No. 08-___

IN THE

Supreme Court of the United States

JERRY GREENBERG.

Petitioner,

v.

NATIONAL GEOGRAPHIC SOCIETY, *ET AL.*

Respondents.

On Petition for a Writ of Certiorari
to the United States Court of Appeals
for the Eleventh Circuit

PETITION FOR WRIT OF CERTIORARI

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QUESTIONS PRESENTED

The questions presented here split the *en banc* Eleventh Circuit by a 7-5 margin and carry wide-reaching consequences to the future applicability of Section 201(c) of the Copyright Act. This Court, in *New York Times Co. v. Tasini*, 533 U.S. 483 (2001), explained that Congress intended, in promulgating that section, to enhance the ability of freelance artists to profit from further uses of their contributions to collective works. The questions presented are:

1. Whether, under *Tasini*, courts are limited to considering the context in which an individual contribution is presented to the user when determining if a collective work is a privileged revision under 17 U.S.C. § 201(c).

2. Whether, under *Tasini*, an aggregation of collective works, none of which has been modified, constitutes a revision of each of those works under 17 U.S.C. § 201(c).

PARTIES TO THE PROCEEDING

Petitioner is Jerry Greenberg, plaintiff-appellee below.

Respondents are National Geographic Society ("National Geographic"), National Geographic Enterprises, Inc., and Mindscape, Inc., defendants-appellants below.

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PETITION FOR A WRIT OF CERTIORARI

Petitioner Jerry Greenberg respectfully petitions for a writ of certiorari to review the judgment of the United States Court of Appeals for the Eleventh Circuit.

OPINIONS BELOW

The *en banc* decision of the Eleventh Circuit is reported at *Greenberg v. National Geographic Soc'y*, 533 F.3d 1244 (11th Cir. 2008) (en banc), and is reprinted in the Appendix to the Petition ("Pet. App.") at 1a-85a. The panel's decision is reported at 488 F.3d 1331 (11th Cir. 2007), and reprinted at 86a-101a. The district court's judgment entered after the jury verdict is available on PACER and reprinted at 102a-103a. The Eleventh Circuit's prior decision is reported at 244 F.3d 1267 (11th Cir. 2001), and reprinted at 104a-124a.

JURISDICTION

The court of appeals issued its *en banc* decision on June 30, 2008 (Pet. App. at 1a), and this Petition is timely filed. This Court has jurisdiction pursuant to 28 U.S.C. § 1254(1).

STATUTORY PROVISIONS INVOLVED

The Copyright Act is contained in 17 U.S.C. § 101, *et seq.* Section 101 defines "collective work:"

> A "collective work" is a work, such as a periodical issue, anthology, or encyclopedia, in which a number of contributions, constituting separate and independent works in themselves, are assembled into a collective whole.

Subsection (c) of 17 U.S.C. § 201, Contributions to collective works, provides:

> Copyright in each separate contribution to a collective work is distinct from copyright in the collective work as a whole, and vests initially in the author of the contribution. In the 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.

STATEMENT OF THE CASE

This case implicates the careful balance of power between publishers and artists struck by Congress in the Copyright Act and affirmed by this Court in *New York Times Co. v. Tasini*, 533 U.S. 483 (2001). It presents the question of whether a database aggregating many collective works constitutes a "revision" of each of its constituent collective works under Section 201(c) of the Copyright Act. Congress created Section 201(c) as a default rule to limit the ability of a publisher to republish contributions to collective works without providing compensation to the freelance artists who should benefit from the demand for their work after the initial publication. Section 201(c) thus creates a foundational backdrop against which publishers and freelance artists negotiate all of their contracts. Such formal and informal contracts are entered into every day, and they depend on clear default rules so that publishers

and artists alike understand when the artist is entitled to pay for the use of his contributions.

Seven years ago, this Court in *Tasini* relied on the plain language and clear purpose of Section 201(c) to find that various databases of articles from periodicals were not "revisions" of the original individual magazines and newspapers. Acting *en banc*, a 7-5 majority of the Eleventh Circuit repudiated *Tasini*'s approach, holding that Section 201(c) only requires that a contribution to a collective work be placed in "context." The court then declared that a function that lets users "flip" between adjacent pages was all that was required to satisfy that "context" inquiry. The result is that publishers can transform *any* collection (regardless of size, use, or content) into a privileged revision under Section 201(c) by merely including a "flip" feature. (Pet. App. at 14a). The Second Circuit agrees with this approach. *See Faulkner v. National Geographic Enters.*, 409 F.3d 26 (2d Cir. 2005).

The Eleventh Circuit's decision, directly contrary to *Tasini*, will only exacerbate the confusion about artists' rights that has significantly hurt their ability to receive full payment for their work, while the possibility that another circuit will follow *Tasini* will simultaneously chill many publishers from selling databases of their archives to the public. This Court should close the loophole opened by *Faulkner* and widened by the *en banc* court below, and reaffirm *Tasini's* straightforward definition of "revision."

A. Factual Background

Respondent National Geographic is a non-profit organization that publishes the National Geographic Magazine. Petitioner Jerry Greenberg is a photographer who completed various freelance assignments for the magazine. Over sixty of his photographs were published in the magazine between 1962-1990, including one on the cover.

In 1996, National Geographic used a number of wholly-owned, for-profit subsidiaries to create a database of all issues of the magazine from 1888 to 1996. Together with various other for-profit partners, it created and marketed a set of 30 CD-ROMs titled "The Complete National Geographic" ("CNG"). Each page was scanned, complete with advertisements and pictures, creating an exact image of each page as it appeared in the magazine. By clicking the "next page" button, a user can flip continuously from the first issue in 1888 through last issue of 1996.

To this, National Geographic added a 25-second video of ten famous covers (including one of Mr. Greenberg's photographs), a video advertisement for Kodak, and various software programs to allow users to search, view, and print the database of images. (Pet. App. at 32a-33a, 50a) (Birch, J., dissenting). Users can search by topic, title, key word, or contributor, and can save their search results so that any particular article can be easily accessed later. *Id.* National Geographic and its partners registered separate copyrights with the Copyright Office in the new collection as a whole and in the separate

software programs. (*Id.* at 33a, 109a). The set of 30 CD-ROMs was first published in 1997.

The CNG contains no safeguards to protect individual articles or photographs from reproduction or piracy. An inexperienced user can use standard programs, such as Windows Explorer and the cut and paste function, to copy and paste pictures from the CNG with just a few clicks. (*See id.* at 34a). Indeed, one version of the CNG purported to grant users express permission to copy images from the database for commercial use. And even the most recent version of the CNG encourages users to print copies of individual articles or images.

The CNG was an incredible commercial success. Over 1.4 million copies have been sold at up to $200 per copy, garnering tens of millions of dollars in revenue. None of that revenue was shared with the freelance contributors to the original magazines. (Pet. App. at 108a) (National Geographic refused to "provide the contributors with any additional compensation for the digital republication and use of their works"). Due to this case, and the confusion in the law surrounding publication of such databases, the CNG has been off the market since 2003. Since that time, very few magazines have ventured to brave the legal landmines surrounding the selling of their archives in new collections.

B. Procedural History

Mr. Greenberg sued National Geographic in 1997 for copyright infringement, claiming that the CNG infringes his copyrights in his individual contributions to the magazine. The district court,

having jurisdiction under 28 U.S.C. §§ 1331 and 1338(a), dismissed his claim on the ground that the CNG was a privileged "revision" of the individual print issues under Section 201(c).[1]

The Eleventh Circuit reversed (*Greenberg I*), rejecting National Geographic's claim that the database was a revision of each magazine under Section 201(c). (Pet. App. 121a). Relying on the "common sense" meaning of "revision," the court held that:

> the Society . . . has created a new product ('an original work of authorship'), in a new medium, for a new market that far transcends any privilege of revision or other mere reproduction envisioned in § 201(c).

(*Id.* at 115a). It also held that the individual magazines, considered alone, could not be "revisions" because nothing was actually *revised*. (*Id.* at 114a, 117a n.14). The court remanded the case for trial.

At trial, Mr. Greenberg introduced evidence that National Geographic took a "damn the torpedoes" approach to copyright issues. When confronted with copyright concerns, the Editor-in-Chief of the magazine effectively shrugged: "We are so far down the road at this point that we probably just have to

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[1] Though the district court called the CNG a "revision," National Geographic insisted below that the CNG was a "straightforward reprint" and a "**republication, *not a revision.***" (Pet. App. at 36a n.8) (emphasis in original).

keep smoothing as many bumps as possible and drive like hell with our fingers crossed."[2] Mr. Greenberg also demonstrated that his photographs had independent economic value, having been licensed for use in advertising and books. In the end, the jury found that National Geographic and its partners had willfully infringed Mr. Greenberg's copyrights, and awarded statutory damages of $400,000.

National Geographic appealed, arguing that *Tasini* radically altered the legal landscape by now letting a publisher sell any database of periodicals so long as the images appear exactly as they do in the magazine, and so long as the database allows a user to directly browse between the pages. A panel of the Eleventh Circuit agreed (*Greenberg II*). (Pet. App. at 86a). The Eleventh Circuit granted Mr. Greenberg's petition for *en banc* review, but reached the same result in a 7-5 split decision (*Greenberg III*). (Pet. App. at 1a).

The *en banc* majority held that *Tasini's* test for whether a database is a privileged revision under Section 201(c) is limited to determining whether or not individual contributions are "removed from their original context." (Pet. App. at 9a). Although it acknowledged that some element of "novelty or 'newness'" was needed (Pet. App. at 11a), it found

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[2] Pl's Memo. in Opp. to Defs' Mtn for JMOL, Mtn for New Trial, and Mtn for Remittitur at 7, *Greenberg v. National Geographic Soc'y*, No. 1:97-cv-03924-AMS (Doc. 293) (S.D. Fla 2003).

that this factor is *always* satisfied where a collective work is transferred from one medium to another, such as from print to microform or to electronic media (*id.* at 12a, 18a-19a). No editorial changes or additions are necessary in the eyes of the majority.

The court also held that the "context" inquiry was satisfied, equating the CNG with microform because it presented images in their original context (albeit without any actual *revision*). (*Id.* at 11a-14a). Rejecting concerns about the obvious and practical differences between microform and the CNG, the court held that considerations such as the use, market, and effect on the contributor's copyright are "legally irrelevant." (*Id.* at 21a n.20). It distinguished *Tasini's* holding that one database of periodicals (the General Periodicals OnDisk, or "GPO") was not a revision on the basis that the CNG, unlike the GPO, allows users to "easily scroll through an entire issue" without conducting multiple searches. (*Id.* at 14a, 14a n.13). The majority conceded that this "flip" function may not matter to the user, but concluded that it dictated the legal analysis. (*See id.* ("[it] may not make a large difference from a marketing standpoint, it does from a legal perspective")).

Finally, the majority held that the addition of software programs and introductory videos was immaterial because it "in no way alters the context in which the original photographs are presented." (*Id.* at 20a). The addition of some 1,200 extra magazine issues also was not considered to be something that altered the "context" of any individual issue. (*Id.*).

While the majority only considered whether each contribution was seen in the context of its collective work, the five dissenters also asked whether the CNG was a "revision of that collective work" as prescribed by Section 201(c). Judge Birch's dissent argued that, as a perfect replica, the CNG does not *revise* any of the collective works, but that, as a comprehensive "assembly" of those works, it constitutes a new collective work. (Pet. App. at 48a-50a, 54a). He relied on the statutory language, finding that when publishers join many collective works into one collection, "*the resulting compilation is a* new anthology or new collective work, *rather than a revision of 'that collective work.'*" (Pet. App. at 41a, 41a n.16) (emphasis in original).

Judge Anderson's dissent framed the question presented by this case as whether "satisfaction of the contextual analysis always mean[s] that the new publication enjoys the § 201(c) privilege?" (*Id.* at 75a). Judge Anderson found that the majority misreads *Tasini* to find that "context" is the only thing that matters. (*Id.*). He reasoned that if a magazine issue devoted to Africa were reprinted as a chapter in a new book called "The Complete Intellectual History of Africa," everyone would agree that it was an entirely different collective work. (*Id.* at 76a). This is so even though every article is placed exactly in "context" within the original collective work. By the same token, just because an issue of National Geographic is reprinted together with other issues in the CNG does not render the CNG any more of a "revision" of that original issue than Judge Anderson's hypothetical book on Africa. (*Id.*). He also faults the majority's analogy to microform, not

only because it and CNG have almost nothing in common, but also because *Tasini* never held that microform enjoys the Section 201(c) privilege. (*Id.* at 78a).

REASONS FOR GRANTING THE PETITION

The *en banc* majority in the Eleventh Circuit, echoed by the Second Circuit, has warped this Court's holding in *Tasini* and, in the process, fundamentally reshaped the carefully calibrated balance that Congress struck in the Copyright Act. *Tasini* held that publishers and artists could agree upon compensation and paved the way for the release of archives of periodicals. *Tasini*, 533 U.S. at 505. But this has not happened because of uncertainty about whether publishers owe anything at all to artists under *Tasini*, as illustrated by the decade of litigation in this case. Few media companies are willing to publish databases of their archives without knowing whether they need to pay artists for their contributions. The Second Circuit in *Faulkner*, and now the Eleventh Circuit in *Greenberg*, in a 7-5 divided *en banc* decision, have held that a publisher can avoid paying the artist anything under *Tasini* by the simple expediency of creating "context" by including a feature that allows users to "flip" between the pages of individual magazines. Those decisions directly conflict with the analysis in *Tasini* that they purport to follow, creating confusion that only this Court can dispel.

Tasini held that whether a database is a "revision" depends on the clear purpose and plain language of the statute, which provides that a publisher of a 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) (emphasis added). As demonstrated by the text, Congress meant to limit the privilege to "certain limited circumstances." H. Rep. 94-1476 (1976), at 122-23, *as reprinted in* 1976 U.S.C.C.A.N. 5659, 5737. This privilege did *not* extend to "a new anthology" or other "new collective works." *Id.*; *Tasini,* 533 U.S. at 497.

Following the statutory language, *Tasini* held that a database is not a "revision" of the original periodical issues under any reasonable definition of that term: "The massive whole of the Database is not recognizable as a new version of its every small part." *Id.* at 499-500. Applying Congress' clear intent, *Tasini* also refused to define revision so broadly as to destroy the value of the copyright in the individual contribution. *Id.* at 497-99 (rejecting publisher's definition of revision because it significantly reduced the value of the author's copyright). *Tasini* further noted that without the ability to flip between the pages of a particular issue, the databases did not even present the contributions in the context of a collective work that might qualify under Section 201(c): "either the original edition or a 'revision' of that edition." *Id.* at 500-04.

The *en banc* majority of the Eleventh Circuit fixated exclusively on *Tasini's* third factor, context, creating a legal loophole that allows publishers to transform *any* image-based database into a "revision"

by adding a "flip" function. This new approach dismisses *Tasini's* teachings about the statute's plain language and purpose as "legally irrelevant" dicta. (Pet. App. at 21a n.20). Not surprisingly, many scholars have found this test inconsistent with *Tasini's* multi-factor approach, the language of the statute itself, and Congress' express purpose. *See* Deborah Tussey, *Technology Matters: The Courts, Media Neutrality, and New Technologies*, 12 J. INTELL. PROP. L. 427, 485 (2005) (noting that this approach is inconsistent with the best reading of *Tasini* and "undercuts the policy protecting authors"); Lateef Mtima, *Tasini and its Progeny: Exclusive Right or Fair Use On the Electronic Publishing Frontier?*, 14 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 369, 425 (2004) (noting that *Tasini* considered many factors, not just "context").[3]

Nevertheless, the Eleventh Circuit majority allows any publisher to declare that any compilation of collective works is a "revision" even if it is entirely

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[3] At least one commentator agrees with the *en banc* majority that the CNG falls under Section 201(c). *See* 2 William Patry, PATRY ON COPYRIGHT, § 5:142.95 (2008). But even Mr. Patry concedes that the CNG is not a "revision" because nothing was revised. *Id.* at 5-312. Instead, he posits that each issue contained in the CNG should be seen as an individual republication of the original issue. *Id.* But the CNG cannot be "*that* collective work" under the first prong of 201(c), because, as even the *en banc* majority appears to concede (Pet. App. 17a-19a), the aggregation of many magazine issues and computer programs creates a "new collective work."

different in content, purpose, market, and user experience from the original collective works it contains. According to the majority, the "flip" function is the key factor that changes a vast collection of many disparate collective works from being "a new collective work" under *Tasini* into a "revision" of every individual collective work. This is so even though the flip function does not revise or change the content of the aggregated collective works in any way. Under this test, any database will be a revision if it shows the artist's contribution to the user in "context."

The five dissenters to the *en banc* opinion explain that the majority missed the forest for the trees. The majority looked only at each magazine, while the statutory definition of collective work (as an "assembly" or "aggregation") directs the court to consider the product itself, the CNG. This logic flows inexorably from *Tasini*:

> After all, the *Tasini* Court noted that placing all the articles from one edition of the New York Times into a CD-ROM database along with all the articles from other editions of that paper, does not constitute a revision of each edition: 'The Database no more constitutes a 'revision' of each constituent edition than a 400-page novel quoting a sonnet in passing would represent a 'revision' of that poem."

(Pet. App. at 77a) (Anderson, J., dissenting) (citing *Tasini*, 533 U.S. at 500). The illogic of elevating the addition of a "flip" feature above all else is particularly pronounced when that feature makes

little or no difference to the user or copyright holder. (Pet. App. at 80a-81a) (Anderson, J., dissenting).

This Petition presents a clear example of a product, the CNG, that presents individual contributions in context but is not a "revision" of any particular magazine in any sense of the word, and which destroys any value in the artists' copyrights. *Tasini* spoke directly to this situation: just as "[t]he massive whole of the Database is not recognizable as a new version of its every small part," *Tasini* 533 U.S. at 499-500, it is clear that "the massive whole of the [CNG] is not recognizable as a new version of its every [monthly magazine]." This Court should reaffirm that *Tasini* requires that a court considering such a database must review all of the factors identified by *Tasini*.

A. *Tasini* Held That A Database Of Periodicals Is Not Recognizable As A "Revision" To A Magazine

Tasini held that a database of the contents of many collective works is not, by definition, a revision of each of the individual collective works. Defining a revision as a "distinct form" or "version," of the original collective work, this Court held that the "massive whole of the Database is not recognizable as a new version of its every small part." *Tasini*, 533 U.S. at 500 (citation omitted). *Tasini* explained, "[o]ne might view the articles as parts of a new compendium – namely, the entirety of works in the database. In that compendium, each edition of each periodical represents only a miniscule fraction." *Id.* A database containing a thousand issues of a magazine is not a revision of any one issue.

Although the databases in *Tasini* were not revisions, there are many clear examples of what *is* a revision. *Tasini* noted that a publisher could reprint content from the 1980 edition of an encyclopedia in the subsequent 1990 edition. *Id.* at 497. The regional or evening editions of a newspaper are, indisputably, revisions of that day's newspaper. *See id.* at 512-13 (Stevens, J., dissenting). Revisions also include yearly editions of dictionaries, adding new words and definitions, or perhaps a textbook updated periodically with current material.

These easily recognizable examples meet all of the criteria for a revision identified by *Tasini*. They are sold for the same consumer use, to the same markets, cost about the same, and do not change the nature or character of the original collective work. They may modify or update some of the content, but are regarded by everyone as a simple revision of the original. Importantly for *Tasini*, they have little effect on the subsequent value of the copyright in the individual contribution. *Tasini*, 533 U.S. at 504 (a revision cannot "effectively override[]" the artist's "exclusive right to control the individual reproduction and distribution"). Compared with the standard examples above, a database of thousands of magazines "simply cannot bear characterization as a 'revision' of any one periodical edition." *Id.* at 501 n.9.

Justice Stevens disagreed in *Tasini*, asserting that if an electronic edition of the New York Times on a computer disk could be considered a revision of the original,

> I do not see why the inclusion of other editions and other periodicals is any more significant than the placement of a single edition of the New York Times in a large public library or in a book store.

Tasini, 533 U.S. at 517 (Stevens, J., dissenting). But the majority in *Tasini* rejected this reasoning. The Court held that a database was not a revision of any one issue, it was a "new compendium" that was concerned with access to individual *articles*, not individual *newspapers or magazine issues*. *Id.* at 500, 503. The value of a database, by definition, is in the user's ability to find individual articles on desired topics.

In addition, *Tasini* held that the databases did not present the articles in the context of a collective work that might qualify for the Section 201(c) privilege. It explained that the databases "store and retrieve articles separately within a vast domain of diverse texts" and that they did not "perceptibly present[] the author's contribution *as part of a revision* of the collective work." *Id.* at 503-04 (emphasis added). The databases did not even give links to the surrounding pages or allow a user to "flip" from one page to the next. *Id.* at 491 n.2, 503-04. Completely divorced from the rest of the collective work, it was impossible for the article to be part of "either the original edition or a 'revision' of that edition." *Id.* 500, 504.

In sum, *Tasini* held that Section 201(c)'s "revision" privilege applies only to actual revisions of the *particular collective work*. It analyzed the economic effect of the databases on individual copyrights held by the artists and rejected a

definition of "revision" as "unacceptable" because "it would diminish the Authors' exclusive rights in the Articles." *Tasini*, 533 U.S. at 499. It further held that the databases were simply not recognizable as a "distinct form" of the individual periodicals in which the articles appeared. *Id.* at 500. Rather, they were *new* collective works, different in purpose and use, where individual issues were no more than "a miniscule fraction" of the whole. *Id.*[4] Lastly, it required that individual works be presented in their original context. *Id.* at 503-04. This is akin to a threshold requirement – an electronic copy of a magazine cannot be considered a "revision" if it does not bear even a superficial resemblance to the work it supposedly revises. *Id.*

B. The Eleventh Circuit *En Banc* Majority Has Repudiated *Tasini*

The Eleventh Circuit's majority ignored the two factors in *Tasini* required by the statute, the common sense definition of "revision" and the purpose of protecting the artist's rights, in favor of "context," the judicially-created third factor. It held that the only test for whether a database qualifies as a "revision"

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[4] The majority in *Greenberg III* responds to this point in a footnote, claiming that "the amount of 'newness' will certainly impact the contextual inquiry." (Pet. App. at 19a n.18). Yet if 1,200 magazine issues crowded with one magazine issue ("that collective work") does not impact the context of that one issue, it is difficult to imagine what the majority imagines could change the context.

under Section 201(c) is whether individual contributions are presented to the user in their original context with some modicum of "newness." This is so even if the database is entirely different in content, purpose, market, and user experience from the original collective work. The Eleventh Circuit has effectively adopted Justice Stevens' dissent, holding that so long as each issue is a faithful reproduction of the original, the "inclusion of other editions" to create a new collective work is not "any more significant" than the inclusion of the issue in "a large public library." *Tasini*, 533 U.S. at 517 (Stevens, J., dissenting).

Tasini held that a freelancer *must* be able to benefit from the inclusion of his work in "a new collection" or "new collective work," such as the LEXIS/NEXIS or GPO databases. *Id.* at 497. The Copyright Act defines "collective work" as a work "in which a number of contributions constituting separate and independent works in themselves, are assembled into a collective whole." 17 U.S.C. § 101. If those databases are "collective works" under the statutory language, not a revision of their constituent periodical issues, then so is the CNG.

The contrast between *Tasini*'s approach and of the majority below is most apparent when comparing the GPO at issue in *Tasini* with the CNG in this case. Both are image-based collections that allow users to search the universe of their contents, display articles as separate items within the search results, and display the requested pages complete with photographs, captions, and advertisements. The only real difference, as recognized by the *en banc* majority, is that the CNG allows a user to "flip" from article to

article in the scanned pages. (Pet. App. at 14a). The majority held that this single difference was enough to dictate a different outcome under *Tasini*, making the CNG a revision of each individual magazine. (*Id.* at 14a, 14a n.13 ("While the 'flip' function of the GPO may not make a large difference from a marketing standpoint, it does from a legal perspective.")). By turning this feature into a proxy for "context" that can constitute a revision, the court ignored *Tasini*'s teachings about why the GPO is not a revision of an individual magazine under Section 201(c), and therefore radically reshaped the governing legal standard.

The *Tasini* Court offered three principal reasons why the GPO is not a revision.

1. The first is premised on the express purpose of Section 201(c): "If there is demand for a freelance article standing alone or in a new collection, the Copyright Act allows the freelancer to benefit from that demand." *Tasini*, 533 U.S. at 497. Reselling individual periodicals as a part of massive databases eliminates the value of individual contributions, so an interpretation of the statute that destroys that value cannot be correct. As the Court noted, few people will buy a collection of stories or photographs if the individual works are "freely and permanently available on line." *Id.* at 497 n.6. And who would buy the rights to a photograph if it, bundled with tens of thousands of other individual works, was available for the same price?

In response, the publishers in *Tasini* argued that they were merely exercising their privilege to reproduce a revision of each individual collective

work, and that each database was only a forum for many individual revisions of collective works, not a collective work itself. *Id.* at 499. The Court squarely rejected this "encompassing construction" of the meaning of revision as "unacceptable" because it would "diminish the Authors' exclusive rights" – the opposite of what Section 201(c) was intended to do. *Id.* The right to republish the articles in a "new collection," which the databases undoubtedly were, inures to the author. *Id.* at 497. After all, the express intent of the 1976 legislation that created Section 201(c) was "to enhance the author's position vis-a-vis the patron." *Id.* at 496 n.3.

This point was echoed by Judge Anderson in dissent, who explained that National Geographic was selling

> an entirely new product – a sophisticated research tool capable of readily accessing and isolating any article or subject matter . . . thus appealing to a new market. I do not believe that § 201(c) can encompass the magnitude of the changes wrought here.

(Pet. App. at 80a) (Anderson, J., dissenting). Aggregating 1,200 issues of a magazine together creates a "new product in a new format with these new features and these new uses." *Id.* This is a new collection that creates a right to compensation for contributors. (*Id.* 80a-81a). The *en banc* majority, of course, dismissed this market analysis as "legally irrelevant." (*Id.* at 21a n.20).

