

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF FLORIDA

JERRY GREENBERG, individually,
and IDAZ GREENBERG, individually,

Plaintiffs,

CASE NO. 97-3924
CIV-LENARD
Magistrate Judge Turnoff

vs.

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

Defendants.

**PLAINTIFFS' MEMORANDUM
IN RESPONSE TO DEFENDANTS'
MOTION TO DISMISS OR FOR
SUMMARY JUDGMENT**

Plaintiffs, JERRY GREENBERG and IDAZ GREENBERG ("the Greenbergs"), submit this memorandum in response to Defendants' Motion to Dismiss Count II and to Dismiss Or For Summary Judgment on Counts III-V of Plaintiffs' Amended Complaint.

STATEMENT OF UNDISPUTED MATERIAL FACTS

The National Geographic Society ("the Society") is a not-for-profit corporation formed in the District of Columbia, and its principal place of business is there. Defs. Answer ¶ 5. National Geographic Enterprises, Inc. is a wholly-owned for-profit subsidiary of the Society. Thomas Stanton Declar. ¶ 1. The Society or a subsidiary relies on a marketing and distribution agreement with Mindscape, Inc. to distribute and sell The Complete National Geographic on CD-ROM ("the Complete Geographic"), among other projects. Stanton Declar., Ex. B.

The Complete Geographic¹ was first distributed in 1997, and incorporates 108 years of the National Geographic monthly magazine, through the year 1996, amounting to more than 1,200 issues of the magazine. Thomas Stanton Declar. ¶ 3. The Complete Geographic product consists of approximately 30 discs for display through a computer. Stanton Declar., Ex. A. The materials in the Complete Geographic are clustered by decade, and within the box containing the 30 discs the monthly magazines for each decade are segregated in separate packages. *Id.* Each disc will display the covers of all issues for any given year within that decade. *Id.* A purchaser of the Complete Geographic must buy the entire 30-disc set, although the defendants have had a decade-a-month purchase plan, whereby, for example, discs encompassing magazine issues for the 1990s are available.

As to the specific magazines included in the Complete Geographic, a computer can display an image of each page of the magazine as it appeared in hard copy, including all articles, photographs, graphics, advertising, notices of copyright, and attributions. Defs. Mem. at 6. At two places on the labeling that adorns the box containing the 30 discs appears the following: "Relive 100 years of classic advertisements as they appeared in over a century of National Geographic magazine." Stanton Declar., Ex. A. Additionally, promotional literature distributed by the Society for the Complete Geographic product included the following invitation: "Relive 100 years of classic advertisements as they appeared in over a century of National Geographic magazine." Idaz Greenberg Affid., Attach. A.

The Society's literature states that the magazine is available for advertising purposes in "worldwide, international, U.S., regional, statewide, metro, and 'test'" editions, as well as an edition published in the Japanese language. John David Affid. Therefore, many variations of the monthly magazine, bearing different advertising or a different language, are not included in the Complete Geographic product. The box in which the Complete Geographic is packaged says on the printed cover that "The Complete National Geographic on CD-ROM was produced from an archive of magazines collected in a central repository, and is not representative of any single

¹ This memorandum utilizes the term "Complete Geographic," as it appears in the Amended Complaint. The defendants' memorandum refers to the product as CD-ROM 108.

regional edition of the magazine.” Stanton Decl., Ex. A. The same statement appears on the label attached to each of the 30 discs. Id. The same statement appears on screen at the end of the display on each disc. Id.

No product like the Complete Geographic existed prior to 1997. Stanton Declar. ¶ 3. Each disc, when activated, displays a moving logo of a globe with music, and a 30-second advertisement for Kodak with sound. Stanton Declar., Ex. A. As an introductory logo, each disc also contains a multi-media sequence of moving magazine covers (“the Moving Covers Sequence”) that serves as thematic material for the Complete Geographic. That sequence consists of the front covers of ten selected issues of the Society’s monthly magazine. Id. The ten covers are electronically and visually manipulated so that they metamorphose from one to another. Id. One of the ten covers utilized in the Moving Covers Sequence is taken from the January 1962 issue of the Society’s monthly magazine that features a photograph of a female diver, using scuba gear, shown swimming among corals and fishes. Jerry Greenberg Affid. The photograph was taken by Mr. Greenberg. Id.

