

UNITED STATES DISTRICT COURT  
SOUTHERN DISTRICT OF FLORIDA

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

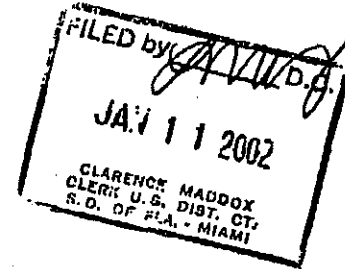
JERRY GREENBERG, IDAZ  
GREENBERG,

Plaintiffs,

vs.

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

Defendants.



**ORDER GRANTING, IN PART, DEFENDANTS' MOTION FOR  
ADDITIONAL ORDER OF REFERENCE; DENYING DEFENDANTS'  
CROSS-MOTION FOR ENLARGEMENT OF TIME; AND GRANTING  
PLAINTIFFS' MOTION TO STRIKE DEFENDANTS' ANSWERS**

THIS CAUSE is before the Court on the Motion for an Additional Order of Reference (D.E. 83) and Cross-Motion to Extend Time to File a Response to Amended Complaint (D.E. 82), filed December 4, 2001, by Defendants National Geographic Society, National Geographic Enterprises, Inc. and Mindscape, Inc., and the Motion to Strike Defendants' Answers to Counts III and V of the Amended Complaint (D.E. 78), filed November 13, 2001, by Plaintiffs Jerry and Idaz Greenberg. Plaintiffs filed a Memorandum in Opposition to Defendants' Motion for an Additional Order of Reference (D.E. 86) on December 7, 2001, and Defendants filed a Reply (D.E. 89) in support thereof on December

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20, 2001. Defendants filed a Memorandum in Opposition to the Motion to Strike (D.E. 85) on December 4, 2001, and Plaintiffs filed a Reply (D.E. 87) in support thereof on December 7, 2001. Having reviewed the motions, the memoranda, the replies and the record, the Court finds as follows.

### **I. Procedural History**

On May 14, 1998, the Court granted Defendants' Motion for Summary Judgment on Counts III-V of the Amended Complaint, holding that Defendants were not liable under Section 206(c) the Copyright Act. (D.E. 37.) On December 28, 1999, the parties stipulated to dismissal of Counts I and II, and the case was closed. (D.E. 71.) Plaintiffs filed a Notice of Appeal. (D.E. 72.) On March 22, 2001, the Eleventh Circuit Court of Appeals issued an opinion reversing on the issue of liability. In a mandate issued on October 25, 2001, the Eleventh Circuit remanded the case back to this Court for a determination of the amount of damages and attorney fees, and the possibility of injunctive relief. (D.E. 75.) On November 13, 2001, the Court referred the matter of damages, attorney's fees and possible injunctive relief to U.S. Magistrate Judge William C. Turnoff. (D.E. 80.) On November 28, 2001, the Court administratively reopened the case in order to address the mandated issues.

After the mandate issued, Defendants filed Answers to the Complaint. (D.E. 76, 77.) Plaintiffs filed a Motion to Strike Defendants' Answers to Counts III and V of the Amended Complaint, or Alternatively, to Strike all Affirmative Answers in Answers. (D.E. 78.) The

Court referred Plaintiffs' Motion to Strike to Judge Turnoff. (D.E. 81.) The Court vacated the Order of Reference on January 9, 2002.

In the instant Motion for Additional Order of Reference, Defendants are asking the Court to refer "all matters in this case" to Judge Turnoff. (Defs.' Mot. at 1.) In particular, Defendants seek referral of the following issues:

1. Whether the Eleventh Circuit's opinion in Greenberg remains viable in light of the United States Supreme Court's subsequent opinion in New York Times v. Tasini, 121 S. Ct. 2381 (June 25, 2001).
2. Whether Plaintiff is entitled to recover with respect to images governed by the Copyright Act of 1909.
3. Whether Plaintiff granted the National Geographic Society a license to reproduce his images in "The Complete National Geographic."

(Defs.' Mem. in Supp. of Mot. for Add'l Order of Ref. at 3.) Additionally, Defendants seek to schedule another settlement conference with Judge Turnoff to attempt to resolve Plaintiffs' remaining claims. (Id.)

