

DOCKET NO. 05-16964-JJ

**IN THE  
UNITED STATES COURT OF APPEALS  
FOR THE ELEVENTH CIRCUIT**

JERRY GREENBERG,  
Plaintiff/Appellee

vs.

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

Defendants/Appellants.

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On Appeal from the United States District Court  
for the Southern District of Florida

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**Brief of Appellee Jerry Greenberg**

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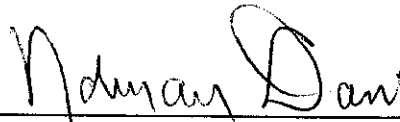
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## INTRODUCTION

Greenberg challenges certain statements made by the Defendants/Appellants (together “the Society”) in the Introduction to their brief.

The Society insists that in Greenberg v. National Geographic Society, 244 F.3d 1267 (11<sup>th</sup> Cir. 2001) (“Greenberg I”) this Court “upset” a balance of rights between authors and publishers. In the first paragraph of the Introduction, the Society correctly says that a publisher “may revise and reproduce the original collective work itself in a new medium” pursuant to Section 201(c) of the Copyright Act. As explained in detail in this brief, the Complete National Geographic product (“CNG”) does not in any way “revise” what the Society calls “the original collective work itself,” which can only refer to each of the hundreds of monthly magazines placed in the CNG. None of the magazines was revised. All were gathered into what became a prohibited new collective work.

According to the Society, at page 2 of the Introduction, Greenberg I deemed that “the creation of a ‘new’ collective work is inherently inconsistent with the creation of a ‘revision.’” Indeed, it is. As explained in this brief, Congress made clear that a publisher’s presumptive privilege to reproduce a copyrighted work does not extend to including it in a new collective work. The Supreme Court confirmed that understanding in its Tasini decision.

The Society provides a useful example: “A revised encyclopedia . . . will often include new (and independently copyrightable) entries – indeed, that is the whole purpose of a revision. . . .” The operative word there is “include.” Revising an encyclopedia means that new material (“new entries” as the Society puts it) has been added, or changes otherwise have been made, to a preexisting collective work – the encyclopedia. A collective work consisting of dozens of different encyclopedias would not amount to a “revision” of any of them. The only collective works within the CNG are issues of monthly magazines, and not one of them was revised in any way. That is why the Court in Greenberg I rejected the contention that the CNG constitutes a revision under Section 201(c).

Greenberg I, they say, is “inconsistent with subsequent Supreme Court authority.” That is not so, as the discussion of Tasini in this brief makes clear. Moreover, says the Society at page 3 of the Introduction, Greenberg I created a post-Tasini conflict with the Second Circuit, which would be quite a feat because Greenberg I preceded Tasini. The conflict that emerged was created without a good basis by the Second Circuit, as will be discussed.

## STATEMENT OF THE ISSUES

1. Whether New York Times Co. v. Tasini, 533 U.S. 483 (2001), is superseding and controlling authority that invalidates Greenberg v. National Geographic Society, 244 F.3d 1267 (11<sup>th</sup> Cir. 2001) ("Greenberg I").
2. Whether the Court's decision in Greenberg I adequately contemplated the Society's available defenses to infringement so that the district court's subsequent order striking the Society's answer and defenses did not deprive the Society of defenses.
3. Whether the jury had sufficient evidence, including documents, testimony and credibility assessments, to conclude that the Society's infringement was willful.

## STATEMENT OF THE CASE AND THE FACTS

[Greenberg adopts the Society's Statement of the Case and the Facts except for the comments and additions outlined below.]

The first iteration of The Complete National Geographic ("CNG"), encompassing 108 years of the magazines, contains, in addition to those elements listed by the Society, a display depicting moving spines of the magazines. It also has computerized features permitting the copying and e-mailing of materials, and an interactive link with the Society's web site. As explained in the brief, later iterations of the CNG involved still other elements.

In granting the Society's alternative motion to dismiss or for summary judgment, the district court below followed a district court in New York which had just granted summary judgment to publisher-defendants in Tasini v. New York Times Co., Inc., et al., 972 F.Supp. 804 (S.D.N.Y. 1997). The district court below said that it found the Tasini Court's reasoning sound and adopted the legal framework developed by that court. The Second Circuit reversed the district court in New York, and the Supreme Court affirmed the Second Circuit in New York Times Co., Inc. v. Tasini, 121 S.Ct. 2381 (2001).

When this Court reversed the district court in Greenberg v. National Geographic Society, 244 F.3d 1267 (11<sup>th</sup> Cir. 2001) ("Greenberg I"), the Society

petitioned for reconsideration, asking, among other things, for an opportunity to present additional defenses in the district court. This Court denied the petition.

In its statement of the case, the Society states repeatedly that the Magistrate Judge who presided stated prior to trial that the evidence for willful infringement was weak. The Magistrate Judge was not a juror, of course, and could not second-guess the jury, particularly on matters of credibility. The Magistrate Judge also was unaware at that time of numerous facts that would be developed in the course of the trial that supported a willfulness finding, and that are outlined in this brief. The Magistrate Judge subsequently denied the Society's motion for a new trial.

## STANDARDS OF REVIEW

The Appellee disagrees in part with the standards of review outlined in the Society's brief. Greenberg agrees that the question of whether Greenberg I continues to be valid law is reviewed *de novo*.

For a determination as to whether the district court's actions on remand complied with the mandate rule, the Court must determine the scope of its mandate in Greenberg I. U.S. v. Lee, 358 F.3d 315, 321 (5<sup>th</sup> Cir. 2004).

As to the rules of procedure, the issue is not, as the Society presents it, whether the district court required the filing of an answer before the filing of a dispositive motion. Rather, the issue before the district court was whether the answer that eventually was filed was timely. That question is reviewed *de novo*.

Finally, the question of whether the jury had sufficient evidence to find that the infringement was "willful" is not a question of law, as discussed in this brief. Instead, the question is whether the district court abused its discretion in concluding that the jury could properly have found the infringement to be willful as a factual matter.

## SUMMARY OF THE ARGUMENT

(1) The Society contends that Greenberg I is wrong because Tasini, which was decided later, defined “revision” under Section 201(c) of the Copyright Act in a way that encompasses the CNG as a revision. The issue, therefore, centers on what Tasini actually said about a “revision.”

Tasini is distinguishable at the outset because it dealt with the disassembly of collective works – newspapers and magazines – and the random scattering of articles from those works in vast databases. Greenberg I dealt with the assembly of many intact collective works – magazines -- containing many articles into a new collection called the CNG. Tasini differentiated between articles (sometimes called contributions) standing in isolation in databases, and articles used in new collective works. The latter is prohibited without the consent of the author.

Tasini clearly says, in numerous places, that any “revision” must involve change in the underlying collective work, i.e., a newspaper edition or a magazine edition. The Society adopts a contrary view: if one gathers a large bunch of intact, unchanged magazines in a new collection, and throws into the overall collection some additional elements that do not “revise” any of the magazines, the whole collection can be called a “revision.” Greenberg I disagreed, saying that such a package is not a “revision” under Section 201(c) and is instead a new collective work.

The Supreme Court's reasoning in Tasini does not undermine the Greenberg I rationale, but clearly supports it.

(2) The Society says it was deprived of additional defenses when the district court struck the Society's answer, which was filed after Greenberg I. Greenberg responds that the district court, obligated to honor the express and implied holdings in Greenberg I, followed the clear language in the mandate. Moreover, in petitions for reconsideration, the Society asked this Court to give it an opportunity to state other defenses. The Court denied the petitions.

