' license agreements with Mead, the district court held that Time, too, was protected.

However, the fact that a party has licensed certain rights to its copyright to another party does not prohibit the licensor from bringing an infringement action where it believes the license is exceeded or the agreement breached. *See Schoenberg v. Shapolsky Publishers, Inc.*, 971 F.2d 926, 932 (2d Cir. 1992) ("If a breach of a condition is alleged, then the district court has subject matter jurisdiction."). Rather, where an author brings an infringement action against a purported licensee, the license may be raised as a defense. *See Bourne v. Walt Disney Co.*, 68 F.3d 621, 631 (2d Cir. 1995). Where the dispute turns on whether there is a license at all, the burden is on the alleged infringer to prove the existence of the license. *See id.* Where the dispute is only over the scope of the license, by contrast, "the copyright owner bears the burden of proving that the defendant's copying was unauthorized." *Id.* In either case, however, an infringement claim may be brought to remedy unauthorized uses of copyrighted material. *See id.* Whitford did not, there-

fore, have the burden of pleading a contract claim against Time.⁵

With respect to express transfers of rights under Section 201(c), that provision provides in pertinent part that “[i]n the absence of an express transfer of the copyright or of any rights under it, the owner of copyright in the collective work is presumed to have acquired only the privilege of reproducing and distributing the contribution [in limited circumstances].” 17 U.S.C. § 201(c). Whitford contends that this provision, by its plain terms, does not apply where there is “an express transfer of copyright or of any rights under it,” and that his license agreement with Time constitutes just such an express transfer. Therefore, he contends, the court erred in applying the privilege at all.

As noted, the district court rejected this argument, observing that “Section 201(c) does not provide that the specified privileges apply ‘only’ in the absence of an express transfer of rights,” but rather that “in the absence of an express transfer of rights, publishers are presumed to acquire ‘only’ the delineated privileges.” *Tasini II*, 981 F. Supp. at 845. The district court went on to hold that “the specified privileges represent a floor—*i.e.*, a minimum level of protection which, if unenhanced by express agreement, publishers are generally presumed to possess. In other words, . . . in the absence of an express transfer of ‘more,’ a publisher is presumed to acquire, at a minimum [], the delineated privileges.” *Id.* at 845-46.

⁵ Time did not raise paragraphs (b) or (c) of its license agreement with Whitford as a defense to his infringement claim. Instead, Time contended that the “first publication” rights it received in paragraph (a) covered its subsequent license to Mead and that it did not therefore have to further compensate Whitford for permitting Mead to place his piece in NEXIS. Time took this position, of course, because it did not compensate Whitford pursuant to the agreement and could not, therefore, convincingly invoke the conditional license granted in paragraphs (b) and (c) thereof.

Under the district court's reasoning, therefore, unless Time's agreement with Whitford explicitly narrowed its "privilege" under Section 201(c), the privilege accorded by that Section would continue to exist concurrently with any other rights obtained under the agreement. Given the district court's previously expressed broad view of the Section 201(c) privilege, Time prevailed, not because the agreement authorized the licensing of Whitford's article to Mead but because the agreement did not forbid it.

The district court is mistaken. As discussed above, Section 201(c) creates only a presumption by the parties as to what an author means to convey by giving consent to inclusion of an article in a collective work. Section 201(c) does not permit a collective-work author in Time's shoes to license to Mead an individually-copyrighted work such as Whitford's article. Time's rights to license the article to Mead must, therefore, be derived from its agreement with Whitford. However, we agree with the district court that paragraph (a) of that agreement does not authorize such a license, and the record is clear that Time cannot invoke the conditional license provided in paragraphs (b) and (c). *See* Note 4, *supra*. There being no other basis for Time to license Whitford's article to Mead, summary judgment should have been granted in favor of Whitford on his claim.

CONCLUSION

We therefore reverse and remand with instructions to enter judgment for appellants.

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SEC. 201(c)

CHAPTER 2—COPYRIGHT OWNERSHIP AND TRANSFER

Sec.

201. Ownership of copyright.
202. Ownership of copyright as distinct from ownership of material object.
203. Termination of transfers and licenses granted by the author.
204. Execution of transfers of copyright ownership.
205. Recordation of transfers and other documents.

CROSS REFERENCES

Semiconductor chip product protection provisions relationship to this chapter, see 17 USCA § 912.

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§ 201. Ownership of copyright

(a) **Initial Ownership.**—Copyright in a work protected under this title vests initially in the author or authors of the work. The authors of a joint work are coowners of copyright in the work.

