

IN THE
UNITED STATES COURT OF APPEALS
FOR THE ELEVENTH CIRCUIT

Case No. 00-10510-C

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

BRIEF OF *AMICUS CURIAE*,
AMERICAN SOCIETY OF MEDIA PHOTOGRAPHERS, INC.,
IN SUPPORT OF PLAINTIFFS-APPELLANTS

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Greenberg v. National Geographic, Docket No. 00-10510-C

**Certificate of Interest and
Corporate Disclosure Statement**

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The Honorable Joan A. Lenard

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The *Amicus Curiae* has no parent companies, no subsidiaries and no affiliates that have issued shares to the public.

Plaintiffs:

Jerry Greenberg

Idaz Greenberg

Defendants:

National Geographic Society

National Geographic Enterprises, Inc.

Mindscape, Inc.

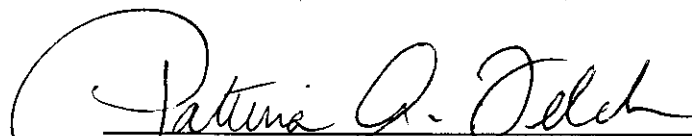

Patricia A. Felch

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STATEMENT OF INTEREST

The organization supporting this *amicus curiae* brief is:

The American Society of Media Photographers, Inc.

The American Society of Media Photographers, Inc., or ASMP, was founded in 1944 as the Society of Magazine Photographers. Its primary mission is to protect and promote the interests of professional photographers who earn their livings by making photographs for publication. ASMP is the largest organization in this country, or in the world, representing professional photographers who make photographs for publication in the various media. ASMP has approximately 6,000 members, most of whom are freelance photographers, who have been producing some of this country's best photography for publishers, advertising agencies and corporate clients for more than half a century. We estimate that there are over 100,000 freelance photographers with interests similar to those of our members in this country.

Counsel for the plaintiffs/appellants and the defendants/appellees have consented to this filing of this *amicus curiae* brief. Copies of consent letters will be filed with the Court.

SUMMARY OF ARGUMENT

If Congress had wanted to permit the National Geographic Society (“Society”) to re-use Plaintiff/Appellant, Jerry Greenberg’s (“Photographer”)’s original photographs, initially contributed to a particular issue of the National Geographic (“Magazine”), in an entirely “new anthology...or other collective work”, like the CD-ROM product, 108 Years of the National Geographic (“Complete Geographic”), Congress would not have forbidden expressly such a re-use. In the last sentence of the House Report, for the 1976 Copyright Act, specifically interpreting Section 201(c), Congress states that, regardless of what the rest of Section 201(c) might provide:

the publisher could not revise the contribution itself or include it in a new anthology or an entirely different magazine or other collective work.

H.R. Rep. 94-1476, at 122-23 (emphasis added). *See, infra*.

Those two expressly prohibited uses, however, are exactly what the Society made of the copyrighted photographs of Photographer, who created his photographs for first publication in various issues of the Magazine. Not only did the Society “revise” Photographer’s “Scuba Diver over a Coral Reef” photograph in the “Moving Covers Sequence”. *See, infra*. The Society and its co-defendants also re-used Photographer’s copyrighted photographs, without authorization, compensation or written agreement, throughout the “new anthology” or “other collective work, which

is exactly what the Complete Geographic is. *See, infra.*

Worse, the District Court erred in entering summary judgment for defendants/appellees by failing to understand the significance of the written re-assignments filed by plaintiffs during the summary judgment proceedings. The 1985 and 1989 re-assignments¹ established that the Society had re-assigned to Photographer “all rights”, including copyrights, in and to his photographs that were first published in the Magazine. Those re-assignments occurred long before the Society contracted with co-defendants, National Geographic Enterprises, Inc. (the Society’s for-profit subsidiary) (“NGE”) and Mindscape, Inc. (“Mindscape”), to create the CD-ROM product, “Complete Geographic”. Photographer even recorded the re-assignments with the Copyright Office (*see*, APPENDIX to Appellants’ Brief). Accordingly, the Society had no rights whatsoever to re-use Photographer’s photographs, much less any right to license them to NGE and Mindscape for commingling, with thousands of other photographs from 1,200 previous issues of the Society’s Magazine, in the Complete Geographic CD-ROM product. *See, infra.*

At a minimum, Photographer should have been granted summary judgment on the Defendants’ infringement of his re-assigned photographs, which Photographer registered or renewed with the Copyright Office in his own name, and for which

¹ One of the re-assignments was noted by the District Court (at page 4 of her May 14, 1998 order), albeit with the wrong date; and both the 1985 and 1989 re-assignments of all rights to Greenberg from the Society were attached as Exhibits to Plaintiffs’ Memorandum in Opposition to the defendants’ Motion for Summary Judgment and to Plaintiffs/Appellants’ brief

Photographer duly recorded the Society's written re-assignments in the Copyright Office. Given the Defendants' violations of the two prohibitions that Congress expressly delineated, moreover, Photographer should have been granted summary judgment for copyright infringement against all Defendants for their unauthorized uses of his copyrighted photographs in both the "Moving Cover Sequence" and the "Complete Geographic" CD-ROM product. *See, infra.*

ARGUMENT OF AMICUS CURIAE

The American Society of Media Photographers, Inc., *Amicus Curiae*, respectfully submits this brief in support of the appeal filed by Photographer, one of the Plaintiffs/Appellants in this case. The *amicus curiae* supports reversal of the District Court's order in *Greenberg v. National Geographic Society, et al.*, 97-3924, Order (S.D. Fla. May 14, 1998). The *amicus curiae* also supports a remand by this Court, with instructions to enter judgment in favor of Photographer.

I. INTRODUCTION²

Barbara Ringer, the Register of Copyrights at the time of the debates on the 1976 Copyright Act ("the 1976 Act"), wrote:

The new statute makes a number of fundamental changes in the American copyright system, including some so profound that they may mark a shift in direction for the very philosophy of copyright itself. Properly designated, the New Act is not a "general revision", but is as radical a departure as was our first copyright statute, in 1790.

Barbara Ringer, *First Thoughts on the Copyright Act of 1976*, 22 N.Y.L. Sch. L. Rev. 477, 479 (1977).

² The *amicus curiae* notes in its Summary of Argument above that this appeal should be resolved in favor of Plaintiffs/Appellants, because of the Society's re-assignments to Photographer of all of the "rights", including copyrights, in and to his Photographs. Nonetheless, the *amicus curiae* is well aware that its responsibilities to the Court are not to argue to case *sub judice*, but to assist the court by giving less case-specific analyses of the issues, in light of the applicable statutes and existing case law, as well as to advise the Court on how the trade and custom in the publishing industry may clarify the issues and how publishing industry participants may be affected by the Court's resolution of this case. Therefore, the *amicus curiae* will focus its brief on the laws pertinent to, and potential ramifications of, this Court's decision in this case.

Ms. Ringer concluded her article, by stating that the 1976 Act was enacted to:

break with a two-hundred-year-old tradition that has identified copyright more closely with the publisher than with the author.

Id. At 490.

Section 201(c), the clause of the 1976 Act which is placed at issue in this case of first impression for this Circuit, exemplifies this shift. See, APPENDIX to the brief of Plaintiffs/Appellants. By its express terms and, according to scholarly commentators and one other Circuit court (the U. S. Court of Appeals for the Second Circuit), the purpose of § 201(c) was to safeguard the rights of authors in their contributions to collective works. Unless collective-work publishers and authors entered into written transfers of rights, such publishers were limited to only three presumptive privileges to re-use authors' contributions. See, infra.