The Society stores and sells single back-issues of the monthly magazine if issues for particular months are available. Idaz Greenberg Affid. A month-by-month and year-by-year search would have to be made to determine availability. Id. Where issues do not exist in a warehouse, paper reprints of those issues are not available. Id.

The Society has in its possession or control hundreds of photographs taken by Mr. Greenberg, or duplicates or electronically-scanned images of those photographs. Id.

The Complete Geographic product contains more than a dozen photographs taken by Mr. Greenberg for which he owns exclusive copyright. Id. Those copyrights have been timely registered and/or renewed with the U. S. Copyright Office. Id.

The Society placed the following notice on the Complete Geographic: “© 1997 National Geographic Society. All rights reserved.” The notice appears on the outside of the box containing the Complete Geographic, on the label attached to each disc in the box, and in the visual display contained on each disc. Stanton Declar., Ex. A. When a single “page” display on the computer is downloaded and printed, the 1997 copyright notice appears at the bottom of the

hard copy. *Id.* The printed matter on the outside of the box containing the discs encourages the user to “print spectacular photographs and articles in color or black and white.” *Id.*

Jerry Greenberg never received a copy of the May 21, 1997 letter described by Thomas Stanton in paragraph 9 of his affidavit, attached to the defendants’ memorandum, nor did he receive any other communication from any of the defendants regarding his photographs. J. Greenberg Affid.

ARGUMENT²

I. **ALL OF THE RELEVANT GREENBERG COPYRIGHTS ARE REGISTERED**

The defendants seek dismissal of Counts II-V because the Amended Complaint does not allege in those counts that all pertinent copyrights were registered. The memorandum argues a lack of jurisdiction. The motion, however, invokes Rule 12 (b) (6), which has nothing to do with jurisdiction. In all counts of the Amended Complaint the allegations are that the Greenbergs own valid and exclusive copyrights; they would not be valid for litigation purposes had they not been registered. An affidavit by Jerry Greenberg, attached hereto as Exhibit A, identifies with particularity each and every registration and renewal.

The Greenbergs urge the Court to minimize disruption to the case on this issue, and to consider the somewhat similar circumstances involving copyright registration in M.G.B. Homes, Inc. v. Ameron Homes, Inc., 903 F.2d 1486, 1489 (11th Cir. 1990), where the Eleventh Circuit quoted Rule 61, Federal Rules of Civil Procedure, to the effect that “[t]he court at every stage of the proceeding must disregard any error or defect in the proceeding which does not affect the substantial rights of the parties.” The defendants are not prejudiced by the technical omission. Nonetheless, the Greenbergs are prepared to amend the complaint if necessary, or to take any other corrective action directed by the Court.

² This memorandum attempts to correspond as much as possible to the arguments and the format utilized in the defendants’ motion.

**II. THE COMPLETE GEOGRAPHIC IS NOT MERELY
A BOX FILLED WITH REPRINTS, BUT IS
A NEW COLLECTIVE WORK**

Count III of the Amended Complaint alleges infringement of copyright by the defendants because the Complete Geographic, as a new collective work, incorporates the protected photographs of Jerry Greenberg without his consent. In their memorandum, the defendants contend in Part II starting on page 4 that the incorporation of the photographs is protected by Section 201 (c) of the Copyright Act. The defendants have not answered Counts II, III, IV and V of the Amended Complaint.

**A. The Complete Geographic is
Not a "Reissuance" or a "Reprint."**

The parties agree that each separate monthly issue of the Society's magazine is a collective work, pursuant to 17 U.S.C. § 101. The defendants maintain that the Complete Geographic is merely a "reissuance" or a "reprint" of more than 1,200 collective works in a different medium. Defs. Mem., Ex. B. Plaintiff Jerry Greenberg's position is that he holds valid copyrights to many photographs that originally appeared in various monthly issues, and that have been reproduced without his consent in the Complete Geographic.

The defendants contend that ownership of copyright in each of the monthly issues (each a collective work) that are germane to this case entitles them pursuant to Section 201(c) of the Copyright Act to reprint those monthly issues and the Greenberg photographs they contain. But Section 201 (c) expressly limits the reproduction by the defendants of separate contributions to a collective work, such as the Greenberg photographs, and says that any reproduction of an underlying copyrighted contribution must be

part of that collective work [the particular monthly magazine], any revision of that collective work [the particular magazine], and any later collective work in the same series.

