
No. 05-16964-JJ

**In the United States Court of Appeals
for the Eleventh Circuit**

JERRY GREENBERG, INDIVIDUALLY

Plaintiff-Appellee,

IDAZ GREENBERG, INDIVIDUALLY

Plaintiff,

v.

NATIONAL GEOGRAPHIC SOCIETY, A DISTRICT OF COLUMBIA CORPORATION,
NATIONAL GEOGRAPHIC ENTERPRISES, INC., A CORPORATION,
MINDSCAPE, INC., A CALIFORNIA CORPORATION

Defendants-Appellants.

**On Appeal From The United States District
Court For The Southern District of Florida**

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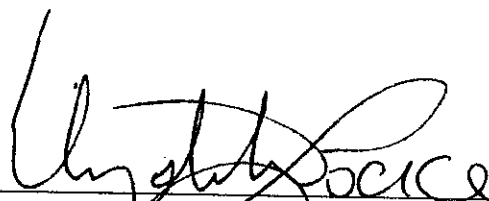
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STATEMENT REGARDING ORAL ARGUMENT

This case was argued before a panel of this Court on March 19, 2007. The Court subsequently issued its *en banc* order on September 19, 2007 indicating that oral argument will be set for the week of February 25, 2008.

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INTRODUCTION

This *en banc* case is about preserving the proper balance between the rights of publishers to reproduce their collective works (including magazines, newspapers, and other periodicals), and the rights of freelance contributors to those collective works to exploit their individual works of authorship (like photographs and articles). Congress struck that balance in Section 201(c) of the Copyright Act of 1976, and the Supreme Court reaffirmed the balance in the landmark case of *New York Times Co. v. Tasini*, 533 U.S. 483, 497 (2001).

The Copyright Act grants freelance authors the copyrights in their individual contributions to collective works, but grants the publishers of such works a separate copyright in the collective work and a privilege to reproduce such contributions “as part of ... any revision of that collective work.” 17 U.S.C. § 201(c).¹ That provision, the Supreme Court recognized in *Tasini*, strikes a balance between the rights of authors and publishers. In the absence of a contract to the contrary, a publisher may not exploit an individual freelance contribution

¹ Section 201(c) provides as follows:

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

outside the context of the original collective work, but may revise and reproduce the original collective work itself in a new medium. *See Tasini*, 533 U.S. at 502.

At issue before the *en banc* Court is “The Complete National Geographic,” (CNG), a thirty-disc CD-ROM set that reproduces each monthly issue of *National Geographic* magazine from 1888 through the late twentieth century. Like microfilm or microfiche, the CNG presents an exact (electronic) image of the original paper magazines, with pages presented two at a time in the very same sequence as in the original paper format. In *Greenberg I*, a panel of this Court—in a decision rendered prior to *Tasini*—held that this digital archive did not qualify as a “revision” within the meaning of § 201(c) because it added additional copyrightable material—a 25-second introductory sequence and a computer program—and thereby became a “new” collective work. According to *Greenberg I*, the creation of a “new” collective work is inherently inconsistent with the creation of a “revision.”

Tasini supplants and supercedes the analytical framework that the *Greenberg I* panel employed (without the benefit of the Supreme Court’s authoritative guidance). Under *Tasini*, the critical inquiry is not whether a “new” collective work has been created, but whether the freelance contribution has been presented in its original context. The legislative history of § 201(c) only confirms this point. A revised encyclopedia, for example, will certainly include new (and

independently copyrightable) entries—indeed, that is the whole purpose of a revision—but that does not mean that the revised encyclopedia is any less of a privileged “revision” within the meaning of § 201(c). For just this reason, the Second Circuit, speaking through Judge Winter, rejected *Greenberg I* in a post-*Tasini* case involving the very same product, the CNG. Writing for a unanimous panel, Judge Winter explained that the CNG is privileged under § 201(c) because it “presents the underlying works to users in the same context as they were presented to the users in the original versions of the Magazine.” *Faulkner v. National Geographic Enters., Inc.*, 409 F.3d 26, 38 (2d Cir. 2005). In so holding, the Second Circuit affirmed the judgment of Judge Lewis A. Kaplan, who held in an elaborate opinion that *Tasini’s* analytic framework was entirely inconsistent with *Greenberg I’s* pre-*Tasini* approach.

In *Greenberg II* (now vacated), a panel of this Court similarly acknowledged that *Tasini* fashioned a new framework for analyzing § 201(c)’s privilege, an approach contrary to *Greenberg I*. Drawing from the Second Circuit’s analysis in *Faulkner*, *Greenberg II* held that the CNG is a privileged “revision” under § 201(c) because it presents the individual photographs in the original context of the magazine. *See Greenberg v. National Geographic Soc’y.*, 488 F.3d 1331 (11th Cir.), *vacated*, 497 F.3d 1213 (11th Cir. 2007).

Both the Second Circuit and the *Greenberg II* panel (in its now-vacated opinion) recognized this pivotal point of law: *Greenberg I* is contrary to *Tasini*. *Id.*; 488 F.3d at 1338. Accordingly, National Geographic Society, National Geographic Enterprises, Inc., and Mindscape, Inc. (collectively “National Geographic”) respectfully request this Court to follow the governing legal framework, as set out in *Tasini*, with respect to the CNG. Because *Greenberg I* cannot be squared with *Tasini*, this Court should reconsider *Greenberg I* in light of *Tasini*. In particular, this Court should reaffirm *Greenberg II*’s analysis to avoid a post-*Tasini* conflict with the Second Circuit over the application of the *same* provision of the federal copyright laws to the *same* work.

The bottom line is that the copyright laws allow publishers such as National Geographic to employ new technology to preserve their collective works in electronic or digital format for the benefit of both the current and future generations. And that is a good thing for copyright law and the dissemination of knowledge and culture in the digital age. *Greenberg I*, however, thwarts this stewardship responsibility. The *Greenberg I* approach effectively denies publishers control over their own intellectual property and gives freelancers veto power over the publishers’ creation of their own archives. This is not only the view of the National Geographic Society. It is the view of librarians, archivists and historians whose views are presented to this *en banc* Court through amicus

briefs. It is the view of a unanimous Second Circuit, which read *Tasini* and saw that *Greenberg I* cannot stand in *Tasini*'s wake. It is the view of Judge Kaplan. It is the view set forth in *Greenberg II*, which harmonized the law of this Circuit with post-*Greenberg I* law. It is the view of scholarly commentators. And it is the view of the Register of Copyrights.²

Because no less is at stake than the preservation and diffusion of collective works, this Court should restore *Greenberg II*'s analysis, and reaffirm copyright's constitutional goal of "promot[ing] the Progress of Science and useful Arts." U.S. Const. art. I, § 8, cl. 8.

STATEMENT OF JURISDICTION

The district court had subject-matter jurisdiction under 28 U.S.C. § 1338, because the case arises under the federal copyright laws.

² Since 1897, the Register of Copyrights has headed the U.S. Copyright Office, the federal agency with discrete expertise in the copyright field. The Register is also tasked with federal enforcement of the copyright laws. In the wake of *Greenberg I*, the Register has publicly opined that the panel's decision was "dead wrong" in light of *Tasini*, and that an image-based page-by-page reproduction of a collective work on CD-ROM "would be permissible under [§ 201(c)]." 3/4/03 *Greenberg* Trial Tr. 48-49 (Adamson); *see also* Aff. of Terrence Adamson, at 6, Ex. 1 To Notice Of Filing Of Declaration (Docket No. 172) (S.D. Fla.) (filed 12/23/02). Given the statutory expertise in copyright delegated to the Register, the *en banc* Court may wish to invite the Register to submit the views of the Copyright Office with respect to the legal questions at issue.

This Court had jurisdiction over the *Greenberg II* appeal under 28 U.S.C. § 1291. The district court entered final judgment in Greenberg's favor on November 16, 2005. RE160. Greenberg filed a motion to amend the judgment (seeking an award of prejudgment interest) under Fed. R. Civ. P. 59(e) on November 23, 2005. National Geographic filed a notice of appeal from the final judgment on December 13, 2005. RE162. The district court denied Greenberg's post-judgment motion (thereby bringing the previously filed appeal to life, *see* Fed. R. App. P. 4(a)(4)(B)), on April 14, 2006. RE164-67.

This Court retains appellate jurisdiction when it holds the mandate for *en banc* review. Fed. R. App. P. 41(d).