The premises and fundamental purposes of the 1976 Act and § 201(c), however, have been eviscerated by the District Court in this case in two ways. First, the District Court ignored the concessions and arguments made by the parties in their summary judgment motions and briefs and, instead, focused on only the second ("revision") presumptive privilege in the last-clause exceptions to the second-sentence exception in § 201(c). See, infra.

Second, the District Court relied on one of the lower court's opinions in Tasini v. The New York Times, et al., 922 F. Supp. 804 (S.D. N.Y. August, 1997) (hereinafter

referred to as Tasini), which has been reversed and remanded unanimously by the Second Circuit, with instructions to enter judgment in favor of the freelancers (writers of articles contributed to collective works, in that case. Tasini v. The New York Times, et al. ___ F.3d ___, 2000 Slip Op. 6749 (2d Cir. Feb. 25, 2000) (Amended Opinion, Docket Nos. 97-9181, 97-9650) (hereinafter referred to as Tasini II). See infra.

ASMP, the organization of freelance photographers supporting the appeal of the District Court's order, respectfully submits that the complete legislative history of § 201(c) of the 1976 Act contradicts the holdings of the District Court on appeal in this case. A copy of pertinent excerpts of the 1976 Act's Legislative History is attached to this brief as Appendix A. See also, infra.

More importantly, the effects of affirming the District Court will not merely strip freelance photographers of any meaningful rights in their original, copyrighted photographs contributed to collective works. Such an affirmance will also create a very destructive split in the circuits, leaving freelancers in the Second Circuit with rights to their own works and depriving freelancers in the Eleventh Circuit of the very rights that freelancers won in the Second Circuit. In this global communications era, such a split would render both freelancers authors and collective-work publishers, as well as electronic database producers, unable to rely, with any certainty, on their ownership rights in contributions to collective works. Confusion will reign. See, infra.

II. INTERESTS OF *AMICUS CURIAE*

ASMP, the *amicus curiae* which supports the Plaintiffs/Appellants' appeal of the District Court's May 14, 1998 order, represents a substantial number of freelance photographers in the United States -- in excess of 6,000 of them. Freelancers collectively produce an enormous amount of what we all see, read, hear and learn from, periodicals, encyclopedias and other collective works, as well as from radio, television and other electronic and communications media. Freelancers' creative materials are distributed around the world not only through collective works, but also to clients outside the publishing industry who then use freelancers' work in packaging, advertising and a multitude of other communications media.

By the very nature of their status as freelance photographers, the members of the ASMP earn their livings primarily from payments for works contributed to collective-work publishers and communications-media producers. Thus, any unauthorized, uncompensated re-uses of freelance authors' works jeopardize their very livelihoods.

Collective-work publishers used to usurp legally all rights freelancers might have had in their individual contributions to collective works, because the 1909 Copyright Act adhered to the ancient concept of "bundling" copyrights. If one right (*e.g.*, what is called a "first-publication right" in the custom and trade of the publishing industry) was sold by a freelancer photographer or other type of freelance author to a collective-work publisher, the publisher obtained all rights in the contribution. That is,

ownership of all copyrights in freelancers' works went to publishers by operation of law. For example, Theodore Geisel (a.k.a. Dr. Seuss) lost all of his copyrights in his cartoon figures by merely permitting their first publication in magazines. See, infra.

It was this unfairness that the 1976 Act sought to correct, both in general for individual authors (throughout the 1976 Act) and in specific for freelance photographers and other freelance authors (in § 201(c)). Indeed, § 201(c) was supposed to delineate what rights freelance authors retained, so that their retained rights in contributions to the learning, education and knowledge that emanate from collective works would be remunerative enough to nurture and sustain them. For example, freelance authors, who do not cede all rights to publishers, retain the rights to sell their creative works to: (1) other periodicals, encyclopedias, anthologies and other collective works (called "second-serial rights" in the custom and trade of the publishing industry); (2) on-line database, CD-ROM and other electronic producers (called "electronic rights" in the custom and trade of the publishing industry); and (3) communications-media producers for transformation into other types of creative works, such as radio, television, theatrical or motion picture versions of their works (called "subsidiary rights" in the custom and trade of the publishing industry, and "derivative works" under the 1976 Act (17 U.S.C. 101, definition of "derivative works"))).

Congress established a balancing of rights for freelance authors and limited presumptive privileges for collective-work publishers. See, 17 U.S.C. 201(c); see also, *infra*. It is this balancing that the District Court has destroyed.

According to Congress, the Defendants could not re-use Photographer's photographs in a "new anthology...or other collective work". See, *supra*, *infra* and Appendix A. Nonetheless, the District Court has condoned such conduct under the guise of the presumptive "revision" privilege, one of the three, limited exceptions to the exception delineated in the second sentence of § 201(c). See, *supra*, *infra* and Appendix A.

Accordingly, Jerry Greenberg and the other freelance photographers who are members of the *amicus curiae* have two interests in the appeal of this case. First, they have an economic stake in the "information age". If periodicals and their for-profit database producers (like the Society, NGE and Mindscape) are permitted to usurp freelance photographers' rights by amalgamating the freelance photographers' works into CD-ROM boxed sets, which are sold over the Internet and in stores to the public, then the freelance photographers will be denied a potential source of additional income from their creative work. That is, freelance photographers will be precluded from re-licensing "second-publication", "electronic" and "subsidiary" rights in their creative works, just because their original works were first published in collective works. That situation is exactly what § 201(c) was supposed to "fix".

After all, it is the freelance authors who provide a large portion of the “content” that we see, read, hear and learn from collective works. Without that freelance “content”, newspapers, periodicals, encyclopedias and other collective works would reflect only the views of the publishers, because the only authors would be employees of the publishers. That is not what the “fourth” estate is valued for in our local, regional, national or global culture. Diversity of ideas is the mainstay of American journalism, education and citizenship. Survival of freelance authors is essential to our well-being and democracy.

The second interest of the freelance photographers, who could be affected by this appeal, is in avoiding the chaos that could result from affirming the District Court’s order. If upheld, the *Greenberg* order will open the doors to any collective-work publisher who wants to pay others to produce electronic or non-electronic anthologies made up of freelance authors’ articles, photographs and graphics, in which the publishers and electronic producers have no rights and for which freelance authors have not been paid. *See, infra*.

More crucial is the potential for this Court’s affirmance to establish a split in the Federal Circuit courts that could destroy both the publishing industry and its mainstay source of “content”, the freelance authors. *See, infra*. The Second Circuit has already ruled in favor of freelance authors in *Tasini II* on the very issue presented in this case -- the scope of the second three-part presumptive-privilege clause in the second-

sentence exception to authors' vested rights under the first sentence of § 201(c).

Accordingly, the *amicus curiae* support conformity with the well-reasoned holdings in *Tasini II*, but would decry any affirmance of the District Court's order in this case. Such an affirmance would splinter the rule of law applicable to freelance authors, collective-work publishers and electronic product producers -- the entire publishing and communications industry -- by allowing in the Eleventh Circuit what the Second Circuit precludes.

III. THE SOCIETY, NGE AND MINDSCAPE ARE NOT PERMITTED, UNDER ANY OF THE THREE PRESUMPTIVE PRIVILEGES IN THE LAST CLAUSE OF § 201(C), TO REVISE OR COMMINGLE PHOTOGRAPHER'S PHOTOGRAPHS INTO THE CD-ROM PRODUCT, 108 YEARS OF THE NATIONAL GEOGRAPHIC.

