

# National Geographic Charts New Territory In Electronic Republication of its Magazines

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On June 30, 2008 in *Greenberg v. National Geographic Society*, the Court of Appeals for the Eleventh Circuit resolved a split between the circuits when it reversed its previous decision and held that National Geographic's "The Complete National Geographic" CD-ROM compendium ("CNG") is a "revision" of previous National Geographic publications. As such, National Geographic is entitled under copyright law to reproduce and distribute the CNG. This case is unusual because it includes a publisher sued for infringing copyrights it once owned, opposing parties that both have some valid rights to the same photographs, and dramatic reversals of fortune.

Beginning in the 1960s, The National Geographic Society ("NGS") engaged freelance photographer Jerry Greenberg to take photographs for publication in National Geographic magazine. Prior to the 1976 Copyright Act, a freelance photographer (or other author) who contributed to a "collective work" such as a magazine (i.e., a work that compiles several individual contributions into a collective whole) risked losing her copyright in her individual work absent a printed copyright notice in her name. The copyrights were not divisible: an author could not simply grant a publisher a right of publication in the collective work while preserving her copyright in the individual work. To avoid complete abandonment of the copyright, some authors (including Mr. Greenberg) assigned the rights in their individual works to the publisher.

In 1976, Congress amended the copyright statute to reallocate the rights as between authors of individual works and publishers of collective works. Under 17 U.S.C. §201(c), an author who contributes to a collective work may retain ownership of the copyright in her contribution, while in the absence of a contract to the contrary, the publisher acquires (among other things) "the privilege of reproducing and distributing the contribution as part of . . . any revision of that collective work. . . ."

Between 1962 and 1990, several of Mr. Greenberg's photographs were published in the National Geographic magazine, including one cover shot. In 1997, NGS produced the CNG, a CD-ROM set containing a scanned

copy of each page of the roughly 1200 issues of National Geographic published between 1888 and 1996, as well as a 25-second opening montage of 10 National Geographic covers. The collection, as well as the opening montage, includes photographs taken by Mr. Greenberg. NGS worked with a third party to add computer programs to compress and decompress the images, zoom-in on portions of the scanned pages, and allow a user to search the CNG.

In an act of generosity that NGS surely came to regret, NGS had assigned the copyrights in the individual photographs back to Mr. Greenberg in 1985 and 1990, at Mr. Greenberg's request. As a result, both Mr. Greenberg and NGS had some rights in the photographs: Mr. Greenberg held the rights in the individual photographs, while NGS held the right to publish the photographs as part of its collective works (the magazines). In 1997, soon after the publication of the CNG, Mr. Greenberg sued NGS, alleging that both the scanned pages of the magazine and the opening montage in the CNG infringed his copyrights.

The trial court agreed with NGS that the CNG is a "revision" of the collective works that the magazines constituted, and that NGS was therefore entitled to the "privilege" of §201(c). But in 2001, a three-judge panel of the Eleventh Circuit Court of Appeals reversed ("**Greenberg I**"), holding that the CNG was not a "revision" of the original collective work.

The Court referred to the legislative history of §201(c) to construct a narrow interpretation of the privilege. Then, in view of the fact that the CNG contained 1200 issues of the magazine, as well as the new opening montage and the computer programs, the Court concluded that NGS had "created a new product ('an original work of authorship'), in a new medium, for a new market that far transcends any privilege of revision or other mere reproduction envisioned in 201(c)." A jury assessed damages in the amount of \$400,000.

NGS appealed a second time, arguing that the legal landscape of §201(c) had changed in the time between *Greenberg I* and the jury verdict. First, just months after the decision in *Greenberg I*, the US Supreme Court ruled

in *New York Times v. Tasini* that the critical question under §201(c) is whether the individual work included in an alleged “revision” is presented in its original context, as perceptible by the reader. Elements of context may include formatting features such as text and photographs, advertisements, headlines, and other surrounding materials.

