

NOTES

Interpretation of “Revision” Under the Copyright Act Spells Trouble for Publishers: *Greenberg v. National Geographic Society*

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I. INTRODUCTION

The National Geographic Society (Society) is a nonprofit scientific and educational organization with approximately 9.5 million members.¹ The Society publishes National Geographic Magazine (Magazine) and hires freelance photographers who work on an independent-contractor basis to complete specific assignments.² Jerry Greenberg, the plaintiff, is a freelance photographer who was hired by the Society on four separate occasions over the course of thirty years.³

Photographs from Greenberg’s first three assignments were published in different issues of the Magazine during the 1960s and early 1970s.⁴ A series of informal letters established the terms of employment for these assignments.⁵ Greenberg would be compensated in return for the Society acquiring all rights to his photographs that were selected for publication in the Magazine.⁶ At Greenberg’s request in 1985, the Society reassigned its copyrights to these pictures back to him.⁷

Greenberg’s fourth assignment appeared in the July 1990 issue of the Magazine.⁸ The terms of this assignment were more detailed as compared to the previous three.⁹ The parties agreed that all rights the Society acquired in photographs taken by Greenberg would be returned to him sixty days after the pictures were published in the Magazine.¹⁰

1. Greenberg v. Nat’l Geographic Soc’y, 244 F.3d 1267, 1268 (11th Cir. 2001).

2. *Id.* at 1268-69.

3. *Id.* at 1269.

4. *Id.*

5. *Id.*

6. *Id.*

7. *See id.*

8. *Id.*

9. *Id.*

10. *Id.*

In 1996, the Society, in collaboration with a computer programming company, began developing a product called *The Complete National Geographic* (CNG).¹¹ CNG is a collection of every issue of the Magazine from 1888 to 1996 in digital format on a CD-ROM library.¹² Part of CNG is a moving covers sequence (Sequence) that plays automatically and lasts for twenty-five seconds when any disc from the thirty disc collection is activated.¹³ This animated clip, accompanied by music and sound effects, displays for about one second each, ten different covers from past issues of the Magazine.¹⁴ One of these covers contains a photograph that was taken by Greenberg.¹⁵ The Society informed contributors to the Magazine that there would be no additional compensation for the use of their works in CNG.¹⁶

In response to the development of CNG and use of his photograph, Greenberg initiated a copyright infringement action.¹⁷ The district court held that CNG constituted a “revision” of the paper copies of the Magazine within the Society’s privilege under § 201(c) of the Copyright Act and, accordingly, granted summary judgment for the defendants.¹⁸ The United States Court of Appeals for the Eleventh Circuit, as a question of first impression, disagreed and *held* that the republishing of photographs in a CD-ROM library was not merely a revision of the prior collective work, but rather constituted a new collective work that lies beyond the scope of § 201(c). *Greenberg v. National Geographic Society*, 244 F.3d 1267, 1268 (11th Cir. 2001), *cert. denied*, 122 S. Ct. 347 (U.S. Oct. 9, 2001).

II. BACKGROUND

The United States Constitution provides for congressional power to write and enact a copyright statute.¹⁹ Copyright protection exists “in

11. *Id.*

12. *Id.* Every cover and page of each issue of the Magazine was scanned into a computer to create the digital CD-ROM. *Id.* The CNG user thus sees “a reproduction of each page of the Magazine that differs from the original only in the size and resolution of the photographs and text.” *Id.*

13. *Id.*

14. *Id.*

15. *Id.*

16. *Id.* at 1270.

17. *Id.*

18. *Greenberg v. Nat’l Geographic Soc’y*, No. 97-3924, 1998 U.S. Dist. LEXIS 18060, at *10 (S.D. Fla. May 14, 1998), *rev’d*, 244 F.3d 1267 (11th Cir. 2001).

19. U.S. CONST. art. I, § 8, cl. 8 (“To promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries.”).

original works of authorship fixed in any tangible medium of expression . . . from which they can be perceived, reproduced, or otherwise communicated.”²⁰ The Copyright Act was amended in 1976 in response to the significant technological changes that had occurred since its last revision in 1909.²¹

The Copyright Act, as amended in 1909, recognized an author’s copyright only if a notice was present in the author’s name.²² As a result, the author would lose his copyright when the contribution was placed in a collective work without such notice because it was then considered part of the public domain.²³ This inability of the author to assign the rights held by a copyright owner is known as the doctrine of indivisibility.²⁴

As new forms of entertainment and communication developed, the doctrine of indivisibility proved confusing and often resulted in “technical pitfalls for both buyers and sellers.”²⁵ Congress recognized these problems and the Copyright Act, as amended in 1976, rejects this doctrine.²⁶ Section 106 now provides for a bundle of exclusive rights, which, per § 201(d)(2), may be transferred or owned separately.²⁷

