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VIA FEDERAL EXPRESS

Thomas K. Kahn, Clerk
U.S. Court of Appeals for the 11th Circuit
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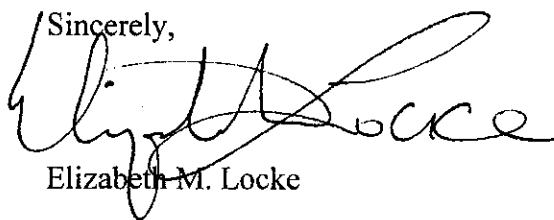
Re: *Greenberg v. National Geographic Soc'y et al.*, No. 05-16964-JJ

Dear Mr. Kahn:

Enclosed for filing today, pursuant to the Court's September 17, 2007 Briefing Order, please find 18 copies of Appellant's En Banc Reply Brief. I have also enclosed one additional En Banc Reply Brief; please file-stamp and return it to me in the enclosed Federal Express Envelope.

Pursuant to Eleventh Circuit Rule 31-5, I have uploaded an electronic version of the En Banc Reply Brief to the Court's website. If you have any questions, please do not hesitate to contact me at the number noted above. Thank you for your assistance.

Sincerely,



Elizabeth M. Locke

cc: Norman Davis, Esq.

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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INTRODUCTION

In his En Banc Brief, Greenberg misconceives the law and misapprehends the facts. As to the law, Greenberg recognizes that no fewer than seven federal judges, with the benefit of the Supreme Court's guidance in *New York Times Co., Inc. v. Tasini*, 533 U.S. 483 (2001), have determined that the analysis in *Greenberg I* cannot be squared with *Tasini's* supervening teaching. Greenberg's tack in response is (i) to highlight and distinguish *Tasini's* facts, and (ii) to transmogrify *Tasini's* straightforward analysis of 17 U.S.C. § 201(c)'s "revision" prong into a convoluted analytic framework, and in the process limit the Supreme Court's elaborate emphasis upon fidelity to original context as merely a threshold, preliminary inquiry. We respond in Parts I and II.

In the process, Greenberg tellingly retreats in significant part from *Greenberg I's* analysis. He understands, as did both the *Greenberg II* panel and the Second Circuit in *Faulkner*, that a computer program is indispensable in converting a publication from print to digital format. See *Greenberg v. National Geographic Soc'y*, 488 F.3d 1331, 1338 (11th Cir.), *vacated*, 497 F.3d 1213 (11th Cir. 2007); *Faulkner v. National Geographic Enters., Inc.*, 409 F.3d 26, 38 (2d Cir. 2005). This, Greenberg would allow as consistent with § 201(c). Rightly so. A CD-Rom or DVD simply cannot work without a computer software program, which is separately copyrightable. His concession is pivotally important, for it

strikes at the heart of the *Greenberg I* analysis. That pre-*Tasini* approach—if left standing by the *en banc* Court—renders the conversion of aging print media to readily accessible digital archives impossible as a practical matter. The reason: Notwithstanding the *Greenberg I* panel’s express hopes, no silver remedial bullet is at hand. Freelance authors, such as Greenberg, are demanding in some instances literally millions of dollars (each) for articles published in *National Geographic Magazine* and reproduced in the CNG, even though those authors remained (rightly) silent throughout the decades of microform reproduction of collective works.

No reason in law, logic, or policy requires this odd result. In producing the CNG, National Geographic has not exploited Greenberg’s sixty-four individual photographs (as Greenberg, in fact, has continued to do). To the contrary, the Society has reproduced the entire corpus of the century-plus body of *National Geographic Magazines*—approximately 180,000 images in precise and exact context—as Congress intended the Society (and other publishers of collective works) to be able to do. At all events, this Court—in light of the clarity of *Tasini’s* post-*Greenberg I* teaching and the eminently reasonable reading of that controlling

case by seven distinguished federal judges—should not put itself into square conflict with the Second Circuit.¹

As to Greenberg's rendition of the facts, two points merit response. First, without any record support, Greenberg asserts that the CNG affirmatively provides "means for an end user to retriev[e] individual photographs" and that those means "make[] it easy to e-mail pages." Response Br. at 17-18 n.10, 20. Not so. As we show in Part III, the record is precisely to the contrary. Second, again without any record support, Greenberg repeatedly opines that microform has no commercial significance. *Id.* at 6, 24, 25. Not so. As we likewise show in Part III, microform is (and has long been) a for-profit mechanism by publicly-traded companies for disseminating high-cost collective works. Yet, for decades, individual authors (including Greenberg) never sought nor received compensation for this long-standing practice of reproducing a collective work. Their decades-long silence speaks volumes.