17 U.S.C. § 201(c) (emphasis and bracketed material added). The Complete Geographic falls within none of those permitted reproductions. Under 201 (c), a reproduction or reissue of a

particular monthly magazine containing Greenberg photographs would be permissible. Indeed, the four magazines (from 1962, 1968, 1971 and 1990) containing Greenberg photographs may be purchased in single-copy form from the Society. *Idaz Greenberg Affid.* Such use of the Greenberg photographs does not constitute infringement.

The reference in Section 201 (c) to “any later collective work in the same series” can only implicate a subsequent issue of the monthly magazine, where reproduction would be permissible.

The defendants cite to Tasini v. New York Times Co., 972 F.Supp. 804 (S.D.N.Y. 1997), aff'd on rehearing, 1997 WL 681314 (Oct. 29, 1997), for the conclusion that the Copyright Act is medium-neutral. The Greenbergs' claims do not suggest otherwise. The principal holding in Tasini was that the reproductions at issue there were permissible revisions of individual collective works, such as a daily issue of the New York Times. As to Section 201 (c), neither the plaintiffs nor the defendants in this case contend that the Complete Geographic is a revision of a prior collective work. See Defs. Mem. at 6.

The legislative history cited in the defendants' memorandum at page 7 actually undermines the defendants' position. The House Report reflects the lawmakers' intention, in writing Section 201 (c), to restrict any republication of a separately copyrighted contribution (such as the Greenberg photographs) contained within a collective work (such as an issue of the Society's monthly magazine) to “certain limited circumstances,” as described in the report:

[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 revision 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.

H.R.Rep. No. 2237, 89th Cong., 2d Sess. 117 (1966), referenced in the final committee report on the 1976 Copyright Act, H.R. Rep. No. 1476, 94th Cong., 2d Sess. 122-23 (1976) (emphasis added). As discussed below, the Complete Geographic violates that restriction.

B. The Complete Geographic is a New Collective Work.

Other portions of the Copyright Act are implicated in this dispute. A “collective work” is defined in the Copyright Act 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 whole.

17 U.S.C. § 101. “A collective work ... consists of numerous original contributions which are not altered, but which are assembled into an original collective whole.” Tasini, 972 F.Supp. at 812. Moreover, a “collective” work is a subset of “compilation” which is defined in the Act as

a work formed by the collection and assembling of preexisting materials or of data that are selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes an original work of authorship. The term “compilation” includes collective works.

Id. “The originality requirement [for a compilation] is not particularly stringent. A compiler may settle upon a selection or arrangement that others have used; novelty is not required. Originality requires only that the author make the selection or arrangement³ independently ... and that it display some minimal level of creativity.” Feist Publishers v. Rural Tel. Serv., 499 U.S. 340, 346, 111 S.Ct. 1282, 1287 (1991). In the context of selection and arrangement, the Second Circuit has said that “[i]n the law of copyright, only an unmistakable dash of originality need be demonstrated; high standards of uniqueness in creativity are dispensed with.” Weissman v. Freeman, 868 F.2d 1313, 1321 (2d Cir. 1989). “Originality means only that the work ‘owes its origin to the author’ -- i.e., that the work is independently created, rather than copied from other works.” Reader’s Digest Ass’n v. Conservative Digest, Inc., 821 F.2d 800, 806 (D.C. Cir. 1987) (quoting Alfred Bell & Co. v. Catalda Fine Arts, Inc., 191 F.2d 99, 102 (2d Cir. 1951)). “[C]ompilations, and collective works, are characterized by the fact that they possess relatively little originality. . . .” Tasini, 972 F.Supp. at 814. See also Baltimore Orioles v. Major League Baseball Players, 805 F.2d 663, 668 n.6 (7th Cir. 1986) (a work is original if it is the creation of its author). “[T]he originality called for in a collective work consists of the collection and

³ “The requisite originality [in a collective work] may inhere in selection or arrangement alone, even if the other ingredient is lacking.” 1 NIMMER ON COPYRIGHT § 2.04[B] (footnotes omitted). Thus, the Complete Geographic, in selection or arrangement of its contents, qualifies as a collective work.

assembling of pre-existing materials. . . .” 1 NIMMER ON COPYRIGHT § 3.02 at 3-7. Originality in a collective work does not require the addition of new materials. Id. § 3.03 at 3-9, 10. See also E. F. Johnson v. Uniden Corp., 623 F.Supp. 1485, 1500 (D. Minn. 1985) ().

