

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

Initial Brief of Jerry Greenberg and Idaz Greenberg

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U. S. COURT OF APPEALS FOR THE ELEVENTH CIRCUIT

CERTIFICATE OF INTERESTED PERSONS
AND CORPORATE DISCLOSURE STATEMENT

Jerry Greenberg and Idaz Greenberg v. National Geographic Society, et al., Case
No. 00-10510-C

Aronberg, David

Davis, Norman

Greenberg, Jerry

Greenberg, Idaz

Lenard, Joan, U. S. District Judge

Mindscape, Inc.

National Geographic Enterprises, Inc.

National Geographic Society

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STATEMENT REGARDING ORAL ARGUMENT

The Appellants request oral argument if a full analysis of Section 201 (c) of the Copyright Act should be required. As an alternative to that analysis, the Appellants contend in their argument that the reassignment of copyrights to Appellant Greenberg by the National Geographic Society deprived the Defendants/Appellees of any right of any kind under the Copyright Act to republish and distribute the photographs that are in issue here. If that straightforward legal construction should be adopted by the Court, oral argument would serve no purpose.

STATEMENT OF JURISDICTION

This Court has jurisdiction pursuant to 28 U.S.C. § 1291. The statute authorizes appeals from all final decisions of a district court.

STATEMENT OF THE ISSUES

(1) Whether the district court erred in granting summary judgment to the Defendants/Appellees as to both Count III and Count V of the Amended Complaint, given that the reassignment to Jerry Greenberg of all rights to his photographs, after first publication in the Magazine, deprived the Society of any right or presumptive privilege to republish and distribute the photographs.

(2) Whether the district court erred in granting summary judgment to the Defendants/Appellees as to Count III of the Amended Complaint, given that photographs copyrighted by plaintiff Jerry Greenberg were utilized without his consent in a new collective work or new anthology in contravention of Congressional prohibitions as reflected in the Copyright Act.

(3) Whether the district court erred in granting summary judgment to the Defendants/Appellees as to Count V of the Amended Complaint, given that a photograph copyrighted by plaintiff Jerry Greenberg was utilized without his consent in a new derivative work in contravention of Congressional prohibitions as reflected in the Copyright Act.

(4) Whether the district court erred in denying a cross-motion for summary judgment as to Count III filed by the Plaintiffs/Appellants, given that the Defendants/Appellees infringed copyrights owned by Jerry Greenberg by including

photographs without his consent in a “new anthology” or a new collective work in contravention of Congressional prohibitions as reflected in the Copyright Act.

STATEMENT OF THE CASE

The Complete Geographic product infringes copyrights owned by Appellant Jerry Greenberg in two respects: (1) a significant number of his photographs were republished in the product, and (2) one of his photographs was transformed into a new derivative work that was included in the Complete Geographic product. On May 14, 1998, the district court granted summary judgment to the defendants/appellees on those issues. R1-37. This appeal is limited to those issues as treated in the order under review.

Subsequently, the district court granted summary judgment as to liability to the plaintiffs/appellants on two unrelated claims. R1-55. Following a settlement conference as to the remaining issues relevant to those counts, the parties on December 28, 1999 filed a joint stipulation of dismissal of Counts I and II. R1-71. On the same date, the district judge entered an order affirming the dismissal. R1-71. Thereafter, nothing remained for the district court to decide.

Rule 58, Federal Rules of Civil Procedure, requires entry by the district court of a judgment “on a separate document.” No such document was entered below. However, “[f]or purposes of § 1291, a final judgment is generally regarded as ‘a

decision by the district court that ends the litigation on the merits and leaves nothing for the court to do but execute the judgment.” Lauro Lines S.R.L. v. Chasser, 490 U.S. 495, 497, 109 S.Ct. 1976, 1978 (1989), quoting Van Cauwenberghe v. Biard, 486 U.S. 517, 521, 108 S.Ct. 1945, 1949 (1988). The stipulation referenced above effectively ended the litigation on the merits, and turned the May 14, 1998 order that is being appealed into a final and appealable order.

STATEMENT OF FACTS

Introduction

The Appellees in 1997 launched an “unprecedented” new product consisting of 30 CD-ROM disks containing 108 years of National Geographic Society magazines. The Society included in the new product a substantial number of photographs by Appellant Jerry Greenberg to which he owns the copyright interest. Greenberg contends that the Society had no legal right to republish his photographs because the Society had reassigned all rights to him long before the creation of the new product. Alternatively, even if the Society had any lingering right or privilege to republish, the Copyright Act, in Section 201 (c), prohibited such an act. Greenberg thus contends that his copyrights have been infringed by the Appellees.

As a completely separate issue, Greenberg contends that the Society infringed his copyright in a photograph that the Society transformed into a new derivative work

-- called here the Moving Covers Sequence -- that is included as a component of the Complete Geographic CD-ROM product.

The Parties

The Appellants are a husband-and-wife team of professionals who operate a modest publishing business from their home in Miami, Florida. Jerry Greenberg is a photographer. Idaz Greenberg is an illustrator. R1-25-Ex. A, Ex. B. Among his many other pursuits, Jerry Greenberg accepted photographic assignments from the National Geographic Society ("the Society") over a period of more than 30 years. Many of his photographs were published in the Society's monthly magazine ("the Magazine") and in other Society publications. Id. As is set forth below, Mr. Greenberg owns copyright in all of his photographs that were first published in a new Society product without his permission. R1-25-Ex. B.

Appellee National Geographic Society is a not-for-profit corporation formed in the District of Columbia, where its principal place of business is located. The Society hails itself as "the world's largest nonprofit scientific and educational organization." R1-19-1, 2. However, in modern times the Society formed one or more for-profit subsidiaries, including Appellee National Geographic Enterprises, Inc., to increase the revenue stream available to the Society. Id. The Society and/or National Geographic Enterprises, Inc. entered into a marketing and distribution

agreement with Appellee Mindscape, Inc., a California corporation. R1-20-Ex. B. Before the marketing effort on the product at issue here commenced, the Society said that it did not expect “to do more than break even” on products to be marketed by Mindscape.¹ Id.

The CD-ROM Product at Issue

In 1997, the Society² placed on the market a new product called “The Complete National Geographic -- 108 Years of National Geographic Magazine on CD-ROM” (hereafter “the Complete Geographic”). R1-20-2. It consisted of a bright yellow box containing 30 CD-ROM disks for display through a computer. The disks were segregated by decade into separate packages within the box.³ R1-20-Ex. A.

On the cover of the box, the CD-ROM product is called a “collection” that is “unprecedented.” Id. Not included are supplement maps that had been inserted in

¹ Discovery as to the Moving Cover Sequence, pursuant to Rule 56 (f), was denied to the Appellants by the district court. The defendants moved for summary judgment on both counts before answering, thus preempting any discovery opportunity. Should the Appellants eventually prevail on their cross-motion for summary judgment as to liability, they will pursue discovery in the damages phase.

² For convenience, all references in this brief to “the Society” are intended to encompass all defendants.

³ The Court is strongly urged to view carefully all components of the product, including those at the front and rear of each CD-ROM disk, as well as statements on the product box itself.

various issues of the Society's monthly magazine through the years. Id. A search engine provides access by topic, title, key word, or contributor. Id. The collection, according to the cover, contains "every" page of the Magazine "since the very first issue." Id. That is not quite true, as discussed below. The Complete Geographic product also incorporates a link for access to the Internet. Id.

The bottom of the yellow box displays the following: "The Complete National Geographic on CD-ROM was produced from an archive of magazines collected at a central repository and is not representative of any single regional edition of National Geographic magazine." Id. The same statement appears on the label attached to each of the 30 disks. Id. The same statement appears on screen at the end of the display on each disk. Id. The Society's literature states that the magazine is available for advertising purposes in "worldwide, international, U.S., regional, statewide, metro and 'test'" editions, as well as an edition published in the Japanese language. R1-25-Ex. C and attachments. Therefore, many variations of the monthly issues of the Magazine, bearing different advertising or a different language, are not included in the Complete Geographic. Id. Indeed, as the cover of the box states, the product is "not representative" of any single edition. R1-20-Ex. A.