(b) **Works Made for Hire.**—In the case of a work made for hire, the employer or other person for whom the work was prepared is considered the author for purposes of this title, and, unless the parties have expressly agreed otherwise in a written instrument signed by them, owns all of the rights comprised in the copyright.

(c) **Contributions to Collective Works.**—Copyright in each separate contribution to a collective work is distinct from copyright in the collective work as a whole, and vests initially in the author of the contribution. In the absence of an express transfer of the copyright or of any rights under it, the owner of copyright in the collective work is presumed to have acquired only the privilege of reproducing and distributing the contribution as part of that particular collective

work, any revision of that collective work, and any later collective work in the same series.

(d) Transfer of Ownership.—

(1) The ownership of a copyright may be transferred in whole or in part by any means of conveyance or by operation of law, and may be bequeathed by will or pass as personal property by the applicable laws of intestate succession.

(2) Any of the exclusive rights comprised in a copyright, including any subdivision of any of the rights specified by section 106, may be transferred as provided by clause (1) and owned separately. The owner of any particular exclusive right is entitled, to the extent of that right, to all of the protection and remedies accorded to the copyright owner by this title.

(e) Involuntary Transfer.—When an individual author's ownership of a copyright, or of any of the exclusive rights under a copyright, has not previously been transferred voluntarily by that individual author, no action by any governmental body or other official or organization purporting to seize, expropriate, transfer, or exercise rights of ownership with respect to the copyright, or any of the exclusive rights under a copyright, shall be given effect under this title, except as provided under title 11.

(Pub.L. 94-553, Title I, § 101, Oct. 19, 1976, 90 Stat. 2568; Pub.L. 95-598, Title III, § 313, Nov. 6, 1978, 92 Stat. 2676.)

HISTORICAL AND STATUTORY NOTES

**Revision Notes and Legislative Reports
1976 Acts.**

**Notes of Committee on the Judiciary,
House Report No. 94-1476**

Initial Ownership. Two basic and well-established principles of copyright law are restated in section 201(a) [subsec. (a) of this section]: that the source of copyright ownership is the author of the work, and that, in the case of a "joint work," the coauthors of the work are likewise coowners of the copyright. Under the definition of section 101 [section 101 of this title], a work is "joint" if the authors collaborated with each other, or if each of the authors prepared his or her contribution with the knowledge and intention that it would be merged with the contributions of other authors as "inseparable or interdependent parts of a unitary whole." The touchstone here is the intention, at the time the writing is done, that the parts be absorbed or combined into an integrated unit, although the parts

themselves may be either "inseparable" (as the case of a novel or painting) or "interdependent" (as in the case of a motion picture, opera, or the words and music of a song). The definition of "joint work" is to be contrasted with the definition of "collective work," also in section 101 [section 101 of this title], in which the elements of merger and unity are lacking; there the key elements are assemblage or gathering of "separate and independent works * * * into a collective whole."

The definition of "joint works" has prompted some concern lest it be construed as converting the authors of previously written works, such as plays, novels, and music, into coauthors of a motion picture in which their work is incorporated. It is true that a motion picture would normally be a joint rather than a collective work with respect to those authors who actually work on the film, although their usual status as employees for hire would keep the question of

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF FLORIDA

JERRY GREENBERG, individually,
and IDAZ GREENBERG, individually,

Plaintiffs,

CASE NO. 97-3924
CIV-LENARD
Magistrate Judge Turnoff

vs.

NATIONAL GEOGRAPHIC
SOCIETY, a District of Columbia
corporation, NATIONAL GEOGRAPHIC
ENTERPRISES, INC., a corporation,
and MINDSCAPE, INC., a
California corporation,

Defendants.

AFFIDAVIT OF JERRY GREENBERG

Jerry Greenberg appeared before the undersigned authority and stated as follows:

1. My name is Jerry Greenberg. The statements in this affidavit are based on my personal knowledge.
2. I have been a professional photographer for more than 40 years. During most of that time, with Idaz Greenberg, I also have engaged in a small publishing business, based in Miami, Florida, under the name Seahawk Press.
3. Starting in the early 1960s, I provided to the National Geographic Society ("the Society") over a period of time many hundreds of photographs, some of which were utilized in various articles appearing in issues of the monthly Society magazine.

4. I have been advised by various managers and employees of the Society that the Society continues to have possession or control over hundreds of photographs taken by me, or duplicates, or electronically scanned images of the photographs. I have copyright in some of those photographs, and the Society has proprietary rights to others.