Any interpretation of the presumptive privileges in the last clause of the second-sentence exception to authors' "vested" rights under § 201(c) must be consistent with the 1976 Act's fundamental purpose and the section's component parts. A statute must be construed "in conformity with its dominating general purpose,...in the light of its context and [so that] the meaning of the words [is consistent with]...the generally expressed legislative policy." S.E.C. v. C.M. Joiner Leasing Corp., 320 U.S. 344 (1943).

The District Court failed to follow this rule. Accordingly, this Court should reverse the lower court's order by interpreting § 201(c)'s presumptive privileges in a manner which protects Photographer's vested rights, in keeping with the objective of

§ 201(c)³, the purpose of the 1976 Act and the over-all intent of the Act as a whole.

A. The 1976 Act Was Enacted to Protect Authors' Exclusive Rights in Their Creations.

Barbara Ringer's article establishes the fundamental purposes of the 1976 Act.

See, supra.

1. Without Written Contracts, Authors' Rights Under the 1909 Act Were Automatically Ceded to Publishers.

Under the 1909 Act, unless there was a contract stating otherwise, authors lost all of their then-indivisible copyrights in creative works submitted for publication in "composite works". If any one of an author's copyrights was transferred, all were.

The most poignant example of this injustice is the "Dr. Seuss" case. Geisel v. Poynter Prods., Inc., 295 F. Supp. 331 (S.D.N.Y. 1968). The Geisel court held that, lacking any agreement to the contrary with the magazine publisher, Dr. Seuss transferred all rights (the entire bundle of then-indivisible copyrights) in his cartoon characters to the magazine publisher. Id. at 344. The cartoonist had sued manufacturers of three-dimensional dolls, which were derived from his two-dimensional cartoon characters, for copyright infringement. Despite expert testimony about the custom and practices in the magazine publishing industry, the court applied the 1909 Act's Doctrine of Indivisibility of Copyrights and found that Dr. Seuss had

³ Because only the Second Circuit has interpreted the meaning and scope of § 201(c)'s second-sentence terminology (in Tasini II), this is a case of first impression for this Circuit.

ceded all copyrights in his cartoon characters to his publisher by not reserving any rights in writing. As a result, Dr. Seuss had no standing to sue the doll-makers for copyright infringement, and the court denied him any relief at all.

The decision of the District Court in this case imposes precisely the same harsh result on Photographer under § 201(c) the 1976 Act that was reached by the Geisel court under the 1909 Act. The District Court has effectively resuscitated the indivisibility-of-copyrights doctrine by denying Photographer any relief at all for the unauthorized exploitation of his copyrighted and re-assigned photographs by the Society, NGE and Mindscape. Without investigating the objective of § 201(c) and the over-all intent of the 1976 Act, the District Court found the Defendants' anthologies to be "revisions", relying on the lower-court opinion in Tasini. That opinion, however, has since been reversed and remanded with instructions to enter judgment in favor of the freelance writers, in Tasini II.

The 1976 Act was supposed to be a "radical departure" from the 1909 Act and was supposed to protect authors' rights. See Ringer, supra; see also, Appendix A, passim. The District Court, however, has permitted Defendants to usurp Photographer's copyrights in his photographs. In doing so, the District Court stripped Photographer of all meaningful "retained" rights and condoned the Society's, NGE's and Mindscape's unfair exploitation of Photographer, just as Dr. Seuss had been exploited under the 1909 Act.

2. The Language of § 201 and Related Provisions of the 1976 Act Reveal A Statutory Scheme Intended to Protect Authors' Rights in Their Contributions to Collective Works from Publisher Exploitation.

In drafting § 201, Congress established a statutory scheme which radically changed the balance between authors' rights and publishers' privileges regarding ownership of copyrights. Section 201(a) initially vests in the author, *i.e.*, Photographer, the copyrights in his works. 17 U.S.C. § 201(a). With identical language, the first sentence of § 201(c) clearly establishes that copyrights in contributions to collective works "vest initially in the author of the contribution." 17 U.S.C. § 201(c)(first sentence). To protect these vested rights, Congress enacted § 201(d) to confirm the repudiation of the 1909 Act's indivisibility-of-copyrights doctrine by providing for transfers of author's copyrights, in whole or in part. 17 U.S.C. § 201(d). The "rights" or "copyrights" referred to in these sections -- all applicable solely to freelancers like Photographer -- are the exclusive rights provided in § 106: (1) to reproduce his photographs in copies; (2) to prepare derivative works based on his photographs; (3) to distribute copies of his photographs; (4) to allow his photographs to be read, copied and downloaded by the public; and (5) to allow his photographs to be displayed on computer terminals for the public. 17 U.S.C. § 106 ("§ 106 rights"). According to § 201(a), 201(c) and 201(d), these exclusive rights are vested in the original author, *i.e.*, Photographer.

To correct the imbalance of powers between authors and publishers under the 1909 Act, Congress approved these broad grants and vesting of exclusive rights in authors, but “evened the playing field” by way of providing limited exceptions for publishers. For example, § 201(b) provides a “work-made-for-hire” exception to authors’ § 201(a) copyright ownership, so that employers may control the copyrights of their employees. Sections 107-120 are exceptions, in general and for specific industries, to authors’ § 106 rights.

In accordance with the 1976 Act’s statutory scheme, statutory exceptions must be construed narrowly. See In re Parr Meadows Racing Ass’n, Inc., 880 F.2d 1540, 1547 (2d Cir. 1989) (“Statutory exceptions to the automatic stay are to be interpreted narrowly and in accordance with its underlying rationale.”).

The second sentence of § 201(c), which is the exception to the first sentence, and is very limited, states:

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

17 U.S.C. § 201(c). Under this exception, collective-work publishers do not even obtain “rights”. They obtain merely a presumption of “privileges” and only when “an express transfer of copyright or any rights under it” from or to an author does not exist.

17 U.S.C. § 201(c) Thus, if there is no written agreement about re-use rights for a

contribution to a collective work, the publisher is limited to “reproducing and distributing the [author’s] contribution as part of”:

- (1) that particular collective work;
- (2) any revision of that collective work;⁴ and
- (3) any later collective work in the same series.

17 U.S.C. § 201(c).

In the instant case, of course, there were two express transfers: the 1985 and 1989 re-assignments -- of all “rights”, including copyrights, in and to all of Photographer’s photographs that he had submitted for first publication to the Society -- from the Society to Photographer. See, Exhibits to Plaintiff’s Memorandum in Opposition to Defendants’ Motion for Summary Judgment and APPENDIX to Plaintiffs/Appellants’ brief. Accordingly, the presumptive privileges in the last clause of the second sentence of § 201(c) do not apply in this case.

Even if the privileges were available to Defendants, to the extent collective-work publishers own any presumptions at all under § 201(c), publishers’ permitted re-uses are very limited. For example, a copyright in a compilation, which includes a collective work, or a derivative work “extends only to the material contributed by the author of

⁴ The common dictionary meaning of the noun “revision” is “an act of revising”, and the verb, to “revise”, derives from the French “reviser” and Latin “revisere” meaning to look at or see again, with the English definition being “1. to look over again in order to correct or improve [or] 2. to make a new, amended, improved, or up-to-date version of”. Webster’s New Collegiate Dictionary 992 (1977).

such work, as distinguished from the preexisting material employed in the work, and does not imply any exclusive right [i.e., § 106 rights] in the preexisting material.” 17 U.S.C. § 103(b).⁵ As such, a publisher’s collective work copyright is limited to only the material contributed by the publisher -- such “selection, coordination and arrangement” as is original and copyrightable, along with works made for hire -- and does not include a freelance photograph unless its rights are transferred expressly in writing. See Feist Publications v. Rural Tel. Serv. Co., 499 U.S. 340, 356-58 (1991); 17 U.S.C. § 201(c). Here, the rights were transferred -- not from Photographer to the Society, but *vice versa*.

