

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF FLORIDA
Miami Division
CASE NO. 97-3924-CIV-LENARD-TURNOFF

JERRY GREENBERG, individually,
and IDAZ GREENBERG, individually,

Plaintiffs,

vs.

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

Defendants.

**MOTION TO VACATE ORDER GRANTING IN PART DEFENDANTS'
MOTION FOR PARTIAL SUMMARY JUDGMENT, AND FOR OTHER
RELIEF; AND MEMORANDUM OF LAW**

Plaintiffs, JERRY GREENBERG and IDAZ GREENBERG ("the Greenbergs"), pursuant to Rule 60(b)(6) of the Federal Rules of Civil Procedure, file and serve this Motion to Vacate this Court's May 14, 1998 Order Granting in Part the Motion for Summary Judgment of Defendants NATIONAL GEOGRAPHIC SOCIETY ("the Society"), NATIONAL GEOGRAPHIC ENTERPRISES, INC. ("Geographic Enterprises"), and MINDSCAPE, INC. ("Mindscape"), and for other relief. The Greenbergs state the following as support:

INTRODUCTION

This Court's May 14, 1998 Order Granting in Part Defendant's Motion for Partial Summary Judgment (the "Order") should be vacated and modified because the authority relied

upon, Tasini v. New York Times Co., 972 F. Supp. 804 (S.D.N.Y. 1997), has been reversed by the Second Circuit Court of Appeals. On September 24, 1999, the Second Circuit repudiated the district court's reasoning in Tasini and held, inter alia, that "the 'revision' clause in Section 201(c) [of the Copyright Act] was not intended to permit the inclusion of previously published freelance contributions 'in a new anthology or an entirely different magazine or other collective work,' i.e., in later collective works not in the same series." Tasini v. New York Times Co., Nos. 97-9181, 97-9650, 1999 WL 753966, at *5 (2d Cir. Sept. 24, 1999), rev'g 972 F. Supp. 804 (S.D.N.Y. 1997).

This Court based its Order on the now-overruled Tasini opinion. Explaining its view that the district court's opinion in Tasini was the only published opinion on the copyright issue in controversy in the instant case, this Court explicitly "adopt[ed] the legal framework developed by the New York district court to analyze the legal question currently before this Court." Order at 7. Since the legal framework developed by the district court in Tasini has been repudiated, this Court should vacate its Order pursuant to Rule 60(b)(6) of the Federal Rules of Civil Procedure.

PROCEDURAL HISTORY

On December 23, 1997, the Greenbergs filed their Amended Complaint containing five causes of action: Count I alleged copyright infringement by the Society for using various Greenberg photographs that appeared in the Society's "Oceans GeoPack" product (the "GeoPack"). Count II alleged copyright infringement by the Society for using a Greenberg photograph of a sea fan that appeared in a color brochure promoting the Society's 1996 "Jason Project." Count III alleged copyright infringement by the Society, Geographic Enterprises and Mindscape for using more than a dozen Greenberg photographs that appeared in the Defendants'

“Complete National Geographic” CD-ROM product (the “Complete Geographic”). Count IV alleged copyright infringement by the Society, Geographic Enterprises and Mindscape for using more than a dozen Greenberg photographs in a new derivative work that is the Complete Geographic. Count V alleged copyright infringement against the Society, Geographic Enterprises and Mindscape for the use of a Greenberg cover photograph in a moving covers sequence on each of the 30 CD-ROM discs comprising the Complete Geographic.

In Response, Defendants filed a Motion to Dismiss Count II and to Dismiss or for Summary Judgment on Counts III-V of Plaintiff’s Amended Complaint (“Defendants’ Motion for Summary Judgment”). The Greenbergs then filed a Response to Defendants’ Motion for Summary Judgment (the “Greenbergs’ Response”). The Greenbergs’ Response requested the denial of summary judgment for Defendants on Counts II-IV, and requested a continuance on Defendants’ Motion for Summary Judgment on Count V so that reasonable discovery could be undertaken. The Greenbergs also filed a Cross-Motion for Summary Judgment on Count III, and filed a motion for a voluntary dismissal of Count IV of the Amended Complaint.

