

DOCKET NO. 00-10510-C

IN THE  
UNITED STATES COURT OF APPEALS  
FOR THE ELEVENTH 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.

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

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Appellants' Opposition to Appellees' Motion  
to Strike Appellants' Arguments Not Raised below

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CERTIFICATE OF INTERESTED PERSONS  
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National Geographic Enterprises, Inc.

National Geographic Society

National Geographic Holdings

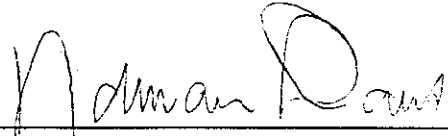
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A handwritten signature in cursive script that reads "Norman Davis". The signature is written in black ink and is positioned above a horizontal line.

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Norman Davis

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AND CORPORATE DISCLOSURE STATEMENT ..... i

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STATEMENT OF FACTS

This case arose as a result of appellees, the National Geographic Society (“the Society”) and the other defendants, launching an “unprecedented” new product -- The Complete National Geographic (“the Complete Geographic”) -- consisting of 30 CD-ROM disks containing 108 years of various issues of National Geographic Society magazines. The Society included in the Complete Geographic a substantial number of photographs owned by Jerry Greenberg (“Greenberg”), without Greenberg’s consent, in violation of Greenberg’s copyright interest. R1-25-Ex. B.

The appellees argue in their motion to strike that Greenberg asserts for the first time on appeal that the Society had no legal right to republish his photographs because the Society had transferred all rights to him long before the creation of the new product. (Motion to strike 2). To the contrary, Greenberg’s initial brief states that in 1985, the Society transferred to Greenberg all right, title and interest, including copyright, to his photographs published in the January 1962, February 1968, and May 1971 issues of the monthly Magazine. R1-25-Ex. B. And, Greenberg’s initial brief states that in 1989, the Society transferred to Greenberg all rights, including copyright, in his photographs published in an article in a 1990 issue of the monthly Magazine. Id. (The latter transfer is not addressed in the appellees’ motion).

Moreover, Greenberg’s Amended Complaint alleges, in paragraph 54, that Greenberg owns copyright to the disputed photographs. Further, Greenberg attached

to his responding summary judgment memorandum copies of two documents that expressly demonstrate that copyright interest in certain photographs had been reassigned (transferred) to Greenberg by the Society. In that memorandum, Greenberg plainly asserted: “[t]he Complete Geographic product contains more than a dozen photographs taken by Mr. Greenberg for which he owns exclusive copyright.” R.1-25-3. Appellees *never challenged* those documents in the district court despite having had adequate opportunity to do so.

## ARGUMENT

### I.

#### The Society’s Transfer of Copyright to Greenberg Was Properly Before the District Court

Contrary to the Society’s position in its motion to strike, the Greenbergs raised and the district court addressed the Society’s transfers of copyright to Greenberg. In its motion to strike, the Society claims that Greenberg asserts “in this appeal for the first time ever” that all rights to certain photographs had been transferred to him by the Society. This is simply wrong. First, Greenberg alleged copyright ownership in his amended complaint and again in his responding summary judgment memorandum. That memorandum contains a citation to the transfer-of-copyright instruments. R.1-25-3. Those two instruments expressly demonstrate that the Society transferred

(reassigned) copyright interest in certain photographs to Greenberg.<sup>1</sup> The instruments are the *sine qua non* of the infringement action brought by Greenberg.

Moreover, contrary to the appellees' claim that the district court did not address the transfer issue, (Motion to strike 3), the district court expressly acknowledged that in 1985, the Society had assigned to Greenberg copyright interest in the disputed photographs. R.1-25-9. At page 4 of the order under review, the court noted that the defendants had questioned Greenberg's copyright claims because he had not registered his copyright in any of the photographs at issue. The court found, however, that "Greenberg has provided the Court with evidence . . . that on [December 18, 1985]<sup>2</sup> Society assigned to him the copyrights in these photographs." (Emphasis added). The transfer of copyright from the Society to the Greenberg plainly was before the district court and is not, as appellees claim, "a new contract theory." (Motion to strike 4). The only issue raised in the appellees' motion to strike is whether Greenberg is raising his copyright transfer argument for the first time on appeal.

