



May 2, 2001

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Washington, D.C.  
20559-6000

Re: Greenberg v. National Geographic Society

Dear Mr. Adamson:

We are writing in response to your letter of April 5, 2001, relating to the decision of the United States Court of Appeals for the Eleventh Circuit in *Greenberg v. National Geographic Society*, No. 00-10510.

Although the Copyright Office does not often comment on the merits of private civil litigation, the court's remarks about the National Geographic Society's possible fraud on the Copyright Office appear to reveal a misunderstanding of Copyright Office registration practices. In the rare cases in which appellate courts discuss our registration practices in a way that is likely to confuse the public, we will speak out in the interests of justice, public education and the orderly administration of the copyright laws. See the Office's Statement of Policy, 65 Fed. Reg. 41,508 (July 5, 2000), and *Raquel v. Education Management Corp.*, 121 S.Ct. 376 (2000) (granting writ of certiorari, vacating the decision of the court of appeals, and remanding "for further consideration in light of the position asserted by the Solicitor General in his brief for the United States, as *amicus curiae*, filed September 20, 2000, and the Copyright Office's July 5, 2000, Statement of Policy, 65 Fed. Reg. 41,508").

In this case, we are pleased to set the record straight and confirm that having reviewed certificate of registration no. VA 931-760 as well as the registered work, "108 Years of National Geographic Magazine CD-ROM," we find that the National Geographic Society's application complied with the Office's requirements for registration, and that there is no reason to conclude that the application misled the Office in any way. To the extent that your letter invites the Office to express its views on the merits in general of the Eleventh Circuit's opinion in *Greenberg*, we must decline the invitation. Although the Office has misgivings about the *Greenberg* opinion in a number of respects, we do not believe that this is the appropriate occasion to express our views, apart from explaining how the court misunderstood the Office's registration practices.

The statement in *Greenberg* that has caused concern in the Office appears in a footnote:

As noted earlier, the Society failed to indicate the third, and critical, element of the new work, the Program. While the storage and retrieval system may be "transparent" to the unsophisticated computer user, it nevertheless is present and integral to the operation and presentation of the data and images viewed and accessed by the user. *Giving the Society the benefit of the doubt, it may not have intentionally perpetrated a fraud on the Copyright Office.*

Slip opinion at 14, n. 13 (emphasis added). This statement casts doubt on the National Geographic Society's conduct in connection with its application to register "108 Years of National Geographic Magazine CD-ROM," and on a standard practice in registration of copyrights in works on media such as CD-ROMs.

The court of appeals appears to have erroneously concluded that certificate of registration No. VA 931-760 purports to be a registration of the entire contents of the CD-ROM series constituting "108 Years of National Geographic Magazine CD-ROM." Our review leads us to a very different conclusion: the certificate purports to register the copyright only in what is described on the face of the certificate as "brief introductory audiovisual montage." It is apparent that this is a reference to what the *Greenberg* opinion refers to as the "moving covers sequence," or simply the "Sequence." See slip op. at 4.

To understand what copyrighted material is being registered, one must carefully examine the application for registration. Although space 1 of the application states that the title of the work is "108 Years of National Geographic Magazine on CD-ROM," space 2 describes the "nature of authorship" as "introductory audiovisual montage." As the *Compendium of Copyright Office Practices, Compendium II* states, "In general, the nature of authorship defines the scope of the registration; therefore, it represents an important copyright fact." *Compendium II*,

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\* The application for registration is reproduced in its entirety as part of the certificate of registration.

§619 (1988); see also Statement of Policy, 65 Fed. Reg. 41,508 (July 5, 2000). Thus, the entry in space 2 clarifies that what is being registered is that introductory sequence, rather than the entire contents of the CD-ROMs on which the sequence appears.

