

NO. 05-16964-JJ

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

JERRY GREENBERG,
Plaintiff/Appellee

VS.

NATIONAL GEOGRAPHIC SOCIETY, a District
of Columbia Corporation, NATIONAL GEOGRAPHIC
ENTERPRISES, INC., a corporation, and
MINDSCAPE, INC., a California corporation,
Defendants/Appellants.

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

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STATEMENT OF THE 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)?

STATEMENT OF THE CASE AND FACTS

This case involves a CD-ROM product with 30 discs called the Complete National Geographic ("CNG"), first published in 1997 by the National Geographic Society ("Society"), that includes every monthly edition of the Society's magazine going back to 1888. Each CD-ROM contains important additional items to be discussed in the Argument. The CNG includes, in four separate issues of the monthly magazine, 64 photographs by Jerry Greenberg for which he owns the copyrights. The Society did not seek his permission to re-publish the photographs in the CNG.

In Greenberg v. National Geographic Society et al., 244 F.3d 1267 (11th Cir. 2001) ("Greenberg I"), the Court held that the CNG infringed Greenberg's copyrights by unlawfully republishing his photographs in this new collective work.

Later in 2001, the Supreme Court decided New York Times Co. v. Tasini, 533 U.S. 483 (2001), a copyright case based on different facts.

In 2005, the Second Circuit decided Faulkner v. National Geographic Enterprises, Inc., 409 F.3d 26 (2d Cir.), cert. denied, ___ U.S. ___, 126 S.Ct. 833 (2005), as case with facts nearly identical to those in Greenberg I, and held that, because of the Tasini “rationale,” the CNG did not infringe the copyrights of authors and photographers. The opinion created a conflict with the Eleventh Circuit. The Supreme Court subsequently denied certiorari that could have resolved the conflict. Faulkner v. National Geographic Enters., Inc., 409 F.3d 26 (2d Cir. 2005), ___ U.S. ___, 126 S.Ct. 833 (2005).

In Greenberg v. National Geographic Society, et al. (“Greenberg II”), decided by a panel of this Court on June 13, 2007, the Court held that Tasini “effectively overrules the earlier panel decision in this case.” Opinion at 19. The panel reached that conclusion even though it acknowledged that Tasini “was decided on different facts” than Greenberg I. Opinion at 10. Greenberg II has been vacated by the *en banc* Court.

Greenberg otherwise accepts the Society’s statement of the case and facts, with the few exceptions discussed below.

At page 8, the Society states that “The CNG neither provides a mechanism for the user to separate the photographs from the text nor otherwise to edit the pages.” That is incorrect because the JPeg codes the Society elected to use in the CNG for storing images are easily accessible to a user, who can retrieve specific

items such as photographs and manipulate or transmit them. The Court can see this readily in the CNG exhibit that is in the record.

The Society lists, at page 8, only some of the additional elements added to the aggregation of monthly magazines in the CNG. A more complete listing includes an animated globe logo with music, a National Geographic Interactive visual montage with sound, a Kodak advertisement with voice and music, a display depicting moving spines of issues of the magazine, and an interactive link with the Society's web site.

In footnote 3, the Society mischaracterized Jerry Greenberg's testimony at the trial on damages, quoting him as saying that the Society had an ongoing license to use his photographs and the only thing Greenberg required was "notification." To the contrary, Greenberg testified that "[a]ll they would have to do, since I owned the copyright, is to come back and ask me for permission." 2/28/03 Tr. 11 (emphasis added). It is undisputed that the Society did not ask Greenberg for permission to include his photographs in the CNG.

Unfortunately, the Society argues throughout its Statement of the Case a large number of points that should properly be limited to the Argument. In this brief, Greenberg disagrees with many of those points but will not push the arguments here.

SUMMARY OF ARGUMENT

Greenberg I held that the Society had infringed copyrights owned by Jerry Greenberg by re-publishing his photographs in a new collective work without his consent.

The Supreme Court, in Tasini, and this Court, in Greenberg I, stressed the constitutional rights bestowed on authors and other creators in the copyright environment. In its long re-working of the Copyright Act that concluded in 1976, Congress also was acutely mindful of the delicate balance between the rights of authors and the rights of publishers. Section 201(c) of the Act, which is central to this appeal, established a qualified privilege allowing the re-publication, without consent, of works created and owned by others.