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<sup>1</sup>Transfer of copyright is synonymous with assignment of copyright. See, e.g., 18 C.J.S. Copyrights § 27 (West 1990) ("A transfer of copyright ownership is an assignment . . . of a copyright").

<sup>2</sup> The district court's order identified the date of the assignment as December 18, 1995. On the transfer instrument itself, the date is shown as December 18, 1985. The error obviously is a clerical one.



The appellees claim that they “did not have the opportunity to develop facts relevant to” the issue of transfer of copyright to Greenberg. (Motion to strike 3). However, the transfer instruments, as shown above, formed the very basis for Greenberg’s infringement claims, and the Society, in its reply summary judgment memorandum, *had every opportunity* to challenge those instruments. It did not do so. The “facts” the Society now belatedly asserts it “*could* have established,” (Motion to strike 3-4), are not supported by *any* citation to the record, indeed are not in the record below, and should be ignored by this Court. For example, the Society attached to its motion to strike a November 15, 1985, letter from Jerry Greenberg to the Society. (Motion to strike 3). This letter is *not* in the record and should not be considered. See Hauptman & Loeb Co. v. Hooven-Owens-Rentschler Co., 262 F. 408 (5<sup>th</sup> Cir. 1920) (“Papers not forming part of the record . . . are not properly before the reviewing court”).<sup>3</sup>

If, notwithstanding the points made above, this Court should elect to consider the November 15, 1985, letter from Greenberg to the Society, the outcome would be the same. The ensuing December 18, 1985, transfer instrument prepared by the Society and “assign[ing] to [Greenberg] all right, title and interest, including copyright” has nothing to do with Greenberg’s earlier letter. Whatever limitation

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<sup>3</sup>Such a letter does not comport with the requirements for judicial notice pursuant to Fed. R. Civ. P. 201 -- nor have appellees requested such notice.

Greenberg may have proposed in November was not incorporated in the December transfer instrument, which has no limitation, condition, or qualification on the rights being transferred. The December instrument was prepared by the Society's Corporate Counsel, who can be presumed to know what she was doing, and it was notarized.<sup>4</sup>

Furthermore, if this Court elects to consider the November 15, 1985, letter from Greenberg to the Society, this Court should also consider that in 1989, four years after the transfer of rights to Greenberg, the Society contracted with him for the use of a 1962 photograph (that was encompassed in the December, 1985, transfer instrument) in a forthcoming 1990 Magazine article. (Greenberg Affid. ¶¶ 3-9).<sup>5</sup> Greenberg consented to its use in the 1990 article, and the Society paid him for the use. Id. As part of that agreement, Greenberg insisted that notice of his copyright accompany the 1962 photograph when it appeared in the 1990 article. The Society agreed. Id. A copy of the photograph from the 1990 magazine issue is attached to the Greenberg affidavit. Id. In text beneath the photograph appears "© 1962, 1990 JERRY GREENBERG (ABOVE); JERRY GREENBERG." Id. The Society's conduct in

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<sup>4</sup>Similarly, the fact that initially "the Society assigned Mr. Greenberg . . . to produce [the] photographs," (Motion to strike 3) – in other words, that the photographs may initially have been works for hire – is simply irrelevant because the Society's subsequent transfer of copyright over the photographs to Greenberg supersedes any ownership by the Society.

<sup>5</sup>Greenberg's affidavit is attached to and incorporated into this response.

1990 is clear evidence that the Society understood that it no longer had a copyright interest in the 1962 photograph.

The Society has wrongly asserted that transfer (or reassignment) of the copyrights was raised for the first time in this Court. The motion to strike should be denied.

II.

Failure to Consider The Transfer of Copyright  
Legal Issue Would Result in Miscarriage of Justice

In the alternative, even if this Court were to agree with appellees that the appellants are raising for the first time on appeal the argument that the Society transferred copyright to Greenberg prior to the Society's release of the Complete Geographic product, this Court should consider that argument because failure to do so would result in injustice. See Skinner v. City of Miami, Fla., 62 F.3d 344, 348 (11<sup>th</sup> Cir. 1995) "Although as a general rule, an appellate court will not consider a legal issue or theory raised for the first time on appeal, [this Court has] discretion to do so if the new issue or theory 'involves a pure question of law, and if refusal to consider it would result in a miscarriage of justice.'" Id. (citations omitted). Here, as in Skinner, "[t]he issue . . . was not ignored entirely during the proceedings below." Skinner, 62 F.3d at 348 (counsel's verbal objection to wording of proposed jury instructions constituted "minimal attention"). Moreover, as shown above in Part I,

no additional facts could have been developed that could have refuted that, as a matter of law, the Society's 1985 letter transferring copyright to Greenberg speaks for itself and is final on the issue.