The Society Sought Protection
for the New Product

No product like the Complete Geographic existed prior to 1997. R1-20-2. As noted above, the Society proclaimed its new collection “unprecedented.” R1-20-Ex. A. As befits a new collection, the Society took steps to protect it. The Society placed the following notice on the Complete Geographic box: “© 1997 National Geographic Society. All rights reserved.” Id. The same notice appears on the label attached to each disk in the box, and also in the visual display contained on each disk. Id. When any single “page” on a disk is displayed on a computer screen and is printed on hard copy, the 1997 copyright notice appears at the bottom of each sheet of hard copy. Id.

Approximately one year after the Complete Geographic first appeared in the market, the Society registered the new product with the U.S. Copyright Office.⁴ R1-66-attachment. The VA registration form asked in Section 1 for the title of the

⁴ In a supplemental memorandum, R1-66, in support of a motion seeking to vacate the order under review here, the Greenbergs urged the district court to take judicial notice, pursuant to Evidence Rule 201, of the copyright registration form that had just come into their possession. In dismissing the plaintiffs’ motion, the court never reached the issue of judicial notice. This Court can take judicial notice of the document because it is not subject to reasonable dispute and is capable of ready determination. Id. See, e.g., Ives Laboratories, Inc. v. Darby Drug Co., 638 F.2d 538, 544 n. 8 (2d Cir. 1981), rev’d on other grounds sub nom. Inwood Laboratories, Inc. v. Ives Laboratories, Inc., 456 U.S. 844 (1982). See generally 1 WEINSTEIN’S FEDERAL EVIDENCE § 201.32[3], 2nd ed. Moreover, the Society has acknowledged the document and its contents. R1-68-5, 6.

“work” to be registered, and the Society stated “108 Years of National Geographic Magazine on CD-ROM.” Id. Where the form asked in Section 3 for the year in which “creation of this work was completed,” the Society stated “1997.” Id. In Section 4 of the form, the “copyright claimant” was identified as “National Geographic Society.” Id. In Section 5, the Society stated that the work had never been registered before. Id. In section 6, the Society described the new work as a “compilation,” which has specific meaning in the context of the Copyright Act. Id. The VA registration form shows the effective date of registration to be July 14, 1998. Id.

Unique Components, and Selective
Components, in the Complete Geographic Product

As noted above, the Complete Geographic product is not at all “complete.” The new work contains complete copies of hundreds of back issues of the Magazine in one or more regional editions, but various other editions of the Magazine containing different matter are excluded. R1-20-Ex. A; R1-25-Ex. C and attachments. Each disk, when activated, displays a moving logo of a globe with background music, which is followed by a thirty-second advertisement for Kodak with sound. R1-20-Ex. A. As an introductory logo, each disk also contains a multi-media sequence of moving magazine covers (“the Moving Covers Sequence”). Id.

In the sequence, ten cover photographs selected from past issues of the magazine are electronically metamorphosed and visually manipulated from one to another. The sequence, with other graphic components placed at the front of each disk, serves as thematic material for the Complete Geographic product. The product also prominently displays trademarks and logos for Mindscape, Eastman Kodak, Microsoft, Macintosh, QuickTime, Dataware and AT&T WorldNet. Id. Those marks are different from, and separate from, any marks that appear in the various issues of the Magazine incorporated in the new product. Id.

A "Quick Start" leaflet in the product box describes the product's features. Id. A menu of magazine covers and a contents menu is available on each disk. Id. A list of all articles in alphabetical order is available. Id. A link is available, through the disks, to the Society's web site on the Internet. Id. The product box contains Magazine issues through 1996; the leaflet offers an update disk that will add all 1997 issues to what the leaflet calls "the collection." Id.

**Jerry Greenberg Owns Copyrights in
Photos Contained in the Complete Geographic**

The Complete Geographic contains a substantial number -- more than a dozen -- of photographs taken by Jerry Greenberg for which he owns copyrights. R1-25-Ex. B and attachments. The copyrights were not challenged below. Those copyrights

were timely registered and/or renewed with the U. S. Copyright Office. Id. Mr. Greenberg did not consent to the inclusion of his photographs in the Complete Geographic. Id. Prior to the appearance of the Complete Geographic on the market, Mr. Greenberg, through his legal counsel, informed the Society that he would not agree to the inclusion in the product of his copyrighted materials. Id. The Society never responded to his protest. Id.

Moreover, one of the ten covers utilized in the Moving Covers Sequence features a photograph of a female diver, using scuba gear and swimming among corals and fishes. R1-20-Ex. A.; R1-25-Ex. B. The cover is taken from the January 1962 issue of the Society's Magazine, and the photograph on that cover was taken by Jerry Greenberg. R1-25-Ex. B. Jerry Greenberg owns copyright in the photograph, and his consent to its use in the Moving Covers Sequence was never sought or granted. Id.

In 1985, the Society reassigned to Greenberg all right, title and interest, including copyright, to his photographs published in the January 1962, February 1968, and May 1971 issues of the monthly Magazine. R1-25-Ex. B. In 1989, the Society reassigned to Greenberg all rights, including copyright, in his photographs published in an article in a 1990 issue of the monthly Magazine. Id.

STANDARD OF REVIEW

On appeal, a district court's grant of summary judgment, and denial of summary judgment, is entitled to de novo review, and all reasonable doubts about the facts are to be resolved in favor of the non-moving party. Browning v. Peyton, 918 F.2d 1516, 1520 (11th Cir. 1990); Tackitt v. Prudential Insurance Co. of America, 758 F.2d 1572, 1574 (11th Cir. 1985).

SUMMARY OF THE ARGUMENT

(1) After first publication of his photographs in the Society's magazine, the Society reassigned to Jerry Greenberg all rights to the photographs. Moreover, any express transfer of rights to the Society that may have occurred at the time of first publication was negated. Moreover, if no express transfer took place, the presumptive privilege provided in Section 201 (c) of the Copyright Act was rebutted by the 1985 and 1989 reassignment of all rights to Greenberg.

(2) As to the claim in the Amended Complaint pertaining to the Complete Geographic product, the Appellees infringed copyrights owned by Appellant Greenberg by including his copyrighted photographs in a new *compilation, anthology* or *collective* work without his consent. Congress forbade such republication. The district court erred by holding that the republication in the new product by the

Appellees was a "revision" and that Section 201 (c) permits the inclusion of the photographs in the new work.

(3) The Appellants filed a cross-motion in the court below for summary judgment on liability as to the republication of Greenberg's photographs in the Complete Geographic product. For the same reasons that the Appellees' motion should have been denied, the Appellants' cross-motion should have been granted.

(4) As to the claim in the Amended Complaint pertaining to the Moving Covers Sequence, the Appellees infringed a copyright owned by Appellant Greenberg by transforming his copyrighted photograph into a new *derivative* work, the Moving Covers Sequence, without his consent. The district court erred by holding that the republication by the Appellees amounted to a "revision" and that Section 201 (c) of the Copyright Act permitted the transformation of the photograph into a new derivative work.

ARGUMENT

INTRODUCTION

In 1997, the National Geographic Society (the Society)⁵ and the other defendants began distribution of a completely new product called The Complete National Geographic (“the Complete Geographic”). The product contains photographs for which Appellant Jerry Greenberg owns all the copyright interest. The Society included his photographs in the new product without consulting Greenberg or obtaining his consent, and over his express, written objection. The inclusion of the photographs constitutes infringement of the Greenberg copyrights.