By these legal standards, the Complete Geographic is a new collective work. It is new because nothing like it existed before, and it is therefore original. It is original, moreover, because of the selection and arrangement of things included (and excluded) from the work. The defendants concede that nothing like it ever existed before. Apart from the new product, no collection of the monthly magazines covering 108 years has ever existed previously in any medium. Hard-copy issues of some of the monthly magazines -- but not all -- are stored in warehouses and can only be purchased individually for varying prices. Idaz Greenberg Affid. The final issue of the monthly magazine incorporated in the Complete Geographic product was published in December 1996. The Complete Geographic was produced in 1997 and sales began in that year. Defs. Mem., Ex. B. This is further confirmed by the use of the year 1997 in the copyright notice affixed to the product. The Copyright Act requires such notice to state “the year of first publication of the work.” 17 U.S.C. § 401(b)(2). Each notice includes the assertion “all rights reserved,” which has legal implications for protecting copyright under various international copyright treaties. The large box containing 30 discs, as well as each box within containing a decade’s discs, each contain unique and original ISBN numbers, which are used for cataloging by some repositories.

Furthermore, the label on the box containing the 30 discs proclaims an “unprecedented CD-ROM collection.” (Emphasis added). It is an unprecedented collection in any medium.⁴ In the new product, the magazines are sold only as a collection. A purchaser of the Complete Geographic must purchase the entire 30-disc collection covering 108 years, or a smaller

⁴ The May 21, 1997 letter attached to the Thomas Stanton Declaration states that the republishing of “this magazine” on CD-ROM is “comparable to magazines being made available on microfiche.” The issue, however, is not the medium used (as the defendants’ memorandum stresses) but whether the microfiche product would be a new collective work. A single issue of the monthly magazine produced in its entirety on microfiche would not qualify as a new collective work, but 1200-plus issues duplicated on microfiche and packaged and sold only as a collection would.

collection covering an entire decade. The Complete Geographic product is certainly new and unique.

The new product is a collective work “formed by the collection and assembling of preexisting materials ... that are selected, coordinated, or arranged.” 17 U.S.C. § 101. The defendants assert that the Complete Geographic “displays an image of each page of the Magazine *exactly* as it appeared in hard copy, including all articles, photographs, graphics, advertising, notices of copyright, and attributions.” Defs. Mem. at 6. (Emphasis in original). That may be true of those magazines that the defendants chose to place in the Complete Geographic, but the defendants left out of the collection other versions of the monthly magazine that were different in some way, as in advertising or language. The defendants thus engaged in selection that included some magazines or editions, and omitted others.

The box in which the Complete Geographic is packaged says on the printed cover that “The Complete National Geographic on CD-ROM was produced from an archive of magazines collected in a central repository and is not representative of any single regional edition of the magazine.” The same language appears on the label attached to each of the 30 discs, and it also appears at the end of the display on each disc. The Society’s own advertising literature states that the magazine is available for advertising purposes in “worldwide, international, U.S., regional, statewide, metro, and ‘test’” editions, as well as an edition published in the Japanese language. John David Affid. attachments. The defendants thus exercised considerable discretion in selecting editions to be included and excluded.⁵

The materials in the Complete Geographic are clustered by decade, and within the box containing the 30 discs the monthly magazines for each decade are segregated on discs placed in separate packages. Each disc will display the covers of all issues for any given year within that decade. The Society’s magazines have never been packaged or marketed in such a fashion. Each disc, when activated, displays an elegant moving logo of a globe, a multi-media Moving Cover

⁵ The defendants considered advertisements in the magazine over the decades to be an important ingredient of the Complete Geographic product. At two places on the labeling that adorns the box containing the 30 discs appears the following: “Relive 100 years of classic advertisements as they appeared in over a century of National Geographic magazine.”

Sequence that also serves as a logo, and a multi-cover display page for each year of the 108 years of publication. Each disc contains a 30-second advertisement for Kodak. When each disc is exited, a series of moving graphics displays lengthy credits for those who participated in the project. Any single page displayed on screen has the capacity to be downloaded and printed, in color or black-and-white. Every such page, when printed, contains 1997 copyright notice across the bottom.

The Complete Geographic, therefore, is not merely a box containing reprints of magazines, but is a new and original collective work.

