

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

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.

**PLAINTIFFS' MOTION TO STRIKE DEFENDANTS'
ANSWERS TO COUNTS III AND V OF THE AMENDED COMPLAINT;
ALTERNATIVELY, TO STRIKE ALL AFFIRMATIVE DEFENSES IN ANSWERS,
AND ACCOMPANYING MEMORANDUM OF LAW**

Plaintiffs, JERRY GREENBERG and IDAZ GREENBERG ("the Greenbergs"), move pursuant to Rule 12, Federal Rules of Civil Procedure, to strike the two separate answers to Counts III and V of the Amended Complaint, filed by the defendants on November 5, 2001, (a) as in conflict with the Eleventh Circuit's opinion in this case, or (b) in the alternative as untimely, or (c) in the alternative, to strike all affirmative defenses set forth in the answers as substantively or procedurally insufficient. Grounds for the motion are set forth in the Memorandum of Law that follows.

MEMORANDUM OF LAW

The Defendants, NATIONAL GEOGRAPHIC SOCIETY, NATIONAL GEOGRAPHIC ENTERPRISES, INC., and MINDSCAPE, INC. (collectively "the Society"), on November 5, 2001 served two sets of answers¹ to Counts III and V of the Amended Complaint.²

A. Introduction

This case commenced in December of 1997. Before filing an answer, the defendants served a motion to dismiss Counts III and V under Rule 12, alternatively a motion for summary judgment under Rule 56. This Court in time granted the motion for summary judgment, and the plaintiffs appealed.

On March 22, 2001, the Eleventh Circuit Court of Appeals reversed. Greenberg v. National Geographic Society, 244 F.3d 1267 (11th Cir. 2001). In its opinion that court said:

We conclude that the unauthorized use of the Greenberg photographs in the [Complete National Geographic] compiled and authored by the Society constitutes copyright infringement that is not excused by the privilege afforded the Society under § 201 (c). [Count III]. 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. [Count V]. 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. . . .

Id. at 1275-76.

¹ Defendants National Geographic Society and National Geographic Enterprises, Inc. filed a joint answer. Defendant Mindscape, Inc. filed its answer separately.

² The defendants previously answered Counts I and II of the Amended Complaint.

The appellate court thus found infringement, as alleged in Counts III and V, and found liability to exist. The remand instruction limits further proceedings in this Court to a review of Greenberg's claims for damages and attorneys' fees. "We have in this circuit a well-settled 'mandate rule' obligating district courts to adhere closely to the dictates of our opinions." Pelletier v. Zweifel, 987 F.2d 716, 717 (11th Cir. 1993).

A district court may not alter, amend, or examine the mandate, or give any further relief or review, but must enter an order in strict compliance with the mandate. The trial court must implement both the letter and the spirit of the mandate, taking into account the appellate court's opinion, and the circumstances it embraces. . . . [I]t is bound to follow the appellate court's holdings, both expressed and implied.

987 F.2d at 718. This Court should strike the answers and provide the plaintiffs with a fair opportunity to resolve the remaining issues as set forth the appellate court's opinion.

B. Although the Invocation of Rule 12 in 1998 Did Toll the Time, the Answers are Nonetheless Untimely

The Amended Complaint was served by hand on December 23, 1997. The response deadline, therefore, was January 13, 1998. A joint motion for an enlargement of time for the response, prepared by the defendants, was filed on January 8, 1998. Fifteen days of the response period thus had elapsed before the request for an enlargement was made. The enlargement motion, of course, tolled the remaining time. The defendants timely served a combined motion to dismiss or for summary judgment as to Counts III and V on January 30, 1998, but only five days remained for the service of an answer if the motion should be resolved adversely to the defendants.

That adverse resolution was effected when the Eleventh Circuit's mandate issued on October 16, 2001. The date on which the mandate is issued determines when a district court reacquires jurisdiction for further proceedings. See, e.g., U. S. v. Rivera, 844 F.2d 916, 921 (2d Cir. 1988). The clock started running on the defendants' response time, therefore, on October 16, 2001. They served their answers on November 5, 2001. The defendants had five days within which to serve a response; they served the response 20 days after issuance of the mandate. The defendants obviously believe that the clock started all over again on a 20-day period to answer, but nothing in the rules provides defendants with a second full bite at the apple.

Rule 6 reads in pertinent part as follows:

[T]he court for cause shown may at any time in its discretion (1) with or without motion or notice order the [response] period enlarged if request therefor is made before the expiration of the period originally prescribed . . . or (2) upon motion made after the expiration of the specified period permit the act to be done where the failure to act was the result of excusable neglect.

