

Docket No. 00-10510-C

IN THE
UNITED STATES COURT OF APPEALS
ELEVENTH JUDICIAL CIRCUIT

JERRY GREENBERG and IDAZ GREENBERG,
Plaintiffs/Appellants

vs.

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

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

RESPONSE BY *AMICUS CURIAE*
THE AMERICAN ASSOCIATION OF MEDIA PHOTOGRAPHERS, INC.
TO THIS COURT'S OCTOBER 26, 2000 MEMORANDUM

Patricia A. Felch, on behalf of *amicus curiae*:
Ill. Bar No. 6196329
BANNER & WITCOFF, LTD.
Ten So. Wacker Drive, Suite 3000
Chicago, IL 60606-7407
(312) 715-1000 (phone)
(312) 715-1234
felch@bannerwitcoff.com

Victor S. Perlman, General Counsel
AMERICAN SOCIETY OF
MEDIA PHOTOGRAPHERS, INC.
150 North Second St.
Philadelphia, PA 19106-1912
(215) 451-2767
(215) 451-0880
perlman@asmp.org

Attorneys for *Amicus Curiae*

Greenberg v. National Geographic, Docket No. 00-10510-C
Certificate of Interest and
Corporate Disclosure Statement

Trial Judge:

The Honorable Joan A. Lenard

Attorneys:

Norman Davis
Steel, Hector & Davis, LLP
200 S. Biscayne Blvd.
Miami, FL 33131-2398
Counsel for Plaintiffs-Appellants

Robert G. Sugarman
Weil, Gotshal & Manges, LLP
767 Fifth Avenue
New York, NY 10153
Counsel for Defendants-Appellees

Patricia A. Felch, on behalf of *amicus curiae*: Victor S. Perlman, General Counsel
Banner & Witcoff, Ltd. American Society of Media Photo-
Ten So. Wacker Dr., Suite 3000 graphers, Inc.
Chicago, IL 60606-7407 150 North Second St.
Philadelphia, PA 19106-1912

Attorneys for Amicus Curiae


The *Amicus Curiae* has no parent companies, no subsidiaries and no affiliates that have issued shares to the public.

Joseph M. Beck
Sara K. Stadler
Kilpatrick Stockton LLP
Suite 8200, 1100 Peach Tree Street, N.E.
Atlanta, GA 30309

*Attorneys for Amici Curiae, Magazine Publishers of America, Inc.,
Newspaper Association of America, Inc., Gannett Co., Inc., Hachette Filipfachi
Magazines, Inc., The New York Times Company, Time, Inc., Times Mirror Co., and
Tribune Companys*

Plaintiffs:

Jerry Greenberg
Idaz Greenberg



Patricia A. Felch

Defendants:

National Geographic Society
National Geographic Enterprises, Inc.
Mindscape, Inc.

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STATEMENT OF INTEREST

The organization supporting this *amicus curiae* brief is:

The American Society of Media Photographers, Inc.

The American Society of Media Photographers, Inc., or ASMP, was founded in 1944 as the Society of Magazine Photographers. Its primary mission is to protect and promote the interests of professional photographers who earn their livings by making photographs for publication. ASMP is the largest organization in this country, or in the world, representing professional photographers who make photographs for publication in the various media. ASMP has approximately 6,000 members, most of whom are freelance photographers, who have been producing some of this country's best photography for publishers, advertising agencies and corporate clients for more than half a century. We estimate that there are over 100,000 freelance photographers with interests similar to those of our members in this country.

ARGUMENT

This Court has directed both the parties and their *amicus curiae* to address two issues: (1) the meaning of the prohibitory language in the last sentence of Section 201(c)'s legislative history; and (2) whether the 108 Years of the National Geographic Society CD-ROM set is a completely new product, in a new medium for a new market outside the reach of Section 201(c). The *Amicus Curiae*, the American Society of Media Photographers, Inc. (hereinafter referred to as ASMP *Amicus*), respectfully adopts the legal arguments articulated by counsel for the plaintiffs. Additionally, the ASMP *Amicus*, as is its responsibility, discusses the public-policy and industry-practice ramifications of plaintiffs' arguments.

I. THE LEGISLATIVE HISTORY LIMITS WHAT PUBLISHERS WERE PRESUMPTIVELY PRIVILEGED TO DO WITH AUTHORS' CONTRIBUTIONS TO COLLECTIVE WORKS UNDER THE STATUTORY LANGUAGE OF SECTION 201(c).