**C. The Inclusion of the Greenberg Photographs
Infringes His Copyright in Those Photographs**

The Complete Geographic contains many photographs created by Jerry Greenberg, for which he is the sole owner of copyright. The photographs were included in the new collective work that is the Complete Geographic against his express instructions. Such inclusion amounts to infringement of his copyrights.

“The copyright [in a collective work] is independent of, and does not affect or enlarge the scope, duration, ownership, or subsistence of, any copyright protection in the preexisting material.” 17 U.S.C. § 103 (b). Copyright protection for the Complete Geographic product does not diminish Jerry Greenberg’s copyright protection in his photographs that are contained in that product. “Under Section 103 (b), any unauthorized use of preexisting protected material by the creator of a derivative or a collective work infringes the copyright existing in that preexisting material.” Tasini, 972 F.Supp. at 814.

If the Complete Geographic is not a new product and is merely a reprinting of the earlier issues, with no copyright liability for the defendants for using the protected works of others contained in earlier issues, the defendants will have unlimited opportunity to exploit protected works of others that have been gathered over decades, for purposes never conceived by either side, in still other “reprints” that can take many forms. The economic reality is that offering a back issue or a reprint of the May 1956 issue of the magazine, or the November 1974 issue, or any other single issues, on its face has extremely limited appeal. The earlier issues have profit-

making marketability only when collected with others and packaged in new and original works in such a way that consumers will be enticed to buy.⁶ This in no way demeans the significance or quality of the Society's products or the noble purposes for which the Society says it exists. But as with any other publisher, the Society and its affiliates may not with such business strategies transgress the protections afforded by the Copyright Act to creative artists such as Jerry Greenberg.

The defendants' memorandum in Part II does not defeat the allegations in Count III of the Amended Complaint with respect to a new collective work, and summary judgment on that claim cannot be granted to the defendants.⁷

III. BECAUSE THE DEFENDANTS HAVE MADE PROMINENT USE OF A GREENBERG PHOTOGRAPH IN THE MOVING COVERS SEQUENCE, SUCH INFRINGEMENT CANNOT BE DE MINIMIS

The defendants' argument in Part III of their memorandum is directed at Count V of the Amended Complaint. The defendants have not answered the allegations in Count V, and have not asserted defenses to that claim. Nonetheless, in Part III they have invoked a de minimis defense⁸ with respect to Count V. The defendants' motion for summary judgment as to Count V

⁶ The Court can note that single issues that may be available are sold by the Society itself, a nonprofit corporation. *Id.* Greenberg Affid. The Complete Geographic, on the other hand, is prepared and marketed by one or more for-profit subsidiaries created by the Society, with licensing extended to defendant Mindscape, another for-profit entity. Defs. Memor. at 2, n.2.

⁷ In a motion, the plaintiffs are voluntarily seeking dismissal of the claim in Count IV of the Amended Complaint that the Complete Geographic constitutes a derivative work. However, in pursuing Count V, the plaintiffs will contend, inter alia, when their response to the defendants' "fair use" argument is presented to the Court, that the impermissible use of the Greenberg photograph in the Moving Cover Sequence involves the creation by the defendants of a derivative work.

⁸ Establishing a de minimis contention is the defendants' burden. See generally 2 NIMMER ON COPYRIGHT § 8.01 [G].

should be denied because the defendants' infringement in the Moving Covers Sequence is not de minimis.⁹

A. The Use of the Greenberg Photograph Cannot Be De Minimis Because the Defendants Have Thrust the Photograph to the Forefront of Every One of its Discs in the Complete Geographic

Part III of the defendants' memorandum argues that since the Greenberg cover photograph appears in the Moving Covers Sequence for less than one second,¹⁰ it is a de minimis use and thus not actionable. The defendants, however, cite no authority to support the proposition in Part III that de minimis is defined solely on the basis of quantity of use rather than quality of use. Indeed, "even a small usage may be unfair if it is of critical importance to the work as a whole and taken by the infringer in order to save the time and expense incurred by the copyright owner." Meredith Corp. v. Harper & Row Publishers, Inc., 378 F. Supp. 686, 693 n.12 (S.D.N.Y. 1974), aff'd, 500 F.2d 1221 (2d Cir. 1974); see also Horgan v. MacMillan, Inc., 789 F.2d 157, 162 (2d Cir. 1986) ("Even a small amount of the original, if it is qualitatively significant, may be sufficient to be an infringement"); Metro-Goldwyn-Mayer, Inc. v. American Honda Motor Co., 900 F. Supp. 1287, 1300 (C.D. Cal. 1995) ("[T]he Court must look to the quantitative and qualitative extent of the copying involved. . . . Plaintiffs should prevail on this issue . . . [because] the brevity of the infringing work when compared to the original does not excuse copying."); Chicago Record-Herald Co. v. Tribune Ass'n, 275 F. 797, 799 (7th Cir. 1927) (rejecting defendant's de minimis argument because "[w]hether the appropriated publication constitutes a substantial portion of [the defendant's infringing article] cannot be determined alone