¹ We reiterate that nothing in *Greenberg I* touches upon the important, but non-section 201(c)-related, issues resolved by the *Greenberg II* panel, namely (i) the right of National Geographic to litigate other defenses to Greenberg's claim and (ii) the determination that "willfulness" was, by definition, not satisfied here and thus that the judgment based upon the jury's verdict cannot stand. Those portions of the *Greenberg II* panel's decision should therefore be fully restored in the sound and proper administration of justice. Indeed, there is no warrant for disturbing those considered judgments by the panel, inasmuch as those have not been drawn into question by the *en banc* Court. See Opening Brief at 16.

In any event, the Court's resolution of these facts has no bearing on whether the CNG is a privileged revision under § 201(c). The relevant inquiry is not whether a user may cut and paste photographs from the CNG or whether the CNG has commercial value. Rather, the key question is whether Greenberg's photographs appear in the CNG in the very same context as they appeared in the paper magazine. As Greenberg concedes, they do.

ARGUMENT

I. *Tasini* Is Controlling Supreme Court Precedent

Greenberg argues at length that “[t]he facts in *Tasini* were totally unlike the facts involving the CNG.” Response Br. at 8; *see also id.* (“*Tasini* ... dealt with the disassembly of collective works In sharp contrast, *Greenberg I* dealt with the assembly in one product of hundreds of intact monthly magazines”). True, but irrelevant. The facts in *Tasini* do not somehow render that case less controlling with respect to § 201(c)'s pivotal legal inquiry. To the contrary, those quite different facts highlight the very reason why the CNG falls within § 201(c).

Tasini explains that the key question under § 201(c) is whether the “context” of the original collective work has been preserved. 533 U.S. at 487, 488, 499, 501, 502. This approach reflects the statutory balance struck between the rights of publishers and freelancers: a publisher may exercise its own rights in a collective work by reproducing that work as a whole or revising that work into new media, as

long as the publisher respects freelancers' rights in their individual contributions by leaving those contributions in their original context. *See id.* at 502 (endorsing "the concept of 'media neutrality,'" and accepting as "true" the proposition that "the transfer of a work between media does not alter the character of that work for copyright purposes.") (internal quotations and brackets omitted). Thus, the Databases at issue in *Tasini* were not protected "revisions" because they exploited the freelance contributors' individual works outside of the periodicals and outside the context in which they were originally published.

In stark contrast, the CNG is not exploiting Greenberg's (or any other freelance contributor's) work "clear of the context provided ... by the original periodical editions" of *National Geographic Magazine*.² Rather, Greenberg freely concedes (as he must) that the CNG presents his photographs within their original context. *See* Response Br. at 4-5 ("It is abundantly clear ... that each monthly magazine appears in the CNG exactly as it appeared when originally published.").

² Indeed, Greenberg makes this very point when he claims that "[t]here is plainly no marketable demand for, say, the May 1938 issue of the magazine, or the October 1956 issue, or any other single issue. When combined for the first time with all monthly magazines since 1888, however, the market value of the collection has proven to be extraordinary." Response Br. at 18 n.12 (emphasis added). By Greenberg's own analysis, *National Geographic* is not exploiting any market for Greenberg's photos in isolation, but instead, exploiting its own work in the "selection, coordination, and arrangement" of *National Geographic Magazine*—which is precisely what a copyright in a collective work protects. *See Tasini*, 533 U.S. at 494 (quoting 17 U.S.C. § 101).

Tasini's analysis makes clear that the *Greenberg I* panel erred by focusing on the addition of new, and independently copyrightable, elements to a collective work. Compare *Tasini*, 533 U.S. at 499 (“In determining whether [individual freelance contributions] have been reproduced and distributed ‘as part of’ a ‘revision’ of the collective works in issue, we focus on the [contributions] as presented to, and perceptible by, the user of the [collective work].”) with *Greenberg I*, 244 F.3d at 1273 (“[T]he CNG is an ‘other collective work’ composed of the Sequence, the Replica, and the Program [T]he Society, in collaboration with Mindscape, has created a new product, in a new medium, for a new market”) (internal quotation omitted)). Where, as here, a publisher leaves an individual freelance contribution in its original context, the publisher is protected by § 201(c) *regardless* of whether new, and independently copyrightable, elements have been added and a new, and independently copyrightable, collective work has been created.

Indeed, it was irrelevant to the *Tasini* analysis that multiple editions of periodicals were bundled together on one microfilm, which, according to *Greenberg*, creates a “new collective work.” See Response Br. at 18 (“The CNG is certainly a new collection”); see also *id.* at 19 n.14 (“When assembled for the first time, as the CNG was assembled, the new collective work was entirely different from anything else that had ever existed.”); *id.* at 23 n.17 (“[I]f an encyclopedia—

unrevised—is placed in a new collection with other encyclopedias, the collection can become a new collective work”). Instead, the *Tasini* Court extolled microfilm as a permissible “revision” of individual periodicals under § 201(c), despite expressly acknowledging the fact that a “microfilm roll contains multiple editions” of a periodical. *Tasini*, 533 U.S. at 501. What matters under § 201(c) is whether a “revision” maintains the original context of the individual contribution—not, as *Greenberg I* held, whether new features or elements were added.