5. In 1997, I purchased in Miami, Florida a product called The Complete National Geographic, consisting of approximately 30 CD-ROM discs on which are produced more than 1,200 issues of the Society's monthly magazine ("the Complete Geographic").

6. More than a dozen photographs on which I hold exclusive copyright interest are included in the Complete Geographic. I was never asked for my consent to include those photographs, and I never provided consent in any form.

7. On December 18, 1985, the Society assigned to me copyright interest in my photographs that had appeared in issues of the monthly magazine in 1962, 1968 and 1971. That assignment was recorded in the U. S. Copyright Office on September 16, 1988. Copies of the assignment and Certificate of Recordation are attached to this affidavit and incorporated as Attachment 1.

8. As expiration neared for the copyright in the 1962 photographs, I renewed the copyright in December 1989. A copy of the renewal form is attached to this affidavit and incorporated as Attachment 2.

9. As expiration neared for the copyright in the 1968 photographs, I renewed the copyright in March 1996. A copy of the renewal form is attached to this affidavit and incorporated as Attachment 3.

10. On June 14, 1989, I entered into an agreement with the Society to produce original photographs to be incorporated in a 1990 magazine article on the Pennekamp Reef Park. In paragraph 5, the agreement provided that copyright in the new photographs to be taken for the 1990 article would inure to the Society, but that after publication all photographs would be returned to me along with all rights to said photographs. In addition, I provided to the Society several stock photos from my personal archive for use in the article. A copy of the agreement is attached to this affidavit and incorporated as Attachment 4.

#

JG affidavit
Feb 11 1998
#7. assigned to JG


11. The photographs utilized in the article described in paragraph 10 above were returned to me by the Society in the spring of 1990. In July 1990, I registered my copyright with the U. S. Copyright Office. A copy of the registration form is attached to this affidavit and incorporated as Attachment 5.

12. Early in 1997 I became aware that the Society was intending to begin the distribution and sale of the Complete Geographic at some time in 1997. In 1997, through my legal counsel, I expressly informed the Society that I would not agree to the inclusion in that product of my copyrighted photographs, and I warned against their inclusion. The Society never responded on the matter.

13. I have read the Declaration of Thomas Stanton, an exhibit to the Memorandum of Law in Support of Defendants' Motion to Dismiss Count II and to Dismiss or for Summary Judgment on Counts III-IV of Plaintiffs' Amended Complaint. Mr. Stanton states, in paragraph 9, that he wrote a letter, dated May 11, 1997, notifying all contributors to the magazine of the pending release of the Complete Geographic. I never received that letter, or any communication from the Society, with reference to the Complete Geographic product.

14. In July 1997, I ordered from Mindscape Direct a CD-ROM excerpt from the Complete Geographic product that covered only the decade of the 1990s. The CD-ROM for that decade was delivered to me some weeks later. The invoice from Mindscape Direct covering the transaction is attached to and incorporated in this affidavit as Attachment 6.

AFFIANT SAID NOTHING FURTHER.


Jerry Greenberg

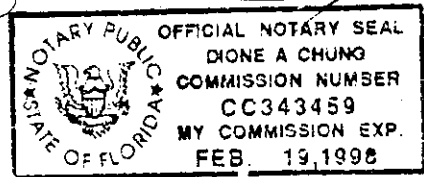
STATE OF FLORIDA)
) ss
COUNTY OF DADE)

The foregoing instrument was acknowledged before me this 11th day of February, 1998, by Jerry Greenberg, who was sworn and who said that the information set forth above is true and correct to the best of his knowledge and belief. Mr. Greenberg is personally known to me, or produced known as personal identification.



Notary Public

My Commission Expires:



National Geographic Society

WASHINGTON, D. C. 20036

SUZANNE DUPRE
CORPORATE COUNSEL

December 18, 1985

Mr. Jerry Greenberg
SEAHAWK PRESS
6840 SW 92nd Street
Miami, Florida 33156

Dear Mr. Greenberg:

In reply to your letter of November 15th to Mr. Garrett, the National Geographic Society hereby assigns to you all right, title and interest, including copyright, in your photographs appearing in National Geographic Magazine, as follows:

-- January, 1962
Vol. 121, No. 1

Photos on cover and
pages 58 through 89

Registration No. B-960824
Date: March 22, 1962

-- February, 1968
Vol. 133, No. 2

Photos on cover and pages 222-223, 225,
226-227, 238, 240-241 and 251

Registration No. B-402772
Date: January 31, 1968

-- May, 1971
Vol. 139, No. 5

Photos on pages 674 through 683

Registration No. B-701984
Date: July 15, 1971

District of Columbia

ss:

Subscribed and sworn to before

me this 18TH day of

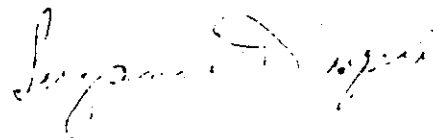
DECEMBER 1985

Jessie R. Bennett

Notary Public

WASHINGTON, D. C.