⁹ As set forth later in this memorandum, the plaintiffs are unable to respond adequately to Part IV of the defendants' memorandum, which asserts the statutory defense of fair use, without appropriate discovery of facts. Part IV includes, in sub-part C, a discussion of the "amount and substantiality" of use as an aspect of fair use, which overlaps with the de minimis argument in Part III. The plaintiffs' response to Part III of the memorandum, therefore, is not a waiver of their right to challenge all of the components of Part IV when adequate information is in hand.

¹⁰ A genuine issue of fact exists as to the duration of the appearance of the Greenberg photograph in the Sequence. See Idaz Greenberg Affidavit, ¶ 7.

by lines or inches which measure the respective articles.”). The defendants cannot now attempt to trivialize a photograph they made the conscious decision to highlight in the Moving Covers Sequence.

The Complete Geographic consists of 108 years of versions of the monthly magazine. Altogether, the Complete Geographic features more than 1200 issues of the magazine published between 1888 and 1996. These 1200-plus issues are spread out over 30 compact discs. Amid the more than 1200 issues of the magazine on the 30 discs, a photograph by Jerry Greenberg appears prominently on the cover of the January 1962 issue.

The defendants admit that they created the Moving Covers Sequence to run at the beginning of every one of the 30 discs. (Memorandum, at 2). As the defendants admit, the purpose of this Moving Covers Sequence is to provide “a series of images which transition from one into another vividly illustrating the broad range of topics and issues that [the Complete Geographic] and the Magazine address.” *Id.* (emphasis added). With these expressed goals of (1) transition, and (2) vivid illustration in mind, the defendants had to select carefully the right images to effectuate their purpose. This means that the images could not have been chosen at random, and the defendants do not argue that this was the case. Indeed, the defendants had to choose the right images from more than 1200 magazine covers to create their dramatic Moving Covers Sequence. Out of the 1200-plus magazine covers, the defendants settled upon ten. Ten magazine covers with images that could meet the goals of the Moving Covers Sequence by (1) transitioning smoothly into another image, and (2) providing a vivid illustration of the topics addressed by the magazine. From more than 1200 magazine covers, the defendants chose the Greenberg cover photograph as one of the ten. Those ten images, in the context of their placement, use and prominence in the Complete Geographic product, are nothing less than iconic in terms of their significance to the product.¹¹

¹¹ An instruction sheet that accompanies the discs inside the product box refers to the sequence as “The Complete National Geographic icon.” Thomas Stanton Affid., Ex. A. An icon can be said to be a symbol of the magazine. H. Mifflin Co., *THE AMERICAN HERITAGE DICTIONARY* at 638 (2d Coll. Ed.).

The defendants cannot now downplay the significance of this choice by dismissing it as “de minimis.” See Educational Testing Servs. v. Katzman, 793 F.2d 533, 542 (3d Cir. 1986) (rejecting defendants’ de minimis argument that they copied only a “handful” of test questions out of thousands produced by plaintiff; court looked instead to the “qualitative value of the copied material, both to the originator and to the plagiarist.”); Elsmere Music, Inc. v. National Broad. Co., 482 F. Supp. 741, 744 (S.D.N.Y. 1980) (rejecting defendant’s de minimis argument because, even though defendant copied only four notes and two words from a song of 100 measures and 45 words, “[u]se of such a significant (albeit less than extensive) portion of the composition is far more than merely a de minimis taking.”), aff’d, 623 F.2d 252 (2d Cir. 1980). The defendants have thrust the Greenberg cover photograph to the forefront of every one of its discs in the Complete Geographic. No law is required to conclude that the decision to place his photograph on a magazine cover in 1962 represented a high tribute to the quality of his work. It was an even higher tribute to Greenberg’s work that the defendants chose to use his photograph to epitomize all the cover photographs that have come before. In essence, along with nine other photographs in the Moving Covers Sequence, the Greenberg photograph has become emblematic of all of the magazines in the Complete Geographic collection.

