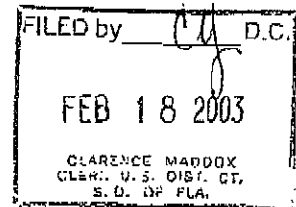


UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF FLORIDA

Case No. 97-3924-CIV-LENARD/SIMONTON



JERRY GREENBERG, individually

Plaintiff,

CONSENT CASE

v.

NATIONAL GEOGRAPHIC SOCIETY, et al.,
Defendants.ORDER ON CROSS-MOTIONS FOR PARTIAL SUMMARY JUDGMENT

Presently pending before this Court is Plaintiffs' Motion for Partial Summary Judgment as to Number of Works Infringed (DE #117, filed 4/22/02), and Defendants' Cross-Motion for Partial Summary Judgment as to Number of Works Infringed (DE #121, filed 5/6/02). Based upon the consent of the parties, these motions have been referred to the undersigned Magistrate Judge for disposition (DE #140). Defendants initially contended that Plaintiff's motion was premature since discovery was not completed. Therefore, following a hearing held on August 14, 2002, the undersigned entered an Order which deferred consideration of these motions, and permitted supplemental briefing. Following completion of the supplemental briefs, further argument was heard at the pretrial conference on February 5, 2003. At that hearing, the undersigned indicated a tentative decision that material issues of fact precluded the entry of partial summary judgment as to the number of works infringed. However, based upon the arguments presented by counsel, and a review of the record as a whole as well as the applicable caselaw, for the reasons stated below, the undersigned has concluded that the undisputed facts establish as a matter of law that the infringing photographs were included in four compilations, and therefore, for the purpose of computing statutory damages, the number of works infringed is four. Therefore, the Defendants' Motion for Partial Summary Judgment as to the number

of works infringed is **GRANTED**, and the jury shall be instructed that four works were infringed by the Defendants.

I. BACKGROUND

The relevant background facts are summarized in detail in the opinion of the Eleventh Circuit Court of Appeals which ruled as a matter of law that the Defendants had infringed the copyrights of the Plaintiff, and will not be repeated in this Order. Greenberg v. National Geographic Society, 244 F.3d 1267 (11th Cir. 2001). The issue that remains for determination is the remedy to which the Plaintiff is entitled. As stated by the Court of Appeals:

[T]he district court should ascertain the amount of damages and attorneys fees that are, if any, due as well as any injunctive relief that may be appropriate. In assessing the appropriateness of any injunctive relief, we urge the court to consider alternatives, such as mandatory license fees, in lieu of foreclosing the public's computer-aided access to this educational and entertaining work.

Id., at 1276.

II. CROSS MOTIONS FOR PARTIAL SUMMARY JUDGMENT

The Plaintiff (hereafter "Greenberg") and the Defendants (hereafter "National Geographic") agree that the determination of the number of works infringed may properly be resolved on motions for partial summary judgment. Greenberg contends that the undisputed facts establish that each photograph he took was a separate copyrighted work, and that since the Complete National Geographic ("CNG") contains 64 photographs within the four articles that were copied onto the CD-ROM library, plus the use of one of these photographs in an introductory "moving cover" sequence, he is entitled to a determination that there were 65 works infringed by the publication of the CNG. National Geographic, on the other hand, contends that since the 64 photographs were contained in four articles, and since the articles were compilations, under the terms of 17 U.S.C. § 504(c)(1), there were

only four works infringed. National Geographic contends, alternatively, that if the Court rules that the photographs were not contained in a compilation, there are material issues of fact regarding whether each photograph is a separate "work," that is, whether each photograph had independent economic value.

III. STANDARD FOR SUMMARY JUDGMENT

Rule 56(c) of the Federal Rules of Civil Procedure authorizes entry of summary judgment where the pleadings and supporting materials show that there is no genuine issue as to any material fact and that the moving party is entitled to judgment as a matter of law. Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 248 (1986); Denney v. City of Albany, 247 F.3d 1172, 1181 (11th Cir. 2001). Summary judgment is an integral part of the federal rules as a whole, which are designed to secure a just, speedy, and inexpensive determination of every action. Celotex Corp. v. Catrett, 477 U.S. 317 (1986). The court's focus in reviewing a motion for summary judgment is "whether the evidence presents a sufficient disagreement to require submission to a jury or whether it is so one-sided that one party must prevail as a matter of law." Allen v. Tyson Foods, Inc., 121 F.3d 642, 646 (11th Cir. 1997). In assessing whether the movant has met its burden, the courts should view the evidence and all factual inferences therefrom in the light most favorable to the party opposing the motion and all reasonable doubts about the facts should be resolved in favor of the non-movant. See Denney v. City of Albany, 247 F.3d at 1181. Ultimately, "[w]here the record taken as a whole could not lead a rational trier of fact to find for the non-moving party, there is no genuine issue for trial." Allen v. Tyson Foods, 121 F.3d at 646; accord Denney v. City of Albany, 247 F.3d at 1181.