Excerpts of Section 201(c)'s legislative history have been provided to this Court in Appendix A (hereinafter referred to as "App." with the applicable page number) of the ASMP *Amicus* brief. Throughout the excerpts, it is clear that representatives of both the publishers and authors were concerned about ambiguities regarding "revision" rights of publishers. As early in the drafting process as 1962, authors' representatives argued that a publisher should obtain only a privilege of publishing a contribution in a particular collective work. In an attempt to accept that

argument, the the Register of Copyrights, Barbara Ringer, suggested that the publishers' presumptive privileges be limited to:

hold[ing] in trust for the author all rights in the author's contribution, except the right to publish [the contribution] in a similar [collective work], and any other rights expressly assigned. App. at 2.

That "similar [collective work]" language was strongly contested by authors' representatives until a recording industry representative, Sydney A. Diamond recommended that the "similar" be deleted and that the language be changed to "that particular collective work". App. at 4. Indeed, the 1963 bill limited publishers to:

only the privilege of publishing the contribution in that particular collective work. App. at 5.

During the 1963 debates, Bella Linden, a publisher's representative, questioned such a limitation:

The addition of the word "particular" raises in my mind the question as to whether revisions of that collective work would be "that particular work" -- whether a volume containing only half of the materials in "that particular collective work" would therefore be excluded. App. at 7.

She received no response. Id.

Instead, authors' representative, Irwin Karp, noted the custom and practice of the periodical publishing industry in which:

[e]very reputable publisher that I know of willingly reassigns to the author, immediately after publication of

the periodical, all rights except first periodical or first serial rights. App. at. 8.

Despite the lack of debate on Ms. Linden's question, the 1964 draft of Section 201(c) concluded with publishers' presumptive privileges being limited to:

reproducing and distributing the contribution as part of that particular collective work and any revisions of it. App. at 8

Publishers' representatives argued that the "any revisions to it" language was necessary in order to take into account the custom of publishers' republishing contributions in other issues of the same periodical and in encyclopedias. App. at 9. Harriet Pilpel, however, characterized the suggested language as an "ambiguity", in that it could be construed to allow publishers to "revise" the contribution itself, which she argued was not and should not be the law. App. at 10.

It is only after these years of debate, circling around the ambiguities inherent in words like "similar" and "revision", that the Copyright Office's final version of Section 210(c) was drafted in 1965:

In the absence of an express transfer of 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 [author's] contribution as part of that particular collective work, any revisions of that collective work, and any later collective work in the same series. App. at. 11.

The 1965 commentary by the Copyright Office further limited the reach of those three presumptive privileges, as follows:

However, the privileges under the presumption 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. App. at 12.

Still more debates ensued. The 1966 House Report reflected further qualifications and examples of what publishers were, and were not, permitted to do with authors' contributions to collective works:

Under the language which has been retained, a publisher could reprint a contribution from one issue in a later issue of his magazine, or could reprint an article from a 1970 edition of an encyclopedia in a 1980 revisions of it; he could not revise the contribution itself or include it in a new anthology or an entirely different magazine or other collective work. App. at 13.

Finally, the 1976 House Report reworded the legislative history prohibitions to be gender-neutral, concluding with the language identified for discussion by this Court:

[t]he **publisher could not** revise the contribution itself or **include it** [the contribution] **in a new** anthology or entirely different magazine or other **collective work**. App. at 15 (emphasis added by this Court).

It is only with this more in-depth look at the debates and gradual re-wording of the statute and its congressional reports that we learn three very important lessons:

(1) the publishing industry customs and practices that the amended Copyright Act were supposed to alter or confirm; (2) the sources of the house report's exemplifications and prohibitions; and, most importantly, (3) what Congress intended.

Jerry Greenberg's dealings with the Society¹ track Irwin Karp's testimony about the customs and practices of periodical publishers completely. See, App. at 8. Three sets of Greenberg's photographs were created and sold to the Society under the provisions of the 1909 Copyright Act (when copyrights were indivisible and bundled such that the sale of one right ceded all rights). In 1985, the Society reassigned "any and all rights, including copyright" in and to the first three sets of Greenberg contributions to Greenberg. See, Plaintiff's Affidavit. The fourth set of Greenberg's photographs was sold to the Society under the 1976 Copyright Act (which revoked indivisibility and bundling). In 1989, Greenberg and the Society entered into a written agreement on the fourth set of his photographs, whereby the Society agreed to revert all rights automatically to Greenberg after its first publication of the fourth set in the magazine. Id. That is what Professor Karp said was the custom and practice, and that is what happened in this case.