The careful and narrow phrasing of that privilege was noted repeatedly in Tasini. The Society virtually would re-write the privilege. Their argument emphasizes – over and over again – that the Complete National Geographic product was “revised” pursuant to § 201(c) and therefore comes within the privilege. Section 201(c), however, states plainly that a “revision” must supplement or modify in some way the underlying works in which the Greenberg photographs originally appeared, and in this case that would involve a revision of four of the original monthly magazines. It is abundantly clear, and the Society

agrees, that each monthly magazine appears in the CNG exactly as it appeared when originally published. The “revision” prong of § 201(c) cannot apply.

Tasini involved completely unrelated facts. There, the core issue involved the disassembly of newspapers and magazines and the random placement of articles from those publications in vast digital databases. The Supreme Court held that the re-publication of the articles in the databases was not privileged under § 201(c). There was no way to determine whether the articles were newly published in a privileged “revision” because an article appearing in the databases was without the “context” it originally had in a newspaper or a magazine. The “context” issue thus was a threshold question, because in the absence of context the existence of a privileged re-publication could not be determined.

The Society attempts to add “context” language to § 201(c), by contending that the re-publication of monthly magazines in their original context is privileged. Such an approach is like declaring context to be an insurance policy against copyright infringement. The Supreme Court in Tasini never said that context assures the application of the privilege. As discussed above, context is merely a starting point for determining whether the privilege applies.

Tasini does not undermine this Court’s holding in Greenberg I that the CNG was an impermissible new collective work. The Supreme Court, in multiple places, noted that the legislative history is clear that Congress intended that the

inclusion of works such as the Greenberg photographs in a “new collective work” or a “new collection” would not be privileged. Common sense, in addition to the statutory definition of a collective work, makes it evident that the CNG is a first-time collective work, largely because the aggregation of magazines was supplemented by new and nonessential features that enhanced the commercial value of the package.

The Second Circuit Court of Appeals, in similar cases based on the CNG and § 201(c), erroneously held that the “context” factor was evidence that the re-publication of the monthly magazines was a “revision” under the statutory privilege – notwithstanding that nothing whatsoever in any of the magazines was revised. The Second Circuit also ignored the proscription by Congress of re-publication in new collective works.

The *amici* outline valuable social purposes for the re-publication of newspapers and magazines, but in library and archival settings those purposes are entirely noncommercial, unlike the CNG.

ARGUMENT

I. Introduction

This Court, rehearing the appeal *en banc*, asked the parties whether Greenberg is still entitled to copyright protection regarding the Complete National Geographic subsequent to the Supreme Court's decision in New York Times Co. v. Tasini.¹ Greenberg contends that the protection afforded in Greenberg I, which held that the Society infringed Greenberg's copyrights, is not affected by Tasini.

The Copyright Act reserves a bundle of rights to a photographer, among other creators, including the right to re-publish. A small paragraph within the Act – Section 201(c) – provides a narrow and limited presumptive privilege within which a publisher can re-publish a set of photographs without the consent of the copyright owner. In a committee report, Congress explained that § 201(c) would not permit the re-publication of photographs in a new collective work, or in a new collection. The Supreme Court in Tasini noted that extra limitation.

A panel of this Court, in Greenberg I, held that infringement of the copyrights occurred because the Complete National Geographic (“CNG”), which

¹ In lengthy footnotes 3, 6 and 8 in its brief, the Society unfairly goes far beyond the limited briefing instruction directed by this *en banc* Court to re-argue lesser issues that were covered earlier in this appeal in the parties' briefs. Greenberg will not focus on those issues here. The Court should strike the three footnotes, or otherwise ignore them in its deliberations.

contains the Greenberg photographs, did not fall within § 201(c) and instead amounted to a new collective work.

Tasini does not alter the Greenberg I outcome.