IV. THE UNDISPUTED FACTS

Viewing the evidence and all inferences in the light most favorable to the Plaintiff, the

following material facts, are undisputed.

The Eleventh Circuit Court of Appeals provided the following concise statement of undisputed facts in its opinion which granted summary judgment on the issue of liability in favor of Greenberg:

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 [33 photos], February 1968 [11 photos], and May 1971 [8 photos] issues of the Magazine, respectively. The terms of Greenberg's employment for these assignments were set out in a series of relatively informal letters. Greenberg received compensation consisting of a daily fee, a fee based on the number of photographs published, and payment of expenses, and in return the Society acquired all rights in any photograph taken on the jobs that was ultimately selected for publication in the Magazine. In 1985, at Greenberg's request, the Society reassigned its copyrights in the pictures from these three jobs back to Greenberg. Greenberg's fourth hire for the Society appeared in the July 1990 issue [12 photos] of the Magazine, but the agreement for this job was more detailed than its predecessors. The principal 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 issue of the Magazine from 1888 to 1996 in digital format. There are three components of the CNG ... (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 repository 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 the 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 collected issues of the Magazine ... 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.

Greenberg v. National Geographic Society, 244 F.3d 1267, 1269 (11th Cir.), cert. denied, 534

U.S. 951 (2001).

In 1988, Greenberg filed a Certificate of Recordation with the United States Copyright Office to give public notice of the copyrights to the photographs taken in 1962, 1968 and 1971 (DE #119, Ex. B). Three certificates of renewal registration were subsequently filed (DE #119, Ex. E). The following information appears with respect to each of the three certificates:

Effective Date of Renewal Registration	Title of Work in Which Renewal is Claimed	Renewable Matter	Contribution to Periodical or Composite Work
12/29/89	National Geographic	photographs appearing on cover and pages 58 thru 89	Florida's Coral City Beneath the Sea. Key Largo Reef: America's First Undersea Park Vol. 121 No. 1 January, 1962
3/12/96	NATIONAL GEOGRAPHIC Sharks: Wolves of the Sea	photographs appearing on cover and on pages 222, 223, 225, 226, 227, 238, 240, 241, 251, 256 & 257	SHARKS: Wolves of the Sea. Vol. 133 No. 2 February, 1968
1/20/99	NATIONAL GEOGRAPHIC Buck Island - Underwater Jewel	photographs on pages 674-683	National Geographic Buck Island - Underwater Jewel Vol. 139 No. 5 May, 1971

With respect to the photographs appearing in the July 1990 issue of National Geographic, Greenberg filed a Certificate of Copyright Registration, effective July 27, 1990. He provided the following information on the form (DE #119, Ex. D): "Title of this Work: Florida's Coral Reefs are Imperiled;" "Nature of this Work: photographs." The form next states, "If this work was published as a contribution to a periodical, serial, or collection, give information about the collective work in which the contribution appeared." Greenberg listed the title of the collective work as "National Geographic Magazine," in "Vol. 178, No. 1, July, 1990, pgs. 114-132 + on assgnt." The nature of authorship was listed as "photographs on pages 114, 115, 118, 119, 120, 121, 122, 123, 126, 127, 130, 132 + On Assignm." With respect to the portion of the form relating to a description of a "Derivative Work or Compilation," Greenberg stated under "Preexisting Material:" "U/W panorama on pages 118, 119 & 120 originally appeared on pages 58 - 59 in January, 1962 edition Vol. 121, No. 1 issue of National Geographic Magazine; and stated under "Material Added to this Work:" - "Reconstruction of coral reef panorama in color and details on pages 118, 119, & 120 and additional new photographs listed at space 2."

Greenberg avers that after he received the rights to these photographs, he licensed the use of certain of the photographs to an advertising agency and a publisher, and that he has reprinted numerous of the photographs in books marketed though a company owned by Greenberg and his wife (DE #119, ¶ 12).