The order under review also concerns an iconic sequence that appears within the new product. The sequence (the “Moving Covers Sequence”) consists of ten covers taken from certain issues of the National Geographic Magazine (“the Magazine”). The covers were electronically metamorphosed from one to another to achieve an attractive iconic or thematic creation that appears at the front of each of the 30 CD-ROM disks in the new product. As such they constitute a new derivative work. Specifically, a cover featuring a sailing ship fades into Greenberg’s scuba-diver photograph, which itself fades into a photograph of a dancer. The inclusion of

⁵ For convenience, all references in this brief to “the Society” are meant to encompass all defendants/appellees.

Greenberg's altered photograph in the Moving Covers Sequence without his consent constitutes infringement of the copyright.

The court below, in the order under review, based its decision entirely on a 1997 decision in the Southern District of New York, discussed below, which has now been reversed by the Second Circuit Court of Appeals.

The Society, for so long a not-for-profit corporation, now has for-profit subsidiaries, including Appellee National Geographic Enterprises, Inc. As such, the Society is not allowing the copyright interests of others to interfere with grand marketing schemes, involving commercial products like the Complete Geographic, that are hardly being undertaken for philanthropic purposes.⁶

I.
BY ASSIGNING ALL RIGHTS TO GREENBERG,
THE SOCIETY HAD NO RIGHTS AT ALL
UNDER THE COPYRIGHT ACT TO
REPUBLISH GREENBERG'S PHOTOGRAPHS

There is much discussion and legal analysis below in this brief regarding the application of Section 201 (c) of the Copyright Act to the republication and

⁶ The Society stated, in a letter to photographers prior to placing the new product on the market, that it expected only to break even on its costs. R1-20 Ex. B. The product has been on the market for almost three years. The appellants were denied an opportunity to test the revenue predictions through discovery.

distribution of Jerry Greenberg's photographs. But resolution of the dispute need not reach that analysis.

On December 18, 1985, the Society assigned to Jerry Greenberg "all right, title and interest, including copyright" in Greenberg's photographs appearing in three separate issues of the monthly Magazine. R1-25-Ex. B. The assignment document identified each specific magazine and the specific pages on which the photographs appeared. Id. Greenberg recorded the reassignment in the U.S. Copyright Office. Id.

On June 14, 1989, the Society prepared and provided to Greenberg a letter agreement that hired him as a freelance photographer for a work assignment in Pennekamp Reef Park. Within that agreement, in the paragraph numbered 5, the Society expressly stated that after publication of the photographs in the Magazine all photographs would be returned to him along with all rights, including copyright, to said photographs" Id. The letter segment attached certain conditions to the assignment that are not material here. Id. Greenberg recorded that reassignment in the Copyright Office. Id.

When the Society, after first publication, reassigned all rights back to Greenberg, the Society had no rights whatsoever to republish and distribute the photographs. With no rights, the Society's inclusion of the Greenberg photographs

in the Complete Geographic product, and in the Moving Covers Sequence, constituted infringement of the Greenberg copyrights.

II.
**NOTWITHSTANDING THE REASSIGNMENTS,
THE COMPLETE GEOGRAPHIC PRODUCT INFRINGES
GREENBERG'S COPYRIGHTS BECAUSE IT IS A
NEW COLLECTIVE WORK IMPERMISSIBLY
REPUBLISHING GREENBERG'S PHOTOGRAPHS**

Section 201 (c) of the Copyright Act creates a presumption as to additional use that a publisher might make of material, such as the Greenberg photographs, after first publication in an issue of the Magazine. In the only definitive analysis of Section 201 (c) by a federal appellate court, the Second Circuit recently explained the presumption:

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 . . . the author also gives a non-assignable, non-exclusive privilege to use the article as identified in the statute. [Section 201 (c)] 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."

Tasini v. New York Times Co., ___ F.3d. ___, Slip op. 6749-68 (2d Cir. 2000) (quoting Section 201 (c)), reversing 972 F.Supp. 804 (S.D.N.Y. 1997).⁷

This Court may conclude that, notwithstanding the Society's reassignment of all rights to Jerry Greenberg, the Society retained a presumptive privilege under Section 201 (c). However, that privilege cannot apply to the Society in the circumstances here.

The Complete Geographic product is a new collective work, or at the very least a new anthology, as a matter of law. A "collective work" is defined below. The parties are agreed that each monthly Magazine placed within the product is a separate collective work as contemplated in the Copyright Act. The copyright for each Magazine protects only the collection – the magazine – itself. Section 201 (c) of the Act, discussed below, narrowly limits the republication and distribution of each monthly Magazine and its contents, and Congress explicitly said that the narrow presumptive "privilege" in that section does not extend, as here, to a new "anthology" or other "collective work."

⁷ Because the Second Circuit's February opinion amended an opinion entered September 24, 1999, citations hereafter to the amended opinion will be to "Tasini II."

A. A Collective Work as Defined in the Act

A "collective work" is defined in the Copyright Act 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.⁸

17 U.S.C. § 101. Thus, each of the Society's monthly Magazines qualifies as a collective work, and each enjoys copyright protection as a collective work. R1-20-Ex. A. Moreover, a "collective" work is a subset of "compilation" which is defined in the Act as

a work formed by the collection and assembling of preexisting materials or of data that are selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes an original work of authorship. The term "compilation" includes collective works.

Id. Protection for a work employing preexisting material in which copyright subsists does not extend to any part of the work in which such material has been used unlawfully. 17 U.S.C. § 103 (a). Thus, the copyright registration of the Complete Geographic product by the Society does not serve to shield an infringement of Greenberg's copyrights. Importantly, the Act limits the scope of copyright in a compilation or collective work:

⁸ An anthology is defined as a "collection of literary pieces of varied authorship." THE AMERICAN COLLEGE DICTIONARY at 52 (1964).

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. The copyright in such work is independent of, and does not affect or enlarge the scope, duration, ownership, or subsistence of, any copyright protection in the preexisting material.

17 U.S.C. § 103 (b).

B. The Society Violated the Presumptive Privilege in Section 201 (c) by Publishing Greenberg's Photographs in a New "Anthology" or "Collective Work"

As a bedrock proposition, the Copyright Act reserves to Appellant Greenberg the exclusive right, among other things, to reproduce his copyrighted photographs and to distribute copies of the photographs to the public by sale or otherwise. See 17 U.S.C. § 106. Because the Society is not entitled to the presumptive and limited privilege described next, the Society has infringed the Greenberg copyrights.

The Copyright Act grants the author of a collective work, such as the Society, a presumptive privilege -- not a right -- in very limited circumstances, to republish individual contributions, such as Greenberg's photographs, contained within a particular collective work, such as the monthly Magazine.

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.

17 U.S.C. § 201 (c). The Second Circuit recently provided the first detailed analysis by a federal appellate court of the language in that section.

[T]he presumptive privilege granted to a collective-work author to use individually copyrighted contributions is limited to the reproduction and distribution of the individual contributions 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.”

Tasini II, Slip op. at 6757 (bracketed material in original). The precise meaning of elements (i) and (iii) in that section of the Act is crucial to a determination of the central issue here.⁹ The Second Circuit has provided the most definitive clarification of those elements, and this Court should follow Tasini II to that extent. In the following discussion, “individual contribution” should be read to mean the Greenberg photographs.

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

⁹ Element (ii) of that section was dispositive to the district court because it relied on the Tasini decision in the Southern District of New York, which was reversed by Tasini II. No party here advanced a “revision” argument, and thus the parties waived such a contention.

or issue of a periodical. . . . 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.

Tasini II, slip op. at 6758.