2. Next, *Tasini* turns to the plain meaning of the word "revision" as used in the statute. *Id.* at 500. The compilation of articles from thousands of

collective works does not constitute a revision of those collective works: the "massive whole of the Database is not recognizable as a new version of its every small part." *Id.* The Court saw this new product for what it is, what consumers expect from it, and how it is marketed: "a new compendium – namely, the entirety of works in the Database." *Id.* An individual magazine within the whole of the database (of 1,200 magazines in the CNG) "no more constitutes a 'revision' of each constituent edition than a 400-page novel quoting a sonnet in passing would represent a 'revision' of that poem." *Id.*; *see* Tussey, 12 J. INTELL. PROP. L. at 484-85 (the best reading of *Tasini* is that "an accumulation of issues . . . is a new anthology collecting multiple, previous compilations").

Though the Court held that databases must be considered as one collective work and not as multiple individual revisions of magazines, *Tasini*, 533 U.S. at 499, it did recognize, alternatively, that they might be viewed by the user as "individual articles presented individually." *Id.* at 500. But this characterization does not help either the GPO or CNG become "individual *collective works* presented individually." The purpose of those databases is to let a user search for individual contributions, not particular magazine issues. There is no consumer demand for individual archived magazines, and which article goes with which magazine is irrelevant to the user. If National Geographic had switched various articles between various issues in the CNG, few users would notice or care.

The dissenters below echoed *Tasini*'s holding, noting that Section 201(c) allows for revisions of only "that particular collective work," not massive

databases. (Pet. App. at 41a-42a) (Birch, J., dissenting). Neither Congress nor this Court allows a "new anthology" or "other collective work" to masquerade as a "revision." (*Id.* at 42a). The CNG is nothing if not a new anthology and new collective work. (*Id.*); 17 U.S.C. § 101 (definition of "collective work"). In response to Justice Stevens' question of why publishers cannot publish all the issues together if they can publish each issue individually, *Tasini* and the dissenters answer together: *"the resulting compilation is* a new anthology or new collective work, *rather than a revision of 'that collective work."* (Pet. App. at 41a n.16) (emphasis in original); *see Tasini*, 533 U.S. at 500.

These twin holdings are dictated by Congress' clear purpose in enacting Section 201(c), and its understanding of the limited nature of the publisher's privilege. Mtima, 14 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. at 375 (noting that these two holdings are the "two principal bases upon which" *Tasini* "disqualified the digital re-publications from shelter within the special statutory privilege"). Congress explained that "the publisher could not revise the contribution itself or include it in a new anthology or an entirely different magazine of other collective work." H. Rep. 94-1476, at 122-23, *as reprinted in* 1976 U.S.C.C.A.N. 5659, 5737. Indeed, soon after it was enacted, an attorney for a major publisher conceded that the privilege was very limited: "the right to include the contribution in any revision would appear to be of little value to the publisher." (Pet. App. at 27a n.1) (Birch, J., dissenting) (citation omitted).

3. *Tasini*'s third reason for denying the status of revision to the GPO was that it did not place the articles in context because it did not allow users to move directly between articles in the same issue. Of course, the CNG's flip feature meets this one contextual criterion. And on that basis alone the *en banc* majority dismissed *Tasini*'s two other holdings as irrelevant. Yet Judge Anderson, in dissent, explained that this was the *weakest* of the three reasons:

> As a matter of common sense and common experience, that is not a difference that would make a difference to the user, or to the publisher whose interest is marketing the new product. The existence *vel non* of the flip feature is similarly irrelevant to the authors of the individual articles.

(Pet. App. at 81a) (Anderson, J., dissenting). Judge Birch, also in dissent, noted that one could make a "digital microfilm" that would allow a user to go from page to page. (*Id.* at 53a) (Birch, J., dissenting). But without the comprehensive database and search feature, such a product "would not be marketable." (*Id.*). The "flip" feature defines print and microform – it is largely irrelevant to electronic media and is hardly a sufficient basis to depart from *Tasini*.

The *en banc* majority actually conceded that the context of an individual article "may not make a large difference from a marketing standpoint." (*Id.* at 14a n.13). But they held that *Tasini* required them to turn a blind eye to such realities, and treat the question from a purely "legal perspective." (*Id.*). Yet, as *Tasini* explained, whether a product is considered

a "revision" of a collective work should depend upon its effect on an artist's individual copyright, the intended market, and its avowed purpose and use.

The Eleventh Circuit has thus rewritten *Tasini*, so that "context," defined by the ability to flip between pages, is all that matters for the legal test for a revision, even though it makes no difference to the user, the publisher, or the author. The conflict with *Tasini* could not be more stark.

C. If The Circuits Have Not Misread *Tasini*, Then *Tasini* Has Proven To Be Unworkable

The legal test introduced by *Faulkner* and enhanced by *Greenberg III* has implications far beyond this Petition. The Second and Eleventh Circuits' misreading of *Tasini* creates an easy workaround for publishers desiring to benefit from the demand for individual works without paying the artist. This is inimical both to *Tasini* and congressional intent, and at a minimum illustrates the need for the Court to clarify *Tasini*.

The *en banc* court's interpretation of *Tasini* makes a mockery of Section 201(c). Though it holds that context is "the bedrock of any § 201(c) analysis," closer scrutiny reveals that this bedrock is nothing more than the ability to move between pages. (Pet. App. at 24a). And the only other requirement is "newness," which is apparently satisfied by the move from print to electronic media. (*Id.* at 11a-12a, 18a-19a). No actual *revisions* are necessary in the Eleventh Circuit's view. Nor must the new products

resemble in any meaningful way anything that was contemplated by Congress.

Defining revision in terms of "context" is unworkable as a general test, even for products similar to the CNG. For example, if an online magazine wished to sell its archives in print or DVD, how would it provide context? Would it have to include the banner advertising, hyperlinked content, reader commentary, videos and podcasts, web-style formatting, and its search engine? It is impracticable, and likely impossible, to reproduce the "context" of a website in any other medium. Nor does the focus on recreating a reader's experience – the importance of allowing a reader to "flip" between content the same way as in the previous media – make any sense. One clicks from page to page in a website; this is simply not possible in print. *Tasini's* approach is far more workable than the draconian test adopted below.

And the "context" loophole recognized by the Eleventh Circuit utterly destroys the ability of artists to benefit from their works. So long as publishers use an image-based database with a flip function, they can place their entire archive of magazines or newspapers on the web for free, benefiting from advertising revenues or increased traffic. Yet the artist receives nary a penny. The majority's reasoning below knows no constraints, as it in no way is limited to CD-ROMs or other disks, but applies just as readily to the Internet and to magazine archives posted online. Publishers can sell access to individual articles, stories, or pictures, so long as the rest of the pages in the issue are a click away. Once a Google search can find it, the author's copyright for

that individual text, picture, or video is essentially worthless.[5] Under the majority's decision, nothing prevents National Geographic from putting the CNG's search engine online, linking directly to the desired article exactly as it does on the CD-ROMs.

Supporters of the context-only test for Section 201(c) celebrate the approach in *Greenberg II* as a complete victory for publishers:

> Similarly, so long as the original context is preserved, how access is controlled to the original or parts thereof, is irrelevant. Current models in the newspaper and magazine field run the gamut from free, unfettered access, password protected but free access, and paid subscriptions. Pay-per-view may even be broken down by individual articles or issues. None of this matters, so long as the original context has been preserved.

Patry, PATRY ON COPYRIGHT, § 5:143 at 5-315. This new paradigm "would scarcely 'preserve the author's copyright.'" *Tasini*, 533 U.S. at 497.

The majority's decision below thus eliminates a freelance artist's motivation to create works that will maintain relevancy or value in the future. Thomas Dallal, *Faulkner v. National Geographic Enterprises,*

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[5] For example, a spokesman for the new archive of Sports Illustrated Magazine (*see* http://vault.sportsillustrated.cnn.com) hopes that when "someone searches Johnny Unitas" then "SI.com is going to pop up." Richard Pérez-Peña, *Dusting Off the Archive for the Web*, NEW YORK TIMES (Mar. 17, 2008).

Inc.: Driving a Truck Through the Eye of a Needle, 15 TEX. INTELL. PROP. L.J. 63, 88 (2006) (former photojournalist explains that *Faulkner* will "chill the creation of new works by freelance authors because they can no longer rely on being able to reap the residual income that their works have historically generated."). As mentioned above, Congress sought to balance the bargaining power between publishers and freelancers, rejecting the idea that artists should cede all exclusive rights to a publisher. No publisher offers consideration for rights it can simply claim, and as we have seen, the "revision" right created by the Eleventh Circuit majority is almost boundless.

In addition, when publishers release these database archives on the web or on disk, they have no incentive to protect the individual artists' work. Publishers could allow users to drag-and-drop images from their magazine off of the web, and would never be responsible for inducing infringement. *Faulkner*, 409 F.3d at 40 ("there can be no contributory infringement absent actual infringement"). Indeed, the CNG contains no copy protection at all. In his dissent, Judge Birch explained how a user (using only standard programs) can copy, edit, and transmit any picture from the CNG with just a few mouse clicks. (Pet. App. at 33a-34a) (Birch, J., dissenting). The artist has no means of protection under the Eleventh Circuit majority's regime.

The majority dismissed the dissenters' concerns about the destruction of the author's copyright by holding that "this is not the proper inquiry under *Tasini*." (Pet. App. at 11a n.10). They likened the CNG to microform: "this is no different from material in microform where a user can print only a portion of

what is contained on a microform roll or a microfiche sheet." (*Id.*). But, microform has almost nothing in common with commercial databases. Most importantly, microform is non-commercial by nature. Nat'l Geo. En Banc Pet. (from *Greenberg I*) at 14 n.4 ("Not surprisingly, very few (if any) individuals buy microfilm or microfiche . . . for home use."). Microform is not sold to consumers and cannot be easily put on the web. Nor can microform be readily copied for use in other media—one cannot cut and paste from microfilm into a computer. It also contains no additional copyrightable elements, such as a search function or the CNG's introductory montage.

The vigorous disagreement between the majority and dissent about whether the value of the artist's copyright matters at all confirms that this Court's attention is needed to both uphold *Tasini* and eliminate the confusion that it has engendered.

D. This Case Represents an Ideal Vehicle To Explore Important Legal Issues Concerning The Copyright Act

This case presents the perfect vehicle for resolving the correct test for a "revision" under Section 201(c). There are no disputed factual issues, the parties have the benefit of a jury verdict on infringement and damages, and the parties, courts, and scholars have been debating this case and its implications for over a decade.

Even National Geographic has repeatedly recognized the importance of resolving the fundamental uncertainty:

> And even more fundamentally, clarification of the law in this area is vital to the preservation and diffusion of collective works in an era of rapid technological change . . . At issue here, in short, is the future of public access to digital information depositories.

Resp. to Pet. for Writ of Cert., *Faulkner v. National Geographic Enters.*, 126 S. Ct. 833 (2005) (Nos. 05-490, 05-504, 05-506), 2005 WL 2985713 at *10-11.

Until *Tasini*'s meaning is resolved, one way or the other, archives of artists' contributions will be stuck in an uncomfortable limbo. Only a handful of publishers have been brave enough to sell copies of their archives to consumers.[6] And some of those that have been published are not focused on usefulness, but rather on fitting within *Faulkner* and *Greenberg III*. For example, the recently-published *New Yorker* archive was designed "largely based on [*Tasini*'s] remarks about preserving context" – and the result was a "low-tech" product that frustrates many users. Jessica Mintz, *New Yorker on DVD is Readers' Delight, Surfers' Frustration*, WALL STREET JOURNAL (Nov. 10, 2005); Alex Beam, *It's a Case of Who Owns*

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[6] Once a publisher grants access to its archives, it exposes itself to liability from its freelance artists if any court later disagrees with *Faulkner* and *Greenberg III* and finds that the release violated the artists' rights. As a practical matter, only a relative trickle of archives will be released until this Court clarifies the matter.

the Words, BOSTON GLOBE (Oct. 4, 2005). Needless to say, the *New Yorker* archive was published without any compensation to freelance authors or artists. *Id.*

The future of easily-accessible digital archives is online, or perhaps in media that we cannot predict at this juncture. Regardless, the outcome of this dispute will determine whether freelance artists will share in the benefits of modern technology. Once a periodical archive is posted online, the value of a freelance contributor's copyright becomes *zero*. This Court should clarify that publishers cannot reap the benefits of appropriating the market for the freelancer's individual works without compensating the freelancer. Finally, without a clear test under Section 201(c), the future of projects such as Google or Yahoo's efforts to digitize books, and features used by many online retailers to publish excerpts on the web, remain uncertain. *See, e.g.*, Jonathan Kerry-Tyerman, *No Analog Analogue: Searchable Digital Archives and Amazon's Unprecedented Search Inside the Book Program as Fair Use*, 2006 STAN. TECH. L. REV. 1, ¶¶35-41 (2006) (noting the problematic application of *Tasini* to Amazon's "Search Inside").

But as important as it is for major publishers and successful artists, the impact of *Greenberg III's* interpretation of *Tasini* will chiefly fall upon the masses of freelance contributors. Tens of thousands of community papers and magazines, websites and blogs, software and video ventures (among others), create collective works from freelance contributions, paid or not. Most of these parties will not contract around the default privilege created by Section 201(c). And as a result, the *en banc* majority will allow these publishers to expropriate the individual

contributions in almost any manner without payment, no matter what the purpose, use, or effect the new use has on the freelancer's copyright. The Eleventh and Second Circuits have turned *Tasini* into a cipher, expanding the privilege to cover almost everything on disk or the internet. This Court should correct that error and reaffirm its holding in *Tasini*.

CONCLUSION

For all of the foregoing reasons, the petition for a writ of certiorari should be granted.

Respectfully submitted,

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Counsel of Record

September 29, 2008

APPENDIX

APPENDIX A

[PUBLISH]

IN THE UNITED STATES COURT OF APPEALS
FOR THE ELEVENTH CIRCUIT

No. 05-16964
D.C. Docket No. 97-03924-CV-AMS

JERRY GREENBERG, individually,
Plaintiff–Appellee,

IDAZ Greenberg, individually,
Plaintiff,

versus

National GEOGRAPHIC SOCIETY, a District of COLUMBIA corporation, NATIONAL GEOGRAPHIC ENTERPRISES, INC., a corporation, MINDSCAPE, INC., a California corporation,
Defendants–Appellants.

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

(June 30, 2008)

Before EDMONDSON, *Chief Judge*, TJOFLAT, ANDERSON, BIRCH, DUBINA, BLACK, CARNES, BARKETT, MARCUS, WILSON, PRYOR and KRAVITCH, *Circuit Judges*.[1]

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[1] Judge Frank M. Hull recused and did not participate in this case. Senior U.S. Circuit Judge Phyllis A. Kravitch elected to participate in this matter pursuant to 28 U.S.C. § 46(c).

BARKETT, *Circuit Judge*:

Appellant National Geographic Society is a non-profit scientific and educational organization that has published a monthly magazine since 1888.[2] The Society also produces televised programs and computer software as well as other educational products through National Geographic Enterprises, a wholly-owned and for-profit subsidiary of the Society. Appellee Jerry Greenberg is a freelance photographer, some of whose photographs were published in four issues of the National Geographic Magazine.[3]

For decades, the Society has reproduced back issues of the Magazine in bound volumes, microfiche, and microfilm. In 1997, National Geographic produced "The Complete National Geographic" ("CNG"), a thirty-disc CD-ROM[4] set containing each monthly issue of the Magazine, as it was originally published, for the 108 years from 1888 through 1996—roughly 1200 issues of the Magazine. In addition, the CNG includes a short opening montage and a computer program that allows users to search the CNG, zoom into particular pages, and print.

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[2] National Geographic Society is one of three Appellants in this case. The other two Appellants are National Geographic Enterprises, Inc. and Mindscape, Inc. Mindscape is the creator of the computer program underlying the "The Complete National Geographic"—the product at issue in this case. Collectively, the three Appellants are referred to throughout this opinion as "National Geographic."

[3] Specifically, Greenberg's photographs appeared in the January 1962, February 1968, May 1971, and July 1990 issues. In each instance, after their initial publication in the Magazine, Greenberg regained ownership of the copyrights in the photographs he originally assigned to National Geographic.

[4] CD-ROM is an abbreviation for "Compact-Disc Read-Only Memory."

Greenberg sued National Geographic, alleging that it had infringed his copyrights by reproducing in the CNG the print magazine issues that included his photographs. The district court disagreed and granted summary judgment in favor of National Geographic, holding that because the CNG constituted a "revision" of the print issues of the Magazine, the reproduction of Greenberg's photographs in the CNG was privileged under 17 U.S.C. § 201(c) of the Copyright Act and did not constitute an infringement of Greenberg's copyrights. However, a panel of this Court in *Greenberg v. National Geographic Society (Greenberg* I), 244 F.3d 1267, 1275–76 (11th Cir. 2001), reversed and remanded for the district court to "ascertain the amount of damages and attorneys fees that are, if any, due as well as any injunctive relief that may be appropriate." After a jury trial on damages, the jury returned a verdict against National Geographic in the amount of $400,000.

National Geographic appealed again, this time arguing that the intervening decision of the U.S. Supreme Court in *New York Times Co. v. Tasini*, 533 U.S. 483 (2001), decided after *Greenberg I,* mandated a reversal of the jury verdict against it. A second panel of this Court agreed, finding that *Tasini* compelled a reversal of the jury verdict because, under *Tasini's* rationale, National Geographic was privileged to reproduce its print magazines in digital format pursuant to § 201(c) of the Copyright Act. *See Greenberg v. Nat'l Geographic Soc'y (Greenberg II)*, 488 F.3d 1331 (11th Cir. 2007).[5] This Court then va-

[5] Subsequent to the *Tasini* decision, the Second Circuit also decided a case involving the CNG with nearly identical facts to this case. *See Faulkner v. Nat'l Geographic Enters. Inc.*, 409 F.3d 26, 36 (2d Cir. 2005) ("[The *Greenberg I*] decision addressed the application of Section 201(c) to a case virtually identical on

cated the *Greenberg II* panel opinion and granted rehearing en banc to address the question of whether National Geographic's use of Greenberg's photographs in the CNG is privileged.

I. DISCUSSION

The section of the Copyright Act that is relevant to the question before us, 17 U.S.C. § 201(c), was added to the copyright statute as part of the 1976 amendments to the 1909 Act, and provides:

> (c) Contributions to collective works. Copyright in each separate contribution to a collective work is distinct from copyright in the collective work as a whole, and vests initially in the author of the contribution. In the 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.

Prior to 1976, whenever freelance authors contributed to a collective work, they risked losing their copyright in their individual works absent a printed copyright notice in the author's name. A freelance author could not just assign the publisher the right of

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the facts and law to the instant matter."). In that case, the Second Circuit found that (1) *Greenberg I* did not have preclusive effect because "the *Tasini* approach so substantially departs from the *Greenberg* analysis that it represents an intervening change in law rendering application of collateral estoppel inappropriate," *id.* at 37, and (2) "because the original context of the [National Geographic] Magazines is omnipresent in the CNG and because it is a new version of the Magazine, the CNG is a privileged revision," *id.* at 38.

publication in the collective work while preserving her copyright in the individual work. The amended 1976 Copyright Act—including § 201(c)—rejected this idea of copyright "indivisibility," instead reframing copyright as a bundle of discrete "exclusive rights." *See Tasini*, 533 U.S. at 494–96; *see also* 17 U.S.C. §§ 106, 201(d)(2). Thus, as part of its recasting of copyright as a bundle of exclusive rights, Congress added § 201(c) to the Copyright Act in order to protect both the copyrights of freelance authors in their individual contributions to a collective work as well as the copyright of the publisher in the collective work itself:

> When . . . a freelance author has contributed an article to a "collective work" such as a newspaper or magazine, . . . the [Copyright Act] recognizes two distinct copyrighted works: "Copyright in *each separate contribution to a collective work* is distinct from copyright in *the collective work as a whole* . . . ." Copyright in the separate contribution "vests initially in the author of the contribution" (here, the freelancer). Copyright in the collective work vests in the collective author (here, the newspaper or magazine publisher) and extends only to the creative material contributed by that author, not to "the preexisting material employed in the work."

Tasini, 533 U.S. at 493–94 (citations omitted). Congress intended this limitation on what the author is presumed to give away primarily to keep publishers from "revis[ing] the contribution itself or includ[ing] it in a new anthology or an *entirely different magazine or other collective work*" without the author's consent. *Id.* at 497 (emphasis added) (quoting

H.R. Rep. No. 94-1476, at 122–23 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5738).

Thus, pursuant to § 201(c), and as *Tasini* notes, a magazine publisher is privileged to reproduce or distribute an article—or photographs, in this instance—contributed by a freelancer, "absent a contract otherwise providing, only 'as part of' any (or all) of three categories of collective works: (a) 'that collective work' to which the author contributed her work, (b) 'any revision of that collective work,' or (c) 'any later collective work in the same series.'" *Id.* at 496. National Geographic argues that it should be able to reproduce and distribute the CNG under either the first or second prongs of § 201(c). Greenberg, on the other hand, argues that the CNG should be considered a "new collective work" which, he asserts, is not entitled to any privilege under § 201(c).

Accordingly, we must decide whether the reproduction of the National Geographic Magazines from print to CD-ROM falls within either (a) "that particular collective work" privilege, and/or (b) the "revision of that collective work" privilege.[6] Because we conclude that the CNG is a "revision" of the original "collective works" under the second prong of § 201(c) based on *Tasini's* definition of "revision" in conjunction with its discussion of microform, we need not address

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[6] The third prong of the § 201(c) privilege—"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 . . . any later collective work in the same series"—is not at issue in this case, and National Geographic has not argued that the CNG falls within this third prong.

whether it is also privileged under the first prong of § 201(c).[7]

The Copyright Act defines "collective work" as a "work, such as a periodical issue, anthology, or encyclopedia, in which a number of contributions, constituting separate and independent works in themselves, are assembled into a collective whole." 17 U.S.C. § 101. Under the definition of "compilation," which includes "collective works," a "collective work" is an "original work of authorship" insofar as it involves the selection, coordination, or arrangement of preexisting materials or data. *Id.*; *see also id.* § 102(a) ("Copyright protection subsists . . . in original works of authorship fixed in any tangible medium of expression . . . .").

With respect to a "collective work," copyright extends only to materials contributed by the compiling

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[7] Judge Birch devotes nearly half of his dissent to two substantive issues that have never been raised in this case. In Parts B and C of his dissent, he finds that National Geographic impermissibly transferred its § 201(c) privileges to third-parties and the § 201(c) privilege does not extend to the "public display" of Greenberg's photographs, a copyright owner's exclusive right under § 106(5). While neither of these arguments has merit, it is inappropriate to consider these issues for the first time en banc. The parties have been briefing this case for over a decade now and not once has either party argued that either of these issues is dispositive in deciding whether National Geographic is entitled to the § 201(c) privilege. Furthermore, the district court never ruled on these issues and we did not ask the parties to brief these issues. Finally, in Parts B and C of his dissent, Judge Birch relies on *Tasini* in finding that the § 201(c) privilege is nontransferable and "public display" is not covered under § 201(c), even though the Supreme Court explicitly stated that it "neither decide[d] nor express[ed] any view" on either issue, one of which was only raised by an amicus. 533 U.S. at 496 n.5, 498 n.8.

author, as opposed to preexisting materials. *Id.* § 103(b). A copyright in a "collective work" does not imply an exclusive right in the preexisting material. *Id.* Here, each individual National Geographic Magazine issue—including the January 1962, February 1968, May 1971, and July 1990 print issues in which Greenberg's photographs first appeared—is a "particular collective work," and each of Greenberg's photographs is "part of" one of those collective works. National Geographic has the privilege of reproducing these individual magazine issues in print as often as it wishes, and Greenberg retains his copyrights in his individual photographs. At the same time, National Geographic has a copyright in the collective work as a whole—to wit, the individual magazine issues.

The Copyright Act does not define "revision," but *Tasini* does. *Tasini* defines "revision" as a "*new* 'version,' and a version is, in [the § 201(c)] setting, a *'distinct form* of something regarded by its creators or others as one work.'" 533 U.S. at 500 (emphases added) (quoting Webster's Third New International Dictionary 1944, 2545 (1976)).

In *Tasini*, the articles at issue—written by freelance authors—originally appeared in the New York Times, Newsday, and Sports Illustrated. Pursuant to licensing agreements with two computer database companies, the publishers of the three periodicals provided to the database companies all the separate articles from each periodical which were then placed in electronic databases, isolated from the context of the original print publications in which they first appeared. *Id.* at 487–89.[8] The reproduction of all articles

[8] The New York Times provided its articles to both computer database companies—LEXIS/NEXIS and University Microfilms

took place without any of the freelance authors' consent. *Id.* at 489.

To resolve the case, the Court focused on whether the articles were removed from their original context and now isolated in an entirely different context. *Id.* at 503. It noted that the three databases in question—NEXIS, the NYTO, and the GPO—have certain differences but are all similar in that a user of any of the three databases can only view articles in isolation of the context of their original print publications. For example, in NEXIS, each article appears as a "separate, isolated 'story'—without any visible link to the other stories originally published in the same newspaper or magazine edition. NEXIS does not contain pictures or advertisements, and it does not reproduce the original print publication's formatting features such as headline size . . . ." *Id.* at 490. Like NEXIS, the NYTO shows articles with "identifying information (author, title, etc.), but without original formatting or accompanying images." *Id.*[9] Finally, the GPO

International (UMI). Newsday and Time, Inc.—the publisher of Sports Illustrated—only provided their articles to LEXIS/NEXIS. *See Tasini,* 533 U.S. at 488–90. LEXIS/NEXIS reproduced the articles in its NEXIS electronic database and UMI reproduced the articles on two CD-ROM products—the New York Times OnDisc (NYTO) and General Periodicals OnDisc (GPO). *Id.* at 489–90.

