

CASE NO. 00-10510-C

IN THE UNITED STATES COURT OF APPEALS  
FOR THE ELEVENTH CIRCUIT

JERRY GREENBERG and IDAZ GREENBERG,

Plaintiffs/Appellants,

v.

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

Defendants/Appellees.

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

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SUPPLEMENTAL BRIEF OF *AMICI CURIAE*, MAGAZINE  
PUBLISHERS OF AMERICA, INC., NEWSPAPER  
ASSOCIATION OF AMERICA, INC., GANNETT CO., INC.,  
THE NEW YORK TIMES COMPANY, HACHETTE FILIPACCHI  
MAGAZINES, INC., NEWSDAY, INC., TRIBUNE COMPANY  
AND TIME INC. SUPPORTING DEFENDANTS/APPELLEES  
AND AFFIRMANCE OF THE DECISION BELOW

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## ARGUMENT

The Court requested supplemental briefs on two issues. In the interim, the United States Supreme Court has granted certiorari in New York Times Co. v. Tasini (No. 00-201).<sup>1</sup> As a result, *Amici* recognize that the Court may decide to refrain from construing section 201(c) in advance of a Supreme Court decision on the issue. Nevertheless, *Amici* respectfully respond to the questions posed by the Court, as shown below.

I. THE PRODUCT<sup>2</sup> IN ITS ENTIRETY IS NEITHER A "NEW ANTHOLOGY" NOR "AN ENTIRELY DIFFERENT MAGAZINE OR OTHER COLLECTIVE WORK."

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In a report on the adoption of the language that became section 201(c) of the Copyright Act, Congress provided the following examples of what publishers "could" and "could not" do under that section:

Under the language of this clause a publishing company could reprint a contribution from one issue in a later issue of its magazine, and could reprint an article from a 1980 edition of an encyclopedia in a 1990

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<sup>1</sup> The Supreme Court granted certiorari on November 6, 2000. We believe Tasini was wrongly decided by the Second Circuit and have urged this Court to decline to follow it. See Brief of *Amici Curiae*, Magazine Publishers of America, Inc., Newspaper Association of America, Inc., Gannett Co., Inc., Hachette Filipacchi Magazines, Inc., The New York Times Company, Time Inc., Times Mirror Co., and Tribune Company ("*Amici*") Supporting Defendants/Appellees and Affirmance of the Decision Below, filed on April 26, 2000 ("*Amici's* April 26 Brief").

<sup>2</sup> Like the Court, *Amici* refer to the National Geographic CD-ROM Product as the "Product."

revision of it; the publisher could not revise the contribution itself or include it in a new anthology or an entirely different magazine or other collective work.

H.R. Rep. 94-1476, at 122-123 (1976), reprinted in 1976 U.S.C.C.A.N. 5659, 5737 (emphasis added) (App 20-21). This legislative history - and particularly the "could not" language about which the Court has asked - finds an unusually clear explanation in the negotiation over the meaning of section 201(c).

The legislative history highlights **two prohibited practices** under section 201(c). First, publishers "could not" revise the "contribution itself" - i.e., could not cut and paste parts of a freelance photograph, or rewrite a freelance story. The legislative history on this point is clear. When Harriet Pilpel, an experienced advocate for the freelancers, argued during the section 201(c) debate that it "should not be the law" that a publisher could revise individual contributions (as opposed to the collective work),<sup>3</sup> the Register of Copyrights refashioned section 201(c) to clarify that the "any revision" language authorized changes to the "particular collective work" as a whole, **but not to the individual contribution.**

Supplementary Report of the Register of Copyrights on the

<sup>3</sup> See Discussion and Comments on Report of the Register of Copyrights on the General Revision of the U.S. Copyright Law, 88th Cong., 1st Sess., Copyright Law Revision, Part 2 (H. Judiciary Comm. Print 1963), at 152 (App 13).