Although the first versions of Section 201(c) contemplated only a freelancer's

¹ The term, "Society", is intended to include all three defendants.

conveyance of a first-publication license to a publisher, the concerns of encyclopedia and magazine publishers were addressed. Thus, publishers' presumptive privileges, absent express agreements to the contrary, were limited to: (1) first-publication in the particular periodical for which the work was created; (2) reprinting a contribution in a revision of an encyclopedia; and (3) reprinting a contribution in a later edition of the same periodical or encyclopedia. The legislative history cited by this Court, however, limited those presumptive privileges even further. It expressly prohibited publishers from abusing those three presumptive privileges by reprinting authors' contributions to collective works in an entirely "new collective work", new magazine or new anthology. Congress intended very limited re-uses and precluded abusive re-uses of authors' contributions; but that is not what happened here in this case.

Indeed, until the digital age established new mediums and new markets for publishers, most authors and publishers -- like the National Geographic -- operated under the old scheme, even after the 1976 Copyright Act became effective, on January 1, 1978. The author submitted the contribution understanding that s/he was granting merely a first-publication right, with only two other possible re-uses -- in a later edition or "Year in Review" type issue of the periodical or, if submitted to an encyclopedia, the continued use of the contribution along with all of the other updated articles in a new edition of the encyclopedia.

The Society's CD-ROM set is not "that particular collective work", because the individual National Geographic issues for which Greenberg created his photographs were individually "that particular collective work." The CD-ROM set is also not a "revision of that collective work", because the set is not a magazine and contains 108 years of 12 monthly issues of the magazine, only a few of which were "that particular collective work" *vis a vis* Jerry Greenberg's photographs. The CD-ROM set is also not a "later collective work in the same series" for five reasons: (1) the set does not have the same title as the individual magazines did; (2) defendants admitted to the Copyright Office and to the public (through the packaging ads) that the set was "new" and had never been registered before, even though the Society registered all of its individual periodical issues; (3) the set is not just a digitized version of one magazine issue in which Greenberg's photographs first appeared; (4) the set includes a plethora of newly added materials, including its underlying copyrighted operational software rendering it interactive and all of the rest of the magazines in which Greenberg's photographs were not first published; and (5) the set does not enjoy the protections of archival microfilm and microfiche used in libraries (see, 17 U.S.C. §§107 and 108), because it is sold directly to the public for a profit.

In sum, the CD-ROM set is an entirely "new collective work". The legislative history for Section 201(c) prohibits publishers from reprinting freelancers' works in

“a new anthology or an entirely different magazine or other collective work”. App. at 14. Yet, that is exactly what the Society has done... despite the fact that the Society reassigned all of the copyrights in Greenberg’s photographs back to him and despite the fact that Congress did not intend publishers’ Section 201(c) presumptive privileges to be so abused.

II. THE CD-ROM SET IS A NEW WORK, IN A NEW MEDIUM INTENDED FOR A COMPLETELY NEW MARKET AND, THUS, IS WAY OUTSIDE THE COVERAGE OF SECTION 201(c).

Compact-disc read-only memory technology was not sophisticated enough to achieve mass-marketing of digitized collections until about 1995. Jerry Greenberg’s most recent contract with the Society was dated in 1989, and the Society reverted all right, including copyrights to him in 1985 and 1989.

Regardless of the reversions, though, there is no way that either the Society or Greenberg could have anticipated CD-ROM technology when he produced the first three sets of photographs for first publication in the National Geographic. Even for his fourth and last set of photographs, neither party could have contemplated the CD-ROM medium as one in which Greenberg’s photographs might one day be reprinted, albeit digitally. Whether his contracts with the Society were effectively assignments (under the 1909 Act) or licenses (under the 1976 Act), they did not, and could not, anticipate the new medium of CD-ROM. Therefore, Greenberg did not impliedly

permit the Society to re-use his photographs in the CD-ROM set. In fact, the record shows that he wrote the Society a cease and desist letter, precluding it from including his photographs in the announced new product in the new CD-ROM medium for a new market. The facts that the Society chose to disobey that cease and desist letter, chose to ignore its own reassignments of copyrights to Greenberg and chose to do so in such a blatant way -- in a new product, in a new medium for a new market -- establish the Society's willful culpability for copyright infringement.