Sincerely yours,



Notary Public, expires January 31, 1986

cc: W. E. Garrett, Editor

Copyright
Office
of the
United
States

THE
LIBRARY
OF
CONGRESS

Certificate of Recordation

THIS IS TO CERTIFY THAT THE ATTACHED DOCUMENT WAS RECORDED IN THE COPYRIGHT OFFICE ON THE DATE AND IN THE PLACE SHOWN BELOW.

THIS CERTIFICATE IS ISSUED UNDER THE SEAL OF THE COPYRIGHT OFFICE.

DATE OF RECORDATION

16Sep88

VOLUME

PAGE

2391

422

VOLUME

PAGE



OFFICIAL SEAL

Register of
Copyrights and
Assistant
Librarian for
Copyright
Services

National Geographic Magazine

WASHINGTON, D. C. 20036

KENT J. KOBERSTEEN
ASSISTANT DIRECTOR OF PHOTOGRAPHY

June 14, 1989

Mr. Jerry Greenberg
6840 S.W. 92nd Street
Miami, FL 33156

Dear Jerry:

This letter, when signed by both parties, will constitute your agreement as a freelance photographer with the National Geographic Society ("NGS") to photograph Pennekamp Reef Park (#05738) for National Geographic Magazine.

1) This assignment will extend for 20 days. Your compensation will be at the rate of:

(a) \$350 per day for days spent shooting or in field research (i.e., research directly germane to producing the coverage); and

(b) one half of the above rate per day for days spent in travel (including arranging or waiting for travel); on standby, in the field or elsewhere; or in consulting with NGS editors ("editorial days").

2) Your compensation is subject to the following provisions:

(a) Work beyond the anticipated assignment days mentioned above will be compensated at the same daily rates as above. Should it become necessary to extend this assignment for additional days, you must get authorization to do so from the Director of Photography, the Assistant Director of Photography or the Illustrations Editor assigned to the project.

(b) The total compensation paid to you for this assignment will be applied against the page rate of \$300 a page for the National Geographic Magazine, or a minimum of \$100 a transparency, whichever is greater.

3) When working for NGS, you will carefully avoid doing similar work for publications which NGS would consider to be editorially competitive with it. You will advise NGS promptly of any possible conflict of interest that may develop. You also will take care not to grant any prepublication interviews or assist in any way in the preparation of any prepublication articles or other press coverage in any medium which would reveal the subject matter, editorial content or the scheduling of an assignment, article or story for the National Geographic Society.

4) By this Agreement you warrant to NGS that publication of any photographs taken by you on this assignment will not infringe upon any right of privacy, copyright or any other proprietary right of a third party.

5) All photographs taken by you under this Agreement will be considered as specially commissioned for use by NGS and upon creation all rights, including the copyright and world publication rights, to these photographs will automatically, by virtue of this Agreement, be deemed transferred exclusively and indefinitely to NGS, subject to the following provisions:

(a) all photographs will be returned to you along with all rights to said photographs under the following conditions: (i) none may be made available to anyone for publication until sixty days after NGS has published its selections; (ii) it is understood that any necessary rights clearance or release for non-NGS publication is your independent responsibility; and (iii) NGS may make and retain copies of some of the photographs ("reference selects") for reference purposes only in its Illustrations Library;

(b) you grant to NGS without additional charge the right to use your name, likeness and biographical material in connection with the publication of any photographs retained by NGS under this Agreement;

(c) NGS may crop your photographs.

6) You undertake all work under this Agreement as an independent contractor. NGS assumes no responsibility for your health, safety or property or that of any person accompanying or assisting you. While on assignment in the field you will be covered by NGS's accident insurance policy, which provides a payment of \$200,000 to you in the event of total disability or to your beneficiary, specified below, in the event of death, and lesser coverage for other injuries. The policy also provides up to \$10,000 for excess medical coverage, i.e. for costs beyond those covered by your own personal accident and health coverages. The above coverage is restricted to you alone.

