

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF FLORIDA

Miami Division
CASE NO. 97-3924-CIV-LENARD
Magistrate Judge 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.

**PLAINTIFFS' MEMORANDUM IN OPPOSITION
TO DEFENDANTS' MOTION FOR
ADDITIONAL ORDER OF REFERENCE**

Plaintiffs, JERRY GREENBERG and IDAZ GREENBERG ("the Greenbergs"), serve this memorandum in opposition to Defendants' Motion for an Additional Order of Reference to the Magistrate Judge.¹

¹ The defendants served two memoranda that overlap significantly in the issues covered. Accordingly, the Court should consider jointly the two responding memoranda prepared by the Greenbergs, including Plaintiffs' Reply Memorandum in Support of Motion to Strike Answers or Defenses, and in Opposition to Cross-Motion for Enlargement which is being filed simultaneously herewith.

Introduction

The defendants ask the Court to refer "all matters in this case" to Magistrate Judge William C. Turnoff. The Court already has done so. In an order entered on November 13, 2001, the Court stated as follows:

[T]he above-captioned cause is referred to United States Magistrate Judge William C. Turnoff to take all necessary and proper action as required by law with respect to the amount of damages and attorneys fees that are due, if any, as well as any injunctive relief that may be appropriate and motions and papers relating thereto.

The order is fully consistent with the mandate of the Eleventh Circuit Court of Appeals. The defendants suggest that other issues of liability must be resolved, but the Eleventh Circuit's remand instructed this Court to do exactly what is set forth above. Because liability has been established, the only remaining tasks for the Court are, as the Eleventh Circuit directed, to assess the issues of damages, attorneys' fees and injunctive relief. The mandate rule long established in this Circuit permits nothing more.

Apart from the mandate issues, nothing is pending that might be referred, other than the Greenbergs' motion to strike the answers or the affirmative defenses. If that motion is granted it will moot this attempt to refer to the Magistrate Judge something additional.

The Purported Issues of Liability

In their memorandum, the defendants identify three liability issues to be addressed. Each is discussed below. Except for the contract question, the "issues" have not been pled as affirmative defenses; they are discussed below in an abundance of caution.

A. The Copyright Act of 1909

The defendants propose that an issue exists as to whether Mr. Greenberg "is entitled to recover with respect to images governed by the Copyright Act of 1909." The 1909 Act has no application here. Professor Nimmer, in providing an overview of U. S. copyright law, references the two key enactments by Congress as follows:

1. The Copyright Act of 1909, as amended, the effectiveness of which lasted through 1977, and which continues to govern pre-1978 causes of action as well as certain rights under the current Act.

* * *

3. The Copyright Act of 1976, a comprehensive revision to the 1909 Act, which became effective on January 1, 1978.

1 M. Nimmer & D. Nimmer, NIMMER ON COPYRIGHT, Overview, at page OV-1.

(Footnotes omitted.)

In determining the corpus of law that governs a particular situation, the guiding principle should be to apply the law in effect when the infringement (or other activity) upon which suit is based, arises. Thus, the dividing line for applying the Copyright Act of 1976 is its effective date, January 1, 1978 -- prior law continues to govern pre-existing causes of action, whereas the new law is effective as to subsequently arising undertakings.

Id. at OV-7 and -8.

The record is clear that Mr. Greenberg acquired all rights to his photographs, including copyright, after January 1, 1978. It also is clear that the infringing acts that were alleged involved the CD-ROM product "108 Years of the Complete National Geographic," which was created and marketed after January 1, 1978. The 1909 Act has no relevance to this case, and the defendants' suggestion that it raises liability issues is spurious.

B. The Purported Greenberg License

As the Greenbergs noted in the initial memorandum, and in the reply memorandum supporting their pending motion to strike all affirmative defenses, all rights to the Greenberg photographs, including copyright, were conveyed to Mr. Greenberg by the National Geographic Society in 1985 and 1989. The Eleventh Circuit found the 1985 transfer to be valid. That transfer (in Exhibit A to initial memorandum) expressly conveyed all rights to the photographs to Mr. Greenberg. The Eleventh Circuit also found that the 1989 agreement conveyed “all rights” to the photographs pertinent to that agreement. See Greenberg v. National Geographic Society, et al., 244 F.3d 1267, 1269 (11th Cir. 2001).² The Society cannot claim a license, and the question raises no issue of liability.