On May 14, 1998, this Court issued its Order Granting in Part and Denying in Part Defendants’ Motion for Partial Summary Judgment. In the Order, this Court denied Defendants’ motion to dismiss and/or summary judgment as to Count II, but relied on the opinion of the district court in the Southern District of New York in Tasini to grant Defendants’ motion for summary judgment as to Counts III, IV and V with prejudice. In so doing, this Court denied the Greenbergs’ cross-motion for summary judgment as to Count III and denied the Greenbergs’ Motion to voluntarily dismiss Count IV as moot.

On June 8, 1999, this Court issued an Order Granting Plaintiff's Motion for Summary Judgment on Liability as to Count I and Count II (the "Second Order"). On September 24, 1999, the district court's opinion in Tasini was reversed, and this Motion to Vacate the Order of May 14, 1998 follows.

MEMORANDUM OF LAW

I. ALL FIVE FACTORS THAT DETERMINE WHETHER A DISTRICT COURT SHOULD GRANT RELIEF FROM AN ORDER FAVOR THE GREENBERGS, AND THEREFORE RULE 60(B)(6) RELIEF IS APPROPRIATE IN THIS CASE

Rule 60(b)(6), Fed.R.Civ.P., authorizes a district court, in the exercise of its discretion, to relieve a party "from a final judgment, order, or proceeding" for "any . . . reason justifying relief." The law in the Eleventh Circuit is clear that "Rule 60(b) can be used to remedy a mistake in the application of the law," Ritter v. Smith, 811 F.2d 1398, 1401 (11th Cir. 1987), and that "[a] supervening change in the law can, but need not always, constitute sufficiently extraordinary circumstances to warrant relief under Rule 60(b)(6)." Scott v. Singletary, 870 F. Supp. 328, 330 (S.D. Fla. 1994) (Moore, J.).

In Scott, the court summarized the following factors used by the Eleventh Circuit to determine whether a district court should grant relief from a judgment because of the advent of new precedent:

(1) whether the change in the law is final and definitive; (2) whether the judgment has been executed; (3) whether the Rule 60(b)(6) motion was filed soon after the judgment was rendered; (4) whether the intervening decision is closely related to the instant case; and (5) considerations of comity.

Id. at 339 (citing High v. Zant, 916 F.2d 1507, 1509 (11th Cir. 1990), and Ritter v. Smith, 811 F.2d 1398, 1401 (11th Cir. 1987)). In Scott, the court denied the petitioner's Rule 60(b)(6)

motion because there was no change in the law, as the petitioner relied only on a split between two Eleventh Circuit panels in separate cases. See id. at 331 (explaining that “prior decisions of panels of the Eleventh Circuit may only be overruled by the en banc court or the Supreme Court”) (citations omitted).

In contrast, the decision of the district court for the Southern District of New York in Tasini was clearly and definitively reversed by a higher court -- the Second Circuit Court of Appeals -- with explicit instructions to enter judgment for the appellants on remand. See Tasini, 1999 WL at *10.

The remaining four factors for Rule 60(b)(6) relief are also satisfied in the instant case. The second factor is satisfied because a judgment has not been entered here, and thus no judgment has been executed. The Eleventh Circuit has said that this is a “significant factor in the extraordinary circumstances favoring relief from the judgment” because “[w]hen a judgment has been executed a concomitantly greater interest in finality exists.” Ritter, 811 F.2d at 1401, 1402. “Generally courts have refused to undo the past, executed effects of the judgments, but they have, almost uniformly, recognized that it would be unjust to give prospective effect to a judgment now known to be improper. Thus, they have granted prospective 60(b)(6) relief.” Id. at 1402.