Moreover, the entries in space 6 further clarify that the only subject matter being registered is the introductory sequence. Space 6 of an application for copyright registration seeks information about compilations and derivative works. Space 6 of certificate of registration No. VA 931-760 clearly identifies the work being registered as a derivative work, stating in space 6a that the preexisting material includes a "compilation of pre-existing material primarily pictorial," and stating in space 6b that the "material that has been added to this work and in which copyright is claimed" consists of a "brief introductory audiovisual montage." The court's conclusion that the certificate of registration reveals that "the registered work, the CNG, was a compilation," slip op. at 14, is thus based on a misinterpretation of the certificate. While the certificate states that the preexisting material was a compilation, it does not state that the additional material, the "audiovisual montage," was a compilation. Of course, it is possible to view that audiovisual montage as a compilation – but that compilation would simply be a compilation of covers from past issues of the National Geographic magazine, not a compilation of, in the words of the court, "the Sequence, the Replica, and the Program." See slip op. at 13.

Hence, the National Geographic Society's application for copyright registration clearly sought registration only of the copyright in the introductory sequence. The Office clearly understood this and issued the certificate of registration based on that understanding.\*\*

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\* See Copyright Office Circular 55, *Copyright Registration for Multimedia Works*, at 4 ("New Material Added (6b). Briefly describe all the new copyrightable authorship that is the basis of the present registration. An example is: 'some new text, new photography.' (The statement used in 6b may be used in space 2 to describe the author's contribution.)").

\*\* The certificate indicates that the information in spaces 2 and 6a was amended by a Copyright Office examiner as a result of a telephone conversation with an attorney representing the National Geographic Society. This is a common practice when the examiner believes that clarification of the copyright claim is needed. The original application included a claim in "photograph" and "text," but following the telephone conversation, those claims were deleted, apparently because the examiner explained to the attorney that the photographs and text in question were part of a straight, chronological replication of 108 years' worth of issues of National Geographic Magazine, which a trained examiner would understand as not rising to the level of copyrightable compilation authorship because of the lack of the statutorily required selection, organization or arrangement. The attorney authorized the examiner to delete the references to "photograph" and "text," and to insert the references to "introductory audiovisual montage." Thus, the application in its final form claimed copyright only in a very limited portion of the content on the CD-ROM, and the Office was aware of this.

Accordingly, there can be no question of any attempt to perpetrate a fraud on the Copyright Office, and the court's speculation in footnote 13 of the opinion is inconsistent with the Copyright Office registration record for this particular work.

There is another reason why the court's reference to possible fraud on the Copyright Office is inconsistent with the Office's actual examination and registration practices. A trained examiner understands that a straight, chronological replication of 108 years' worth of National Geographic Magazine does not rise to the level of copyrightable compilation authorship because of the lack of the statutorily required selection, coordination or arrangement. However, assuming that the National Geographic Society had attempted to register a copyright in the entire compilation of 108 years of issues of the National Geographic magazine on CD-ROM, the court appears to have implied that the Society may have attempted to conceal from the Office the presence of the software that is included on the CD-ROM to enable users to gain access to the contents of the magazine issues, and that this possible concealment may have been intended to avoid the consequences that would have ensued if the Office had been aware of the presence of the software on the CD-ROM. We infer this because of the court's reference to "fraud on the Copyright Office." The doctrine of fraud on the Copyright Office provides that the knowing submission of a misleading application for copyright registration may invalidate the resulting registration if awareness of the true facts might have caused the Copyright Office to deny registration. See *Whimsicality, Inc. v. Rubie's Costume Co.*, 891 F.2d 452, 456 (2d Cir. 1989); *S.O.S., Inc. v. Payday, Inc.*, 886 F.2d 1081, 1086 (9th Cir. 1989); 2 M. & D. Nimmer, *Nimmer on Copyright* § 7.20[B], at 7-209 (2000).

If this is what the court was thinking, the court misunderstood another aspect of copyright registration practice. The Copyright Office recognizes that when works of authorship embodied in CD-ROM format are submitted for registration, computer programs may be included on the same CD-ROM, and that use of those computer programs may be necessary in order for a user to gain access to the work of authorship in which copyright is claimed. However, it is not necessary in such cases that the application for copyright registration include a claim of copyright in the software.

The Copyright Office Examining Division examines works of authorship embodied in CD-ROM format also according to its "Interim CD-ROM Practices, Literary Section, Rev. 2/95." The Practices acknowledge that a single CD-ROM disc may contain "many different types of material, including text, still images: photographs and illustrations, artwork, maps, sounds..., motion pictures..., computer software code..." and that "computer program text is only one of the elements that can be stored on a CD-ROM disc." CD-ROM Practices at 1. The Practices further state that "the author of the material on the CD-ROM can also be the author of the retrieval software. Sometimes, however, a company will put together the material on the CD-

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\* Although the Practices are titled "Literary Section," they apply to registration claims received in all classes of authorship and are used by all examiner staff within the Division.

