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A Victory For Media Neutrality: The Eleventh Circuit's En Banc Decision in *Greenberg v. National Geographic Society* July 9, 2008

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Sitting en banc, the U.S. Court of Appeals for the Eleventh Circuit on June 30, 2008, decided *Greenberg v. National Geographic Society*, finding that the CD-ROM set, "The Complete National Geographic" (CNG), was a privileged revision of a collective work under 17 U.S.C. § 201(c) and not a "new collective work" in violation of Mr. Greenberg's copyrights. This case is in line with the Second Circuit's decision in *Faulkner v. National Geographic Enters.*,¹ further clarified the U.S. Supreme Court's ruling in *New York Times Co. v. Tasini*,² and importantly, upheld the "long embraced doctrine of media neutrality" that the "transfer of a work between media does not alter the character of that work for copyright purposes."³

I. Facts

In 1997, The National Geographic Society, publishers of National Geographic Magazine, produced a thirty-disc CD-ROM set, "The Complete National Geographic" (CNG), containing every monthly issue of the magazine from 1888 through 1996. The CD-ROM contained scans of every page of the magazine, presenting them exactly as they appeared in print, including the original advertisements and page numbering. Additionally, the CD-ROM contained a short introductory montage and a piece of software that allowed users to search the magazine's contents, zoom in on particular pages, and print.

Freelance photographer Jerry Greenberg had his photographs published in four issues of National Geographic. Upon publication of the CNG, Greenberg sued National Geographic in Federal District Court alleging that National Geographic infringed his copyrights.

II. Procedural History

In 2000, the District Court for the Southern District of Florida granted summary judgment to National Geographic, holding that the reproduction of Greenberg's images in the CNG

¹ 409 F.3d 26 (2nd Cir. 2005).

² 533 U.S. 483 (2001).

³ *Greenberg v. National Geographic (Greenberg III)*, No. 05-16964, 2008 WL 2571333, at *8 (11th Cir. June 30, 2008), citing *Tasini*, 533 U.S. at 502.

was privileged under §201(c) because the CNG constituted a revision of the print issues of the magazines. On appeal, a panel of the Eleventh Circuit Court of Appeals disagreed, reversed the decision, and remanded the case to the District Court for a determination of damages.⁴ After a trial on the issue of damages, a jury returned a verdict against National Geographic for \$400,000.

National Geographic appealed this jury verdict, arguing that the Supreme Court's post-*Greenberg I* holding in *New York Times v. Tasini* clarified §201 as it related to printed works in digital formats and required a reversal of the jury verdict. In 2007, a panel of the Eleventh Circuit agreed and held that publication of the CNG was privileged under §201.⁵ This decision, however, was vacated when the Eleventh Circuit agreed to hear the case en banc.

III. Issue

Both Greenberg and National Geographic agreed that each individual issue of National Geographic, in print form, was a collective work and that National Geographic was privileged to reproduce and distribute those issues in print. At issue was whether the CNG constituted a privileged revision of the print magazines, or whether it was sufficiently different from the original issues to become a new work.

Under 17 U.S.C. § 201(c), “copyright in each separate contribution to a collective work is distinct from copyright in the collective work as a whole and vests initially in the author of the contribution.” However, the owner of copyright in the collective work is presumed to have the privilege of “reproducing and distributing the contribution” in one of three ways: 1) as part of that particular collective work; 2) as a revision of that collective work; or 3) in any later collective work in the same series.⁶

In 2001, the Supreme Court addressed the issue of §201(c)'s privilege for publishers in *New York Times, Co. v. Tasini*.⁷ In that case, a group of freelance publishers sued the New York Times and several online databases, alleging that by republishing their work in these formats, the newspaper and the database publishers infringed their copyrights. The publishers asserted that such republication was a protected revision under §201(c). The Supreme Court disagreed, holding that “[t]he Publishers are not sheltered by § 201(c) because the Databases reproduce and distribute articles standing alone and not in context.”⁸ Following *Tasini*, the Second Circuit in *Faulkner v. National Geographic Enters.* decided a case factually similar to *Greenberg* – a freelance photographer sued National Geographic for republishing his photographs in the CNG. In *Faulkner*, the

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

⁵ *Greenberg v. National Geographic Society (Greenberg II)*, 488 F.3d 1331 (11th Cir. 2007).

⁶ 17 U.S.C. §201(c) (2006).

⁷ 533 U.S. 483.

⁸ *Id.* at 484.

Second Circuit applied *Tasini* and held that because the CNG maintained the original context of the publication, National Geographic was entitled to protection under §201(c).⁹

In this case, National Geographic argued that republishing Mr. Greenberg’s photographs as part of the CNG was privileged under either the first or second prongs of § 201(c) – as part of that particular collective work, or as a revision of that collective work. Mr. Greenberg, however, argued that the CNG was a “new collective work” not entitled §201(c) protection, and therefore publication of the CNG violated Mr. Greenberg’s copyrights.

IV. Holding

By a 7-5 vote, the en banc Eleventh Circuit held that although the CNG is in a digital format and thus is different from the original print publications, the CNG “faithfully preserve[d] the original context of National Geographic’s print issues” and therefore National Geographic “is privileged to reproduce and distribute the CNG under the ‘revision’ prong of §201(c).” Further, the court found the elements of the CNG not present in the print edition, including the search and zoom functionality as well as the introductory montage, were not sufficient to deprive National Geographic of its §201 protection.