As to the first clause, therefore, the Society's privilege is limited to reproducing the Greenberg photographs only in the "specific edition or issue" of the monthly magazine in which they originally appeared. *Id.* The first clause does not permit the compilation of many years of monthly magazines, at issue here, in a new format which embodies the legal ingredients of a new collective work. The first clause says nothing whatsoever about a new compilation or a new collective work. The Society, however, reproduced the photographs in a new compilation -- a collective work, or even an anthology, as defined in Section 101 of the Act -- that never had existed before, and that reproduction infringes the Greenberg copyrights. As to the third clause of Section 201 (c), the Second Circuit illuminates the meaning of "later collective work in the same series" as follows:

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 anthology¹⁰ or an entirely different magazine or other collective work," i.e., in later collective works not in the same series.

Tasini II, slip op. at 6759 (emphasis added), quoting H.R. Rep. No. 94-1476, at 122-23 (1976).

Thus, Congress did not intend to permit the inclusion of previously published freelance contributions -- such as the Greenberg photographs -- in a completely new anthology or in later collective works not in the same series. The Society cannot contend that The Complete Geographic is a collective work in the same series as each issue of the monthly Magazine. The title itself -- The Complete Geographic -- takes the product out of the "same series" language in the third clause of Section 201 (c). The Complete Geographic is a new compilation containing versions of the Society's monthly magazine -- without differentiation of editions, from an unidentified archive. The new compilation contains much new material and has deleted still other material found in various issues of the monthly Magazine.¹¹

¹⁰ Congress thus foreclosed any attempt by a publisher to evade the new collective work prohibition by creating a new anthology. The Complete Geographic product is either or both.

¹¹ In accord with the Second Circuit's reasoning, a later work in the "same series" might consist of a revised edition of a particular issue of the monthly Magazine. Here, however, the Society disavows such a revision by repeatedly

The Second Circuit's construction of the third element in Section 201 (c) can be applied thusly: Congress intended that one of Greenberg's photographs might be included in a subsequent issue of the Society's monthly magazine. The Complete Geographic product is not a subsequent issue of the monthly magazine but is an entirely new "anthology" or "collective work" that never existed before, with its own notice of copyright for 1997. The Complete Geographic, in other words, is not a collective work in the "same series," as contemplated in the presumptive privilege set forth in the third element of Section 201 (c).¹²

That analysis is consistent with Notes of Committee on the Judiciary, House Report No. 94-1476,¹³ where the committee said, with respect to the final clause in Section 201 (c), that "a publishing company could reprint a contribution from one issue in a later issue of its magazine, and could reprint an article from a 1980 edition of an encyclopedia in a 1990 revision of it; the publisher could not . . . include it in

asserting that certain editions of the Magazine were included from some archive, but repeatedly acknowledges that the compilation is "not representative of any single regional edition" of the Magazine.

¹² In Part II D, *infra*, Appellants set forth in detail the characteristics of the Complete Geographic that mark it as a new "collective work," i.e., a work manifesting "selection, coordination, and arrangement of the preexisting materials [the monthly magazines]."

Tasini II, slip op. at 6762.

¹³ See 17 U.S.C.A. § 201 (c), Historical and Statutory Notes, at page 344.

a new anthology or an entirely different magazine or other collective work.”

(Emphasis added.)

In Tasini II, the court referred to “NY Times OnDisc,” a product at issue there, which contains the full texts of articles from many years of The New York Times. The court characterized the product as “at best a new anthology of innumerable editions of the Times.” Slip op. at 6764. Analogously, the Complete Geographic product is a new anthology of hundreds of earlier single issues of the monthly Magazine.

C. The Society Itself Treats the Complete Geographic as a New Collective Work or Anthology

In cases typically considered by the courts, a publisher labors hard to demonstrate protection in a collective work in order to discourage or to proceed against infringers. Here, the effort is reversed. The Society vigorously attempts to disavow the notion of a new collective work, or a compilation (either of which would be a new and separate work) in order to evade a claim of infringement. Ironically, however, the Society’s conduct and statements reveal the Complete Geographic product as the new and unique work that it is.¹⁴

¹⁴ The product is in the record at R1-20-Ex.A.

There is simply no question that the product is a “work” and is “new” as a matter of law. It is uncontradicted that no product like the Complete Geographic existed prior to 1997. In the labeling on the product box, the Society proclaimed its new collection “unprecedented.” As befits a new collection, the Society took steps to protect it, first by placing copyright notice on the product box, on the label attached to each disk in the box, and also in the visual display contained on each disk. When a user displays any single “page” from a disk on a computer screen, and prints that page on hard copy, the 1997 copyright notice appears at the bottom of each sheet of hard copy.¹⁵ Significantly, the Copyright Act requires that any notice must reflect the year of completion and first publication of the work. 17 U.S.C. § 401 (b).¹⁶ Each issue of the monthly magazine contained in the Complete Geographic product were published in years prior to 1997, and each magazine issue displays its own copyright notice (all of them prior to 1997). The 1997 notice, therefore, announces a new work, or else it serves no purpose at all.

¹⁵ The Berne Convention Implementation Act in 1989 deleted any requirement for notice, but such notice is likely still essential in nations not adhering to the Berne Convention.

3 NIMMER ON COPYRIGHT § 7.02[B], .03 [C][3].

¹⁶ In its summary judgment memorandum, the Society dismissed the 1997 notice issue as of no significance, but did not explain why the notice is spread so pervasively throughout the new work. R1-28-4.

In 1998, after the Complete Geographic had been sold in the marketplace for about a year, the Society registered the new product with the U.S. Copyright Office. The VA registration form asked in Section 1 for the title of the "work" to be registered, and the Society stated "108 Years of National Geographic Magazine on CD-ROM." In papers filed with the district court the Society was clear that it was registering the entire product. R1-69-6. That title is evidence that the product cannot be a "later collective work in the same series," as the third clause in Section 201 (c) provides. Where the form asked in Section 3 for the year in which "creation of this work was completed," the Society stated "1997." In Section 4 of the form, the "copyright claimant" was identified as "National Geographic Society."

In Section 5, the form asked if an earlier version of the work -- the Complete Geographic -- had been registered, and the Society said "no." The Society claims a privilege, under the first clause of Section 201 (c), to republish the original collective works, i.e., the original monthly Magazines. But if that were true (and it is not true in the circumstances here), the proper response in Section 5 would be "yes," and pursuant to the instruction contained within Section 5 the previous registration numbers for each of the original collective works should be listed. The "no" response is an admission against interest by the Society.

The 1998 registration did not apply to individual monthly Magazines in the Complete Geographic product. The registration was of a completely new and separate work.¹⁷

The Copyright Act contains an important distinction: "Copyright in each separate contribution to a collective work is distinct from copyright in the collective work as a whole" 17 U.S.C. § 201 (c). Thus the Act requires, in an application for copyright registration of a compilation (which incorporates a collective work) "a brief, general statement of the additional material covered by the copyright claim being registered." 17 U.S.C. § 409 (9). On the form, the Society wrote "brief introductory audio-visual montage." R1-66-Attach. In a memorandum submitted to the district court, and with reference to the registration form, the Society attempted to minimize the additional material as "merely . . . a small amount of material in addition to that which existed previously." R1-69-6. In reality, as discussed below, material much more than trivial, and with controlling legal significance, was added to the collection of Magazines in the product.

¹⁷ In a representation to the district court in a memorandum, the Society described the work it was registering with the U.S. Copyright Office as "a compilation of preexisting material." R1-69-5. That falls squarely within the Act's definition of a compilation. 17 U.S.C. § 101. The compilation, of course, constitutes a new work.

Notwithstanding its attempt to deflect the registration, the Society plainly sought protection in the form of registration for material it deemed worthy of protection – not preexisting material in monthly Magazines that each had copyright protection, but new material and components, in an original format, justifying the Complete Geographic as a separate and independent work.

The Act's definition of "compilation," which includes collective works, speaks of a new work that "as a whole constitutes an original work of authorship." 17 U.S.C. § 101 (emphasis added).¹⁸ Having registered the Complete Geographic product as a new compilation that never existed before, the Society cannot now contend that the compilation is not an original work of authorship. As discussed below, the Society had no legal right to re-publish the Greenberg photographs, without his consent, in a new compilation and original collective work.