7) While you are on NGS assignment, NGS will pay or reimburse you for all reasonable expenses and will supply you with film and processing. At the close of this assignment you will provide NGS with a diary of your activities while on assignment, including an accurate and complete record of the people and places represented in your photographs. A final accounting of expenses, supplies, etc. for an assignment will be due to NGS no later than two weeks after the work on that assignment is finished. Failure to reconcile expense/supply accounts with NGS in a timely manner may impede payment of fees.

8) Your work on this assignment will not be considered complete until so indicated by the Illustrations Editor. At the end of the assignment you will deliver to NGS all photographs you have taken on this assignment as well as complete captions for your photographs. You will be available for a projection session with the editor to explain your work. If you are

Mr. Jerry Greenberg
(Pennekamp Reef Park/#05738)

June 14, 1989

called back for editorial consultation, you will be paid a fee of \$175 per day plus expenses.

9) This agreement cannot be modified except by written instrument signed by both of us.

If the foregoing is acceptable, please sign and return the enclosed copy of the Agreement to me.

Sincerely yours,
NATIONAL GEOGRAPHIC SOCIETY

By Kent J. Kobersteen
Kent J. Kobersteen

Agreed to and Accepted:
Jerry Greenberg
Name
JUNE 14, 1989
Date
431-523-822
Social Security/
Federal ID#
JERRY GREENBERG

IDAZ GREENBERG
Insurance Beneficiary
WIFE
Relationship to you
6840 SW 92ND ST
MIAMI, FL. 33156
Address

Check to be Written
to the Order of

© JERRY GREENBERG
Credit Line to read
ALL RIGHTS RESERVED

(For NGS records):
Executed copy received:

Date

KJK/mac

68-ATTACH.

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF FLORIDA
Miami Division
CASE NO. 97-3924-CIV-LENARD-TURNOFF

JERRY GREENBERG, individually,
and IDAZ GREENBERG, individually,

Plaintiffs,

vs.

NATIONAL GEOGRAPHIC
SOCIETY, a District of Columbia
corporation, NATIONAL GEOGRAPHIC
ENTERPRISES, INC., a corporation,
and MINDSCAPE, INC., a
California corporation,

Defendants.

FILED BY _____
99 NOV 23 PM 2:28
CARLOS JUENKE
CLERK U.S. DISTRICT CT.
S.D. OF FLA. - MIAMI

**SUPPLEMENTAL MEMORANDUM IN SUPPORT OF
PLAINTIFFS' MOTION TO VACATE ORDER GRANTING
IN PART DEFENDANTS' MOTION FOR PARTIAL
SUMMARY JUDGMENT, AND FOR OTHER RELIEF**

Plaintiffs, JERRY GREENBERG and IDAZ GREENBERG ("the Greenbergs"), submit this supplemental memorandum, based on newly-discovered evidence, in support of plaintiffs' Motion to Vacate Order Granting in Part Defendants' Motion for Partial Summary Judgment, and for Other Relief.

Introduction

The cited motion seeks vacation and modification of the aforesaid order because the law on which the Court principally relied for its order has been reversed. The motion asks, inter alia, that the Court (1) deny the defendants' motion for summary judgment as to Counts III, IV and V,

11/23/99

(2) grant the plaintiffs' cross-motion for summary judgment as to Count III, and (3) reinstate Count V and provide the plaintiffs with adequate time for discovery.

This supplemental memorandum presents newly-discovered evidence that pertains directly to the issues in Counts III and V.

The Newly-Discovered Evidence

The defendants' motion for summary judgment as to Counts III, IV and V of the Amended Complaint was fully briefed with the service on February 23, 1998 of a reply memorandum prepared by the defendants in support of the motion.

On July 14, 1998,¹ Defendant National Geographic Society filed a Form VA with the U. S. Copyright Office to register a new derivative work² that is directly relevant to Counts III and V of the Amended Complaint. The registration was discovered by the plaintiffs within the last two weeks. A copy of the registration form is attached hereto.

The plaintiffs request that the Court take judicial notice of the facts in the document pursuant to Rule 201 (b), Federal Rules of Evidence, in that the facts are capable of accurate and ready determination by resort to sources whose accuracy cannot reasonably be questioned, and because a jury will not be making factual determinations. The Copyright Act provides that such forms are reliable: "In any judicial proceedings the certificate of a registration made before or within five years after first publication of the work shall constitute prima facie evidence . . . of

¹ This date is after entry on May 14, 1998 of the Court's Order Granting in Part and Denying in Part Defendants' Motion for Partial Summary Judgment.