STATEMENT OF THE ISSUE

In its Order of September 19, 2007, the *en banc* Court directed the parties to address the following issue:

Is Greenberg entitled to copyright protection for the subject work subsequent to the United States Supreme Court's decision in *New York Times Co. v. Tasini*, 533 U.S. 483 (2001)?

The corollary question is:

Whether, in light of the Supreme Court's decision in *Tasini*, National Geographic is entitled to the privilege of 17 U.S.C. § 201(c) when it reproduced Greenberg's photographs as part of an exact digital replica of the entire *National Geographic* magazine series, within which those photographs first appeared in print?

As a general matter, the answer to the first question is yes. Greenberg retains his copyright protection for his individual works. Those copyrights,

however, have not been infringed in this case because National Geographic, as the owner of the collective work copyright, is entitled to reproduce Greenberg's pictures in the CNG by virtue of § 201(c).

STATEMENT OF THE CASE AND THE FACTS

A. The Parties

National Geographic Society is one of the world's largest nonprofit scientific and educational organizations, with approximately ten million members worldwide. The Society engages in promoting and funding scientific research, exploration, and grants for geography education, with an historic mission "to increase and diffuse geographic knowledge." Since its founding in 1888, the Society has endeavored to advance that mission by publishing a monthly official journal, *National Geographic* magazine.

For over a century, the Society has reproduced back issues of the magazine in bound volumes. In addition, for nearly five decades the Society has reproduced back issues in microfiche and microfilm. With the advent of CD-ROM technology, the Society in 1997 produced "The Complete National Geographic" (CNG), a thirty-disc CD-ROM set containing each monthly issue of the magazine for the 108 years from 1888 through 1996. RE79. The CNG is an exact, image-based reproduction of the magazine. Every page of every issue remains as it was in the original paper version, including all page arrangements, articles,

photographs, graphics, advertising, and attributions. RE73-74, 80. The issues appear chronologically, from the earliest at the beginning of the first disc to the latest at the end of the thirtieth disc.

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Like every CD-ROM product, the CNG contains an underlying computer program. That program compresses and decompresses the images and allows the user to search an electronic index (just as a reader might search a paper index). RE80-81. Once retrieved through the search function, an article appears just as it did in the original paperbound magazine, with all of the surrounding materials from the original magazine. The CNG neither provides a mechanism for the user to separate the photographs from the text nor otherwise to edit the pages.

Whenever a CNG disc is inserted into a CD-ROM drive, it automatically launches a brief introductory sequence. The sequence begins with a display of the Society's logo and its theme song, followed by a short promotional message for Kodak, and a 25-second segment in which ten *National Geographic* magazine covers digitally fade into each other. RE79-80. A user need only view these elements once; when the user opens the program on subsequent occasions, he or she can skip the introductory sequence altogether by mouse-clicking it once.

After placing CNG on the market, National Geographic, as the owner of the collective work, registered the CNG with the United States Copyright Office,

SEPARATE PHOTOS
EDIT PAGES
MOVING COVER AUTOPLAY

claiming a copyright in the “[b]rief introductory audiovisual montage.” The Copyright Office registered the CNG copyright effective July 14, 1998.

Plaintiff-appellee Jerry Greenberg is a freelance photographer whose pictures were published in the January 1962, February 1968, May 1971, and July 1990 issues of *National Geographic* magazine. RE78.

B. *Greenberg I*

Greenberg filed this lawsuit in December 1997, alleging (among other things) that the Society’s digital reproduction of his photographs in the CNG infringed his individual copyrights. RE42-60. (There is no dispute that Greenberg authorized the initial publication of his photographs in *National Geographic*.)³

³ Prior to § 201(c)’s revision in 1976, freelance contributors lost their individual copyright upon the contribution’s publication in a collective work unless the contribution was printed with a copyright notice in the freelancer’s name. See *Tasini*, 533 U.S. at 494. Greenberg’s 1962, 1968, and 1971 photographs were printed without such a notice. Accordingly, in a letter dated November 15, 1985, Greenberg asked National Geographic for “a re-assignment of copyright from the Society” with respect to those photographs. Joint Trial Ex. 18, RE136. “This re-assignment,” he continued, “*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.* (emphasis added). National Geographic replied to Greenberg in a letter dated December 18, 1985, and (for no monetary consideration, and no motive other than good will) voluntarily “assign[ed] to [Greenberg] all right, title and interest, including copyright, in [his] photographs appearing in *National Geographic Magazine*.” Joint Trial Ex. 19, RE137. National Geographic’s letter thus reassigned its copyright in the individual contributions back to Greenberg so that he could exploit those individual works outside of the context of *National Geographic* magazine. That voluntary reassignment, however, in no way addressed or limited National Geographic’s copyright in the collective work.

(Continued...)

Before answering those allegations, the Society moved to dismiss those claims, or in the alternative for summary judgment. The district court (Lenard, J.) granted summary judgment in National Geographic's favor on the copyright claims involving the CNG. *See* 5/14/98 Order, RE67-75. As the district court explained, federal copyright law grants the publisher of a collective work (like National Geographic) a copyright in the collective work as a whole, and the author of an individual contribution to a collective work (like Greenberg) a copyright in that individual contribution. RE70-71 (citing 17 U.S.C. § 201(c)). Because the CNG reproduced the entire collective work as a whole, not Greenberg's individual contribution isolated from the context of the entire collective work, the court held that the Society did not infringe Greenberg's copyrights in the individual photographs. *See* RE71-74.

Greenberg appealed, and this Court reversed. *See* 3/22/01 Opinion, RE76-97. The *Greenberg I* panel held that § 201(c) did not apply to a "new" collective work (as opposed to a "revision" of the original collective work), and that the CNG was a "new" collective work because it included additional copyrightable material

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 if National Geographic had a policy of paying for reuse. *See* 2/27/03 Tr. 91, 159-71 (Greenberg).

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(the computer program and the introductory sequence). *See* RE87-90 & n.12. The *Greenberg I* Court also held that the use of the January 1962 cover photograph in the introductory sequence violated Greenberg's copyright in that photograph. *See* RE90-94. In a concluding paragraph, the Court remanded the case, and stated that "[u]pon remand, the court below is directed to enter judgment on these copyright claims in favor of Greenberg." RE94-95.

National Geographic moved for rehearing and noted, among other things, that there was no basis for this Court to direct entry of judgment in Greenberg's favor on liability for copyright infringement. As National Geographic explained, the only issue on appeal was whether the district court erred in granting National Geographic summary judgment under § 201(c), and thus none of the Society's other defenses to copyright liability had been implicated or adjudicated. While that petition was pending, this Court issued a corrected opinion *deleting* the sentence directing the district court to enter judgment on the copyright claims in Greenberg's favor. *See* 3/22/01 (post-dated) Corrected Opinion, published at 244 F.3d 1267 (11th Cir. 2001). This Court subsequently denied rehearing, and National Geographic unsuccessfully sought review of the decision in the U.S. Supreme Court. *See National Geographic Soc'y v. Greenberg*, 534 U.S. 951 (2001) (denying certiorari in No. 01-186).

C. *Tasini and Faulkner*

Shortly after this Court decided *Greenberg I* and denied National Geographic's petition for rehearing, the United States Supreme Court decided *New York Times Co. v. Tasini*, 533 U.S. 483 (2001). That case involved the use of individual freelance contributions in electronic databases (e.g., LEXIS/NEXIS) that removed the individual contributions from the context of the original collective work. The *Tasini* Court held that § 201(c) did not apply there *precisely because* the individual contributions were divorced from their original context. *See id.* at 499-502. The Court specifically distinguished the electronic databases at issue in *Tasini* from microfilm and microfiche, which present an individual freelance contribution in the context of the original collective work. *See id.* at 501-02.

On remand from *Greenberg I*, the trial court held that because liability for copyright infringement already had been determined as a matter of law, the case should proceed to a jury trial on damages only. The jury returned a verdict that National Geographic's infringement had been "willful," and awarded the maximum statutory damages of \$100,000 for each of the four works at issue, for a total award of \$400,000. 5/5/03 Verdict, RE139.