ROM but use preexisting operating software which may or may not belong to that same company." CD-ROM Practices at 2.

Under these practices, an examiner will accept an application for registration in which no claim is specifically made for the retrieval software embodied in the CD-ROM as long as there is no information elsewhere on the application or on the deposit copy of the CD-ROM itself which indicates that the software may be owned by the same party claiming copyright in the substantive content of the CD-ROM. This is consistent with the Division's CD-ROM Practices noted above, which explicitly recognize that the copyright owner of some or all of the substantive content fixed in the CD-ROM may not be the same party that owns the copyright in the retrieval software present on the CD-ROM. Further, an examiner will also accept an application for registration in which no claim is specifically made for the software even if it is factually the case that the same party does own both the substantive content *and* the retrieval software embodied in the CD-ROM. The reason for the latter is that as long as the claim is facially acceptable, *i.e.*, all registration requirements for the authorship explicitly claimed have been met, the examiner will not investigate further and will not communicate with the applicant, according to the general examining principles in *Compendium II*, to determine whether the applicant wishes to extend the scope of the claim. In other words, if the applicant is entitled to claim copyright in the software but elects not to assert that claim, the Examining Division will not require the applicant to make the claim. The Examining Division assumes that the applicant has accurately described the extent of the authorship for which registration is sought. Moreover, if the applicant subsequently finds that the description of the extent of the authorship is incorrect and that additional authorship should have been claimed, a supplementary registration may be made under 37 C.F.R. 201.5.

Thus, after review of the registration in question by appropriate supervisory examiner staff, the Office considers the registration no. VA 931-760 for the "introductory audiovisual montage" in the work "108 Years of National Geographic Magazine on CD-ROM" to be valid because the registration was made within required examining guidelines. The National Geographic Society had no obligation to disclose or assert a copyright claim in the software.

The Copyright Office provides information to the public about its examining and registration practices in a series of circulars, including Circular 55, *Copyright Registration for Multimedia Works*. Circular 55 explains that although "All copyrightable elements of a multimedia kit may generally be registered with a single application, deposit and fee ... [s]eparate registrations for individual elements may be made by submitting a separate application and filing fee each." Circular 55, at 2. Of particular significance with respect to registration no. VA 931-760, the Circular also states:

"A separate registration is required, however, for any element of a multimedia kit that is published separately or claimed by someone other than the copyright claimant for the other elements."

Circular 55, at 2. According to the opinion in *Greenberg*, the software that was included on the CD-ROM was created not by the National Geographic Society, but by Mindscape, Inc. Slip op. at 5. Moreover, the court appears to have concluded that Mindscape owns the copyright in the software. Slip op. at 6 n.3. If that is the case, the National Geographic Society could not have claimed copyright in the software, whether as part of the application for registration of "108 Years of National Geographic Magazine CD-ROM" or separately.

We understand that the court of appeals viewed the entire CD-ROM as a compilation, and that the elements of that compilation included (1) the "Sequence," (2) the digitally reproduced issues of the magazine themselves, and (3) the software that enables users to gain access to the contents of the magazine issues. However, although this letter will not express a view on the merits of that analysis and its implications with respect to what a publisher may do pursuant to 17 U.S.C. § 201(c), we can clarify that the Office's examining practices do not require the owner of the copyright in content that is included on a CD-ROM, and which can be accessed only by using software that is also included on the CD-ROM, to claim compilation authorship with respect to the all of the contents (including the software) on the CD-ROM.

In conclusion, based on the facts as we understand them, we believe that the suggestion by the court of appeals that the National Geographic Society may have "perpetrated a fraud on the Copyright Office" when it submitted its application for registration no. VA 931-760 is based on a misunderstanding of copyright registration practices.

We hope that this letter assists in clarifying that the National Geographic Society's application as amended was consistent with Copyright Office policies and practices.

Sincerely,



David O. Carson  
General Counsel

cc: Norman Davis, Esq.