

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF FLORIDA
Miami Division
CASE NO. 97-3924-CIV-LENARD-SIMONTON

JERRY GREENBERG, individually,
and IDAZ GREENBERG, individually,

Plaintiffs,

vs.

NATIONAL GEOGRAPHIC
SOCIETY, a District of Columbia
corporation, NATIONAL GEOGRAPHIC
ENTERPRISES, INC., a corporation,
and MINDSCAPE, INC., a
California corporation,

Defendants.

APRIL 19
2002

**MEMORANDUM IN SUPPORT OF
PLAINTIFFS' MOTION FOR PARTIAL SUMMARY
JUDGMENT AS TO NUMBER OF WORKS INFRINGED**

Plaintiffs, JERRY GREENBERG and IDAZ GREENBERG ("Greenberg"), submit this memorandum in support of their motion for partial summary judgment as to the number of "works" that were infringed by the defendants, NATIONAL GEOGRAPHIC SOCIETY, NATIONAL GEOGRAPHIC ENTERPRISES, INC., and MINDSCAPE, INC. ("the Society").

I. INTRODUCTION

In its Order entered on January 11, 2002, the Court found that “the appellate mandate does not permit reopening of the liability issues in this case.” Order at 5. Greenberg has filed a demand for a jury trial on an award of damages and a determination of willful infringement.¹

Because, as discussed below, Greenberg is exercising his option under the Copyright Act to seek statutory damages, a determination of those damages requires, among other things, a finding as to the number of works that were infringed by the defendants here. This motion for partial summary judgment asks the Court to determine as a matter of law that 65 separate “works” created by Greenberg were infringed.

II. STATEMENT OF UNDISPUTED MATERIAL FACTS

Greenberg’s Amended Complaint claimed infringement by the defendants of photographs, now owned entirely by him, that originally appeared in four separate articles in the Society’s monthly magazine.

A. The 1962, 1968 and 1971 Photographs

In 1985, the Society conveyed to Jerry Greenberg “all right, title and interest, including copyright” to photographs taken by him that had appeared in articles in the Society’s monthly magazine in 1962, 1968 and 1971. Greenberg Aff. ¶ 2.² In 1988, he filed a Certificate of

¹ A jury trial on statutory damages has been available to a plaintiff only since 1998. See Feltner v. Columbia Pictures Television, Inc., 118 S.Ct. 1279 (1998). A jury can determine whether the infringements were willful and the amount of an award of statutory damages. Columbia Pictures Industries, Inc. v. Krypton Broadcasting, 259 F.3d 1186 (9th Cir. 2001); Segrets, Inc. v. Gillman Knitwear Co., 207 F.3d 56 (1st Cir. 2000); Yurman Designs, Inc. v. PAJ, Inc., 93 F. Supp. 2d 449 (S.D.N.Y. 2000).

² An affidavit, with exhibits, executed by Jerry Greenberg on April 19, 2002 is being filed simultaneously with this memorandum.

Recordation with the U. S. Copyright Office to give public notice of his ownership of the copyrights encompassed in the 1985 conveyance. Id. Greenberg subsequently filed three certificates with the Copyright Office that sought renewal of copyrights covering the photographs in the 1962, 1968 and 1971 magazine articles. Greenberg Aff. ¶ 6.

The January 1962 issue of the Society's monthly magazine includes 33 separate photographs taken by Greenberg, the rights to all of which were conveyed to him in 1985. Greenberg Aff. ¶ 6. The number 33 does not include the cover photograph for that issue, which displayed a photograph included within the article in that issue. Id. The number 33 does include a composite panoramic view of the Carysfort Reef, which is counted as one photograph. Id.

The February 1968 issue of the Society's monthly magazine includes 11 separate photographs taken by Greenberg, the rights to all of which were conveyed to him in 1985. Greenberg Aff. ¶ 7. The number 11 does not include the cover photograph for that issue, which displayed a photograph included within the article in that issue. Id.

The May 1971 issue of the Society's monthly magazine includes 8 separate photographs taken by Greenberg, the rights to all of which were conveyed to him in 1985. Greenberg Aff. ¶ 9.

B. The 1990 Photographs

In 1989, the Society agreed to convey to Greenberg "all rights," with no reservation, to photographs taken by him for inclusion in an article that was to be published in the Society's monthly magazine in July of 1990. Greenberg Aff. ¶ 3. The 1989 agreement provided that all photographs by Greenberg pertaining to that article would be returned to him "along with all rights to said photographs." Id. All photographs, and thus all rights, were returned to Greenberg by July 1990. Id.