[9] In his dissent, Judge Anderson points to the Supreme Court's discussion in *Tasini* regarding the databases (specifically, the NYTO) to find that the CNG is not a "revision" under § 201(c). Judge Anderson notes that, similar to the CNG, the NYTO contains all the articles from one edition of the New York Times along with all the articles from other editions of that periodical on CD-ROM. However, Judge Anderson fails to take into account the main problem with the NYTO in making his analogy—that is, like the CNG, the NYTO may have placed all the articles from one edition of the New York Times together on CD-ROM

did show each article exactly as it appeared in print, with photographs and advertisements, "but without any material published on other pages of the original periodical." *Id.* at 500.

After finding that the individual articles were presented "clear of the context provided either by the original periodical editions or by any revision of those editions," the Supreme Court concluded that the three electronic databases did not reproduce or distribute the freelance authors' works "as part of" either the original editions or as a "revision" of those editions. *Id.* at 499–500. Because the freelance authors' articles were "presented to, and retrievable by, the user in *isolation*, clear of the *context* of the original print publication," *id.* at 487 (emphases added), the publishers could not claim a privilege under § 201(c). Thus, the "crucial fact" for the Supreme Court was the databases' ability to "store and retrieve articles *separately* within a vast domain of diverse texts." *Id.* at 503 (emphasis added). The articles were presented to the user "standing alone and not in context." *Id.* at 488.

The Supreme Court found that by presenting the articles outside of their original context, the databases were not mere revisions of the original collective works because the publishers had done more than create a "distinct form of something regarded by its creators or others as one work." *Id.* at 500. "Under § 201(c), the question is not whether a user can generate a revision of a collective work from a database, but whether the database itself perceptibly presents

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along with all the articles from other editions of the New York Times, but unlike the CNG, the individual articles were never preserved in their original context. Thus, the analogy is wanting.

the author's contribution as part of a revision of that collective work." *Id.* at 504.[10] Therefore, "[i]n determining whether the [a]rticles have been reproduced and distributed 'as part of' a 'revision' of the collective works in issue, we focus on the [a]rticles as presented to, and *perceptible by, the user* of the [d]atabases." *Id.* at 499 (emphasis added); *see also Faulkner,* 409 F.3d at 38.

In sum, the teachings of *Tasini* are twofold. First, the concept of "revision" necessarily includes some element of novelty or "newness" as defined by the Court, and second, consideration of the context in which the contributions are presented is critical in determining whether that novelty is sufficient to defeat the publisher's § 201(c) privilege.[11]

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[10] Judge Birch explains in his dissent how a user of the CNG could extract a photograph from a scanned page of an issue of the Magazine, thereby removing it from its original context. However, this is no different from material in microform where a user can print only a portion of what is contained on a microform roll or a microfiche sheet. More importantly, this is not the proper inquiry under *Tasini*. The question is whether the reproduction of a collective work "perceptibly presents" a freelancer's contribution as part of a revision of that collective work. If the user's manipulation of a collective work, after it has been initially presented to the user, were the deciding factor in a contextual inquiry under § 201(c), then National Geographic—or any other publisher—would never be able to revise an edition of its Magazine and reproduce and/or distribute it, even in print, because a user could easily cut and isolate a photograph out of the Magazine issue. He or she could then copy and scan the photograph and transmit it free of its original context. Moreover, with existing technology, there is nothing to prevent an individual from scanning an existing document and isolating a portion of that document.

[11] *Tasini* does not decide, nor need we, at what point elements of novelty or "newness" make a republished collective work more

Through its discussion of microform reproductions, the Supreme Court elaborated on the difference between revisions of collective works and collective works where the individual contributions have been taken out of context. *See Tasini*, 533 U.S. at 501. It explained that "[m]icroforms typically contain continuous photographic reproductions of a periodical in the medium of miniaturized film. Accordingly, articles appear on the microforms, writ very small, in precisely the position in which the articles appeared in the newspaper." *Id.* And 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 user first encounters [the articles] in context." *Id.* Based on this fidelity to context, the Supreme Court reasoned that the reproduction of print publications in microform would be privileged under § 201(c). *Id.* at 501–02. Unlike the "conversion of newsprint to microfilm, the transfer of articles to the [d]atabases [in *Tasini* did] not represent a mere conversion of intact periodicals (or revisions of periodicals) from one medium to another." *Id.* at 502.

Applying *Tasini* to the facts before us, we find that the CNG is analogous to the microforms discussed therein. Similar to microfilm or microfiche, the CNG uses the identical selection, coordination, and arrangement of the underlying individual contributions as used in the original collective works. 17 U.S.C. § 101; *Greenberg I*, 244 F.3d at 1269; *Greenberg II*, 488 F.3d at 1335; *Faulkner*, 409 F.3d at 38. The CNG's image-based reproduction of the Magazine is like microform. The CNG presents two pages of an

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than a "revision." In this case, we simply find that the degree of novelty here does not reach that level.

issue at a time, with the Magazine fold in the middle, and with the page numbers in the lower outside corners, exactly as they are presented in the print version. *See Faulkner*, 409 F.3d at 38. In addition to the layout of the Magazine issues, the content of the CNG is also in the same position as in the print versions of the Magazine. As we noted in *Greenberg I,* "[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[,] [with] [e]very cover, article, advertisement, and photograph appear[ing] as it did in the original paper copy of the Magazine." 244 F.3d at 1269; *see also Greenberg II*, 488 F.3d at 1335.[12] That is, an author's contribution is viewed within its *original context*, with each page containing the articles, photographs, and/or advertisements as they originally appeared in the Magazine's print versions. No alteration in positioning has been made in the CNG. A user of the CNG can focus on a particular page or parts of a page, but this is similar to microform, where the user "can adjust the machine lens to focus only on the [a]rticle, to the exclusion of surrounding material." *Tasini*, 533 U.S. at 501. Thus, Greenberg's photographs do not appear disconnected from their

[12] *See Faulkner*, 409 F.3d at 30–31 ("[T]here are no changes in the content, format, or appearance of the issues of the magazine. The pages appear as they do in the print version, including all text, photographs, graphics, advertising, credits and attributions. Issues of the Magazine appear chronologically with the first issue published appearing at the beginning of the first disk and the last appearing at the end of the last disk. The individual images and texts are therefore viewed in a context almost identical—but for the use of a computer screen and the power to move from one issue to another and find various items quickly—to that in which they were originally published.").

original context. Rather, they are firmly positioned within their original context, and a user of the CNG cannot move or alter the photographs.

The CNG is also distinct from the GPO CD-ROM of *Tasini*. The GPO is an image-based system which shows "each article exactly as it appeared on printed pages, complete with photographs, captions, advertisements, and other surrounding materials," *id.* at 491, making it the most similar of the three databases in *Tasini* to the CNG. When a user conducts a search using the GPO, a computer program will search available indexes and abstracts, and a user may view each article within the search result. However, "[t]he display of each article provides no links to articles appearing on other pages of the original print publications" and a user cannot simply "flip" to another article. *Id.* at 491 & n.2. In the GPO, the original context of the print publication is not perceptible to the user. This is in direct contrast to the CNG where the user is free to flip through the pages or issues of the Magazine after conducting a search, thereby preserving the original and complete context of the print issues. [13]

Moreover, the aggregation of multiple issues of the Magazine in the CNG is no different from the aggregation of multiple editions or issues in microform.

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[13] Judge Anderson's dissent finds little difference between the CNG and GPO. While the "flip" function of the GPO may not make a large difference from a marketing standpoint, it does from a legal perspective. The GPO isolates an article clear of the context of its original print publication whereas the CNG presents an article within the Magazine's larger context as a user of the CNG can easily scroll through an entire issue of the Magazine without having to conduct an indefinite number of searches trying to retrieve each individual article from an issue, each of which is only viewable to the user standing alone.

Aggregation is permissible if the original context of the individual contribution is preserved. The Supreme Court in *Tasini* recognized that although "the microfilm roll contains multiple editions" of a publication, the relevant consideration was that "the user first encounters [the articles] in context." *Id.* at 501. The Court focused on the ability of a user to isolate an individual copyrightable article from its original collective work. *Id.* at 503–04. In the CNG, a user cannot "isolate" an article from its original context. Thus, that concern does not apply here. Aggregating editions or issues of one magazine into a larger collective work of that same magazine is permissible under § 201(c) insofar as the individual contributions are presented and perceivable to viewers in their original context. [14]

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[14] We find unavailing Greenberg's attempt to distinguish this case from *Tasini* by arguing that *Tasini* was a disassembly case (i.e., removing individual contributions from collective works in which they originally appeared) whereas this case is an assembly case (i.e., taking collective works with their individual contributions intact within those collective works and putting the collective works into a larger collective work). Greenberg argues that *Tasini* involved completely unrelated facts from this case, and that *Tasini's* contextual inquiry is simply a threshold question in any § 201(c) analysis. *Tasini,* however, never placed a caveat on the contextual inquiry by describing it as a "starting point" in a § 201(c) analysis. The Court clearly stated, without qualification, that "[u]nder § 201(c), the question is . . . whether the database itself perceptibly presents the author's contribution as part of a revision of the collective work." 533 U.S. at 504. Thus, the contextual inquiry laid out in *Tasini* does not turn on this assembly-disassembly dichotomy such that it need not be addressed for an assembly case. Nor is it somehow simply a threshold inquiry for any § 201(c) analysis. It is the contextual inquiry that is of fundamental import in any § 201(c) analysis.

The legislative history supports this conclusion because it reveals that Congress intended the § 201(c) privilege to allow publishers to make revisions to collective works, but not to the individual contributions themselves. As part of the Roundtable Discussions in 1964 regarding § 201(c), a prominent author captured this sentiment:

> I have but one question with reference to the wording, and that is with respect to the wording at the end of subsection (c): " . . . and any revisions of it." If that means "any revisions of the collective work" in terms of changing the contributions, or their order, or including different contributions, obviously the magazine writers and photographers would not object. But there is an implication, or at least an ambiguity, that somehow the owner of the collective work has a right to make revisions in the contributions to the collective work. This is not and should not be the law, and consequently I suggest that the wording at the end of subsection (c) be changed or eliminated to make that absolutely clear.

S. 3008, H.R. 11947, H.R. 12354, 89th Cong. § 14(c) (1965), *reprinted in* Copyright Law Revision pt. 5, 1964 Revision Bill with Discussions and Comments 152 (Comm. Print 1965), *quoted in Tasini v. N.Y. Times Co.*, 972 F. Supp. 804, 819 (S.D.N.Y. 1997). Congress responded by changing § 201(c) from privileging "any revisions of it" to "any revision of that collective work." *Compare* Copyright Law Revision pt. 5, at 152, *with* 17 U.S.C. § 201(c). And the House and Senate Reports indicate that Congress intended that language to prevent publishers from "revis[ing] the contribution itself or includ[ing] it in a new anthology or an *entirely different* magazine or other collective

work." H.R. Rep. No. 94-1476, at 122 (emphasis added).[15]

Moreover, the legislative history exposes the flaw in Greenberg's claim that the CNG is a "new collective work," and therefore unprivileged. Even assuming that the CNG is a "new collective work," Congress intended for publishers to retain their § 201(c) privilege unless the republication constituted an "entirely different" collective work. *Id.*[16] Nowhere does the leg-

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[15] *See also* H.R. Rep. No. 89-2237, at 117 (1966); S. Rep. No. 94-473, at 106 (1975), *reprinted in* 8 Melville B. Nimmer & David Nimmer, *Nimmer on Copyright* app. 4A-171 (2007). Similarly, the Register of Copyrights, which drafted § 201(c) at Congress's request, noted that "the [§ 201(c)] privileges . . . are not intended to permit revisions in the contribution itself or to allow inclusion of the contribution in anthologies or other *entirely different* collective works." Staff of H. Comm. on the Judiciary, 89th Cong., Copyright Law Revision pt. 6, Supplementary Report of the Register of Copyrights on the General Revision of the U.S. Copyright Law: 1965 Revision Bill 69 (Comm. Print 1965) (emphasis added), *reprinted in* 9 *Nimmer on Copyright* app. 15-97.

[16] In addition to not appearing at all in the legislative history, the phrase "new collective works" appears only once in the *Tasini* opinion. The Supreme Court stated that "[i]t would scarcely 'preserve the author's copyright in a contribution' as contemplated by Congress, H.R. Rep. 122, 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." *Tasini*, 533 U.S. at 497. This is the only time the Court uses the phrase "new collective works." Taken within the context of the passage in which it appears, the Supreme Court surely did not mean that the addition of any new element to a collective work or the placement of a "revised" collective work within a larger collective work by the same publisher deprives that publisher of its § 201(c) privilege. Within the very same sentence in which "new collective works" appears, the Court cites to the same House Report which states that a publisher cannot include the author's contribution in a "new anthology or

islative history suggest that publishers lose their § 201(c) privilege on account of some novelty or "newness" in the republication of a collective work. Any "revision" of a collective work is, strictly speaking, a "new" collective work. *Tasini*, 533 U.S. at 500 (defining "revision" as a "new" version). Although Greenberg's photographs can be reproduced as part of the original Magazines in which they appeared, they cannot be removed from their original context and printed in an entirely different magazine or database.

Greenberg misses the mark when he argues that the CNG is not privileged because new elements have been added to the original print publications of the Magazine. If simply adding a new element to a collective work, such as an index, table of contents or a new foreword, creates a "new collective work" outside the purview of § 201(c), then the "revision" prong is effectively nullified.[17] The addition of new material to

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an *entirely different magazine or other collective work*." H.R. Rep. No. 122-23 (emphasis added). Furthermore, in support of the *Tasini* sentence in question, the Supreme Court cites to a law review article. However, the page cited to by the Supreme Court does not use the phrase "new collective work" and deals solely with the danger of interpreting "revision" such that it swallows the third prong of § 201(c)—i.e., "a later collective work in the same series." *See* Wendy J. Gordon, *Fine-Tuning Tasini: Privileges of Electronic Distribution and Reproduction*, 66 Brook. L. Rev. 473, 484 (2000). The phrase "new collective work" is only used once in the law review article as well, in a sentence regarding the "distribution" of collective works which reads: "Even if a privilege were available to allow a new collective work to be made, § 201 would not cover distribution of the individually-owned articles, except in connection with the whole collective work." *Id.* at 499.

[17] We are not persuaded by Greenberg's extension of this argument that the addition of any independently copyrightable element to a collective work renders it unprivileged. Merely

a collective work will not, by itself, take the revised collective work outside the privilege, and the pertinent question for a court is whether the new material so alters the collective work as to destroy its original context. [18]

Looking at the new elements of the CNG, we find that they do not bring the CNG outside the scope of the § 201(c) privilege. First, the brief twenty-five second montage of the introductory sequence, which serves as nothing more than a "brief visual introduction" to the image-based collection of the Magazine,

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adding an independently copyrightable foreword to a collective work would not necessarily forfeit the publisher's privilege in the work. *See* 2 William F. Patry, *Patry on Copyright* § 5:139 (2007) ("[A] revision may still include new elements such as an index, as well as some new material." (footnote omitted)). Contrary to Judge Birch's contention in his dissent, the addition of two independently copyrightable computer programs does not divest National Geographic of its § 201(c) privilege. Even when the degree of novelty of such an addition is sufficient to forfeit the privilege, that determination would not turn simply on the independent copyrightability of the additional element.

[18] In Judge Anderson's dissent, he gives the example of placing the March 2000 monthly edition of National Geographic devoted entirely to the geography and natural beauty of Africa into a larger book entitled "The Complete Intellectual History of Africa from 1900 to 2008" as an impermissible reproduction. Under this opinion's reasoning, that reproduction and/or distribution would not survive the contextual analysis either and I would reach the same result. As noted earlier, a revision includes something "new" and the amount of "newness" will certainly impact the contextual inquiry. While the context of the individual contribution within its original collective work may have been preserved in the above example, that context is infected to the extent that a "user" of the larger collective work will not readily perceive the individual contribution within its original context. Thus, *Tasini's* contextual analysis is also dispositive in the above example and not simply a threshold inquiry

does not infect the CNG such that it destroys the original context of the more than 1200 digitally reproduced issues of the Magazine. As a "virtual cover" for the Magazines, the introductory sequence in no way alters the context in which the original photographs were presented, just as a new cover on an encyclopedia set would not change the context of the entries in the encyclopedia. *See Faulkner*, 409 F.3d at 38 (noting that the "additional elements [of the CNG], such as, among other things, the Moving Cover Sequence . . . do not substantially alter the original context which, unlike that of the works at issue in *Tasini*, is immediately recognizable"). The use of Greenberg's January 1962 cover photograph in the introductory sequence, which is not just Greenberg's photograph taken apart from its original context but rather the entire original cover, does not nullify National Geographic's privilege under § 201(c).[19]

In addition to the introductory sequence, the computer program's elements, such as the search function or zoom capacity, do not take the CNG outside the § 201(c) privilege. The CNG is no different than other CD-ROM products, in that all CD-ROMs contain an operating computer program that directs their functionality. The CNG's computer program simply compresses and decompresses the digital images of the Magazine issues while allowing a CNG user to search an electronic index of the Magazines. The search function of the computer program is akin to a traditional index, except that it is a by-product of the medium in which it finds its functionality. Just as

[19] Even though the introductory sequence does not deprive National Geographic of its § 201(c) privilege, we are only deciding that the CNG as a whole is privileged.

a reader of a bound-volume of previous issues of National Geographic might look to an index to find all the pages in which the phrase "global warming" appears, a user of the CNG's search function can enter the phrase "global warming" and the program will retrieve for the user all those same pages. The CNG user is then free to flip through other pages of the issues without having to conduct a new search. Similarly, the zoom function, while allowing a CNG user to focus on a specific part of a page, does not deprive National Geographic of its privilege because, just like adjusting a lens to look at a specific part of a page of a publication reproduced on microform, the page in question first appears to the reader in context. *See Tasini*, 533 U.S. at 501. These added features only serve to provide functionality to "the CNG's *raison d'être*"—i.e., the intact collected issues of the Magazine. *See Greenberg I*, 244 F.3d at 1269. The CNG's new elements are no different than microform's "new" elements, such as a zoom lens or the ability to print only a portion of a document. These additional features do not destroy the original context of the collective works.

We see no material distinction between the CD-ROMs at issue here and the permissible "revision" of a collective work into microform as discussed in *Tasini*. The fact that the CNG is on CD-ROMs in digital form does not make the microform analogy any less relevant.[20] The conversion of magazine issues from

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[20] Greenberg seeks to distinguish microform from the CNG based primarily on an economically-driven argument—he argues that microform has no commercial value. However, there is nothing in the record to suggest that microform has no commercial value. The question of whether the reproduction of a collective work creates a "new market" is legally irrelevant to a § 201(c) privilege analysis. The protection afforded an author's

print to digital form—as opposed to their conversion from print to print, or print to microform—does not create a different balance of copyright protection under § 201(c) between individual authors and publishers because copyright protection is media neutral. *See* 17 U.S.C. § 102(a) (noting that "[c]opyright protection subsists . . . in original works of authorship fixed in any tangible medium of expression, *now known or later developed*, from which they can be perceived, reproduced, or otherwise communicated . . ." (emphasis added)). *Tasini* explained that the long-embraced doctrine of media neutrality mandates that the "transfer of a work between media does not alter the character of that work for copyright purposes." 533 U.S. at 502 (internal quotations 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.").

To this end, Congress adopted broad statutory language including within copyright's ambit all existing and later developed media through which works could be communicated either directly or with the aid of a device. *See* 17 U.S.C. §§ 101, 102(a). The legisla-

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individual contribution does not vary with the market value of the collective work or a revision of the collective work in which it appears. Contrary to Judge Birch's view, this case is not simply "about who gets the money." The fact that a publisher can resell a collective work for a profit with a freelancer's individual contribution in it is not determinative of whether that reproduction and/or distribution of the collective work is privileged as a "revision" under § 201(c). Under an extension of Judge Birch's view, republishing an old magazine issue in its original format to a younger, new market would not be permissible. The economic inquiry is clearly not the question. Rather, it is a question of whether the publisher has a privilege to reproduce and/or distribute "that particular work," not whether that reproduction and/or distribution is targeted at a new market.

tive history underscoring the adoption of this doctrine explains:

> This broad language is intended to avoid the artificial and largely unjustifiable distinctions . . . under which statutory copyrightability in certain cases has been made to depend upon the form or medium in which the work is fixed. Under the bill it makes no difference what the form, manner, or medium of fixation may be—whether it is in words, numbers, notes, sounds, pictures, or any other graphic or symbolic indicia, whether embodied in a physical object in written, printed, photographic, sculptural, punched, magnetic, or any other stable form, and whether it is capable of perception directly or by means of any machine or device "now known or later developed."

H.R. Rep. No. 94-1476, at 5665. Because the principle of media neutrality is a staple of the Copyright Act, 17 U.S.C. § 102(a), *Tasini*, 533 U.S. at 502, it is incorrect to say that an exact digital replica of a print magazine is somehow a "new collective work."

Furthermore, the fact that a computer program allows CNG users to search and access—without altering—the collective works in their exact original form and context does not change our § 201(c) analysis. As technology progresses and different mediums are created through which copyrightable works are introduced to the public, copyright law must remain grounded in the premise that a difference in form is not the same as a difference in substance. "No one doubts that [a publisher] has the right to reprint its issues in Braille, in a foreign language, or in microform, even though such revisions might look and feel quite different from the original. Such differences,

however, would largely result from the different medium being employed." *Tasini*, 533 U.S. at 512–13 (Stevens, J., dissenting). Thus, the revision of a magazine by reproducing it in its original context in a new "distinct form"—i.e., a digital version—is not a difference that would undo a publisher's privilege under § 201(c). *See id.* at 500.

With publications continuously being reproduced in new mediums, courts should not disapprove of the reproduction or distribution of collective works in those mediums without evaluating whether the publisher has violated the contextual fidelity of the original collective work or revised the individual contribution itself. Courts must determine whether the addition of new materials to the reproduction creates an "entirely different" collective work which falls outside § 201(c)'s privilege, not whether the medium itself presumptively creates a "new collective work." Greenberg's copyrights in his individual contributions to the National Geographic Magazine issues and National Geographic's copyrights in the collective works—and National Geographic's privilege of reproducing and distributing the collective works—were not determined thirty years ago based on the medium in which they were produced, and they should not be determined on that basis today.

II. CONCLUSION

In the light of the Supreme Court's holding in *Tasini* that the bedrock of any § 201(c) analysis is contextual fidelity to the original print publication as presented to, and perceivable by, the users of the revised version of the original publication, we agree with the Second Circuit in *Faulkner* and find that National Geographic is privileged to reproduce and

distribute the CNG under the "revision" prong of § 201(c).

The CNG—albeit in a different medium than print or microform—is a permissible reproduction of the National Geographic Magazine. Greenberg's photographs are preserved intact in the CNG and can only be viewed as part of the original collective works in which they appeared. Similar to the microforms of *Tasini*, which preserve the context of multiple issues of magazines, the CNG's digital CD-ROMs faithfully preserve the original context of National Geographic's print issues. The CNG's additional elements—such as its search function, its indexes, its zoom function, and the introductory sequence—do not deprive National Geographic of its § 201(c) privilege in that they do not destroy the original context of the collective work in which Greenberg's photographs appear.[21]

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[21] The only issue addressed en banc is whether the CNG itself is privileged under § 201(c). We adopt and reiterate the holding of the panel in *Greenberg II* that the introductory sequence itself is not privileged under § 201(c). 488 F.3d at 1339. On remand, the district court must consider National Geographic's other defenses not yet adjudicated with respect to its liability for the use of the 1962 cover photograph in the introductory sequence. Likewise, because the CNG is privileged and other defenses relating to the introductory sequence have not been adjudicated, we also adopt the *Greenberg II* panel's holding that the district court erroneously permitted the jury to find that National Geographic willfully violated § 201(c). *Id.* at 1341.

We REVERSE and REMAND to the district court for proceedings consistent with this opinion. BIRCH, *Circuit Judge*, dissenting, in which WILSON, *Circuit Judge*, joins, and in which EDMONDSON, *Chief Judge*, and ANDERSON, *Circuit Judge*, join in Part A only:

I respectfully dissent. I also concur in Judge Anderson's dissent.

The controlling issues and facts in this case have not been fully identified by the majority — hence, it is not surprising that it reaches the wrong conclusions.

Putting aside the legal analysis or rationales in play in this case, the reader should understand the pecuniary or commercial positions of the parties and their constituencies in this dispute. On one side there are the artists, authors, and other creators of copyrightable works who argue that their creative contributions to collective works already exploited by publishers should not be further exploited by those publishers without sharing the profits realized by that further commercial exploitation. These authors, artists, and other creators contend that the publishers now want to ignore the economic compromise — the balancing of equities — that is reflected in 17 U.S.C. § 201(c) of the 1976 Copyright Act.[1] Hereinafter, all

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[1] The 1976 Copyright Act was supposed to reverse two hundred years of publishers' exploitation of authors under the 1909 Copyright Act. *See* Barbara Ringer, *First Thoughts on Copyright Act of 1976*, 22 N.Y.U. Sch. L. Rev. 477, 490 (1977) ("Barbara Ringer, the Register of Copyrights, more than any other single person, is responsible for the content of the new law . . ." Melville Nimmer, Preface to the 1978 Comprehensive Treatise Revision of 1 Melville Nimmer, *The Law of Copyright*, at vi (1983)). Marybeth Peters, a later Register of Copyrights, echoed

statutory citations are to Title 17 of the U.S. Code, unless otherwise indicated.

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this in her 2001 letter to Congress regarding *New York Times Co. v. Tasini*, 533 U.S. 483, 121 S. Ct. 2381 (2001):

> Section 201(c) was intended to limit a publisher's exploitation of freelance authors' works to ensure that authors retained control over subsequent commercial exploitation of their works.
>
> In fact, at the time § 201 came into effect, a respected attorney for a major publisher observed that with the passage of § 201(c), authors "are much more able to control publishers' use of their work" and that the publishers' rights under § 201(c) are "very limited." Indeed, he concluded that "the right to include the contribution in any revision would appear to be of little value to the publisher." Kurt Steele, "Special Report, Ownership of Contributions to Collective Works under the New Copyright Law." Legal Briefs for Editors, Publishers, and Writers (McGraw-Hill, July 1978).
>
> In contrast, the interpretation of § 201(c) advanced by publishers in *Tasini* would give them the right to exploit an article on a global scale immediately following its initial publication, and to continue to exploit it indefinitely. Such a result is beyond the scope of the statutory language and was never intended because, in a digital networked environment, it interferes with authors' ability to exploit secondary markets. Acceptance of this interpretation would lead to a significant risk that authors will not be fairly compensated as envisioned by the compromises reached in the 1976 Act. The result would be an unintended windfall for publishers of collective works.

