

World Copyright Law Report

incorporating World eBusiness Law Report

This article first appeared in World Copyright Law Report on July 26 2007. If you are interested in subscribing, please visit www.worldcopyrightlawreport.com.

July 26 2007 - USA

Foley & Lardner LLP

Circuits finally agree on scanned pages of *National Geographic* CD-ROM

The Eleventh Circuit has reversed its earlier ruling in [Greenberg v National Geographic Society](#), resolving a two-year long split with the Second Circuit regarding the rights of authors who contribute to collective works.

In dispute was a CD-ROM reproduction of all the issues of *National Geographic Magazine*. Individual contributors to *National Geographic* alleged that the CD-ROM infringed on their copyrights. The Eleventh Circuit sided with the contributors; in a later suit over the same issue, the Second Circuit sided with *National Geographic*. The Supreme Court denied *certiorari* to both cases, leaving the law divided (see [Supreme Court leaves circuits divided over National Geographic CD-Rom](#)).

The courts differed in their interpretation of Section 201(c) of the [Copyright Act](#). Under Section 201(c), individual contributors to collective works, such as magazines, retain copyrights to their contributions. Publishers acquire the right to publish the work only in a particular collection *and* in *revisions* of that collection. In both courts, the question was whether the CD-ROM was a new work or a revision of an existing work.

The Eleventh Circuit decided first, finding the CD-ROM to be a new work. The court focused on the addition of multimedia to the CD-ROM and found that *National Geographic* "created a new product [...] in a new medium, for a new market that far transcends any privilege of revision" (*Greenberg v Nat'l Geographic Soc'y* [244 F 3d 1267 (11th Cir 2001), *cert denied* 534 US 951 (2001) rev'd, No 05-16964, slip op (11th Cir June 13 2007)]).

The following month, the Supreme Court decided an unrelated case involving Section 201(c). In *New York Times v Tasini* individual contributors sued the *Times* for selling their contributions to LexisNexis, which allowed users to search for the articles in a database and view them individually, separated from the content and context of the original paper publication ([533 US 483 (2001)]). Siding with the contributors, the court contrasted articles in a database devoid of original content and contexts against articles in microfilm rolls, where "the user first encounters the articles in context". While the court did not state as much, it implied that microfilm reproductions, which retain the full content and context of the original publication, are permissible revisions under Section 201(c). (For further background, see [Supreme Court delivers landmark ruling in New York Times v Tasini](#).)

The Second Circuit seized on this dictum in 2005 when it heard another contributor's suit against *National Geographic* (*Faulkner v Nat'l Geographic Enterprises, Inc* [409 F 3d 26 (2d Cir 2005), *cert denied* 126 S Ct. 833 (2005)]). The court reasoned that *Tasini* had given tacit approval to microfilm, and that the *Greenberg* analysis from the Eleventh Circuit was inapplicable. It then found the CD-ROM to be analogous to microfilm, as it "present[ed] the underlying works to users in the same context as they were presented [...] in the original versions of the magazine". (For further background, see [National Geographic off the hook for CD-ROM reproduction](#).)

The Eleventh Circuit revisited *Greenberg* in June and reversed its earlier decision. Following *Faulkner* and *Tasini*, it ruled that the scanned images of the *National Geographic* pages constituted a permissible revision under Section 201(c). However, *National Geographic* conceded that a multimedia portion of the CD-ROM, which used copyrighted photos out of their original context, was not privileged under Section 201(c). The court therefore remanded the claim regarding the multimedia for further consideration. Despite *National Geographic's* concession, the court commented that, under the *Tasini* framework, *National Geographic* could have argued that even the multimedia was privileged. The

Faulkner court did not reach the multimedia issue. Thus, while the circuits now agree on the definition of 'revision', the legal status of the *National Geographic* CD-ROM remains unclear.

Mark J Diliberti, Foley & Lardner LLP, Milwaukee and Robert A Gretch, University of Michigan Law School, Ann Arbor

© Copyright 2004 - 2007
Globe Business Publishing Ltd