In July 1990, after all photographs had been returned, Greenberg filed with the Copyright Office a Certificate of Copyright Registration relating to photographs that appeared in that month's magazine. Greenberg Aff. ¶ 4. Where the form requested a description of the "nature of the material created by this author in which copyright is claimed," Greenberg inserted "photographs on pages 114, 115, 118, 119, 120, 121, 122, 123, 126, 127, 130, 132." Id. He intended registration only of those photographs. Id.

On the 1990 registration form is a reference to a "derivative work" -- a composite of three photographs that originally appeared in the January 1962 magazine article, and which consisted of an underwater panoramic view of the Carysfort Reef in the Pennekamp State Park, an underwater park. Greenberg Aff. ¶ 5. That panoramic view was re-printed by the Society in the July 1990 article. Greenberg did not know whether the panoramic view legally qualified as a derivative work. Id. On the same pages in the 1990 article appeared a single photograph, taken in 1989 from the same location as the 1962 composite, intended to show how the Carysfort Reef had disintegrated with time. Id. The "reconstruction" mention in box 6 of the 1990 registration referenced the single photograph taken in 1989, because the photograph reconstructed the 1962 view. Id.

Another comparative set of photographs, both showing the same view of the Molasses Reef, appeared on pages 121, 122 and 123 in the 1990 article. The first set was made by Greenberg in 1983, and the second was made by him in 1989. Id. Each set consisted of two photographs spliced into a panoramic view of the Molasses Reef. Id.

The July 1990 issue of the Society's monthly magazine includes 12 separate photographs taken by Greenberg, all of which were encompassed in the 1989 agreement transferring "all

rights” to the photographs to Greenberg. Greenberg Aff. ¶ 9. The number 12 includes two panoramic views of the Molasses Reef, each of which is counted as one photograph. Id. The number 12 does not include a panoramic view of the Carysfort Reef, which had been published originally in the January 1962 article and was re-printed in the July 1990 article. Id.

C. The Works Infringed by the Defendants

The Greenberg photographs published in the four magazine articles described above, and republished by the Society in the CD-ROM product without his consent, consisted of the following:

<u>January 1962</u>	<u>February 1968</u>	<u>May 1971</u>	<u>July 1990</u>
33 photos	11 photos	8 photos	12 photos

Those 64 photographs form the basis for Greenberg’s claim for statutory damages. One additional photograph should be added to bring the total to 65. That photograph, owned by Greenberg, appeared on the cover of the January 1962 issue and in 1997 was included by the Society in what has been called the Moving Covers Sequence within the Complete National Geographic CD-ROM. That additional photograph is discussed more fully below.

As discussed in the Argument section below, Greenberg seeks a ruling by the Court that 65 separate works were infringed by the defendants.

D. Greenberg’s Photographs Have Independent Economic Value

After rights to the photographs described above were returned to Greenberg, he had various opportunities to make other commercial use of the photographs, principally prior to the marketing of the CD-ROM product in 1997. He licensed the use of certain of the photographs to

an advertising agency and to a publisher, and was paid for such use. Greenberg Aff. ¶ 10. Greenberg and his wife, in marketing books through their own company, Seahawk Press, reprinted in their books numerous photographs among those discussed above. *Id.* Greenberg received other proposals for the use of various photographs among those published in the Society's magazine, but declined them.

III. ARGUMENT

A. The Principles of Statutory Damages

Where, as here, liability for copyright infringement has been found, the Copyright Act provides to the successful plaintiff optional paths to pursue damages. Greenberg has opted to seek statutory damages pursuant to the following language in the Act:

[T]he copyright owner may elect, at any time before final judgment is rendered, 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. . . . For the purposes of this subsection, all the parts of a compilation or derivative work constitute one work.

17 U.S.C. § 504(c)(1). “Copyright protection subsists . . . in original works of authorship fixed in any tangible medium of expression . . . from which they can be perceived, reproduced, or otherwise communicated . . .” 17 U.S.C. § 102(a).³ That section lists “pictorial, graphic, and sculptural works” as “works of authorship,” and photographs fall within the definition of

³ Copyright protection existed in each photograph at the moment Greenberg tripped the shutter on his camera, thereby fixing on film a creative work. Registration of the copyright did not create the copyright, which inheres at the moment of creation.

“pictorial, graphic, and sculptural works” that are copyrightable. 17 U.S.C. § 101. The House Report on section 504(c)(1) said as follows with respect to statutory damages:

A single infringer of a single work is liable for a single amount [of statutory damages] . . . no matter how many acts of infringement are involved in the action and regardless of whether the acts were separate, isolated or occurred in a related series Moreover, . . . the minimum and maximum amounts are to be multiplied where multiple ‘works’ are involved in the suit

H.R.Rep. No. 1476, 94th Cong., 2d Sess. at 162 (1976), U.S.Code Cong. & Admin. News 1976, pp. 5659, 5778.