In addition, the third factor for Rule 60(b)(6) relief also favors the Greenbergs. The filing of this motion took place only weeks after the Second Circuit’s ruling in Tasini. And although the Order was rendered on May 14, 1998, the Greenbergs have not sat on their rights, as they filed this motion as soon as they qualified for relief under Rule 60(b)(6). In fact, since judgment in this case has not yet been entered, there is no intrusiveness in granting Rule 60(b)(6)

relief here. See Ritter, 811 F.2d at 1402 (mentioning intrusiveness as a consideration in determining whether Rule 60(b)(6) relief is justified under the third factor).

Moreover, the fourth factor also supports the granting of Rule 60(b)(6) relief because of the close relationship between the Tasini decision and the instant case. This Court relied solely on the district court opinion in Tasini and expressly “adopt[ed] the legal framework developed by that court” to conclude that the Society’s CD-ROM constituted an allowable “revision” of the earlier periodicals. Order at 6-7, 8. The plaintiffs’ view, expressed in their response to the defendants’ summary judgment motion, was and is that a revision is not at issue here in any of the claims. In basing its Order upon the district court’s opinion in Tasini, this Court noted that Tasini was the only published opinion in which a court has addressed the issue whether a collective work is a revision within the meaning of the federal copyright statute. Order at 5. Now that the district court’s opinion has been reversed by the Second Circuit, the new opinion in Tasini is the only good law applicable to the issue in controversy in Count III of the instant case.¹

The last of the five Rule 60(b)(6) factors also favors the Greenbergs, as there are no comity concerns with this Court’s vacating its own earlier judgment. Cf. Ritter, 811 F.2d at 1403 (“A federal court’s grant of a writ of habeas corpus upsets the finality of a state court judgment and is always a serious matter implicating considerations of comity.”)

With all five of the Rule 60(b)(6) factors favoring the Greenbergs, this Court should grant the Greenbergs’ Motion to Vacate this Court’s May 14, 1998 Order.

¹ In its May 14, 1998 order, this Court granted summary judgment on Count V in reliance on the district court’s Tasini decision. The facts on which Count V are based, however, have no relationship of any kind to that decision.

II. THE NEW TASINI DECISION UNDERMINES THE DEFENDANTS' MOTION AND STRONGLY SUPPORTS THE PLAINTIFFS' CROSS-MOTION FOR SUMMARY JUDGMENT AS TO COUNT III

In addressing Count III in its 1998 order, the Court assumed that the Society's position, with respect to The Complete Geographic, was that the product constitutes a "revision" of collective works -- specific issues of monthly magazines. Order at 5. To the contrary, the defendants negated the idea of revision by explaining, at page 6 of their initial memorandum, that each page of each magazine was replicated in an electronic medium exactly as it appeared in hard copy. Thus, even if the Court at the time believed "revision" to be an operative legal basis for its May 14, 1998 order, that basis has been overturned by the Second Circuit in Tasini.

The real issue between the parties is whether The Complete Geographic, as addressed in Count III, amounts only to a permitted reprint of issues of the monthly magazine (the defendants' position), or constitutes a new collective work in which the unauthorized reprinting of the Greenberg photographs is not permitted (the plaintiffs' position).²

The parties agree that the question is controlled by Section 201 (c) of the Copyright Act, although they differ as to the meaning of key parts of that section. The Second Circuit's Tasini decision significantly clarifies those parts.³

² This drawing of the issue is set forth in careful detail in the Greenbergs' memorandum in response to the defendants' motion.

³ All references to Tasini hereafter are to the Second Circuit's decision on September 24, 1999.

A. A “Collective Work” Defined

The definition of “compilation” in Section 101 of the Act states that “collective work” is a subset of “compilation.” Section 101 further defines “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 whole.”