(Emphasis added). The rule thus requires that any enlargement after a deadline may be granted only pursuant to a motion. Here, the defendants made no request to the Court for an enlargement. In any event, the defendants had almost four years to contemplate the rules and the deadlines, so they hardly qualify for excusable neglect. The answers were untimely and should be stricken.³

³ Rule 12 (a) (4) provides that the service of a motion under that rule alters the 20-day response time provided in Rule 12, and specifies a 10-day response period after court action. In Brogie v. Mackay-Smith, 75 F.R.D. 739 (W.D.Va. 1977), the court applied that rule to a matter that had been reversed on appeal and remanded to the district court. The defendants, the court said, had 10 days from notification of the appellate action in which to file an answer. Here, the notice was the issuance of a mandate. The answers were filed outside a 10-day period.

C. Alternatively, the Affirmative Defenses Should be Stricken

The defendants have asserted four affirmative defenses to Counts III and V of the Amended Complaint. A motion to strike is a proper means to attack the legal sufficiency of a defense. EEOC v. First National Bank, 614 F.2d 1004, 1008 (5th Cir. 1980). The affirmative defenses are addressed separately below.

1. Failure to State a Claim

The first affirmative defense asserts that “plaintiffs have failed to state a claim on which relief may be granted.” The defense of failure to state a claim arises under Rule 12 (b) (6). Under such a defense the plaintiffs’ factual allegations are taken as true. Hooper v. Ronwin, 104 S.Ct. 1989 (1984). The issue of validity is thus purely one of law.

It is ludicrous for the defendants to assert such a defense when Counts III and V have been addressed in this Court on the defendants’ motion for summary judgment, when a court of appeals held that copyright infringement had occurred pursuant to those counts, and when the appellate outcome has been considered for review by the Supreme Court.

Such a pleading is an abuse of the rules. The asserted defense should be stricken.

2. Republication Pursuant to Contract

The second affirmative defense asserts that “the Society is permitted to reproduce plaintiffs’ images pursuant to contract with Mr. Greenberg.”

All contracts relevant to the allegations in the Amended Complaint were placed in the appellate record at the specific behest of the Eleventh Circuit Court of Appeals. It is true that a motion to strike cannot be granted if an affirmative defense involves disputed issues of fact. U.

S. v. Martell, 844 F.Supp. 454 (N.D. Ind. 1994). The only relevant facts here are the contracts themselves, and they are unchallenged in the record.

The Greenberg photographs at issue in this action appeared in four separate articles published in the Society's monthly magazine. Those articles were published in 1962, 1968, 1971 and 1990.⁴ Those facts are not disputed. On December 18, 1985, the Society assigned to Greenberg "all right, title and interest, including copyright" to photographs appearing in the first three articles. That transfer document is attached hereto as Exhibit A. The contract covering photographs in the fourth article is attached hereto as Exhibit B. That agreement provided that "all rights, including the copyright and world publication rights" to the photographs would initially vest in the Society, but that "all rights" to the photographs would be "returned to [Greenberg]" after publication in the monthly magazine.

None of the facts set forth above are disputed, and the affirmative defense turns on a question of law. As to the first three articles, whatever rights the Society may have originally obtained under a contract were transferred away in 1985. The transfer document specifies "all right, title and interest, including copyright . . . ," which clearly embodied any contract right that may have existed. The contract executed in 1989 similarly conveyed back to Greenberg, after publication, "all rights" to the photographs published in the 1990 article. The documents could not be more clear. Those documents provide Greenberg's sole basis to bring this copyright action as to Counts III and V, and that basis has not been challenged in almost four years of litigation. As a matter of law the affirmative defense must fail.

⁴ See Exhibit B to Plaintiffs' Memorandum in Response to Defendants' Motion to Dismiss Count II and to Dismiss or for Summary Judgment on Counts III-V of Plaintiffs' Amended Complaint. (D.E. #25)

3. Barred by Laches Doctrine

The third affirmative defense asserts that “the plaintiffs’ claims are barred by the doctrine of laches.”