In December 2003, while various post-trial motions remained pending in the *Greenberg* litigation, the U.S. District Court for the Southern District of New York

granted summary judgment in National Geographic's favor in another copyright infringement case involving the same product at issue here, the CNG. See *Faulkner v. National Geographic Soc'y*, 294 F. Supp. 2d 523 (S.D.N.Y. 2003), *aff'd*, 409 F.3d 26 (2d Cir. 2005). The *Faulkner* plaintiffs were freelance contributors (like Greenberg) whose photographs were published in various issues of *National Geographic*. Based on *Greenberg I*, the *Faulkner* plaintiffs sought to use non-mutual offensive collateral estoppel to bar National Geographic from claiming that its use of their photographs was privileged under § 201(c). The district court (Kaplan, J.) rejected the claims. In a comprehensive opinion, Judge Kaplan meticulously explained that the Supreme Court in *Tasini* "took a different approach" to § 201(c) than *Greenberg I*, and therefore declined to apply issue preclusion. See *id.* at 537; see also *id.* ("[T]he difference in the Supreme Court's approach to the revision issue ... is striking."). On the merits, Judge Kaplan concluded that

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[t]he material [in the CNG], once it is accessed via the software, is presented to, and perceptible by, the user precisely as it appeared in print. In this respect, therefore, it is precisely comparable to the microforms to which the Supreme Court referred approvingly in *Tasini*. It certainly contains elements that are consistent and recognizable from the *Magazine* so that a relationship between the original and the CNG is apparent.

Id. at 540-41 (internal quotations & alteration omitted). Judge Kaplan thus concluded that "the CNG is a revision of the individual print issues of the

Magazine,” and “respectfully disagree[d] with so much of *Greenberg* as held otherwise.” *Id.* at 543. The New York plaintiffs appealed.

In March 2005, again while the post-trial motions in the *Greenberg* litigation remained pending, the Second Circuit (speaking through Judge Winter)⁴ unanimously affirmed Judge Kaplan’s ruling. *See Faulkner v. National Geographic Enters. Inc.*, 409 F.3d 26 (2d Cir. 2005). Of particular relevance, the Second Circuit agreed with Judge Kaplan (i) that the CNG was a “revision” of the original collective works within the meaning of § 201(c), and (ii) that *Greenberg I* was not entitled to collateral estoppel effect because it conflicted with the Supreme Court’s subsequent ruling in *Tasini*. *See id.* at 37-39 (“In our view, the *Tasini* approach so substantially departs from the *Greenberg* analysis that it represents an intervening change in law rendering application of collateral estoppel inappropriate.”).

D. *Greenberg II*

In September 2005 (more than two years after the jury verdict), the magistrate judge in the instant case denied National Geographic’s post-trial motions. *See* 9/30/05 Order, RE146-56. In particular, the magistrate judge held

⁴ It bears emphasis that Judge Winter was also the author of the Second Circuit’s decision in *Tasini v. New York Times Co.*, 206 F.3d 161 (2d Cir. 2000). That judgment was affirmed by the United States Supreme Court in the watershed case that now controls the issue before this *en banc* Court.

(i) “that a reasonable jury could find that Defendants were willful in their infringement of Plaintiff’s copyright,” RE150; and (ii) that her conclusion “is not altered by the fact that the Second Circuit Court of Appeals has disagreed with the decision of the Eleventh Circuit Court of Appeals. ... The Eleventh Circuit’s decision is the law of this case, thus the [Second Circuit] decision is not persuasive.” *Id.* The magistrate judge entered judgment in Greenberg’s favor. *See* 11/16/05 Order, RE157-59; Judgment, RE160-61.

National Geographic appealed, arguing (among other things) that this Court should reconsider its decision in *Greenberg I* in light of the Supreme Court’s supervening decision in *Tasini*. Appellants’ Br. 17-27. In particular, National Geographic argued, *Tasini* makes clear that the pivotal question under § 201(c) is whether a collective work perceptively reproduces the disputed freelance contribution within its original context. *Id.* at 21. *Greenberg I*’s analysis, National Geographic further argued, is thus fundamentally at odds with *Tasini*. The former focuses on whether a collective work includes additional copyrightable material, whereas the latter focuses on whether the collective work is so substantially revised that the individual contribution is presented “clear of the context provided ... by the original periodical editions.” *Tasini*, 533 U.S. at 499; *see also* Appellants’ Br. at 21-22. The *Greenberg II* panel agreed, concluding that “[i]t is clear ... that the addition of new material to a collective work will not, by itself,

take the revised collective work outside the privilege [of § 201(c)].” *Greenberg II*, 488 F.3d at 1338-39. Because *Tasini* established “a new, post-*Greenberg I* framework for analyzing the § 201(c) privilege,” the panel determined that it was not bound by the prior panel precedent rule. *Id.* at 1338.

On July 29, 2007, Greenberg filed a petition for rehearing *en banc* solely on the issue whether the *Greenberg II* panel erred by relying on *Tasini*’s analytical framework in light of *Greenberg I*. Importantly, Greenberg did not seek *en banc* review of the *Greenberg II* panel’s two other holdings—that the district court (i) improperly struck National Geographic’s answer, and (ii) erroneously permitted the jury to find that National Geographic willfully violated § 201(c). This Court granted Greenberg’s limited petition on August 30, 2007. *Greenberg*, 497 F.3d 1213 (11th Cir. 2007). Specifically, this Court directed the parties to brief the question whether Greenberg is entitled to copyright protection under § 201(c) for the reproduction of his photographs in the CNG.

STANDARDS OF REVIEW

The extent to which *Tasini* creates a new framework for analyzing § 201(c)’s privilege that overrules or conflicts with *Greenberg I* is a question of law reviewed *de novo*. See, e.g., *Transamerica Leasing, Inc. v. Institute of London Underwriters*, 430 F.3d 1326, 1331 (11th Cir. 2005); *Alphamed, Inc. v. B. Braun Med., Inc.*, 367 F.3d 1280 (11th Cir. 2004). Whether National Geographic is

entitled to the privilege of 17 U.S.C. § 201(c) for the CNG under the Supreme Court's decision in *Tasini* presents a mixed question of law and fact that is also reviewed *de novo*. Cf. *Cable/Home Commc'n Corp. v. Network Prods., Inc.*, 902 F.2d 829, 844 (11th Cir. 1990) (whether fair use defense applies is a mixed question of fact and law); see also *Jennings v. McDonough*, 490 F.3d 1230, 1236 (11th Cir. 2007) (mixed questions of law and fact are reviewed *de novo*).

SUMMARY OF ARGUMENT

Section 201(c) of the Copyright Act strikes a balance between the rights of authors of individual contributions (such as Greenberg) to exploit their contributions, while permitting publishers of collective works (such as National Geographic) to reproduce their works in new media. Interpreting this provision, the Supreme Court in *New York Times Co. v. Tasini*, 533 U.S. 483, 494 (2001), placed dispositive emphasis on how the freelance work is "presented to, and perceptible by, the user [of the work]." Where the contribution is presented outside the context provided by the original collective work (here, *National Geographic* magazine), then the collective copyright holder has infringed the freelancer's copyright in the individual work. In contrast, where, as here, the original context of the collective work is preserved, such as in microfilm, microfiche, or a digital archive of the original collective work, the publisher of the

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collective work is protected by § 201(c) when the publisher simply reproduces the collective work as a whole in a new medium.

The Complete National Geographic readily fits within *Tasini*'s demarcation of § 201(c)'s boundaries. The CNG is a comprehensive archive of *National Geographic* magazine and presents its users with an exact image-based reproduction of each issue from the time of the Society's founding in 1888. National Geographic is not exploiting the freelancers' contributions outside the context of the original work, but to the contrary is faithfully reproducing the original collective work (each issue of the Magazine) in a new, digital medium. The CNG thus qualifies both as "part of that particular collective work" and as a "revision" of the collective work within the meaning of § 201(c).

In *Tasini*'s wake, seven federal judges have correctly come to the conclusion that the CNG, as a digital archive of past issues of *National Geographic* magazine, is protected by § 201(c). Four federal judges in the *Faulkner* litigation in the Second Circuit and the unanimous panel in *Greenberg II* looked to *Tasini* for authoritative guidance, and concluded that the CNG constituted a permissible "revision" within the meaning of § 201(c). Those judges correctly determined that the earlier panel in *Greenberg I* fashioned an analytical approach that was inconsistent with *Tasini*'s supervening interpretation of that pivotal provision of the Copyright Act. It is *Tasini*, not *Greenberg I*, that guides the analysis of the *en*

banc Court. To conclude to the contrary would be inconsistent with *Tasini*, create a circuit split with respect to the very same product (the CNG), and at the same time profoundly disserve important interests in the preservation and diffusion of collective works.