General Revision of the U.S. Copyright Law; 1965 Revision Bill,  
89th Cong., 1st Sess., Copyright Law Revision, Part 6 (H.  
Judiciary Comm. Print 1965), at 69 (App 15). Thus, the National  
Geographic Society (the "Society") has no privilege under  
section 201(c) to cut, paste or otherwise "revise" parts of the  
photographs taken by Jerry Greenberg for use in other  
photographs. *Amici*, for their part, are not privileged under  
section 201(c) to rewrite ("revise") the news reports, stories  
and articles found in their publications. Neither the Society  
nor *Amici* have sought to do so in reliance on section 201(c).

Second, under the legislative history of section 201(c),  
publishers "could not" include a freelance contribution in a  
"new anthology" or an "entirely different magazine or other  
collective work"<sup>4</sup> - i.e., could not include an *Atlantic Monthly*  
story in a University of Georgia Press anthology, "Best American  
Short Stories"; and could not reprint a Greenberg photograph in  
*Nature* or *Conde Nast Traveler*. To be sure, an early draft of

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<sup>4</sup> The Court in its Memorandum to *Amici* of October 26, 2000 uses  
the phrase "new collective work" presumably synonymously with  
"entirely different collective work." The words "entirely  
different" in the phrase "entirely different magazine or other  
collective work" modify both "magazine" and "other collective  
work" for the simple reason that among collective works, there  
are magazines and there are "other" types of collective works.  
See 17 U.S.C. § 101 (1994 & Supp. IV 1998) (defining a  
"collective work" as 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 work").

section 201(c) gave publishers the privilege of publishing freelance contributions in the original periodicals or "a composite work like that of the publisher...." Discussion and Comments on Report of the Register of Copyrights on the General Revision of the U.S. Copyright Law, 88th Cong., 1st Sess., Copyright Law Revision, Part 2 (H. Judiciary Comm. Print 1963), at 385 (App 5) (emphasis added). Yet when Harriet Pilpel voiced concerns that the section was "less favorable than the present law" - presumably because it arguably could allow *Newsday*, for example, to sell one of its articles for later publication in *The New York Times*, arguably a "like" composite work<sup>5</sup> - the Register of Copyrights clarified that publishers had the privilege only for "that particular composite work." Id. at 153 (App 4).<sup>6</sup> Thus, under section 201(c), the Society may not license the Greenberg photographs to a Sierra Club magazine; and *Amicus The New York Times* is not free under that section to trade its freelance news reports, stories, and articles with

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<sup>5</sup> See id. at 151-152 (App 2-3).

<sup>6</sup> This language later was changed to give publishers the privilege of distributing freelance contributions of "that collective work and any revisions of it," 1964 Revision Bill with Discussions and Comments, 89th Cong., 1st Sess., Copyright Law Revision, Part 5 (H. Judiciary Comm. Print 1965), at 9 (App 12), and then changed again to become the present section 201(c). See id. at 152 (App 13); Supplementary Report of the Register of Copyrights on the General Revision of the U.S. Copyright Law; 1965 Revision Bill, 89th Cong., 1st Sess., Copyright Law Revision, Part 6 (H. Judiciary Comm. Print 1965), at 69 (App 15).

*Amicus Times Mirror*. Again, neither the Society nor *Amici* have sought to do so in reliance on section 201(c).

As the legislative history makes clear, the Product in fact falls well within the privilege granted by section 201(c). First, the Society has not made any changes to the Greenberg photographs themselves as they appear in the issues — *i.e.*, to the “individual contributions” that Harriet Pilpel and the freelancers sought to protect. Instead, the Society merely has changed (electronically) the “binding” in which those photographs are packaged. This is the very conduct for which the publishers sought, **and achieved**, an express statutory privilege when section 201(c) was being debated.