This case is similar to United States v. Southern Fabricating Co., 764 F.2d 780 (11<sup>th</sup> Cir. 1985). In that case, the United States argued that a statute of limitation did not apply because the complaint was predicated on "piercing the corporate veil," an equitable action not governed by the relevant statute. Southern Fabricating Co., 764 F.2d at 781. On appeal, however, the United States argued that the district court erroneously failed to address the applicability of the statute at issue to the enforcement of a consent judgment. Id. "The appellees urge[d] that this contention was neither raised in nor considered by the district court and, therefore, may not now be advanced on appeal." Id. In deciding to consider the issue, this Court took into account the United States' characterization below of the consent judgment, both in its complaint and in its motion for summary judgment, and this Court considered that the United States' argument in the district court was not "wholly inconsistent with its claim" below. Id. at 783. Similarly, in this case, to avoid a miscarriage of justice, this Court should agree with Greenberg that the Society transferred copyright to Greenberg.<sup>6</sup>

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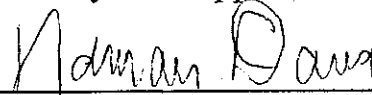
<sup>6</sup>Appellees' reliance on Estate of Martin Luther, King, Jr., Inc. v. CBS, Inc., 194 F.3d 1211, 1220 (11<sup>th</sup> Cir. 1999) for the proposition that "arguments not raised

CONCLUSION

For the foregoing reasons, appellants Jerry Greenberg and Idaz Greenberg respectfully request this Court to enter an order denying the appellees' motion to strike appellants' arguments not raised below.<sup>7</sup>

Respectfully submitted,

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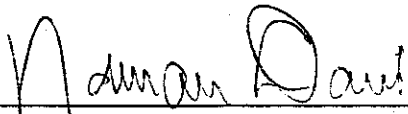
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below are deemed waived, and may not be raised on appeal absent plain error," (Motion to strike 4), is inapposite because here, unlike there, the district court *did* address the argument and facts at issue. Similarly, the Greenbergs here are not "argu[ing] a different case from the case [they] presented to the district court." See Motion to strike 4 (citing Irving v. Mazda Motor Corp., 136 F.3d 764, 769 (11<sup>th</sup> Cir. 1998)).

<sup>7</sup>Even if this Court were to grant appellees' motion to strike with respect to the December, 1985, transfer, appellants' arguments with respect to the 1989 transfer would still stand.

**CERTIFICATE OF SERVICE**

I hereby certify that a copy of the foregoing opposition to motion to strike was served by hand on Edward Soto, Esq., Weil, Gotshal & Manges LLP, 701 Brickell Avenue, Suite 2100, Miami, FL 33131; and by Federal Express on Robert G. Sugarman, Esq., Weil Gotshal & Manges LLP, 767 Fifth Avenue, New York, NY 10153 this 28 day of April \_\_\_\_, 2000.

  
\_\_\_\_\_  
Norman Davis

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Defendants/Appellees.

**AFFIDAVIT OF JERRY GREENBERG IN SUPPORT  
OF APPELLANTS' OPPOSITION TO APPELLEES'  
MOTION TO STRIKE ARGUMENTS NOT RAISED BELOW**

Jerry Greenberg affirms as follows, under penalty of perjury:

1. My name is Jerry Greenberg. The statements in this affidavit are based on my personal knowledge.
2. I reside at 6840 S.W. 92<sup>nd</sup> Street, Miami, Florida. With my wife, Idaz Greenberg, I have a small publishing business known as Seahawk Press.
3. On December 18, 1985, the National Geographic Society ("the Society") transferred, or assigned, to me all of its copyright interest in specified photographs

that appeared in the January 1962, February 1968, and May 1971 issues of the monthly National Geographic Magazine.

4. In 1989, the Society was preparing an article to be published in the monthly magazine concerning the underwater Pennekamp State Park in the Florida Keys. That article later appeared in the July 1990 issue of the Society's monthly magazine.