For purposes of this Order, the critical undisputed facts are that when each article was published, the photographs at issue were part of that article, each magazine was a compilation of articles, and National Geographic owned the copyright to each compilation. Thereafter, the copyrights to all the photographs were transferred from National Geographic to Greenberg. Following this transfer, National Geographic included copies of these articles

in the CD-ROM library known as the Complete National Geographic ("CNG"). In addition, one of the photographs was altered as part of the moving covers sequence, and therefore appears separately on the CD-ROM from the magazine in which it originally appeared, as well as appearing in the copy of that magazine. All copies made by the Defendants in this case were made from the articles.

IV. LEGAL ANALYSIS

Title 17, United States Code, Section 504(c), which governs the award of statutory damages for copyright infringement in this action, provides, in pertinent part:

[T]he copyright owner may elect ... to recover, instead of actual damages and profits, an award of statutory damages for all infringements involved in the action, with respect to any one work, for which any one infringer is liable individually, or for which any two or more infringers are liable jointly and severally, in a sum of not less than \$500 or more than \$20,000 as the court considers just. For the purposes of this subsection, all the parts of a compilation or derivative work constitute one work.¹

(Emphasis added).

The parties agree that each issue of the National Geographic magazine is a compilation.² The issue presented to this Court in the cross-motions for summary judgment is whether a compilation is considered "one work" where the owner of the copyright of a

¹ This subsection of the statute was amended in 1999 to increase the amount of the statutory award to a minimum of \$750 and a maximum of \$30,000.

² The Copyright Act, 17 U.S.C. § 101, contains the following relevant definitions:

"A 'compilation' is a work formed by the collection and assembling of preexisting materials or of data that are selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes an original work of authorship. The term 'compilation' includes collective works."

"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."

component part of that work sues the owner of the copyright of the compilation. The positions of the parties were clarified at oral argument. Greenberg argues that since he does not own the copyright to the compilation, but owns the copyrights only to the photographs contained within the compilation, he is not bound by the "one work" limitation. To support this statutory construction, Greenberg argues that the use of the word "copyright owner" at the beginning of the first sentence of this subsection, modifies the term "compilation or derivative work" in the second sentence, such that the "one work" limitation only applies where the copyright owner suing for infringement is the copyright owner of the compilation. Greenberg agrees, however, that if the defendants had copied an entire book of his photographs, as to which he owned the copyright to the book as well as the included photographs, he would be entitled to damages for the infringement of only one work. According to Greenberg's argument, the critical distinction is that National Geographic owns the copyright to the compilation, and thus could not be liable for infringement of the compilation, but only for infringement of the works contained therein. Thus, Greenberg contends that since National Geographic can only be liable for the infringement of the photographs, each photograph infringed is a separate work.³

National Geographic, on the other hand, argues that the statute clearly states that all parts of a compilation are considered one work, and it does not matter who owns the

³ Greenberg also argues that, as a matter of law, each photograph is a separate work since it was created separately and has independent economic value. National Geographic, on the other hand contends that if summary judgment is not granted with respect to the determination that each compilation is one work for the purpose of computing statutory damages, there are material issues of fact which preclude the determination that each photograph is a separate work. Although this issue need not be reached in view of the determination made in this Order, the undersigned concludes that summary judgment would not be appropriate on the issue of whether each photograph is a work, or whether, in view of the manner in which they were created and registered, there were still only four works, corresponding to the four copyright registrations.

copyright to the compilation. Since it is undisputed in this case that the infringing activity consisted of copying the compilation, National Geographic contends that all parts of the compilation owned by one copyright owner constitute only one work for purposes of computing statutory damages. Therefore, National Geographic contends that Greenberg is entitled to statutory damages for infringement with respect to four "works," rather than 64 individual photographs.

The language at issue was enacted in 1976 as part of the first major revision of federal copyright law since 1909. The House Report which accompanied the bill provides the following explanation of this provision:

Where the suit involves infringement of more than one separate and independent work, minimum statutory damages for each work must be awarded. For example, if one defendant has infringed three copyrighted works, the copyright owner is entitled to statutory damages of at least \$750 and may be awarded up to \$30,000. Subsection (c)(1) makes clear, however, that, although they are regarded as independent works for other purposes, "all the parts of a compilation or derivative work constitute one work" for this purpose. Moreover, although the minimum and maximum amounts are to be multiplied where multiple "works" are involved in the suit, the same is not true with respect to multiple copyrights, multiple owners, multiple exclusive rights, or multiple registrations. This point is especially important since, under a scheme of divisible copyright, it is possible to have the rights of a number of owners of separate "copyrights" in a single "work" infringed by one act of a defendant.