II. Tasini Involved Unrelated Facts

The facts in Tasini were totally unlike the facts involving the CNG. In Tasini, the publishers of The New York Times and various magazines licensed rights to NEXIS and other companies to include in their digitized databases individual articles lifted from daily issues of the Times and from various magazines. Those articles, placed randomly in the sprawling databases, were seen by users of the databases in isolation, without the original publication's context, which consisted of headlines, graphics, page placement and the like.² Tasini, 533 U.S. at 499. Tasini thus dealt with the disassembly of collective works, *i.e.*, the carving out of individual articles from daily issues of newspapers and magazines (collective works) in which the articles originally appeared. In sharp contrast, Greenberg I dealt with the assembly in one product of hundreds of intact monthly magazines, each of which qualifies under the Copyright Act as a collective work, plus a variety of other elements. Greenberg I held that the CNG was a new collective work, and therefore outside the § 201(c) protection.

² Jonathan Tasini, one of the plaintiffs, was a writer.

The central issue presented to the Supreme Court in Tasini was whether the reproduction and distribution of each original contribution by an author, in an isolated manner, was a permissible revision of “that collective work” authorized by Section 201(c) of the Copyright Act. The Supreme Court held that no privileged revision existed. That holding has nothing to do with the facts here.

III. The “Context” Question Discussed in Tasini Does Not Decide the Privilege Presented in § 201(c)

Section 201(c) of the Copyright Act was central to Tasini and Greenberg I.

That section states, in pertinent part:

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 [1] as part of that particular collective work, [2] any revision of that collective work, and [3] any later collective work in the same series.

(Brackets added.) Only prongs [1] and [2] are germane to this appeal.³

The Supreme Court referred again to the legislative purpose: “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

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.

revise the contribution itself or include it in a new anthology or an entirely different magazine or other collective work.”⁴ Tasini, 533 U.S. at 496-97, quoting H.R. Rep. 122-123, U.S. Code Cong. & Admin. News 1976, pp. 5659, 5738.

The Supreme Court said in Tasini that the articles scattered in the databases did not appear in their original context as part of a newspaper or a magazine. The Court said: “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.” 533 U.S. at 502-03. The Society seized on that statement to mean that if an author’s or photographer’s contributions are reproduced in the same context in which they originally appeared – in a newspaper or a magazine – it amounts to a revision under Section 201(c). Stated another way, the Society strongly, and wrongly, sees “context” as an insurance policy against copyright infringement. The Second Circuit in Faulkner, and the panel in Greenberg II, adopted that “rationale.” Tasini and Congress never intended that context have such weight.

The “context” discussion in Tasini sets out a **threshold** requirement by which a republication can be measured against § 201(c). Section 201(c) itself

⁴ The Society says that Greenberg I was incorrect in saying that a “revision” of a collective work cannot be a “new” collective work. “There is no inconsistency between a ‘revision’ and the creation of a ‘new’ collective work.” Rhrg.Br., 34. But there is an inconsistency. A revised collective work is a revised preexisting work. A new collective work is just that – new. Greenberg I had it right.

makes no reference to “context.” 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. However, when the re-published magazine becomes part of a new collective work it violates the photographer’s copyright.

The Society has insisted from day one that the CNG itself is a revision under the second prong of § 201(c). 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. The Supreme Court clarified the meaning of the language in the second prong of § 201(c). There is no way to know whether the original collective work (here, a magazine) was revised, however, unless there is some context present from which a revision could be perceived.

The Court explained the threshold: “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.” Tasini, 533 U.S. at 499 (emphasis added). A user of the databases in Tasini would perceive only a stand-alone article from a newspaper or magazine. There is no way, therefore, that a user of those Databases, when examining the article, would be able to perceive the newspaper or magazine (a collective work) where the article was originally published. Nor could a user of

that database perceive a revised newspaper or magazine among the thousands of articles scattered in that collection.

Obviously, the Tasini databases did not present a revised collective work. Because each article was visible in the databases in isolation, the second prong of § 201(c) could not apply there. That was the holding in Tasini, and that holding has nothing to do with Greenberg I.

Looking to Tasini, the Society contends that “context” is the only thing needed to acquire a privilege under § 201(c). The Supreme Court did not say, and certainly did not hold, that context alone would assure that a re-publication was privileged.

Put another way, if photographs are not re-published as part of the National Geographic magazine that originally contained them, you never reach the issue of whether those photographs are now part of a “revision” of that original magazine and protected by § 201(c). Context is thus a starting point; whether a revision was accomplished is a separate question under the second prong in § 201(c).