In addition, unlike the other photographs in the Complete Geographic, the plaintiff’s photograph does not sit silently on a page within one of the 1200-plus issues on one of the 30 discs until someone finds it. Rather, the photograph finds you. Every time someone views any one of the 30 discs, he or she views the Moving Covers Sequence. The only way to avoid viewing the Moving Covers Sequence each time a disc is opened is for the viewer to make a conscious decision to mouse-click it away.¹² Except for the nine other photographs within the Moving Covers Sequence, no other image is granted such exalted status within the Complete Geographic as the Greenberg photograph.

¹²It is axiomatic that the amount of times an individual views the Moving Covers Sequence depends on the individual’s own taste. But the fact that the Complete Geographic enables a viewer to mouse-click the Moving Covers Sequence away does not alter the fact that the Moving Covers Sequence begins playing automatically, without any prompting from the viewer. Moreover, the defendants cannot know whether, or how often, the Moving Covers Sequence will be stopped by clicking.

Furthermore, the defendants' de minimis argument should be rejected because the case law cited in Part III of their memorandum does not support their position. The defendants rely largely on two cases, Ringgold v. Black Entertainment Television, Inc., 126 F.3d 70 (2d Cir. 1997) and Amsinck v. Columbia Pictures Indus., Inc., 862 F. Supp. 1044 (S.D.N.Y. 1994).

Ringgold, in reality, provides support for the Greenbergs. In Ringgold, the defendant used a poster of a copyrighted image in the background scenery in one of its television shows. 126 F.3d at 73. As in the instant case, the defendants invoked the de minimis defense in a motion for summary judgment prior to discovery. Id. at 73. The defendants argued that the use was de minimis because "the television viewer sees no more than 'some vague stylized [sic] painting . . . ' and can discern none of [the plaintiff's] particular expression of her subjects." Id. at 77 (quoting from the defendants' brief). The Second Circuit, however, rejected this argument and held that the de minimis threshold for actionable copying of protected expression had been crossed. Id. Using language particularly appropriate for the instant case, the court found it "disingenuous" for defendant Home Box Office, "whose production staff evidently thought that the poster was well suited as a set decoration for the [scene] . . . , now to contend that no visually significant aspect of the poster is discernible." Id.

Similarly, the defendants here are attempting now to diminish the importance of a photograph they deemed well-suited for inclusion in a highly-select group of photographs chosen to represent the history of the magazine. In Ringgold, the artist's work was part of background scenery. Here, the photograph serves as an emblem for the entire 108-year magazine collection.

The defendants also cannot find support in Amsinck, which is clearly distinguishable from the instant case. In Amsinck, without the artist's permission, the defendants used a crib mobile that featured the plaintiff's artwork as part of the set decoration in a film. Id. at 1046. In contrast, the Greenberg photograph at issue is not some incidental decoration for the Complete Geographic, but as discussed above it is given stage-center prominence, in a highly symbolic manner, on every disc in the 30-disc collection. See Harper & Row Publishers, Inc. v. Nation Enters., 471 U.S. 539, 566, 105 S. Ct. 2218, 2233 (1985) ("In view of the expressive value of the excerpts and their key role in the infringing work, we cannot agree with the Second Circuit that

the 'magazine took a meager, indeed an infinitesimal amount of [the] original language.'") (citation omitted).

This Court should reject the defendants' argument in Part III of their memorandum that quantity of use alone determines what crosses beyond the de minimis threshold.

B. The Defendants' Inclusion of the Photograph Cannot Be De Minimis Because the Defendants Used the Entire Photograph, and Not Just a Fragment, in the Sequence

The defendants' de minimis argument also should be rejected because the defendants used Jerry Greenberg's entire photograph, and not just a fragment, in the Moving Covers Sequence. "As a rule, a taking is considered de minimis only if it is so meager and fragmentary that the average audience would not recognize the appropriation." Fisher v. Dees, 794 F.2d 432, 434 n.2 (9th Cir. 1986); accord Epic Metals Corp. v. Condec, Inc., 867 F. Supp. 1009 (M.D. Fla. 1994) (quoting the above rule of law from Fisher); Acuff-Rose Music, Inc. v. Campbell, 972 F.2d 1429, 1438 (6th Cir. 1992) ("A de minimis use, one that is meager and fragmentary, by definition fails to conjure up the original and does not constitute an infringement."), rev'd on other grounds, 510 U.S. 569 (1994).