C. The Supreme Court Decision in *Tasini*

The defendants propose that this Court should ignore the Eleventh Circuit’s mandate in Greenberg because of a Supreme Court decision in New York Times Co., Inc. v. Tasini, 121 S.Ct. 2381 (2001), which was decided a few weeks after Greenberg. The defendants contend that the two courts construed Section 201(c) of the Copyright Act differently. This Court, they say, must give retroactive effect to the Tasini decision.

The sole authority cited for that proposition is Harper v. Virginia, 113 S.Ct. 2510 (1993), which dealt with the retroactive application to the states of a new rule of constitutional dimension announced by the Court. In Tasini, no new “rule” was created. The Supreme Court applied Section 201(c) to one set of facts, and the Eleventh Circuit applied it to a different set of facts.

² The defendants contend in their memorandum that the Eleventh Circuit did not “analyze” the Greenberg contracts under contract law principles.

The defendants sought a writ from the Supreme Court largely by arguing that Tasini should control in this case. Their petition was rejected.

“The standard for declaring a decision or doctrine of a higher court defunct is . . . whether the lower court is certain or almost certain that the decision or doctrine would be rejected by the higher court if a case presenting the issue came before it. This is a high standard and will rarely be met.” Olson v. Paine, Webber, Jackson & Curtis, Inc., 806 F.2d 731, 741 (7th Cir. 1986). Even within the Eleventh Circuit Court of Appeals, the court is hesitant to challenge itself. “It is the firmly established rule of this Circuit that each succeeding panel is bound by the holding of the first panel to address an issue of law, unless and until that holding is overruled en banc, or by the Supreme Court.” United States v. Hogan, 986 F.2d 1364, 1369 (11th Cir. 1993).

The Eleventh Circuit indicated in Greenberg its awareness that the Tasini case was then before the Supreme Court. 244 F.3d at 1274 n.14. An inference is warranted that the Eleventh Circuit understood Tasini to be a different case, as indeed it was. Tasini, based on completely different facts, has no application here.

Quite relevant is that the Supreme Court in Tasini made no reference whatever to Greenberg, not even in a footnote. Tasini did not cast even the faintest shadow on the Eleventh Circuit’s opinion.

The Proposed Settlement Conference

The defendants propose that Magistrate Judge Turnoff should schedule a settlement conference “to attempt to resolve Plaintiffs’ remaining claims.” There are no remaining claims.

As the Court’s order of reference on November 13 states plainly, this cause of action as it presently exists has been transferred to the chambers of Magistrate Judge Turnoff. The reference

order specifically calls for appropriate action "with respect to the amount of damages and attorneys fees that are due, if any, as well as any injunctive relief that may be appropriate"

Those are the surviving "claims" to be resolved.

The Greenbergs have asked for a jury trial as to damages. They are entitled to a reasonable period of time before trial for discovery as to damages. That discovery has just begun. The Greenbergs have indicated to opposing counsel a willingness to explore settlement of the remaining issues, but only after adequate discovery can be accomplished. Thus, the Greenbergs submit that a settlement conference at this time would not be productive, in the absence of highly relevant information as to damages that the Greenbergs are entitled to have.

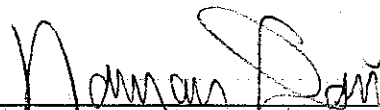
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CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing plaintiffs' memorandum was served by mail on Edward Soto, Weil, Gotshal & Manges, LLP, 701 Brickell Avenue Boulevard, Suite 2100, Miami, Florida 33131; and via Federal Express on Robert G. Sugarman, Weil, Gotshal & Manges, LLP, 767 Fifth Avenue, New York, New York 10153, this 7TH day of December, 2001.



Norman Davis

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