The language of § 201(c) establishes that Congress’ intent was to safeguard the rights of authors, while limiting collective-work owner’s privileges and the formats in which those privileges can be exercised. The House Report confirms that § 201(c), “under which the privilege of republishing the contribution under certain limited circumstances would be presumed, is an essential counterpart of the basic

⁵ Section 101 defines the meanings of key words used in the first sentence of § 201(c) and § 103(b):

(1) a “collective work” is a work, such as a periodical issue, anthology, or encyclopedia, in which a number of contributions, consisting of separate and independent works in themselves, are

assembled into a collective whole;

(2) [the term “compilation” includes collective works; and

(3) a “compilation” is 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.

17 U.S.C. § 101.

presumption” of preserving the original author’s copyright in the contribution. See Appendix A, 1976 House Report at 14 (emphasis added).

B. The Society’s Republishing in the Complete Geographic of Photographer’s Photographs, Which Were Originally Contributed To a Particular Issue of the Magazine, Is Not Publishing Them “In That Part Particular Collective Work,” in “Any Revision of That Particular Collective Work” or “In Any Later Collective Work in The Same Series”.

Attorneys for the parties in this case never argued below about whether the Defendants’ re-use of Photographer’s copyrighted and re-assigned photographs fell within the “revision” privilege. Defendants conceded that the CD-ROM product was not a “revision.” Nevertheless, the District Court found that the Complete Geographic was merely a “revision” of 1,200 separate issues of the Magazine. Nor did the parties argue below about whether the Complete Geographic was a “later collective work in the same series”. Despite the District Court’s holding, those two claims were waived.

1. The Complete Geographic is Not “That Particular Collective Work”.

Instead, Defendants argued to the District Court that the Complete Geographic was “that particular collective work”, thus, falling within the first presumptive privilege in the three-part list of exceptions to the second-sentence exception. “That particular collective work” must mean the original periodical to which a freelance author’s work is contributed. See, *Tasini II*, Slip op. at 6758. Here, for example, “that particular collective work” would be the July, 1962 issue of National Geographic

Magazine, in which Photographer's "scuba diver over a coral reef" photograph was first published.

As counsel for the Plaintiffs/Appellants has painstakingly detailed in his appellants' brief, the Complete Geographic has so many additions, re-arrangements, re-selections and other alterations that it could not possibly be considered "that particular collective work". More importantly, the huge 30-disc boxed-set re-compilation of 1,200 issues of the Magazine, covering 108 years, is certainly not the "particular" work to which Photographer originally agreed to contribute his photographs and is not the "particular" work for which he was paid to make photographs. To argue that a 1997 CD-ROM re-compilation, published some 20-30 years after Photographer created his photographs and they were published in a collective work, is "that particular collective work" is nonsense.

Nor does the Complete Geographic constitute a "reprint" or a mere "binding", as argued by Defendants below. To be such, it would have to contain exact copies of each issue of each exactly reproduced Magazine, albeit digitalized. The CD-ROM box, however reveals the following alterations: maps that were in the original issues of the Magazine have been excised; inter-active features have been added; everything is in English, despite the Magazine's multi-lingual editions; and included materials are "not representative of any particular issue" -- again, an admission against interest by Defendants. Too much of what was in the original, individual Magazines has been

changed, re-selected, de-selected and re-constituted in the Complete Geographic. See, the CD-ROM boxed set, which has been proffered to this Court.

2. The Complete Geographic is Not a Revision of Any “Particular” Issue of the Magazine.

As the *Tasini II* court held, in reversing the *Tasini* opinion on which the District Court here relied, the lower court’s expansive interpretation of the term “revision” renders that term meaningless, when juxtaposed to the other two presumptive privileges in the last clause of § 201(c). A “revision” of a periodical cannot constitute a database in which thousands of articles (here, photographs) are commingled from thousands of individual issues of a periodical. To allow “revision” such a broad scope permits an exception (in the last clause of the second sentence of § 201(c)) to the exception (in the first clause of the second sentence of § 201(c)) to “swallow the rule” of the first sentence of § 201(c) -- which “vests” copyrights in the original creator of the contributed work, here, Photographer. *Tasini II*, Slip op. at 6760.

3. The Complete Geographic is Not a “Later Collective Work in the Same Series”.

Nor could the Complete Geographic be considered a “later collective work in the same series”. In the first place, the CD-ROM set is entitled: The Complete Geographic: 108 Years of the National Geographic. That is a new title, even though the new title includes the words, “National Geographic”. At worst, “National Geographic” refers to the Society; and, at best, the term “National Geographic” is an

ambiguous reference either to the Society or to its Magazine. Indeed, as the “Moving Covers Sequence” establishes, the National Geographic periodical was once called a “journal” -- perhaps suggesting the Society’s non-profit status. Later, it became known as the National Geographic Magazine. Either way, the inclusion of the term “National Geographic” does not change the fact that the primary title for the CD-ROM collection is The Complete Geographic. That title, itself, takes the CD-ROM product out of the “same series” exception.

Moreover, as Appellants’ counsel has detailed in Appellants’ brief, the Society did not register The Complete Geographic CD-ROM product as another issue in the same series as the National Geographic Magazine. To the contrary, the Society’s 1998 VA registration certificate for the Complete Geographic is a copy of the Society’s application, which was verified as to its accuracy. The Certificate establishes that the Society claimed it had not registered any of the part of the Complete Geographic prior to filing the application. That is, the Society answered “no” to Section 5’s question about whether the work had ever been registered previously, even though the Society registered all of its individual issues on TX forms, identifying them as “serials”. That it used a VA form for the CD-ROM product and TX forms for individual issues is, itself, an admission that the Complete Geographic is not a “later collective work in the same series”.

CD-ROM products, like the Complete Geographic, are not “that particular collective work”, are not “a revision of that particular collective work” and are not “a later collective work in the same series”.

C. The Limited Privileges of § 201(c) Do Not Authorize or Encompass the Creation of New Anthologies, New Collective Works or Derivative Works.

A CD-ROM boxed set, like the Complete Geographic, does not retain any vestiges of the original selection, coordination and arrangement apparent in any one “particular” issue of a periodical from whence the Photographer’s copyrighted photographs came. CD-ROM boxed sets are more like anthologies or other collective works, but “new” anthologies and “other collective works” are specifically excepted from publishers’ presumptive privileges by Congress in the 1976 House Report. See Appendix A, 1976 House Report, at 14. That is, the Society may not exercise any § 201(c) privileges in a manner that results in “new anthologies, entirely different magazines or other collective works.” Id.

Indeed, according to Defendants’ summary judgment filings, they admitted that they “transformed” Photographer’s copyrighted photographs in the CD-ROM product (albeit in arguing that they met a “fair use” test). They obviously did so with Greenberg’s “scuba diver over coral reef” photograph. See, infra. By their very nature, though, CD-ROM sets are derivative works, *i.e.*, complete transformations of individual issues and photographs taken out of their original contexts and commingled

into huge reservoirs of single, edited issues of magazines and photographs, accessible photograph-by-photograph depending on a user's needs. If the Society had the rights to every photograph in its individual issues of the Magazine, then there would be no problem with the transformations made in connection with the creation of the Complete Geographic. But that is not the case here.

1. The Complete Geographic Is a New Anthology, Expressly Excluded by Congress from Publishers' § 201(c) Privileges.

The Complete Geographic at issue in this case is a "new anthology". An anthology is defined as a "collection of literary pieces of varied authorship." The American College Dictionary 52 (1964); see also The New Columbia Encyclopedia 116 (1975). The fact that Defendants have issued yearly up-dates of the Complete Geographic each year since its introduction in 1997, confirms that the Defendants' CD-ROM sets become "new anthologies" each time they are updated with added photographs.