The district court's secondary basis for striking the answer was that it was filed beyond deadlines in the rules, and the Society did not timely request additional time to file and serve.

(3) The Society challenges the district court's support of a finding by the jury of willful infringement. The rationale is that the Society relied on advice from its legal counsel, which made the willfulness question a matter of law. Greenberg disagrees, because the jury had abundant evidence that much of the advice obtained arrived after the Society had committed itself to the CNG and because the Society failed to provide adequate information to its lawyers concerning the CNG product and its contents. The jury also had strong evidence that the Society flouted this Court's finding of infringement and continued its infringing conduct by selling the CNG. Those became fact issues appropriate for the jury.



## ARGUMENT

### I.

#### **GREENBERG I IS GOOD LAW, UNCHANGED BY TASINI**

##### A. Introduction

The Society is asking this Court to overturn its prior decision in Greenberg v. National Geographic Society, 244 F.3d 1267 (11<sup>th</sup> Cir. 2001) (“Greenberg I”). The first order of business is thus to determine the basis on which that can be considered.

“Under the well-established prior panel precedent rule of this Circuit, the holding of the first panel to address an issue is the law of this Circuit, thereby binding all subsequent panels unless and until the first panel’s holding is overruled by the Court sitting en banc or by the Supreme Court.” Schiavo ex rel. Schindler v. Schiavo, 403 F.3d 1289, 1292 (11<sup>th</sup> Cir. 2005), quoting Smith v. GTE Corp., 236 F.3d 1292, 1300 n.8 (11<sup>th</sup> Cir. 2001). While not an inexorable command, the law of the case doctrine provides stability and finality in litigation . . . .” Klay v. All Defendants, 389 F.3d 1191, 1199 (11<sup>th</sup> Cir. 2004).

Greenberg I has not been overruled by New York Times Co., Inc. v. Tasini, 121 S.Ct. 2381, as the Society proposes. This Court reviews that question *de novo*.

Tasini was a dissimilar case, with starkly different facts, and with a completely unrelated holding that does nothing to question the validity of Greenberg I.<sup>1</sup>

The Society also contends that the Second Circuit Court of Appeals correctly applied Tasini to cases in New York based on the same product – the Complete National Geographic (“CNG”) – and issues under Section 201(c) of the Copyright Act. Faulkner v. National Geographic Enterprises, Inc., 409 F.3d 26 (2d Cir. 2005). The Society urges that this Court should resolve the resulting conflict.<sup>2</sup> However, even a casual reading of the Second Circuit’s opinion shows that the analysis there of the Tasini issues was far less detailed and thorough than was the decision in Greenberg I. The Second Circuit thus set up a conflict with this Court through the misapplication of Tasini, as discussed below. Any resolution of the conflict between the two circuits should be left to the Supreme Court.

Section 201(c) is a tightly-focused element of the Copyright Act that was adopted by Congress in 1976:

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

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<sup>1</sup> This Court decided Greenberg I on March 22, 2001. The Supreme Court decided Tasini on June 25, 2001. The Supreme Court surely was aware of the nature of the appeal in this Court and of the ruling that ensued but made no reference to it in any way.

<sup>2</sup> The Society asked the Supreme Court resolve the conflict between the Second and Eleventh Circuits. The Court denied the petition on December 12, 2005.

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

The “author” here is photographer Jerry Greenberg, and his “contribution” consists of 64 photographs published over the years in the Society’s monthly magazine, each issue constituting a “collective work” under the Copyright Act. Under Section 201(c) the Society has a presumptive privilege (not a right) to further reproduce those photographs in three narrowly limited circumstances. In their briefs, the Society and the *amici* wrongly contend that the Complete National Geographic (“CNG”) complies with the second prong of Section 201(c) because, they say, the CNG is a “revision” of preexisting works.

In the very first sentence of its argument, the Society misleads the Court as to its holding in Greenberg I. That case, says the Society, held that National Geographic “is not privileged under the Copyright Act to reproduce the paperbound editions of that collective work in a digital archive.” Brief, 17. The Court expressly avoided such a holding. Greenberg I, 244 F.3d 1273 n.12. Its actual holding was that the CNG represents a new collective work that was beyond any privilege that might have been available under Section 201(c) of the Copyright Act. That holding is still good law, unchanged by Tasini.

**B. Tasini is Completely Distinguishable**

In Tasini, the publishers of the New York Times and various magazines licensed rights to NEXIS and other companies to include in their vast computerized databases individual articles lifted from daily issues of the Times and from various magazines. Those articles, placed randomly in the databases, are seen by customers of the databases as stand-alone articles without the original publication's context, including headlines, graphics, page placement and the like. Tasini, 121 S.Ct. at 2381-82. Tasini thus dealt with the disassembly of collective works, i.e., the carving out of individual articles from various daily issues of newspapers and magazines (collective works) in which the articles originally appeared. In contrast, Greenberg I dealt with the assembly in one product of hundreds of intact monthly magazines, each of which qualifies under the law as a collective work.

Tasini does not control Greenberg I because Tasini focused on a different issue. The Court concluded that the republication of newspaper articles in an isolation setting did not constitute "revisions" under Section 201(c). In contrast, Greenberg I concluded that the combination of more than twelve hundred monthly magazines in the CNG, with other new elements, constituted a new collective work. Greenberg I rejected the contention that the CNG was a revision. 244 F.3d at 1272. The Society is still pursuing that notion.

The Supreme Court in Tasini confirmed that a new collective work is not permissible under Section 201(c), but it did not address the elements necessary to create a new collective work. The holding in Tasini, therefore, does not undermine Greenberg I.<sup>3</sup>

The Society, and the *amici*, make too much of the Supreme Court's emphasis on the preservation of "the context provided either by the original periodical editions or by any revision of those editions." Tasini, 121 S.Ct. at 2391. Context was particularly important in Tasini because of the total destruction, in the digital databases there, of the newspaper and magazine context in which the contributors' news articles originally appeared. The Supreme Court emphasized context because, in the framework of Section 201(c), the language of the second prong ("any revision of that collective work") requires significant continuity in "that collective work" in order for the revision privilege to apply. The relevant underlying works in Tasini were daily editions of newspapers and of magazines that formerly provided context for the articles. The scattering of the articles in isolation in the databases destroyed any context through which any revision of "that work" (the original newspaper or magazine) could be measured. Accordingly,

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<sup>3</sup> This Court acknowledged its awareness of deliberations in the Tasini case by the Supreme Court at the time of the Greenberg I opinion. 244 F.3d at 1274 n.14.

the publishers could not prevail. Stating the Tasini outcome another way, a publisher cannot “revise” a collective work under Section 201(c) by destroying it.

But context, while significant, is not controlling here. Greenberg’s photographs, placed over many years in four separate articles in four separate monthly magazines, still appear in that context in the CNG. The Society says “Greenberg I erred by focusing on whether the CNG itself is a ‘new’ collective work rather than focusing on whether the CNG exploits any individual freelance contribution outside the context of the original collective work.” Brief, 29. The Society’s recurrent theme, over and over again, seems to be: so long as you reprint material in context, anything goes. It does not.

The Supreme Court held that context is only one part of the analysis:

It would scarcely “preserve the author’s copyright in a contribution” as contemplated by Congress, H.R. Rep. 122, U.S. Code Cong. & Admin. News 1976, pp. 5659, 5738, if a newspaper or magazine publisher were permitted to reproduce or distribute copies of the author’s contribution in isolation [out of context, as in Tasini] or within new collective works.