In all events, the limited *en banc* review of the § 201(c) issue does not affect the *Greenberg II* panel's independent determinations that the district court improperly struck National Geographic's answer and erroneously permitted the jury to find a "willful" violation of § 201(c). Those independent holdings are not the subject of the limited *en banc* review and therefore should be reinstated. The judgment below should therefore be reversed.

ARGUMENT

As a threshold matter, this Court—sitting *en banc*—is at liberty to consider afresh whether the Supreme Court's decision in *Tasini* grants the owner of a copyright in a collective work the right to reproduce that work from its paperbound editions to a digital archive under § 201(c) of the Copyright Act. In *Tasini*, the Supreme Court drew a line, and, as the *Greenberg II* panel properly recognized, the CNG falls well within the line of § 201(c)'s protection for reproductions. Because the *Greenberg I* holding cannot be squared with *Tasini*, the Supreme Court's conclusion represents controlling law. Indeed, failure to restore

Greenberg II's analysis would create a clear post-*Tasini* circuit split as to this very product.

I. National Geographic Is Entitled To The § 201(c) Privilege In Light Of *Tasini*.

Section 201(c) of the Copyright Act recognizes two distinct and independent copyrights: one in the collective works of publishers in their creation, and another in the original work of authorship of freelance contributors. 17 U.S.C. § 201(c); *see also Tasini*, 533 U.S. at 493-94 (citing § 201(c)). With respect to the former, the copyright protects only the creative material contributed by a publisher, such as its "selection, coordination, and arrangement." 533 U.S. at 494. The copyright in the original work, however, vests exclusively with the freelance contributor. *Id.* To retain the divisible nature of the two copyrights, any reproduction of the compilation must balance the right of authors of individual contributions to exploit those contributions while, at the same time, permitting publishers of collective works to reproduce their works in various forms. Section 201(c) accomplishes this goal by granting the publishers of a collective work (like National Geographic) the privilege to reproduce freelance contributions "as part of that particular collective work," or as "any revision" of the collective work. 17 U.S.C. § 201(c). Section 201(c) states in pertinent part:

In the absence of an express transfer of the copyright ..., 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

express transfer
?

that particular collective work, any revision of that collective work, and any later collective work in the same series.

Id.

Addressing a question of first impression, the Supreme Court in *Tasini* analyzed how an individual contribution may be used as part of a privileged reproduction for purposes of § 201(c). The CNG clearly falls comfortably within *Tasini*'s enumerated boundaries. To strike the appropriate balance between the copyrights in the collective and individual works, *Tasini* focuses on how the freelance work is "presented to, and perceptible by, the user [of the work]." 533 U.S. at 499. Where the contribution is presented "clear of the context provided ... by the original periodical editions," the collective copyright holder has infringed the freelancer's copyright in the individual work. *Id.* This makes perfect sense in light of what each copyright protects—the collective work's creative selection, coordination and arrangement, versus the creative work of the individual contribution itself. Thus, to permit a publisher to reproduce an individual article or photograph outside the context of a magazine or periodical in which it was first published would be to permit a publisher to profit from a creative process of which it was not a part.

Accordingly, *Tasini* makes clear that a "revision" of a collective work is protected under § 201(c) if it presents an individual contribution as part of "a new version, [which] is ... a 'distinct form of something regarded by its creator or

others as one work.”” *Id.* at 500 (quoting Webster’s Third New International Dictionary 1944, 2545 (1976)). Drawing on the legislative history of § 201(c), the Supreme Court demonstrated precisely what kinds of revisions would be privileged:

In accord with Congress’ prescription, 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.”

Id. at 496-97 (quoting H.R. Rep. 94-1476, at 122-23, (1976), reprinted in 1976 U.S.C.C.A.N. 5659, 5738). The *Tasini* Court went out of its way to note that the reproduction of a collective work in microfilm or microfiche also qualifies for the privilege. As the Court explained, “articles appear on the microforms, writ very small, in precisely the position in which the articles appeared in the newspaper.” *Id.* at 501. Although “the microfilm roll contains multiple editions, and the microfilm user can adjust the machine lens to focus only on [an] Article, to the exclusion of surrounding material,” the dispositive fact remains that the user “encounters the Article in context.” *Id.* In this regard, the Court expressly reaffirmed the Copyright Act’s neutrality towards revisions of collective works in a new medium.

The CNG is, in effect, a digital form of the microform example the Supreme Court extolled in *Tasini*. The CNG reproduced Greenberg’s photos “as part of” or

as a “revision” of the original *National Geographic* magazine, but merely in a new medium. The CNG presents its users with an exact image-based reproduction of each issue of *National Geographic* magazine in CD-ROM format. As the *Greenberg I* panel rightly acknowledged, “[w]hat the user of the CNG sees on his computer screen ... is a reproduction of each page of the Magazine that differs from the original only in the size and resolution of the photographs and text.” 244 F.3d at 1269. Because “[e]very cover, article, advertisement, and photograph appears as it did in the original paper copy of the Magazine,” *id.*, the CNG simply reproduced freelance contributions in a new medium. National Geographic is not exploiting the freelancers’ contributions outside the context of the original collective work (e.g., by putting a particular photograph on a coffee mug, or in a book or calendar).⁵ To the contrary, the CNG faithfully reproduces the original collective work itself in a new medium.

Although the Supreme Court based its decision in *Tasini* on the “revision” prong of § 201(c) (just like this Court’s decision in *Greenberg II*), this does not

⁵ Indeed, Greenberg has been compensated by other periodicals for the further use of his photographs that first appeared in *National Geographic*. For example, National Geographic paid Greenberg \$750 for the use of one of his photographs in *National Geographic Traveler* magazine. Tr. 201-02 (2/27/03). Greenberg also sold two sets of photographs to *Audubon* and *Boys’ Life* magazines for \$3500 each. *Id.* at 195, 201. Finally, Greenberg sold a photograph of a spadefish for use in a calendar, as well as in a book entitled “Fishes Beneath The Tropic Sea.” *Id.* at 206.

alter the fact that the CNG reproduced Greenberg's photographs "as part of that particular collective work." § 201(c). A "particular collective work" does not cease to be a "particular collective work" just because it is reproduced in a new medium or because it contains other introductory material as "bookends" (here the introductory sequence and the Kodak promotion). To be sure, a freelance contribution to *National Geographic* magazine, for example, cannot be reproduced in *The New Yorker*, the *Encyclopedia Britannica*, or a collection of articles on a particular topic. But this does not mean that a publisher cannot include "a particular work"—here, an issue of *National Geographic*—in its entirety in a new (and independently copyrightable) collective work—here, the CNG. The creation of a new collective work (whether copyrightable or copyrighted in its own right) is simply not inconsistent with the preservation of the "particular collective work" in which an individual's contributions appeared. One collective work can form part of another, just as a Sunday magazine forms part of a Sunday newspaper. Thus, a publisher is free to reproduce a "particular collective work" in a new media (such as microfilm, microfiche, or CD-ROM) regardless of whether the resulting product is itself a "new" collective work through the addition of new, original elements.

The CNG is precisely that. Greenberg's photographs still appear in the CNG exactly as they originally appeared in the magazine. *See Greenberg II*, 448 F.3d at 1338 ("Clearly the Replica portion of the CNG preserves the original context of the

magazines, because it comprises the exact images of each page of the original magazines.”).

The CNG is also a “revision” of *National Geographic* magazine. The Supreme Court in *Tasini*, citing Webster’s Third New International Dictionary 1944, 2545 (1976), described a revision as a “distinct form of something *regarded by its creator and others as one work.*” *Tasini*, 533 U.S. at 500 (emphasis added). The CNG is a comprehensive archive of 108 years of *National Geographic* magazine, presented to the user with exactly the same individual contributions, arranged in the same way, with each presented in the same context. The CNG differs from a complete collection of *National Geographic* magazines only in that it adds an introductory sequence of photographs at the start of the program.

False
web context

In light of that pivotal fact, the *Faulkner* district court correctly recognized that the CNG is a “revision” because it is “readily recognizable as a variation” of *National Geographic* magazine. *Faulkner*, 294 F. Supp. 2d at 543. That decision was affirmed by a three-judge panel of the Second Circuit. *Faulkner*, 409 F.3d at 38 (“[A] permissible revision may contain elements not found in the original—for example, a collection of bound volumes of past issues with a copyrightable index to the entire collection.”) (citing *Tasini*, 206 F.3d at 167).