## II. Analysis

The "mandate rule" requires a district court to adhere closely to the dictate of an appellate court opinion. Pelletier v. Zweifel, 987 F.2d 716, 718 (11th Cir. 1993); Barber v. Int'l Bhd. of Boilermakers, 841 F.2d 1067, 1070 (11th Cir. 1988). The rule derives from the "law of the case" doctrine, and means simply that "a district court is not free to deviate from an appellate court's mandate." Pelletier, 987 F.2d at 718 (quoting Barber, 841 F.2d at 1070).

A district court must follow an issue decided by an appellate court, with three narrow exceptions: (1) the evidence on a subsequent trial was substantially different, (2) controlling authority has since made a contrary decision of the law applicable to the issue, or (3) the previous decision was clearly erroneous and would work a manifest injustice. Westbrook v. Zant, 743 F.2d 764, 768-69 (11th Cir. 1984).

In the instant case, the appellate court issued the following mandate:

Upon remand, the district court should ascertain the amount of damages and attorneys fees that are due, as well as any injunctive relief that may be appropriate. In assessing the appropriateness of any injunctive relief, we urge the court to consider alternatives, such as mandatory license fees, in lieu of foreclosing the public's computer-aided access to this educational and entertaining work.

(D.E. 75 at 7.)

Defendants allege that the Supreme Court's decision in Tasini requires this Court to question the viability of the Eleventh Circuit's decision in the instant case. The Eleventh Circuit was aware, however, that certiorari had been granted in Tasini when it issued its opinion in this case. Greenberg v. Nat'l Geog. Soc., 244 F.3d 1267, 1274 n.14 (11th Cir. 2001) ("This derivative-works issue may be addressed by the Supreme Court in Tasini . . . ."). The court distinguished the instant case from Tasini: "But here . . . we have far more than a mere reproduction in another medium." Id. Thus, the Court does not find that the Tasini decision constitutes a contrary decision of law by a controlling authority, which might otherwise permit the Court to question the appellate mandate. Moreover, given that the

Supreme Court had granted certiorari in Tasini before the Eleventh Circuit issued its March 22, 2001 opinion in Greenberg, Defendants could have petitioned the appellate court for rehearing pending the Supreme Court's decision in Tasini. See FED. R. APP. P. 40. A timely filed petition for rehearing would have stayed the mandate until disposition of the petition. See FED. R. APP. P. 41.

Based on the foregoing analysis, the Court finds that the appellate mandate does not permit reopening of the liability issues in this case. The Court also finds that a settlement conference should be scheduled in order for the parties to attempt to resolve Plaintiffs' remaining claims consistent with the Eleventh Circuit's mandate and this Order. Accordingly, it is

**ORDERED AND ADJUDGED** that:

1. The Motion for an Additional Order of Reference (D.E. 83), filed December 4, 2001, by Defendants National Geographic Society, National Geographic Enterprises, Inc. and Mindscape, Inc., is **GRANTED**, in part, as follows:

Pursuant to 28 U.S.C. § 636 and the Magistrate Rules and the Local Rules of the Southern District of Florida, the above-captioned cause is referred to U.S. Magistrate Judge William C. Turnoff to take all necessary and proper action as required by law with respect to **settlement conference**.

2. The Cross-Motion to Extend Time to File a Response to Amended Complaint

(D.E. 82), filed December 4, 2001, by Defendants National Geographic Society, National Geographic Enterprises, Inc. and Mindscape, Inc., is **DENIED**.

3. The Motion to Strike Defendants' Answers to Counts III and V of the Amended Complaint (D.E. 78), filed November 13, 2001, by Plaintiffs Jerry and Idaz Greenberg, is **GRANTED**. Defendants' Answers to Amended Complaint (D.E. 76, 77) are stricken as untimely, filed without leave of Court, and contrary to the Eleventh Circuit mandate.

**DONE AND ORDERED** in Chambers at Miami, Florida this 11 day of January, 2002.

  
**JOAN A. LENARD**  
**UNITED STATES DISTRICT JUDGE**

Cc: U.S. Magistrate Judge William C. Turnoff  
Norman Davis, Esq.  
Edward Smta, Esq.  
Robert G. Sugarman, Esq.  
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