Because the defendants do not deny that they used anything but the entire Jerry Greenberg photograph in the Moving Covers Sequence, their de minimis argument in Part III of their memorandum should be rejected.

IV. THE PLAINTIFFS CANNOT ADEQUATELY RESPOND TO THE DEFENDANTS' FAIR USE ARGUMENTS WITHOUT REASONABLE DISCOVERY AS TO RELEVANT FACTS

Part IV of the defendants' memorandum is devoted to the application of the fair use doctrine to Count V of the Amended Complaint, which asserts a claim relative to the Moving Covers Sequence that appears on each disc in the Complete Geographic product.

Rule 56 (f), Federal Rules of Civil Procedure, provides as follows:

Should it appear from the affidavits of a party opposing the motion that the party cannot for reasons stated present by affidavit facts essential to justify the party's opposition, the court may refuse the

application for judgment or may order a continuance to permit affidavits to be obtained or depositions to be taken or discovery to be had or may make such other order as is just.

The plaintiffs request a continuance of the defendants' pending motion -- but only as to Count V -- so that appropriate discovery may be had.¹³ According to Rule 56 (f), such a request must take the form of an affidavit stating the reasons for the party's inability to present facts essential to justify its opposition. An affidavit by a party's counsel can satisfy the requirement of the rule where the attorney has the requisite first-hand knowledge and is competent to address the specifics of the facts needed. Fernandez v. Bankers Nat'l Life Ins. Co., 906 F.2d 559, 570 (11th Cir. 1990). See also Resolution Trust Corp. v. North Bridge Assocs., 22 F.3d 1198 (1st Cir. 1994)(). An affidavit for that purpose is attached to and incorporated in this memorandum as Exhibit _____.

"The party opposing a motion for summary judgment has a right to challenge the affidavits and other factual materials submitted in support of the motion by conducting sufficient discovery so as to enable him to determine whether he can furnish opposing affidavits." Snook v. Trust Co. of Georgia Bank of Savannah, N.A., 859 F.2d 865, 870 (11th Cir. 1988). If the documents or other discovery sought would be relevant to the issues presented by the motion for summary judgment, the opposing party should be allowed the opportunity to utilize the discovery process to gain access to the requested materials. Id. Generally summary judgment is inappropriate when the party opposing the motion has been unable to obtain responses to his discovery requests. Id.

The plaintiffs presently believe that the discovery required as to issues raised in the motion with respect to Count V should require no more than two months. That period may be significantly reduced, depending on the ability and willingness of the defendants to respond promptly to requests. The plaintiffs cannot know whether follow-up requests or depositions may become necessary on the basis of information provided by the defendants. The plaintiffs have no desire to prolong resolution of the motion unnecessarily, but where a dispositive motion affecting

¹³ In making the request under Rule 56 (f), the plaintiffs expressly do not waive any other discovery to which they are entitled under Rule 26.

an important claim in their case is involved, they should have the full ability to oppose arguments advanced by the defendants in the motion.

Notwithstanding this request with respect to Count V, the Court's ability to resolve issues addressed in the defendants' motion with respect to other counts would not be impaired.

CONCLUSION

As to the defendants' motion to dismiss with reference to Counts II-V, the plaintiffs urge the Court to accept that the copyright registrations are implied in the allegations, or accept the sworn representations in the Jerry Greenberg Affidavit as to the registration of copyrights in the interest of minimizing disruption that would be caused by a newly-amended complaint.

Alternatively, the plaintiffs are prepared to amend the Amended Complaint to incorporate the registrations.

As to the defendants' motion for summary judgment on Counts III through V, the plaintiffs urge as follows:

Count III -- defendants' motion should be denied.

Count IV -- plaintiffs are moving separately to voluntarily dismiss the claim.

Count V -- plaintiffs request the discovery time set forth in Part IV of this memorandum.

Respectfully submitted,

STEEL HECTOR & DAVIS LLP
Attorneys for Plaintiffs

Norman Davis (Fla. Bar No. 475335)
David Aronberg (Fla. Bar No. 090565)
Suite 4000
First Union Financial Center
200 S. Biscayne Boulevard
Miami, FL 33131-2398
(305) 577-2988 (phone)
(305) 577-7001 (facsimile)