UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF FLORIDA

Miami Division
CASE NO. 97-3924-CIV-LENARD
Magistrate Judge 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.
_____/

PLAINTIFFS' REPLY MEMORANDUM IN SUPPORT OF MOTION TO STRIKE ANSWERS OR DEFENSES, AND IN OPPOSITION TO CROSS-MOTION FOR ENLARGEMENT

Plaintiffs, JERRY GREENBERG and IDAZ GREENBERG ("the Greenbergs"), pursuant to Local Rule 7 C., serve this reply memorandum in support of Plaintiffs' Motion to Strike Defendants' Answers to Counts III and V of the Amended Complaint; Alternatively, to Strike all Affirmative Defenses in Answers. This memorandum also opposes the Defendants' cross-motion for an enlargement of time in which to serve answers.[1]

[1] The defendants served two memoranda that overlap significantly in the issues covered. Accordingly, the Court should consider jointly the two responding memoranda prepared by the Greenbergs, including Plaintiffs' Memorandum in Opposition to Defendants' Motion for Additional Order of Reference, which is being filed simultaneously herewith.

The Answers Should be Stricken

A. No Liability Issues Exist

As set forth in the Greenbergs' initial memorandum, the Eleventh Circuit's opinion, and the resulting mandate, make it clear that no liability issues exist. The defendants did not bother to address the opinion, or the mandate, or the mandate rule that governs. The answers, therefore, are moot. The only mission for the Court now, as instructed by the Eleventh Circuit, is to deal with issues of damages, attorneys' fees and injunctive relief.

B. The Answers Were Not Timely

The defendants' memorandum in opposition simply declares that their answers were timely. It states that the Greenbergs cited to no authority for their proposition that the answers were late. To the contrary, the Greenbergs' argument references Rule 12 and Rule 6, Federal Rules of Civil Procedure, which are controlling. The defendants have pointed to no error in the Greenbergs' calculations under those rules. We are not addressing a "technicality" here. This action is almost four years old, and the defendants have had ample resources and have had adequate time to understand and comply with the rules.

The defendants contend that Rule 12 is not applicable here. Rule 12, they say, triggers a 10-day response period (as the Greenbergs contend) instead of a 20-day period only when a Rule 12 motion is *denied*. In contrast, goes the argument, the summary judgment motion was granted. But the *reversal* by the Eleventh Circuit of this Court's grant of summary judgment under

Rule 56[2] is equivalent to a denial under Rule 12. Reversal by an appellate court renders a grant of summary judgment by a district court void. See Atlantic Coast Line R.R. Co. v. St. Joe Paper Co., 216 F.2d 832, 833 (5th Cir. 1954). Thus the motion filed by the defendants in early 1998 has effectively been *denied* (there was no valid grant of anything with respect to the motion).

C. No Basis for an Enlargement of Time

The defendants suggest that they will be prejudiced, absent an enlargement of time for answers, because certain liability issues remain. No such issues exist. This contention by the defendants is treated in detail in a separate memorandum being served and filed simultaneously by the Greenbergs in opposition to Defendants' Motion for an Additional Order of Reference.

Moreover, the Court can note that the defendants' answers were served outside the time provided by the rules, and their pending motion for enlargement was itself not timely served. Rule 6(b), Fed. R. Civ. P. The defendants' plea that any untimely filing was "excusable neglect" should have no audience here. The size and sophistication of the three defendants, and the four-year lifespan of this action to date, should undermine any request for an elastic application of the rules.

Alternatively, the Affirmative Defenses Should be Stricken

A. No Liability Issues Exist

As set forth above, no liability issues exist to which any affirmative defenses might be asserted. The affirmative defenses alleged involve no fact questions, and can be resolved by the Court purely as a matter of law.

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[2] The defendants' motion was stated as a Rule 12 motion to dismiss and alternatively a motion for summary judgment under Rule 56.