V. Reasoning

In order to determine whether National Geographic’s inclusion of Greenberg’s photos in the CNG was protected under §201(c), the court looked to *Tasini* for guidance on what constitutes a revision. Noting that “[t]he copyright act does not define ‘revision,’ but *Tasini* does,” the Eleventh Circuit determined that “the teachings of *Tasini* are twofold.”¹⁰ First, the court found that under *Tasini* “the concept of ‘revision’ necessarily includes some element of novelty,” and second, that “consideration of the context in which the contributions are presented is critical in determining whether that novelty is sufficient to defeat the publisher’s §201 privilege.”¹¹

The dissent argued that inclusion of new elements such as a computer program to perform the search and zoom functions, and the opening montage sufficiently modified the CNG to make it a new work and therefore exempt from §201(c) protection. The majority disagreed, finding that under *Tasini*, a revision may include some novelty, and that here “the new elements of the CNG ... do not bring the CNG outside the scope of the §201(c) privilege.”¹² The court found the opening montage to be a “virtual cover” which “in no way alters the context in which the original photos were presented ... just as a new cover on an encyclopedia set would not change the context of the entries in the encyclopedia

⁹ 409 F.3d at 38.

¹⁰ *Greenberg III* at *4.

¹¹ *Id.*

¹² *Id.* at *7.

set.”¹³ Further, the court found the computer program’s search capability analogous to a print index and the zoom capability similar to a magnifying glass or the lens on a microfilm machine. Accordingly, the court held that “these additional features do not destroy the original context of the collective works.”¹⁴

Drawing upon *Tasini*’s suggestion that the “reproduction of print publications in microform would be privileged under §201(c)” because they represent a “mere conversion of intact periodicals (or revisions of periodicals) from one media to another,”¹⁵ the court here found that the CNG is like microform and therefore protected. Unlike in *Tasini* where the “articles were removed from their original context,” here Greenberg’s photographs “are firmly positioned within their original context” just as “they originally appeared in the Magazine’s print versions.”¹⁶ One of the databases in question in *Tasini*, General Periodicals OnDisk (GPO), maintained the original position of the article as it appeared on the printed page, but did not allow users to “flip” to another article. In distinguishing the CNG from GPO, the Eleventh Circuit emphasized the fact that by allowing the CNG user “to flip through the pages or issues of the Magazine after conducting a search,” the CNG “preserv[ed] the original and complete context of the print issues.”¹⁷

The court found this conclusion bolstered by the legislative history surrounding the adoption of §201(c), deciding that while the statute prevents publishers from revising the contribution itself, including it in a new anthology, or publishing it in an entirely different work, “Congress intended for publishers to retain their §201(c) privilege unless the republication constituted an ‘entirely different’ collective work.”

Importantly, the court concluded its analysis by articulating the “long-embraced doctrine of media neutrality” stated in *Tasini*: the idea that the “transfer of a work between media does not alter the character of that work for copyright purposes.”¹⁸ In this case, the court found that “Greenberg’s copyrights ... and National Geographic’s privilege of reproducing and distributing the collective works – were not determined thirty years ago based on the medium in which they were produced, and they should not be determined on that basis today.”¹⁹ The court correctly recognized that “as technology progresses ... copyright law must remain grounded in the premise that difference in form is not the same as a difference in substance.”²⁰

¹³ *Id.* at *3.

¹⁴ *Id.* at *7.

¹⁵ *Id.* at *8, citing *Tasini*, 533 U.S. at 502.

¹⁶ *Id.* at *5.

¹⁷ *Id.*

¹⁸ *Id.* at *8.

¹⁹ *Id.* at *9.

²⁰ *Id.*

VI. Dissent

There were two dissents in this case: one by Judge Birch who was joined by Judge Wilson for the entire opinion and by Judges Edmondson and Anderson for Part A only; and a second dissent by Judge Anderson joined by Judges Birch, Edmondson, Wilson, and Tjoflat.

Judge Birch's 47 page dissent began with the premise that this case is "not about education, access by the masses, or efficient storage and preservation – it is about who gets the money."²¹ In Part A, Judge Birch argued that the CNG is an entirely different work and thus not eligible for §201(c) protection. In Parts B and C of his dissent, Judge Birch explored issues not briefed by either party – the question of whether National Geographic could transfer its §201(c) privilege to third parties and whether by distributing a product that could project copyrighted images on a computer screen, the CNG publicly displayed the works, an act not privileged by §201(c).

Judge Anderson's dissent echoed part A of Birch's dissent and found that satisfaction of *Tasini's* contextual analysis alone does not always mean that the new publication enjoys §201(c) protection. Instead, Judge Anderson argued that *Tasini's* discussion of microform is dicta and not binding on the court. However, Judge Anderson continued, even if microforms are protected under §201(c), the CNG is not protected because the advanced search function, the compression/decompression program, and the digital format makes the CNG "an entirely new product – a sophisticated research tool."²²

VII. Conclusion

The majority correctly interpreted §201(c), in light of *Tasini*, recognizing that digitizing a copyrighted object does not result in the loss of a publisher's ability to re-use that contribution so long as the original context is preserved and the work itself is not significantly changed. Further, by avoiding a split with the Second Circuit's decision in *Faulkner*, the Eleventh Circuit provided welcome clarification to application of §201 post-*Tasini*. In *Greenberg III*, the court struck the proper balance between the rights of copyright owners and the rights of publishers who seek to move large amounts of analog content they paid for into the digital environment.

²¹ *Id.* at *10. (J. Birch, dissenting).

²² *Id.* at *29. (J. Anderson, dissenting).