¹⁸ "In order to be acceptable [for registration] as a pictorial, graphic or sculptural work, the work must embody some creative authorship in its delineation or form." 37 C.F.R. § 202.10 (7-1-99 edition). In complying with that regulation, and in registering the Complete Geographic, the Copyright Office obviously found that creative authorship. The Act provides that a registration certificate creates "prima facie evidence of the validity of the copyright and of the facts stated in the certificate." 17 U.S.C. § 410 (c).

D. The Product Contains Unique and Original Components That Qualify it as A New Collective Work or Anthology

Apart from the Society's own conduct and admissions as to a new work, as discussed above, the Complete Geographic product otherwise qualifies on its own as a new compilation, or collective work, or anthology.

While originality is required for copyright protection, the Second Circuit has said that "[i]n the law of copyright, only an unmistakable dash of originality need be demonstrated; high standards of uniqueness in creativity are dispensed with." Weissman v. Freeman, 868 F.2d 1313, 1321 (2d Cir. 1989). "[C]ompilations, and collective works, are characterized by the fact that they possess relatively little originality. . . ." Tasini v. New York Times Co., 972 F.Supp. 804, 814 (S.D.N.Y. 1997), reversed on other grounds in Tasini II. "[T]he originality called for in a collective work consists of the collection and assembling of pre-existing materials. . . ." 1 NIMMER ON COPYRIGHT § 3.02 at 3-7. Originality in a collective work does not require the addition of new materials. Id. § 3.03 at 3-9, 10. The most definitive word on originality comes from the Supreme Court, in Feist Publications v. Rural Telephone Service, 499 U.S. 340, 111 S.Ct. 1282 (1991), which involved copyright protection for a new factual compilation. The Court held that "choices as to selection and arrangement, so long as they are made independently by the compiler and entail

a minimal degree of creativity, are sufficiently original that Congress may protect such compilations through the copyright laws.” 499 U.S. at 349, 111 S.Ct. at 1289. “Even a directory that contains absolutely no protectible written expression, only facts, meets the constitutional minimum for copyright protection if it features an original selection or arrangement.” Id.

[T]he requisite level of creativity is extremely low; even a slight amount will suffice. The vast majority of works make the grade quite easily, as they possess some creative spark, “no matter how crude, humble or obvious” it might be.

499 U.S. at 345, 111 S.Ct. at 1287 (citation omitted). The Complete Geographic product consists of much more than such a barebones set of facts, or even a barebones set of old issues of the Magazine.

Selection most assuredly was involved in creating the product. As noted above, the Complete Geographic is “complete” only in a limited sense. The product contains complete copies of hundreds of back issues of the Magazine in certain regional editions, but various other editions of the Magazine containing different matter and in a different language are excluded. Map inserts that had accompanied individual Magazines through the years were omitted. Importantly, the Society repeatedly admits in the product itself that the Complete Geographic “is not representative of any single regional edition” of the Magazine.

Creation of the new product also involved arrangement. The Complete Geographic product box proclaims an “unprecedented” collection of Magazines. Despite comparison in its district court papers to microfilm storage, the Society cannot show (and did not) that 108 years of individual issues of the Magazine ever were assembled before, in any medium, in one collection. Thus the gathering of so many Magazines involved a unique and original arrangement. The product box contains 30 CD-ROM disks, arranged by decade. The Society has not contended, and cannot show, that such a collection of 108 years of the Magazines, by decade, ever existed before. On each disk, the Society arranged for a display of Magazine covers for each full calendar year for ease of access. No such display of so many covers, within a single product, ever existed before. The product provides a menu of actual covers, and a contents menu, plus a listing of all articles by alphabetical order. No such displays were ever available previously, at least in a comprehensive 108-year collection.

New and original material was included in the Complete Geographic product. Each disk, when activated, displays a moving logo of a globe with background music, which is followed by a thirty-second advertisement for Kodak with sound. As an introductory logo, each disk also contains a multi-media sequence of moving magazine covers (“the Moving Covers Sequence”). In the sequence, ten cover

photographs selected from past issues of the magazine are electronically metamorphosed and visually manipulated from one to another. The sequence, with other graphics related to the Society, obviously serves as thematic material for the Complete Geographic product. The product also prominently displays trademarks and logos for Mindscape, Eastman Kodak, Microsoft, Macintosh, QuickTime, Dataware and AT&T WorldNet. The marks are shown separately from any marks that appear in the various issues of the Magazine that are incorporated in the collective work. At the end of each disk, lengthy credits and attributions are displayed -- none of which are displayed in the Magazines themselves. The collection of items identified in this paragraph never existed previously in any product created or distributed by the Society. A menu of magazine covers and a contents menu is available on each disk. A list of all articles in alphabetical order is available. A computer link is available, through the disks, to the Society's web site on the Internet. The issue is not the medium used; the issue is the existence of originality in the product itself. The Society attempts to compare its new compilation to microfiche rolls prepared for libraries and similar users, but the Society has not shown that any microfiche roll contained the elements of originality described above.

Much more originality exists here than the "crude" and "humble" and "slight amount" threshold established by the Supreme Court for a compilation, and as a

statutory subset of “compilation,” for a collective work. In making the originality assessment, the collective work must be viewed “as a whole.” 17 U.S.C. § 101.

There can be no doubt that the Complete Geographic product constitutes an original work of authorship.

**E. The District Court Erroneously Held That
The Product Constitutes a Revision
Permitted Under Section 201 (c) of the Act**

In its remarkable May 14, 1998 order, the district court held that the Complete Geographic product constitutes a “revision” of the Society’s magazines within the meaning of Section 201 (c), and that inclusion of the Greenberg photographs in the “revision” was authorized pursuant to that section. In reaching that conclusion, the court relied almost entirely on Tasini v. New York Times Co., 972 F.Supp. 804 (S.D.N.Y. 1997), which, as noted, has been reversed by the Second Circuit.¹⁹ The court wrongly relied on, and wrongly applied, Tasini.²⁰ The Complete Geographic product is not a “revision” that might qualify for privileged publication by the defendants under the second prong of Section 201 (c).

¹⁹ All references to Tasini in this sub-part that discusses the district court’s order under review are to the decision by the court for the Southern District of New York.

²⁰ “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.” R1-37-7.

Section 201 (c) provides, in the second prong, that the Society, as owner of copyright in each monthly Magazine (each of which constitutes a collective work) may reproduce a separate contribution within an issue of the Magazine in “any revision of that collective work.” That prong is simply not applicable here. None of the appellants or appellees here ever has contended that the Complete Geographic product is a “revision” as defined in the Act.

In an amazing analysis that missed the core issue completely, the court below said in the order being reviewed that the 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.” R1-37-7. That, of course, is not the question. The district court said further:

[Greenberg] 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

.....
R1-37-8. (Emphasis added). The court’s analysis is deeply flawed. Apart from the court’s omission of numerous other factors that make the Complete Geographic product new and original, as outlined above, the legal analysis does not require a

comparison of the Complete Geographic product with prior issues of the Magazine. The proper question is whether the Complete Geographic product contains enough ingredients of originality to qualify as a new and separate work under the Act. The Appellants strongly contend that it does, and the Society's registration of the product as a "compilation" qualifies it as a matter of law as an original work of authorship.

The district court's error is plain and substantial.

III.
**THE MOVING COVER SEQUENCE, AS A
NEW DERIVATIVE WORK, HAS
INFRINGED THE GREENBERG COPYRIGHT**

The Moving Cover Sequence which appears at the front of each disk in the Complete Geographic product constitutes a separate and new derivative work, and the Society infringed Jerry Greenberg's copyright by including his photograph in the new work (and the Complete Geographic) without his consent. In its summary judgment memorandum, which included a challenge of Count V, the Society argued *de minimis* use and that the doctrine of fair use permitted inclusion of the Greenberg photograph in the sequence. The district court's order under review, granting summary judgment to the Society as to Count V, is almost entirely devoid of any discussion or analysis of Count V. R1-37. The court's error is manifest.