The conclusion that the Defendants' Complete Geographic is a new anthology finds support in the express language of the definition of "collective works." The word "anthology" is one of three examples expressly included in the 1976's Act's definition of collective works. 17 U.S.C. § 101 (defining "collective work").

The 1976 House Report on § 201(c), however, expressly excludes "new anthologies" from publishers' privileges:

Under the language of this clause[,] 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 revise the contribution itself or include it in a new anthology or an entirely different magazine or other collective work.

See Appendix A, 1976 House Report at 14. Therefore, Congress knew it was excluding a particular type of collective work that Congress defined as an example of a collective work. Congress specifically limited publishers' privileges by preventing them from overstepping the boundaries of the § 201(c) privileges by creating "new anthologies". See, *Tasini II*, Slip op. at 6759.

As such, § 201(c)'s legislative history provides exceptions to the statutory exceptions in the second sentence of § 201 (c) to the rule in the first sentence of § 201(c). An exception in the legislative history to an exception within a statute must be construed very narrowly. See *Israel-British Bank (London), Ltd. v. F.D.I.C.*, 536 F.2d 509, 512-13 (2d Cir. 1976). Instead of construing the § 201(c) "revision" privilege very narrowly, the District Court turned the exception into the rule.

2. Under § 201(c), a "Revision" of a Collective Work Cannot Result in an Unauthorized Derivative Work.

A derivative work is one that:

is based upon one or more preexisting works, such as a translation, musical arrangement, dramatization, fictionalization, motion picture version, sound recording, art reproduction, abridgement, 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 (emphasis supplied). The "forms" in which Photographer' copyrighted photographs in this case were "recast, transformed, or adapted" are both in the whole Complete Geographic, as well as in the Moving Covers Sequence.

Section 201(c) does not permit Defendants to make derivative works out of Photographer' contributions to individual issues of the Society's Magazine. One of Photographer' vested § 106 rights is to preclude others from making derivative works out of Photographer' works. 17 U.S.C. § 106(2). According to the Defendants' own admissions, they "transformed" Photographer's works in the Complete Geographic. All "transformations" of creative works -- whether they commingle one of Photographer's individual photographs from a 1970 issue of the Magazine with thousands of others, or there is actual alteration of a particular photograph (as in the Moving Covers Sequence) -- result in "derivative" works and, thus, infringe Photographer' copyrights.

D. The District Court's Reliance on the Now-Overruled *Tasini*, Interpreting the Term "Revision" So Broadly, Was Misplaced.

In finding that the term "revision" in § 201(c) was so broad that it encompassed newly created CD-ROM anthologies, the District Court ignored the juxtaposition of rights for Photographer and presumptive privileges for the Society. Indeed, the District Court disregarded the words of the statute and misconstrued the specific term

“revision” in a manner inconsistent with the over-all intent of the 1976 Act.

When interpreting a statute, especially in a case of first impression, a court must construe the entire section of the statute and not merely focus on an isolated word, phrase or provision. See Gustafson v. Alloyd Co., 513 U.S. 561 (1995). The District Court’s short analysis of the second sentence of § 201(c) focuses on the word “revision” and defines it as the lower court did in the now-reversed Tasini -- without regard to its meaning within the context of § 201(c) as a whole, within the context of § 201 as a whole or within the context and purpose of the 1976 Act as a whole.

As detailed in the Legislative History Excerpts in Appendix A, though, the debates, compromises and resulting choices of language are persuasive. See Mills Music, Inc. v. Snyder, 469 U.S. 153, 173 n. 40 (1984) (relying on the 1976 Act’s House Report as “certainly persuasive legislative history”). A review of the history makes clear that the presumptive privileges were intended to be limited not only in scope, but also in application. Section 201(c) evolved from a “constructive trust” concept, through a bare “first publication right”, through an ambiguous “any revision of it” definition, to the language which appears in § 201(c) to this date. See, Appendix A, *passim*.

The testimony of Irwin Karp is particularly pertinent to this case. During hearings, he stated that “reputable” publishers re-assigned any and all rights, except the right of first publication, to authors of works contributed to collective works

(Appendix A, 1962 Debates, at 2-4). The Society, after all, did reassign all of the rights, including the copyrights back to Photographer in 1985 and 1989, long before it even contemplated the Complete Geographic.

The long and detailed history of the 1976 Act supports Photographer's basic claims: that all copyrights in his photographs contributed to individual issues of the Society's Magazine were vested in him. The Complete Geographic is not a mere "revision." It is a "new anthology," excluded by Congress from publishers' § 201(c) privileges. Defendants overstepped the boundaries established by Congress by licensing Photographer's copyrighted photographs for inclusion in the "new anthologies" produced by Defendants. That is blatant copyright infringement, despite the District Court's ruling.

IV. THE "MOVING COVERS SEQUENCE", WHICH APPEARS AT THE BEGINNING OF EACH AND EVERY CD IN THE "COMPLETE GEOGRAPHIC", IS A DERIVATIVE WORK AND, THUS, AN INFRINGEMENT OF PHOTOGRAPHER'S COPYRIGHTS.

In the "Moving Covers Sequence", the Society apparently wanted to show samples of cover photographs originally published in the Magazine. What the Magazine did, though, is alter the original cover photographs so that they appeared to metamorphose from one to another. For example, in the beginning of the sequence of cover photographs is a cover photograph of a sailing ship at sea, which videographically fades into Photographer's original 1962 cover photograph of a scuba diver swimming over coral and looking at a spotted fish, which then fades and is

videographically changed so that the diver appears to be floating upwards, from a horizontal position to a vertical one, thus, meshing into another cover photograph of a dancer standing and reaching to the sky.⁶ Each of these images (original cover photographs and their alterations), it must be emphasized, appears within the golden edges identified with the Magazine and with the title, "National Geographic", in its prominent place on the top of each image, giving the ultimate impression that each image is actually an exact copy of a Magazine cover page. Photographer did not grant the Society any right to alter his original photograph of the scuba diver; and Congress forbade such a revision in the final House Report. See, Appendix A, 1975 House Report at p. 14. That revision by the Society is, thus, a violation of § 106(2) of the Copyright Act (establishing an author's "exclusive rights ... to make derivative copies" of a copyrighted work).

More importantly, the Society re-assigned all copyrights in that particular photograph to Photographer. See, Exhibits to Plaintiffs' Memorandum in Opposition to Defendants' Motion for Summary Judgment and APPENDIX to Plaintiffs/Appellants' brief. Accordingly, the Society had no rights whatsoever to re-use his photographs in any manner, much less in a derivative work, or to re-license his photograph to the co-defendants. See, e.g., Prince v. Clare, 67 B.R. 270, 273 (N.D.

⁶ The sequence in fast-speed computers appears to be of three distinct cover photographs, because the metamorphosis occurs so quickly. This description, however, can be verified by enabling a window-by-window segmentation of the Moving Covers Sequence, through software, or by viewing the beginning of the each CD with a slow computer.

Ill. 1986).

On this point, the Defendants argued below that their preparation of the Moving Covers Sequence may have resulted in a derivative work, but that their use was *de minimis* and a “fair” use. A derivative work that appears on every single one of the 30 CDS in the Complete Geographic is not *de minimis*; and counsel for Plaintiffs/Appellants has thoroughly decimated Defendants’ fair-use claims.