A rejection of the doctrine of indivisibility meant that an author did not automatically lose his copyright by having a contribution in a collective work. Section 201(c) now provides for distinct copyrights, first in each contribution to the collective work and another copyright in the collective work as a whole.²⁸ This provision, in conjunction with § 404, “preserve[s] the author’s copyright in a contribution even if the contribution does not bear a separate notice in the author’s name, and without requiring any unqualified transfer of rights to the owner of the collective work.”²⁹

20. 17 U.S.C. § 102 (1994). An “original” work “requires independent creation plus a modicum of creativity.” *Feist Publ’ns v. Rural Tel. Serv. Co.*, 499 U.S. 340, 346 (1991).

21. H.R. REP. NO. 94-1476, at 47 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5660.

22. *See* Copyright Act of 1909, § 18, 35 Stat. 1075, 1079; 3 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 10.01[C][2], at 10-12 (2001).

23. *See* 3 NIMMER & NIMMER, *supra* note 22, § 10.01[C][2], at 10-12. A “collective work” is “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 (1994).

24. *See* 3 NIMMER & NIMMER, *supra* note 22, § 10.01[A], at 10-5.

25. *See id.* § 10.01[A], at 10-6 to 10-7.

26. 17 U.S.C. §§ 106-201(d)(2) (1994); H.R. REP. NO. 94-1476, at 122 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5738.

27. The exclusive rights provided for in § 106, relevant to the noted case, include the right to reproduce the copyrighted work and to prepare derivative works based upon the copyrighted work. 17 U.S.C. § 106 (1994).

28. *Id.* § 201(c).

29. H.R. REP. NO. 94-1476, at 122 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5738. Section 404(a) provides that a single notice of copyright, “applicable to the collective work as a

In addition, § 201(c) provides for three instances when the owner of the copyright in the collective work has only the “privilege” to reproduce or distribute the contribution by the author.³⁰ First, the privilege exists when it is part of “that particular collective work” to which the author made her contribution.³¹ Second, the privilege exists when it is part of “any revision of that collective work.”³² Lastly, the privilege exists when it is part of “any later collective work in the same series.”³³

The House Report that accompanied the 1976 changes to the Copyright Act reflects the intent of Congress to ensure that the privilege to reproduce or distribute the contributions by authors in a collective work exists only under certain situations.³⁴ The report states, “a publishing company could reprint a contribution from one issue in a latter issue of its magazine, and could reprint an article from a 1980 edition of an encyclopedia in a 1990 revision of it.”³⁵ On the contrary, “the publisher could not revise the contribution itself or include it in a new anthology or an entirely different magazine or other collective work.”³⁶

In its totality, the changes made in the Copyright Act reflect a clear “break with a two-hundred-year-old tradition that has identified copyright more closely with the publisher than with the author.”³⁷ Section 201(c) now preserves the author’s copyright in a contribution, which implicitly reaffirms the idea that an author is entitled to reap the potential financial rewards by placing the contribution in a new collective work.³⁸

III. THE COURT’S DECISION

In the noted case, the Eleventh Circuit continues the trend of aligning copyright protection more closely with the author. The court

whole[,] is sufficient to invoke” other provisions of the Copyright Act that ensure a copyright in each contribution to the collective work. 17 U.S.C. § 404(a) (1994).

30. 17 U.S.C. § 201(c).

31. *Id.*

32. *Id.*

33. *Id.*

34. H.R. REP. NO. 94-1476, at 122-23 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5738.

35. *Id.*

36. *Id.*

37. Barbara Ringer, *First Thoughts on the Copyright Act of 1976*, 22 N.Y.L. SCH. L. REV. 477, 490 (1977).

38. *Cf. Harper & Row, Publishers v. Nation Enters.*, 471 U.S. 539, 546 (1985) (“[T]he rights conferred by copyright are designed to assure contributors to the store of knowledge a fair return for their labors.”).

rejected the Society's claim that it had a privilege to use the photographs in the CD-ROM under § 201(c).³⁹ The court's interpretation of the statute was that a new work, independently worthy of copyright protection, had been developed.⁴⁰ Thus, Greenberg's photographs had been used in a manner inconsistent with his rights granted by § 106 to reproduce his photographs and prepare derivative works.⁴¹

The starting point for the court's analysis was defining the roles of each of the parties.⁴² The court determined that Greenberg, in the language of § 201(c), was the "author of the contribution" and the Society was "the owner of [the] copyright in the collective work."⁴³ Furthermore, the court highlighted the fact that the contributor has a "copyright" and "any rights under it" while the Society who published the Magazine has just a "privilege."⁴⁴ The court, therefore, reasoned this favored "narrowly construing the publisher's privilege when balancing it against the constitutionally-secured rights of the author/contributor."⁴⁵