147 Cong. Rec. E182-02 (2001) (Letter from Marybeth Peters, The Register of Copyrights of the United States of America, to Representative James P. McGovern, United States House of Representatives (Feb. 14, 2001)). *See* Jessica D. Littman, *Copyright Compromise, And Legislative History*, 72 Cornell L. Rev. 857, 893-96 (Interpreting Bargains) (1987).

On the opposite side, the publishers are seeking to generate new revenues by repackaging an old product — the "old wine in new bottles" paradigm; updated in this instance with an easier access twist-off metal cap rather than a cork. Here the new packaging of the old content, *replicated but unrevised,* in electronic medium is both cost-efficient, profitable, and attractive to a new, computer-savvy generation of consumers. Moreover, the profits are enhanced exponentially when the publisher can exclude the contributing artists, authors, and creators of the content from sharing in those profits. At the end of the day this case is not about education, access by the masses, or efficient storage and preservation — it is about who gets the money. The legal arguments and non-legal arguments on both sides, not surprisingly in a free enterprise society, reduced to these essentials are all about who is paid for their contributions and efforts. Accordingly, it is probative and pertinent to examine the Congressional motivation for passage of the statutory section — § 201(c) — central to the present dispute. If the motivating idea and intent of Congress was to require the publishers to share profits from a new or different product (in copyright terms — a "work") placed on the market, then the authors, artists, and creators win. If the intent of Congress was to allow an up-to-date, modern, handy, and desirable incarnation of the previously exploited work, then the publishers win. I will endeavor to demonstrate that the authors, artists, and creators should share in the publisher's profits and that the arguments, both legal and policy, by the publishers are bereft of logic, legal merit, and are totally disingenuous.[2]

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[2] It should be emphasized that the proper copyright analysis examining this commercial product, the "The Complete National

There are at least three distinct legal rationales that support affirmance of the judgment of the district court which followed our court's directions in *Greenberg v. Nat'l Geographic Soc'y*, 244 F.3d 1267 (11th Cir. 2001) ("*Greenberg I*"). Each of these legal rationales are based upon core copyright law principles applied to the facts existing in this record. Application of each such rationale demonstrates the erroneous conclusions and logic of the majority. The three rationales, succinctly stated, are as follows:

(A) the CNG is a "new," "entirely different" collective work to which the putative § 201(c) privilege does not attach and does not reproduce and distribute articles as "part of that collective work" or "any revision" thereof;

(B) the National Geographic Society ("the Society") cannot transfer its privilege to third parties to exercise; and,

(C) the Society and its co-infringers have undertaken to *display* Greenberg's protected works *publicly* by means of projection on a computer screen, a non-privileged exercise by a § 201(c) grantee.

In the corresponding sections of my dissent, I shall demonstrate that the Society and its co-defendants have infringed the registered copyrights of plaintiff Greenberg. I shall endeavor to demonstrate the CNG is a non-qualifying (per § 201(c)) "new collective work," not due to its "revision" or "non-revision" status, but because it is a rote copy of the magazines

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Geographic" ("CNG"), should be no different than if the collection were of Playboy or Hustler magazines. Just as the medium is "neutral" so is the content for copyright purposes.

scanned onto CD-ROMs (an analogous replica to a microform replica) which has been combined with at least two copyrightable computer programs, each a free-standing and *sui generis* copyrightable work.

Necessary to my discussion that follows are some material record facts which have been omitted by the majority. In September 1996, National Geographic Interactive[3] ("NGI") entered into a Distribution Agreement with Mindscape, Inc., a Delaware corporation. "Mindscape is a computer software publisher and distributor which collaborates with the Society in its efforts to bring its products to the public in the digital environment." R 1-19 at 2. Pursuant to the Distribution Agreement, the Society and Mindscape developed the product marketed as the CNG. The CNG is a thirty CD-ROM compendium that collects an edition of *each issue* of The National Geographic Magazine ("the Magazine") ("that particular collective work") from 1888 to 1996. Under the "Distribution Agreement," NGI would receive royalties on sales of the CNG by Mindscape.[4] R5-284, Joint Trial Exh. 323 at 13-15.

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[3] National Geographic Interactive is a division of National Geographic Enterprises, Inc. National Geographic Enterprises, Inc. was a wholly-owned for-profit subsidiary of National Geographic Ventures, Inc., which was a wholly-owned for-profit subsidiary of the Society. National Geographic Ventures, Inc. has since been dissolved. *Faulkner v. Nat'l Geographic Enter.*, 409 F.3d 26, 31 (2d Cir. 2005). National Geographic Interactive and National Geographic Enterprises, Inc., along with National Geographic Holdings, Inc., are now incorporated as NGHT, Inc., a wholly-owned, for-profit subsidiary of the Society. *Id.* at n.4.

[4] The parties stipulated that the Society would "receive royalties on all sales [of the CNG] by Mindscape." RAcc#2-230 at 10. However, upon a reading of the Distribution Agreement, it appears that NGI, not the Society, received such royalties. R5-284,

In December 1996, the Society entered into a "Trademark and Copyright License Agreement" ("License Agreement") with National Geographic Ventures, Inc. ("NGV"), a for-profit subsidiary of the Society. The License Agreement was premised upon the Society's decision to "to establish its electronic publishing and cartographic operations as units of a separate but wholly owned taxable subsidiary." R5-284, Joint Trial Exh. 323 at 1. Under the License Agreement, the Society granted NGV a "royalty bearing license for certain . . . copyrighted materials of [the Society]," including "[t]he Archive of National Geographic Magazine *for reproduction in archival form only, without manipulation or alteration." Id.* at 1, Att. B (emphasis mine).

To create the CNG, the Society entered into an agreement with Dataware Technologies, Inc. ("Dataware"), dated 15 August 1996, to digitally scan the pages of the Magazine.[5] The agreement authorized Dataware to "develop a custom CD-ROM template, including integration of a custom set of interfaces to display magazine pages and . . . JPEG images of the scanned pages." R4-203 at 8. "Each issue [of the Magazine] was [] scanned, page by page, into a computer system. The scanning process created an

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Joint Trial Exh. 323 at 13- 15. This appears to be consistent with the apparent rationale for the Society in creating for-profit subsidiaries in order to avoid direct receipt of disqualifying income by a non-profit corporation.

[5] A copyright notice appearing on the packaging of the CNG states that the Society holds the copyright in the CNG, and that the CNG "was produced from an archive of magazines collected in a central repository and is not representative of any single regional edition of NATIONAL GEOGRAPHIC magazine." R1-20, Exh. A.

exact image of each page as it appeared in the Magazine. R1-23 at 2 (emphasis mine).

Mindscape developed a computer program (the "Program"), which is contained on each CD-ROM of the CNG, to allow the user of the CNG to select, view, and navigate through the images of the Magazine replica (the "pages" of the magazines) on the CD-ROM. *Greenberg I*, 244 F.3d at 1269.[6] Without the Program, the pages could be stored on a CD-ROM, but they would not be *efficiently* accessible to the user. *Id.* at 1270. In creating the Program, Mindscape incorporated two separate, copyrighted computer programs: the "CD Author Development System," which is a search engine created by Dataware, and the "PicTools Development Kit," which is a storage

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[6] It is not disputed that a computer program is a form of literary work, and thus is copyrightable. *See* Melville B. Nimmer & David Nimmer, 2 *Nimmer on Copyright* § 2.04[C] (2008). The 1980 amendments to the Copyright Act brought computer programs within the scope of copyright by adding them to the list of defined works and providing for limitations on the reproduction and adaptation rights in favor of owners of copies of programs. *See* §§ 101, 117. These amendments were recommended by the Commission on New Technological Uses of Copyrighted Works which concluded that computer programs were the proper subject matter of copyright. *See* Nat'l Comm. on New Technological Uses of Copyrighted Works, Final Report 1 (1978). Moreover, courts have recognized the audiovisual displays produced by a computer programs as a *separate* copyrightable work. *See Stern Elecs. Inc. v. Kaufman*, 669 F.2d 852 (2d Cir. 1982). Electronic media inherently pose problems in delineating the by-products of original works, such as derivative works, collective works, and revisions. Bits of computer code may represent content (text, graphic images, and the like) or encode functional, stand-alone computer programs – thereby intertwining content and method of delivery. *See Micro Star v. Formgen, Inc.*, 154 F.3d 1107 (9th Cir. 1998).

mechanism created by Pegasus Imaging Corp. for compressing and decompressing the images scanned onto each disc. *Id.* at 1269-70. Mindscape has not registered a copyright in the Program, *id.* at 1270 n.3, but the claims of copyright for both the CD Author Development System and the PicTools Development Kit, respectively, have been registered with the Copyright Office. *Id.* at 1269-70.

Part of the Program consists of "a search engine based on the National Geographic Society proprietary indexing scheme."[7] R1-20 at Ex. B, p. 2. The search engine "contains the same information as the print indices published by the Society," RAcc#2-230 at 10, and it allows the user of the CNG to access articles "by topic, title, key word, or contributor." *Greenberg I*, Appellants' Br. at 7. The Program also contains "a feature for saving search results," R4-203 at 10, which would allow a user to repeatedly access the results of a former search, but "[t]here is no text-based search capability." *Greenberg I*, Appellees' Br. at 25.

Using any CD-ROM of the CNG, a user therefore can locate, isolate, copy, and print or transmit any

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[7] In 1988, National Geographic published a "100-year index." That index is a separately bound volume consisting of an index to the first 100 years of National Geographic Magazine. R1 1 at 183-84 [Idaz Greenberg - Jury Trial Cross Examination]. There are "[v]ery little similarities" between the CD-ROM index and the print index. "When you have the paper index, the year's index, you can find anything in the world that you want to find there, but you're not going to be able to print it out and you're not going to have access to it, and it's not going to be right there at our fingertip. Whereas, when you have the product, the CD-ROM [CNG], whatever you find in the search engine you can immediately access and immediately print [and] copy." R1 1 at 143-44 (Idaz Greenberg - unrefuted Jury Trial Direct Testimony).

photograph through the following steps. First, run the CD-ROM using Windows Explorer® (extant at the publication of the CNG) and open the folder labeled "IMAGES" from within the CD-ROM. Then, open one of the subfolders contained in the IMAGES folder. Each image contained in the subfolder will be displayed, and each such image is a single scanned page of an issue of the Magazine. Next, right-click on an image, place the cursor over "Open With," and then choose "Paint." Using the "Select" tool provided by "Paint," select only the photograph, omitting all other material contained in the image. Right-click in the selected photograph and choose "Copy." Then, from the "File" menu in the toolbar, left-click "New," which creates a new blank document. Within the new document, right-click and choose "Paste." The new document will now contain only the photograph extracted from the scanned page, free of any of the other material originally contained on the page as it was scanned into the CD-ROM. Copies of the photograph now can readily be made and printed or transmitted. *See* R1-20, Exh. A.

A.

The holding in *New York Times Company, Inc. v. Tasini ("Tasini")*, 533 U.S. 483, 488, 121 S. Ct. 2381, 2384-85 (2001) is as follows:

> In agreement with the Second Circuit, we hold that § 201(c) does not authorize the copying at issue here. The publishers are not sheltered by § 201(c), we conclude, because the databases *reproduce and distribute articles* standing alone and not in context, *not "as part of that particular collective work"* to which the author contributed, *"as part of . . . any revision" thereof,* or "as part of . . . any later collective work in the same series."

> Both the print publishers and the electronic publishers, we rule, have infringed the copyrights of the freelance authors.

(emphasis mine).

The Society desires to license the use of certain photographs in a new assembly of its previously published magazine series, but does not want to pay the contributing photographers to do so. To succeed, the CNG must qualify for the protection of the privilege extended by § 201(c). However, the *assembly* of *"[those]* particular collective *work[s]"* – 1,200 magazines – is a far different undertaking, in a practical as well as a copyright sense, than the permitted § 201(c) *reproduction* or *republication* of *"that* particular collective *work"* – each issue of the magazine.

Until the case returned to our court for oral argument, generally the appellants traveled on the "revision" prong of § 201(c).[8] Now, glossing over or

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[8] The appellants have changed their legal position in this case more than a politician running for election. In February of 1998 in the district court they argued: "CD-ROM 108 [the CNG] thus does not qualify as a *new collective work* for purposes of § 201(c) because it does not differ in any material creative respect from paper copies of the Magazine. As a straightforward reprint of the Magazine, the Society is entitled to publish it pursuant to § 201(c) . . . Thus, revisions of a particular collective work and later collective works in the same series — both explicitly authorized by § 201(c) — are clearly 'new' collective works. For example, 'a "revision" can alter a preexisting work by a sufficient degree to give rise to a new original creation." [citing the *Tasini* district court opinion]. Reply Memorandum of Law in Support of Defendants' Motion to Dismiss Count II And to Dismiss for Summary Judgment on Counts III-V of Plaintiffs' Amended Complaint. R1-28 at 4-5 (emphasis mine). In their November 1999 "Memorandum of Law in Opposition to Plaintiffs Motion to Vacate Order Granting in Part Defendants' Mo-

tion for Partial Summary Judgment, and for other Relief," R1-62, appellants made the following statement in judicio: **"CD-ROM 108 [the CNG] is merely a republication, *not a revision*, of the Magazine** . . . CD-ROM 108 is nothing more than a collection of issues of the Magazine in a different medium . . ." *Id.* at 7-8. In their initial brief to our court in *Greenberg I*, appellants continued to assert and concede that CNG is indeed a "new" collective work but qualified that concession by claiming that: "SECTION 201(c) OF THE COPYRIGHT ACT PERMITS THE SOCIETY TO PUBLISH CD-ROM 108 [THE CNG] AS A REVISION EVEN IF IT IS A *NEW COLLECTIVE WORK*, NOTWITHSTANDING THE SECOND CIRCUIT'S OPINION IN *TASINI* . . . Thus, revisions of a particular collective work and later collective works in the same series . . . are clearly 'new' collective works." Brief in Opposition to Initial Brief of Jerry Greenberg and Idaz Greenberg, 19-20. To further fortify their concession appellants added the following definition: "To 'revise' something means to 'make a new, amended, improved, or up-to-date version' of it. Webster's Ninth New Collegiate Dictionary at p. 1010." *Id.* at 22. Just as the chamaeleon politician changes position with the most recent poll, our appellants have changed their legal position and rationales as the *Tasini* case worked its way through the courts. However, as I have endeavored to demonstrate in this dissent, the CNG is a non-qualifying (per § 201(c)) new collective work, not due to its "revision" or "non-revision" status, but because the essentially archival copy of Magazines scanned into CD-ROMs (the most analogous replica to the microform replica) has been combined with at least two copyrightable (and in one case registered) computer programs — each a free-standing, *sui generis* copyright-eligible work. Thus, as the appellants correctly conceded in their zig-zag argument trail, the CNG is not any sort of revision — it is an *exact replica* placed in a different medium; which mere placement does not constitute a "revision." Moreover, the act of scanning is all that is necessary to place the rote copy of the Magazine into the digital medium. The "assembly" of these, "separate and independent works in themselves" [the replica and the computer programs] constitute a "new" and, even "completely different," collective work. *See* § 101 definition of "collective work" which in pertinent part provides: "A 'collective work' is a work . . . , in which a

misstating the meaning of "that particular collective work" (which is limited to, and descriptive of, each individual issue of the magazine), they claim the Society may license a reproduction or republication of all issues, collectively in a new anthology or aggregation, so long as each replication is in "context" *per Tasini*. Recall, however, that *Tasini* factually was a "disassembly" case not an "assembly" case. The Court focused on textual and pictorial context, in a *threshold* examination, to determine whether a "particular collective work" even existed in order to ascertain whether the § 201(c) "revision privilege" was available. The Court determined that it was not, and it never reached the controlling issue presented in our case as to whether an *assemblage* is privileged under § 201(c). As discussed below, an assemblage of a replica and copyrightable computer programs is not privileged because a "new collective work" is *expressly not included* in § 201(c) per House Report No. 94-1476, at 122, as reprinted in 1976 U.S.C.C.A.N. 5659, 5737 (hereinafter "H.R. Rep.") and each "particular collective work" (each issue of the Magazine) is not part of a "revision." Thus the Society has failed to grapple with the reality that such a heretofore non-existent aggregation of the 1,200 magazines has now been assembled into what constitutes a "new collective work."[9] The Society represented, in its claim of

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number of contributions, constituting separate and independent works in themselves, are *assembled* into a collective whole."

[9] "The term 'compilation' includes collective works." § 101. The definition of "collective work," per § 101 in pertinent part: ". . . is a work, such as a[n] . . .. anthology . . .in which a number of contributions, consisting of separate and independent works in themselves [here, each issue of the magazine as well as at least two computer programs], are *assembled* into a collective whole [here, the CNG]."

copyright for the CNG ("108 Years of National Geographic Magazine on CD-ROM"), that the CNG is a "Compilation of Pre-Existing Material Primarily Pictorial" under section 6 [entitled "Derivative Work Or Compilation"]. Per H. R. Rep., cited by the Second Circuit, the Supreme Court, and the *Greenberg I* panel, this assemblage actually constitutes a "new collective work" which is not embraced, and is *expressly excluded,* from the scope of § 201(c).[10] This assemblage is a new product and a public dissemination that totally eviscerates the economic value of the contributors' rights under § 201(c). If the Society is also relying on the second, or "revision" prong of § 201(c), as it has (from time to time) until now, its argument fails because *no revisions have been made to the magazines.* No revisions have been made because nothing has been "revised."[11] Accordingly, since § 201(c) specifically provides that a reproduction and distribution can only occur "as part of" a later edition or *revision,* a publisher infringes a freelance contributor's work by either a reproduction or a distribution that takes place not "as part of a revision." *Ryan v. Carl Corp.*, 23 F. Supp. 2d 1146, 1149 n.2 (N.D. Cal. 1998) (Judge Fern Smith got this im-

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[10] H.R. Rep. No. 94-1476, at 122-23; *Tasini v. New York Times Co.*, 206 F.3d 161, 167 (2d Cir. 2000); *Tasini*, 533. U.S. at 495, 121 S. Ct. at 2388; *Greenberg I*, 244 F.3d at 1273.

[11] "A revision is commonly understood as a purposeful alteration of content undertaken for some substantive reason . . . . Likewise when an exact replica of the original work is produced the result is not a revision because nothing has been 'revised.'" Lateef Mtima, *Tasini and its Progeny: Exclusive Right or Fair Use On the Electronic Publishing Frontier?*, 14 Fordham Intell. Prop. Media & Ent. L.J., 369, 423-26 (Winter 2004) (hereinafter "Mtima").

portant aspect of the case right even before the Second Circuit and Supreme Court in *Tasini*).

As the appellants have conceded and recognized they must demonstrate that the CNG constitutes a "collective work" that each of the defendants[12] are privileged under § 201(c) to reproduce and distribute.[13] By its express terms, § 201(c) protects and refers to only "collective works" and confers a "privilege" only to "the owner of the copyright in *the collective work.*" § 201(c) (emphasis mine); *see also* H.R. Rep. (referencing § 201(c) and the definition of "collective work" in § 101 and stating that § 201(c) "deals with the troublesome problem of ownership of copyright in contributions to 'collective works.'" Under these

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[12] Copyright in each separate contribution to a *collective work* is distinct from copyright in the collective work as a whole, and vests initially in the author of the contribution. In the 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.

[13] As will be discussed below, only appellant Society (a nonprofit entity) holds the § 201(c) privilege. However, the record is clear that a separate legal entity, National Geographic Enterprises, Inc. a for-profit subsidiary corporation, together with an independently owned corporation, Mindspring, Inc., actually reproduced and distributed the CNG. As explained below, the § 201(c) privilege is personal to the Society and may not be transferred to another person (i.e., legal entity). Yet it is these two other legal entities that are commercially exploiting the plaintiff's copyright and contributions or works, purportedly under the auspices and cover of the § 201(c) privilege as to which the law negates their putative claim.

statutory definitions,[14] as clarified by the referenced legislative history, the CNG is a "new collective work." Before examining why the CNG is a new collective work, recall that the *Tasini* case involved a factual situation that was totally different from the facts in this case. That case was a *disassembly* case not an *assembly* case — as is this case. This assemblage know as "the CNG" does not constitute a privileged revision because it is, at the very least not a revision and, moreover, is a new and different collective work that Congress expressly exempted from the coverage of § 201(c)[15] and does not constitute a revision, much less "part of . . . any revision" of "that particular collective work." *Tasini*, 533 U.S. at 488, 121 S. Ct. at 2384-85.

The Second Circuit decision in *Tasini*, affirmed by the Supreme Court, began with the undisputed assumption that: "[T]he electronic databases are neither the original collective work — the particular edition of the periodical — in which the [a]uthors' articles were published[,] nor a later collective work in the same series." *Tasini*, 206 F.3d 161, 166 (2d Cir.

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[14] A "collective work" is a work, such as a periodical issue, anthology, or encyclopedia, in which a number of *contributions, constituting separate and independent works in themselves,* are *assembled* into a collective whole. A "computer program" is a set of statements or instructions to be used directly or indirectly in a computer in order to bring about a certain result. § 101 (emphasis mine).

[15] H.R. Rep. at 122-23 (. . . the publisher could not revise the contribution itself or *include it in a new anthology or entirely different magazine or other collective work.*" (emphasis mine). *See Tasini*, 533 U.S. at 495, 121 S. Ct. at 2388; *Tasini v. New York Times Co.*, 206 F.3d at 167; *Greenberg I*, 244 F.3d at 1273.

2000), *aff'd*, 533 U.S. 483, 121 S.Ct. 2381 (2001).[16] That reasoning left only the "revision" prong of § 201(c) remaining to the publishers. Then, the Second Circuit rejected the publishers' contention "that each database constitutes a 'revision' of the particular collective work in which each [a]uthor's" contribution first appeared. *Id.* at 166. The Second Circuit correctly explained – just as our *Greenberg I* opinion agreed — "[t]he most natural reading of the 'revision' of 'that collective work' clause is that Section 201(c) protects only later editions of a particular issue of a periodical, such as the final edition of a newspaper." *Id.* at 167.

This analysis by the Second Circuit also correctly observed, interpreting the legislative history explaining the introduction of § 201 into the then-new 1976 Copyright Act, that: "the 'revision' clause in Section 201(c) was not intended to permit the inclusion of previously published freelance contributions 'in a

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[16] The "work" referred to in § 201(c) is the individual periodical or encyclopedia, not a collection of periodicals or sets of volumes over dozens of years. The drafters of the statute clearly had in mind the narrower idea of a single issue of a periodical, not the entire series of periodicals. The terminology "that particular collective work" certainly suggests this: The legislative history refers to individual "editions" and "volumes." *See* H.R. Rep. at 122-23 (under section 201(c) "a publishing company could reprint a contribution from *one issue in a later issue* of its magazine . . . .") (emphasis mine). Section 101 of the Copyright Act refers to a "a periodical issue" in the definition of a collective work. *See also Tasini*, 206 F.3d at 167 ("'that particular collective work' means a *specific edition or issue of a periodical")* (emphasis mine). To the question *"if the publishers can publish revisions issue by issue, then why can't they put all the issues together[?];"* the answer would be: *"the resulting compilation is a* new anthology or new collective work, *rather than a revision of 'that collective work.'"*

new anthology or an entirely different magazine or other collective work,' *i.e.*, in later collective works not in the same series." *Id.* (citing H.R. Rep. at 122-23). The panel emphasized that: permissible uses under § 201(c) "are an exception to the general rule that copyright vests initially in the author of the individual contribution"; and warned that "[w]ere the permissible uses under Section 201(c) as broad and as transferable as [publishers] contend, it is not clear that the rights retained by the [a]uthors could be considered 'exclusive' in any meaningful sense." *Id.* at 168. The *Tasini* panel also noted in a footnote that: "Section 201(c) grants collective works authors 'only' a 'privilege' rather than a 'right.' Each of these terms connotes specialized legal meanings, and they were juxtaposed by Congress in the same sentence of Section 201(c)." *Id.* at 168 n.3.

Thus, both the Second Circuit in *Tasini* and our court in *Greenberg I* concluded that a "new anthology" or "new collective work" was not within the "revision" privilege of § 201(c) or otherwise protected within the limited scope of § 201(c). The Supreme Court's affirmance of the Second Circuit's opinion in *Tasini*, not only failed to diminish the force and effect of both the Second and Eleventh Circuit opinions that had issued before the Court ruled, but rather fortified those respective courts' analyses of how new collective works ("other collective works") are beyond the scope of the § 201(c) privilege.[17] Specifically, the Court explained that:

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[17] *See* Mtima, at 425 ("The content-altered digital re-publications in *Tasini* and Greenberg were held to virtually extinguish any secondary market for the contributory works contained therein, because once available online, there would be little need for alternative access to the works. An exact digital replica of a collective work, particularly when disbursed into an online

§ 201(c) adjusts a publisher's copyright in its collective work to accommodate a freelancer's

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commercial database, would likely have the same effect. Accordingly, exact digital replicas can be disqualified from § 201(c) revision status on the same market impact grounds as the content-altered digital re-publications at issue in *Tasini.*"). [T]he [*Tasini*] Court ruled that to allow the digital re-publications as privileged revisions would defeat the legislative objective underlying § 201(c) . . . the Court found that the development of digital technology has resulted in the creation of a secondary 'stand alone' market for the individual contributions to collective works and construed that Congress intended that the contributory authors, as opposed to the publishers, be the ones to benefit from such new markets . . . . [T]hus the secondary, 'stand alone' re-publication market that § 201(c) restores to individual contributing authors had been usurped by the publishers." *Id.* at 388-89 (citations omitted); *see also*, Thomas Dallal, *Faulkner v. National Geographic Enterprises, Inc.: Driving a Truck Through the Eye of a Needle*, 15 Tex. Intell. Prop. L.J. 63, 82-84 (2006) ("A recent article . . . defines 'media neutrality' to mean that a 'copyright owner's rights should be the same regardless of the form, whether analog or digital, in which the work may be embodied or fixed.' . . . Because the Second Circuit in *Faulkner* held that the CNG was a permissible revision, it raised the issue of media neutrality only in passing and only in the context of whether the plaintiffs' contracts explicitly forbade the challenged CNG uses. . . . [T]he Second Circuit dodged the central issue of whether the CNG was a 'other later collective work' or anthology by declaring microform and microfiche a permissible revision and then analogizing the CNG to microform. In *Greenberg*, on the other hand, the Eleventh Circuit undertook the required analysis, determined that the CNG possessed substantial indicia of originality, and emphasized that the Society had admitted as much by registering it with the copyright office as a new compilation. It then correctly, and consistently with the Second Circuit and Supreme Court *Tasini* decisions, concluded that the CNG was 'a new product ("an original work of authorship"), in a new medium.'"); Alice Haemmerli, *Commentary: Tasini v. New York Times Co.*, 22 Colum. J. L. & Arts 129 (Winter 1998) (to the same effect).