The *Tasini* defendants had taken the individual contributions from their collective works and made them available in searchable databases in which each contribution was accessible in isolation, free from its original context in the collective work. This searchable database, resulting in the presentation of articles in isolation from the collective work in which they were originally published, was deemed to be a step too far. The databases were deemed not to be mere revisions of existing collective works, but new collective works entirely.

The Supreme Court contrasted these databases with microfilm and microfiche, which reproduce the elements of collective works in precisely the position in which they appeared in the original publication. *Tasini* suggested that such microforms would be “revisions” under §201(c) because they maintain the context of the original publications, but held that the databases were not a “revision” for failure to maintain such context.

Later, in a Second Circuit case also involving the CNG, NGS seized on *Tasini* and successfully argued that the CNG is analogous to microfilm, and therefore NGS is entitled to the privilege provided by §201(c). That decision, *Faulkner v. National Geographic Enterprises Inc.*, was in direct conflict with the Eleventh Circuit’s previous holding on the exact same issue in *Greenberg I*, and created a temporary split between the Second and Eleventh Circuits.

In 2007, a different three-judge panel of the Eleventh Circuit Court of Appeals held, in view of the *Tasini* and *Faulkner* decisions, that the CNG was a “revision” of a collective work entitled to the privilege provided by §201(c) (“**Greenberg II**”). However, the Eleventh Circuit Court of Appeals quickly vacated *Greenberg II* in favor of rehearing the case *en banc*. Ultimately, in its 2008 decision (“**Greenberg III**”), the Eleventh Circuit sitting *en banc* held (despite nearly 60 pages of passionate dissent) that the CNG is a “revision” of a collective work entitled to the privilege provided by §201(c).

The majority extended the suggestion in *Tasini* that a compilation of collective works on microfilm would be within the scope of §201(c), and concluded that compiling 1200 issues of the magazine “is permissible under §201(c) insofar as the individual contributions are presented and

perceivable to viewers in their original context.” From that position, the majority analogized the opening montage to a “virtual cover” that “in no way alters the context in which the original photographs were presented. . . .” The majority also analogized the CNG’s image compression and zoom functions to microfilm and zoom lenses, which “do not destroy the original context of the collective works.”

Finally, the majority analogized the CNG’s search function to a traditional index. As with an index in a printed work, the user of the CNG’s search function can locate a topic of interest within the CNG, and is then free to flip through adjacent pages of the collected issues, arranged in their original context.

Thus, while the New York Times’s search function in *Tasini* was a key component of the finding that the Times had published a new collective work, the NGS search function did not cause that result. The difference was what the user saw once the search had been performed. In *Tasini*, the user saw the article in isolation. In *Greenberg*, the user saw the pages of the National Geographic magazine in their original layout.

The Court concluded that the addition of the montage and computer programs do not deprive the CNG of the §201(c) privilege. The majority in *Greenberg III* did not attempt to identify the point at which added material alters the original collective work so substantially that it destroys the original context and deprives an alleged revision of the §201(c) privilege; it merely concluded that the new material – the search function and the zoom capability – of the CNG does not reach that level.

The Court ultimately found no meaningful distinction between the CNG and the privileged “revision” of a collective work onto microfilm as discussed in *Tasini*, and held that NGS is privileged to reproduce and distribute the CNG under §201(c). With that reversal of fortune, Mr. Greenberg saw his \$400,000 judgment disappear.

Mr. Greenberg remains poised to pursue the question of whether the CNG infringes his copyright by using his cover photograph in the opening montage – an act that is not privileged by §201(c) according to *Greenberg III* – but several lessons are already clear. Taken together, *Tasini*, *Faulkner*, and *Greenberg III* teach that contextual fidelity – the preservation of the original reader experience in viewing the article – is the touchstone of §201(c) analysis.

As practical matters, NGS would have been better off had it simply taken a license-back when it transferred the intellectual property rights to Mr. Greenberg, while Mr. Greenberg might have been better off had he settled the case earlier on. Either way, as the Supreme Court said in

*Tasini*, “it bears reminder here and throughout that these Publishers and all others can protect their interest by private contractual arrangement.” In any case, a combination of solid advocacy and pragmatic advice is invaluable when your business depends on ascertaining your intellectual property rights. ✧