Despite Congress' intent that there would be "media neutrality" as to what was copyrightable, there is no support the legislative history or the 1976 Act for media neutrality as to infringement. To the contrary, the language of the House Report for Section 201(c) -- quote and with emphasis added by this Court -- very clearly precludes periodicals from stepping over the "that particular collective work" line in exercising all three presumptive privileges. Without express authorization from the original author, any re-use of a freelancer's work in "a new anthology or an entirely different magazine or other collective work" fell way outside the Section 201(c) presumptive privileges.

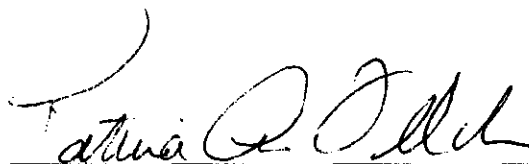
Despite the express prohibition by Jerry Greenberg, the Society created a completely "new collective work" re-using his photographs in the abusive way Congress anticipated and tried to forestall. The CD-ROM set is way beyond the

parameters of Section 201(c) and its legislative history's express prohibitions and, thus, is copyright infringement.

CONCLUSION

For all the reasons stated above, the ASMP *Amicus*, respectfully urges this Court to rule in favor of the plaintiffs.

Respectfully submitted by:



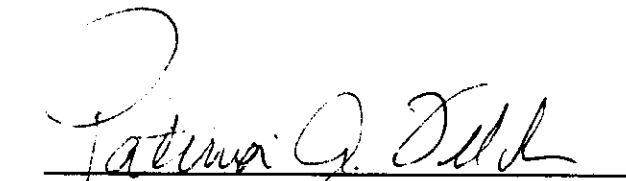
Patricia A. Felch, Attorney for *Amicus Curiae*
The American Society of Media Photographers

Patricia A. Felch, on behalf of *amicus curiae*:
Ill. Bar No. 6196329
BANNER & WITCOFF, LTD.
Ten So. Wacker Drive, Suite 3000
Chicago, IL 60606-7407
(312) 715-1000 (phone)
(312) 715-1234
felch@bannerwitcoff.com

Victor S. Perlman, General Counsel
AMERICAN SOCIETY OF
MEDIA PHOTOGRAPHERS, INC.
150 North Second St.
Philadelphia, PA 19106-1912
(215) 451-2767
(215) 451-0880
perlman@asmp.org

Certificate of Compliance with Fed. R. Civ. Proc. 32(a)(7)(B)

I, Patricia A. Felch, an attorney, certify that this brief complies with the type-volume limitations provided in the Rules of the United States court of Appeals for the Eleventh Circuit, by containing -- other than such words as appear in brief sections where word counts are not required -- less than 4,000 words, much less than half of the word limit for Plaintiffs/Appellants. This brief is also less than 15 pages, as ordered by this Court on October 26, 2000.



Patricia A. Felch

Certificate of Service

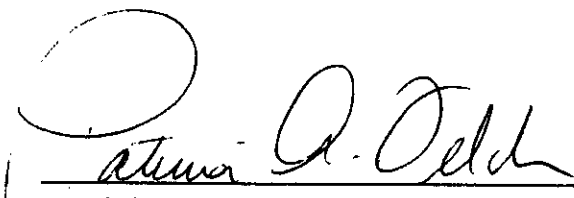
I, Patricia A. Felch, an attorney, certify that I have caused to be served the requisite number of copies of the **RESPONSE BY AMICUS CURIAE THE AMERICAN ASSOCIATION OF MEDIA PHOTOGRAPHERS, INC. TO THIS COURT'S OCTOBER 26, 2000 MEMORANDUM**, by placing them in pre-stamped, pre-addressed envelopes, which were then deposited in the postal box of the United States Postal Service in Ten South Wacker Drive, Chicago, Illinois, to:

Mr. Norman Davis
Steel, Hector & Davis, LLP
First Union Financial Center, Suite 4000
200 S. Biscayne Boulevard
Miami, FL 33131-2398

Mr. Robert G. Sugarman
Weil, Gotshal & Manges, LLP
767 Fifth Avenue
New York, NY 10153

Mr. Joseph M. Beck
Kilpatrick Stockton LLP
Suite 2800, 1100 Peach Tree Street
Atlanta, Georgia 30309

on this 14th day of November, 2000.


Patricia A. Felch