A. A Derivative Work As Defined in the Act

The Copyright Act defines “derivative work” as follows:

A “derivative work” is a work based upon one or more preexisting works, such as a translation, musical arrangement, dramatization, fictionalization, motion picture version, sound recording, art reproduction, abridgment, condensation, or any other form in which a work may be recast, transformed, or adapted. A work consisting of editorial revisions, annotations, elaborations, or other modifications which, as a whole, represent an original work of authorship, is a “derivative work.”

17 U.S.C. § 101. The Moving Cover Sequence meets that definition in every respect. It is beyond question an original work. It recasts, transforms and adapts the ten covers, including Greenberg’s photograph, by literally “morphing” them from one to another. Especially noteworthy is how the Society adjusted Greenberg’s photograph from a horizontal presentation of the diver into a vertical realignment and transformation of the diver into a dancer. The Court is urged to visually review the sequence.

As provided in the Copyright Act, the owner of copyright – here, Jerry Greenberg – has the exclusive right, among other things, to reproduce his copyrighted work in copies, or to prepare derivative works based upon his copyrighted work, and to distribute copies to the public by sales or other transfer. 17 U.S.C. § 106 (1), (2), (3). That right was infringed by the Appellees.

B. The District Court Ignored the Moving Covers Sequence in its Erroneous Haste to Apply Tasini

The district court's order totally ignores argument presented by the plaintiffs with respect to Count V, and even wrongly characterizes the argument advanced by the defendants with respect to that count. The order states that the Society contends that Count V must be dismissed because of re-publishing authority provided in Section 201 (c) of the Act. R1-37-4. The Society never made such a contention. Instead, the Society's treatment of Count V was based on Section 107 of the Act, which permits "fair use," and on a *de minimis* argument.

Each of the elements in the application of the fair use doctrine is fact-intensive, and must be decided on a case-by-case basis. Campbell v. Acuff-Rose Music, Inc., et al., 510 U.S. 569, 577 (1994). The Greenbergs had no opportunity to conduct any discovery on any of the factors, and implored the district court to deny the defendants' motion as to that claim until appropriate discovery could be accomplished. The court ignored that request, and also ignored the inapplicability of the case law advanced by the defendants in purported support of their fair-use argument below.

C. **The Appellees' Arguments Below as to Fair Use and *De Minimis* Use Do Not Comport with the Law**

(1) *De Minimis*

(A) Even a Small Usage Can be Unfair

The defendants argued below that because the Greenberg cover photograph appears in the Moving Covers Sequence for less than one second, it is a *de minimis* use and thus not actionable. R1-19-7. They cited no authority to support the proposition that a *de minimis* use is defined solely on the basis of quantity of use rather than quality of use.²¹ Indeed, "even a small usage may be unfair if it is of critical importance to the work as a whole and taken by the infringer in order to save the time and expense incurred by the copyright owner." Meredith Corp. v. Harper & Row Publishers, Inc., 378 F. Supp. 686, 693 n.12 (S.D.N.Y. 1974), aff'd, 500 F.2d 1221 (2d Cir. 1974); see also Horgan v. MacMillan, Inc., 789 F.2d 157, 162 (2d Cir. 1986) ("Even a small amount of the original, if it is qualitatively significant, may be sufficient to be an infringement"); Metro-Goldwyn-Mayer, Inc. v. American Honda Motor Co., 900 F. Supp. 1287, 1300 (C.D. Cal. 1995) ("[T]he Court must look to the quantitative and qualitative extent of the copying involved. . . . Plaintiffs

²¹ Even the quantity used was relatively very significant. The full sequence lasts about ten seconds, and the Greenberg photograph constitutes approximately one-tenth of the entire "work," which is not inconsequential.

should prevail on this issue . . . [because] the brevity of the infringing work when compared to the original does not excuse copying."); Chicago Record-Herald Co. v. Tribune Ass'n, 275 F. 797, 799 (7th Cir. 1927) (rejecting defendant's *de minimis* argument because "[w]hether the appropriated publication constitutes a substantial portion of [the defendant's infringing article] cannot be determined alone by lines or inches which measure the respective articles."). The Appellees cannot attempt to trivialize a photograph they made the conscious decision to highlight in the Moving Covers Sequence that appears on every single one of the 30 disks in the Complete Geographic product.

Amid the more than 1,200 editions of the Magazine in The Complete Geographic product, the "scuba diver above a coral reef" photograph by Jerry Greenberg appears prominently on the cover of the January 1962 issue. Among the many hundreds of covers available for the Moving Covers Sequence, the Appellees settled upon ten covers with images that could meet the stated purpose of the Moving Covers Sequence by creating a new work that would serve as the Complete Geographic "icon."²²

²² An instruction sheet that accompanies the discs inside the product box refers to the sequence as "The Complete National Geographic icon." R1-20-Ex. A. An icon can be said to be a symbol of the magazine. See H. Mifflin Co., THE AMERICAN HERITAGE DICTIONARY at 638 (2d Coll. Ed.) (1985).

The defendants cannot downplay the significance of their selection of Greenberg's photograph by dismissing it as "*de minimis*." See Educational Testing Servs. v. Katzman, 793 F.2d 533, 542 (3d Cir. 1986) (rejecting defendants' *de minimis* argument that they copied only a "handful" of test questions out of thousands produced by plaintiff; the court looked instead to the "qualitative value of the copied material, both to the originator and to the plagiarist."); Elsmere Music, Inc. v. National Broad. Co., 482 F. Supp. 741, 744 (S.D.N.Y. 1980) (rejecting defendant's *de minimis* argument because, even though defendant copied only four notes and two words from a song of 100 measures and 45 words, "[u]se of such a significant (albeit less than extensive) portion of the composition is far more than merely a *de minimis* taking."), aff'd, 623 F.2d 252 (2d Cir. 1980). The defendants thrust the Greenberg cover photograph to the forefront of every one of its discs in the Complete Geographic product. No law is required to conclude that the decision to place his photograph on a magazine cover in 1962 represented a high tribute to the quality of his work. It was an even higher tribute to Greenberg's work that the defendants chose to use his photograph, with nine others, to epitomize all the cover photographs that have come before.

However, unlike the other photographs in the Complete Geographic product, the plaintiff's photograph does not sit silently on a page²³ within one of the 1200-plus issues on one of the 30 discs until someone finds it. Rather, the photograph finds you. Every time someone views any one of the 30 discs, he or she views the Moving Covers Sequence. The only way to avoid viewing the Moving Covers Sequence each time a disc is opened is for the viewer to make a conscious decision to mouse-click it away.²⁴ Except for the nine other photographs within the Moving Covers Sequence, no other image is granted such exalted status within the Complete Geographic as the Greenberg photograph.

The Appellees relied below largely on two cases, Ringgold v. Black Entertainment Television, Inc., 126 F.3d 70 (2d Cir. 1997) and Amsinck v. Columbia Pictures Indus., Inc., 862 F. Supp. 1044 (S.D.N.Y. 1994). Neither of these cases establishes what was claimed below as a basis for their *de minimis* argument, nor do

²³ As noted above, the Society has "morphed" the covers, including Greenberg's photograph, into a new derivative work.

²⁴ It is axiomatic that the number of times an individual views the Moving Covers Sequence depends on the individual's own taste. But the fact that the Complete Geographic enables a viewer to mouse-click the Moving Covers Sequence away does not alter the fact that the Moving Covers Sequence begins playing automatically, without any prompting from the viewer. Moreover, the defendants cannot know whether, or how often, the Moving Covers Sequence will be discarded by clicking.

they present fact patterns even arguably applicable to this case. In fact, the two cases support Jerry Greenberg.

