

This is Jim Pickerel's article on his subscription website. The site has limited coverage, with about 450 paid subscribers. So, most of the photo-world and general public still has no idea what happened in Miami. Press coverage is still to come. But this is a start.

Fred

## GREENBERG WINS

March 8, 2003

### National Geographic Guilty Of Willful Infringement

On March 5, 2003 in the U.S. District Court in Miami a jury awarded Jerry Greenberg the maximum allowed by law of \$100,000 per infringement for four infringements (\$400,000) in this damages portion of his case against National Geographic Society for the unauthorized use of his images in the CD-ROM entitled "108 Years of National Geographic on CD-ROM". The 8 person jury also found that the infringement was "willful", which usually adds legal fees to the damages award.

Greenberg has 64 images that appear on the CD-ROM and they were part of four separate articles. During the trial for damages Judge Andrea Simonton ruled that under the copyright laws all the images in a given story would be treated as a single infringement rather than individual infringements. Thus, Greenberg had only 4 infringements, not 64. (This decision is questionable and appealable.)

In a statement after the verdict Mary Jeanne Jacobsen, spokesperson for National Geographic Society wrote, "National Geographic regrets and respectfully disagrees with the jury verdict in the Miami court regarding the National Geographic Society v. Jerry Greenberg. We published the electronic version of the archive of National Geographic Magazine as 'The Complete National Geographic on CD-ROM' in good faith and based on independent legal opinions that we had the legal rights to do so under the Copyright Law, and as interpreted by the United States Supreme Court in *Tasini v. The New York Times*. Based on this verdict and out of respect for the court, as of today we are directing that the 'Complete National Geographic on CD-ROM' will no longer be offered for sale until specific authority is obtained from an appropriate judicial authority. We believe that the public will be the loser, as this valuable educational archive will no longer be available to individuals,

libraries and schools. We look forward to arguing the motion to set aside the verdict, which is still pending with the trial judge in Miami, and will further pursue every legal remedy available to us."

It is difficult to see what grounds NGS will have to set aside the verdict.

The CD-ROM discs were initially released in September, 1997 and Greenberg filed suit against NGS in December. His case was heard in 2000 in Federal Court in Miami and he appealed that decision to the 11th Circuit Appeals Court in Atlanta. In March 2001 that court ruled that NGS had infringed Greenberg's copyright by using his photos in "108 Years of National Geographic on CD-ROM" and stated, "...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..." and also said that such copyright infringement "is not excused by the privilege afforded the Society under 201(c)" of the copyright law.

NGS first asked the Atlanta court to reconsider its decision, and that failed. NGS then asked the Supreme Court to hear the case, but in the fall of 2001 the Supreme Court refused to hear the case, which allowed the 11th Circuit Court decision to stand. The 11th Circuit then sent the case back to Miami for the purpose of assessing damages. Because the higher courts have already spoken on the issue it is difficult to see them being receptive to another appeal from NGS.

#### The Trial Revealed

# That to date there have been more than 1.4 million CD's sold and they have generated more than \$70 million in total revenue.

# That this product is not a single disc set. There are more than 100 different CD-ROM products that re-use material originally published in the National Geographic Magazines.

# Many of the senior staff at National Geographic had expressed opinions prior to the first release of the discs that NGS did not have the right to publish such a product without paying additional compensation to the photographers and authors. This, in fact, was exactly what two courts eventually found.

## Outside Counsel Expressed Concern

Geographic's outside counsel, Paul Kilmer and Mark Radcliffe had also warned of the financial risk of going forward with the project. In a letter dated February 21, 1997, Mr. Kilmer said Geographic might have to pay statutory damages to stock houses alone of up to \$16,290,000.

After reviewing 17 license agreements from stock houses giving National Geographic one-time use to stock images, Mr. Radcliffe said none of the agreements "would permit the use of the stock photographs in the archival CD-ROM or prior National Geographic issues" and he warned that failure to obtain permission from stock houses could lead to litigation.

## Future For Other Geographic Suppliers

While this decision is great news for all photographers, there are a few things that those who have had images published in the National Geographic Magazine should consider before they rush to jump on the bandwagon.

# Jerry Greenberg had registered his copyrights prior to the initial infringement. This gave him a much stronger legal position than those who have not registered their copyrights would have.

# There is a statute of limitations for filing an action of three years after the infringement takes place. (This has been interpreted as the first release of the discs.) That period has passed for CD108, which included the NGS issues from 1888 through 1996. But Geographic brought out a single CD109 (including 1997), CD110, which had 1888 through 1998, CD111 (including 1999), and CD112, which had 1888 through 2000. Testimony in Miami revealed that NGS is already at work on CD114, which was to include 1888 through 2002.

Photographers with rights should be able to claim infringements on any of the products that are no more than three years old. Because the products have been continually sold since their first release, it may be possible to claim that the three years is still running for packages that have been sold recently.

# Pictures that were published before 1978 when the copyright law was changed may fall under different rules than those made after 1978, particularly if those copyrights have not been registered. This was not an issue in the Greenberg case because he had registered copyrights from the 1960s into the 1990s.

Thus, while this case points out the importance of registering your copyrights and that copyrights can have value and are protected in the digital age, winning a copyright infringement suit is not short, easy, or inexpensive. Because of NGS costs, contracts, other agreements, and the lack of copyright registrations, the majority of those who have produced images for National Geographic Magazine over decades are unlikely to recover anything for this additional use Geographic made of their images.

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Subject: Pickerell's website article on Miami trial