In its sweeping reliance on “context” alone, the Society would turn § 201(c) into a limitless concept that greatly broadens what Congress structured as a narrowly limited privilege.

III. There Was No “Revision” In The CNG

The Society, in its rehearing brief and its earlier briefs in Greenberg II, firmly embraced the idea that the CNG is a “revision” under Section 201(c). At page 18 of its initial brief, the Society argues that, because every cover, article, advertisement, and photograph appears as it did in the original paper copy of the monthly magazine, “the CNG simply reproduced freelance contributions in a ‘revision’ of the original collective work” That is a truly remarkable statement, because nothing in any of the four magazines in which Greenberg’s photographs first appeared – each a collective work – was revised or changed in any way. The Society’s logic is that the bundling together of a cluster of individual magazines somehow revises them,⁵ which is totally contrary to the language in § 201(c).

In the second prong of Section 201(c), the privilege extends to “any revision of that collective work.” That collective work thus refers to the original collective work in which a photographer’s contributions first appeared.

⁵ At page 34, the Society goes to Webster’s Third International Dictionary to examine revision, but instead focuses on one of more than a dozen definitions of “version.” That dictionary includes a number of definitions of “revision” that fit here: “to look at or over again for the purpose of correcting or improving . . . to make a new, amended, improved, or up-to-date version.” All of the definitions plainly speak to changes within an existing work.

In Tasini, the Supreme Court discussed “revision” a number of times. The Court said, with regard to the facts there, that “we cannot see how the Database perceptibly reproduces and distributes the article ‘as part of’ either the original edition [of the newspaper] or a ‘revision’ of that edition.” 533 U.S. at 500. (emphasis added).

The Court emphasized the meaning of “revision” still again: “[T]he Databases do not perceptibly reproduce articles as part of the collective work to which the author contributed [a newspaper or a magazine] or as part of any ‘revision’ thereof.” 533 U.S. at 501-02 (emphasis added). The collective works in which Greenberg’s photographs originally appeared were monthly issues of the Society’s magazine. The Supreme Court’s explanation of “revision” as involving some modification of the underlying collective work could not be more clear.⁶ Those explanations by the Supreme Court confirm that “context” alone is not enough.

⁶ Greenberg listed in his answer brief in this appeal, at 16, examples of true revisions. A newspaper that publishes four editions each day publishes four collective works; each edition after the first constitutes a revision, preserving the bulk of the preceding edition and adding new and updated information. The same is true for a dictionary that publishes a revision each year, preserving most of the old material but supplementing with new words and definitions. Or a math textbook republished periodically with fresh material added. Not one monthly magazine in the CNG was modified, updated or supplemented with new information, and the Society does not and cannot contend otherwise.

The Society steadfastly insists – and Greenberg II agreed – that the CNG is a privileged “revision,” even though the CNG does not revise any of the underlying collective works – the monthly magazines.⁷ No serious reading of Section 201(c) or Tasini can sustain that conclusion. Greenberg II contained no discussion of the meaning of a “revision” under Section 201(c). The Second Circuit, in Faulkner, said that the collection in the CNG of more than 1200 unchanged magazines, supplemented by a computer and search program and an opening sequence, “is a new version of the Magazine” and thus a privileged revision. 409 F.3d at 37. That reasoning is so totally at odds with the Supreme Court’s discussion of a revision in Tasini as to be an invention – because no original collective work was revised.

The Society provides the following contorted example:

Reprinting an article from a 1980 edition of an encyclopedia in a 1990 revision of it would be privileged, even though the 1990 revision obviously would contain new and independently copyrightable material.

Rehg. Br., 34 (quote marks and citations omitted). Of course the reprint would be privileged under § 201(c), because the underlying 1980 encyclopedia (a collective work) was revised by adding new material in 1990. No underlying work in the CNG was revised.

⁷ Greenberg II, at page 12, said: “Under the Tasini framework, the relevant question is whether the original context of the collective work has been preserved in the revision.” (Emphasis added.) What revision?

Tasini did not find a revision to exist, under the Section 201(c) privilege, and did not hold that microform versions of a magazine amounted to a revision.