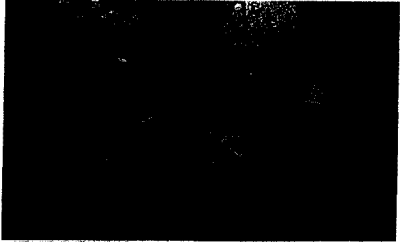
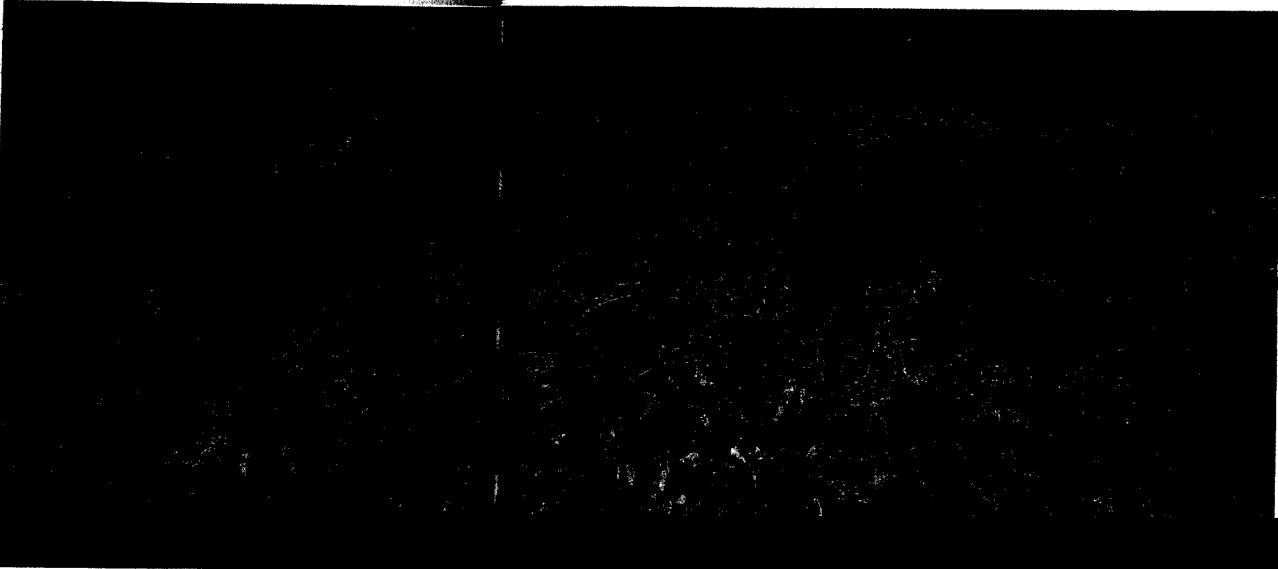
5. The Society asked my permission to include in the 1990 article a composite underwater photograph, showing a portion of the state park, that I had taken almost three decades earlier. The photograph had appeared originally in the January 1962 issue of the Society's monthly magazine. The Society's December 1985 transfer to me of "all right, title and interest, including copyright" in specified photographs that had previously been published in the magazine encompassed the photograph sought to be used in 1990.

6. In due course I gave permission for that specific use in the 1990 article, and I was paid an appropriate sum by the Society for the use.

7. As a condition of the use in the 1990 article, I specified that text giving notice of my copyright interest in the photograph must appear alongside the photograph in the 1990 article. The Society agreed to that request.







© 1981, 1989 JERRY GREENBERG (TOP); FRED WARD (BOTTOM)

A wondrous realm unfolds in a panorama taken by Jerry Greenberg at Carysfort Reef in 1960 (top). Golden branches of elkhorn coral stand beside brain coral, at lower right. In the same region 29 years later, coral was reduced to a mass of stumps. To compare such areas, author Fred Ward (above) uses laminated old photographs.

made by living organisms, coral reefs are the handwork of small marine animals called polyps, which reproduce asexually. After a polyp dies, it leaves behind deposits of calcium carbonate upon which live polyps build. When nutrient levels soar from such sources as human sewage and fertilizers washed from farmland, algae can overwhelm and smother the polyps.

Earth's largest formations

1960

1989