V. AN ELEVENTH CIRCUIT DECISION, IF INCONSISTENT WITH THE SECOND CIRCUIT’S, WILL WREAK HAVOC IN THE PUBLISHING INDUSTRY.

In the Second Circuit, publishers are liable for not obtaining authorization from freelance authors and for not compensating freelance authors for re-licensing their works to electronic database and CD-ROM producers. An opposite holding in this case would render the same publishers not liable for infringing freelance authors’ copyrights in the Eleventh Circuit.

Affirming the District Court in this case will result in publishers’ total lack of control over their own liabilities, as well as freelance authors’ continuing rights to sue publishers and database producers. It is important to understand that, while many publishers began obtaining “all rights” agreements from freelance authors shortly after the *Tasini* case was filed in 1994, most collective-work publishers and freelance authors entered into hand-shake agreements prior to that time, thus, leaving those publishers in a huge class of infringers. Some other publishers tailored their freelance-

author agreements to deal with § 201(c)'s presumptive privileges, but did not pay freelance authors under their agreements to re-license freelancers' works for inclusion in databases and CD-ROM products, with hopes that the *Tasini* defendants would prevail. Still other publishers have operated always on a hand-shake basis, even after 1994, thus, leaving themselves potentially liable to every freelance author whose work they published and then re-licensed to other collective-work publishers, as well as database and CD-ROM producers.

There may be a three-year statute of limitations on how much in damages each freelance author could be entitled to, but the infringement is continuing with each update and log-on to a database and with each update and sale of a CD-ROM product. Accordingly, there is no end to how long freelance authors will continue to be able to claim copyright infringement and entitlement to all of the Copyright Act's statutorily provided remedies against publishers and their sub-licensees. Moreover, those publishers that re-licensed freelance authors' creative works -- in which the publishers had no rights, but for which the publishers indemnified their sub-licensees -- could be held liable not only to freelance authors, but also to the database and CD-ROM producers.

By ruling consistently with the Second Circuit, on the other hand, this Court will be in the position of confirming the rights expressly reserved to freelance authors and limiting the publishers to the presumptive privileges established in § 201(c). This

Court will also be in the position of entering an order which will be consistent with the purposes and spirit of the 1976 Copyright Act. Finally, this Court will confirm the standard set in *Tasini II*, a standard which should be the law of the land.

CONCLUSION

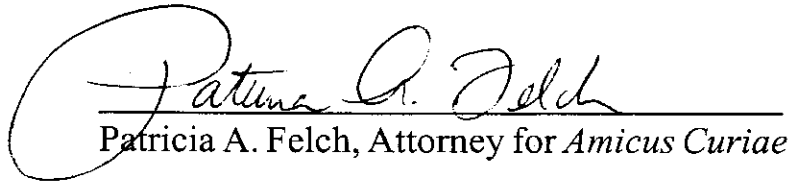
The District Court's order should be reversed, mainly because the Society re-assigned in writing of all of the photographs that Photographer created for first publication in the Magazine. In addition, Photographer renewed and/or recorded those assignments. He owns all of the copyrights in his photographs, and so the Defendants had no rights whatsoever to re-use them in the Complete Geographic. The Society's express transfers to Photograph take his case out of the reach of § 201(c) of the 1976 Copyright Act.

Even if this were not the status of copyright ownership, Defendants have violated Photographers' copyrights by commingling his photographs, along with thousands of others, into the Complete Geographic. That work is either a "new anthology...or other collective work", both of which are expressly prohibited as forms in which collective-work publishers like the Society can exercise their presumptive privileges under § 201(c) of the 1976 Copyright Act.

In the Moving Cover Sequence, moreover, Defendants have admitted that they "transformed" Photographer's photograph of the "scuba diver over coral reef" to fit it into the Society's "iconic" representation of the contents of the Complete Geographic.

Respectfully submitted by:


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Certificate of Compliance with Fed. R. Civ. Proc. 32(a)(7)(B)

I, Patricia A. Felch, an attorney, certify that this brief complies with the type-volume limitations provided in the Rules of the United States court of Appeals for the Eleventh Circuit, by containing -- other than such words as appear in brief sections where word counts are not required -- less than 7,000 words, half of the word limit for Plaintiffs/Appellants.



Patricia A. Felch


Certificate of Service

I, Patricia A. Felch, an attorney, certify that I have caused to be served the requisite number of copies of the **BRIEF OF AMICUS CURIAE, THE AMERICAN ASSOCIATION OF MEDIA PHOTOGRAPHERS, INC., IN SUPPORT OF PLAINTIFFS/APPELLANTS**, by placing them in pre-stamped, pre-addressed envelopes, which were then deposited in the postal box of the United States Postal Service in Ten South Wacker Drive, Chicago, Illinois, to:

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Miami, FL 33131-2398

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Weil, Gotshal & Manges, LLP
767 Fifth Avenue
New York, NY 10153

on this 22nd day of March, 2000.


Patricia A. Felch



APPENDIX A
LEGISLATIVE HISTORY EXCERPTS

1961 DRAFT

As introduced in 1961 by Abraham L. Kaminstein, then the Register of Copyrights, the Copyright Office recommended that:

[t]he statute should provide that copyright may be secured by the author or his representatives, successors, or assigns, except that-

(a) In the case of a work made for hire (defined as a work created for an employer by an employee within the regular scope of his employment), the employer should have the right to secure copyright.

(b) In the case of a periodical, encyclopedia, or other composite work containing the contributions of a number of authors, the publisher should have the right to secure copyright. The copyright secured by the publisher in the composite work as a whole should cover all of the contributions not separately copyrighted; but the publisher should be deemed to hold in trust for the author all rights in the author's contribution, except the right to publish it in a similar composite work and any other rights expressly assigned.

Register of Copyrights for the House Comm. on Judiciary, 87th Cong., 1st Sess.,

Copyright Law Revision 88 (Comm. Print 1961) (hereinafter "1961 Report").

1961 REPORT

The 1961 Report explains the recommended language, as follows:

When the component parts of a composite work are created by the publisher's employees, the publisher acquires the rights in each part as employer. But when the component parts are contributed by independent authors, each author is the initial owner of his contribution, and the publisher must acquire his rights by assignment.

However, the author of a contribution may not have assigned all of his rights to the publisher. And in some cases there is no express agreement between them as to the assignment of rights. We propose that the rights not assigned should be held by the publisher in trust for the author. And in the absence of any express agreement, only the right to publish the contribution in a composite work like that of the publisher should be deemed to have been assigned.

Id. at 87.

1962 DEBATES

During a January 24, 1962 debate on that recommendation, Barbara Ringer, then the Assistant Register of Copyrights, explained that the report:

recommends that the publisher should have the right to secure copyright in the work as a whole. Bear in mind, this is leaving aside the entire question of notice. This involves ownership only. With respect to the ownership of contributions to composite works, the report recommends that this very nebulous question be clarified, and that the publisher would be deemed...

to hold in trust for the author all rights in the author's contribution, except the right to publish it in a similar composite work, and any other rights expressly assigned.

Register of Copyrights for the House Comm. on Judiciary, 88th Cong., 1st Sess., Copyright Law Revision, Part 2 144 (Comm. Print 1963).

Mrs. Harriet Pilpel (a representative of magazine authors and photographers) objected to the proposed language -- "in the absence of any express agreement, only the right to publish a contribution in a composite work like that of the publisher should

be deemed to have been assigned". She argued that all writers give "to a publisher [is] the right to include his contribution in *that particular composite work*. There is no presumption that he gave more than that. And, indeed, in my experiences, most authors do not give any more than that, except when the buyer says, 'We are buying all rights, or these rights'." Id. at 151. Under the language as phrased, she argued, the author would be deemed to have "assigned" all of his rights in the contribution to the publisher with only the first right to publish the contribution, thus, denying the author any rights to submit the contribution to other composite-work publishers. Id. at 152.