² See attached Form VA, page 2, items 5 and 6.

the facts stated in the certificate.” 17 U.S.C. § 410 (c). The Form VA was executed by Angelo M. Grima on behalf of the National Geographic Society.³ As a public record, the form is not excludable as hearsay pursuant to Rule 803 (8), Federal Rules of Evidence. Additionally, the Court is the only factfinder in this action.

**Count V -- The Infringing Use
Was In a New Derivative Work**

In its order of May 14, 1998, in granting summary judgment to the defendants on Count V, the Court gave scant attention, and minimal analysis, to the issues argued by the parties with respect to Count V. The Greenbergs alleged that inclusion of a Jerry Greenberg photograph in what the plaintiffs referred to in the Amended Complaint as the Moving Cover Sequence⁴ amounts to an infringement of Greenberg’s copyright in the photograph. The Moving Cover Sequence appears on each CD-ROM disc comprising The Complete Geographic product. The Court, however, adopted the Society’s assertion that the cover photograph in dispute was merely included in each CD-ROM disc in “a short display of images” from ten different magazine covers. May 14, 1998 Order at 8.

As the attached Form VA shows, the Society registered the cover-photograph sequence (after the summary judgment arguments were completed) as a new derivative work deserving of copyright protection. The Copyright Act defines a derivative work as a work based upon one or

³ See, e.g., Massachusetts v. Westcott, 431 U. S. 322, 323 n. 2, 97 S. Ct. 1755, 1756 (1977) (records of Merchant Vessel Document Division may be judicially noticed); Southmark Prime Plus v. Falzone, 776 F. Supp. 888 (D. Del. 1991) (taking judicial notice of SEC filings);

⁴ In the attached Form VA, the newly-registered work is described as an “introductory audiovisual montage.” Attachment, page 1, part 2 a.

more pre-existing works in which the works are recast, transformed, or adapted. "A work consisting of editorial revisions . . . or other modifications which, as a whole, represent an original work of authorship is a 'derivative work.'" 17 U.S.C. 101. One need only view the Moving Cover Sequence to see that it qualifies as a derivative work as defined in the Act.

The unauthorized incorporation in a derivative work of a copyrighted work (the Greenberg cover photograph) constitutes an act of copyright infringement.⁵ See Cortner v. Israel, 732 F.2d 267 (2d Cir. 1984); see generally 1 NIMMER ON COPYRIGHT § 3.06, 1999 ed. at page 3-34.23.

Thus, in considering the issues raised in the Greenbergs' motion to vacate the summary judgment order as to Count V, the Court should look upon the Moving Cover Sequence (the "introductory audiovisual montage"), not as mere filler or decoration, but as a new work that the Society deemed unique and valuable enough to register with the U. S. Copyright Office. The plaintiffs otherwise rely on their argument in the pending motion to vacate.

**The Inclusion of a New Derivative Work
Supports the Plaintiffs' Contentions
in Count III of the Amended Complaint**

The newly-discovered Form VA also has direct relevance to issues raised by the Greenbergs with respect to their allegations in Count III of the Amended Complaint. More specifically, the registration by the Society of the Moving Cover Sequence as a derivative work

⁵ In neither their initial memorandum, nor their reply memorandum, in support of their motion for summary judgment as to Count V do the Society and the other defendants argue that an infringement did not occur in the preparation and use of the Moving Cover Sequence. Instead, they devote extraordinary space to the defense of fair use -- a defense on which the Greenbergs contend they have had no opportunity to seek discovery.

CASE NO. 97-3924-CIV-LENARD-TURNOFF

undermines the defendants' argument for summary judgment as to Count III, and supports the Greenbergs' cross-motion for summary judgment.⁶ The parties' relative positions, set forth in detail in their summary judgment memoranda, will not be repeated here.

The Court should note, however, the particular relevance of the attached Form VA. The Copyright Act defines a "collective work" as "a work . . . in which a number of contributions, constituting separate and independent works in themselves, are assembled into a collective whole." 17 U.S.C. § 101. In The Complete Geographic product at issue in Count III, each monthly magazine included is a separate and independent work. We now have evidence that the Society also considers the Moving Covers Sequence, which appears on every CD-ROM disc, to be a separate and independent work, i.e., a new derivative work that has an independently protectible copyright. The Society's position throughout has been that The Complete Geographic product is not a new collective work but instead is merely a box filled with reprints of monthly magazines. That product, as set forth in detail in the Greenberg memorandum, incorporates enough new elements (along with selection, arrangement, and other legally relevant criteria) to constitute a new collective work in itself. That argument is bolstered substantially by the acknowledgment that the Moving Covers Sequence has now been defined by the Society (subsequent to the filing of this action) as a separate collective work. The Complete Geographic Product, even more clearly, is much more than a box filled with reprints of magazines.