In Ringgold, for example, the defendant used a poster of a copyrighted image in the background scenery in one of its television shows. 126 F.3d at 73. As in the instant case, the defendants invoked the *de minimis* defense in a motion for summary judgment prior to discovery. Id. at 73. The defendants argued that the use was *de minimis* because "the television viewer sees no more than 'some vague stylized [sic] painting . . . ' and can discern none of [the plaintiff's] particular expression of her subjects." Id. at 77 (quoting from the defendants' brief). The Second Circuit, however, rejected this argument and held that the *de minimis* threshold for actionable copying of protected expression had been crossed. Id. Using language particularly appropriate for the instant case, the court found it "disingenuous" for defendant Home Box Office, "whose production staff evidently thought that the poster was well suited as a set decoration for the [scene] . . . , now to contend that no visually significant aspect of the poster is discernible." Id. at 77.

Similarly, the Appellees here attempted to diminish the importance of a photograph they deemed well-suited for inclusion in a highly-select group of ten cover photographs chosen to represent the history of the magazine. In Ringgold, the artist's work was part of background scenery. Here, Jerry Greenberg's photograph

serves as a foreground emblem for the entire 108-year Magazine collection. As the Second Circuit did in *Ringgold*, this Court should dispatch any arguments made by Appellees that their use of Greenberg's photograph - which appears, it should be remembered, at the beginning of every disk in the Complete Geographic package - was *de minimis*.

The defendants also cannot find support in Amsinck, which is clearly distinguishable. In Amsinck, without the artist's permission, the defendants used a crib mobile that featured the plaintiff's artwork as part of the set decoration in a film. 862 F.Supp. at 1046. In contrast, the Greenberg photograph at issue is not some incidental decoration for the Complete Geographic product. As discussed above it is given stage-center prominence, in a highly symbolic manner, on every disc in the 30-disc collection. See Harper & Row Publishers, Inc. v. Nation Enters., 471 U.S. 539, 566, 105 S. Ct. 2218, 2233 (1985) ("In view of the expressive value of the excerpts [of former-President Nixon's admissions to then-President Ford regarding Watergate] and their key role in the infringing work, we cannot agree with the Second Circuit that the 'magazine took a meager, indeed an infinitesimal amount of [the] original language.'" (citation omitted).

This Court should reject any argument that quantity of use alone determines what crosses beyond the *de minimis* threshold.

(B) The Defendants' Inclusion of the Greenberg Photograph Cannot Be *De Minimis* Because the Defendants Used the Entire Photograph, and Not Just a Fragment, in the Sequence

The defendants' de minimis argument below also should be rejected because the defendants used Jerry Greenberg's entire photograph, and not just a fragment, in the Moving Covers Sequence. "As a rule, a taking is considered de minimis only if it is so meager and fragmentary that the average audience would not recognize the appropriation." Fisher v. Dees, 794 F.2d 432, 434 n.2 (9th Cir. 1986); accord Epic Metals Corp. v. Condec, Inc., 867 F. Supp. 1009 (M.D. Fla. 1994) (quoting the above rule of law from Fisher); Acuff-Rose Music, Inc. v. Campbell, 972 F.2d 1429, 1438 (6th Cir. 1992) ("A de minimis use, one that is meager and fragmentary, by definition fails to conjure up the original and does not constitute an infringement."), rev'd on other grounds, 510 U.S. 569 (1994). Anyone at all familiar with the Greenberg cover photograph would certainly recognize it in the Moving Covers Sequence.

(2) Fair Use

The requirements for adjudicating whether an unauthorized use of a copyrighted work is a "fair" use and, thus, not an infringement pursuant to Section 107 of the Copyright Act were most recently delineated in Campbell v. Acuff-Rose Music, Inc., et al., 504 U.S. 569 (1994). In Campbell, the Court was faced with the

issue of whether a parody was automatically a "fair" use, under Section 107, or whether the courts had to apply all four express tests for "fair use" defined in that Section. The Campbell Court held not only that all four tests had to be evaluated, but that each had to be evaluated in light of the particular facts of a particular case. In other words, the efficacy of a "fair use" defense turns on the facts.

In this case, however, the plaintiffs did not have the luxury of any discovery on this issue. Defendants foreclosed any discovery by filing for summary judgment instead of answering the complaint, and the district court denied the plaintiffs' Rule 56 (f) motion.

(A) The Appellants Should Have Had Reasonable
Discovery As To Facts Relevant to "Fair Use"

The Appellees devoted considerable argument below to the fair use doctrine in attempting to justify their infringement. R 1-19-9 to 16. Although plaintiffs sought leave to obtain discovery solely on the "fair use" issue, that leave was denied. R 1-37. Rule 56 (f), Federal Rules of Civil Procedure, however, provides as follows:

Should it appear from the affidavits of a party opposing the motion that the party cannot for reasons stated present by affidavit facts essential to justify the party's opposition, the court may refuse the application for judgment or may order a continuance to permit affidavits to be obtained or depositions to be taken or discovery to be had or may make such other order as is just.

Despite the clear instruction of Rule 56 (f), the plaintiffs sought, and were refused, a continuance -- but only as to Count V -- of the defendants' then-pending motion for summary judgment so that appropriate discovery could be had. Plaintiffs also complied completely with the procedural requirements of Rule 56 (f). According to Rule 56 (f), a request for discovery during a summary judgment proceeding must take the form of an affidavit stating the reasons for the party's inability to present facts essential to justify its opposition. An affidavit by a party's counsel can satisfy the requirement of the rule where the attorney has the requisite first-hand knowledge and is competent to address the specifics of the facts needed. Fernandez v. Bankers Nat'l. Life Ins. Co., 906 F.2d 559, 570 (11th Cir. 1990). See also Resolution Trust Corp. v. North Bridge Assocs., 22 F.3d 1198 (1st Cir. 1994) (party need not execute affidavit). An affidavit for that purpose by Norman Davis was attached to and incorporated in the plaintiffs' responding memorandum. R1-25-Ex.D. Accordingly, plaintiffs complied with Rule 56 (f) by submitting an Affidavit describing the reasons for their inability to present material facts that could have been found to be in dispute. R 1-25-Ex. D.

"The party opposing a motion for summary judgment has a right to challenge the affidavits and other factual materials submitted in support of the motion by conducting sufficient discovery so as to enable him to determine whether he can

furnish opposing affidavits." Snook v. Trust Co. of Georgia Bank of Savannah, N.A., 859 F.2d 865, 870 (11th Cir. 1988). If the documents or other discovery sought would be relevant to the issues presented by the motion for summary judgment, the opposing party should be allowed the opportunity to utilize the discovery process to gain access to the requested materials. Id. Generally summary judgment is inappropriate when the party opposing the motion has been unable to obtain responses to his discovery requests. Id. Where a dispositive motion affecting an important claim in the case is involved, plaintiffs should have been granted the full ability to oppose arguments advanced by the defendants in a summary judgment motion. Despite full compliance with Rule 56 (f) and the materiality of defendants' "fair use" defense, plaintiffs' plea for a discovery opportunity was denied.

(B) Even Absent Discovery, the
Fair Use Arguments Fail

In assessing the Appellees' arguments regarding fair use, this Court can usefully consider the discussion immediately above relating to the uniqueness and prominence in the placement and display of the Moving Covers Sequence within the Complete Geographic product. Within that context, the Court should accept that the Society's use of the Greenberg photograph in that sequence was not merely a borrowing or reprinting of a photograph. The photograph was incorporated in what

unquestionably is a new derivative work, as defined in Section 101 of the Act. The definition refers to the recasting, transforming or adapting of a work into an entirely new work, as is the case here. The Society's Moving Cover Sequence did more than that, because it distorted the photograph and merged it with others, albeit with great visual impact. The fair use factors discussed below hardly contemplate such a patently exploitive use. The Appellees may attempt to trivialize such contentions, but the new derivative work speaks vividly for itself in justifying this argument.