B. Determining the Number of Works Infringed

The Eleventh Circuit established a test for this circuit for determining the number of works that can be counted for statutory damages. In MCA Television Ltd. v. Feltner, 89 F.3d 766, 769 (11th Cir. 1996), the Court adopted the rule followed in other circuits that separate copyrights are distinct “works” in the context of Section 504(c)(1) if they can “live their own copyright life,” quoting Gamma Audio & Video, Inc. v. Ean-Chea, 11 F.3d 1106, 1116-17 (1st Cir. 1993)(the test is whether each expression, or work, “has an independent economic value and is, in itself, viable”). The Court also cited for the same proposition to Walt Disney Co. v. Powell, 897 F.2d 565, 569 (D.C.Cir. 1990), and Robert Stigwood Group, Ltd. v. O’Reilly, 530 F.2d 1096, 1105 (2nd Cir. 1976). In Feltner the holding was that each episode in a television series could stand alone, if only because they could be rented separately at a video store and not as a series. Whether a particular episode actually was rented is not the test. “A distributor’s decision to sell or rent complete sets of a series to video stores in no way indicates that each episode in the series is unable to stand alone . . . [even if a customer] may never watch or rent all

of the episodes” Gamma Audio, 11 F.3d at 1117, quoted favorably by the Eleventh Circuit in Feltner, 89 F.3d at 769.

See also Twin Peaks Productions, Inc. v. Publications International, Ltd., 996 F.2d 1366, 1381 (2nd Cir. 1993), where the court held that “the author of eight scripts for eight television episodes is not limited to one award of statutory damages just because he or she can continue the plot line from one episode to the next and hold the viewers’ interest without furnishing a resolution.” Greenberg’s circumstance is much simpler than the issue in Twin Peaks. Greenberg’s photographs also can live their own copyright life, and indeed they do. Since acquiring all rights in the photographs that had appeared in various articles in the Society’s monthly magazine, Greenberg has licensed the use of various of those photographs to other publishers and has re-printed many of the photographs in books sold through his company, Seahawk Press. Greenberg’s affidavit indicates that he has had other inquiries, which he declined, regarding the commercial use of still other photographs at issue here.

Significantly, the Society itself ascribed independent value to a number of the Greenberg photographs. The Society chose to place on the cover of that issue a photograph showing a female diver swimming among corals. In 1997, the Society used that same photograph, with nine other cover photographs by other photographers, for inclusion in the Moving Cover Sequence. That sequence, held by the Eleventh Circuit to be an infringing new derivative work,⁴ was featured prominently on each of 30 discs in the Complete National Geographic CD-ROM product. In the Society’s 1968 article on sharks, the publisher chose to place on the cover of the issue one of the Greenberg photographs used to illustrate the shark story. In 1990, the Society

⁴ Greenberg v. National Geographic Society, 244 F.3d 1267, 1274 (11th Cir. 2001).

chose to republish a panoramic view of an underwater park that had been originally published in the January 1962 article.

C. Greenberg Obtained the Copyrights, and Preserved Them

On December 18, 1985, the Society transferred to Greenberg “all right, title and interest, including copyright” to specific photographs listed in the transfer document. The photographs had appeared in three separate articles published in the Society’s monthly magazine in 1962, 1968 and 1971. The transfer document identified the copyright registration number for each of the monthly issues in which the photographs had appeared.

In 1988, Greenberg filed a Certificate of Recordation with the Copyright Office, thus giving public notice of his ownership of the copyrights covered in the transfer document. Greenberg subsequently renewed the registration for all of the copyrights conveyed to him in the 1985 transfer.

When ownership of “all rights” reverted to Greenberg in 1990 for photographs appearing that year in the July issue of the Society’s magazine, he registered those copyrights with the Copyright Office.

The First Circuit, in Gamma Audio, rejected the district court’s conclusion that the use of one registration form to register multiple copyrights meant that the author considered the four television episodes involved there to be one work. “Under regulations promulgated by the Copyright Office, the copyrights in multiple works may be registered on a single form, and thus considered one work for the purposes of registration . . . while still qualifying as separate ‘works’ for purposes of awarding statutory damages.” 11 F.3d at 1117. (emphasis in original) (citation and footnote omitted). “As the legislative history to § 504(c)(1) makes clear, the number of

copyright registrations is not the unit of reference for determining the number of awards of statutory damages.” Id. at n. 8.