Second, these slight changes in presentation (but not in content) do not make the Product either the “new anthology” or the “entirely different magazine or [entirely different] other collective work” proscribed by the legislative history. The Product is not *Nature* or *Conde Nast Traveler* or some other “entirely different magazine” or “entirely different collective work.” The Product does not alter the pages of the *National Geographic* magazines, but consists of a computer image of each page **as it originally appeared in paper form**. In other words, the Product **is the *National Geographic* in an electronic form rather than on paper**. The stories, photographs, and drawings from the original *National Geographic* magazines remain — the

only difference is that readers can use the Product to page through years of issues of *National Geographic* without wrestling with dusty bound volumes, aging microfilm or deteriorating microfiche using cumbersome mechanical readers in an (often distant) library. The result cannot be a "new anthology" or an "entirely different magazine or other collective work" because the Product is a copy that contains the **same** contributions from the **same** issues under the **same** masthead. The Society simply has reprinted its earlier issues (with digital exactitude), with arguably *de minimis* differences in the form of the Moving Sequence, to offer readers more than one issue in a single source.

The brief Moving Sequence and the computerized index found in the Product do not change this result. The photographs as used on the covers of the individual issues (the individual "contributions" themselves) are not revised; and the Moving Sequence use is less akin to unprivileged cutting or pasting than to the digital (and privileged) equivalent of "flipping through" the magazines, issue by issue, to view the photographs on the covers. The index, for its part, does not change the *National Geographic* magazines into a "new anthology" or "entirely different" periodical, but merely offers readers the ease of a searchable index - a function that is a part of certain paper issues of the *National Geographic* as well.

While the United States Supreme Court will weigh the scope of the 201(c) privilege in New York Times Co. v. Tasini (No. 00-201), *Amici* respectfully submit that this Court has the rare opportunity to be heard on such an issue **before** it reaches the Supreme Court. In the Eleventh Circuit (if not the Second), *Amici* respectfully urge that section 201(c) should be construed in accordance with its clear legislative history.

II. UNDER SECTION 201(C), PUBLISHERS HAVE THE "PRIVILEGE OF REPRODUCING AND DISTRIBUTING THE CONTRIBUTION AS A PART OF THAT PARTICULAR COLLECTIVE WORK, ANY REVISION OF THAT COLLECTIVE WORK, AND ANY LATER COLLECTIVE WORK IN THE SAME SERIES" **REGARDLESS OF WHETHER OR NOT THE PRIVILEGED WORK CONSTITUTES A NEW PRODUCT, IN A NEW MEDIUM, IN A NEW MARKET.**

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In its October 26, 2000 Memorandum, the Court also asked the parties and *Amici* to consider "whether a change in the medium ... for the collective set of individual issues of the Magazine ... integrated together with the Moving Sequence and the Program constitutes a new product, in a new medium, in a new market, that transcends the publisher's privilege in Sect. 201(c)."

In the first place, microfilm and microfiche reproductions of collective works (not to mention 1990 revisions of 1980 encyclopedias) may, depending on one's definition, constitute a new product, in a new medium, in a new market. Yet not even the Greenbergs argue that such uses transcend the privilege of 201(c).



Respectfully, however, *Amici* suggest that under Section 201(c), the issue is not whether a work "constitutes a new product, in a new medium, in a new market"; whether freelancers who contributed to periodicals in the past are receiving any of the benefits of this "new market"; or even whether they should. Instead, under Section 201(c), **the sole question for the Court is whether the work at issue exceeds the privilege under the statute - that is, of "reproducing and distributing the contribution as a part of that particular collective work, any revision of that collective work, and any later collective work in the same series."** 17 U.S.C. § 201(c) (1994). This is the dictate of Congress, reached after lengthy negotiations between advocates for publishers and freelancers alike. **It is a "privilege" extended by the law.**<sup>7</sup>