The *Greenberg II* panel likewise correctly held (among other things) that the CNG constituted a permissible revision under § 201(c).⁶ “Under the *Tasini* framework, the relevant question is whether the original context of the collective work has been preserved in the revision.” 488 F.3d at 1338. As the panel opined, “[c]learly the Replica portion of the CNG preserves the original context of the magazines, because it comprises the exact images of each page of the original

⁶ The *Greenberg II* panel also correctly held that the district court erred by directing a judgment against National Geographic and striking its answer, which was filed 20 days after this case was remanded by this Court. The *Greenberg II* panel was correct for two reasons. *First*, in entering judgment against National Geographic on the issue of liability for copyright infringement, the district court misunderstood the scope of *Greenberg I*’s mandate. The *Greenberg I* decision was amended *sua sponte* by this Court to delete a sentence that “[u]pon remand, the court below is directed to enter judgment on these copyright claims in favor of Greenberg.” *Greenberg I* simply did not present the issue whether National Geographic was liable for copyright infringement; rather, it presented only the question whether National Geographic was entitled to summary judgment under § 201(c). Thus, the district court erroneously stripped National Geographic of its right to interpose other defenses based on a then-deleted sentence in *Greenberg I*. As the *Greenberg II* panel recognized, there simply was no mandate ordering an entry of judgment on copyright liability. 488 F.3d at 1340. *Second*, *Greenberg II* also correctly held that the district court improperly struck National Geographic’s answer as untimely. Under the Federal Rules of Civil Procedure, “a defendant may file a motion under Rule 12 before filing an answer to a complaint.” 488 F.3d at 1340. Because the Rules set no timeline for filing an answer after an appellate court’s reversal of a dispositive motion, the 20-day period in which National Geographic filed its answer was not untimely. *Id.* These arguments are more fully developed in Appellants’ Opening Brief in *Greenberg II*, at 35-44, filed 05/30/06. *See also supra* at p. 16. It bears repeating that neither holding is before this *en banc* Court. Accordingly, at minimum *Greenberg II*’s judgment should be reinstated with respect to these two points.

magazines.” *Id.* *Greenberg II* thus properly applied the Supreme Court’s analytical framework by focusing not on what was added to the collective work, but rather on whether the CNG preserved the original context of Greenberg’s photographs as they first appeared in *National Geographic* magazine. It is irrelevant, as *Greenberg II* properly recognized, that the CNG contains an introductory sequence. That sequence

is nothing more than a brief visual introduction to the [CNG], which acts as a virtual cover for the collection of magazines. *Just as a new cover on an encyclopedia would not change the context of the entries in the encyclopedia, the [introductory s]equence in no way alters the context in which the original photographs (as well as the articles and advertisements) were presented.*

448 F.3d at 1339 (emphasis added).

In short, four federal judges in the *Faulkner* litigation and the unanimous panel in *Greenberg II* looked to *Tasini* for authoritative guidance. We therefore turn to *Tasini* in greater detail. At issue in *Tasini* was the reproduction of individual freelance contributions in three electronic databases that were not in the context of their prior collective work: (1) LEXIS/NEXIS, (2) the New York Times OnDisc (NTYO), and (3) General Periodicals OnDisc (GPO). *See Tasini*, 533 U.S. at 488-91. The Court held that these reproductions fell outside the scope of § 201(c) because in the databases at issue “each article is presented to, and retrievable by, the user in isolation, clear of the context the original print publication presented.” *Id.* at 487; *see also id.* at 488 (“The publishers are not

sheltered by § 201(c), ... because the databases reproduce and distribute articles standing alone and not in context.”). With respect to LEXIS/NEXIS and NYTO, both of which store individual articles from collective works in text-only format, “an article appears to a user without the graphics, formatting, or other articles with which the article was initially published.” *Id.* at 500. And with respect to GPO, which stores individual articles from collective works in image-based format, “the article appears with the other materials published on the same page or pages, but without any material published on other pages of the original periodical.” *Id.*

The *Tasini* Court thus drew a line to balance the interests of the author of the collective work and the author of the individual contribution. *Id.* at 500-01 (“The Databases’ reproduction and distribution of individual Articles—as *individual articles*—would invade the core of the Author’s exclusive rights under § 106.”) (emphasis in original). This balance makes perfect sense both in light of the divisible nature of copyright and from a public policy perspective. *Tasini* makes clear that collective-work owners can bring their periodicals to a new, more technologically advanced medium. This permits publishers to share their creations with a wider market for public use and consumption. At the click of a mouse, generations to come will be able to access and view untold numbers of educational periodicals with limitless amounts of information. *See generally* Br. of Amicus Curiae Magazine Publishers of America, 2006 WL 4402465 (June 7, 2006).

Equally important, archivists and libraries greatly benefit as well. Rather than housing every newspaper and magazine in print format, online and CD-ROM versions can be used for storage, greatly reducing libraries' space requirements.⁷ Finally, like microfiche, electronic media may provide a more reliable method for archival and preservation purposes than printed materials. *See generally* Br. of Amicus Curiae American Library Association, 2006 WL 4402466 (June 6, 2006) .

II. *Greenberg I* Conflicts with *Tasini*.

Relying on *Greenberg I*, appellees ask this Court to upset the balance between authors and publishers carefully struck by § 201(c) and specifically recognized by the Supreme Court in *Tasini*. This reliance is totally misplaced. As the Second Circuit concluded, *Greenberg I* is fundamentally at odds with *Tasini*.

Until the mid-1990s, no case had examined § 201(c) and its (undefined) privilege provisions. With the advent of new digital technologies, publishers and archivists alike created more efficient ways of producing and storing periodical

⁷ Moreover, it is impossible as a practical matter to preserve paperbound magazines indefinitely. Their repeated use causes wear and tear. Additionally, paper periodicals can be defaced or removed from library shelves. Digital archives, therefore, are highly important to preserve fragile publications for generations to come. *See generally* Br. of Amicus Curiae JSTOR, 2004 WL 3756760, at *26 (June 30, 2004) (submitted to the Second Circuit in *Faulkner*) ("For example, in many early journals, engraved illustrations—such as Audubon illustrations—have been removed to be framed as art. Content in some print journals has been destroyed by users who have disagreed with its contents or wanted to thwart other researchers' use of the journal.").

literature. *Tasini* presented the Supreme Court with its first occasion to interpret § 201(c). Before the Supreme Court could give guidance to this Court (and with no guidance from sister circuits), *Greenberg I* presented this Court with its first occasion to define a protected “revision” under § 201(c). This Court concluded that “[i]n layman’s terms, the [CNG] is in no sense a ‘revision,’” 244 F.3d at 1272, and therefore not privileged under § 201(c). Instead, the *Greenberg I* Court reasoned, the CNG is a “new” collective work because National Geographic added independently copyrightable materials to the digital replica—the computer program and the introductory sequence. 244 F.3d at 1273 n.12.

Greenberg I’s approach—where the dispositive issue under § 201(c) is whether a “new” collective work has been created—cannot be squared with *Tasini*. Under the latter decision, to determine whether underlying works have been reproduced as part of a “revision” of a collective work, a court must “focus on the [individual contributions] as presented to, and perceptible by, the user of the [CNG].” *Tasini*, 533 U.S. at 499. While the former dispositively focuses on what has been added to a collective work, the latter dispositively focuses on what a user perceives. The Second Circuit in *Faulkner* recognized the substantial analytical gap between these two approaches. We set forth here the pivotal passage from Judge Winter’s opinion:

Greenberg held that if a subsequent work contains independently copyrightable elements not present in the original collective work, it

cannot be a revision privileged by Section 201(c). Several months later, however, the Supreme Court held in *Tasini* that the critical analysis focused on whether the underlying works were presented by the particular database in the context of the original works. For example, in a straightforward application of that analysis, it also strongly implied, by contrasting the database to microfilm, that microfilm would constitute a privileged revision. 533 U.S. at 501. In our view, the *Tasini* approach so substantially departs from the *Greenberg* analysis that it represents an intervening change in law rendering application of collateral estoppel inappropriate.