In this critical regard, seven judges have unanimously recognized that *Tasini* constitutes an intervening change in law that displaces the *Greenberg I* panel’s analysis.³ Three judges on the *Greenberg II* panel acknowledged that “*Tasini* creates a new, post-*Greenberg I* framework for analyzing the § 201(c) privilege.” 488 F.3d at 1338. So too, Judge Lewis Kaplan in the Southern District of New York noted that “the change worked by *Tasini* [on the legal terrain of § 201(c)] was substantial by any measure” and that “the difference in the Supreme Court’s approach to the revision issue ... is striking.” *Faulkner v. National Geographic*

³ Similarly, the Register of Copyrights and various Amici, all of whom are independent voices in this dispute, agree that *Tasini* cannot be squared with *Greenberg I*. See Opening Br. at 5, n.1; En Banc Amicus Br. of JStor, (filed 10/18/07); En Banc Amicus Br. of Am. Assoc. of Law Libraries, et al. (filed 10/18/07).

Soc'y, 294 F. Supp. 2d 523, 537 (S.D.N.Y. 2003) (emphasis added). Finally, a unanimous panel of the Second Circuit (speaking through Judge Winter) similarly recognized this dichotomy:

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. ... 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.

Faulkner, 409 F.3d at 37 (emphasis added). These seven judges have accepted that “*Tasini* made clear what the *Greenberg* [I] panel ... misunderstood: as long as an individual work appears in its original context, the resulting product qualifies as a permissible ... revision of a collective work under Section 201(c).” *Faulkner*, 294 F. Supp. 2d at 534.

Despite the wealth of authority recognizing the unmistakable shift in law from *Greenberg I* to *Tasini*, *Greenberg* gamely declares that “the Second Circuit misapplied *Tasini*.” Response Br. at 22. *Greenberg* is boldly asking this *en banc* Court to create a post-*Tasini* conflict. The request should be denied. The Second Circuit carefully considered both precedents, and concluded not only that *Greenberg I*'s analytical framework did not survive *Tasini*, but that the CNG was a

privileged “revision” under § 201(c) as a matter of law. *Faulkner*, 409 F.3d at 35-38. This Court should do the same.

II. Without Legal Support, Greenberg Seeks To Limit The Definition Of “Revision”

Greenberg repeatedly insists that a “revision” is a “narrowly limited privilege.” Response Br. at 4, 7, 12, 14, 25. As we understand his argument, Greenberg suggests the creation of a complex analytic framework, which would so narrow the definition of “revision” as to render it unusable and meaningless. Tellingly, this newly-contrived framework has no basis in the statute or in *Tasini*.

As we piece together Greenberg’s argument, a “revision” is, in his view, permissible if: (1) as a threshold inquiry to § 201(c), the original context of the individual contribution is maintained, (2) the work makes “some modification of the underlying collective work,” and (3) the “revision” is not itself a “new collective work” by adding “nonessential features” for a commercial purpose. *See* Response Br. at 6, 9, 14, 21. We address each of these points in turn.

A. “Context” Is Not A Threshold Inquiry

In Greenberg’s view, the first analytic step is to determine whether the reproduction maintains the original context of the individual contribution. *See* Response Br. at 10. Greenberg appears to view “context” as a threshold inquiry

for all three prongs of § 201(c),⁴ not just the “revision” question. *Compare id.* (“The ‘context’ discussion in *Tasini* sets out a threshold requirement by which a republication can be measured against § 201(c).”) *with id.* at 11 (“Publishing a photographer’s contributions in context could be permissible, under the *first prong* of the privilege, when a specific magazine in which the photographs first appeared is republished as it was originally.”) (emphasis added) *and id.* (“It is true that the *second prong* extends a privilege to a re-publication of the artist’s contributions in a revision of the original monthly magazine [if] there is some context present from which a revision could be perceived.”) (emphasis added).

Tellingly, Greenberg offers no support from either § 201(c) or *Tasini* for the proposition that context is globally relevant to all of § 201(c)—nor could he. “Section 201(c) itself makes no [general] reference to ‘context.’” *See id.* at 10-11. Rather, *Tasini* specifically discusses “context” in terms of a “revision.” *Tasini*,

⁴ Section 201(c) provides:

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

17 U.S.C. § 201(c) (2007). Greenberg describes “reproducing and distributing the contribution as part of that particular collective work” as prong one, “any revision of that collective work” as prong two, and “any later collective work in the same series” as prong three. Response Br. at 9.

533 U.S. at 499 (“In determining whether the Articles have been reproduced and distributed ‘as part of’ a ‘revision’ of the collective works in issue, we focus on the Articles as presented to, and perceptible by, the user of the Databases.”) (emphasis added); *see also* Response Br. at 11 (quoting same). Concomitantly, the *Tasini* Court did not remotely say that context is only the first of a multi-part inquiry under § 201(c)’s second prong.