The parties agree that each issue of the Society’s monthly magazine is a “collective work” as defined in sections 101 and 103 (b) of the Act. With reference to Count III, and as set forth in the Greenbergs’ summary judgment memorandum, more than a dozen photographs taken by Jerry Greenberg, for which he owns the exclusive copyright, are embedded in various past issues of the Society’s monthly magazine.

B. The Section 201 (c) Privilege

Section 201 (c) of the Copyright Act grants collective-work authors only a privilege, not a right, and Congress has expressly limited the scope of that privilege. See Tasini, 1999 WL 753966 at *10 n. 2. In that context, the Second Circuit says the following about the right of the Society, as a collective-work author, to use the Greenberg photographs:

[T]he privilege granted to a collective-work author to use individually copyrighted contributions is limited to the reproduction and distribution of the individual contributions as part of (i) “that particular [i.e., the original] collective work”; (ii) “any revision of that collective work”; or (iii) “any later collective work in the same series.”

1999 WL 753966 at *4 (bracketed material in original) (quoting Section 201 (c) of the Copyright Act). The precise meaning of elements (i) and (iii) in that section of the Act is crucial to a

determination of the central issue here.⁴ The Second Circuit has provided the only definitive clarification of those elements, and this Court should follow Tasini. In the following discussion, “individual contribution” should be read to mean the Greenberg photographs.

The first clause sets the floor, so to speak, of the privilege: the collective-work author is permitted to reproduce and distribute individual contributions as part of “that particular collective work.” In this context, “that particular collective work” means a specific edition or issue of a periodical. . . . The second clause expands the privilege, to permit the reproduction and distribution of the individual contribution as part of a “revision” of “that collective work.” i.e., a revision of a particular edition of a specific periodical. Finally, the third clause sets the outer limit or ceiling on the privilege: it permits the reproduction and distribution of the individual contribution as part of a “later collective work in the same series,” such as a new edition of a dictionary or encyclopedia.

1999 WL 753966 at *4.

As to the first clause, therefore, the Society’s privilege is limited to reproducing the Greenberg photographs only in a “specific edition or issue” of the monthly magazine. The first clause refers only to a specific issue of the monthly magazine, not the compilation of many years of monthly magazines, at issue here, in a new format which embodies the legal ingredients of a new collective work. The first clause says nothing whatsoever about a new compilation, and, as the Second Circuit notes, speaks only of a “specific issue.” The Society, however, reproduced the photographs in a new compilation -- even an anthology, as defined in Section 101 of the Act - - that never had existed before. The Greenbergs have contended from the outset that that new compilation constitutes a new collective work that is not covered by any of the privileges in Section 201 (c).

⁴ Element (ii) of that section is not relevant because neither party here has advanced a “revision” argument.

As to the third clause of Section 201 (c), the Second Circuit illuminates the meaning of “later collective work in the same series” as follows:

Issues of periodicals, as noted, are often updated by revised editions, while anthologies and encyclopedias are altered every so often through the release of a new version, a “later collective work in the same series.” Perhaps because the “same series” clause might be construed broadly, the House Report on the Act noted that the “revision” clause in Section 201 (c) was not intended to permit the inclusion of previously published freelance contributions “in a new anthology or an entirely different magazine or other collective work,” i.e., in later collective works not in the same series.

1999 WL 753966 at *4 (emphasis added).

Thus, Congress did not intend to permit the inclusion of previously published freelance contributions -- such as the Greenberg photographs -- in a completely new anthology or in later collective works not in the same series. It is wholly disingenuous for the Society to contend that The Complete Geographic is not a new compilation, as defined in Section 101 of the Copyright Act. The Complete Geographic compilation contains versions of the Society’s monthly magazine through the December 1996 issue. A later work in the “same series” might be the January 1997 issue of the magazine, or the November 1998 issue of the magazine, or some other monthly issue of the magazine.