B. Failure to State a Claim

The defendants assert that Greenberg stated no claim because, they say, the decisions of this Court and the Eleventh Circuit did not address applicability of the 1909 Copyright Act, or Mr. Greenberg's contracts, or the import of a new Supreme Court decision. None of those issues has anything to do with stating a claim.[3]

The test on stating a claim is whether it appears beyond doubt that the Greenbergs could prove no set of facts in support of a claim which would entitle them to relief. See, e.g., Brown v. Crawford County, Ga., 960 F.2d 1002 (11th Cir. 1992). The allegations in the Greenbergs' Amended Complaint on their face amply state a legal claim because they allege a prima facie case of copyright infringement. The Eleventh Circuit expressly held that his copyrights were infringed as alleged. The evidence could not be more vivid as to the pleading of a valid claim.

C. Republication Pursuant to Contract

The defendants now contend that, in one or more of Greenberg's contracts with the National Geographic Society, Greenberg granted a license to the Society to republish his photographs. The defense fails as a matter of law, as set forth in the Greenbergs' initial memorandum. As explained there, in 1985 the Society transfered to Greenberg "all right, title and interest, including copyright . . . ." (emphasis added) to numerous Greenberg photographs that appeared in three earlier magazine articles. Any "license" that may have existed by contract prior to 1985 thus was abandoned by that absolute transfer in 1985 of all rights to Mr. Greenberg. See Greenberg v. National Geographic Society, et al., 244 F.3d 1267, 1269 (11th Cir. 2001).

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[3] Indeed, only the contract issue has been asserted as a defense. The other two issues, although waived because they were not alleged as defenses, are treated in this and the Greenbergs' accompanying memorandum as a precaution.

The only other contract that has any relevance to the Greenberg claims was executed on June 14, 1989. A copy of that agreement is attached to the Greenbergs' first memorandum as Exhibit B. That contract, by its terms, returned "all rights" to the photographs to Mr. Greenberg.

The Eleventh Circuit found that the 1985 transfer and the 1989 contract were valid conveyances. Id. at 1269. That is the law of the case. Therefore, nothing remains to be determined about rights to republish the photographs. The defense is without legal basis and should be stricken.

D. Laches and Estoppel

In an amazing declaration, the defendants state that the Greenbergs' theory of the case is that the Greenberg photographs may be republished only in a print version of the monthly magazine. They then proceed to an argument that the Greenbergs sat on their rights by not complaining through the years of republication, in microfilm or microfiche format, of the monthly magazines containing the Greenberg photographs.

The premise is patently false. The Greenbergs' actual theory from the outset -- see Count III of the Amended Complaint -- has been that the photographs may not be reproduced in a new collective work,[4] whatever the medium. The Greenbergs made that argument to the Eleventh Circuit, and that Court agreed. See Greenberg, supra. The fact that the Eleventh Circuit affirmed the theory alleged by Greenberg, and found copyright infringment under Counts III and V, should foreclose the asserted defenses of laches and estoppel. They should be stricken.

[4] In their brief to the Supreme Court, opposing a petition for a writ of certiorari, the Greenbergs distinguished traditional microfilm and microfiche copying because it does not constitute a new collective work pursuant to the Copyright Act.

Conclusion

The defendants have waived any defense not set forth in their answers. The four affirmative defenses stated there are legally insufficient, and should be stricken.

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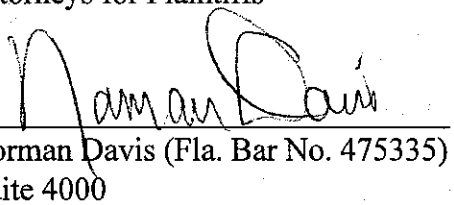
Attorneys for Plaintiffs



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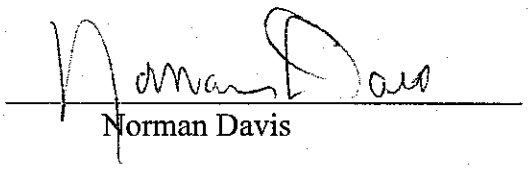
CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing plaintiffs' memorandum was served by mail on Edward Soto, Weil, Gotshal & Manges, LLP, 701 Brickell Avenue Boulevard, Suite 2100, Miami, Florida 33131; and via Federal Express on Robert G. Sugarman, Weil, Gotshal & Manges, LLP, 767 Fifth Avenue, New York, New York 10153, this 7th day of December, 2001.



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