IV. **Tasini Does Not Undermine This Court's Holding in 2001 That The CNG Is An Impermissible New Collective Work**

It is worth revisiting the Supreme Court's cautionary reminder that Congress never contemplated that new collective works could be embraced by the § 201(c) privilege:

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

Tasini, 533 U.S. at 497 (bracketed material and emphasis added). The Supreme Court expressly said there that the issue of a new collective work, as in Greenberg I, is fundamentally a different question from the Tasini issue of isolation. In Greenberg I, this Court rightly concluded that the CNG was outside the privilege in Section 201(c) because it is a new collective work. The panel looked to the statutory definition of "collective work" as "a number of contributions, constituting separate and independent works in themselves . . . assembled into a collective whole." 17 U.S.C. § 101. The panel listed the Replica, the Moving Cover

Sequence and the Program as constituting separate and independent elements.⁸

The Society brushes aside the new components as of no consequence, but they are elements that were totally extraneous to a digital republication of the monthly magazines themselves – especially the Program with its many nonessential features – and they were plainly put in the CNG for commercial reasons: to enhance sales in a huge, global market.⁹ 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, which is essentially what the *amici* advocate. The 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.¹⁰ The Supreme Court's sense of an author's rights is that such opportunities

⁸ Greenberg I considered the Replica to be the aggregation of monthly magazines. The Moving Cover Sequence was a short animated sequence, with music, in which a number of magazine covers morphed from one to the other. The Program was the software built into the CNG.

⁹ Greenberg does not challenge the use of a different medium for the CNG, because it is a given that the Copyright Act is medium-neutral.

¹⁰ The Society has contended all along that the CNG allows for copying of a page but does not provide a means for a user to separate the photographs from the text, or otherwise edit the pages in any way. That is not correct. The universal JPeg codes utilized in the CNG provide an easy means for an end user to exploit the

should be reserved to a creator such as Jerry Greenberg.¹¹ With reference to § 201(c), the Tasini Court said:

If there is demand for a freelance article [or photograph] standing alone **or in a new collection**, the Copyright Act allows the freelancer to **benefit** from that demand

533. U.S. at 497 (emphasis added).¹²

The CNG is certainly a new collection. Indeed, a new collective work, by the statutory definition. This Court attached to its opinion in 2001 a copy of the registration form filed with the U.S. Copyright Office on which the Society said, with respect to the CNG, that the “date...of first publication of this particular

CNG’s contents. The Court can see that capability for itself in the CNG exhibit. Tasini noted that a system that allows retrieval of individual photographs “effectively overrides the Authors’ exclusive right to control the individual reproduction and distribution of each [photograph]. . . .” 533 U.S. at 503-04.

¹¹ Greenberg’s action was predicated on the 1997 version of the CNG, which covered 108 years of the monthly magazines [Dist. Ct. D.E.20, Ex. A]. For years thereafter, the Society published variations of that original iteration. Faulkner, 409 F.3d at 30 n.2. lists some of the added elements in later iterations. The Court is urged to require the Society to provide copies of subsequent versions for a review of those elements. Faulkner also identifies a number of later versions of the CNG. Id.

¹² There 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.

work” was January 1, 1997.¹³ Greenberg I properly concluded, therefore, that the CNG was a “new” work. In fact, the Second Circuit noted that “[t]he CNG was originally distributed and marketed as an ‘unprecedented’ collection.” Faulkner, 409 F.3d at 32. That means “new.”¹⁴

The Society attacks the idea of a new collective work (insisting that the CNG is a revision), but also defends the idea. With reference to the CNG, the Society said: “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.” Rhrgr.Br., 24. Tasini disagreed with that, citing to Congress and concluding without qualification that republishing the original collective work, in which an individual’s photographs appeared, in a new collective work is not allowed by § 201(c). 533 U.S. at 497.

¹³ No record exists in this case showing that microfilm aggregations of the Society’s magazines were ever registered with the U.S. Copyright Office. Microfilm copies, of course, exist for non-commercial purposes. Additionally, elements are not added to microforms that could re-characterize it as a new collective work. Comparing the CNG to microfilm is not a valid exercise.

¹⁴ At page 36, the Society protests that a “new” work has to be “entirely different.” However, a new work, by definition, is entirely different. The statute defines a collective work: “[a] number of contributions, constituting separate and independent works in themselves . . . assembled into a collective whole.” See 17 U.S.C. § 101. 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. The Society conceded that in its registration form.