The court said that CNG in its totality could in no sense be considered, as the Society claimed, a "revision."⁴⁶ The court's reasoning was based on Congress's legislative commentary of § 201(c).⁴⁷ Specifically, the court found that while a publisher could reprint a contribution from one issue in a later issue of its magazine, it "*could not* revise the contribution itself or *include it in . . . an* entirely different magazine or *other collective work*," which in the noted case was CNG and its components.⁴⁸ According to the court, "common-sense copyright analysis" compelled it to reach the conclusion that a new product in a new medium, worthy of the title "an original work of authorship," was created and that it transcended "any privilege of revision or other mere reproduction envisioned in § 201(c)."⁴⁹

39. See *Greenberg v. Nat'l Geographic Soc'y*, 244 F.3d 1267, 1273 (11th Cir. 2001).

40. See *id.*

41. See *id.*

42. See *id.*

43. *Id.* In the noted case, the author's contribution is his photographs and the collective work would be the Magazine. *Id.*

44. *Id.*

45. *Id.*

46. See *id.* The court's analysis focused on the entire product and expressly did not pass judgment on whether the "Replica" portion of CNG could be considered a "revision" under § 201(c). *Id.*

47. See *id.* at 1272-73.

48. *Id.* at 1273 (quoting H.R. REP. NO. 94-1476, at 122-23 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5738) (emphasis added by the court).

49. *Id.*

The court found its conclusion was consistent with the Society's application when it registered its claim of copyright in CNG.⁵⁰ The Society said that no registration for CNG, or any earlier version of it, had been made in the Copyright Office.⁵¹ It said this even though the Society knew that registrations already existed with regard to the individual issues of the Magazine.⁵² Because no reference was made to the existing copyrights in the individual issues, the court concluded that the Society had admitted that CNG was a new work.⁵³

Furthermore, the Society described CNG as a "[c]ompilation of pre-existing material primarily pictorial" that also included a "[b]rief introductory audiovisual montage."⁵⁴ The court, therefore, found that the Society admitted that CNG was a compilation, which by definition is a type of collective work.⁵⁵ As a result of these admissions and the legislative commentary previously discussed, the court found that the Society could not include the photographs in CNG because it was a new "collective work."⁵⁶

The court also noted that the Society's unauthorized use of Greenberg's photograph in the Sequence infringed upon Greenberg's exclusive right under § 106(2) to prepare derivative works.⁵⁷ The photographs used were "transformed . . . into a moving visual sequence that morphs one into the other."⁵⁸ In addition, the Society changed the orientation of Greenberg's photograph from a horizontal to a vertical presentation.⁵⁹ Thus, the court concluded that the Society committed copyright infringement because: (1) such "an animated, transforming selection and arrangement of preexisting copyrighted photographs"

50. *Id.*

51. *Id.*

52. *Id.*

53. *Id.*

54. *Id.*

55. *See id.*; 17 U.S.C. § 101 (1994).

56. *See Greenberg*, 244 F.3d at 1273-74.

57. *See id.* at 1274. A "derivative work" is "a work based upon one or more preexisting works, such as a . . . musical arrangement, dramatization . . . motion picture version, sound recording, art reproduction . . . or any other form in which a work may be recast, transformed, or adapted." 17 U.S.C. § 101. Furthermore, "[a] work consisting of editorial revisions . . . elaborations, or other modifications which, as a whole, represent an original work of authorship, is a 'derivative work.'" *Id.* A derivative work, in addition to a creative work and a compilation, are entitled to copyright protection. *Warren Publ'g v. Microdos Data Corp.*, 115 F.3d 1509, 1515 n.16 (11th Cir. 1997).

58. *Greenberg*, 244 F.3d at 1274.

59. *Id.*

constituted a compilation and (2) Greenberg's photograph was a derivative work, both of which are entitled to copyright protection.⁶⁰

IV. ANALYSIS

Over the last twenty years, technological advancements and their rapid emergence and integration into the daily lives of many, caught some off-guard, including publishers. This is demonstrated by the noticeable absence of a clause addressing copyright ownership in electronic databases in Greenberg's and other freelancer's contracts. Nevertheless, in the noted case the Eleventh Circuit, addressing the matter as a question of first impression, felt no sympathy for the publishers and dealt a stunning blow to their rights under the Copyright Act. By rejecting the Society's claim that it had a privilege under § 201(c) to use Greenberg's photographs in the CD-ROM, the court restricted the ability of publishers to use new technology as a way to reproduce and distribute its prior copyrighted collective works.⁶¹