Such a defense proposes that the plaintiffs sat on their rights too long. The record shows that Greenberg’s counsel wrote to the Society before the disputed CD-ROM product reached the market to protest that the product would include his copyrighted works without his consent, and that the Society never responded to the notice letter.⁵ Greenberg thus asserted his rights even before the product went on sale. *Laches?* The record also is clear that the product was placed on the market in the latter half of 1997. See Exhibit B to the defendants’ motion for summary judgment (D.E. #19). The Greenbergs filed their original complaint on December 5, 1997. (D.E. #1). Such a lapse in time cannot trigger a laches defense. See Roulo v. Russ Berrie & Co., Inc., 886 F.2d 931, 942 (7th Cir. 1989), cert. denied, 493 U. S. 1075 (1990) (two-year delay in filing action following knowledge of infringement “has rarely been held sufficient to constitute laches”). The asserted defense is spurious and should be stricken.

Estoppel

The fourth affirmative defense is that “the plaintiffs are estopped from asserting their claims.” The defense gives no notice to the plaintiffs of what it is about.

Affirmative defenses are pleadings and are subject to all pleading requirements of the rules of procedure. Heller Financial, Inc. v. Midwhey Powder Co., Inc., 883 F.2d 1286, 1294 (7th Cir. 1989). Accordingly, the defendants must set forth a short and plain statement of the defense.

⁵ See Exhibit D to the plaintiffs’ memorandum referenced in footnote 3, supra.

Id. Bare bones conclusory allegations will not suffice. 883 F.2d at 1295. A short and plain statement of facts, and the elements of a defense, must be stated. Id.

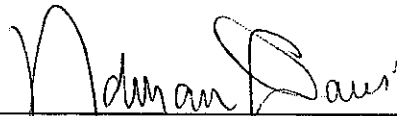
The defendants merely shout “estoppel” and walk away. The law of estoppel has variants, and the plaintiffs cannot know how to challenge such a defense when it is nothing more than “bare bones” and conclusory. The defense is legally invalid as stated and should be stricken.

D. Conclusion

The defendants seek in their answers and affirmative defenses only to prolong litigation that very soon will be four years old. The plaintiffs are prejudiced by having to address such shallow allegations. The Court should strike the answers, or the affirmative defenses, and allow the case to proceed to a determination of damages and attorneys’ fees.

Respectfully submitted,

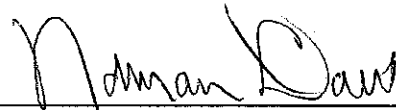
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CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing plaintiffs' motion and memorandum was served by mail on Edward Soto, Weil, Gotshal & Manges, LLP, 701 Brickell Avenue Boulevard, Suite 2100, Miami, Florida 33131; and via Federal Express on Robert G. Sugarman, Weil, Gotshal & Manges, LLP, 767 Fifth Avenue, New York, New York 10153, this 13th day of November, 2001.

A handwritten signature in cursive script that reads "Norman Davis". The signature is written in black ink and is positioned above a horizontal line.

Norman Davis



RECYCLED PAPER



National Geographic Society

WASHINGTON, D. C. 20036

SUZANNE DUPRÉ
CORPORATE COUNSEL

December 18, 1985

Mr. Jerry Greenberg
SEAHAWK PRESS
6840 SW 92nd Street
Miami, Florida 33156

Dear Mr. Greenberg:

In reply to your letter of November 15th to Mr. Garrett, the National Geographic Society hereby assigns to you all right, title and interest, including copyright, in your photographs appearing in National Geographic Magazine, as follows:

-- January, 1962
Vol. 121, No. 1

Photos on cover and
pages 58 through 89

Registration No. B-960824
Date: March 22, 1962

-- February, 1968
Vol. 133, No. 2

Photos on cover and pages 222-223, 225,
226-227, 238, 240-241 and 251

Registration No. B-402772
Date: January 31, 1968

-- May, 1971
Vol. 139, No. 5

Photos on pages 674 through 683

Registration No. B-701984
Date: July 15, 1971

District of Columbia

Subscribed and sworn to before

me this 18TH day of

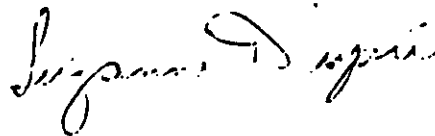
DECEMBER 1985

Jessie R. Bennett

Notary Public
WASHINGTON, D. C.

My Commission Expires January 31, 1988

Sincerely yours,



cc: W. E. Garrett, Editor

EXHIBIT A



RECYCLED PAPER



National Geographic Magazine

WASHINGTON, D. C. 20036

June 14, 1989

KENT J. KOBERSTEEN
Assistant Director of Photography

Mr. Jerry Greenberg
6840 S.W. 92nd Street
Miami, FL 33156

Dear Jerry:

This letter, when signed by both parties, will constitute your agreement as a freelance photographer with the National Geographic Society ("NGS") to photograph Pennakamp Reef Park (#05738) for National Geographic Magazine.