409 F.3d at 37.⁸

Under *Tasini*, therefore, whether additional copyrightable material has been added is immaterial, so long as the “revision” presents the underlying work in its original context. *Id.* at 37-38. The analytical gap between *Tasini* and *Greenberg I*

⁸ Clear disagreement exists between, on the one hand, the U.S. District Court for Southern District of New York, the Second Circuit, and the *Greenberg II* panel, and, on the other hand, the *Greenberg I* panel as to whether National Geographic’s use of individual photographs is protected under § 201(c). In light of this disagreement, it was erroneous for the magistrate judge on remand from *Greenberg I* to permit a jury to consider whether National Geographic had “willfully” infringed Greenberg’s copyright. “Willfully,” as this Court has previously noted, “means with knowledge that the defendant’s conduct constitutes copyright infringement.” *MCA Television Ltd. v. Feltner*, 89 F.3d 766, 768 (11th Cir. 1996) (defining “willfully” in the context of § 504(c) of the Copyright Act) (internal quotation omitted). No one could seriously contend that National Geographic knew the CNG would not be privileged under § 201(c) if the forgoing authorities could not agree on that question. This issue is discussed in detail in Appellants’ Opening Brief in *Greenberg II*, at 45-53, filed 05/30/06. In light of the limited scope of the question appellees’ petitioned for *en banc* review—namely National Geographic’s right to reproduce a collective work in which it holds a copyright under § 201(c) post-*Tasini*—the *Greenberg II* panel’s decision to vacate the jury’s finding that National Geographic willfully violated § 201(c) should be restored. 488 F.3d at 1341. *See supra* at p. 16.

is starkly revealed by the fact that each of the databases at issue in *Tasini* contained computer programs that were independently copyrightable. Yet, in contrast to *Greenberg I*, the Supreme Court not only failed to make this point essential to the outcome, it accorded the point no weight at all. In fact, *Tasini* did not cite *Greenberg I* for any proposition of law.

The Supreme Court's failure to accord *Greenberg I* any weight is unsurprising. The *Greenberg I* panel's focus on the addition of new materials cannot be reconciled with the very legislative history of § 201(c) upon which it (and *Tasini*) relied. To discern the meaning of "revision" under § 201(c), the *Greenberg I* panel based its conclusion not on "dictionaries or colloquial meanings," 244 F.3d at 1272, but on the following passage from the legislative history:

Under the language of [§ 201(c)] 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*.

Id. at 1272-73 (quoting H.R. Rep. No. 94-1476, at 122-23 (1976), reprinted in 1976 U.S.C.C.A.N. 5659, 5738; emphasis added in *Greenberg I*).⁹ By stringing

⁹ It was premature to resort to § 201(c)'s legislative history before considering traditional canons of statutory interpretation. See *Shotz v. City of Plantation*, 344 F.3d 1161, 1167 (11th Cir. 2003) (Birch, J.) ("If the statutory language is not
(Continued...)

together the italicized words from that passage, the *Greenberg I* panel created the following sentence: “[T]he publisher could not include [the contribution] in an other collective work.” The panel then substituted the word “new” for the word “other” and interpreted that sentence to mean that the creation of a “new” collective work necessarily negates the existence of a “revision.” *See id.* at 1273. Under this view, the CNG is an “other collective work”—as opposed to a “revision”—because it includes not only the original magazines, but also the independently copyrightable introductory sequence and computer program. *See id.*; *see also id.* at 1272 (“Assuming *arguendo*, but expressly not deciding, that 201(c)’s revision privilege embraces the entirety of the Replica portion of the CNG ..., we are unable to stretch the phrase ‘that particular collective work’ to encompass the Sequence and Program elements as well.”); *id.* at 1273 (“[T]he Society ... has created a new product ... in a new medium, for a new market that

entirely transparent, we employ traditional canons of construction before reverting to legislative history to assist us in determining the meaning of a particular statutory provision by focusing on the broader, statutory context.”) (alteration and quotation omitted). Instead, to decipher the plain meaning of the word “revision” in § 201(c), the *Greenberg I* panel should have looked first to common parlance and dictionaries. *See, e.g., Price v. Time, Inc.*, 416 F.3d 1327, 1337 (11th Cir. 2005) (“The use of dictionaries to define words used in statutes is, of course, a more accepted and more defensible approach to determining the plain meaning of statutory language. ... Accordingly, we will look at both [general purpose dictionaries and legal] dictionaries to determine the natural, plain, ordinary, and commonly understood meaning of the word newspaper.”) (internal quotations omitted).

far transcends any privilege of revision or other mere reproduction envisioned in § 201(c)."); *id.* at 1274 ("[I]n creating a new work the Society forfeited any privilege that it might have enjoyed with respect to only one component thereof, the Replica.") (emphasis & footnote omitted).

The *Greenberg I* panel fell into error. To hold that a "revision" of a collective work cannot be a "new" collective work is flawed in both logic and law. There is no inconsistency between a "revision" and the creation of a "new" collective work. To the contrary, *Tasini* makes clear that a revision is, by definition, a new collective work. *Tasini*, 533 U.S. at 500 ("'Revision' denotes a new 'version,' and a version is ... a 'distinct form of something regarded by its creator or others as one work.'") (quoting Webster's Third New International Dictionary 1944, 2545 (1976)) (emphasis added). For example, a new edition of an encyclopedia may reproduce an unchanged freelance contribution about dinosaurs, even if the new edition adds a new (and independently copyrightable) contribution about thermodynamics. Indeed, the very legislative history of § 201(c) upon which *Greenberg I* relied expressly states that "reprint[ing] an article from a 1980 edition of an encyclopedia in a 1990 revision of it" would be privileged, 244 F.3d at 1273 (quoting H.R. Rep. No. 94-1476, at 122 (1976), reprinted in 1976 U.S.C.C.A.N. 5659, 5738), even though the 1990 revision obviously would contain new and independently copyrightable material.

On this score, the *Greenberg II* panel correctly declined to follow *Greenberg I*. Because “*Tasini* creates a new, post-*Greenberg I* framework for analyzing the § 201(c) privilege,” 488 F.3d at 1338, the appropriate question is not whether new, independently copyrightable materials have been added to the CNG. Instead, *Greenberg II* properly focused on whether those materials “so alter ... the CNG as a whole [that it] is no longer a privileged revision.” *Id.* It rightly concluded that it did not. With respect to the introductory sequence, *Greenberg II* concluded that a brief introductory sequence to the collective work simply does not alter the entire context from which *Greenberg*’s photographs are presented:

Just as the addition of 400 pages of prose to a sonnet does not constitute a “revision” of the sonnet, the addition of a preface to a 400-page anthology would not transform the book into a different collective work. So it is here. The [introductory s]equence is nothing more than a brief visual introduction to the *Replica*, which acts as a virtual cover for the collection of magazines.

Id. at 1339.

The computer program, which is also independently copyrightable, “is transparent to the viewer and does not alter the original context of the magazine contents.” *Id.* at 1338. Unlike *Greenberg I*, the *Greenberg II* panel asked the right question and reached the right answer.

Greenberg I not only misinterprets the legislative history to suggest a “new” collective work is something wholly distinct from a “revision,” it also misconstrued the legislative history (and departs from *Tasini*’s analysis) in another

critical respect. By cobbling together select phrases—“[T]he publisher could not include [the contribution] in an other collective work”—this Court omitted the term “entirely different” from the text of the legislative history.¹⁰ Use of the words “entirely different” suggests that a “collective work that is merely somewhat different from the original in which the contribution appeared” would be privileged under § 201(c). *Faulkner*, 294 F. Supp. 2d at 539. Again, a “new” collective work is not invariably an “entirely different” collective work. The *Greenberg I* panel erred by focusing only on whether a “new” (or “other”) collective work was created, as opposed to whether such a new collective work is “entirely different” from the original.¹¹ *See id.* As Judge Kaplan explained:

¹⁰ A close reading of this sentence reveals that the words “entirely different” modify not only “magazine,” but also “other collective work.” The phrase “other collective work” lacks its own preceding article (unlike “a new anthology” and “an entirely different magazine”), and therefore must borrow the article “an” preceding “entirely different magazine.” Moreover, the word “or” between “magazine” and “other collective work” suggests that those items should be grouped together as something distinct from “a new anthology.” Compare H.R. Rep. 94-1476, at 122-23 (1976), reprinted in 1976 U.S.C.C.A.N. 5659, 5738 (“[T]he publisher could not revise the contribution itself or include it in a new anthology or an entirely different magazine or other collective work.”) with *Greenberg I*, 244 F.3d at 1273 (“[T]he publisher could not ... include [the contribution] in ... an ... other collective work.”) (emphasis added in *Greenberg I*; alterations supplied).