Tasini, 121 S.Ct. at 2389 (emphasis and bracketed material added). That word “or” is significant. The Supreme Court expressly said there that the issue of a new collective work, as in Greenberg I, is fundamentally a different question from the Tasini issue of isolation. The other briefs in this appeal seek to trivialize any inquiry into a new collective work. The Tasini analysis does not fit the wholly different set of facts here, and that case does not conflict and is not controlling here.

C. The Society's Reliance on "Revision" is Misplaced

As a protection for authors, Congress wrote the following in Section 201(c) of the Copyright Act:

[T]he owner of copyright in the collective work [here, the Society] is presumed to have acquired only the privilege of reproducing and distributing the [author's] contribution [1] as part of that particular collective work, [2] any revision of that collective work, and [3] any later collective work in the same series.

"That particular collective work" mentioned in the first prong clearly refers back to the collective work – here the monthly magazines – in which the author's contribution first appeared.

In the second prong, the privilege extends to "any revision of that collective work." That collective work thus refers back to the original collective work identified in the first prong. The Supreme Court interpreted that language as follows:

Under Section 201(c), the question is not whether a user can generate a revision of a collective work from a database, but whether the database itself perceptibly presents the author's contribution as part of a revision of the collective work.

Tasini, 121 S.Ct. at 2393 (emphasis added). The collective work contemplated there is an edition of a newspaper or a magazine. At page 18, the Society says that, because every cover, article, advertisement, and photograph appears as it did in the original paper copy of the monthly magazine, "the CNG

simply reproduced freelance contributions in a 'revision' of the original collective work . . . ." A truly remarkable statement, because nothing in any of the original collective works in the CNG was revised.

The Society argues that the very elements that Greenberg I said make the CNG a prohibited new collective work – the independently copyrightable introductory sequence and computer program – are instead components that "revise" the monthly magazines. Brief, 19. But how does adding elements extraneous to individual magazines actually revise the magazines themselves? Greenberg I made exactly that point: "[W]e are unable to stretch the phrase 'that particular work' to encompass the Sequence and Program elements as well. In layman's terms, the instant product is in no sense a 'revision.'" 244 F.3d at 1272. Nothing in Tasini affects that reasoning.

A newspaper that publishes four editions each day publishes four collective works. Each edition after the first constitutes a revision, preserving the bulk of the preceding edition and adding new and updated information. The same is true for a dictionary that publishes a revision each year, preserving most of the old material but supplementing with new words and definitions. Or a math textbook republished periodically with fresh material added. The Society did not revise any of the underlying collective works by adding updated material or rearranging material in those collective works – the monthly magazines.



Section 201(c) states that “any revision of that collective work” can qualify for the privilege. In applying that prong to newspaper articles, the Tasini Court said the databases there presented articles to readers “clear of the context provided either by the original periodical editions or by any revision of those editions,” obviously referring to the original editions of the newspaper or magazine. 121 S.Ct. at 2391 (emphasis added).

In the same paragraph, the Court went on to say that “we cannot see how the Database perceptibly reproduces and distributes the article ‘as part of’ either the original edition [of the newspaper] or a ‘revision’ of that edition.” (Emphasis added.) Id. The Court emphasized the meaning of the word “revision” still again: “[T]he Databases do not perceptibly reproduce articles as part of the collective work to which the author contributed or as part of any ‘revision’ thereof.” (Emphasis added.) 121 S.Ct. at 2392. The collective works to which Greenberg contributed his photographs were monthly issues of the Society’s magazine. The Supreme Court’s explanation of “revision” as involving change in the underlying collective work could not be more clear.

The Society insists that the CNG is a privileged “revision,” even though it does not revise the underlying collective works. No serious reading of Section 201(c) or Tasini can sustain that argument.

**D. This Court Correctly Held That the CNG is a New  
Collective Work Not Protected by Section 201(c)**

In Greenberg I, this Court rightly concluded that the CNG was outside the privilege in Section 201(c) because, contrary to a prohibition enunciated by Congress (confirmed by Tasini), it is a new collective work. This Court looked to the statutory definition of “collective work” as “a number of contributions, constituting separate and independent works in themselves . . . assembled into a collective whole.” 17 U.S.C. § 101. The Court listed the Replica, the Sequence and the Program as constituting separate and independently copyrightable elements.<sup>4</sup> The Society brushes aside these elements as of no consequence, but they are elements that were never essential to a republication of the monthly magazines themselves – especially the Program with its numerous nonessential features -- and they were plainly put in the CNG to enhance sales in a huge, open market. A republication of the magazines could have been done with a far more

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<sup>4</sup> The Court is urged to look again at the CNG itself, in its 1997 iteration and in later versions, to note that other independently copyrightable elements are included in the product, including but not limited to an animated globe logo, a National Geographic Interactive visual montage with sound, and a display depicting moving spines of issues of the magazines. In addition, Kodak paid a fee to the Society “for placement of a Kodak promotional message at the beginning of CNG CD-ROMs and advertising on the product package.” Faulkner v Nat’l Geographic Society, 294 F.Supp.2d 523, 527 (S.D.N.Y. 2003). All of these elements are indisputably independently copyrightable. None of them are essential to the product. [The 1997 CNG is found at Dist. Ct. D.E.20, Ex. A. The district court clerk advised that no numbered list of record materials had been provided to this Court when this brief was prepared.]

basic software program that would do little more than find an article and turn the pages. The software program in place now provides a great many features not important to replicating the magazines, and some of them, like the copying feature and the e-mail forwarding capability, quite directly exploit republication opportunities, contrary to opportunities, in the Supreme Court's sense of author's rights, that should have been reserved to Jerry Greenberg.<sup>5</sup>

The Supreme Court said that, in converting a publication from print to digital, various additions to the product would be acceptable where they were "entirely attributable to the nature of the electronic media. . . ." Tasini, 121 S.Ct. at 2392 n. 11. Such additions would not be acceptable where they were "entirely attributable to . . . the nature of the economic market served" by the product. Id. The Society's historic "market" consisted of Society members. More recent products, including the CNG, opened the market much wider to consumers around the world. Many of the elements in the CNG clearly were added only to serve the economic market by making the product more attractive and user-friendly, which is not consistent with any ongoing interest by Jerry Greenberg in his photographs.

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<sup>5</sup> Greenberg's action was predicated on the 1997 version of the CNG, which covered 108 years of the monthly magazines. The Society continued thereafter to turn out numerous variations of that original iteration. Faulkner contains a list of some of the later iterations. Faulkner, 409 F.3d at 30 n.2.

The Supreme Court explained in Tasini why the question of a new collective work is vital. “If there is demand for a freelance article standing alone or in a new collection, the Copyright Act allows the freelancer to benefit from that demand . . . .” 121 S.Ct. at 2389. The CNG is certainly a new collection. Indeed, a new collective work, by the statutory definition. This Court attached to its opinion in 2001 a copy of the registration form filed in 1997 with the U.S. Copyright Office on which the Society conceded that neither the CNG, nor any earlier version, had been registered previously with the Copyright Office.<sup>6</sup> The Court concluded, therefore, that the CNG was a “new” work. In fact, the Second Circuit noted that “[t]he CNG was originally distributed and marketed as an ‘unprecedented’ collection.” Faulkner, 409 F.3d at 32. That means “new.” The Society in its brief in 2001, and in its current brief, attempts to evade the 1997 representation to the Copyright Office (without mentioning the representation), saying that the CNG is not a new work but a revision of an older work. As discussed above, none of the preexisting collective works contained in the CNG was revised.<sup>7</sup>

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<sup>6</sup> It is a meaningful contrast that no record exists in this case showing that the Society ever registered microfilm copies of its magazines with the U.S. Copyright Office. There were no elements added to the microfilm that would re-characterize it as a new collective work.