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<sup>7</sup> While the Greenbergs have argued that *Amici's* "mere privilege" falls short in some respects of an exclusive "right" of copyright, it bears mention that Congress used the terms interchangeably throughout the legislative history of section 201(c). In any event, the Greenbergs' argument proves too much: if indeed *Amici* possess a "mere privilege," the Greenbergs retain **all** of their exclusive "rights" of copyright, including the right to license their photos for use in "derivative works" as diverse as coffee cups and motion pictures. (See *Amici's* April 26, 2000 Brief at 17-18). Yet by expressly exempting the "privilege" of 201(c) from the termination opportunities granted to freelancers under 17 U.S.C. 304(c) and 203(a), Congress preserved the ability of *Amici* to fulfill the important archival mission of providing, for the entire term of copyright (and thereafter as works became part of the public domain), "the contributions themselves" in the nation's electronic library. See *id.* at 5-6.

In fact, both the Society and *Amici* have exercised a **lesser** privilege than is available to them under the statute. Under section 201(c), the Society legally could have created a disk set that made **far greater changes** to the original *National Geographic* magazines - in other words, it **could have created a derivative work and still retained the section 201(c) privilege.** See 17 U.S.C. § 101 (1994 & Supp. IV 1998) (definitions). Thus, even if a "revised" collective work (for the sake of argument, the Product) contains the modicum of originality necessary to qualify for copyright protection as a "derivative work," it does not thereby also become a "new anthology" or an "entirely different" periodical, thus removing it from the privilege of section 201(c). Neither the statute nor its legislative history support such a reading. Instead, the legislative history stands for precisely the opposite, sanctioning (as it does) use of an article "from a 1980 edition of an encyclopedia in a 1990 [and obviously "derivative" for copyright purposes] revision of it." See H.R. Rep. 94-1476, at 122-123 (1976), reprinted in 1976 U.S.C.C.A.N. 5659, 5737 (App 20-21).

That a 1990 revision of a 1980 encyclopedia would be sufficiently original to constitute a "derivative work" is obvious - just think of the changes that a publisher would have to make to the 1980 edition to reflect, for example, the fall of the Soviet Union as an entity and empire and the rise of the

very technology that threatens to eclipse statutory construction in this case. It is equally obvious from the legislative history that precisely such a "derivative work" falls squarely within the privilege of section 201(c). Yet nothing in the statute or the legislative history suggests that the section 201(c) privilege to publish such a derivative work - and to include a previously published freelance contribution within it - evaporates if a "new [digital] medium" is used, or if the work occupies a "new market." Both the history and purpose of the copyright law - **which, by its terms, is media neutral**<sup>8</sup> - stand for precisely the opposite. In short, under 201(c), the Society has the privilege of creating derivative works (in the form of "revised" collective works), and notwithstanding the fact that such derivative works (just like updated encyclopedias) may constitute new products for new markets; or (just like microfilm and microfiche), subsist in a new media.

Moreover, even if copies in microfilm, microfiche or electronic reproductions (including the Product) could be said to satisfy some definition of "new product, new medium, new market," this does not mean that the copies also possess

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<sup>8</sup> The Copyright Act expressly has embraced computers by referring, e.g., to "copies" as "material objects fixed by any method now known or later developed" and to "literary works" as works expressed in "words, numbers, or other verbal or numerical symbols or indicia ... such as books, periodicals, manuscripts, phonorecords, film, tapes, disks, or cards, in which they are embodied." 17 U.S.C. § 101.

sufficient originality to constitute a "derivative work".<sup>9</sup> In L. Batlin & Son, Inc. v. Snyder, 536 F.2d 486, 491 (2d Cir. 1976) (en banc), for example, the plaintiff sought to protect a plastic mechanical toy bank in the shape of Uncle Sam, admittedly taken directly from an almost identical antique bank made of cast iron. The Second Circuit refused to grant the plaintiff copyright protection, notwithstanding the fact that the "new" product occupied a different medium - and even could have revived a "new" market for banks of that kind. See id. The court went on to hold that translating a work to a different medium was a "trivial," as opposed to original, variation and was insufficient to support a copyright in the new work. As the court put it, "[a]bsent a genuine difference between the underlying work of art and the copy of it for which protection is sought, the public interest in promoting progress in the arts - indeed, the constitutional demand - could hardly be served" by granting copyright protection to the plastic copy. Id. at 492. See also 1 Melville B. Nimmer, NIMMER ON COPYRIGHT § 2.08 (1998). The court reached a similar result in Bridgeman