¹¹ Thus, the *Greenberg I* panel erred on two scores. First, (unlike *Tasini*) it erred by resorting to legislative history before deciphering the statute’s plain meaning, including the use of dictionaries. *See supra* at p. 32-33 n.9. Second, it materially misread the relevant legislative history. In doing so, the *Greenberg I* panel unnecessarily spawned confusion with respect to § 201(c)’s interpretation. (Continued...)

Greenberg's holding—that the presence of independently copyrightable material is inconsistent with a conclusion that the CNG is a “revision” of the print versions of the *Magazine*—cannot be reconciled with the legislative history. *Indeed, it defies the very legislative history upon which the Eleventh Circuit relied.*

Id. (emphasis modified; internal quotation omitted); *see also* Jennifer L. Livingston, Casenote, *Digital “Revision”: Greenberg v. National Geographic Society*, 70 U. Cin. L. Rev. 1419, 1430 (2002) (“[T]he [*Greenberg I*] court’s interpretation of section 201(c) is in conflict with a natural reading of the very legislative history the court cites in its support.”); *id.* at 1431 (“[T]hroughout the legislative history, it is clear that Congress intended (and publishers and freelancers agreed) that publishers would maintain a presumptive privilege to publish revisions of their collective works.”).

Greenberg I also conflicts with *Tasini* to the extent that *Greenberg I* relied on the fact that § 201(c) grants the publisher of a collective work “only a privilege, not a right.” 244 F.3d at 1272 (internal quotation omitted). In the *Greenberg I* panel’s view, “[t]his is an important distinction that militates in favor of narrowly construing the publisher’s privilege when balancing it against the constitutionally-

See United States v. Second Nat’l Bank of N. Miami, 502 F.2d 535, 541 n.5 (5th Cir. 1974) (“In undertaking to probe the legislative history of this statute, we are wary of the dangers of reaching a decision that, in the eloquent words of Mr. Justice Jackson, [‘]pulls federal law, not only out of the dark where it has been hidden, but into a fog in which little can be seen if found.[’]”) (quoting *United States v. Public Util. Comm’n*, 345 U.S. 295, 320 (1953) (concurring opinion)).

secured rights of the author/contributor.” *Id. Tasini*, however, attached no weight to this would-be distinction. Indeed, *Tasini* makes clear that *both* the author and the publisher have “constitutionally-secured rights” at issue. The author has a copyright in his individual contribution, whereas the publisher has a copyright in the collective work as a whole. 533 U.S. at 493-97. Whether a publisher can rely on § 201(c) in any particular case depends on whether the individual contribution remains in the context of the collective work, not on any right/privilege distinction. Especially in view of the fact that the Supreme Court has backed away from the right/privilege distinction in constitutional law, *see, e.g., Board of Regents v. Roth*, 408 U.S. 564, 571 (1972); *see generally* William Van Alstyne, *The Demise of the Right-Privilege Distinction in Constitutional Law*, 81 Harv. L. Rev. 1439 (1968), this Court should be loath to imbue any such distinction with talismanic significance in copyright law.

In addition, *Greenberg I* conflicts with *Tasini* to the extent it relied on the fact that the CNG reproduced the original collective work “in a new medium.” 244 F.3d at 1273. *Tasini* reaffirmed the bedrock principle that the Copyright Act is medium-neutral. Accordingly, “the transfer of a work between media does not alter the character of that work for copyright purposes.” 533 U.S. at 502 (internal quotation and brackets omitted); *see also Faulkner*, 409 F.3d at 40 (“The transfer of a work from one medium to another generally does not alter its character for

copyright purposes.”). Thus, a publisher is entitled to reproduce collective works in new media, as long as it reproduces “intact periodicals,” not “individual articles.” *Tasini*, 533 U.S. at 502. That is why the “crucial fact” in *Tasini* was that “the [challenged] Databases ... store and retrieve articles *separately* within a vast domain of diverse texts,” rather than leaving the articles within the context of the particular collective works to which the authors contributed. *Id.* at 503 (emphasis added). Contrary to *Greenberg I*’s analysis, the privilege turns on the preservation of the integrity of the original collective work, not on the technology of the medium of reproduction. *See, e.g.,* Livingston, *supra*, 70 U. Cin. L. Rev. at 1434 (“[*Greenberg I*] takes a position squarely in conflict with copyright law’s established principle of media neutrality.”).¹²

¹² The *Greenberg I* panel asserted in a footnote that its decision was consistent with the principle of medium-neutrality because CD-ROMs (like the CNG) include computer programs, which “are themselves the subject matter of copyright, and may constitute original works of authorship.” 244 F.3d at 1273 n.12. That is a *non sequitur*. As long as an individual freelance contribution remains in the context of the original collective work, it is immaterial whether the transformation of the original collective work from one medium to another involves the addition of independently copyrightable material. It is not “medium-neutral,” in other words, to say that the addition of independently copyrightable material necessarily destroys the § 201(c) privilege, because the transition from one medium to another may often involve the addition of independently copyrightable material. Indeed, *Greenberg I* would prevent a publisher like National Geographic from reproducing a collective work even in “old” media (such as microfilm and microfiche) because these media at least potentially include independently copyrightable elements, such as an introductory page and a subject, title, and author-based index.

(Continued...)

Similarly, the *Greenberg I* panel erred by attaching any weight to the proposition that the CNG was “created ... for a new market.” 244 F.3d at 1273. Nothing in the text or legislative history of § 201(c) suggests that the existence of a “revision” of an original collective work turns on the “market” for such a product. The statute does not allocate rights in different “markets.” Rather, it gives authors a copyright in their individual work and publishers a copyright in the collective work as a whole. Whether a revised collective work is sold in a different “market” than the original has no bearing on whether the revision alters the original context. Bound volumes of *National Geographic* magazine or rolls of microfilm or sheets of microfiche may serve a different “market” (e.g., libraries) than individual issues

The Copyright Office’s registration practices for works of authorship embodied on a CD-ROM is consistent with this approach. In response to the *Greenberg I* panel opinion, David Carson, General Counsel to the U.S. Copyright Office, explained that

[t]he 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.*

See Letter From D. Carson to T. Adamson, at 4 (05/02/01) (emphasis added). This letter was previously submitted to the *Greenberg I* panel in support of National Geographic’s petition for rehearing or rehearing *en banc*, but was stricken (without
(Continued...)

of the magazine, but no one would seriously suggest that appellants are not entitled to publish past issues in these other media. Indeed, *Tasini* suggests just the opposite by embracing microforms even though they are directed at a different market than the paper publications they reproduce. Thus, under *Tasini's* analysis, the fact that a CD-ROM version of *National Geographic* magazine appeals to a wider audience than, say, a more dated form of replication, such as microfilm, is irrelevant. If anything, a wider market audience for educational materials such as the CNG "promotes the Progress of Science and useful Arts." U.S. Const. art. I, § 8, cl.8.

In spite of the myriad differences between the analysis in *Tasini* and *Greenberg I*, appellees nevertheless contend that *Greenberg I* remains the law of the land. They make much ado that *Tasini* was decided on different facts and, therefore, cannot be controlling in this case. See Pet'n For Rehearing *En Banc* at 5 ("Because *Tasini*, indeed, was decided on totally different facts ... its holding could not be an intervening change in law affecting *Greenberg I*."); see also *id.* at 7 ("The Supreme Court did not overrule *Greenberg I*."); *id.* at 6 ("A strong implication in a Supreme Court opinion can hardly be an adequate basis upon which to overturn a prior panel decision in this Court."). This misses the key

explanation) by a single-judge order. For the *en banc* Court's benefit, we respectfully submit this letter as Attachment A to this brief.

point. *Tasini* set forth and then applied an *analysis* inconsistent with *Greenberg I*. It is immaterial, in this regard, that *Tasini* did not expressly overrule *Greenberg I*, or that *Tasini* had no occasion to consider the CNG. Moreover, *Tasini* provides more than a “strong implication” that exact reproductions of a collective work in a new medium are protected under § 201(c). Indeed, *Tasini* says so directly. Compare *Tasini*, 533 U.S. at 504 (“Under § 201(c), the question is ... whether the [collective work] perceptibly presents the author’s contribution as part of a revision of the collective work.”) with *id.* at 501-02 (“In short, *unlike microforms*, the 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).