<sup>7</sup> At page 26, the Society plays with the language in the Congressional passage cited by the Supreme Court above, to suggest that a “new” work has to be “entirely different.” The rationale is not persuasive. The “new collective works” targeted by the Supreme Court simply have to satisfy the statutory definition of

The CNG is a “new collection” – to use the Supreme Court’s term -- in another way, because prior to 1997 there never was a collection in one product of all Society magazines dating from 1888.<sup>8</sup> The Society has said that it assembled, at least in some years, a bound package in print of magazines for a given year, directed primarily to libraries.<sup>9</sup> The CNG, by contrast, contains over 1,200 magazines in a sleek box of CD-ROMs that was sold to the public at large on the Society’s web site and in retail outlets around the world.<sup>10</sup> As this Court noted, the CNG is a new product for a new market. 244 F.3d at 1273. Jerry Greenberg -- who never approved distribution of his photographs in such a market – cannot benefit (as Tasini suggests) from the extraordinary demand for the CNG in the

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collective work: “a number of contributions, constituting separate and independent works in themselves . . . assembled into a collective whole.” See 17 U.S.C. §101. The separate monthly magazines were independently copyrighted, and in the CNG they were assembled into a collective whole. The CNG happens to be “entirely different.” In any event, the Supreme Court’s construction of the Congressional language, quoted above, is that “new collective works” cannot benefit from the privilege.

<sup>8</sup> The May 1938 issue of the magazine, or the October 1956 issue, or any other issue, plainly has no significant market value alone. When combined for the first time with all monthly magazines since 1888, however, the market value of the collection has proven to be extraordinary.

<sup>9</sup> In Greenberg I, in its Petition for Rehearing and Petition for Rehearing En Banc, at page 14 n.4, the Society stated: “Not surprisingly, very few (if any) individuals buy microfilm or microfiche . . . for home use.”

<sup>10</sup> In 2003, on the day following a jury verdict on damages in favor of Greenberg, the Society announced that it was removing the CNG from the marketplace pending a resolution by the courts of matters in this case that are adverse to the Society.

global market.<sup>11</sup> Indeed, his photographs are so easily copied and/or e-mailed from the CNG, because of manipulative features unnecessarily added to the CNG (these are easily seen in the CNG box in the record), that any ongoing value in his photographs has been at least marginalized. Those added features, on the other hand, make the CNG's collection of magazines more attractive in a wide consumer market and thus create additional value for it.

At page 22, the Society tries to wave off the inclusion in the CNG of the unnecessary elements by noting that independently copyrightable works can properly be included in a revision. That can be true, but only if they are woven into a revision of the monthly magazines themselves. The copyrightable elements cited by this Court in 2001 make the CNG a new collective work, not a revision.

The brief of the Magazine Publishers of America argues a similar point by constructing an example of a revision that fails to prove its point. An article in a 1980 encyclopedia, goes the example, would be reprinted in a 1990 version of the encyclopedia, along with "new entries on topics that took place in the intervening decade." Brief, 10. That actually constitutes a Section 201(c) revision because those "new entries" go into the original, underlying collective work. The *amicus* argument goes on to say that elements added to the CNG like the Sequence

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<sup>11</sup> The Society's frequent comparisons with microfilm are meaningless when the microfilm market – limited essentially to libraries – is compared with the global market for the CNG.

similarly qualify as a revision. But those elements do not, because they do not revise the underlying collective works. They become instead elements of a new collective work, as this Court held in 2001.

**E. The Second Circuit Also Misapplied  
the “Context” Discussion in *Tasini***

The Second Circuit in Faulkner was confronted with the same product – the CNG – and similar Section 201(c) issues involving different photographers and authors. In its decision, disagreeing with Greenberg I, the Second Circuit held that the CNG is a privileged revision “because the original context of the Magazines is omnipresent in the CNG . . . .” Faulkner, 409 F.3d at 38. The court’s discussion of the applicability of Tasini consumed less than one full page in an 18-page opinion.

The Second Circuit essentially adopted a district court decision, which held that the CNG was a “revision of the individual print issues of the magazine,” even though no single issue was revised. Faulkner v. National Geographic Society, 294 F.Supp.2d 523, 543 (S.D.N.Y. 2003). The collection of unchanged magazines, said the district court, “is readily recognizable as a variation of the original.”<sup>12</sup> Id.

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<sup>12</sup> The district court said that the “revision privilege [can] extend to collective works which, like the revision of an encyclopedia, contain original contributions along with new or updated material.” 291 F.Supp.2d at 541. The key word there is “contain,” which means that the encyclopedia itself is revised, rather than placing the encyclopedia in a collection of other encyclopedias and calling that a revision.

That is puzzling logic. The collection is more readily recognizable as a new collective work, by the very definition of such a work in the Copyright Act.

The Second Circuit opinion (and that of the district court) totally ignored the repeated instruction by the Supreme Court in Tasini that a permissible revision must re-make or update the underlying collective works – the monthly magazines. The Second Circuit also ignored the Supreme Court’s admonition that republication is not privileged when the original contributions are “within new collective works,” Tasini, 121 S.Ct. at 2389, and brushed aside any real consideration of a new work.

The Society neglects to mention that it petitioned the Supreme Court for a writ of certiorari, seeking resolution of differences between the Second Circuit and the Eleventh Circuit on CNG issues. The Court denied the petition on December 12, 2005.

**F. Public Policy Prominently Includes Authors’ Rights**

The Society and the *amici* properly highlight the archival and historical value of public access to earlier issues of the National Geographic Magazine. But that anthem, while valid, does not trump other significant public policy aspects surrounding the CNG.

This Court began its analysis in Greenberg I by citing to the copyright clause in Article I of the U. S. Constitution, which secures “for limited Times to



Authors . . . the exclusive Right to their . . . Writing.” 244 F.3d at 1271 n.8. That clause, said the Court, “is the Rosetta Stone for all statutory interpretation and analysis.” Id. The Supreme Court in Tasini pursued a similar path. It adopted an observation by the Register of Copyrights that the 1976 revision of the Copyright Act represented “a break with a two-hundred-year-old tradition that had identified copyright more closely with the publisher than with the author.” 121 S.Ct. at 2388 n.3. The Court then said:

Congress’ adjustment of the author/publisher balance is a permissible expression of the “economic philosophy behind the [Copyright Clause],” i.e., “the conviction that encouragement of individual effort [motivated] by personal gain is the best way to advance public welfare.”

Id. (Citations omitted.) The creation by Congress of Section 201(c), outlining a presumptive privilege only, is a manifestation of the concepts delineated above. To preserve the motivational effort of authors, Congress wrote that reproduction of their works is not a right, but is a privilege in limited circumstances. An attempt to stretch those circumstances with “revisions” that do not revise is without meaning.

The Supreme Court also found the publishers’ warning about devastating consequences for the electronic record of history to be “unavailing.” Tasini, 121 S.Ct. at 2384. “[S]peculation about future harms is no basis for this Court to shrink authorial rights created by Congress.” Id. The Court noted that remedies

other than injunctions could be available, through negotiation or through action by Congress. Id. This Court said essentially the same thing in Greenberg I.

Greenberg's rights can be seen in a different perspective as well. In an affidavit filed with the district court, Greenberg said:

When I began a relationship with the Society as a contributor to the Magazine around 1960, and for many years thereafter, the Magazine was distributed only to Society members and the Society was purely a nonprofit institution. No other "market" for the photographs provided by me for the four articles published in the monthly Magazine was ever contemplated. Had I had any intimation that the Society would in later years expand its horizons for the Magazine into for-profit enterprises and digital products, I would have approached the jobs they offered me with a different set of expectations.