Context as an omnibus threshold inquiry to § 201(c) makes no sense. With respect to the first prong, a faithful reproduction of a collective work (which the CNG is) obviously presents an individual contribution in its original context. Thus, any threshold context inquiry would be pointless. Likewise, with respect to the third prong—republication of a contribution in any later collective work in the same series—context is irrelevant. As *Tasini* recognized, § 201(c)’s legislative history permits “a ‘publishing company [to] reprint a contribution from one issue in a later issue of its magazine.’” *Tasini*, 533 U.S. at 496-97 (quoting H.P. Rep. 122-123, U.S. Code Cong. & Admin. News 1976, pp. 5659, 5738). Greenberg concedes this. *See* Response Br. at 9 n.3 (“Although not relevant here, the third prong of § 201(c) permits republication of the Greenberg photographs in ‘any later collective work in the same series.’ The ‘same series’ would be a subsequent issue of the monthly magazine. A Greenberg photograph that appeared originally in the

Society's magazine in 1962 was republished lawfully in an article in a 1990 issue of the magazine."').⁵

As *Tasini* makes abundantly clear, the bottom line in deciding whether a reproduction is a permissible "revision" is *whether the reproduction maintains the original context of the individual contribution*. This is eminently logical in light of the two independent copyrights that § 201(c) seeks to protect—(i) the freelancer's copyright in his individual contribution, and (ii) the publisher's copyright in the arrangement, selection and coordination of the collective work. *Tasini*, 533 U.S. at 493-94. The careful balance that Congress struck (and that *Tasini* elucidated) would not, as Greenberg fears, create "a limitless concept [of revision] that greatly broadens what Congress structured as a narrowly limited privilege." Response Br. at 12. To the contrary, a "revision" is stringently cabined to present an individual contribution within the confines of its original context, including "the graphics,

⁵ Greenberg is correct that National Geographic lawfully republished one of his photographs in a later edition of the Magazine. But he fails to mention that National Geographic voluntarily compensated him for that republication despite the fact, as Greenberg now concedes, it was not required to do so under § 201(c). See Response Br. at 9 n.3; § 201(c). Similarly, National Geographic was not required to reassign its copyright in Greenberg's individual photographs printed in the 1962, 1968 and 1971 editions of the Magazine. See Opening Br. at 9 n.3. Nevertheless, for no monetary consideration (and no motive other than good will), National Geographic transferred the rights to those individual photographs back to Greenberg.

formatting, [and] other articles with which [it] was initially published.” *Tasini*, 533 U.S. at 500.

B. A “Revision” Is Not Required To Have New Elements “Woven Into” The Underlying Collective Work

Next, Greenberg claims that to qualify as a “revision,” the substantive contributions in an underlying collective work must have been “revised or changed in [some] way.” Response Br. at 13 (“[N]othing in any of the four magazines in which Greenberg’s photographs first appeared ... was revised or changed in any way.”); *id.* at 15 (“[T]he CNG does not revise any of the underlying collective works—the monthly magazines.”). Greenberg also asserts (without citation) that any new changes must be “woven into a revision of the individual monthly magazines.” Response Br. at 22 (emphasis added). For two reasons, Greenberg is wrong.

First, it is simply not true that a “revision” of a collective work necessarily entails “updat[ing] or supplement[ing] with new information.” *Id.* at 14 n.6. Rather, as *Tasini* itself explained, “[r]evision’ denotes a new ‘version,’ and a version is, in this setting, a ‘distinct form of something regarded by its creator or others as one work.’”⁶ 533 U.S. at 500 (quoting Webster’s Third New

⁶ Greenberg also challenges the dictionary entry for the term “version” that National Geographic cited in its Opening En Banc Brief. See Response Br. at 13 n.5. His challenge is misdirected. It is the Supreme Court that chose both the
(Continued...)

International Dictionary 1944, 2545 (1976)). To put the original paperbound magazines on CD-Rom is to create a “distinct form” (and hence a “revision”) of those magazines, *see Faulkner*, 409 F.3d at 38—or alternatively, as National Geographic noted in its opening brief, *see* Opening Br. 23-24—“th[e] particular collective work” itself in a new medium, § 201(c).⁷ Indeed, like the CNG, both microfilm and microfiche (which *Tasini* cited as examples of technologies that constitute revisions § 201(c), *see* 533 U.S. at 501) do not alter a collective work itself, but produce an exact image of every page of the original collective work.

Second, Greenberg’s extra-statutory interpretation—under which “revision” *requires* a publisher to weave new material into the original collective work—would, by definition, at least somewhat alter the context of that work, potentially running afoul of *Tasini*. If a potential “revision” requires the new updated

dictionary and the particular entry for that term. *See* Opening Br. at 34; *see also Tasini*, 533 U.S. at 500 (quoting Webster’s Third New International Dictionary).