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<sup>9</sup> A "derivative work" is a work based upon one or more preexisting works.... A work consisting of editorial revisions, annotations, elaborations, or other modifications, which, as a whole, represent an original work of authorship, is a "derivative work." 17 U.S.C. 101. For a collection of cases in which the requisite "originality" has been found to be lacking, see generally 1 Melville B. Nimmer, NIMMER ON COPYRIGHT § 3.03 (1998).

Art Library, Ltd. v. Corel Corporation, 36 F. Supp. 2d 191, 197 (S.D.N.Y. 1999), finding that notwithstanding the change in medium, the color transparencies at issue were "'slavish copies' of public domain works of art" whose entire purpose was "to reproduce the underlying works with absolute fidelity" - hence unoriginal and unprotectible.<sup>10</sup>

Finally, the public interest hardly would be served by a "new product, new medium, new market" test. Feist,<sup>11</sup> Donnelley,<sup>12</sup> Warren Publishing<sup>13</sup> and the Constitution require more in the way

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<sup>10</sup> In the pre-Feist decision in Alfred Bell & Co. v. Catalda Fine Arts, Inc., 191 F.2d 99 (2d Cir. 1951), of course, the court did grant copyright protection to mezzotints of famous oil paintings, see id. at 104, but it did so because there was substantial evidence as to the variability of the mezzotint process - meaning that "[n]o two engravers [could] produce identical interpretations of the same oil painting." Alfred Bell & Co. v. Catalda Fine Arts, Inc., 74 F. Supp. 973, 975 (S.D.N.Y. 1949). This reasoning highlights one of the reasons why the Society and Amici rest squarely within the section 201(c) privilege: Unlike the artists at Alfred Bell & Co., the Society and Amici generally do not, without separate authorization, make any changes ("original" or not) to the individual contributions within the body of their publications. That is, the Society and Amici generally do not "revise the contribution itself" - one of the two acts listed as prohibited in the legislative history of section 201(c). See H.R. Rep. 94-1476, at 122-123 (1976), reprinted in 1976 U.S.C.C.A.N. 5659, 5737 (App 20-21).

<sup>11</sup> Feist Publications v. Rural Tel. Serv. Co., 499 U.S. 340 (1991).

<sup>12</sup> BellSouth Advertising and Publ'g Corp. v. Donnelley Info. Publ'g, Inc., 999 F.2d 1436 (11th Cir. 1993).

<sup>13</sup> Warren Publ'g, Inc. v. Microdos Data Corp., 115 F.3d 1509 (11th Cir. 1997).

of authorial originality than the transformation and storage of periodicals from one medium to another - and notwithstanding the fact that the "new work" (such as the *National Geographic Product* here) includes such technological advances (as opposed to "acts of authorship," see Donnelley, 999 F.2d at 1441) as a digital retrieval system.

The Constitution empowers Congress to "promote the Progress of Science and the useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their Writings and Discoveries." U.S. CONST., art. I, § 8, cl. 8. This goal - the promotion of progress, or "learning" - necessarily requires at least some public access to writings and other copyrighted works.<sup>14</sup> See L. Ray Patterson & Judge Stanley F. Birch, Jr., "Copyright and Free Speech Rights," 4 J. INTELL. PROP. L. 1, 7 (1997). It also asks courts to place limits on what otherwise

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<sup>14</sup> As *Amici* have stated, the increased access to back issues of newspapers and magazines made possible through sources such as the *National Geographic Product* and Nexis® undeniably has advanced this goal of increasing the store and the availability of "writings." See Twentieth Century Music Corp. v. Aiken, 422 U.S. 151, 156 (1975) (ultimate aim of copyright law is "promoting broad public availability of literature, music and the other arts"). Yet according to an article last summer in *The New Yorker* magazine, millions of copies of old newspapers (including those formerly stored by the Library of Congress) have been destroyed in recent years; and microfilm and microfiche copies, the same article notes, frequently are inadequate. "Surely this material is all available on the Web by now, or will be soon?" the author asks, apparently unaware of the risks posed to such material by Tasini. See Nicholson Baker, Deadline, THE NEW YORKER, at 50 (July 24, 2000).