A re-publication of preexisting collective works such as the monthly magazines, even when bundled digitally in aggregate fashion, need not cross into the realm of a new collective work because the first prong of § 201(c) permits continued use of the original magazines. **But when new and independent elements are added to the aggregation it becomes a new collective work.**

Greenberg I elected to focus only on the three independent elements identified above. This Court is urged to look again at the 1997 CNG itself (in the case record), as well as versions marketed in subsequent years, to note that other fresh elements are included in the product that emphasize even more the “new” character of the CNG as a collective work.¹⁵ Those elements include but are not limited to an animated globe logo with music, a National Geographic Interactive visual montage with sound, a Kodak advertisement with voice and music, a display depicting moving spines of issues of the magazines, an interactive link with the Society’s web site, and a button for printing any page displayed on the screen. The copying feature makes it easy to e-mail pages, or portions of pages, from a particular magazine. None of these elements are essential to a simple republication of monthly magazines (no such elements appear on microfilm in libraries). These elements are far more significant in terms of content than the “bookends” label the

¹⁵ These “separate and independent works” fit within the statutory definition of a collective work. See 17 U.S.C. §101.

Society tries to apply to them. They also enhance materially the marketing opportunities for the CNG.

Importantly, the Supreme Court strongly implied in *dicta* that, in converting a publication from print to digital, various additions to the product would be acceptable where they were “entirely attributable to the nature of the electronic media. . . .” Tasini, 533 U.S. at 502 n. 11. The Court proposed that such additions would not be acceptable where they were “entirely attributable to . . . the nature of the economic market served” by the product. Id. The Society’s historic “market” consisted of Society members. More recent products, including the CNG, opened the market much wider to consumers around the world. Many of the elements in the CNG clearly were added to serve the economic market by making the product more attractive and user-friendly, which is not consistent with any ongoing interest by Jerry Greenberg in his photographs.¹⁶ Greenberg’s photographs are so easily copied and/or e-mailed from the CNG that any ongoing value in his photographs has been at least marginalized. All of the opposing briefs totally wish away these realities.

In its rehearing brief, at 34, the Society tries to wave off the inclusion in the CNG of the unnecessary elements by noting that independently copyrightable

¹⁶ Tasini noted the impact of new digital markets: “The Register of Copyrights reports that ‘freelance authors have experienced significant economic loss’ due to a ‘digital revolution that has given publishers [new] opportunities to exploit authors’ works.” 533 U.S. at 497 n.6.

works can properly be included in a revision. That can be true, under § 201(c), but only if they are woven into a revision of the individual monthly magazines. The copyrightable elements cited by this Court in 2001 (plus other elements in the CNG that were not cited) make the CNG a new collective work, not a revision.

V. **The Second Circuit Misapplied Tasini**

The Second Circuit in Faulkner was confronted with the same product – the CNG – and the same Section 201(c) issues involving different photographers and authors. In its decision, disagreeing with Greenberg I, the Second Circuit held that the CNG is a privileged revision “because the original context of the Magazines is omnipresent in the CNG and because it is a new version of the Magazine” Faulkner, 409 F.3d at 38. A new version of what magazine? As explained above, the “context” argument employed by the Society and the Second Circuit cannot work.

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

The collection of the magazines is more readily recognizable as a new collective work, by the very definition of such a work in the Copyright Act.¹⁷

The Second Circuit opinion (and that of the district court there) totally ignored the repeated instruction by the Supreme Court in Tasini that a permissible revision must re-make or update the underlying collective works – the monthly magazines.

The Second Circuit also ignored the Supreme Court's admonition that republication is not privileged when the original contributions are "within new collective works," Tasini, 533 U.S. at 497, and the court bypassed any consideration of a new collective work.

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

VI. The *Amici* Outline Valuable, Noncommercial Objectives

Greenberg is in full accord with the need that libraries and archives have for digital storage and sensible access by patrons to stored information. But the Court

¹⁷ The district court said that the "revision privilege [can] extend to collective works which, like the revision of an encyclopedia, contain original contributions along with new or updated material." 291 F.Supp.2d at 541. That describes, rightly, a revised encyclopedia. But if an encyclopedia – unrevised – is placed in a new collection with other encyclopedias, the collection can become a new collective work, as the Copyright Act defines that term.

should note that libraries and archives exist essentially for research and other academic purposes. They do not exist for commercial activity.