The Court should remember, in a "fair" use analysis, that the Complete Geographic product itself is evidence of an enormous library of photographs in the Society's archives, including hundreds of cover photographs in the monthly Magazines (although the Society reassigned to Greenberg all rights in his photographs). Is it "fair" use for the Society to exploit a cover photograph that it does not own, in lieu of limiting itself to its massive archive containing hundreds of cover photographs the Society does own? Decidedly not.

Moreover, the record is uncontradicted that Jerry Greenberg communicated with the Society, prior to the marketing of the Complete Geographic, and expressly stated that he did not want his copyrighted photographs included in the product. R 1-25-Ex. B. The Society never responded. Thereafter, indifferently and wilfully, the Society not only proceeded to republish the Greenberg photographs that were

imbedded in early editions of the monthly Magazine, it also proceeded to include one of the Greenberg photographs in a totally new Moving Cover Sequence. These facts alone should negate any claim by the Society of "fair" use of the Greenberg photographs.

(C) The Fair Use Defense Offered by Defendants Below Has No Merit

The most prominent categories of fair use, set forth in Section 107 of the Act, are criticism, comment, news reporting, teaching, scholarship and research. The first three on their face have no application here. The research prong is not applicable because the Moving Covers Sequence is used only for decorative or for iconic purposes, and because any research value inherent in use of the cover photograph is to be found within the particular monthly Magazine in which the photograph and its related text appear. The remaining categories -- teaching and scholarship -- have no meaning in terms of a sequence of moving covers that was brief and was obviously intended for decorative or iconic purposes only.

The specific fair use arguments discussed below appeared in the Society's memorandum for the district court. R1-19-9 to 16.

(i) The Society's Claim of Educational Value is Misplaced

In the lower court, the Society argued fair use in that the Magazine is an educational periodical. Its argument was limited to the Magazine itself, with emphasis that its role in increasing knowledge of and appreciation for humans and plant life inherently warrants the borrowing of the photograph. The Magazine, however, was not sold just to libraries, schools and other educational institutions. It also has a wide, public subscription base, it would seem, as evidenced by the circulation figures for the Magazine. R 1-25-Ex. C.

The Society cannot deny that the Complete Geographic is sold primarily to the public at book stores, specialty stores and over the Internet. The 30-disk boxed set may, indeed, be educational, but its marketing, distribution and sale is for profit.

The Society's discussion on education – in terms of its “mission” – implies that Appellant Greenberg could not possibly have a similar mission. Indeed, the record is clear that the Appellants' works are used widely in schools, libraries, and in various educational programs and endeavors. R1-51-Ex. K.

(ii) The Society's Use of Greenberg's Photograph is a “Transformative Use”

The Society admitted below that it made “transformative” use of the Greenberg photograph by adding further creative expression or meaning to it. R 1-19-10. Far

from supporting defendants' argument below that such "transformation" constituted a "fair use," that admission supports a finding that the defendants created a work "derivative" of Greenberg's photograph. That, of course, is copyright infringement, not a "fair use."

The beginning sequence of each of the 30 disks in the Complete Geographic establishes, with indisputable clarity, the way in which the Society and the other defendants "transformed" the Greenberg photograph. They faded from another cover photograph into it, showed the original, and then altered one of the original photograph's distinctive features (the diver) by turning her from a horizontal to a vertical position so that Greenberg's photograph could be morphed into the cover photograph of a dancer, standing upright with a hand to the sky. The "transformation" thus impermissibly exceeded the bounds of fair use by utilizing the photograph to create an entirely new derivative work.

(iii) The Defendants' Use of the Greenberg
Photograph was for Commercial Gain

The Society acknowledged to the district court that copying which serves a commercial or profit-making activity is presumptively unfair, citing to Sony Corp. v. Universal City Studios, Inc., 464 U.S. 417, 448-49 (1984), and then argued at length that the presumption should not apply here. The commercial aspect here is clear: the

Complete Geographic product is being marketed by and for a for-profit subsidiary of the National Geographic Society. Below, the Society contended that it did not stand to gain from “exploitation of the copyrighted material,” borrowing a phrase from Harper & Row Publishers, Inc. v. Nation Enterprises, 471 U.S. 539, 562 (1985). But the Greenberg photograph is exploited expressly for the purpose of enhancing and making attractive each disk in the CD-ROM product. The photograph appears elsewhere in the product on the cover of the 1962 monthly magazine. Its additional use in the introductory sequence that appears on all 30 disks is the very definition of exploitive. And what of the commercial value of his photograph to Greenberg? Can it be seriously denied that such repetitive use of the photograph, every time a user opens a disk, diminishes its commercial value to him? Of course not. Defendants, by including Greenberg’s “scuba diver over a coral reef” photograph in the Moving Cover Sequence, have effectively cut off any chance that Greenberg might have had to license the photograph for some other use. That is, after all, the essence of what is not a fair use: a use that impairs the original author in reaping added value from his own original work.

(iv) The Society’s “Good Faith” Claim Has No Merit

The “good faith” argument made by the defendants below does not deserve to be dignified. The Society’s claim that fair use should apply because the cover had

previously been published, and so it acted in “good faith,” is not only unsupported in copyright law, but flies in the face of the written assignment back to Greenberg of all copyrights at issue here. R 1-25-Ex. B and Attach. It is reasonable to conclude that the Society would not be so casual about the “good faith” of others if its own treasured works were being exploited in the name of “fair” use. Moreover, it is hardly “good faith” – having reassigned the rights to Greenberg, and having received a written protest from him regarding republication – to ignore the protest, with no response, and to proceed with the republication.

(C) To Find “Fair” Use Here
Would Undermine the Doctrine

The Society’s Moving Cover Sequence, as noted above, did much more than simply borrow a photograph for some worthy social purpose. It distorted the photograph and merged it with others into a totally new work, with total disdain for the photographer who actually owns the rights to the photograph. The Society used Greenberg’s photograph, not for some elegant educational purpose, but to help sell the Complete Geographic product. This Court should reject any attempt by the Appellees to use the “fair use” doctrine, given the visually indisputable facts available in the CD-ROM product itself.

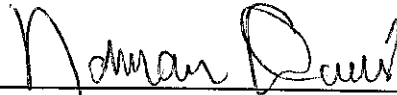
V.
CONCLUSION

With respect to the claim as to the Complete Geographic product, this Court should reverse the district court's grant of summary judgment to the Appellees and the district court's denial of the Appellants' cross-motion for summary judgment on liability. Because the factual record is adequate, and because the review is de novo, the Court should grant the Appellants' cross-motion for summary judgment on liability as a matter of law. The matter should be remanded to the district court for findings as to damages, with instructions to permit adequate discovery by the Appellants, and for other appropriate action.

With respect to the claim as to the Moving Covers Sequence, this Court should reverse the district court's grant of summary judgment to the Appellees and hold that the sequence constitutes a new derivative work. Because the factual record on that claim is not adequate as to fair use, the matter should be remanded to the district court for discovery and for other appropriate action.

Respectfully submitted,

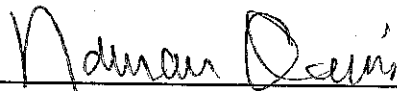
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CERTIFICATE OF COMPLIANCE


I hereby certify that this brief complies with the type-volume limitation set forth in Federal Rule of Appellate Procedure 32 (a) (7). The brief utilizes proportional spacing and consists of approximately 12,360 words.



Norman Davis

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing brief was served by hand on Edward Soto, Esq., Weil, Gotshal & Manges LLP, 701 Brickell Avenue, Suite 2100, Miami, FL 33131; and by Federal Express on Robert G. Sugarman, Esq., Weil Gotshal & Manges LLP, 767 Fifth Avenue, New York, NY 10153 this 20TH day of March, 2000.



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