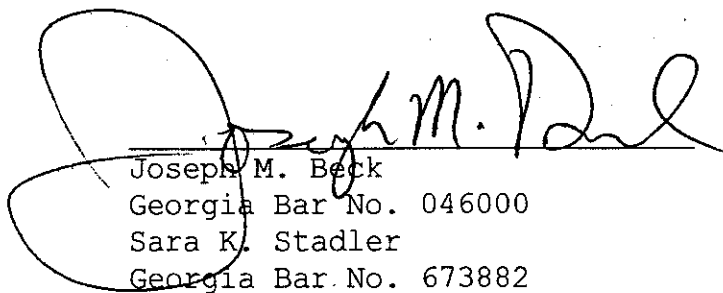
could constitute a copyright "monopoly" if the statutory scheme were construed too broadly.

In sum, *Amici* respectfully ask this Court to heed the language and clear legislative history of section 201(c); to decline to craft a "new product, new medium, new market" test; and to recognize that a "proprietary" model of copyright law and its notion of "exclusive rights"<sup>15</sup> is, and always has been, subject to the constitutional mandate "to increase and not to impede the harvest of knowledge." Harper and Row Pub., Inc. v. Nation Enterprises, 471 U.S. 539, 545 (1985). So should it be in this case.

Dated: November 15, 2000.

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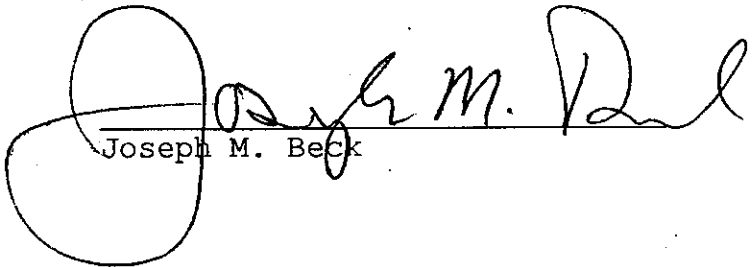
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<sup>15</sup> As with patents (also covered by U.S. CONST., art. I, § 8, cl. 8), the difficulty comes in "drawing a line between the things which are **worth to the public** the embarrassment of an exclusive [copyright], and those which are not." Graham v. John Deere Co., 383 U.S. 1, 9 (1966) (quoting Thomas Jefferson on patents).

CERTIFICATE OF COMPLIANCE

I hereby certify that this brief complies with the type-volume limitation set forth in Federal Rule of Appellate Procedure 32(a)(7). The brief utilizes proportional spacing and consists of approximately 3,507 words.

  
Joseph M. Beck




CERTIFICATE OF SERVICE

This is to certify that I have this day served a true and correct copy of the foregoing SUPPLEMENTAL BRIEF OF AMICI CURIAE, MAGAZINE PUBLISHERS OF AMERICA, INC., NEWSPAPER ASSOCIATION OF AMERICA, INC., GANNETT CO., INC., HACHETTE FILIPACCHI MAGAZINES, INC., HEARST CORPORATION, THE NEW YORK TIMES COMPANY, NEWSDAY, INC., AND TIME INC. SUPPORTING DEFENDANTS/APPELLEES AND AFFIRMANCE OF THE DECISION BELOW via first class mail, addressed to:

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This 15th day of November, 2000.

  
Sara K. Stadler