⁷ Greenberg fails to respond straightforwardly to National Geographic’s claim that the CNG also falls within prong one of § 201(c)—a republication of “that particular collective work.” Instead, he contends that “[t]he Society has insisted from day one that the CNG itself is a revision under the second prong of § 201(c).” Response Br. at 11. True, but only in part. National Geographic has steadfastly maintained that the CNG is a reproduction of “that particular collective work” as well. *See, e.g.*, Opening Br. at 23-24 (“[T]he CNG reproduced Greenberg’s photographs ‘as part of that particular collective work.’ 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’”).

contributions to be “woven into” an original collective work, the resulting change may upset the arrangement and coordination of the original contributions. In other words, Greenberg interprets § 201(c) to require publishers to do that which *Tasini* might not allow.

On the other hand, new materials that are placed either before or after the original collective work maintain the integrity of its original coordination and arrangement. As the *Greenberg II* panel rightly concluded, that is what the Introductory Sequence to the CNG does—it adds “25 seconds of ‘new’ material, that has been appended to some 1200 intact issues of the magazine.” 488 F.3d at 1338. The addition of the Introductory Sequence effects a change (so as to buttress further the “revision” nature of the product) but scrupulously honors the integrity of the individual contributions and the original collective work. *Cf. En Banc Amicus Brief of Am. Assoc. of Law Libraries*, at 12 (filed Oct. 18, 2007) (arguing that “the addition of software elements should be viewed, at most, as creating a permissible ‘revision’ under Section 201(c).”).

C. A “New Collective Work” And A “Revision” Are Not Mutually Exclusive

Finally, Greenberg argues that *after* (i) considering the “threshold” context question, Response Br. at 10, *and* (ii) assessing whether a collective work has been “updated or supplemented,” *id.* at 14 n.6, *then* (iii) a Court must determine whether any addition to a collective work renders it a “new collective work,” *id.* at 16.

According to Greenberg, the *Tasini* Court “expressly said ... that the issue of a new collective work, as in *Greenberg I*, is fundamentally a different question from the *Tasini* issue of isolation.” *Id.* His sole support is the following passage:

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

Id. (quoting 533 U.S. at 497; emphasis altered; brackets omitted). In Greenberg’s view, the word “or” is significant because it demonstrates “a new collective work is not allowed by § 201(c).” *Id.* at 16, 19.

This is a wild over-reading, if not an outright distortion, of that passage. Rather than establishing an additional test to determine whether a “revision” has morphed into a “new collective work,” the passage echoes the legislative history’s admonition that a publisher may not “revise the contribution itself or include it in a new anthology or *an entirely different magazine or other collective work.*” *Tasini*, 533 U.S. at 497 (quoting H.R. Rep. 122-123, U.S. Code Cong. & Admin. News 1976, pp. 5659, 5738) (emphasis added). It is not *any* “other collective work” (*i.e.*, any “new” work) that is beyond the scope of § 201(c), but a new collective work (whether a “magazine” or “other collective work”) that is “entirely different” from the original collective work (*i.e.*, one that removes the disputed contribution from its original context). Nowhere did *Tasini* suggest that the

§ 201(c) analysis hinges on whether the publisher has added new, and independently copyrightable elements, or created a “new collective work.”

Nevertheless, Greenberg asserts that a “new collective work” and a “revision” are necessarily distinct. *See* Response Br. at 19 n.14 (“[T]he Society protests that a ‘new’ work has to be ‘entirely different.’ However, a new work, by definition, is entirely different.”). He is wrong. A revised encyclopedia may include new and independently copyrightable elements, and thus may be a new and independently copyrightable collective work, but it is nonetheless a “revision” protected by § 201(c). Opening Br. at 34. Greenberg himself illustrates the point. “A newspaper that publishes four editions each day publishes four collective works.” Response Br. at 14 n.6. Indeed, each of the three later editions would be “new collective works” because they differ from any prior edition. Nevertheless, each would be a protected “revision” under § 201(c) because each preserves the original context of a freelancer’s contribution from the first edition, and does not reproduce those contributions in an “entirely different ... other collective work,” *Tasini*, 533 U.S. at 497.

Similarly, the CNG is not an “entirely different ... other collective work.” *Id.* To the contrary, as we have emphasized throughout, the CNG faithfully reproduces each magazine, page after page, with the same individual contributions in the same way, with each presented in the same context. Greenberg repeatedly

argues that the CNG “[w]hen assembled for the first time [was a] new collective work [that] was entirely different from anything else that had ever existed.” See Response Br. at 19 n.14. He ignores, however, the uncontested fact that National Geographic has long reproduced multiple issues of the Magazine in bound volumes and on microfilm. See Tr. at 176 (2/28/03) (Fahey).