> copyright in her contribution. If there is demand for a freelance article standing alone or in a *new collection,* the Copyright Act allows the freelancer to benefit from that demand; after authorizing initial publication, the freelancer may also sell the article to others.

Tasini, 533 U.S. at 485, 121 S. Ct. at 2383 (emphasis mine). The Court stressed that a principal component of the underlying policy rationale for finding that the publisher did not enjoy any § 201(c) privilege was that:

> It would scarcely "preserve the author's copyright in a contribution" as contemplated by Congress, [H.R. Rep. at 122], 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.*

Tasini, 533 U.S. at 497, 121 S. Ct. at 2389 (citation omitted) (emphasis mine). The *Tasini* Court emphasized this copyright policy in protecting the author's (here photographers') rights by observing:

> The [p]ublishers' encompassing construction of the § 201(c) privilege is unacceptable, we conclude, for it would diminish the [a]uthors' exclusive rights in the [a]rticles.

Id. With that policy in mind, the Court moved to the actual test to be applied "[i]n determining whether the [a]rticles have been reproduced and distributed *'as part of' a 'revision'* of the collective works in issue." *Id.* (emphasis mine). The Court stated that it "focus[es] on the [a]rticles as presented to, and perceptible by, the user of the [d]atabases." *Id.* at 499, 121 S. Ct. at 2390.

Under this analytical approach, the Court explained:

> One might view the articles as parts of a new [aggregation][18] – namely, the entirety of works in the [d]atabase. In that [aggregation], each edition of each periodical represents only a miniscule fraction of the ever-expanding [aggregation]. The [aggregation] no more constitutes a "revision" of each constituent edition than a 400-page novel quoting a sonnet in passing would represent a "revision" of that poem. "Revision" 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. The massive whole of the [aggregation] is not recognizable as a new version of its every small part."

Id. at 500, 121 S. Ct. at 2391 (citation omitted). The Court concluded: "Those [d]atabases [the aggregation] simply cannot bear characterization as a 'revision' of any *one periodical edition.*" *Id.* at 501 n.9, 121 S. Ct. at 2391 n.9 (emphasis mine).

A review of the *Tasini* opinions, both in the Second Circuit and the Supreme Court, as well as our *Green-*

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[18] The Supreme Court used the word "compendium" here. "Compendium" is defined as: "1. a brief treatment or account of a subject, esp. an extensive subject; concise treatise; 2. a summary, epitome, or abridgement; 3. a full list or inventory. *Random House Unabridged Dictionary* 417 (2d ed. 1987). Presumably, the Court relied upon the third definition. In order to avoid confusion, because the more favored definitions of the word – emphasizing brevity and conciseness – are inappropriate to the database at issue in our case, reproducing, as it does, the *complete National Geographic* with each issue as originally published rather than shortened or summarized in any way, I have instead used the word "aggregation."

berg I opinion, discloses that all three opinions cite to the same House Judiciary Committee Report for interpretation of the last clause of § 201(c), the meaning of "revision," and the definition of its scope.[19] The relevant House Report passage explains:

> The basic presumption of section 201(c) is fully consistent with present law and practice, and represents a fair balancing of equities. At the same time, the last clause of the subsection, under which the privilege of republishing the contribution under certain limited circumstances would be presumed, is an essential counterpart of the basic presumption. Under the language of this clause 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.*

H.R. Rep. at 122-23 (emphasis mine). Based upon a straight-forward reading of that legislative history, the two *Tasini* opinions and our *Greenberg I* opinion concluded that § 201(c) does not extend protection for a publisher to include an author's or photographer's contribution in a collective work in a new aggregation, *Tasini*, 533 U.S. at 500, 121 S. Ct. at 2391, or anthology (a "later collective work" in § 201(c) parlance). *Tasini*, 206 F.3d at 169; *Tasini* 533 U.S. at 496-97, 121 S. Ct. at 2389-90. Under this analysis, Greenberg's copyrights have been infringed.

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[19] *Tasini*, 206 F.3d at 167; *Tasini*, 533. U.S. at 495, 121 S. Ct. at 2388; *Greenberg I*, 244 F.3d at 1273.

If only the Second Circuit had followed its earlier, affirmed approach in *Tasini* when it decided *Faulkner*, it would have stayed on the correct track. In stark contrast to the later *Faulkner* decision, the *Tasini* Second Circuit panel had clearly held that: "If the republication is a 'new anthology'[20] or a different collective work, it is not within Section 201(c)." *Id.* at 169 (citing H.R. Rep. at 122-23 (1976)). It should be noted that appellants in their briefs to this court have attempted to perpetuate an inappropriate and inaccurate analysis originally introduced by the wrong question by the trial court in the *Faulkner* case, which is: "What then distinguishes a 'revision' from an 'entirely different' work?" *Faulkner v. Nat'l Geographic Soc'y*, 294 F. Supp. 2d 523, 539 (S. D. N.Y. 2003). The correct inquiry, reading the plain text of § 201(c) is, rather: "What distinguishes a 'revision' from an 'other collective work?[21] '" The House

[20] "Anthology" is defined as: "[A] collection of literary pieces, such as poems, short stories, or plays," *The American Heritage Dictionary of the English Language* 114 (2d ed. 1982); or "[a] book or other collection of selected writings by various authors, usually in the same literary form, of the same period, or on the same subject." The Random House Dictionary of the English Language 88 (2d ed. 1987). The only reference to "anthology" in the Copyright Act appears in the § 101 definition of "collective work": "a work, such as a periodical issue, anthology, or encyclopedia, in which a number of contributions, constituting separate and independent works in themselves, are assembled into a collective whole."

[21] "Collective work" is a copyright term of art defined in Section 101 of the Act. *See* fn 12 & 14, *supra*. By that definition, a "collective work" is a species or type of copyrightable work different from the other two types of copyrightable works; such as, a creative work (like a novel or drama) and a derivative work (like a motion picture based upon a novel). Thus the conflation of "work[s]" and generic usage by the *Faulkner* district judge, and others, distorts the correct interpretive process.

Report defines it not solely as an "entirely different work," as Judge Kaplan framed the question, but as a "new anthology or an entirely different magazine or other collective work." H.R. Rep. at 122-23. The *Faulkner* court, using an attenuated microform analogy from *Tasini* dicta, avoided the obvious alternate conclusion that the CNG is a new compendium, anthology, or "other collective work" and not a "revision" under § 201(c).[22] The Society and Mindscape cannot

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[22] After publication of both the *Tasini* opinion and the *Faulkner* opinion, Professor Deborah Tussey made the following insightful and pertinent observation:

> The NYTO and GPO CDs, on the other hand, were distributed as compilations of original issues, requiring a more extensive inquiry into whether they were functional equivalents of revisions or new collective works. Congress, in the legislative history, indicated that 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, but publishers could not revise the contribution itself or include it in a new anthology or an entirely different magazine or other collective work. Since GPO included publications other than those taken from the New York Times, it clearly constitutes a new anthology and, hence, a new collective work under section 201(c). NYTO, which accumulated only issues of the New York Times, presents a more difficult case. The Faulkner court read the "entirely different" language to indicate that a collective work which is merely somewhat different from the original is privileged and relies on Tasini dictum regarding microforms to conclude that accumulations of issues of the same periodical are permissible. One can as easily read the passage, standing alone, to indicate that an accumulation of issues, like NYTO, is a new anthology collecting multiple, previous compilations (the individual issues). In the absence of clear direction from Congress, the court should have resolved the question by emphasizing the policy underlying section 201(c).
>
> The legislative history of section 201(c) clearly supports the majority's interpretation of Congress's intent to equalize the

point to any single issue of the some 1,200 separate collective work magazines that bears anything anyone could term a "revision." Each issue of the magazine has been slavishly and identically reproduced and lodged in a different more compact and portable/storable digital medium accompanied by a completely new moving sequence with audiovisual accompaniment (a derivative work), which is displayed

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balance of power between individual authors and publishers. The overriding policy issue reflected in that history is fairness in the allocation of incentives for creation, not, as Justice Stevens argues, efficiency of dissemination. The majority offers sufficient empirical evidence to support that policy analysis, based on the impact on the authors' markets for new anthologies. Had the court emphasized this argument and clarified the question whether accumulation of multiple issues was permissible, it might have avoided the result in Faulkner, which undercuts the policy protecting authors. Indeed, the combination of Tasini, Faulkner, and the publishers' new practice of requiring that freelancers license all conceivable rights as a prerequisite to publication, suggests that if Congress retains any interest in protecting powerless freelancers against overreaching publishers, it must devise a better mechanism than section 201(c).

The court would have done well to pursue an alternative argument, urged by the Register of Copyrights, that the critical right infringed in Tasini was the right of public display. The Register argued "vigorously" that the display of individual articles to users violated the authors' right to public display and that since section 201(c) provides publishers no display privilege, the defendants should be held liable. This approach, had the court taken it, might have avoided the difficulty of defining copies and revisions, and their functional equivalents, in the electronic context. When combined with the policy analysis, it would also have provided a more satisfactory rationale for the result.

Deborah Tussey, *Technology Matters: The Courts, Media Neutrality, and New Technologies*, 12 J. Intell. Prop. L. 427, 484-85 (2005).

on the computer screen and plays each and every time a constituent CD-ROM is booted-up on the computer. Assembled with the unedited/unrevised copies are separately copyrightable computer programs (i.e., the CD Author Development System and the PicTools Development Kit). Recall that the 25-second audio-visual clip consists of 10 different Magazine covers morphing into each other with music and sound effects including Greenberg's "diver" photograph (a contribution or work). This sequence, which is little-discussed in the appellants' many pages of briefs, manifestly infringed upon Greenberg's, and the other contributing photographers', exclusive derivative work rights under § 106(2) by using his work in new ways.

Thus, assuming *arguendo* that the Society can invoke the § 201(c) privilege on behalf of infringing third parties as well as defense of its own conduct, the question becomes: Does the creation of a work that never before existed (the CNG) by combining an exact, unrevised digital replica of 1,200 pre-existing collective works (i.e., the magazines) together with at least two independently created and owned copyrightable computer programs into a single integrated commercial product (the CNG) constitute either: (1) a new anthology; or, (2) other collective work? If it is a new anthology or other collective work, then it is precluded from being privileged under § 201(c) by the express language of H.R. Rep 94-1476. *See* H.R. Rep., *supra*. However, the majority at footnote 11 cites a supplementary report by the Register of Copyrights from 1965 for the inaccurate and inartful proposition that what Congress really meant in legislative history which states that a publisher cannot include an author's contribution in a "new anthology or an entirely different magazine or other collective work"

really should be read as an 'entirely different' collective work." *See* Maj. Opin. at 16-17.

The majority places great weight upon its comparison of a microform version of the Magazine pursuant to the putative approval, albeit in dicta, by the *Tasini* Court under the § 201(c) privilege of a reproduction of print publications in microform. The majority states: "Based on this fidelity to context, the Supreme Court reasoned that the reproduction of print publications in microform would be privileged under § 201(c)." *Id.* at 12. At the outset of its discussion of the microform analogy argument by the publishers in *Tasini* the Court stated: "The Publishers press an analogy between the Databases,[23] on the one hand, and microfilm and microfiche, on the other. *We find the analogy wanting." Tasini*, 533 U.S. at 501, 121 S. Ct. at 2391 (emphasis mine). The majority then proceeds to find the CNG "analogous" to these forms of microform. On the heels of that tenuous "analogy," the majority is dismissive of the addition of the copyrightable computer programs incorporated by Mindscape into the CNG — the CD Author Development System and the PicTools Development Kit.[24] After describing and lumping together all of these independent and free-standing copyrightable computer programs the majority summarily concludes that: "[T]he computer program's elements . . . do not take the CNG outside the § 201(c) privilege." Maj. Opin. at 19. These copyrightable computer programs are referred to by the majority as "the search function," "zoom capacity,"

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[23] Recall that the "GPO" (General Periodicals OnDisc) in *Tasini*, similar to the CD-ROMs here, were included in the term "Databases."

[24] *See* Appendix A (Text on CNG boxes of CDs) and Appendix B (shrinkwrapped "License Agreement And Limited Warranty").

and a "computer program [that] simply compresses and decompresses the digital images." *Id.* at 19-20. The majority invoking the "a staple of the Copyright Act" – "the principle of media neutrality"[25] – observes that: "The CNG is no different than other CD-ROM products, in that all CD-ROMs *contain* an operating computer program that directs its functionality;"[26] and, "These added features only serve to provide functionality to the 'CNG's *raison d'etre*.'" *Id.* (emphasis mine). Confronted with a similar argument the Supreme Court majority in *Tasini* stated: "We lack the dissent's confidence that the current form of the Databases is entirely attributable to the nature of the electronic media, rather than the nature of the economic market served by the Databases. In any case, we see no grounding in § 201(c) for a 'medium-

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[25] Maj. Opin. at 22. This so-called "staple of the Copyright Act" actually appears for the first time in a Supreme Court opinion in *Tasini*, 533 U.S. 483, 502, 121 S.Ct. 2381, 2392.

[26] Maj. Opin. at 19-20. The statement that *"[a]ll* CD-ROMs contain an operating computer program" is incorrect; CDs are commonly used to store music, data and photograph files without incorporation of any computer program. It is possible to save pictures, images, songs, or videos onto a CD-ROM without adding a separate computer program to the disk. As noted above, by using *only* "Windows Explorer®" on a host computer, without a compression or decompression computer program or a search-engine computer program, a user can view each and every page and isolate and copy any photograph on the CD-ROM — thereby destroying any freelance contributors ability to economically benefit from the sale thereof. Moreover, the appellants use of the JIF (or Jpeg Interchange Format) provides easy, unencumbered access to the individual images of the Magazines on the CNG's constituent CD-ROMs. So easy that this abacus-age judge could accomplish it with only a little coaching from his law clerks! Moreover, Professor Patry even refers to me as a "Luddite" in his recent copyright treatise edition. 2 William F. Patry, *Patry on Copyright*, § 5:142.95 (2007)

driven' necessity defense . . . to the Authors' infringement claims." *Tasini*, 533 U.S. at 502 n.1 1, 121 S. Ct. at 2392 n.1 1.

First and foremost, the majority's analogy of the CNG to microfilm and microfiche is far too comprehensive. A valid analogy would be to a reproduction of the Magazines by scanning them onto a CD-ROM in digital format using the mechanical operating software embedded in a scanning device — similar to the photographic microfilming of the pages of a publication. At that point, without the benefit of a compression computer program, one would have essentially a "digital microfilm" stored and capable of display on a computer screen truly analogous to microfilm. The problem for the Society and its co-infringers, however, is that that digital reproduction would likely consume several hundred CDs by assembling it without a compression computer program. Such a reproduction would place the Magazines' images in context, readable and displayable by a computer — but it would not be a marketable product to the present computer-savvy generation, "the economic market served by the [CNG]." *Id.* The same can be said for the search-engine computer program. Without it the microform-like collection of CDs would not be marketable. Stated differently, the old wine without the new bottles with the twist off cap would be an unmarketable product. The tech-savvy consumer of today would be better off pulling the old editions of the National Geographic Magazine from their parents' and grandparents' closets, basements, or attics and viewing them for free!

The copyright principle in play here is that the nebulous concept of "media neutrality"[27] that has its principal focus on the *owner* of the copyright right, not the *grantee* of a privilege. That concept cannot trump the codified and constitutionally-based rights of a copyright owner. The statutory definition of collective work clearly applies to the "assembly" — the aggregation — of distinctly copyrightable works into "a collective whole;" here, the CNG. Thus, when the distinct, separable, copyrightable computer programs (some of which have registered claims of copyright predating the creation of the CNG) have been intentionally incorporated into the commercial product known as the CNG together with the existing components of the collective works — the *unrevised* individual issues of the National Geographic Magazines — there then exists an "other collective work" or surely, even under the majority's (mis)interpretation,

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[27] Media neutrality means that a copyright *owner* enjoys the same protection in any form where his work is fixed. Stated differently, "media neutrality" conveys the concept that the copyright law should not favor any particular technology over another, such that the subject matter of copyright includes works fixed on both existing media and future media. This broad protection encourages authors to create more works and thereby advance the progress of science and useful arts. Thus, the purpose of media neutrality is to shape a more flexible copyright law to fit new technology without revising the statutory copyright law in the future. H.R. Rep. at 52. Media neutrality language also appears in a series of statutory definitions (e.g., "audiovisual works," "copies," "fixed," "literary works," "phonorecords" and "sound recordings"). *See* §101. However, such language is conspicuously absent from the definitions of "derivative works" and *"compilations." See* § 101. Section 201(c) also lacks media neutrality language. Wendy J. Gordon, *Fine-Tuning Tasini: Privileges of Electronic Distribution and Reproduction*, 66 Brook. L. Rev. 473, 485 n.65 (2000).

"an entirely different collective work" that fails to qualify for inclusion within the § 201(c) privilege.

B.

The Society claims the benefit of a privilege for a group of third parties that actually compiled and published the CNG. The Society relies on putative transfers to those third-parties of the § 201(c) privilege to insulate it from liability for its contributory infringement and to protect its partners in publication from liability.

Although the issue of the transferability of the privilege accorded under §201(c) was not squarely briefed by the parties,[28] it was identified directly by the Supreme Court in *Tasini*.[29] *See Tasini*, 533 U.S.

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[28] "The matter of what questions may be taken up and resolved for the first time on appeal is one left primarily to the discretion of the courts of appeals, to be exercised on the facts of individual cases." *Singleton v. Wulff*, 428 U.S. 106, 121, 96 S. Ct. 2868, 2877 (1976). Courts have generally been amenable to exercising their inherent power to consider unbriefed *threshold* issues when they arise. *See U. S. Nat'l Bank of Or. v. Indep. Ins. Agents of Am. Inc.*, 508 U.S. 439, 447, 113 S. Ct. 2173, 2178 (1993) ("[A] court may consider an issue 'antecedent to . . . and ultimately dispositive of' the dispute before it, even an issue the parties fail to identify and brief.") (quoting *Arcadia v. Ohio Power Co.*, 498 U.S. 73, 77, 111 S. Ct. 415, 418 (1990)). Moreover, it is an axiom of appellate review that the judgment of a district court may be affirmed upon any adequate ground, even if it is other than the one on which the court actually relied. *See Smith v. Allen*, 502 F.3d 1255, 1280 (11th Cir. 2007).

[29] The Society must rely upon the privilege in § 201(c) because it does not hold exclusive right to Greenberg's photographs. Under § 103(b), a copyright in a compilation does *not* extend to the compiler any exclusive rights in the preexisting materials brought together in the collective work. Greenberg's photographs were produced and submitted to the Society *before* the periodicals were published. Therefore, the photographs were

at 496 n.5, 121 S. Ct. at 2389 n.5. Here, the Society, as the owner of the copyright in the collective works (the Magazines), is the statutory grantee and holder of the privilege. However, the record reflects that the Society, through taxable subsidiaries, contracted with an unaffiliated third party, Mindscape, to reproduce and distribute the Magazines on CD-ROMs. RAcc#2-230 at 9. Mindscape incorporated two independently owned and copyrighted computer programs (CD Author Development Kit and the PicTools Development Kit owned by DataWare, Inc. and Pegasus Imaging Corporation, respectively) onto each CD-ROM of the CNG.

The question is straightforward: once it has been established who owns the copyright in a particular collective work, who may exercise the § 201(c) privilege? The answer is equally straightforward: the exercise of privilege accorded the owner of a collective work under § 201(c) is limited to that owner. As the Act makes clear, the § 201(c) grant, is a privilege, not a right. As such, it is not transferrable. Thus, as a *threshold* matter, the invocation in this case of the

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preexisting works in which the Society owned no rights at all absent a written transfer. This delineation is further reinforced by the Copyright Office in its Circular 62 on the registration of copyrights in serials, where it states:

> If the serial issue includes any independently authored contributions in which all rights have *not* been transferred by the contributor to the claimant for the serial issue as a whole, those contributions are not included in the claim being registered, because the claimant in these contributions is different from the claimant in the entire serial issue.

Copyright Office Circular No. 62 (Serials) at 4 ("The Claimant and the Extent of the Claim").

§ 201(c) privilege is not authorized by the law on this record.

"Section 201(c) does not and cannot grant rights (since only [§ 106] does that); instead, it provides (rebuttable) presumptive privileges where the owner of a collective work does not have a transfer of exclusive rights from a free-lancer." William F. Patry, *Patry on Copyright* (hereinafter "Patry") § 5:138 (2007). "Section 201(c) grants specified privileges that can be exercised only by the owner of the original collective work (or an agent acting on behalf of the collective work owner) and cannot, without free-lancers' permission, be transferred to third parties." *Id.* Privileges are lesser even than non-exclusive licenses.

> As a result, there can be no doubt that collective owners do not own a transferable copyright ownership interest in freelance authors' separate contributions and that authorization to third parties to include those contributions in an entirely different collective work exceeds the collective work owners' authority under Section 201(c). *Only if the copyright owner in the collective work owns an exclusive right can it authorize third parties to reproduce and distribute freelance authors' separate contributions.*

Patry § 5:141 (emphasis mine).

In the original proceeding in district court in *Tasini*, the trial judge concluded that any § 201(c) "privilege" was, under § 201(d)(2), a "subdivision of any of the rights specified by section 106." *Tasini v. New York Times Co.*, 972 F. Supp. 804, 815-16 (S.D.N.Y. 1997). Thus, he concluded that it could be transferred. *Id.* However, as noted, "[t]he only 'rights' granted in the Copyright Act are [contained] in Sec-

tion 106, not in chapter 2." Patry § 5:141 n.2. That the term "privilege," in turn, appears only in § 201(c) shows that Congress recognized a difference between a right and a privilege. Further, "in general law," privileges are "regarded as personal and not transferable."[30] *Id.*

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[30] *See Chesapeake & Ohio Ry. v Miller*, 114 U.S. 176, 186, 5 S. Ct. 813, 818 (1885) (immunity from taxation enjoyed by railroad was a privilege and as such was "personal, and incapable of transfer without express statutory direction," and thus did not pass to purchaser of tract of railroad land); *Wilson v. Gaines*, 103 U.S. 417, 420-21 (1880) (same); *Morgan v. Louisiana*, 93 U.S. 217, 223 (1876) (same); *Am. Pelagic Fishing Co. v. United States*, 379 F.3d 1363, 1374 (Fed. Cir. 2004) (fishing permits issued by the government not transferable); *FDIC v. Morrison*, 747 F.2d 610, 613-14 (11th Cir. 1984) ("statutory right of redemption" under mortgage was "a personal privilege, not a transferable property right") (alterations omitted); *United States* v. *Murdock*, 919 F. Supp. 1534, 1541 (D. Utah 1996), *aff'd*, 132 F.3d 534 (10th Cir. 1997) (under tribal law principles, "hunting and fishing privilege within the *Ute reservati* is a personal right of user, 'neither inheritable nor transferable'"); *Herbert v. Newton Mem'l Hosp.*, 933 F. Supp. 1222, 1230-31 (D. N.J. 1996), *aff'd*, 116 F.3d 468 (3d Cir. 1997) (doctor hospital privileges not transferable); *Fulton v. United States*, 825 F. Supp. 261, 262 (D. Nev. 1993) (grazing permit as to federal lands "is a revocable privilege issued by the government; it is neither a transferable nor an assignable right"). The Restatement of the Law, Property, is also helpful on this point, to wit:

> A privilege, as the word is used in this Restatement, is a legal freedom on the part of one person as against another to do a given act or a legal freedom not to do a given act.
>
> *Comment:*
>
> *a. Correlative absence of right.* The relation indicated by the word "privilege" may also be stated from the point of view of the person against whom the privilege exists. From the point of view of this other person it may be said that there is no right on his part that the first person should

If one examines the pertinent copyright definitions in § 101 and the usage "privilege" and "right" throughout the Act, the error of the *Tasini* district court — and the appellants here invoking it — becomes clear. For instance, § 101 defines copyright ownership and transfer as follows:

> "Copyright owner", with respect to any one of the exclusive rights comprised in a copyright, refers to the owner of that particular right. A "transfer of copyright ownership" is an assignment, mortgage, exclusive license, or any other conveyance, alienation, or hypothecation of a copyright or of any of the exclusive rights comprised in a copyright, whether or not it is limited in time or place of effect, but not including a nonexclusive license.

§ 101. As noted, "ownership" and "transfer" thereof are addressed only in the context of the § 106 "exclusive rights." Nowhere is either of these terms used in connection with a "privilege." Incidentally, the forms of transfer mentioned in the above definition and in § 201(d)(1)[31] are familiar forms of property transfer.

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not engage in the particular course of action or of nonaction in question.

Illustration:

1. A is the lessee of a farm. The least contains a covenant with the landlord B that A will cultivate field one, and that he will not cultivate field two, and has no covenant as to field three. As between A and B, A has both the duty and the privilege of cultivating field one; he has both the duty and the privilege of not cultivating field two; except so far as he is affected by the law of waste, he has the privilege of cultivating and the privilege of not cultivating field three.