The *amicus* briefs of JStor and the library associations rightly extoll the virtues of microfilm and microfiche and their use over many decades, but they wrongly compare such microforms to the Complete National Geographic. What microforms contain and how they are organized is materially different from the CNG. Microforms have no copyright consequence to photographers and authors, because such products do not exist in archives to inherently derive revenue or profits. Microforms have played little or no role except in the archive marketplace, and their use has been limited historically to libraries and other storage facilities. In Greenberg I, in its Petition for Rehearing and Petition for Rehearing En Banc, at page 14 n.4, the Society stated: “Not surprisingly, very few (if any) individuals buy microfilm or microfiche . . . for home use.”¹⁸

Amicus JStor says that “[t]he use of scholarly materials in the research process typically involves three components: identifying relevant material; obtaining access to it; and preserving it for use by successive generations.” Br., 21. If the Society had more narrowly assembled the CNG, it would not be wrapped in controversy. The CNG contains additional elements – noted in this brief – that are

¹⁸ Rolls of microfilm in libraries and archives containing reproductions of the monthly magazines were never copyrighted for the obvious reason that they were not intended as consumer products in the marketplace. Historically, there has been no fear that microfilm would be copied and exploited by others.

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completely nonessential to gaining access to archived magazines and articles. The product certainly was assembled and marketed to make scientific and educational information readily available, but with a commercial appeal that transcends research and study.

Libraries and archives make information available to interested students and researchers. The Society is not passive about providing access, as libraries are. It has actively marketed the CNG around the world, and sizable revenues have resulted. One must agree that the Complete National Geographic is an attractive, convenient and unique resource. But, assembled the way it is, the CNG bypasses the rights of copyright owners whose works are embedded within.

CONCLUSION

The Society and other publishers warn that the publication of back issues as a whole in a new medium should be routinely privileged because otherwise authors and photographers could deny permission for re-use of their works or ask for excessive fees. That is not what the Copyright Act provides. Congress crafted a qualified privilege in Section 201(c) that does provide a re-publication privilege in tightly limited circumstances. Congress also made it clear that re-publication in a “new collective work” or a “new collection” is beyond the privilege, and the Supreme Court noted those limitations expressly in Tasini.

The Supreme Court said in Tasini that the publishers there had warned that “a ruling for the Authors will have ‘devastating’ consequences [and] will punch gaping holes in the electronic record of history.” 533 U.S. at 504-05. The Court observed, however, that an injunction against re-publication was not mandatory and may not be necessary.

The parties (Authors and Publishers) may enter into an agreement allowing continued electronic reproduction of the Authors’ works; they, and if necessary the courts and Congress, may draw on numerous models for distributing copyrighted works and remunerating authors for their distribution.

533 U.S. at 505.¹⁹

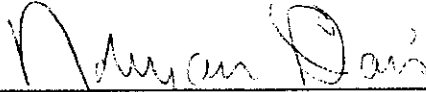
Even before Tasini was decided, this Court in Greenberg I had a similar message for the district court below: “[W]e urge the court to consider alternatives [to injunctive relief], such as mandatory license fees, in lieu of foreclosing the public’s computer-aided access to this educational and entertaining work.” 244 F.3d at 1276.

Alternative remedies are available, but they all arise from an infringement of the Greenberg copyrights, as this Court properly held in Greenberg I.

¹⁹ “[I]t bears reminder here and throughout that these Publishers and all others can protect their interests by private contractual arrangement.” Tasini, 533 U.S. at 502 n.11.

Respectfully submitted,

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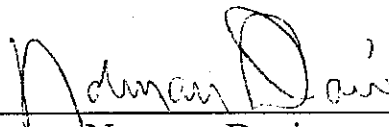


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In accordance with Federal Rule of Appellate Procedure 32(a)(7)(B) and (C),

I hereby certify that this brief contains 7,095 words, as determined by the word processing system used to prepare the brief.



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I hereby certify that a copy of this brief was served by Federal Express, on the counsel of record listed below, on this 16th day of November, 2007.



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