After much ado about the CNG constituting a “new collective work,” Greenberg admits (as he must) that adding a new, independently copyrightable computer program would not take the CNG out of § 201(c)’s privilege. Compare Response Br. at 20 (“But when new and independent elements are added to the *aggregation* it becomes a new collective work”) (emphasis in original) *with id.* at 17 (“A straightforward republication of the magazines could have been done digitally with a more basic software program that would search for and retrieve an article and turn the pages.”). Greenberg’s concession strikes at the heart of *Greenberg I*’s analysis. 244 F.3d 1273, n.12.

Refining the point, Greenberg argues that the defect lies in the addition of “elements that were totally extraneous to a digital re-publication of the monthly magazines themselves.” Response Br. 17; *see also id.* (asserting that the CNG’s computer program contains “many nonessential features”); *id.* at 20 (insisting that “*other fresh elements* are included in the product that emphasize even more the ‘new’ character of the CNG as a collective work.”) (emphasis in original). Once

again, no basis for this interpretation is to be found in law, logic, or policy. Nothing in § 201(c) negates the privilege where new and independently copyrightable elements are added to a collective work, regardless of whether those elements are deemed “essential” or “nonessential.”

By conceding that a new copyrightable (but essential) computer program may be added under § 201(c)’s “revision” prong, Greenberg spawns an internal inconsistency between the second and third parts of his complex “revision” analysis. On the one hand, he claims that a “revision” must supplement or update a prior version with new materials. See Response Br. 14 n.6. On the other hand, he contends that if the “nonessential features” are added to a collective work, then it ceases to be a “revision” under § 201(c).⁸ This foundation-less theory is an invitation to endless litigation. Who is to say that the addition of a new article to a 1990 edition of an encyclopedia, not previously included in a 1980 edition, is “essential”? In any event, Greenberg’s speculation about “nonessential” features misses the point; what matters, in light of § 201(c) as interpreted in *Tasini*, is that

⁸ In moving from part two to part three of his newly-minted “revision” framework, Greenberg also switches baselines as to what constitutes “the collective work.” For part two, Greenberg argues there is no “revision” of a collective work because the *four individual magazines* in which his photographs appeared were not altered. For part three, however, Greenberg focuses on *the CNG*, arguing it is not a “revision,” but a “new collective work” by virtue of the addition of the Introductory Sequence. This is, with all respect, not analytically coherent.

the CNG “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*, 409 F.3d at 38.

Greenberg also argues that National Geographic added what he deems “nonessential features” to the CNG to “enhance materially [its] marketing opportunities.” Response Br. 21; *see also id.* (“The Society’s historic ‘market’ consisted of Society members,” whereas “the CNG[] opened the market much wider to consumers around the world.”). Here again, Greenberg argues outside both the statutory text and *Tasini’s* analysis. Nothing in § 201(c) limits the privilege to works in the same “market” as the original collective work (even if some factual record had been established on the contours of any such “market,” which it was not). Indeed, any focus on distinct “markets” inherently conflicts with the bedrock statutory principle of media-neutrality, *see, e.g., Tasini*, 533 U.S. at 502, because different media can naturally be expected to appeal to different “markets.”⁹ Greenberg’s assertion that he is entitled to benefit from the “sales [of

⁹ Indeed, as Judge Kaplan recognized in *Faulkner*, testimony in hearings before the House Committee on the Judiciary demonstrates that § 201(c) would permit reproductions and revisions in a new, and more technologically advanced medium. 294 F. Supp. 2d at 541 n.89. In response to a question posed by Representative Kastenmeier, George Cary of the U.S. Copyright Office testified that “[y]ou can read the bill from beginning to end and you won’t find in it any reference to computers Yet these are one of the coming instruments of communication in the future. *We have tried to phrase the broad rights granted in such a way that they* (Continued...)

the CNG] in a huge, global market,” Response Br. 17-18, is mystifying. Any “market” for the CNG is *a market for the collective work as a whole* (from which the publisher is entitled to benefit), *not a market for an individual freelance contribution* (from which the freelancer is entitled to benefit). In any event, the very concept of “markets” is alien to the copyright laws, which (unlike the antitrust laws) do not presuppose commercial activity in a particular “market.” Indeed, it makes no difference for copyright purposes whether a work is distributed in a “market” at all. National Geographic could have created the CNG solely for its own internal historical archive. Yet, Greenberg’s sweeping theory would call that into question as well.

Finally, the *Tasini* Court did not, as Greenberg would have it, state “that, in converting a publication from print to digital, various additions to the product *would* be acceptable where they were ‘entirely attributable to the nature of the electronic media,’ [but] *would not* be acceptable where they were ‘entirely attributable to ... the nature of the economic market served’ by the product.” *Id.* at 21 (quoting *Tasini*, 533 U.S. at 502 n.11) (emphasis added). In the quoted footnote, the *Tasini* majority simply rejected the dissent’s suggestion that the

can be adapted as time goes on to each of the new advancing media. This is our hope.” *Id.* (citing Hearing on H.R. 4347, 5680, 6831, 6835 Before the House Comm. on the Judiciary, Copyright Law Revision, 89th Cong., 1st Sess. at 57 (1965)) (emphasis added).

challenged databases were privileged because the disaggregation of the original collective works was attributable to a change in media. *See Tasini*, 533 U.S. at 502 n.11. As the *Tasini* majority explained, there was no basis for so concluding, and in any event the statute did not include a “medium-driven” necessity defense. *See id.* Contrary to Greenberg’s assertion, the footnote does not remotely establish that a work’s appeal to a new “market” (or especially a commercial market) somehow precludes the § 201(c) privilege.