H.R. Rep. No. 94-1476 (1976), U. S. Code Cong. & Admin. News 1976, pp. 5659, 5778 (emphasis added).

There are no reported decisions construing the application of this section in the present context. There are numerous decisions, however which discuss the determination of when a group of items constitutes a compilation (or a collective work, which is included in the definition of a compilation). Thus, in MCA Television Ltd. v. Feltner, 89 F.3d 766 (11th Cir. 1996), cert. denied, 520 U.S. 1117 (1997), the Court held that each episode of a

syndicated television series was not a collective work. In reaching this result, the Eleventh Circuit first determined that the District Court did not err in determining that each episode had an independent economic value and was commercially viable, and thus qualified as a "work." The Court next determined that the television episodes were not a collective work since each episode in the series had an individual plot and the episodes were broadcast as a separate "works." In reaching this result, the Eleventh Circuit relied upon Twin Peaks Productions, Inc. v. Publications, Int'l, Ltd., 996 F.2d 1366 (2nd Cir. 1993), where the Second Circuit had reached this result with respect to each episode of a television series even though each succeeding episode continued a single plot line. Other cases have focused on whether the copyright owner intended to register individual works or intended to register a compilation. See, e.g., Costar Group, Inc. v. Loopnet, Inc., 164 F. Supp.2d 688, 709-712 (D. Md. 2001), and cases cited therein. The cases have uniformly held,⁴ however, that where a compilation was found to exist, statutory damages could be awarded for infringement of only one work. See, e.g., Costar Group, Inc., supra.; UMG Recordings, Inc. v. MP3.com, Inc., 109 F. Supp. 2d 223 (S.D.N.Y. 2000); Xoom, Inc. v. Imageline, Inc., 93 F. Supp. 2d 688, 692-93 (E.D. Va. 1999); Phillips v. Kidsoft, L.L.C., 1999 WL 813939, 52 U.S.P.Q.2d 1102, 1106-07 (D. Md. 1999); Stokes Seeds Ltd. v. Geo. W. Park Seed Co., 783 F. Supp. 104 (W.D.N.Y. 1991).

⁴ The one exception to this uniformity is Playboy Enterprises, Inc. v. Sanfilippo, 46 U.S.P.Q.2d 1350 (S.D. Cal. 1998), where the Court awarded damages based upon each image copied, and rejected the defendant's argument that he should only be liable for a singular violation with respect to all images which were included collectively in a particular magazine. The Court reasoned that each image represented "a singular and copyrightable effort concerning a particular model, photographer, and location," and the "fact that many of these images appeared together should not detract from the protection afforded to each individual effort." In addition, the Court noted that although they may have appeared in the same magazine, they were subject to re-use and redistribution individually, and that the defendant had marketed the images individually. In the case at bar, the photographs were the product of a single photographer, and the copy was made of the compilation, which was marketed as a compilation.

In the case at bar, it is undisputed that the photographs taken by the Plaintiff appeared in four magazine issues, and were taken as part of an assignment for each magazine. The act of infringement consisted of copying the prior compilations. Under these facts, and a clear reading of the statute, there were only four works infringed.⁵ It is therefore

ORDERED AND ADJUDGED that Plaintiffs' Motion for Partial Summary Judgment as to Number of Works Infringed (DE #117, filed 4/22/02), is **DENIED**. It is further

ORDERED AND ADJUDGED that Defendants' Cross-Motion for Partial Summary Judgment as to Number of Works Infringed (DE #121, filed 5/6/02) is **GRANTED**.

DONE AND ORDERED in Miami, Florida, this 18th day of February 2003.


 ANDREA M. SIMONTON
 UNITED STATES MAGISTRATE JUDGE

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⁵ Greenberg also argues that he is entitled to a separate statutory award of damages for the additional use of one of the photographs from one of the magazines in the moving covers sequence, since this was a derivative work. However, it was still part of the same compilation that was copied, and therefore, even though there is an alternative theory of liability, his statutory damage claim is limited to one work with respect to all the photographs contained in the particular magazine. See Walt Disney Co. v. Powell, 897 F.2d 565 (D.C. Cir. 1990).