⁶ These arguments are set forth in detail in Plaintiffs' Memorandum in Response to Defendants' Motion to Dismiss Count II and to Dismiss or for Summary Judgment on Counts III-V of Plaintiffs' Amended Complaint. The pertinent argument starts at page 6 of that memorandum.

Conclusion

The plaintiffs urge the Court to consider the express meaning of the attached Form VA as it evaluates the Greenbergs' pending Motion to Vacate Order Granting in Part Defendants' Motion for Partial Summary Judgment, and for Other Relief.

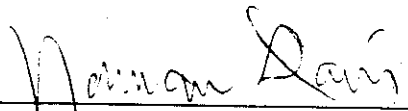
Respectfully submitted,

STEEL HECTOR & DAVIS LLP
Attorneys for Plaintiffs

By 
Norman Davis
Fla. Bar No. 475335
Suite 4000
First Union Financial Center
200 S. Biscayne Boulevard
Miami, FL 33131-2398
(305) 577-2988
(305) 577-7001 (fax)

Certificate of Service

I hereby certify that a copy of the foregoing memorandum was served by mail on Edward Soto, Esq., Weil, Gotshal & Manges LLP, 701 Brickell Avenue, Suite 2100, Miami, FL 33131 and by facsimile and mail on Robert G. Sugarman, Esq., Weil, Gotshal & Manges LLP, 767 Fifth Avenue, New York NY 10153 this 23rd day of November, 1999.



Norman Davis

MIA_1998/543978-1

FORM VA

Work of the Visual Arts
UNITED STATES COPYRIGHT OFFICE

RE

VA 931-760



EFFECTIVE DATE OF REGISTRATION

JUL 14 1998

Month Day Year

DO NOT WRITE ABOVE THIS LINE. IF YOU NEED MORE SPACE, USE A SEPARATE CONTINUATION SHEET.

TITLE OF THIS WORK

NATURE OF THIS WORK See instructions

108 YEARS OF NATIONAL GEOGRAPHIC MAGAZINE ON CD-ROM

CD-ROM

PREVIOUS OR ALTERNATIVE TITLES

PUBLICATION AS A CONTRIBUTION If this work was published as a contribution to a periodical, serial, or collection, give information about the collective work in which the contribution appeared. Title of Collective Work

if published in a periodical or serial give: Volume Number Issue Date On Pages

2 a NAME OF AUTHOR

DATES OF BIRTH AND DEATH

Year Born Year Died

NATIONAL GEOGRAPHIC SOCIETY

Was this contribution to the work a "work made for hire?"

Yes No

AUTHOR'S NATIONALITY OR DOMICILE Name of Country

OR Citizen of Domiciled in USA

WAS THIS AUTHOR'S CONTRIBUTION TO THE WORK

Anonymous? Pseudonymous? Yes No Yes No

If the answer to either of these questions is "Yes," see detailed instructions.

NOTE

Under the law, the "author" of a work made for hire is generally the employer, not the employee (see instructions). For any part of this work that was "made for hire" check "Yes" in the space provided, give the employer (or other person for whom the work was prepared) as "Author" of that part, and leave the space for date of birth and death blank.

NATURE OF AUTHORSHIP Check appropriate box(es). See instructions.

- 3-Dimensional sculpture, 2-Dimensional artwork, Reproduction of work of art, Design on sheetlike material, Map, Photograph, Jewelry design, Technical Drawing, Text, Architectural work

* introductory audiovisual montage

b NAME OF AUTHOR

DATES OF BIRTH AND DEATH

Year Born Year Died

Was this contribution to the work a "work made for hire?"

Yes No

AUTHOR'S NATIONALITY OR DOMICILE Name of Country

OR Citizen of Domiciled in

WAS THIS AUTHOR'S CONTRIBUTION TO THE WORK

Anonymous? Pseudonymous? Yes No Yes No

If the answer to either of these questions is "Yes," see detailed instructions.

NATURE OF AUTHORSHIP Check appropriate box(es). See instructions.