III. Without Record Citation, Greenberg Misstates Several Factual Points

A. The CNG Does Not Provide A User The Capability To Isolate, Copy, Or Email Individual Contributions

The *Greenberg I* panel correctly noted that “the CNG does not provide a means for the user to separate the photographs from the text or otherwise to edit the pages in any way.” 244 F.3d at 1269. Nevertheless, Greenberg now claims:

[t]he software program actually used in the CNG *provides* additional features not essential to replicating the magazines, and some of them, like the easy access to images in JPeg codes, *quite directly provide* copying, editing and re-publication opportunities by any buyer of the CNG.

Response Br. at 17 (emphasis added).

The point is legally irrelevant, but in any event Greenberg is mistaken. *First*, there is *no direct access* to so-called JPeg “codes.” Rather, each CD-Rom contains JPeg files of magazine pages (not individual contributions in isolation of those pages), which are necessary to project the digital image onto a user’s

computer screen. But accessing a single image file is anything but “direct,” as a user must (i) affirmatively choose to bypass the CNG program, (ii) open the computer’s drive directory, (iii) locate the computer’s CD-Rom drive, (iv) open the CD-Rom’s file directory, and (v) search literally one-by-one through thousands of the CD-Rom’s image files (which are not titled by name or in a manner that is easily identifiable to a consumer, but instead by numbers such as “292C0030”). It bears emphasis that double clicking on a CD-Rom icon through the drive directory launches the CNG program—not the CD-Rom’s internal operating files. See “The Complete National Geographic: 108 Years of *National Geographic Magazine* on CD-Rom” (which is part of this Court’s appellate record).

Second, the CNG does not *provide* any of the features Greenberg alleges. The CNG permits a user to “zoom in” or “zoom out” (the equivalent of using a magnifying glass), lighten or darken the page to better see it, or print a page or pages of the CNG on a printer (the equivalent of copying a page of a magazine on a photocopier). See Tr. at 185 (2/28/03) (testimony of John Fahey that the CNG does not permit a user to “print out anything other than a full page [of the Magazine]”). These are precisely the same features available to an individual using microfilm.¹⁰ Moreover, as Idaz Greenberg testified at trial, a user must go

¹⁰ Microfilm reading machines have many different “nonessential” features that are independently copyrightable, trademarkable, and patentable. In addition,
(Continued...)

outside the CNG and access some other software (such as Photoshop) to manipulate the files:

Q: Did you use any [other software program] to do the alterations that we're about to discuss?

A: Yes. These were made on Photo Shop. Photo Shop is a software, in fact, that is bundled automatically with anyone who buys a digital camera; they get a form of Photo Shop with it.

Tr. at 146 (2/26/03).

Finally, as Judge Kaplan recognized in *Faulkner*, it is legally irrelevant whether a user can “manipulat[e] the storage medium” of the CNG to isolate an individual contribution because “[a] user of a print copy of the *Magazine* could physically cut an image from the issue and paste it elsewhere, or reproduce it by photography or electronic scanning.” *Faulkner*, 294 F. Supp. 2d at 542 n.91. What matters is whether, in light of the Supreme Court’s decision in *Tasini*, the CNG “perceptibly reproduces and distributes [Greenberg’s photographs] ‘as part of’ either the original [collective work] or a ‘revision’ [thereof].” 533 U.S. at 500. The CNG does exactly that.

microfilm reels contain different elements, including title pages, tables of contents, indexes, magnification features permitting isolation of individual articles for printing, and promotional ads for entities that produced the microfilm.

B. Microform Is Developed And Used For Commercial Purposes

Greenberg also repeatedly claims (without any citation or support) that microform “do[es] not exist for commercial activity.” Response Br. at 24; *see also id.* (“[S]uch products do not exist ... to inherently derive revenue or profits.”). He is wrong. Several leading companies that commercially sell microform products at considerable cost, such as ProQuest, are for-profit enterprises. These companies make and sell microform to myriad customers, including schools, libraries, government and businesses. *See generally* ProQuest, available at <http://www.proquest.com> (last visited Nov. 28, 2007).¹¹ In any event, whether microform (or the CNG) was created purely for non-commercial purposes is