The Second Circuit’s construction of the third element in Section 201 (c) can be applied thusly: Congress intended that the Greenberg photographs might be included in a subsequent issue of the Society’s monthly magazine. The Complete Geographic CD-ROM product is not a subsequent issue of the monthly magazine but is an entirely new compilation or anthology that never existed before, with its own notice of copyright for 1997. The Complete Geographic, in

other words, is not a collective work in the “same series,” as contemplated in the third element of Section 201 (c). It is instead a new anthology or collective work.⁵ 1999 WL 753966 at *4.

C. Count V Stands Apart From Tasini, and Should be Analyzed as a New Derivative Work

This Court’s May 14, 1998 order gave scant attention to the plaintiffs’ claim in Count V, electing to sweep that claim under the Tasini holding produced by the Southern District of New York. Count V never had the slightest relevance to Tasini, because it plainly never qualified as a “revision” of a prior collective work. Indeed, nothing in Section 201 (c) of the Act supports the Society’s use of the Greenberg photograph as alleged in Count V.

The “morphing” creation addressed in Count V incorporates ten covers of the monthly magazine, one of which is a cover featuring a photograph by plaintiff Jerry Greenberg, for which he indisputably owns the copyright. The Court is urged to review the plaintiffs’ argument as to Count V in their memorandum in opposition to the defendants’ motion for summary judgment as to that count.

The defendants’ argument in support of that motion is almost totally devoted to their invocation of the “fair use” doctrine, as an affirmative defense. That argument, as demonstrated in the defendants’ memorandum, is very heavily fact-intensive. The plaintiffs had no opportunity to discover facts that would assist in defeating such an argument.⁶

⁵ The Greenbergs’ memorandum in response to the Society’s motion for summary judgment as to Count III sets forth in detail the characteristics of the Complete Geographic that mark it as a new “collective work,” i.e., a work manifesting “selection, coordination, and arrangement of the preexisting materials [the monthly magazines].” 1999 WL 753966 at *5.

⁶ In their memorandum, the Greenbergs implored the Court, without success, to allow time for appropriate discovery.

CONCLUSION

In Tasini, the Second Circuit clarified the meaning of Section 201 (c) of the Copyright Act as no court has done previously. Any permitted re-use by the Society of the Greenberg photographs, as prescribed in that section, amounts to a narrowly-defined privilege, and not a right. The Complete Geographic product at issue in Count III fails to qualify under any of the usages permitted in Section 201 (c). The unauthorized use of the Greenberg photographs in The Complete Geographic product amounts to copyright infringement. A separate infringement occurred with the use of the Greenberg cover photograph in the "morphing" sequence.

In reconsidering its May 14, 1998 order, the Court should do the following:

- (1) Vacate all portions of the order necessary to accomplish the items listed below.
- (2) Continue the Court's denial of the defendants' motion as to Count II as moot.⁷
- (3) Deny the defendants' motion for summary judgment as to Counts III, IV and V, and vacate the dismissal of those counts.⁸
- (4) Grant the plaintiffs' cross-motion for summary judgment as to Count III.
- (5) Reinstate Count V and provide the plaintiffs with adequate time to conduct discovery and to re-state their opposition to the defendants' motion for summary judgment as to that count.

⁷ On June 8, 1999, the Court awarded summary judgment to the plaintiffs as to Count II.

⁸ On February 13, 1998, the plaintiffs moved to voluntarily dismiss Count IV.

Respectfully submitted,

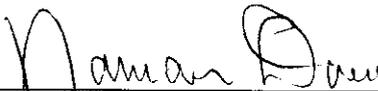
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Certificate of Service

I hereby certify that a copy of the foregoing was served by mail on Edward Soto, Esq., Weil, Gotshal & Manges LLP, 701 Brickell Avenue, Suite 2100, Miami, FL 33131 and by facsimile and mail on Robert G. Sugarman, Esq., Weil, Gotshal & Manges LLP, 767 Fifth Avenue, New York NY 10153 this 18~~th~~ day of October, 1999.



Norman Davis

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