Affidavit attached to plaintiff's response to Memorandum from the Court dated October 26, 2000. (No docket entry). Such cautionary thinking helps explain why a reproduction privilege does not extend to new collective works.

In assessing the language of Section 201(c), the Court noted in Greenberg I that the statute's language contrasts the contributor's copyright "and any rights under it" with the publisher's "privilege." "This is an important distinction that militates in favor of narrowly construing the publisher's privilege when balancing

it against the constitutionally-secured rights of the author'/contributor." 244 Fed.3d at 1272.<sup>13</sup>

## II.

### **THE DISTRICT COURT DID NOT ERR IN STRIKING THE SOCIETY'S ANSWER**

On January 11, 2002, shortly after this Court's ruling in Greenberg I, the district court entered an Order Granting, in Part, Defendants' Motion for Additional Order of Reference; Denying Defendants' Cross-motion for Enlargement of Time; and Granting Plaintiffs' Motion to Strike Defendants' Answers. USDC D.E.90. The Society contends that the district court incorrectly read the mandate issued by the Court in Greenberg I by striking the Society's answer. "The upshot of that error," says the Society, "is that the district court precluded National Geographic from ever raising, in any court, any defense to copyright liability other than § 201(c), including the basic defense that Greenberg contractually authorized the disputed use of his photographs . . . ." Brief, 35-36.<sup>14</sup>

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<sup>13</sup> The Society's brief, at 23-24, suggests that the right/privilege distinction in Section 201(c) is of no consequence. It cites to the Supreme Court's disengagement from such a distinction in terms of constitutional law issues. Here, however, Congress used both words in the same paragraph, clearly conveying a legislative intention that a privilege is not of the same status as a right for the purpose of applying the statutory privilege.

<sup>14</sup> The Court can compare this statement with the Society's depiction of the mandate in its Statement of the Case and the Facts, at 11: "Because liability for

The Society has it upside-down. This Court's mandate precluded the district court from entertaining any defense to infringement. This Court reviews that question by determining the scope of the mandate in Greenberg I.

In striking the answer, the district court properly complied with the Court's mandate. The district court also acknowledged the rules of procedure.

**A. The District Court Correctly Followed the Mandate of this Court**

Greenberg I stated as follows:

We conclude that the unauthorized use of the Greenberg photographs in the CNG compiled and authored by the Society constitutes copyright infringement that is not excused by the privilege afforded under § 201(c). We also find that the unauthorized use of Greenberg's diver photograph in the derivative and collective work, the Sequence, compiled by the Society, constitutes copyright infringement, and that the proffered de minimis use defense is without merit.

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

244 F.3d at 1275-76. The Court thus found infringement to exist. It said the district court should next "ascertain the amount of damages and attorneys' fees that

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copyright infringement already had been determined as a matter of law, the case then proceeded to a jury trial on damages only."

are, if any, due . . . .” The Eleventh Circuit has “a well-settled ‘mandate rule’ obligating district courts to adhere closely to the dictates of our opinions.”

Pelletier v. Zweifell, 987 F.2d 716, 717 (11<sup>th</sup> Cir. 1993).

A district court may not alter, amend, or examine the mandate, or give any further relief or review, but must enter an order in strict compliance with the mandate. The trial court must implement both the letter and the spirit of the mandate, taking into account the appellate court’s opinion, and the circumstances it embraces . . . .[I]t is bound to follow the appellate court’s holdings, both expressed and implied.

Id. at 718. “[T]he law of the case encompasses all things decided by necessary implication as well as those decided explicitly.” Burger King Corp. v. Pilgrim’s Pride Corp., 15 F.3d 166, 169 (11<sup>th</sup> Cir. 1994). This Court plainly directed the district court to proceed to a determination of damages and attorney’s fees, if any, and injunctive relief. The instruction encompassed no liability issue. The district court followed “the letter and the spirit of the mandate, taking into account the appellate court’s opinion, and the circumstances it embraces . . . .” Pelletier, 987 F.2d at 718.

Following the Court’s ruling in Greenberg I, the Society filed a Petition for Rehearing and Petition for Rehearing En Banc, D.E. (4/12/01 No docket entry), in which, among other things, the Society asked the Court to “remand the case for the adjudication of any other factual, legal or equitable defenses to infringement.” Id.

at 14 n.3. This Court denied the petitions, thus determining that no defense remained for the Society.

The Court did agree, after initial entry of its opinion, that it was procedurally incorrect to direct entry of judgment for Greenberg because that was a role reserved to the district court after considering the remaining issues of damages and fees. It also was procedurally improper to declare Greenberg to be the prevailing party for purposes of attorneys' fees because such a determination is at the discretion of the district court after weighing various factors. See generally Fogerty v. Fantasy, Inc., 510 U.S. 517, 533-34 and n. 19, 114 S.Ct. 1023, 1033 and n. 19 (discussing discretion of district courts in awarding attorneys' fees in copyright cases). Thus the Court corrected its opinion (did not amend it) with no change in the original date of entry of the opinion.

The Society cites to Arrington v. City of Fairfield, 414 F.2d 687 (5<sup>th</sup> Cir. 1969), where the Court reversed an award of summary judgment to the defendant city. The city's motion had been filed pre-answer, as here. The Society notes that the Court required the defendant, on remand, to file an answer. The reversal, however, took place because factual issues remained to be resolved.

Greenberg I, in contrast, based its reversal on matters of law, noting no factual issues to be resolved and thus no need for a jury trial. As this Court said in Pelletier, 987 F.2d at 717, a district court on remand "is bound to follow the

appellate court's holdings, both expressed and implied." It is obvious that the Court, in fashioning its decision in Greenberg I, rejected any contract defense, as well as any other defense. As discussed in detail below, the defenses actually proffered by the Society in the district court were hollow and without merit.

The Society strains very hard to attach those supplemental words "if any" to the Court's reference in its ruling to damages for Greenberg. Brief 40. The Society says "[t]he key point . . . is that the corrected opinion . . . did not 'instruct[]' the district court to award damages or consider injunctive relief." Id.

This is not so. This Court did instruct the district court to "ascertain the amount of damages." 244 F.3d at 1276. It did not instruct the district court to consider other liability issues.

**B. The District Court's Ruling Could Not Have Impaired the Society's Defenses**

Although any remaining defenses were mooted by the Court's decision, any actual assertion of defenses would have been futile. In the answer filed, and stricken by the district court, the Society asserted four defenses: (1) failure to state a claim, (2) republication permitted by contract, (3) laches and (4) estoppel. D.E. 76. The Society's brief, at 43, says these were "all" of its defenses.

Subsequently, in Defendants' Motion for an Additional Order of Reference, USDC D.E. 83, the Society proffered two other defenses as follows:

- whether Tasini undermines the viability of Greenberg I
- whether Greenberg could recover with respect to images governed by the Copyright Act of 1909

Id. at 3. Because of the clear language in the mandate, however, the district court rightly determined that the mandate allowed no further liability question. In any event, under close examination the listed defenses fail.

The contract issue

The “basic defense” to which the Society repeatedly refers is that “Greenberg contractually authorized the disputed use of his photographs by National Geographic.” Brief, 36.

Significantly, the Society’s understandings with Greenberg emerged in the course of oral argument before the Court in Greenberg I, and at the conclusion of the argument period the Court verbally instructed the parties to provide copies of all documents reflecting any agreements between Greenberg and the National Geographic. That was followed by a directive issued on October 26, 2000.