Restatement (First) of Property § 2 (1936)

[31] § 201. Ownership of copyright

* * *

Just as with most property transfers, any interest in copyright that is *transferable* must be accomplished in a writing, to wit:

> § 204. Execution of transfers of copyright ownership (a) A transfer of copyright ownership, other than by operation of law, is not valid unless an instrument of conveyance, or a note or memorandum of the transfer, is in *writing* and *signed by the owner* of the rights conveyed or such owner's duly authorized agent.

§ 204 (emphasis mine). Again, only an "owner" may effect a transfer. Thus, it is important and significant that under § 201(c) "the *owner* of copyright in a collective work," not a transferee or sub-grantee, is specified as having:

> only the *privilege* of *reproducing* and *distributing* the contribution [for which copyright ownership is vested in the author] as part of that particular collective work [for which copyright ownership is vested in the publisher], any revision of that collective work, and any later collective work in the same series.

(d) Transfer of Ownership.–

(1) The ownership of a copyright may be transferred in whole or in part by any means of conveyance or by operation of law, and may be bequeathed by will or pass as personal property by the applicable laws of intestate succession.

(2) Any of the exclusive rights comprised in a copyright, including any subdivision of any of the rights specified by section 106, may be transferred as provided by clause (1) and owned separately. The owner of any particular exclusive right is entitled, to the extent of that right, to all of the protection and remedies accorded to the copyright owner by this title.

§ 201(c) (emphasis mine). A clear distinction is drawn between the "owner" of the contribution and the "owner" of the particular collective work — the *only person privileged* to reproduce and distribute said contribution.

Here we have a publisher, the Society (a not-for-profit corporation), allegedly transferring its "revision" privilege(s) to a wholly-owned, for-profit corporation, which then putatively re-transfers the "revision" privilege(s) to Mindscape, Inc. in order to exploit the contributor's independently copyrighted work in a manner never intended by § 201(c).[32] However, as emphasized, the limited § 201(c) "privilege" cannot be exercised by anyone other than the "owner of the [original] collective work" — here the Society.

This limitation as to any transfer of the § 201(c) privilege gains further support through a study of other uses of "privilege" in the Act. If a particular word of a section of a statute is not otherwise expressly defined, that word's use elsewhere in the statute is indicative of how that word should be interpreted within the section itself. *See Dep't of Revenue of Or. v. ACF Indus., Inc.*, 510 U.S. 332, 333, 114 S. Ct. 843, 845 (1994) (requiring courts to give words which are used in more than one place in a statute interpretations that are consistent). The word "privilege" appears only three times in the entire 1976 Copyright Act: in § 201(c), and in §§ 109(d) and 111(d). Section 109(d) provides that persons *other* than the two express recipients (buyers and libraries) of the "privileges" described therein *cannot* exercise those privileges:

> (d) The privileges prescribed by subsections (a) and (c) do *not*, unless authorized by the copyright

[32] *See* notes 1 &17, *supra*.

> owner, extend to any person who has acquired possession of the copy or phonorecord from the copyright owner, by rental, lease, loan, or otherwise, without acquiring ownership of it.

§ 109(d) (emphasis mine). That is, the § 109(d) "privileges," as exceptions to the § 106 rights, are given by express statutory language only to buyers of copyrighted works and to libraries. Such privileges do not extend to third parties, such as non-owners or library patrons who merely borrowed or rented the works unless "authorized by the copyright owner." *Id.* Similarly, § 111(d)(1)(B)(i) defines the consideration (a compulsory licensing fee) that cable systems must pay for the "privilege" of retransmitting television broadcasts. Once paid for, the privilege is particular to the cable system in question. § 111(d)(1)(B)(i).

Interpreting "privilege" in § 201(c) in accordance with that term's use in § § 109(d) and 111(d), clarifies that the § 201(c) privileges cannot be transferred to the subs, NGE/National Geographic Interactive and Mindscape, Inc. The contributing owner (here Greenberg) never authorized the transfer. Like the privileges provided for in § 109(d) and § 111(d), the express limitations on the privilege in § 201(c) exist in the statutory language itself. Only the "owner of the copyright in that collective work" (here each Magazine) has the authority to exercise any of the § 201(c) privileges.

The legislative history of the 1976 Copyright Act also informs the non-transferability of privileges. The 1961 draft stated:

> The copyright secured by the publisher in the composite work as a whole should cover all of the contributions not separately copyrighted; but the publisher should be deemed to hold in trust for

> the author all *rights* in the author's contribution, except the *right* to publish it in a similar composite work and any other *rights* expressly assigned.

Register of Copyrights for the H. Comm. on the Judiciary, 88th Cong., Copyright Law Revision Part 2, 230 (Comm. Print. 1963) (emphasis mine). In stark contrast, a 1964 draft stated:

> The owner of copyright in the collective work shall, in the absence of an express transfer of the copyright or of any exclusive *rights* [of the author] under it, be presumed to have acquired only the *privilege* of publishing the contribution in that particular collective work.

Staff of H. Comm. on the Judiciary, 88th Cong., Copyright Law Revision Part 3, 15 (Comm. Print 1964) (emphasis mine). In addition to demonstrating that a statutory privilege is personal to the statutorily defined recipient thereof, the drafts of § 201(c) demonstrate that the privileges were not meant to be transferable. The change in language from "right" (in the 1961 draft) to "privilege" (in the 1964 draft) confirms the drafters' intent to provide publishers with something less than a right — a mere privilege that was *not* transferable.

The subject matter of § 201 is "copyright ownership and transfer." Throughout the section, the words "right" and "copyright" are used in connection with authors or their surrogates (employers for hire). In that section, the only time the word "privilege" is used at all in is connection with publishers. § 201 *et seq*. This usage reveals an intent to limit a publisher's entitlements. If Congress had wanted to give publishers a "right" to transfer authors' contributions

to third parties, the word "privilege" would not have been substituted for the word "right" in § 201(c). Congress required "express transfers" in the "works-made-for-hire" and "transfer of ownership of copyright" definitions in §§ 101 and 204. Section 201(c), however, is premised on the *non-existence* of an "express transfer of the copyright or of any rights under it." § 201(c). Accordingly, Congress intended the word "privilege" to be less than a right and non-transferable, analogous to a nonexclusive license.

For all of these reasons, it should be clear that the "privilege" of § 201(c) is not transferable but resides only with the copyright owner of the collective work — here the Society. Accordingly, only the Society may claim shelter from infringement under § 201(c) and then only if it exercised the two specific privileges in the manner permitted — which it did not.

C.

Another determinative issue has been ignored by the appellants and omitted from consideration by the majority — the "public display" issue. Simply stated, if indeed the appellants enjoy a § 201(c) privilege it does not include the privilege of publicly displaying Greenberg's protected photographs.

The Court in *Tasini*, 533 U.S. at 498 n.8, 121 S. Ct. at 2390 n.8, expressly stated that it did not reach the display issue. Appellants are relying upon the *privilege* they contend that the Society has *solely* under § 201(c).[33] Section 201(c) provides:

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[33] In the appellants' *en banc* brief, at page 6, under "STATEMENT OF THE ISSUE," they state the following:

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

> 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.

(emphasis mine) ("contribution" in this case refers to the photographs contributed by Greenberg who has undisputed ownership of the copyrights for the photographs that appear in the CNG product.).

As the Court observed in *Tasini*, "[t]he 1976 Act rejected the doctrine of indivisibility, recasting the copyright as a bundle of discreet "exclusive rights," each of which "may be transferred . . . and owned separately." *Id.* at 495-96, 121 S. Ct. at 2388-89 (cita-

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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,* 433 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).

(Emphasis mine).

tions omitted). The *Tasini* Court, in its fourth footnote, quotes the § 106 rights, including subpart "(5)" which reads:

> (5) in the case of literary, musical, dramatic, and choreographic works, pantomimes, and *pictorial,* graphic, or sculptural works, including the individual images of a motion picture or other audiovisual work, *to display* the copyrighted work publicly;

Id. at 496 n.4, 121 S. Ct. at 2389 n.4; § 106(5) (emphasis mine). An examination of the other five descriptions of copyright rights disclose the following verb forms with each enumeration: "(1) to *reproduce;* (2) to *prepare* derivative works; (3) to *distribute* copies; (4) . . . to *perform;* . . . (6) . . . to *perform* . . . publicly by means of a digital audio transmission." *Id.* (emphasis mine).

Accordingly, a comparison between § 201(c) and § 106(1)-(6) discloses that the § 201(c) "privilege" is confined only to two of the copyright owner's exclusive rights: that is, "(1) to reproduce" and "(3) to distribute copies." Nowhere is the right under § 106(5), the right to "display" a pictorial work, mentioned or included. *Expressio unis est exclusio alterius.*

Moreover, when one examines § 101, where the statutory definitions are set out, one discovers that "display" has a definition that includes projection on a computer screen — which is exactly what takes place when a CNG CD-ROM is inserted into the computer of a user:

> To "display" a work means to show a copy of it, either directly or by means of a film, slide, television image, or any other device or process or, in

> the case of a motion picture or other *audiovisual work,* to show individual images nonsequentially.

§ 101 (emphasis mine). The statutory definition of "audiovisual work" under § 101, further clarifies the computerized "display":

> "Audiovisual works" are works that consist of a series of related images which are *intrinsically intended to be shown by the use of* machines, or devices such as projectors, viewers, or *electronic equipment,* together with accompanying sounds, if any, regardless of the nature of the material objects, such as films or tapes, in which the works are embodied.

Id. (emphasis mine).

As observed above, the *Tasini* Court, at footnote 8, squarely raised the "publicly display" issue. Such an issue presents itself in the resolution of the scope of the § 201(c) privilege once we get past the initial hurdle of "context." In the very document cited by the Court, the "letter" of the Register of Copyrights, Marybeth Peters, a recognized copyright scholar, states:

> The limited privilege in § 201(c) does not authorize publishers to display authors' contributions publicly, either in their original collective works or in any subsequent permitted versions. It refers only to "the privilege of reproducing and distributing the contribution." Thus, the plain language of the statute does not permit an interpretation that would permit a publisher to display or authorize the display of the contribution to the public.

. . . The other databases involved in the case, which are distributed on CD-ROMs, also (but not always) involve the public display of the works. Because the industry appears to be moving in the direction of a networked environment, CD-ROM distribution is likely to become a less significant means of disseminating information.

The Copyright Act defines "display" of a work as showing a copy of a work either directly or by means of "any other device or process." The databases involved in *Tasini* clearly involve the display of the authors' works, which are shown to subscribers by means of devices (computers and monitors).

To display a work "publicly" is to display "to the public, by means of any device or process, whether the members of the public capable of receiving the performance or display receive it in the same place or in separate places and at the same time or at different times." . . .

This conclusion is supported by the legislative history. The House Judiciary Committee Report at the time § 203 was finalized referred to "sounds or images stored in an information system and capable of being performed or displayed at the initiative of individual members of the public" as being the type of "public" transmission Congress had in mind.

When Congress established the new public display right in the 1976 Act, it was aware that the display of works over information networks could displace traditional means of reproduction and delivery of copies. The 1965 Supplementary Report of the Register of Copyrights, a key part of

the legislative history of the 1976 Act, reported on "the enormous potential importance of showing, rather than distributing copies as a means of disseminating an author's work" and "the implications of information storage and retrieval devices; when linked together by communications satellites or other means," they "could eventually provide libraries and individuals throughout the world with access to a single copy of a work by transmission of electronic images." It concluded that in certain areas at least, "'exhibition' may take over from 'reproduction' of 'copies' as the means of presenting authors' works to the public." The Report also stated that "in the future, textual or notated works (books, articles, the text of the dialogue and stage directions of a play or pantomime, the notated score of a musical or choreographic composition etc.) may well be given wide public dissemination by exhibition on mass communications devices." When Congress followed the Register's advice and created a new display right, it specifically considered and rejected a proposal by publishers to merge the display right with the reproduction right, notwithstanding its recognition that "in the future electronic images may take the place of printed copies in some situations." H.R. Rep. No. 89-2237, at 55 (1966).

Thus, § 201(c) cannot be read as permitting publishers to make or authorize the making of public displays of contributions to collective works. Section 201(c) cannot be read as authorizing the conduct at the heart of *Tasini*.

The publishers in *Tasini* assert that because the copyright law is "media-neutral," the § 201(c)

> privilege necessarily requires that they be permitted to disseminate the authors' articles in an electronic environment. This focus on the "media-neutrality" of the Act is misplaced. Although the Act is in many respects media-neutral, *e.g.*, in its definition of "copies" in terms of "any method now known or later developed" and in § 102's provision that copyright protection subsists in works of authorship fixed in "any tangible medium of expression," the fact remains that the Act enumerates several separate rights of copyright owners, and the public display right is independent of the reproduction and distribution rights. The media-neutral aspects of the Act do not somehow merge the separate exclusive rights of the author.

147 Cong. Rec. E182-02 (2001) (Letter from Marybeth Peters, The Register of Copyrights of the United States of America, to Representative James P. McGovern, United States House of Representatives (Feb. 14, 2001)).

Clearly, users of the CNG CD-ROMs use their computers by virtue of operating code ("a process") at different "times" and "places." A House Judiciary Committee report states: "In addition to the direct showings of a copy of the work [here photograph], 'display' would include the projection of an image on a screen . . . by any method, the transmission of an image by electronic or other means, and the showing of an image on a cathode ray tube, or similar viewing apparatus connected with any sort of information storage and retrieval system." H.R. Rep. No. 94-1476, *reprinted in* 17 U.S.C.A. § 106 (West 2005). Thus, a computer image of the photograph(s) at issue would clearly constitute a "display." The report continues

that: "The definition of 'transmit' . . . is broad enough to include all conceivable forms and combinations of wired and wireless communications media . . . ." That would certainly include a CD-ROM that is sold to the public at large, to schools, to libraries, and to other downstream "displayers" for that very purpose.

This interpretation is consistent with the judicial and academic interpretation of that section. *See, e.g., Perfect 10, Inc. v. Amazon.com, Inc.*, 487 F.3d 701, 716 (9th Cir. 2007) ("In sum, based on the plain language of the statute, a person displays a photographic image by using a computer to fill a computer screen with a copy of the photographic image fixed in the computer's memory."); *ALS Scan, Inc. v. RemarQ Cmtys., Inc.*, 239 F.3d 619, 622-26 (4th Cir. 2001) (observing that website display of copyrighted photographs to internet subscribers was "public display"); *see generally* R. Anthony Reese, *The Public Display Right: The Copyright Act's Neglected Solution to the Controversy over RAM "Copies"*, 2001 U. Ill. L. Rev. 83. (2001); David Nimmer, *Nimmer on Copyright* § 8.20 (2007).

Finally, I will address the *amici's* histrionic speculation and contention that a decision in favor of Greenberg would lead to the wholesale purging of their electronic archives (information-destroying purges, loss of recorded history, massive destruction of constitutionally protected information, etc.). *See generally Amici* Briefs. This often-repeated but seldom-analyzed threat is totally specious. Archives, under a narrow construction of § 201(c) are not an unauthorized "reproduction and distribution" because they are not "distributed." *See* § 108 ("Limitations on exclusive rights: Reproduction by libraries and archives"). Section 201(c) is aimed at protecting authors

in the context of works reproduced and distributed to the public.[34] If archives are maintained primarily as a set of records, they are unaffected by the holdings in *Tasini* and *Greenberg I*. One must distinguish, however, between history being available to the public in archives, and history as a consumer product sold to the public in mass-merchandised CD-ROMs or databases. If publication is limited to the former, history need not be lost (or even inconveniently stored); it just will not be a profitable commodity – as the publishers here have endeavored to make it.

Moreover, even if such archives were technically not protected by § 201(c), their inclusion of authors' contributions would generally qualify as a fair use.[35]

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[34] The term "distributed" has a very specific meaning in copyright law. The statutory definition of "distribution" specifies distribution of "copies or phonorecords of the copyrighted work *to the pubic* by sale or other transfer of ownership, or by rental, lease or lending." 17 U.S.C. § 106(3) (emphasis mine). Archives maintained by media companies may be visited by researchers (physically or virtually) without thereby being offered to the public by any of the means specified in § 106. Nor would they be distributed in the sense of being "published." *See* the definition in § 101 of "publication," its relationship to distribution, and the differentiation of "public display" from "publication" as a form of distribution.

[35] *See* § 107 (fair use is permitted for purposes of scholarship, criticism, and teaching, among other things). Under the statute, a purported fair use is analyzed on the basis of factors including, but not limited to, (1) "the purpose and character of the use"; (2) "the nature of the copyrighted work"; (3) the amount of the work used in relation to the copyrighted work as a whole; and (4) "the effect of the use upon the potential market for or value of the copyrighted work." *Id.* Although factors (2) and (3) would favor the authors (whose work is creative and reproduced in toto), factor (1), insofar as the archival use is noncommercial and for the purpose of recording the article for posterity, would just as likely favor the archivist despite reproducing the article

Because the contributions would not be made widely available to the general public but would, rather, be included in records utilized primarily by researchers and scholars, there would be little or no impact on the market for the authors' contributions. Therefore, it is specious to assert that the purging of archives must occur based upon an adverse ruling to the publishers. Thus, the doomsday cries of a "loss of history" appear at best hyperbolic, and at worst, disingenuous.

The majority rationale, essentially adopting that of *Faulkner*, should be rejected and the district court's judgment should be affirmed on the basis of the rationales set out above.

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unchanged. As for factor (4), it would not appear that access to archives would adversely affect the value of the contributions to collective works. In addition, one can make other arguments in favor of public access to archives on the basis of the public interest in being fully informed. *See*, e.g., *Time Inc. v. Bernard Geis Assocs.*, 293 F.Supp. 130, 146 (D.N.Y. 1968) (ostensibly using a fair use rationale to permit publication of drawings derived from copyrighted photographs of the Kennedy assassination, but also stating that "[t]here is a public interest in having the fullest information available on the murder of President Kennedy.")

ANDERSON, *Circuit Judge*, dissenting, in which EDMONDSON, *Chief Judge*, TJOFLAT, BIRCH, and WILSON, *Circuit Judges*, join:

Respectfully, I disagree with the majority. I agree with and join Part A of Judge Birch's dissent,[1] but I write separately to emphasize a few points.

A.

Section 201(c) emphasizes that the "[c]opyright in each separate contribution to a collective work is distinct from copyright in the collective work as a whole, and vests initially in the author of the contribution." 17 U.S.C. §201(c). The section goes on to explain that "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 [1] that particular collective work, [2] any revision of that collective work, and [3] any later collective work in the same series." *Id.* (emphasis added). Congress limited the privilege of reproduction and distribution so that publishers could not "revise the contribution itself or include it in a new anthology or an entirely different magazine or other collective work" without the author's consent. *N.Y. Times Co. v. Tasini*, 533 U.S. 483, 497, 121 S. Ct. 2381, 2389 (2001) (quoting H.R. Rep. No. 94-1476, at 122-23 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5738).

In the present case, Greenberg and the other freelancers allowed their separate contributions – i.e., certain photos in the case of Greenberg – to be included in specific collective works – i.e., *individual*

[1] Because Judge Birch's Part A would be dispositive of the *en banc* issue, I need not address Parts B and C of Judge Birch's opinion.

issues of National Geographic magazine. Years later, National Geographic republished the individual contributions, within their original context but combined with other magazine issues, in "The Complete National Geographic" ("the CNG"), and we must decide whether the CNG is a privileged "revision" of the individual issues, as the majority concludes, or instead, an unprivileged "new anthology or . . . entirely different magazine or other collective work." Although this admittedly is a close question, for the reasons explained in Part A of Judge Birch's dissent, and for the reasons set out below, I conclude that the CNG constitutes the latter.

At the outset, my resolution of this question differs from the majority's because in my judgment, the contextual analysis set forth in *Tasini* does not fully resolve the instant case. It is true, of course, that the *Tasini* Court's analysis definitively resolved the case before it. In *Tasini*, the republished newspaper and magazine articles at issue did not appear in context, and therefore the contextual analysis was decisive – i.e., the new publication was not privileged under §201(c). 533 U.S. at 500, 121 S. Ct. at 2391. On the other hand, because individual articles in the CNG appear in their original context, and because users may "flip" through pages as they could with the original magazines, the re-publication of Greenberg's photos satisfies the threshold contextual analysis. Nonetheless, this case presents an issue not addressed, and not answered, in *Tasini* – i.e., does satisfaction of the contextual analysis *always* mean that the new publication enjoys the §201(c) privilege?

As a matter of common sense, it seems clear to me that the answer to that question is: No. For example, suppose the March 2000 monthly edition of National

Geographic had been devoted entirely to the geography and natural beauty of Africa; later, National Geographic included that March 2000 edition as a chapter in a larger book entitled "The Complete Intellectual History of Africa from 1900 to 2008," which purported to describe the historical development of every aspect of African life – including *inter alia* (and in addition to the chapter comprising the March 2000 edition on geography and natural beauty) the literature, philosophy, music, and legal and economic aspects of African society. Of course, my example is attempting to describe a work so entirely different in format, purpose, and utility that everyone would agree that it would qualify as "an entirely different collective work"; i.e., everyone would agree that it is not privileged. Because the individual contributions comprising the March 2000 edition in my example are reproduced in context, and yet the new book would still constitute an entirely different collective work, it thus seems clear to me that *Tasini*'s contextual analysis is merely a threshold issue.

Notwithstanding the fact that this threshold is satisfied in this case, the crucial issue remains whether the CNG is a "revision of that collective work" (to which National Geographic's privilege would extend), or whether it is "an entirely different . . . or other collective work" (to which the privilege would not extend). Several aspects of the CNG convince me that it constitutes the latter, thus exceeding the publisher's §201(c) privilege.

B.

First, there is considerable doubt that §201(c) by itself confers upon National Geographic the privilege of reproducing the individual contributions, even in their original context, within the cumulative total of

all National Geographic magazines. That is, putting aside the CD-ROM format of the CNG and its added features, I doubt that §201(c) permits the publisher to bind together every single issue of National Geographic magazine and sell the compilation as one comprehensive (albeit unwieldy) volume without compensating the individual contributors or obtaining their consent.[2] Section 201(c) permits National Geographic to distribute

Greenberg's photo as part of a particular collective work – a single issue of the magazine – or as a part of a revision of that magazine, but surely the compilation of all National Geographic issues does not constitute a "revision" of any single issue.[3] After all, the *Tasini* Court noted that placing all the articles from one edition of the New York Times into a CD-ROM database along with all the articles from other editions of that paper, does not constitute a revision of each edition: "The Database no more constitutes a 'revision' of each constituent edition than a 400-page novel quoting a sonnet in passing would represent a 'revision' of that poem." 533 U.S. at 500, 121 S. Ct. at 2391. This explanation comports with the Second Circuit's explanation that the database of New York Times articles is "at best a new anthology of innumerable editions of the Times, and at worst a new anthology of

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[2] Of course, National Geographic could secure the right to republish the individual contributions through contract, but National Geographic has asserted no such agreement here. Instead, the extent of the rights National Geographic claims by virtue of contract is the right to republish the individual contributions by virtue of §201(c)'s limited privilege.

[3] I need not decide whether such a compilation is a "later work in the same series," because National Geographic has disavowed reliance on that prong of §201(c)

innumerable articles from these editions," and thus "cannot be said to be a 'revision' of any (or all) particular editions." *Tasini v. N.Y. Times Co., Inc.*, 206 F.3d 161, 169 (2d Cir. 2000). The point is, according to the Supreme Court, that "[t]he massive whole of the Database is not recognizable as a new version of its every small part." *Tasini*, 533 U.S. at 500, 121 S. Ct. at 2391. Similarly, the massive whole of the CNG is not recognizable as a new version of the individual magazines in which Greenberg's photos originally appeared. Notwithstanding the fact that Greenberg's photographs appear in their original context, the CNG remains at best a new anthology of the many editions of National Geographic. Publishing Greenberg's photos in such a new anthology (or "other collective work") exceeds the limited privilege Congress established in §201(c).

The mere fact that in dicta in *Tasini* the Supreme Court distinguished the at-issue databases from microfilm and microfiche does not indicate, as the majority seems to believe, that microforms, which often collect multiple editions of a particular newspaper or magazine, constitute a privileged "revision" of each individual edition. The *Tasini* Court merely rejected a comparison between the databases and microforms because the databases, unlike microforms, failed the threshold requirement that the article may only be distributed in its original context. *See* 533 U.S. at 501-02, 121 S. Ct. at 2391092.[4]

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[4] The publishers in *Tasini* had urged the comparison to microform under the *assumption* that microform falls within the §201(c) privilege, *see Tasini* Supreme Court Br. for Pet'rs, 2001 WL 27573, at 45 (claiming, without citation of any authority, that the Second Circuit's *Tasini* opinion "cannot

Admittedly, microfilm and microfiche are long-standing means of publishing collective works. Assuming that the publisher of a collective work does not infringe the separate copyrights held by individual contributors when the publisher sells microforms containing multiple editions of the collective work, I suggest that the reason is more likely a contract reason, coupled with the doctrine of media neutrality, as opposed to a §201(c) privilege. Fortunately, we need not decide whether publishers' sales of such microforms fall within the privilege granted by §201(c), or are otherwise protected under the Copyright Act, because the issue is not before us, just as it was not before the *Tasini* Court. At no point in *Tasini* did the Supreme Court actually hold that microform copies of multiple editions qualify for the §201(c) privilege. As such, although the CNG, like microforms, passes the threshold contextual requirement, this fact does not end the analysis of whether publishers may, pursuant to §201(c), distribute a collective work that is combined with other collective works.