The court's decision, which the Supreme Court refused to review, is consistent with the most recent and authoritative case on this issue. In *New York Times Co. v. Tasini*, the Supreme Court decided that, unless a writer contractually agrees otherwise, placing an article written by a freelance writer online or in an electronic database constitutes copyright infringement.⁶² The question under § 201(c) the Court said, concerns what is presented to the general public or, more specifically, whether the work "itself perceptibly presents the author's contribution as part of a revision of the collective work."⁶³ Similar to the noted case, the Court found that in its totality the "revision" claimed by the publisher was not "recognizable as a new version of its every small part" due to the free-

60. *Id.*; *Warren Publ'g*, 115 F.3d at 1515 n.16. The court held that the Society had neither a fair use defense or right because its use of Greenberg's photograph in the Sequence "far transcended a mere reprinting or borrowing of the work." *Greenberg*, 244 F.3d at 1274. Rather the use of the photograph "became an integral part of a larger, new collective work" such that it went beyond the scope of § 107. *Id.* The court also rejected the Society's *de minimis* defense because it found the use of Greenberg's photograph "to be both qualitatively and quantitatively significant." *Id.* at 1275.

61. Collective works that contain contributions by employees of the publisher ("works made for hire") are not affected because the Copyright Act provides that in these instances the copyrights reside with the employer, i.e., the publisher. 17 U.S.C. § 201(b) (1994).

62. *N.Y. Times Co. v. Tasini*, 121 S. Ct. 2381, 2394 (2001).

63. *Id.* at 2393. The Court in *Tasini* said a "revision" of a work is a "version" which is in a "distinct form of something regarded by its creators or others as one work." *Id.* at 2391 (quoting WEBSTER'S THIRD NEW INTERNATIONAL DICTIONARY 1944, 2545 (1976)).

standing nature of each article in the database and its “ever-expanding” collection.⁶⁴

Together, the decisions in *Greenberg* and *Tasini* now require authors to explicitly sign over their rights to publishers if they want their works to appear in an online or electronic database. Without such an agreement, publishers cannot legally use such contributions. Freelance authors, now faced with the choice of either contractually giving up their rights or risk not being hired at all if they refuse, will presumably succumb to such a demand in order to maintain their livelihood.

Significant issues remain regarding contributions by freelancers to collective works before such comprehensive contractual agreements were used. The decisions require publishers to remove such contributions from these databases thus resulting in an incomplete collection of all previous works.⁶⁵ The Court in *Tasini*, however, opposed to such “gaping holes in the electronic record of history” suggested that the parties enter into an agreement that would provide compensation to the authors while simultaneously “allowing continued electronic reproduction” of their works.⁶⁶ Recent litigation by the plaintiffs in *Tasini* who are attempting to secure a damage award, demonstrates that publishers appear unwilling to accede to the Court’s suggestions and the authors’ demands, presumably fearing if one such author is compensated it would then open the floodgates for damage claims by thousands of freelance authors.⁶⁷

The fact remains that the courts have clearly sided with the authors. Although current contractual agreements effectively address who holds a copyright with regard to these new forms of reproduction and distribution, issues still need to be addressed regarding the infringements

64. *Id.*

65. After *Tasini* was decided the Chairman of the New York Times Company, Arthur Sulzberger, Jr., was quoted as saying that his company would now “undertake the difficult and sad process of removing significant portions from its electronic historical archive.” Mary Dee Ojala, *So What Happens Now?*, ECONTENT, Sept. 1, 2001, at 35, available at 2001 WL 19617851. Specifically, it is reported that the New York Times Company intended “to take down 115,000 articles written by 27,000 authors between 1980 and 1995.” *Id.*

66. *Tasini*, 121 S. Ct. at 2393.

67. George H. Pike, *Understanding and Surviving Tasini*, INFORMATION TODAY, Oct. 2001, at 19, available at 2001 WL 10515466. The heated debate regarding the issue of damages is exemplified by the “blacklisting” of the plaintiffs in *Tasini* by the *New York Times*. *New York Times Bars Group of Free-Lancers from Writing for Paper*, WALL ST. J., Sept. 25, 2001, at B13, available at 2001 WL-WSJ 2876523. Specifically, an internal memo was distributed to editors at the newspaper recommending that they not hire the plaintiffs because of the current litigation. *Id.* In addition, the *New York Times* and other publishers have even begun to lobby “Congress to amend [the] copyright law to retroactively eradicate any financial liability to compensate authors for past copyright violations.” Seth Shulman, *Content Discontent*, TECH. REV., Oct. 2001, at 35, available at 2001 WL 14102662.

that occurred after 1976 but prior to such agreements. Whether the authors and publishers can agree on these issues or if it will be left to the courts or Congress, remains to be determined.

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