[T]he parties are directed, under separate cover, to provide this court with copies of any agreements between Greenberg and the National Geographic Society (“Society”) in which Greenberg agreed to permit the Society to use his photographs in National Geographic Magazine (“Magazine”). The parties should also provide this court with a copy of the letter in which Greenberg requested the Society transfer all rights in his pictures back to him, as well as provide a copy of the document in which the Society transferred his rights back to him. If any of these documents are already in the record, the parties should provide the applicable citations to the record, as well.



Greenberg I, (No docket entry). Greenberg responded by submitting copies of every document setting forth an understanding between himself and the Society with respect to his photographs. Those documents are contained in Greenberg's Response to Memorandum from the Court, dated October 26, 2000. No docket entry.

When Greenberg wrote to the Society to ask for a reassignment to him of copyrights to his photographs, in a letter dated Nov. 15, 1985, he said in the requesting letter that "[t]his reassignment would have no effect on the Society's reuse of this material as this provision was covered in the original contracts for each assignment." Id. Interestingly, in his first agreement with the Society, in a letter dated June 6, 1960, Greenberg said: "I would like to work out an understanding with you in regards as to the re-use of the published material is concerned. I would work out an arrangement where by all requests for this material would be channeled through me. This way I would have some control as to its use in textbooks, encyclopedias, etc." Id. Greenberg plainly had concern about future uses of his photographs by the Society outside the monthly Magazine.

The Society seriously distorts testimony by Greenberg at the trial on damages: "Indeed, at trial, Greenberg admitted that the Society retained a continued license to use the photographs in its publications and other media whenever and however it wanted; in his view, the only thing that was required was

notification and payment . . . .” Brief, 36 n.4. However, Greenberg’s testimony at trial was that, after all rights had been conveyed to him in 1985 and 1989, the Society could continue to use the photographs. “All they would have to do, since I owned the copyright, is to come back and ask me for permission. I would give it to them. They would use it. And what they were paying me before it would be fine to continue at that.” (Emphasis added.) 2/28/03 Tr. 11.<sup>15</sup> It is undisputed that the Society never sought Greenberg’s permission to use his photographs in the CNG. It also is undisputed that Greenberg’s counsel wrote to the Society months before publication of the CNG to assert his rights as to the photographs; the Society received, and ignored, the letter.

Notwithstanding the colloquy above, the Society’s conveyance to Greenberg on December 18, 1985 involved “all right, title and interest, including copyright, in your photographs . . . .” The final conveyance letter of June 14, 1989 said that upon creation “all rights, including the copyright and world publication rights” would belong to the Society, except that 60 days after publication “all rights” would be returned to Greenberg. The conveyances thus were absolute. Both letters are in Greenberg’s Response to Memorandum from the Court dated October 26, 2000. (No docket entry).

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<sup>15</sup> The citation is to a trial date and a page number in that day’s transcript.

In view of the Society's decades of experience with copyright, its sophistication in dealing with contributors, and its expansive legal resources, the Society easily could have put qualifying language in the conveyance documents, but it did not.

In its opinion in Greenberg I, the Court included the following in its summary of the facts:

The terms of Greenberg's employment for these assignments were set out in a series of relatively informal letters. Greenberg received compensation consisting of a daily fee, a fee based on the number of photographs published, and payment of expenses, and in return the Society acquired all rights in any photograph taken on the jobs that was ultimately selected for publication in the Magazine. In 1985, at Greenberg's request, the Society reassigned its copyrights in the pictures from these three jobs back to Greenberg. Greenberg's fourth hire for the Society appeared in the July 1990 issue of the Magazine, but the agreement for this job was more detailed than its predecessors. The principle [sic] terms of the fourth agreement were similar to those of the first three; however, in this agreement it was explicitly provided that all rights that the Society acquired in the photographs from the job would be returned to Greenberg 60 days after the pictures were published in the Magazine.

244 F.3d at 1269. It is inconceivable that the Court would have held that copyright infringement existed,<sup>16</sup> if the correspondence referenced above – which the Court sought and obtained for review -- could be interpreted to reserve a right, or provide

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<sup>16</sup> “We conclude that the unauthorized use of the Greenberg photographs in the CNG compiled and authored by the Society constitutes copyright infringement . . . .” 244 F.3d at 1275.

a license, to the Society. The Court's decision referred to "the unauthorized use" of the photographs, indicating that nothing in the contract documents reviewed by the Court constituted an authorization. In light of this record, the purported affirmative defense based on contract would never have succeeded.

The 1909 Copyright Act issue

The Society advanced a defense in the district court to the effect that works created by Greenberg before January 1, 1978 – the effective date of the revised Copyright Act – are governed by the Copyright Act of 1909. Reply Memorandum of Law in Further Support of Defendants' Motion for Additional Order of Reference. USDC D.E. 88. The Society cited there a number of court decisions in support of its proposition. These cases do not give the Society any comfort.

Roth v. Pritikin, 710 F.2d 934, 939 (2d Cir. 1983), held that the "1978 Act does not affect the ownership rights of persons holding copyrights prior to January 1978." Playboy Enterprises, Inc. v. Dumas, 53 F.3d 549 (2d Cir. 1995), held that works of art produced before January 1, 1978 are governed by the Copyright Act of 1909 for the purpose of determining whether a painting produced prior to 1978 was a work-for-hire. Philadelphia Orchestra Ass'n v. Walt Disney Co., 821 F.Supp. 341, 347 n.7 (E.D.Pa. 1993), held that the 1909 Act controlled definitions of "work made for hire" and "joint authorship" under a 1939 contract.

All of those cases had to do with ownership questions pursuant to understandings that existed prior to 1978. Here, an absolute, unqualified conveyance of ownership pertaining to the Greenberg photographs took place in 1985 and 1989, as discussed in detail above. Put another way, any "license" that may have existed by contract prior to 1978 was abandoned by the absolute transfer in 1985 and 1989 of all rights to Greenberg. To suggest, as the Society did, that the 1909 Act "governs" the photographs is far off the mark.

#### Failure to State a Claim

The Court's review and ruling in Greenberg I certainly ratified that Greenberg had stated a claim upon which relief could be granted. Implicit in the decision is that Greenberg adequately alleged copyright infringement.

#### Laches and Estoppel

The Society told the district court that Greenberg was "barred by the doctrines of laches and estoppel from pursuing copyright claims against the Society because [he] sat on [his] rights too long." Defendants' Memorandum of Law in Support of Additional Order of Reference, at 8-9, USDC D.E. 88. The reason? "Since 1971, the Society has licensed the production of microfilm and microfiche copies of the Magazine without complaint from [Greenberg]. For years, the Society has also produced bound volumes of the Magazine without complaint from [Greenberg]." Id. We have located no court decision indicating that

reproduction of a magazine in microfilm, microfiche or bound annual volumes -- for libraries and archives -- constituted an unlawful practice.<sup>17</sup> As noted above, it is undisputed that Greenberg wrote to the Society in the spring of 1997 to inquire about the use of his photographs in the CNG and to express concern. The Society never responded.

#### The Proffered Affirmative Defenses are Meaningless

Given the mootness of the defenses as a consequence of this Court's Greenberg I decision, and given the lack of a foundation for any of the defenses asserted in detail to the district court (and in the Initial Brief here), any re-filing of an answer and defenses would be meaningless.