Furthermore, even assuming that microform reproductions enjoy the §201(c) privilege, the CNG contains significant differences from microforms that bolster my opinion that the CNG is a new anthology or an entirely different other collective work. As Judge Birch ably explains in his dissent, the CNG's advanced search function, compression/ decompression program, and its digital format are relevant to deciding whether the CNG constitutes an unprivileged new collective work. Greenberg granted the right to include his pictures in several single monthly editions. National Geographic claims in this

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possibly be correct, because it would deem microfilm and microfiche to be infringing").

case that its rights to the several monthly magazines for casual reading is extended by virtue of §201(c) to the right to publish an entirely new product – a sophisticated research tool capable of readily accessing and isolating any article or subject matter that had been published in National Geographic magazines for over 100 years – thus appealing to a new market. I do not believe that §201(c) can encompass the magnitude of the changes wrought here. Although the mere conversion from print to digital media, the addition of new functionality, and/or the inclusion of other independently copyrightable material *may* not always result in the creation of an entirely different collective work, when National Geographic combined roughly 1,200 issues of a magazine into a new product in a new format with these new features and these new uses, the publisher has created a new collective work that exceeds its §201(c) privilege. Assuming *arguendo* that the doctrine of media neutrality has some operation in the context of a §201(c) privilege – as opposed to the usual context of the copyright owner of the underlying articles – I doubt that the doctrine should operate with such full force in this context as to nullify the significant changes and assemblage wrought in this new product.

Finally, the fact that the Supreme Court in *Tasini* held that the §201(c) privilege did not extend to the publication referred to as GPO provides strong support for my position, and that of Judge Birch, that the §201(c) privilege also does not extend to the CNG. Recall that the GPO "show[s] each article exactly as it appeared on [the original] printed pages, complete with photographs, captions, advertisements, and other surrounding materials." 533 U.S. at 491, 121 S. Ct. at 2386. The difference between the GPO and the CNG is that the user of the former may not flip from

one article to another, whereas the CNG user can. As a matter of common sense and common experience, that is not a difference that would make a difference to the user, or to the publisher whose interest is marketing the new product. The existence *vel non* of the flip feature is similarly irrelevant to the authors of the individual articles. The value of Greenberg's copyright is undermined in a manner comparable to that of the individual authors in the GPO. "It would scarcely preserve the author's copyright in a contribution, as contemplated by Congress . . . 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." *Tasini*, 533 U.S. at 497, 121 S. Ct. at 2389 (internal quotation from the House Report omitted). Like the GPO, the CNG is a new product, appealing to a new market.

For the foregoing reasons, and for the reasons expressed by Part A of Judge Birch's dissent, I respectfully dissent.[5]

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[5] As the Court in *Tasini* noted, "it hardly follows" from my position that an injunction should issue. 533 U.S. at 505, 121 S. Ct. at 2393 (suggesting that courts "may draw on numerous models for . . . remunerating authors"). In my judgment, the circumstances of a case like this call for care on the part of trial courts to ensure that a hold-out freelancer does not exercise either veto power or blackmail power.

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APPENDIX B

APPENDIX B

[PUBLISH]

IN THE UNITED STATES COURT OF APPEALS
FOR THE ELEVENTH CIRCUIT

No. 05-16964
D.C. Docket No. 97-03924-CV-AMS

JERRY GREENBERG,
Plaintiff-Appellee,

versus

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

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

(June 13, 2007)

Before BARKETT, KRAVITCH, *Circuit Judges*, and TRAGER,* *District Judge*. TRAGER, *District Judge*:

This case presents the question of whether § 201(c) of the Copyright Act[1] accords a magazine publisher a

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* Honorable David G. Trager, United States District Judge for the Eastern District of New York sitting by designation.

[1] 17 U. S.C. § 201(c) was added to the copyright statute as part of the 1976 amendments to the 1909 Act, and provides:

privilege to produce a digital compilation that contains exact images of its past magazine issues. This case comes before this Court for a second time and requires a determination whether an intervening Supreme Court case, *New York Times Co. v. Tasini*, 533 U.S. 483 (2001), abrogates an earlier decision in this case, *Greenberg v. Nat'l Geographic Soc'y*, 244 F.3d 1267 (11th Cir. 2001) ("*Greenberg I*"), such that we are bound to overrule *Greenberg I*, which held that the digital compilation was not privileged.

I. PROCEDURAL HISTORY

National Geographic Society ("the Society"), National Geographic Enterprises, Inc. ("NGE") and Mindscape, Inc. ("Mindscape") (collectively, "National Geographic" or "defendants") appeal from a final order and judgment of the District Court for the Southern District of Florida entering judgment as a matter of law against them on the issue of liability and following a jury trial solely on the issues of damages and willfulness. Jerry Greenberg ("Greenberg") and his wife Idaz Greenberg filed a complaint and amended complaint alleging that defendants infringed Greenberg's copyrights in photographs that originally ran in several issues of National Geographic magazine when defendants

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(c) Contributions to Collective Works.—Copyright in each separate contribution to a collective work is distinct from copyright in the collective work as a whole, and vests initially in the author of the contribution. In the 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.

released "The Complete National Geographic" ("CNG"), a thirty-disc CD-ROM set that reproduces each monthly issue of National Geographic magazine from its first issue in 1888 through the late twentieth century. Defendants filed a motion to dismiss[2] on the ground that the Society had a privilege to publish a revision of the originally licensed works under 17 U.S.C. § 201(c). The district court granted the motion. That decision was reversed by this Court in *Greenberg I.*

Twenty days after entry of this Court's mandate in *Greenberg I*, defendants filed answers, raising affirmative defenses for the first time. Pursuant to its understanding of this Court's mandate, the district court entered judgment for plaintiffs and, on motion by plaintiffs, struck defendants' answers. The district court referred the issues of damages and willfulness to a magistrate judge, who conducted a jury trial. The jury returned a verdict of willfulness and awarded plaintiff the maximum statutory damages for willful copyright infringement: $400,000, or $100,000 for each occurrence.[3]

Three months after *Greenberg I* was decided, the Supreme Court decided *Tasini*, which elucidated a test for the application of the § 201(c) privilege. Subsequently, the Second Circuit, deciding a case brought by other photographers and authors whose works were included in the CNG, held that the CNG

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[2] The complaint alleged five counts, three of which related to the CNG. Defendants filed an answer to the non-CNG-related counts, which were subsequently dismissed with prejudice on Dec. 28, 1999.

[3] The maximum statutory damage award for willful infringement has since increased to $150,000 for each work that is infringed. 17 U.S.C. § 504(c).

was privileged under § 201(c) and found that *Greenberg I* was "contrary to" the Supreme Court's subsequent decision in *Tasini*. *Faulkner v. Nat'l Geographic Enters. Inc.*, 409 F.3d 26 (2d Cir.), *cert. denied*, __U.S.__, 126 S.Ct. 833 (2005).

II. BACKGROUND

Greenberg is a freelance photographer whose photographs were published in the January 1962, February 1968, May 1971 and July 1990 issues of National Geographic magazine. In each instance, after their initial publication in the magazine, Greenberg regained ownership of the copyrights in the photographs he had originally assigned to National Geographic. For decades, the Society has reproduced back issues of the magazine in bound volumes, microfiche and microfilm. In 1997, National Geographic produced the CNG, a thirty-disc CD-ROM set containing each monthly issue of the magazine for the 108 years from 1888 through 1996 – a collection of some 1200 issues of the magazine. The CNG is an image-based reproduction of the magazine; every page of every issue appears exactly as it did in the original paper version. The CNG does not provide a means for the user to separate the photographs from the text or to otherwise edit the pages in any way.

The CNG also contains a computer program, created by Mindscape, which compresses and decompresses the images and allows the user to search an electronic index. The CNG further contains an introductory sequence that begins when the user inserts the disc into a drive. This sequence starts with a Kodak advertisement, which is followed by a moving display of the Society's logo and theme song and then a 25-second segment in which ten images of actual magazine covers from past issues (including

Greenberg's January 1962 cover photograph) digitally fade into one another.

The Society registered its copyright of the CNG in 1998. On the registration form, the Society claimed that the work had not been registered before, but indicated that it was a "compilation of pre-existing material primarily pictorial," to which a "brief introductory audiovisual montage" had been added. *Greenberg I*, 244 F.3d at 1270.

Greenberg filed suit in December 1997, alleging, *inter alia*, that the CNG infringed his copyrights in his individual photographs. Before answering, defendants moved to dismiss those claims, or, in the alternative, for summary judgment. The district court, relying on the reasoning in the district court opinion in *Tasini v. New York Times Co.*, 972 F. Supp. 804 (S.D.N.Y. 1997), granted summary judgment in defendants' favor on the copyright claims. The district court noted that § 201(c) grants the publisher of a collective work a copyright on the collective work as a whole, while the author of an individual contribution to a collective work receives a copyright in that individual contribution. Because the CNG reproduced the entire collective work as a whole, the district court held that the CNG was privileged under § 201(c) and that defendants did not infringe Greenberg's copyrights in the individual photographs.

On March 11, 2001, this Court reversed. *Greenberg I*, 244 F.3d 1267. *Greenberg I* separately analyzed what it considered the three components of the CNG: the introductory sequence ("Sequence"), the digitally reproduced issues of the magazine themselves ("Replica"), and the computer program ("Program"). *Id.* at 1269. This Court assumed, without deciding,

that the Replica was privileged under § 201(c), but refused to apply the privilege to the Program or the Sequence, which it characterized as separately copyrightable elements. *Id.* at 1272-73. Taking all three components together, this Court held that the CNG is a new product "in a new medium, for a new market that far transcends any privilege of revision or other mere reproduction envisioned in § 201(c)." *Id.* at 1273. The Court rejected National Geographic's defense that use of the 1962 photograph in the Sequence was a fair use or *de minimus*. *Id.* at 1274-75. In its conclusion, 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." The Court further directed that, "[u]pon remand, the district court should ascertain the amount of damages and attorneys fees that are due as well as any injunctive relief that may be appropriate."

Defendants moved for rehearing, noting that there was no basis for this Court to direct the entry of judgment in Greenberg's favor on liability, as none of National Geographic's defenses other than § 201(c) had been adjudicated. While that petition was pending, this Court, *sua sponte*, issued a corrected opinion deleting the sentence directing the district court to enter judgment on the copyright claims in Greenberg's favor and amending the direction to assess damages and attorneys' fees to read: "Upon remand, the district court should ascertain the amount of damages and attorneys fees that are, *if any*, due as well as any injunctive relief that may be appropriate." *Greenberg I*, 244 F.3d at 1275-76. This Court subsequently denied rehearing. Defendants then filed a petition for a writ of certiorari by the

Supreme Court, which was denied. *Nat'l Geographic Soc'y v. Greenberg*, 534 U.S. 951 (2001).

III. DISCUSSION

On June 25, 2001, after this Court's decision in *Greenberg I*, the Supreme Court handed down its decision in *Tasini*. *Tasini* involved the use of individual freelance contributions in electronic databases that removed the individual contributions from the context of the original collective work. *Tasini*, 533 U.S. at 487. The *Tasini* court held that § 201(c) did not apply there because the works had been removed from their original context. *Id.* at 488.

In particular, the Supreme Court focused on how the articles were "presented to, and perceptible by, the user of the [d]atabases." *Id.* at 499. Finding that the databases presented the articles "clear of the context provided either by the original periodical editions or by any revision of those editions," the Supreme Court concluded that it could not "see how the [d]atabase perceptibly reproduces and distributes the article 'as part of' either the original edition or a 'revision' of that edition." *Id.* at 499-500. The Supreme Court 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, and implied, without directly stating, that such collections are privileged under § 201(c). *Id.* at 501-02. The Supreme Court noted that in the case of microforms, "articles appear . . ., writ very small, in precisely the position in which the articles appeared in the newspaper." *Id.* at 501. The Supreme Court further observed that it is "[t]rue [that] the microfilm roll contains multiple editions, and the microfilm user can adjust the machine lens to focus only on the

article, to the exclusion of surrounding material. Nonetheless, the user first encounters the article in context." *Id.* at 501. The Supreme Court affirmed that "transfer of a work between media does not alter the character of that work for copyright purposes," a concept known as "media neutrality." *Id.* at 502.

Subsequent to *Tasini*, on March 4, 2005, the Second Circuit affirmed in relevant part a summary judgment entered by the District Court for the Southern District of New York in favor of the Society in a copyright action in which the plaintiffs, like Greenberg, were freelance photographers and authors whose photographs and/or written works originally appeared in various issues of National Geographic Magazine.[4] *Faulkner*, 409 F.3d 26. The *Faulkner* plaintiffs sued for copyright infringement following republication of their work in the CNG. Of the six cases that were filed nationwide concerning the CNG, only *Greenberg* was not filed in, or transferred to, the Southern District of New York. *Faulkner*, 409 F.3d at 32-33. The district court in *Faulkner* refused to apply the doctrine of collateral estoppel to give preclusive effect to *Greenberg I* and found the CNG to be a privileged revision under § 201(c). *Id.* at 30. The Court of Appeals for the Second Circuit agreed with the district court, holding that the *Tasini* decision "represented an intervening (post-*Greenberg I*) change in law precluding the application of collateral estoppel, and [that] the CNG is a revision for Section 201(c) purposes." *Id.*

Although *Tasini* was decided on different facts from *Faulkner* and *Greenberg*, the *Faulkner* court

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[4] Unlike Greenberg, none of the *Faulkner* plaintiffs had works that were used in the Sequence.

found it telling that the Supreme Court had given "tacit approval to microfilm and microfiche as permissible Section 201(c) revisions, by contrasting that method of reproduction with the databases," at issue in *Tasini*, which allowed a user to retrieve an article in isolation, removed from its original context. *Faulkner*, 409 F.3d at 35. The Faulkner court distinguished the analysis in Greenberg I, which had focused on whether the three components identified as comprising the CNG - the Sequence, the Replica and the Program - were themselves copyrightable. *Id.* at 36. The *Faulkner* court described *Greenberg I* as holding 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)." *Id.* at 37. In contrast, "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. . . . [I]t also strongly implied, by contrasting the database to microfilm, that microfilm would constitute a privileged revision." *Id.* The *Faulkner* court concluded:

> In our view, the *Tasini* approach so substantially departs from the *Greenberg [I]* analysis that it represents an intervening change in law rendering application of collateral estoppel inappropriate.

Id. On the merits, the *Faulkner* court held that, "because the original context of the [m]agazines is omnipresent in the CNG and because it is a new version of the [m]agazine, the CNG is a privileged revision." *Id.* at 38. The *Faulkner* court additionally held that the Sequence was a revision that did not "substantially alter the original context," and, there-

fore, did not affect the CNG's status as a privileged revision. *Id.* Under the prior panel precedent rule, a panel of this Court is bound to follow an earlier panel decision addressing the same issue of law unless it has been overruled by this Court sitting *en banc* or by the Supreme Court. *See Glazner v. Glazner*, 347 F.3d 1212, 1214 (11th Cir. 2003) (citing *Saxton v. ACF Indus., Inc.*, 254 F.3d 959, 960 n.1 (11th Cir. 2001) (*en banc*)); *Lufkin v. McCallum*, 956 F.2d 1104, 1107 (11th Cir. 1992) ("A panel of this Court may decline to follow a decision of a prior panel if such action is necessary in order to give full effect to an intervening decision of the Supreme Court of the United States."). The exception to the prior panel precedent rule is clear-cut when a subsequent Supreme Court case expressly overrules a prior panel decision, and it is no less applicable "when the *rationale* the Supreme Court uses in an intervening case directly contradicts the analysis this Court has used in a related area, and establishes that this Court's current rule is wrong." *Johnson v. Kmart Corp.*, 273 F.3d 1035, 1063 (11th Cir. 2001) (Barkett, J., concurring) (emphasis in original).

Tasini creates a new, post-*Greenberg I* framework for analyzing the § 201(c) privilege. Under the *Tasini* framework, the relevant question is whether the original context of the collective work has been preserved in the revision. 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. Similarly, the Program is transparent to the viewer and does not alter the original context of the magazine contents. *See Tasini*, 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.").

Thus, the two remaining issues center on the Sequence. First, does the addition of the Sequence so alter the Replica that the CNG as a whole is no longer a privileged revision of the original magazines? And second, is the Sequence itself privileged under § 201(c)? As to the first question, we agree with the Second Circuit and hold that the addition of the Sequence does not extinguish the privilege that attaches to the Replica. The addition of the Sequence to the Replica portion of the CNG amounts to 25 seconds of "new" material that has been appended to some 1200 intact issues of the magazine. For guidance in determining whether this added material destroys the privilege, we turn to the legislative history of § 201(c). The House Report gives the following clarification:

> [T]he last clause of the subsection, under which the privilege of republishing the contribution under certain limited circumstances would be presumed, is an essential counterpart of the basic presumption. Under the language of this clause 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.

H.R. Rep. No. 94-1476, at 122-123 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5738. It is clear from the encyclopedia analogy that the addition of new material to a collective work will not, by itself, take

the revised collective work outside the privilege, as a revision of an encyclopedia would almost by definition include entries on new topics. The question is whether the new material so alters the collective work as to destroy its original context.

The addition of the Sequence to the Replica presents the inverse of an example mentioned in *Tasini*, when it noted:

> The Database no more constitutes a "revision" of each constituent edition than a 400-page novel quoting a sonnet in passing would represent a "revision" of that poem.

Tasini, 533 U.S. at 500. 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 Sequence is nothing more than a brief visual introduction to the Replica, which acts as a virtual cover for the collection of magazines. Just as a new cover on an encyclopedia set would not change the context of the entries in the encyclopedia, the Sequence in no way alters the context in which the original photographs (as well as the articles and advertisements) were presented.

As to the second question, National Geographic does not contend that the Sequence itself comes within the ambit of the § 201(c) privilege.[5] It concedes that Greenberg's 1962 cover photograph was used out

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[5] The *Faulkner* district court did not reach this question, as the Sequence did not use any of the *Faulkner* plaintiffs' contributions. *Faulkner v. Nat'l Geographic Soc.*, 294 F. Supp. 2d 523, 543 n.94 (S.D.N.Y. 2003).

of context in the introductory montage[6] and notes that *Greenberg I*'s rejection of its *de minimus* and fair use defenses remains binding. Accordingly, we follow *Greenberg I* on this point and hold that the Sequence is not privileged under § 201(c). As discussed below, it does not necessarily follow, however, that defendants are liable for infringement of the 1962 cover photograph.

National Geographic also argues that the district court erred by precluding it from ever raising, in any court, any other defenses to copyright liability. The district court granted plaintiff's motion to strike defendants' answers: (1) because it understood this Court's mandate in *Greenberg I* to not "permit reopening of the liability issues in this case;"[7] and (2) because the answers were "untimely"[8] and defendants "waived the right to file an answer"[9] by first moving to dismiss or, in the alternative, for summary judgment under § 201(c). Regarding the first ground, to justify its perceived "mandate" to strike National Geographic's answer, the district court quoted from the portions of *Greenberg I* that were later amended.

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[6] An argument could be made, however, that the Sequence did, in fact, use the covers in context. Just as the original cover provided an introduction to the issue of the magazine to which it was attached, the Sequence recycled previous National Geographic Magazine covers as a virtual cover for (or introduction to) the digital compendium of all of the magazine issues in the CNG.

[7] June 11, 2002 Order Granting, in Part, Defs.' Mot. for Additional Order of Reference; Denying Defs.' Cross-Mot. For Enlargement of Time; and Granting Pls.' Mot. to Strike Defs.' Answers, at 5.

[8] *Id.* at 6.

[9] May 29, 2002 Order Denying Defs.' Mot. For Interlocutory Appeal, at 6.

In short, National Geographic argues that the district court over-read the *Greenberg I* opinion by holding that it precluded defendants from contesting liability on any ground. Greenberg responds that the district court correctly interpreted the mandate as precluding it from entertaining any defense to infringement (including those not raised in the motion to dismiss). Greenberg then proceeds to refute the four defenses that National Geographic raised in its later-stricken answer,[10] attempting to demonstrate the futility of those defenses in the absence of a record.

We review *de novo* whether a district court correctly applied a mandate handed down by this Court. *See Alphamed, Inc. v. B. Braun Med., Inc.*, 367 F.3d 1280, 1285 (11th Cir. 2004) (reviewing *de novo* application of law of the case doctrine); *Piambino v. Bailey*, 757 F.2d 1112, 1120 (11th Cir. 1985) (explaining that a mandate simply requires a specific application of the law of the case doctrine). We agree with defendants that the district court over-read the mandate.[11]

Regarding the second ground given by the district court – untimeliness – National Geographic points out that it followed the procedure set forth in Fed. R. Civ. P. 8(c) and 12(b) which permits filing a motion to dismiss before an answer. After entry of the mandate in *Greenberg I*, National Geographic filed its answer within 20 days. Because Rule 12(a)(1) provides 20 days after service of the complaint to file an answer, National Geographic argues that its answer was timely.

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[10] Those defenses were (1) contractual authorization, (2) that the 1909 Act governs some of the photographs, (3) failure to state a claim and (4) laches and estoppel.

[11] In any event, the mandate of *Greenberg I* is moot in light of today's ruling.

Greenberg asserts that the answer is untimely, because when he first filed his complaint, defendants waited until 15 days after service of the complaint to request additional time to file their motion to dismiss. He argues that, therefore, only 5 days of the 20-day period to answer were tolled by the request for additional time, and any post-mandate answer would have to have been filed within 5 days to be timely. Greenberg cites no case that supports this proposition, and we find his position on timeliness meritless.

Under the Federal Rules, a defendant may file a motion under Rule 12 before filing an answer to a complaint. National Geographic followed the procedure set forth in the Federal Rules in making its motion to dismiss prior to filing an answer and should not have suffered the ultimate penalty of being precluded from presenting its other defenses to copyright liability for doing so. *See Tahoe-Sierra Pres. Council, Inc. v. Tahoe Reg'l Planning Agency*, 216 F.3d 764, 788 & n.45 (9th Cir. 2000), *aff'd*, 535 U.S. 302 (2002) (noting that a defendant need only present on a motion to dismiss those defenses that are susceptible to judgment on the pleadings, and may plead any other defenses in a later-filed answer). Regarding timeliness, National Geographic is correct that defendants have 20 days under the Federal Rules to file an answer after service of a complaint, although no time period is specified in the Federal Rules for filing an answer where a district court grants a pre-answer dispositive motion but an appellate court subsequently reverses.[12] Because National Geographic fol-

[12] The Rules do set forth a time to respond to a complaint in an analogous situation: where a district court denies a motion made under Rule 12, a defendant must answer within 10 days

lowed the procedures set forth in Rules 8 and 12, and because the Rules set no time limit for answering a complaint following a reversal of summary judgment, we hold that National Geographic's answer filed within 20 days after our mandate was timely. Accordingly, the district court's grant of the motion to strike the answer is vacated.

In light of today's holding that the Replica and Program portions of the CNG are privileged under § 201(c) and the fact that defendants have filed an answer with defenses that have not yet been adjudicated to the copyright claims concerning the Sequence, the willfulness verdict is also vacated.

IV. CONCLUSION

We conclude that the Supreme Court's decision in *Tasini* established a new framework for applying the § 201(c) privilege that effectively overrules the earlier panel decision in this case. Under the *Tasini* framework, we conclude that the Replica and Program portions of the CNG are privileged under § 201(c). We further conclude that the district court erred in striking defendants' answer and vacate that order. We also vacate the verdict of willful infringement and the damage award. The case is remanded to the district court for adjudication of the remaining claims and defenses.

REVERSED and REMANDED.

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after notice of the court's action. Fed. R. Civ. P. 12(a)(4)(A). Neither party discusses the applicability of Rule 12(a)(4)(A) here, and we have discovered no case that addresses the issue. Because the applicability of Rule 12(a)(4)(A) to an appellate court's reversal of a district court's grant of a Rule 12 motion is unclear, defendants should not be held to its 10-day time limit for filing an answer.

APPENDIX C

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF FLORIDA

CASE NO. 07-3924
CIV-LENARD/SIMONTON
CONSENT CASE

JERRY GREENBERG,
Plaintiff,

v.

NATIONAL GEOGRAPHIC SOCIETY,
NATIONAL GEOGRAPHIC ENTERPRISES, INC.
AND MINDSCAPE, INC.
Defendants.

FINAL JUDGMENT

Based upon the verdict of the jury, and this Court's Order on Motions for Judgment as a Matter of Law, Motion for Reduction In Jury Award, or in the Alternative for Remittitur, pursuant to Fed. R. Civ. P. 58, it is hereby

ORDERED AND ADJUDGED that JUDGMENT is hereby entered In favor of Plaintiff JERRY GREENBERG and against Defendants NATIONAL GEOGRAPHIC SOCIETY, NATIONAL GEOGRAPHIC ENTERPRISES and MINDSCAPE, INC., jointly and severally, In the amount of $80,000.00, and against Defendants NATIONAL GEOGRAPHIC SOCIETY and NATIONAL GEOGRAPHIC ENTERPRISES, jointly and severally, In the additional amount of $320.000.00, for a total judgment in the amount of $400,000.00 as to Defendants NATIONAL GEO-

GRAPHIC SOCIETY and NATIONAL GEOGRAPHIC ENTERPRISES, INC. and $80,000.00 as to Defendant MINDSCAPE, INC., for which sums let execution issue. The Court retains jurisdiction to consider a motion for attorneys' fees and costs.

DONE AND ORDERED in Miami, Florida, this 16th day of November, 2005.

/s/ Andrea M. Simonton
ANDREA M. SIMONTON
UNITED STATES MAGISTRATE JUDGE

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APPENDIX D

UNITED STATES COURT OF APPEALS,
ELEVENTH CIRCUIT

No. 00-10510

JERRY GREENBERG, IDAZ GREENBERG,
Plaintiffs-Appellants,

v.

NATIONAL GEOGRAPHIC SOCIETY, a District of Columbia Corporation, NATIONAL GEOGRAPHIC ENTERPRISES, INC., a corporation, MINDSCAPE, INC., a California corporation,
Defendants-Appellees.

Appeal from the United States District Court
for the Southern District of Florida.
(No. 97-03924-CV-JAL), Joan A. Lenard, Judge.

March 22, 2001.

Before ANDERSON, Chief Judge, and TJOFLAT and BIRCH, Circuit Judges.