- 3-Dimensional sculpture, 2-Dimensional artwork, Reproduction of work of art, Design on sheetlike material, Map, Photograph, Jewelry design, Technical Drawing, Text, Architectural work

3 a YEAR IN WHICH CREATION OF THIS WORK WAS COMPLETED

DATE AND NATION OF FIRST PUBLICATION OF THIS PARTICULAR WORK

1997 Year

This information must be given in all cases.

Complete this information ONLY if this work has been published.

Month JANUARY Day 1 Year 1997

USA

Nation

4 COPYRIGHT CLAIMANT(S) Name and address must be given even if the claimant is the same as author given in space 2

NATIONAL GEOGRAPHIC SOCIETY WASHINGTON, DC 20038

APPLICATION RECEIVED

JUL 14 1998

ONE DEPOSIT RECEIVED

JUL 14 1998

TWO DEPOSITS RECEIVED

REMITTANCE NUMBER AND DATE

MORE ON BACK

Complete all applicable spaces (numbers 1-9) on reverse of this page.

See detailed instructions.

Sign the form at line 8.

DO NOT WRITE HERE

Page 1 of 2 pages

* Amended by CO per telephone conversation with Paul Kilmer, Esq., authorized agent of National Geographic Society, on February 1, 1999.

EXAMINED BY JH FORM VA
CHECKED BY _____

CORRESPONDENCE
 Yes

FOR
COPYRIGHT
OFFICE
USE
ONLY

DO NOT WRITE ABOVE THIS LINE. IF YOU NEED MORE SPACE, USE A SEPARATE CONTINUATION SHEET.

PREVIOUS REGISTRATION Has registration for this work, or for an earlier version of this work, already been made in the Copyright Office?

- Yes No If your answer is "Yes," why is another registration being sought? (Check appropriate box)
 - a. This is the first published edition of a work previously registered in unpublished form.
 - b. This is the first application submitted by this author as copyright claimant.
 - c. This is a changed version of the work, as shown by space 6 on this application.

If your answer is "Yes," give: Previous Registration Number _____ Year of Registration _____

5

DERIVATIVE WORK OR COMPILATION Complete both space 6a and 6b for a derivative work; complete only 6b for a compilation.

a. Preexisting Material Identify any preexisting work or works that this work is based on or incorporates.

6

COMPILATION OF PRE-EXISTING MATERIAL PRIMARILY PICTORIAL.

See instructions
before completing
this space.

b. Material Added to This Work Give a brief, general statement of the material that has been added to this work and in which copyright is claimed.

* audiovisual montage

BRIEF INTRODUCTORY GRAPHIC MATERIAL

DEPOSIT ACCOUNT If the registration fee is to be charged to a Deposit Account established in the Copyright Office, give name and number of account.

Account Number _____

NATIONAL GEOGRAPHIC SOCIETY

DA 044229

7

CORRESPONDENCE Give name and address to which correspondence about this application should be sent. Name/Address/Apt/City/State/Zip

SEE SPACE 9

Area Code & Telephone Number (202) 857-7490

Be sure to
give your
daytime phone
number

CERTIFICATION I, the undersigned, hereby certify that I am the

Check only one

- author
- other copyright claimant
- owner of exclusive right(s)
- authorized agent of NATIONAL GEOGRAPHIC SOCIETY

Name of author or other copyright claimant, or owner of exclusive right(s)

of the work identified in this application and that the statements made by me in this application are correct to the best of my knowledge.

Typed or printed name and date. If this application gives date of publication in space 3, do not sign and submit it before that date.

ANGELO M. GRIMA

Angelo M. Grima

date 7-10-98

Handwritten signature (X)

8

MAIL CERTIFICATE TO

Name SHEILA HOCKER

Number/Street/Apartment Number NATIONAL GEOGRAPHIC SOCIETY
1145 17TH STREET, NW - RM. 590

City/State/ZIP WASHINGTON, DC 20036

Certificate will be mailed in window envelope

IMPORTANT
* Complete all necessary spaces
* Sign your application in space 8

1. Application form
2. Nonrefundable \$20 filing fee in check or money order payable to Register of Copyrights
3. Deposit material

REGISTER
Register of Copyrights
Library of Congress
Washington, D.C. 20559

The Copyright Office has the authority to adjust fees of 5-year intervals, based on changes in the Consumer Price Index. The next adjustment is due in 1998. Please contact the Copyright Office when July 1998 to determine the actual fee schedule.

9