¹¹ Currently, a complete set of *National Geographic Magazine* on microfilm may be purchased from National Archives Publishing Company via the internet. The cost of such a collection today is more than \$50,000—a cost significantly greater than the CNG, which sold for between \$50 and \$175 in various retail outlets before its withdrawal from the marketplace following the verdict below. *See generally* National Archive Publishing Company, available at <http://napubco.com/catalog/PIMN.pdf> (last visited Nov. 29, 2007) (showing that each year’s reel for *National Geographic Magazine* costs as much as \$1038). This is precisely why the CNG not only serves a public good, but also allows both for-profit and non-profit organizations to benefit from a substantial savings for access to the very same information in a more technologically advanced medium. Moreover, these microform collections have been produced and commercially available to the public for decades. It was not until 2002 (after National Geographic created the CNG and the *Greenberg I*’s panel decision) that any author demanded payment for the republication of his works in microform. *See Auscape Int’l v. National Geographic Soc’y*, 409 F. Supp. 2d 235 (S.D.N.Y. 2004).

legally irrelevant.¹² The Copyright Act, in general, and the § 201(c) privilege, in particular, are not applicable only to non-profit enterprises. To the contrary, the Constitution's Copyright Clause and its legislative progeny are intended "[t]o promote the Progress of Science and useful Arts," U.S. Const. art. I, § 8, cl. 8, by ensuring that copyright holders are entitled to exploit their works. Greenberg oddly contends that he is entitled to profit from the exploitation of his photographs, but the National Geographic Society is not entitled to profit from the marketing and sale of its collective work. *Compare* Response Br. at 17-18 ("[S]uch opportunities should be reserved to a creator such as Jerry Greenberg.") *with id.* at 25 ("The [CNG] certainly was assembled and marketed to make scientific and educational information readily available, but with a commercial appeal that transcends research and study. ... [S]izable revenues have resulted."). Greenberg has not argued that he was not well compensated for his contribution to the collective work, or that he is not free to exploit his contribution separately from the

¹² Although the commercial nature of the CNG is irrelevant to § 201(c)'s analysis, National Geographic Society is a non-profit educational and scientific organization under U.S. tax laws. The Society and its wholly-owned parts, including its taxable subsidiaries, exist solely to generate revenue that will advance and serve the organization's mission to increase and diffuse geographic knowledge. Thus, while some National Geographic products may generate profit, these excess revenues are directed solely towards endeavors that fulfill that mission (such as funding scientific grants and sponsoring public service exhibits and lectures).

collective work in any manner he sees fit. Indeed, he testified that he sold photographs previously published in *National Geographic Magazine* for profit to other publishers. See Tr. at 195, 201, 206 (2/27/03). In any event, microform is an item of commerce, sold by for-profit companies and a source of profit for publication (including royalties paid to National Geographic).

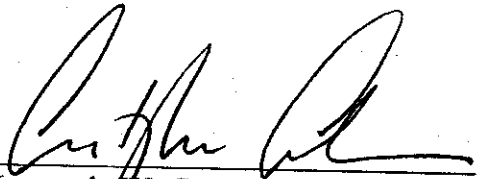
C. Greenberg's Factual Misstatements Are Legally Irrelevant

We close with this brief reflection: Greenberg's error-infected assertions are not relevant to the § 201(c) analysis. As demonstrated by the Supreme Court's teaching in *Tasini*, the relevant inquiry is not whether images may be cut and pasted from the CNG or whether the CNG has any commercial value. Rather, the pivotal legal question is whether the CNG presents Greenberg's photographs in the same context as the paper magazine. There is no dispute that it does.

CONCLUSION

For the foregoing reasons, this *en banc* Court should reverse the *Greenberg I* judgment and reinstate the panel opinion in *Greenberg II* in full. At all events, this Court should restore the unchallenged portions of the *Greenberg II* decision. See n.1, *supra*.

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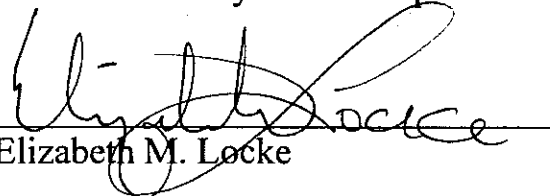
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CERTIFICATE OF BRIEF LENGTH

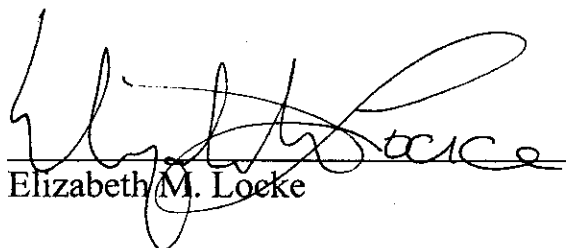
Pursuant to Fed. R. App. P. 32(a)(7)(B) and (C), I hereby certify that this brief contains 6,722 words, on the basis of a count made by the word processing system used to prepare the brief.


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CERTIFICATE OF SERVICE

I hereby certify that on this 3rd day of December 2007, I served two true and correct copies of the foregoing En Banc Reply Brief of Appellants by Federal Express on the following counsel:

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