BIRCH, Circuit Judge:

This appeal requires us, as a matter of first impression in this circuit, to construe the extent of the privilege afforded to the owner of a copyright in a collective work to reproduce and distribute the individual contributions to the collective work "as part of that particular collective work, any revision of that

collective work, and any later collective work in the same series" under 17 U.S.C. § 201(c).[1] In this copyright infringement case, the district court granted the defendants' motion for summary judgment, holding that the allegedly infringing work was a revision of a prior collective work that fell within the defendants' privilege under § 201(c). Because we find that the defendants' product is not merely a revision of the prior collective work but instead constitutes a new collective work that lies beyond the scope of § 201(c), we REVERSE.

I. BACKGROUND

The National Geographic Society ("Society") purports to be the world's largest nonprofit scientific and educational organization at approximately 9.5 million members, and is responsible for the publication of National Geographic Magazine ("Magazine"). Through National Geographic Enterprises, a wholly owned, for-profit subsidiary, the Society also produces television programs and computer software, along with other educational products. In order to acquire photographs for the Magazine and its other publications, the Society hires freelance photographers on an independent-contractor basis to complete specific assignments.

Jerry Greenberg is a photographer who completed four photographic assignments for the Society over the course of 30 years. Photographs from the first three assignments were published in the January 1962, February 1968, and May 1971 issues of the Magazine, respectively. The terms of Greenberg's

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[1] Hereafter, all references to statutory sections (" § ") will be to Title 17 of the United States Code, unless indicated otherwise.

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

In 1996, the Society, in collaboration with Mindscape, Inc., began the development of a product called "The Complete National Geographic" ("CNG"), which is a 30 CD-ROM library that collects every[2] issue of the Magazine from 1888 to 1996 in digital format. There are three components of the CNG that are relevant to this appeal: (1) the moving covers sequence ("Sequence"); (2) the digitally reproduced issues of the Magazine themselves ("Replica"); and (3) the computer program that serves as the storage re-

[2] The Society publishes multiple regional and international editions of each issue of the Magazine. These various editions differ from one another in the language in which they are written and the advertisements that are printed. The CNG includes only one representative edition of each issue.

pository and retrieval system for the images ("Program").

The Sequence is an animated clip that plays automatically when any disc from the CNG library is activated. The clip begins with the image of an actual cover of a past issue of the Magazine. This image, through the use of computer animation, overlappingly fades ("morphs") into the image of another cover, pauses on that cover for approximately one second, and then morphs into another cover image, and so on, until 10 different covers have been displayed. One of the cover images used in the moving covers sequence is a picture of a diver that was taken by Greenberg in 1961. The entire sequence lasts for 25 seconds, and is accompanied by music and sound effects.

The collected issues of the Magazine, which are, of course, the CNG's *raison d'être,* were converted to digital format through a process of scanning each cover and page of each issue into a computer. What the user of the CNG sees on his computer screen, therefore, 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. Every cover, article, advertisement, and photograph appears as it did in the original paper copy of the Magazine. The user can print out the image of any page of the Magazine, but 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.

The Program, which was created by Mindscape, is the element of the software that enables the user to select, view, and navigate through the digital "pages" of the Magazine Replica on the CD-ROM. In creating the Program for the CNG, Mindscape incorporated

two separate programs: the CD Author Development System ("CDA"), which is a search engine created by Dataware Technologies, Inc.; and the PicTools Development Kit ("PicTools"), which is a program for compressing and decompressing images that was created by Pegasus Imaging Corp.[3] The CNG package contains a "shrink-wrap" license agreement in which "all rights [in the Program] not expressly granted are reserved by Mindscape or its suppliers." Without the Program, the Replica could still be stored on a CD-ROM, but the individual "pages" of the Magazine would not be efficiently accessible to the user of the CNG.

Prior to placing the CNG on the market, the Society dispatched a letter to each person who had contributed to the Magazine. This letter informed the contributors about the CNG product and stated the Society's position that it would not provide the contributors with any additional compensation for the digital republication and use of their works. Greenberg contends that he responded to this notice through counsel and objected to the Society's use of

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[3] Mindscape indicates that it has not registered a claim of copyright in the Program, which is manifestly copyrightable. *See* §§ 101 (defining "computer program"), 102; *Montgomery v. Noga,* 168 F.3d 1282, 1288 (11th Cir.1999). However, copyright arises by operation of law upon fixation of an original work of authorship in a tangible medium of expression, which has clearly occurred in the case of the Program. *See* § 102; *Montgomery,* 168 F.3d at 1288. Moreover, Mindscape has represented to this court that two component elements of the Program, the CDA and PicTools, each of which are separately copyrightable computer programs, have been registered with the Copyright Office by Dataware Technologies, Inc., and Pegasus Imaging Corp., respectively. Because it consists of at least two other individually copyrighted works, the Program meets the definition of both a "compilation" and a "collective work" under § 101 of the Act.

his photographs in the CNG, but he received no response from the Society.

The Society sought registration for its claim of copyright for the CNG in 1998, but noted 1997 as the year of its completion. On the registration form,[4] the Society indicated that the "nature of authorship" included photographs, text, and an "introductory audiovisual montage." The Society claimed that the work had not been registered before, but indicated that it was a derivative work, namely a "compilation of pre-existing material primarily pictorial," to which a "brief introductory audiovisual montage" had been added. No reference was made to, nor was there any disclosure of, the copyrightable Mindscape Program or the two pre-existing, copyrightable sub-programs that it incorporates, all of which are also components of the CNG. The box in which the CNG is packaged and each individual CD-ROM bear the mark "© 1997 National Geographic Society"—indicating the creation of a new work of authorship in 1997.

Greenberg initiated an infringement action against the Society, National Geographic Enterprises, and Mindscape, alleging five counts of copyright infringement, two of which are relevant here: count "III" addressed the Society's reuse of Greenberg's photographs in the CNG, generally, and count "V" specifically addressed the use of his diver photograph in the Sequence. The Society, together with the two other defendants, moved for summary judgment on counts III-V, arguing that it had a privilege under § 201(c) to reproduce and distribute Greenberg's photo-

[4] A copy of the registration form (application), which when approved by the Copyright Office became the registration certificate, is attached hereto as Appendix A.

graphs in the CNG because it owned the copyright in the original issues of the Magazine in which the photographs appeared.[5] Greenberg filed a cross-motion for summary judgment on count III. The district court, relying on the district court opinion in *Tasini v. New York Times Co.*, 972 F.Supp. 804 (S.D.N.Y.1997), *rev'd* 206 F.3d 161 (2d Cir.2000), *cert. granted*, — U.S.—, 121 S.Ct. 425, 148 L.Ed.2d 434 (2000) (No. 00-201), held that the CNG constituted a "revision" of the paper copies of the Magazine that was within the Society's privilege under § 201(c), and accordingly granted summary judgment for all of the defendants on counts III-V. The district court later dismissed counts I and II, which did not relate to the CNG, at the parties' joint request. The Greenbergs appeal the district court's judgment only as to counts III and V.

II. DISCUSSION

To evaluate the claims of infringement leveled by Greenberg against the defendants,[6] we must inter-

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[5] There is no evidence in the record that would support the theory that National Geographic Enterprises or Mindscape, neither of which has a copyright interest in the original issues of the Magazine, somehow are privy to the privilege in § 201(c) enjoyed by the Society.

[6] In the Amended Complaint, Greenberg refers to Mindscape's and National Geographic Enterprises's liability as "at least vicarious." We construe this as an allegation of contributory copyright infringement. A contributory copyright infringer is "one who, with knowledge of the infringing activity, induces, causes or materially contributes to the infringing conduct of another." *Cable/Home Communication Corp. v. Network Prods., Inc.*, 902 F.2d 829, 845 (11th Cir.1990) (citations omitted). Accordingly, there can be no contributory infringement without a finding that there was direct copyright infringement by another party. *Id.*

pret and apply § 201(c) of the Act. That section constitutes the sole basis and defense of the Society's use of Greenberg's copyrighted photographs. In all cases involving copyright law, we understand that any interpretation and application of the statutory law must be consistent with the copyright clause of the United States Constitution; specifically, the eighth clause of the eighth section of Article I. That clause is a limitation, as well as a grant, of the copyright power.[7] The copyright clause, consisting of twenty-four words crafted by our founding fathers, is the Rosetta Stone for all statutory interpretation and

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Further, the CNG appears to be a "joint work," which is defined under § 101 as "a work prepared by two or more authors with the intention that their contributions be merged into inseparable or interdependent parts of a unitary whole." Here the two "authors," the Society and Mindscape ("authors" under the legal fiction created in § 201(b)), clearly intended their contributions of the Sequence, Replica, and Program to function and be presented as a unitary whole. The CNG also fits the definition of a "collective work" under § 101; that is, "a work ... in which a number of contributions, constituting separate and independent works in themselves, are assembled into a collective whole." The concept of the "collective work" is included within the term "compilation," which is defined in § 101 as "a work formed by the collection and assembling of preexisting materials ... that are selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes an original work of authorship." Whether the CNG is considered a "joint work" or a "collective work" makes no difference in our analysis because under each definition, a work results that is copyrightable as an entity separate and distinct from its constituent, pre-existing, separately copyrightable contributions.

[7] *See* Paul J. Heald and Suzanna Sherry, "Implied Limits on the Legislative Power: the Intellectual Property Clause as an Absolute Constraint on Congress," 2000 U. ILL. L.REV. 1119 (2000).

analysis. Accordingly, it is upon that predicate that we examine § 201(c) in the context of this case.[8]

The Society conceded that it has used Greenberg's photographs in a way that is inconsistent with his exclusive rights as an author under § 106.[9] However,

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[8] Appreciation of fundamental principles is required in all areas of the law, but is particularly important in the copyright arena. As observed by Professor L. Ray Patterson's opening remarks in his insightful article entitled "Understanding the Copyright Clause," 47 J. COPYRIGHT SOC'Y 365 (2000):

> Probably few industries as large as the copyright industry have rested on a legal foundation as slim as the twenty-four words of the copyright clause. And probably no foundation of comparable importance has been so little understood and so often ignored. This is all the more surprising because the components of the copyright industry-information/learning/entertainment-are so important to a free society, and because the history of the copyright clause is so well documented.

Id. at 365. The copyright clause provides: "The Congress shall have Power ... To promote the Progress of Science ... by securing for limited Times to Authors ... the exclusive Right to their ... Writings." U.S. CONST. art. I, § 8, cl. 8.

[9] Section 106 reserves to the owner of a copyright the rights:

> (1) to reproduce the copyrighted work in copies or phonorecords; (2) to prepare derivative works based upon the copyrighted work; (3) to distribute copies or phonorecords of the copyrighted work to the public by sale or other transfer of ownership, or by rental, lease, or lending; (4) in the case of literary, musical, dramatic, and choreographic works, pantomimes, and motion pictures and other audiovisual works, to perform the copyrighted work publicly; (5) in the case of literary, musical, dramatic, and choreographic works, pantomimes, and pictorial, graphic, or sculptural works, including the individual images of a motion picture or other audiovisual work, to display the copyrighted work publicly; and (6) in the case of sound recordings, to perform the copyrighted work publicly by means of a digital audio transmission.

the Society contends that it is privileged to make such use of the photographs under § 201(c), and therefore does not violate such exclusive rights and thus is not an infringer under § 501(a). Subpart "c" of § 201, entitled "Ownership of Copyright," provides:

> *(c) Contributions to Collective Works.*—Copyright in each separate contribution to a collective work is distinct from copyright in the collective work as a whole, and vests initially in the author of the contribution. In the 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.

In the context of this case, Greenberg is "the author of the contribution" (here each photograph is a contribution) and the Society is "the owner of copyright in the collective work" (here the Magazine). Note that the statute grants to the Society "only [a] privilege," not a right. Thus the statute's language contrasts the contributor's "copyright" and "any rights under it" with the publisher's "privilege." This is an important distinction that militates in favor of narrowly construing the publisher's privilege when balancing it against the constitutionally-secured rights of the author/contributor.

The Society argues that its use of Greenberg's photographs constitutes a "revision" of the Magazine ["that collective work"], referring to the CNG as the compendium of over 1,200 independent back issues; in copyright terms, a collective work of separate and distinct collective works, arranged in chronological

order.[10] Assuming *arguendo,* but expressly not deciding, that 201(c)'s revision privilege embraces the entirety of the Replica portion of the CNG (the 1,200 issues, as opposed to each separate issue of the Magazine), we are unable to stretch the phrase "that particular collective work" to encompass the Sequence and Program elements as well. In layman's terms, the instant product is in no sense a "revision." In this case we do not need to consult dictionaries or colloquial meanings to understand what is permitted under § 201(c). Congress in its legislative commentary spelled it out in the concluding paragraph of its discussion of § 201(c) (which is identical in both the Senate and House versions):[11]

> The basic presumption of section 201(c) is fully consistent with present law and practice, and represents a fair balancing of equities. At the same time, the last clause of the subsection, under which the privilege of republishing the contribution under certain limited circumstances would be presumed, is an essential counterpart of the basic presumption. Under the language of this clause a publishing company could reprint a contribution from one issue in a later issue of its magazine, and could reprint an article from a

[10] It does not satisfy the definition of "compilation" since inclusion of all issues of a publication in chronological order does not satisfy the minimum creativity necessary for the selection, coordination, or arrangement that would result in an original work of authorship. *See Warren Publ'g, Inc. v. Microdos Data Corp.,* 115 F.3d 1509, 1518-19 (11th Cir.1997) (*en banc*) (holding that work incorporating "entire relevant universe" did not exhibit sufficient creativity in selection to merit copyright protection as a compilation).

[11] A reproduction of the entire discussion in the House and Senate Reports is set out in Appendix B.

> 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.*

H.R.Rep. No. 94-1476, at 122-23 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5738 (emphasis added).

As discussed above, the CNG is an "other collective work" composed of the Sequence, the Replica, and the Program. However, common-sense copyright analysis compels the conclusion that the Society, in collaboration with Mindscape, has created a new product ("an original work of authorship"), in a new medium, for a new market that far transcends any privilege of revision or other mere reproduction envisioned in § 201(c).[12]

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[12] The Society characterizes this case as one in which there has merely been a republication of a preexisting work, without substantive change, in a new medium; specifically, digital format. As discussed in the text, however, this case is both factually and legally different than a media transformation. The Society analogizes the digitalization of the Magazine to the reproduction of the Magazine on microfilm and microfiche. While it is true that both the digital reproductions and the microfilm/microfiche reproductions require a mechanical device for viewing them, the critical difference, from a copyright perspective, is that the computer, as opposed to the machines used for viewing microfilm and microfiche, requires the interaction of a computer program in order to accomplish the useful reproduction involved with the new medium. These computer programs are themselves the subject matter of copyright, and may constitute original works of authorship, and thus present an additional dimension in the copyright analysis. Because this case involves not only the incorporation of a new computer program, but also the combination of the Sequence and the Replica, we need not decide in this case whether the addition of only the Program would result in the creation of a new collective work.

This analysis is totally consistent with the conduct of the Society when it registered its claim of copyright in the CNG (under the title "108 Years of National Geographic on CD-ROM"). Under section "5" of the copyright registration form, in response to the question: "Has registration for this work, or for an earlier version of this work, already been made in the Copyright Office?"; the Society replied, "No." Accordingly, this was a new work. Registrations had already been made relative to individual issues of the Magazine. Under section "6", subpart "a", the Society described the work (the CNG) as a "Compilation of pre-existing material primarily pictorial." Under section "6", subpart "b", which requested, "Material added to this work. Give a brief, general statement of the material that has been added to this work and in which copyright is claimed," the Society wrote "Brief introductory audiovisual montage." *See* Appendix A.[13] Thus, even the Society admitted that the registered work, the CNG, was a compilation. Recall that a collective work is included in the definition of compilation and embraces those works wherein its separate components are each themselves copyrightable-as are the Sequence, Replica, and Program (the "pre-existing materials" referred to in part [only the Replica was disclosed] by the Society in section "6".). Accordingly, in the words of the legislative report, "the publisher [the Society] could not ... include [the contribution

[13] 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.

(the photographs)] in a new anthology . . . or other collective work [the CNG]." Thus in creating a new work the Society forfeited any privilege that it *might*[14] have enjoyed with respect to only one component thereof, the Replica. With respect to the Sequence and its unauthorized use of Greenberg's diver photograph, we find that the Society has infringed upon the photographer's exclusive right under § 106(2) to prepare derivative works based upon his copyrighted photograph. The Society has selected ten preexisting works, photographs included in covers of ten issues of the Magazine, including Greenberg's, and transformed them into a moving visual sequence

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[14] We indicate *"might"* because a persuasive argument can be made that when the Replica portion of the CNG was converted from text and picture images on a page to electronic, digital format, the statutory definition of a "derivative work" was not satisfied. A "derivative work" is defined under § 101 as:

> a work based upon one or more preexisting works, such as a translation, musical arrangement, dramatization, fictionalization, motion picture version, sound recording, art reproduction, abridgment, condensation, *or any other form in which a work may be recast, transformed,* or adapted. A work consisting of editorial *revisions,* annotations, elaborations, or other modifications which, *as a whole,* represent an original work of authorship, is a "derivative work".

(Emphasis added). Note that in order to qualify as a derivative work, the resulting work (including "revisions") after transformation must qualify as an "original work of authorship." Thus, the mere electronic digital reproduction that represents the Replica may not qualify as a derivative work, and thus not violate Greenberg's exclusive right to prepare derivative works under § 106. *See supra* note 10. This derivative-works issue may be addressed by the Supreme Court in *Tasini v. New York Times Co.,* 972 F.Supp. 804 (S.D.N.Y.1997), *rev'd* 206 F.3d 161 (2d Cir.2000), *cert. granted,* — U.S. —, 121 S.Ct. 425, 148 L.Ed.2d 434 (2000) (No. 00-201). But here, as explained above, we have far more than a mere reproduction in another medium.

that morphs one into the other over a span of approximately 25 seconds. Moreover, the Society repositioned Greenberg's photograph from a horizontal presentation of the diver into a vertical presentation of that diver. Manifestly, this Sequence, an animated, transforming selection and arrangement of preexisting copyrighted photographs constitutes at once a compilation, collective work, and, with reference to the Greenberg photograph, a derivative work. *See Warren Publ'g,* 115 F.3d at 1515 n. 16.

The Society argues that its use of Greenberg's diver photograph was a fair use under § 107.[15] Guided by the principles explained in *Campbell v. Acuff-Rose Music, Inc.,* 510 U.S. 569, 114 S.Ct. 1164, 127 L.Ed.2d 500 (1994), [16] we find that the Society has neither a fair use defense or right. *See Bateman v. Mnemonics, Inc.,* 79 F.3d 1532, 1542 n. 22 (11th Cir.1996); David Nimmer, "An Odyssey through Copyright's Vicarious Defenses," 73 N.Y.U. L. REV. 162, 191 (1998). The use of the diver photograph far

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[15] Among the factors to be considered in determining whether a use of a copyrighted work is a "fair use" are:

(1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes;
(2) the nature of the copyrighted work;
(3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and
(4) the effect of the use upon the potential market for or value of the copyrighted work.

17 U.S.C. § 107.

[16] In Campbell, the Supreme Court indicated that the statutory factors in § 107 should not "be treated in isolation, one from another. All are to be explored, and the results weighed together, in light of the purposes of copyright." 510 U.S. at 578, 114 S.Ct. at 1170-71.

transcended a mere reprinting or borrowing of the work. As explained above, it became an integral part of a larger, new collective work. The use to which the diver photograph was put was clearly a transformative use. The Sequence reflects the transformation of the photograph as it is faded into and out of the preceding and following photographs (after having turned the horizontal diver onto a vertical axis). The Sequence also integrates the visual presentation with an audio presentation consisting of copyrightable music. The resultant moving and morphing visual creation transcends a use that is fair within the context of § 107. Moreover, while the CNG is a product that may serve educational purposes, it is marketed to the public at book stores, specialty stores, and over the Internet. The Society is a non-profit organization, but its subsidiary National Geographic Enterprises, which markets and distributes the CNG, is not; the sale of the CNG is clearly for profit. Finally, the inclusion of Greenberg's diver photograph in the Sequence has effectively diminished, if not extinguished, any opportunity Greenberg might have had to license the photograph to other potential users.[17]

Alternatively, the Society contends that its use of Greenberg's diver photograph, which appeared on the cover of the January 1962 issue of the Magazine, constitutes a *de minimis* use and thus is not actionable. We find no merit in that argument in the context of this derivative and collective work, the Sequence.

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[17] The inclusion by the Society of Greenberg's photograph in a newly copyrighted work, the Sequence, clearly indicates that the Society claims certain copyright rights in the photograph, with which potential licensees or assignees of the photograph would have to be concerned.

In assessing a *de minimis* defense, we must examine both the *quality* and *quantity* of the use.[18] Greenberg's photograph is one of ten selected and arranged by the Society and constitutes one-tenth of the entire Sequence; a pro-rata share. Thus, when comparing the entire work with the contribution at issue, it clearly represents a significant portion of the new work. This is particularly accentuated in a qualitative way when we consider that only ten covers from a universe of some 1200 covers of the Magazine, embracing 108 years of publication, were selected for this composition. Moreover, the instruction materials that accompany the CD-ROM discs inside the CNG product box refer to the Sequence as "The Complete National Geographic *icon*" (emphasis added). *[R1-20-Ex.A]*

Each and every time a user of the CNG views any of the 30 discs, the user views the Sequence-the projection of the Sequence is automatic without any prompting from the user. Thus, the use of the Sequence in the context of the entire CNG is not a *de minimis* use that fails to reach the threshold of actionable copyright infringement. The two cases principally relied upon by the Society, *Ringgold v. Black Entm't Television, Inc.*, 126 F.3d 70 (2d Cir.1997), and *Amsinck v. Columbia Pictures Indus., Inc.*, 862 F.Supp. 1044 (S.D.N.Y.1994), are not to the contrary. The "iconic" display at the beginning of each disc in the CNG product argues against the suggestion that

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[18] *See Horgan v. Macmillan, Inc.*, 789 F.2d 157, 162 (2d Cir.1986) ("Even a small amount of the original, if it is qualitatively significant, may be sufficient to be an infringement."); *Metro-Goldwyn-Mayer, Inc. v. American Honda Motor Co.*, 900 F.Supp. 1287, 1300 (C.D.Cal.1995) ("[T]he court must look to the quantitative and qualitative extent of the copying involved.").

the use of the Sequence in the CNG or the use of the Greenberg diver photograph in the Sequence is inconsequential. Accordingly, because we find the unauthorized use of the subject photograph to be both qualitatively and quantitatively significant, we reject the *de minimis* defense advanced by the Society and its putative co-infringers.

III. CONCLUSION

We conclude that the unauthorized use of the Greenberg photographs in the CNG compiled and authored by the Society constitutes copyright infringement that is not excused by the privilege afforded the Society under § 201(c). We also find that the unauthorized use of Greenberg's diver photograph in the derivative and collective work, the Sequence, compiled by the Society, constitutes copyright infringement, and that the proffered *de minimis* use defense is without merit. Upon remand, the court below is directed to enter judgment on these copyright claims in favor of Greenberg. Counsel for the appellant should submit its documented claims for attorneys fees relative to this appeal to the district court for review and approval. We find the appellant to be the prevailing party on this appeal and, therefore, is entitled to an award of costs and attorneys fees. Upon remand, the district court should ascertain the amount of damages and attorneys fees that are due as well as any injunctive relief that may be appropriate. In assessing the appropriateness of injunctive relief, we urge the court to consider alternatives, such as mandatory license fees, in lieu of foreclosing the public's computer-aided access to this educational and entertaining work.

REVERSED and REMANDED.

CA(01)1292-1,SIZE-1 PAGE,TYPE-DPI

CA(01)1292-2,SIZE-1 PAGE,TYPE-DPI

APPENDIX B

EXCERPT FROM H.R. 94-1476 (1976)

reprinted in 1976 U.S.C.C.A.N. 5659

Contributions to collective works

Subsection (c) of section 201 deals with the troublesome problem of ownership of copyright in contributions to collective works, and the relationship between copyright ownership in a contribution and in the collective work in which it appears. The first sentence establishes the basic principle that copyright in the individual contribution and copyright in the collective work as a whole are separate and distinct, and that the author of the contribution is, as in every other case, the first owner of copyright in it. Under the definitions in section 101, a "collective work" is a species of "compilation" and, by its nature, must involve the selection, assembly, and arrangement of "a number of contributions." Examples of "collective works" would ordinarily include periodical issues, anthologies, symposia, and collections of the discrete writings of the same authors, but not cases, such as a composition consisting of words and music, a work published with illustrations or front matter, or three one-act plays, where relatively few separate elements have been brought together. Unlike the contents of other types of "compilations," each of the contributions incorporated in a "collective work" must itself constitute a "separate and independent" work, therefore ruling out compilations of information or other uncopyrightable material and works published with

editorial revisions or annotations. Moreover, as noted above, there is a basic distinction between a "joint work," where the separate elements merge into a unified whole, and a "collective work," where they remain unintegrated and disparate.

The bill does nothing to change the rights of the owner of copyright in a collective work under the present law. These exclusive rights extend to the elements of compilation and editing that went into the collective work as a whole, as well as the contributions that were written for hire by employees of the owner of the collective work, and those copyrighted contributions that have been transferred in writing to the owner by their authors. However, one of the most significant aims of the bill is to clarify and improve the present confused and frequently unfair legal situation with respect to rights in contributions.

The second sentence of section 201(c), in conjunction with the provisions of section 404 dealing with copyright notice, will preserve the author's copyright in a contribution even if the contribution does not bear a separate notice in the author's name, and without requiring any unqualified transfer of rights to the owner of the collective work. This is coupled with a presumption that, unless there has been an express transfer of more, the owner of the collective work acquires "only the privilege of reproducing and distributing the contribution as part of that particular collective work, any revision of that collective work, and any later collective work in the same series."

The basic presumption of section 201(c) is fully consistent with present law and practice, and represents a fair balancing of equities. At the same time, the last clause of the subsection, under which the

privilege of republishing the contribution under certain limited circumstances would be presumed, is an essential counterpart of the basic presumption. Under the language of this clause 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 publisher could not revise the contribution itself or include it in a new anthology or an entirely different itself or include it in a new anthology or an entirely different magazine or other collective work.