#### **C. The Society's Answer Was Not Timely**

Although the Court's mandate foreclosed other liability issues, the district court had another reason to strike the answers: they were not timely. That decision is reviewed by this Court *de novo*.

The Amended Complaint was served by hand on December 23, 1997. The response deadline, therefore, was January 13, 1998. A joint motion for an

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<sup>17</sup> The CEO of the Society, John Fahey, testified that no one had ever complained about the republication of the magazine in the bound edition, or by microfilm or microfiche. "It's a way for people to be able to reference material in a library without the library having to keep all of the issues" of magazines and other publications. 2/28/03 Tr. 73-74. For acknowledgement by the Society that microfilm and microfiche almost never are used in homes, see footnote 9 above.

enlargement of time for the response, prepared by the Society, was filed on January 8, 1998. Fifteen days of the response period thus had elapsed before the request for an enlargement was made. The enlargement motion, of course, tolled the remaining time. The defendants, utilizing the full enlargement period, timely served an alternative-purpose motion to dismiss or for summary judgment as to Counts III and V on January 30, 1998, but only five days remained for the service of an answer if the motion should be resolved adversely to the defendants.<sup>18</sup>

That adverse resolution occurred when this Court's mandate issued on October 16, 2001. The date on which the mandate is issued determines when a district court reacquires jurisdiction for further proceedings. See, e.g., U. S. v. Rivera, 844 F.2d 916, 921 (2d Cir. 1988). The clock started running on the Society's response time, therefore, on October 16, 2001. It served its answer on November 5, 2001. Under Rule 6, the Society had five days remaining within which to serve a responsive pleading. It served the response 20 days after issuance of the mandate. The Society obviously believed that the clock started all over again on a 20-day period to answer under Rule 6, but nothing in the rules provided

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<sup>18</sup> The Society contends that "defendants have 20 days after service of the complaint to file an answer," Brief at 44 n.6, and that it thus had 20 days after the appellate mandate to do so. It ignores that, after the complaint was served, 15 days of the 20-day response time had been used up.

the Society with a second full bite at the apple. Rule 6 reads in pertinent part as follows:

[T]he court for cause shown may at any time in its discretion (1) with or without motion or notice order the [response] period enlarged if request therefor is made before the expiration of the period originally prescribed . . . or (2) upon motion made after the expiration of the specified period permit the act to be done where the failure to act was the result of excusable neglect.

(Emphasis added). The rule thus required that any enlargement after a deadline may be granted only pursuant to a motion. The answers were also late if Rule 12(a)(4) were applied, with its 10-day response period. The Society made no timely request to the district court for an enlargement.<sup>19</sup> In any event, the Society had almost four years to contemplate the rules and the deadlines, so it hardly qualified for excusable neglect.<sup>20</sup> The answers were untimely and were stricken.

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<sup>19</sup> Alternatively, Rule 12 (a) (4) would apply. It provides that the service of a motion under Rule 12 alters the 20-day response time provided there, and specifies a 10-day response period after court action. In Broglie v. Mackay-Smith, 75 F.R.D. 739 (W.D.Va. 1977), the court applied that rule to a matter that had been reversed on appeal and remanded to the district court. The defendants, the court said, had 10 days from notification of the appellate action in which to file an answer. Here, the notice was the issuance of a mandate. The answers were filed outside a 10-day period.

<sup>20</sup> The Society contended below that Rule 12 should apply only when a Rule 12 motion is denied. In contrast, went their argument, the summary judgment motion was granted. But the reversal by this Court of summary judgment under Rule 56 is equivalent to a denial under Rule 12. Reversal by an appellate court



### III.

#### **THE JURY HAD ADEQUATE EVIDENCE TO FIND WILLFUL INFRINGEMENT**

##### **A. Introduction**

Eight jurors, not the customary six, found willful infringement in the trial below. They considered documentary evidence, testimony and the demeanor and credibility of witnesses. They were told about Tasini and about the ongoing sales of the CNG after Greenberg I. The jurors heard serious doubts about the Society's reliance on legal counsel regarding the CNG. The Society says that the reasonableness of its reliance on counsel is a question of law because it "depends on an evaluation of the law." Brief, 47. Not so in the trial below. The question was primarily one of fact, because Greenberg proposed to the jury that the outside counsel's advice was too late, and contended further that the counsel were largely uninformed about the actual contents of the CNG. Accordingly, the district court's action is reviewed for an abuse of discretion. These matters are discussed below.

A jury's finding can be overturned only when the finding was unlawful or when the court finds that the verdict was "contrary to the great, and not merely the greater, weight of the evidence." Williams v. City of Valdosta, 689 F.2d 964, 973

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renders a grant of summary judgment by a district court void. See Atlantic Coast Line R.R. Co. v. St. Joe Paper Co., 216 F.2d 832, 833 (5<sup>th</sup> Cir. 1954).

(11<sup>th</sup> Cir. 1982).<sup>21</sup> At page 46, the Society adroitly distorts the legal test for willful infringement, citing to cases requiring that the infringer must have known that its conduct was unlawful. But willfulness also can be found where the infringer recklessly disregarded a plaintiff's copyrights. See, e.g., Hamil America, Inc. v. GFI, 193 F.3d 92, 97 (2d Cir. 1999); Twin Peaks Productions, Inc. v. Publications Int'l, 996 F.2d 1366, 1382 (2d Cir. 1993).

**B. The Society Willfully Infringed by Flatly  
Dismissing This Court's Holding in *Greenberg I***

The Society says that "Greenberg I did not even hold National Geographic liable for copyright infringement . . . ." Brief, 50. "To the contrary, Greenberg I strongly suggested that the district court on remand should not force National Geographic to withdraw the CNG even if the work were ultimately found to be infringing."<sup>22</sup> (Emphasis in original.) Id. Those are astonishing statements.

First, this Court's mandate did not foreclose an injunction, but urged the district court to consider alternatives. The most onerous part of the quoted passage

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<sup>21</sup> The Society's brief, at 47, notes the magistrate judge's remark that the evidence of willfulness was weak. But the judge was not a juror, and evidence that would permit a repudiation of the jury's finding must be quite substantial, as this Court has explained. Notwithstanding, the evidence that the jury weighed, outlined infra, easily supports the finding.

<sup>22</sup> Nothing supports the qualifier the Society attaches to Greenberg I: "even if" the work were ultimately found to be infringing.

above is the assertion that this Court did not find infringement to exist.<sup>23</sup> The

Court said:

We conclude that the unauthorized use of the Greenberg photographs in the CNG compiled and authored by the Society constitutes copyright infringement . . . . We also find that the unauthorized use of Greenberg's diver photograph in the derivative and collective work, the Sequence, compiled by the Society, constitutes copyright infringement . . . . Upon remand, the district court should ascertain the amount of damages and attorneys fees that are due, if any, as well as any injunctive relief that may be appropriate. In assessing the appropriateness of any injunctive relief, we urge the court to consider alternatives, such as mandatory license fees . . . .

Greenberg I, 244 F.3d at 1275-76. As noted previously in this argument, supra at 21, the Society, in petitioning the Court in 2001 to reconsider Greenberg I, urged that other defenses needed resolution. The Court denied the petitions. Why would this Court order the district court to ascertain an amount of damages if liability, as the Society asserts, was an open issue? The defendants also petitioned the Supreme Court for a writ of certiorari and on October 9, 2001, the Supreme Court denied the petition.