Mr. John Schulman, then the Chairman of the American Patent Law Association Committee on Copyright, recommended instead of all the "hard and fast rules" appearing in the 1961 Copyright Office's recommendations that presumptions be established:

I think that if we thought in those terms, that certain presumptions are created from certain transactions but that they are nevertheless rebuttable presumptions, I think we'd find greater agreement on some of these protective provisions.

Id. at 152.

Mr. Irwin Karp, then a representative of the Authors League of America, agreed with both Mrs. Pilpel and Mr. Schulman:

I think that it would simplify matters from the point of view of the author, the publisher, and anybody who is taking rights from the publisher,

if the line of presumption were made clear. In other words, I see no objection to saying that, where a short story is published in a magazine, it should be presumed that the publisher has acquired only the first serial right, or first magazine right, or whatever you call it -- the right to publish in that edition -- and that, in the absence of a specific assignment of other rights by the author in writing, recorded, no one would be free to presume that the publisher owned anything else, and would have to deal with the author.

If the publisher wanted more, and the author were willing to give more, then they would do it by means of a specific assignment of other rights, which the publisher would then have available to record and to show to anybody who was going to deal with him with respect to these other rights. And I think the same should hold true in the case of a composite work.

Id. at 152-53.

Mr. Sydney A. Diamond, then of London Records, clarified:

I would just like to note my general agreement with what Irwin Karp and Harriet Pilpel said about this, and to point out that I think the whole difficulty in this particular recommendation is the reference to a "similar composite work." Perhaps the basic intention really wasn't quite that, but was meant to apply to "that particular composite work." I think everyone would agree, then, that that was a desirable rule.

Id. at 153.

Mr. Horace S. Manges, then of the American Book Publishers Council, questioned what happens:

if there is a revised edition of the composite work and some of the selections are omitted. Is that a composite work like that of the publisher, as referred to?

To which Irwin Karp responded:

No, I would assume not. But you can protect yourself by adding to your voluminous contract another clause which says-

the publisher shall have the right to publish revised editions of this composite work, eliminating some of the contributions.

Id. at 153. The result of these debates was the 1963 "preliminary draft" by the Copyright Office of a revised Copyright Law.

1963 BILL

Taking into account the debates quoted above, the 1963 preliminary draft of a revised Copyright Act defined the rights in contributions to collective works, then identified as Section 14(d), as follows:

Contributions to Collective Works. Copyright in each separate contribution to a collective work -- a work, such as a periodical issue of encyclopedia, combining the separate contributions of various authors into a collective whole -- shall be distinct from copyright in the collective work as a whole, and shall vest initially in the author of the contribution. The owner of copyright in the collective work shall, in the absence of an express transfer of the copyright or of any exclusive rights under it, be presumed to have acquired only the privilege of publishing the contribution in that particular collective work.

Staff of House Comm. on Judiciary, 88th Cong., 2d Sess., Copyright Law Revision, Part 3 15 (Comm. Print 1964).

1963 DEBATES

During June 11, 1963 debates on that draft, Abe A. Goldman, then the Copyright Office's General Counsel, reported:

Section 14(d) deals with the special case of ownership of contributions to a collective work. The first sentence states the principle that the copyright in a contribution is distinct from the copyright in the collective work as a whole, and that the usual principle that copyright ownership begins in the author (see § 14(a)) applies to the contribution. That is, the author of the contribution is initially the owner of the rights in the contribution.

The second sentence deals specifically with the question of ownership as between the author of the contribution and the copyright owner -- normally the publisher -- of the collective work as a whole, in the absence of an express agreement between them. In the [1961] Report it was recommended that, in this situation, the publisher of the collective work would be presumed to have the right to publish the contribution in his particular collective work, and in any similar collective work.

In the course of our previous discussions of that question, strong arguments were made that there should not be a presumption of transfer of ownership, in the absence of any express transfer, of the right to publish the contribution in a similar collective work. We have adopted that argument, and the second sentence provides now that, in the absence of an express transfer of the copyright or an express transfer of any particular exclusive right under it, it would be presumed that the copyright owner of the collective work would have acquired only the privilege of publishing the contribution in his particular collective work. The only other right he [the publisher] would acquire would be any that were transferred to him expressly.

Id. at 257-58.

Mr. Alfred H. Wasserstrom, then a representative of the Magazine Publishers Association, argued that the current custom and practice in the magazine industry was for the publisher to register the copyright in the collective work and hold the copyright in trust for the author of a contribution. He complained that the wording of § 14(d) would change that custom. Id. at 259.

Copyright Office General Counsel Goldman responded: "would your concern be laid to rest, Mr. Wasserstrom, if ... a provision that copyright stems from the author, but that the publisher of the periodical, by agreement with the author and by transfer from the author, could secure whatever rights they contract for in the transfer? Wasserstrom replied, "Well, I think it would go a long way toward clarifying my objection to the way subsection (d) is presently worded", but objected to the use of the word "express" in connection with transfers. Id. at 259-60.

Mrs. Bella L. Linden, representing the American Textbook Publishers Institute, then raised the same question about revisions that Mr. Manges had asked during the 1962 debate on the Copyright Act's 1961 proposal:

The addition of the word "particular" [*i.e., that particular collective work*] raises in my mind the question as to whether revisions of that collective work would be "that particular work" -- whether a volume containing only half of the material in "that particular collective work" would therefore be excluded.

Id. at 261.

Mrs. Linden received no response.

Instead, Authors League of America representative Irwin Karp responded to Mr. Wasserstrom, directly after Mrs. Linden's question about revisions:

[a]s to Mr. Wasserstrom's comment on subsection (d), I think the draft as written reflects and clarifies what is sound practice in the publishing field. Actually, the publisher takes copyright in the individual contributions to collective works only because of a disinclination to put copyright notices on

the bottom of the first page of each article or story [a remnant of § 403's harsh results that, if copyright notices are not placed on published copies of works, they devolve into the public domain]. Every reputable publisher that I know of willingly reassigns to the author, immediately after publication of the periodical, all rights except first periodical or first serial rights. And as Mr. Goldman has pointed out (and I heartily agree with him) this [rewording of § 14(d)] certainly makes it easier to carry that practice forward into the law. I really see no conflict between the position of the publisher and this section. They say the same thing, and this section would just make it a matter of record. It would avoid the necessity of assignments and carry out what is the agreement between most authors, publishers, and only an implied agreement. There are very few contracts between article- and story-writers and their publishers as to what's to happen. It is simply the practice of the trade that, when the magazine has published, it reassigns all rights except first serial rights [to the author].

Id. at 261-262.

1964 BILL

Despite the lack of debate regarding, or in answer to, Mrs. Linden's question about whether "that particular collective work" included revisions, the 1964 draft of the copyright bill provided in Section 14(c), as follows:

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 and any revisions of it."

Staff of House Comm. on Judiciary, 89th Cong., 1st Sess., Copyright Law Revision, Part 5 9 (Comm. Print 1965) (hereinafter "1964 draft bill").

1964 DEBATES

During debates on the 1964 draft bill, on August 7, 1964, Magazine Publishers Association representative Wasserstrom repeated his objection to using the word “express” in connection with transfers by authors to publishers of contributions to collective works:

This other point that I would like to address myself to is just a relatively minor one. If this second sentence [with the “express” retained] is to remain, it seems to me that there should be some clarification as to what is meant by the phrase ‘and any revisions to it’ in connection with the reproducing and distributing of a contribution as part of a particular collective work. Treating it in the terms of this sentence, I’m not at all sure that the draftsmen intended to limit, in the absence of an express transfer, the publication on the part of the publisher to a particular issue of a particular periodical, thereby eliminating the relatively simple and generally accepted right of republication in the same periodical.