Because *Tasini* cannot be squared with *Greenberg I* (as both the *Greenberg II* panel and the Second Circuit in *Faulkner* recognized), it would be inappropriate for this Court *en banc* to reaffirm *Greenberg I* notwithstanding *Tasini*’s teaching. See *Glazner v. Glazner*, 347 F.3d 1212, 1216 (11th Cir. 2003) (*en banc*) (“While we agree ... that the concept of the rule of law underlying our Constitution requires a substantial measure of continuity, certainty, and respect for precedent, we must follow the Supreme Court’s instruction that *stare decisis* should be abandoned where, as here, a prior judicial ruling should come to be seen so clearly as error that its enforcement was for that very reason doomed.”) (internal

quotations omitted). To do so would not only be unfaithful to *Tasini*, it would create two diametrically opposed rulings in two federal judicial circuits regarding the same product. See *Faulkner*, 409 F.3d at 38 (“[W]e hold that, because the original context of the Magazines is omnipresent in the CNG and because it is a new version of the Magazine, the CNG is a privileged revision.”); see also *Faulkner*, 294 F. Supp. 2d at 537 (“[T]he difference in the Supreme Court’s approach [and *Greenberg I*’s approach] to the revision issue is striking.”), *id.* at 543 (“[T]he Court holds that the CNG is a revision of the individual print issues of the Magazine, [and] respectfully disagrees with so much of [*Greenberg I*] as held otherwise.”).¹³

The bottom line is that this Court, sitting *en banc*, has both the power and the duty to follow *Tasini*, not *Greenberg I*. *Greenberg I* essentially wrote the “revision” privilege out of the law by its holding that there can be no “revision” if new material is added or old material changed. The reason is this: by definition, there can be no “revision” *unless* new material is added or old material changed. That is the whole point of a revision. *Greenberg I* thus made it impossible for publishers to create digital archives of their collective works in CD-ROM format,

¹³ Moreover, one member of the *Greenberg I* panel has expressly recognized that *Tasini* “abrogated” *Greenberg I* “as recognized by [*Greenberg II*].” See *BUC Int’l Corp. v. International Yacht Council Ltd.*, 489 F.3d 1129 (11th Cir. 2007) (Tjoflat, J.).

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IMPOSSIBLE**

because the inevitable addition of independently copyrightable material (such as a computer program) would defeat the § 201(c) privilege. It is impossible, as a practical matter, for those publishers (like National Geographic) that have already created CD-ROM archives of their collective works (or those that seek to do so) to reach retroactive license agreements with their many thousands of past freelance contributors. Some contributors may not be located; some may grant licenses; some, of course, may not; or some may just attach a wholly unreasonable value to their previously compensated contributions to the collective work.¹⁴ The only solution for such publishers is to withdraw their CD-ROM products (as National Geographic did with the CNG after the jury verdict in this case). *See generally* Br. of Amicus Curiae Magazine Publishers of America, 2006 WL 4402465 (June 7, 2006).

This is an enormous loss.¹⁵ *See generally* Br. of Amicus Curiae American Library Association, 2006 WL 4402466, at *13 (June 6, 2006) (“Under

¹⁴ For example, in the *Faulkner* litigation, one plaintiff has alleged that the use of his photographs in the CNG is valued at over \$181,000 per photograph. Because National Geographic has published approximately 530 photographs by this one individual, the plaintiff claimed damages in excess of \$96 million. *See* Motion For Summary Judgment, *Ward v. National Geographic Society, et al.*, No. 99-cv-12385, Docket No. 64, at 22 (S.D.N.Y. Apr. 10, 2002).

¹⁵ Not only is the loss of enormous magnitude, it exposes other publishers to the prospect of massive liability. Indeed, since the Supreme Court’s decision in *Tasini* and the Second Circuit’s decision in *Faulkner*, publishers have devoted
(Continued...)

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- 65 ITEMS

Greenberg I, as a practical matter, no collective work reproduced or distributed via CD-ROM, online technology, or other new technology ... could ever qualify for the Section 201(c) privilege"). The elimination of a valuable "educational" archive like the CNG, *Greenberg I*, 244 F.3d at 1275, which has allowed easy, quick, and inexpensive access to collective works, harms not only National Geographic, but also countless individuals, students, and scholars. "Taking from publishers the privilege to create electronic archives like The Complete National Geographic most certainly deprives society of the sort of fast, efficient, and inexpensive access to collective works that such a medium is uniquely positioned to offer." Livingston, *supra*, 70 U. Cin. L. Rev. at 1436.

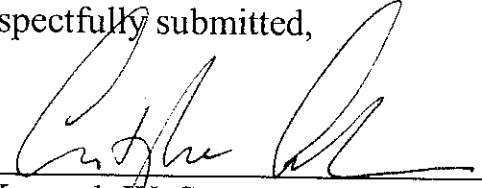
CONCLUSION

For the foregoing reasons, this Court should reverse the judgment.

LETTY IND.
STUDENT, SCHOLAR

considerable resources to make back issues available to the public in digital forms. *The Complete New Yorker: Eighty Years of the Nation's Greatest Magazine* has been published on DVD-ROMs and on a portable hard drive. Other publications either are or will soon be available in digital form. Moreover, past issues of newspapers such as *The New York Times* and *Hartford Courant* (among others) are available in their entirety though online services such as ProQuest.

Respectfully submitted,



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October 18, 2007

CERTIFICATE OF BRIEF LENGTH

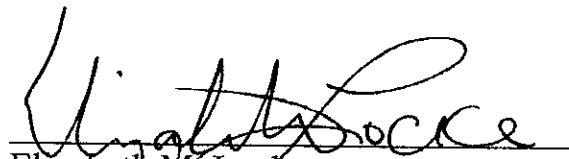
Pursuant to Fed. R. App. P. 32(a)(7)(B) and (C), I hereby certify that this brief contains 11,503 words, on the basis of a count made by the word processing system used to prepare the brief.


Elizabeth M. Locke

CERTIFICATE OF SERVICE

I hereby certify that on this 18th day of October 2007, I served two true and correct copies of the foregoing *En Banc* Brief of Appellant by Federal Express on the following counsel:

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Elizabeth M. Locke

Attachment A

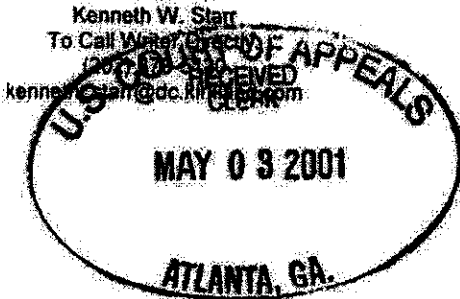
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May 2, 2001

VIA MESSENGER

Mr. Thomas K. Kahn
Clerk of Court
United States Court of Appeals
for the Eleventh Circuit
56 Forsyth Street, N.W.
Atlanta, GA 30303

Re: *Greenberg v. National Geographic Society, et al.*,
Docket No. 00-10510
Amendment to Petition for Rehearing *En Banc*

Dear Mr. Kahn:

We received on Monday, April 30, the "corrected opinion" in the above-captioned case. Because this corrected opinion addresses one of the questions raised in our petition for rehearing (Question Number 3 concerning the award of attorneys' fees) and the error concerning entry of judgment for the plaintiffs pointed out at page 14, footnote 3, of the petition, we wish to notify the entire *en banc* court that we respectfully withdraw Question Number 3 (pp. 13-14) and that portion of the brief concerning entry of judgment for the plaintiffs (p. 14, note 3).

In addition to the merits of our petition relating to Section 201(c) of the Copyright Act (addressed in Question 1 of our petition), the corrected opinion fails to correct the accusation of "fraud" on the Copyright Office by National Geographic at footnote 13 of the opinion, which is addressed in Question 2 of our petition. We have today received a letter from the General Counsel of the Copyright Office of the United States, David Carson, bearing directly on the appropriateness of the registration filed by the National Geographic Society in the application process with the Copyright Office.

KIRKLAND & ELLIS

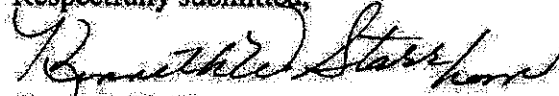
Mr. Thomas K. Kahn

May 2, 2001

Page 2

We respectfully request that you provide this letter to all of the active judges considering the petition and the attached letter from the Copyright Office of the United States.

Respectfully submitted,



Kenneth W. Starr

cc: Norman Davis, Esq.



LIBRARY
OF
CONGRESS

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OFFICE

May 2, 2001

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Avenue, S.E.

Terrence B Adamson
Executive Vice President
The National Geographic Society
1145 17th Street NW
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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").

May 2, 2001

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*,

* 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."

* 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-

* 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."

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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.