1) This assignment will extend for 20 days. Your compensation will be at the rate of:

(a) \$350 per day for days spent shooting or in field research (i.e., research directly germane to producing the coverage); and

(b) one half of the above rate per day for days spent in travel (including arranging or waiting for travel); on standby, in the field or elsewhere; or in consulting with NGS editors ("editorial days").

2) Your compensation is subject to the following provisions:

(a) Work beyond the anticipated assignment days mentioned above will be compensated at the same daily rates as above. Should it become necessary to extend this assignment for additional days, you must get authorization to do so from the Director of Photography, the Assistant Director of Photography or the Illustrations Editor assigned to the project.

(b) The total compensation paid to you for this assignment will be applied against the page rate of \$300 a page for the National Geographic Magazine, or a minimum of \$100 a transparency, whichever is greater.

3) When working for NGS, you will carefully avoid doing similar work for publications which NGS would consider to be editorially competitive with it. You will advise NGS promptly of any possible conflict of interest that may develop. You also will take care not to grant any prepublication interviews or assist in any way in the preparation of any prepublication articles or other press coverage in any medium which would reveal the subject matter, editorial content or the scheduling of an assignment, article or story for the National Geographic Society.

Mr. Jerry Greenberg
(Pennekamp Reef Park/#05738)

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June 14, 1989

4) By this Agreement you warrant to NGS that publication of any photographs taken by you on this assignment will not infringe upon any right of privacy, copyright or any other proprietary right of a third party.

5) All photographs taken by you under this Agreement will be considered as specially commissioned for use by NGS and upon creation all rights, including the copyright and world publication rights, to these photographs will automatically, by virtue of this Agreement, be deemed transferred exclusively and indefinitely to NGS, subject to the following provisions:

(a) all photographs will be returned to you along with all rights to said photographs under the following conditions: (i) none may be made available to anyone for publication until sixty days after NGS has published its selections; (ii) it is understood that any necessary rights clearance or release for non-NGS publication is your independent responsibility; and (iii) NGS may make and retain copies of some of the photographs ("reference selects") for reference purposes only in its Illustrations Library;

(b) you grant to NGS without additional charge the right to use your name, likeness and biographical material in connection with the publication of any photographs retained by NGS under this Agreement;

(c) NGS may crop your photographs.

6) You undertake all work under this Agreement as an independent contractor. NGS assumes no responsibility for your health, safety or property or that of any person accompanying or assisting you. While on assignment in the field you will be covered by NGS's accident insurance policy, which provides a payment of \$200,000 to you in the event of total disability or to your beneficiary, specified below, in the event of death, and lesser coverage for other injuries. The policy also provides up to \$10,000 for excess medical coverage, i.e. for costs beyond those covered by your own personal accident and health coverages. The above coverage is restricted to you alone.

7) While you are on NGS assignment, NGS will pay or reimburse you for all reasonable expenses and will supply you with film and processing. At the close of this assignment you will provide NGS with a diary of your activities while on assignment, including an accurate and complete record of the people and places represented in your photographs. A final accounting of expenses, supplies, etc. for an assignment will be due to NGS no later than two weeks after the work on that assignment is finished. Failure to reconcile expense/supply accounts with NGS in a timely manner may impede payment of fees.

8) Your work on this assignment will not be considered complete until so indicated by the Illustrations Editor. At the end of the assignment you will deliver to NGS all photographs you have taken on this assignment as well as complete captions for your photographs. You will be available for a projection session with the editor to explain your work. If you are

Mr. Jerry Greenberg
(Pennekamp Reef Park/#05738)

June 14, 1989

called back for editorial consultation, you will be paid a fee of \$175 per day plus expenses.

9) This agreement cannot be modified except by written instrument signed by both of us.

If the foregoing is acceptable, please sign and return the enclosed copy of the Agreement to me.

Sincerely yours,
NATIONAL GEOGRAPHIC SOCIETY

By

Kent J. Kobersteen
Kent J. Kobersteen

Agreed to and Accepted:

Jerry Greenberg
Name
JUNE 14th 89
Date
431-523-822

Social Security/
Federal ID#

JERRY GREENBERG

Check to be Written
to the Order of

© JERRY GREENBERG

Credit Line to read

ALL RIGHTS RESERVED

IDA2 GREENBERG

Insurance Beneficiary

WIFE

Relationship to you

6840 SW 92 ST

MIAMI, FL. 33156

Address

(For NGS records):

Executed copy received:

Date

KJK/mac