The Society ignored the law fostered by this Court's decision and consciously and deliberately continued to infringe the copyrights thereafter.<sup>24</sup> No

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<sup>23</sup> The President and CEO of the Society testified about Greenberg I as follows: The court "said we were an infringer but we should not enjoin or stop distributing the products." Q. "You didn't stop infringing at that point, did you?" A. "No. And the number one reason we didn't is because the court told us we shouldn't [stop]." 3/3/03 Tr. 38. That is hardly what the Greenberg I mandate said.

stronger evidence of willful infringement could exist. The fact that in 2005 the Second Circuit, in Faulkner, disagreed with Greenberg I does not alter the state of the law as it applies to the Society in the Eleventh Circuit. It cannot be “reasonable” to flout that law, which directly targeted the CNG.<sup>25</sup>

The Society says that infringement is not necessarily willful where some court in another jurisdiction has previously decided that the very act in question was infringing, as long as that court’s decision was subject to reasonable debate. Brief, 50. The Society relies for that conclusion on Princeton Univ. Press v. Michigan Document Services, 99 F.3d 1381, 1392 (6<sup>th</sup> Cir. 1996). The Sixth Circuit found a defendant’s infringement not to be willful because the “fair use” defense under consideration there “is one of the most unsettled areas of the law” and subject to “reasonable disagreement.” Id. It does not follow that other defenses to infringement are entitled to that level of deference, or that other circuit courts would reach a similar conclusion. Importantly, unlike here, there is no

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<sup>24</sup> As noted above, the Society stopped sales of the CNG on the day after the trial on damages concluded. Thus between March 22, 2001, the date of Greenberg I and March 6, 2003 (one day after the jury’s verdict) sales of the CNG – and the infringements -- continued.

<sup>25</sup> In its Statement of the Case and the Facts, at 11, the Society concedes that “[b]ecause liability for copyright infringement already had been determined as a matter of law, the case then proceeded to a jury trial on damages only.” (Emphasis added.)

evidence that the defendant in Princeton continued the infringement after the Sixth Circuit held its conduct to be infringing.

Moreover, the Society's persistent contention that Greenberg I did not find liability evaporated on January 11, 2002, shortly after this Court's ruling in Greenberg I, when the district court entered its Order granting Greenberg's motion to strike the defendants' answers. The effect of that order was that no other defenses could exist. That became the law of the case. Until and unless the Society could see the district court's order reversed, it would never have defenses to the infringement of Greenberg's copyrights. Thus, from January 11, 2002 to March 6, 2003 (the day after the jury's verdict when CNG sales stopped), the Society could not even propose that this Court's mandate left the infringement door open. The infringement continued -- right through the trial on damages -- and it was willful.

**C. The Society's Reliance on Legal Counsel Was Not Reasonable**

Quite apart from the Society's indifference to Greenberg I, the infringement was willful because other evidence considered by the jury did not support a "reasonable" reliance on legal advice. The brief states, at page 49, that Greenberg focused his willfulness case at trial on the Society's conduct after Greenberg I and not on other conduct. Very much to the contrary, Greenberg also showed the jury how the Society's evidence that it relied on "advice of counsel" was shoddy.

Most prominently, the Society was committed to proceed with the CNG product by the time it began to seek and receive copyright guidance from its counsel. It was too late. That was important because a party cannot avoid a finding of willfulness if the “advice of counsel” was obtained only after the act of infringing occurred. See, e.g., Hospital for Sick Children v. Melody Fare Dinner Theatre, 516 F.Supp. 67 (E.D.Va. 1980); New York Chinese TV Programs, Inc. v. U.E. Enterprises, 1991 WL 113283 \*14 (S.D.N.Y. June 14, 1991). Among other things, unauthorized copying can be infringing.<sup>26</sup> The magazine archive had been digitally copied in 1996 and early 1997 (see Fahey testimony below), before three of the lawyers opined about its legality.

Additionally, the legal guidance obtained was unreliable in light of information not provided to the lawyers by the Society. Pointedly, the Section 201 (c) defense on which the Society has attempted to rely in the eight years of this litigation was never considered or mentioned by a lawyer until April 1997, long after the CNG was under heavy promotion in the marketplace.

John Fahey, President and CEO of the Society, testified that by September 1996 (the CNG went into the market in September 1997) the Society had committed contractually with one company to produce the CNG and with another

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<sup>26</sup> One of the exclusive rights reserved to the owner of a copyright is the right to “reproduce the copyrighted work in copies . . . .” 17 U.S.C. § 106.

to sell and distribute it. 2/28/03 Tr. 98. The copying of 108 years of the magazines was accomplished in 1996 and early 1997. Id. at 95. By early 1997 a costly marketing program was started. Id. at 99. One written legal opinion was received in early 1996 from lawyer Paul Kilmer. It contained no discussion of the CNG. 3/3/03 Tr. 68-69. Kilmer never saw the CNG product on which he was asked to opine. Id. at 33-34.

Kilmer provided another written opinion in February 1997. In it, he said that he had not been told previously that the CNG would be marketed primarily to consumers, rather than institutions, and he told the Society the legal risks had greatly increased. 3/3/03 Tr. 26-27. By that time the Society was committed heavily to the CNG.

A third opinion about the CNG came in late April 1997 from outside counsel Bob Sugarman, who for the first time advanced Section 201(c) as a possible defense to infringement. 3/3/03 Tr. 28.

None of those lawyers testified at the trial. No written opinion regarding the CNG was introduced into evidence. None of those lawyers inspected the CNG before rendering an opinion about it. The first Kilmer opinion never considered pertinent copyright issues. The second Kilmer opinion suddenly expressed grave reservations about the legality of the product. The Sugarman opinion came with the CNG already assembled and headed for market.

The Society says it “reasonably” relied on the advice of counsel before proceeding with the CNG. The jury could easily believe that the opinions were meaningless because it was too late to stop the CNG project, and because the lawyers had not been fully informed about the nature of the CNG. Even Suzanne Dupre, the in-house counsel, concluded that there would be no problem with the CNG -- without having any idea what the product might contain other than magazines. 3/3/03 Tr. 185. “I don’t think it even crossed my mind that there might be something at the beginning or the end. It didn’t matter.” *Id.* at 185-86. It did matter to this Court, however, as a matter of law.

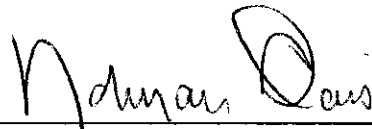
The “willful” finding was entirely proper. “Because willfulness is a factual issue, the [jury’s] weighing of testimony, demeanor, and credibility is, of course, deserving of our deference, and we shall overturn its finding only for clear error.” Wildlife Export Corp. v. Carol Wright Sales, 18 F.3d 502, 512 (7<sup>th</sup> Cir. 1994). When willfulness findings are based primarily on oral testimony, as here, “the appellant’s burden is especially great because the trial judge [or jury] had the opportunity to evaluate the demeanor and credibility of witnesses.” International Korwin Corp. v. Kowalczyk, 855 F.2d 375, 380 (7<sup>th</sup> Cir. 1988).



**CONCLUSION**

The Court should affirm the district court's order granting final judgment to Jerry Greenberg, and instruct the district court to determine an award of attorneys' fees, if any, and to resolve the pending motion for injunctive relief.

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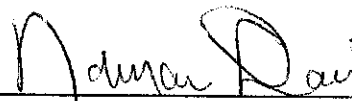


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**CERTIFICATE OF COMPLIANCE**

I hereby certify, pursuant to Rule 32(a)(7)(B), Federal Rules of Appellate Procedure, that this brief contains 11,108 words, based on a count determined by the word processing system utilized to prepare this brief.



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**CERTIFICATE OF SERVICE**

I hereby certify that on July 17, 2006, I served a copy of this brief by U. S.

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