Because the Copyright Act expressly states that “all the parts of a compilation or derivative work constitute one work,” some courts have held that if a registration form shows that a compilation or derivative work is being registered, instead of individual photographs, the compilation or derivative work becomes one work only for purposes of statutory damages. See Costar Group, Inc. v. Loopnet, Inc., 164 F. Supp. 2d 688, 710-11 (D.Md. 2001). None of the forms filed by Greenberg with the Copyright Office attempted to register any derivative or collective work for the simple reason that Greenberg owned none. The photographs for which he seeks redress here were originally contributions to a collective work -- the Society’s monthly magazine -- in which Greenberg never had any ownership right or interest.

When Greenberg recorded the Society’s form conveying to him in 1985 all rights in his photographs that had appeared in three articles, the transfer form itself was attached in the public record to the Certificate of Recordation. The certificate and the transfer form plainly show that the only things being recorded were individual photographs. The renewal forms pertaining to those photographs, filed by Greenberg in 1989, 1996 and 1999, also explicitly state that the copyrights being renewed were for individual photographs -- not for compilations or derivative works.

The fourth Society article containing Greenberg photographs was published in July of 1990. In that same month, Greenberg filed a Certificate of Copyright Registration to protect the photograph copyrights conveyed to him by his 1989 agreement with the Society. In box 2 in the form, which asks the “nature of the material created by this author in which copyright is

claimed,” Greenberg said “photographs” and listed the pages in the magazine article on which they appeared. Greenberg did not register a compilation or a derivative work.⁵

In UMG Recordings, Inc. v. MP3.Com, Inc., 109 F.Supp.2d 223, 224 (S.D.N.Y. 2000), the plaintiffs complained of unlawful copying of their CDs, “implying that each such CD was the relevant ‘work’ unit” for statutory damages. Citing to the language in Section 504(c)(1) that all the parts of a compilation counts as one “work” for statutory damages, the court found that each CD was a compilation and that the individual songs on the CD could not be counted as a work.

Similarly, in Stokes Seeds Ltd. v. George W. Park Seed Co., Inc., 783 F.Supp. 104, 107-08 (W.D.N.Y. 1991), all of the 122 photographs at issue had been published by the plaintiff in two books. The plaintiff had sought copyright registration for each book, but did not obtain registration for the individual photographs. The court said that each book could count as one “work” for damages.

Greenberg’s situation is totally different. He did not register a compilation or derivative work. He did register each of the 64 individual photographs.

**D. The Court Should Find
That 65 Works, Not 64, Were Infringed**

Greenberg contends that each of the 64 photographs described in his affidavit that appear in the Complete National Geographic CD-ROM product constitutes a separate work, and that he is entitled to 64 separate awards of statutory damages for those works.

⁵ “Derivative work originality lies in the manner in which a pre-existing work is transformed” M.B. Nimmer & David Nimmer, NIMMER ON COPYRIGHT § 3.02. If the 1962 Carysfort Reef panorama was a derivative work, it still qualifies as a “work” for the purposes of this motion. Moreover, the panorama was not “transformed” in any way when it was republished in 1990.

One other “work” should be counted. Greenberg’s Amended Complaint sets out one claim for inclusion of his photographs in the Complete National Geographic CD-ROM product as a new collective work. It also sets out a claim for inclusion of a cover photograph he owns in a new derivative work, appearing within the CD-ROM product on each of 30 discs, that the Amended Complaint called the Moving Covers Sequence. The claims are separate, the facts for each claim are different, and the applicable principles of copyright law are different for each claim.

Section 504(c)(1) says: “A single infringer of a single work is liable for a single amount [of statutory damages] . . . no matter how many acts of infringement are involved in the action” (Emphasis added.) The two claims at issue here are separate causes of action. A cause of action is “a factual situation that entitles one person to obtain a remedy in court from another person.” BLACK’S LAW DICTIONARY, 7th ed. at page 214 (1999). Greenberg’s claim for infringement by the Society of one photograph in a derivative work could stand alone legally without respect to the outcome of his separate claim of infringement that involved republication of the 64 photographs in a new collective work.

Thus, the Court should find, to assist the jury in determining the amount of damages to be awarded, that 65 works created and owned by Greenberg were infringed.

IV. CONCLUSION

There being no genuine issue of material fact, the plaintiffs are entitled to partial summary judgment that the defendants infringed 65 works created and owned by Plaintiff, Jerry Greenberg.

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Certificate of Service

I hereby certify that a copy of the foregoing memorandum of law was served by mail on Edward Soto, Esq., Weil, Gotshal & Manges LLP, 701 Brickell Avenue, Suite 2100, Miami, FL 33131 and by Federal Express on Robert G. Sugarman, Esq., Weil, Gotshal & Manges LLP, 767 Fifth Avenue, New York NY 10153 this 19th day of April, 2002.



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