Id. at 149.

American Textbook Publishers Association representative Bella L. Linden’s responded first by describing her representation of publishers of encyclopedias, reference works and textbooks, which “in dollars-and-cents volume ... represent 80% of the entire reference and technical field -- in dollars, 800 million of a billion last year”. Id. at 149. She then objected to the work-made-for hire section of the draft act.

Id. at 150.

American Society of Magazine Photographers and Society of Magazine Writers

representative Harriet F. Pilpel's then commented:

There is obviously no provision of this proposed act of more importance to magazine writers and magazine photographers than section 14. Generally speaking, I think the Copyright Office has done an excellent job in setting forth what the law should be and, at the risk of disagreeing with Mr. Wasserstrom, also of what I think the law is. Mr. Wasserstrom referred to the law and settled practice today in terms of the ownership of all rights in a contribution to a collective work being acquired by the owner of the collective work....

I have but one question with reference to the wording, and that is with respect to the wording at the end of subsection (c): "...and any revisions of it." If that means 'any revisions of the collective work' in terms of changing the contributions, or their order, or including different contributions, obviously the magazine writers and photographers would not object. But there is an implication, or at least an ambiguity, that somehow the owner of the collective work has a right to make revisions in the contributions to the collective work. This is not and should not be the law, and consequently I suggest that the wording at the end of subsection (c) be changed or eliminated to make that absolutely clear.

As far as collective works are concerned, it seems to me that Mr. Karp is quite right in the statements which he made on behalf of authors. In particular, I should like to point out that, where lump sums are paid, there is a tendency to regard the transaction as an employment for hire although it may not be. It is in that situation particularly that greater definition and clarification are called for, and it is in that situation particularly that reversion is called for, because there is no continuing payment [to authors for continued uses by publishers].

Id. at 152-53.

1965 BILL AND COMMENTARY

The 1965 Revision Bill defined the “delicate balance between authors’ and publishers’ rights in collective works”, as follows:

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 any rights under it, the owner of copyrights 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.”

Register of Copyrights for the House Comm. on Judiciary, 89th Cong., 1st Sess., Copyright Law Revision, Part 6 68-69 (Comm. Print 1965)(hereinafter “1965 Revision Bill”).

The explanation of what Section 201(c) means is as follows:

[The first sentence] is intended to establish the significant principle that the copyright in a contribution and the copyright in the collective work in which [the contribution] appears are two different things, and that the usual rule [in § 201(a)] with respect to initial ownership applies to the contribution....

Under the present law, the owner of the copyright in a collective work as a whole is also the owner of copyright in the elements of compilation and editing, in any contributions that were made for hire by [the collective work publisher’s] employees, and in any contributions in which all of the author’s rights have been transferred to [the collective work publisher]. The bill would leave this situation undisturbed but, as recommended in the 1961 *Report*, would clarify and simplify the extremely confused and unsatisfactory situation now existing with respect to individual contributions that were not made for hire.

In conjunction with the notice provision in section 403, the second sentence of section 201(c) would preserve the author's copyright in his contribution without requiring a separate notice in his name or an unqualified transfer of all his rights to the publisher. It would also establish a presumption that, in the absence of an express transfer, the author [of the contribution] retains all rights except '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.' Under this presumption, for example, an encyclopedia publisher would be entitled to reprint an article in a revised edition of an encyclopedia, and a magazine publisher would be entitled to reprint a story in a later issue of the same periodical. However, the privileges under the presumption are not intended to permit revisions in the contribution itself or to allow inclusion of the contribution in anthologies or other entirely different collective works.

Id. at 68-69.

1965 DEBATES

As with the prior drafts, commentary and debates ensued with regard to the 1965 draft bill. For example, the almost 2000-page report includes a letter from Prof. W. Albert Noyes, Jr., then Chairman, Ad Hoc Committee on Copyright Law Revision, in which he opined:

In our opinion, certain sections of the bill are particularly favorable for the individual scientific author. This is true of sections 201(c) and 204(a) relating to the ownership of copyright in collective works and to the requirement for a written transfer of copyright. We support these sections as we feel that the regularity and clarity of the procedures would more than offset their slight additional record keeping requirement.

Copyright Law Revision: Hearings on H.R. 4347, 5680, 6831, 6835 Before Subcommittee No. 3 of the House Comm. on the Judiciary, 89th Cong., 1st Sess. 1917 (1965).

1966 HOUSE REPORT

The 1966 Report of the Committee on the Judiciary to the House of Representatives on the copyright act bill No. 2237 stated, as follows:

Under the language which has been retained, a publisher could reprint a contribution from one issue in a later issue of his magazine, or could reprint an article from a 1970 edition of an encyclopedia in a 1980 revision of it; he could not revise the contribution itself or include it in a new anthology or an entirely different magazine or other collective work.

H.R. Rep. No. 89-2237, at 116-17 (1966).

1976 HOUSE REPORT

Finally, in 1976, the House Report No. 94-1476 to the bill ultimately passed by Congress, stated:

Subsection (c) of section 201 deals with the troublesome problem of ownership of copyright in contributions to collective works, and the relationship between copyright ownership in a contribution and in the collective work in which it appears. The first sentence establishes the basic principle that copyright in the individual contribution and copyright in the collective work as a whole are separate and distinct, and that the author of the contribution is, as in every other case, the first owner of copyright in it. Under the definitions in section 101, a "collective work" is a species of "compilation" and, by its nature, must involve the selection, assembly, and arrangement of "a number of contributions." Examples of "collective works" would ordinarily include periodical issues, anthologies, symposia, and

collections of the discrete writings of the same authors, but not cases, such as a composition consisting of words and music, a work published with illustrations or front matter, or three one-act plays, where relatively few separate elements have been brought together. Unlike the contents of other types of "compilations," each of the contributions incorporated in a "collective work" must itself constitute a "separate and independent" work, therefore ruling out compilations of information or other uncopyrightable material and works published with editorial revisions or annotations. Moreover, as noted above, there is a basic distinction between a "joint work," where the separate elements merge into a unified whole, and a "collective work," where they remain unintegrated and disparate.

The bill does nothing to change the rights of the owner of copyright in a collective work under the present law. These exclusive rights extend to the elements of compilation and editing that went into the collective work as a whole, as well as the contributions that were written for hire by employees of the owner of the collective work, and those copyrighted contributions that have been transferred in writing to the owner by their authors. However, one of the most significant aims of the bill is to clarify and improve the present confused and frequently unfair legal situation with respect to rights in contributions.

The second sentence of section 201(c), in conjunction with the provisions of section 404 dealing with copyright notice, will preserve the author's copyright in a contribution even if the contribution does not bear a separate notice in the author's name, and without requiring any unqualified transfer of rights to the owner of the collective work. This is coupled with a presumption that, unless there has been an express transfer of more, the owner of the collective work acquires "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."

The basic presumption of section 201(c) is fully consistent with present law and practice, and represents a fair balancing of equities. At the same time, the last clause of the subsection, under which the privilege of republishing the contribution under certain limited circumstances would be presumed, is an essential counterpart of the basic presumption. Under the language of this clause a publishing company could reprint a contribution from one issue in a later issue of its magazine, and could reprint a

contribution from a 1980 edition of an encyclopedia in a 1990 revision of it; the publisher could not revise the contribution itself or include it in a new anthology or an entirely different magazine or other collective work.

H.R. Rep. No. 94-1476, at 122-23 (1976).