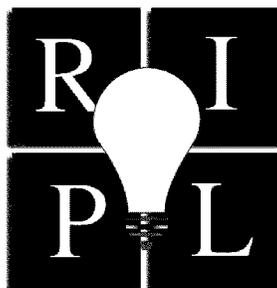


# THE JOHN MARSHALL REVIEW OF INTELLECTUAL PROPERTY LAW



MAGAZINE PUBLISHERS EXHALE: EXPLOITING COLLECTIVE WORKS AFTER  
*GREENBERG*

JASON KORANSKY

## ABSTRACT

The National Geographic Society simply intended to offer an innovative digital product to consumers—its complete archives in digital format—when it released *The Complete National Geographic* CD-ROM. The CD-ROM, however, had a much different impact as well. The litigation that followed its release, in particular *Greenberg v. National Geographic Society*, offered publishers' some clarity in regard to the scope of section 201(c) rights to reproduce collective works in digital formats. *Greenberg*, however, did not address the full range of copyright issues that publishers and freelance contributors alike encounter in reproducing collective works in new digital formats brought about by advances in technology. To further clarify publishers' section 201(c) rights, Congressional intervention is necessary to amend the Copyright Act to redefine section 201(c) to expressly include new digital media revisions as privileged. In addition, Congress should create a compulsory licensing system that gives a publisher a statutory rate at which it can republish contributions to a collective work.

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# MAGAZINE PUBLISHERS EXHALE: EXPLOITING COLLECTIVE WORKS AFTER *GREENBERG*

JASON KORANSKY\*

## INTRODUCTION

Imagine sitting at your desk at your computer, browsing through the archives of *National Geographic* magazine on *The Complete National Geographic* (“*CNG*”) CD-ROM.<sup>1</sup> As an avid scuba diver, you pull up the January 1962 issue on the *CNG*, anticipating a glimpse into an underwater wonderland. In its original print format, this issue features a woman scuba diving on its cover.<sup>2</sup> The *CNG*, however, did not reproduce freelance photographer Jerry Greenberg’s image. Instead, you are greeted by a photo-less cover on the *CNG*’s digital version.

This is not what happened, though. National Geographic did reproduce Greenberg’s cover image—and other images that appeared in the magazine—on the *CNG*. The publisher probably would have left Greenberg’s images off of the *CNG*, or not have produced the CD-ROM at all, had it known of the litigation that would follow the CD-ROM’s release.<sup>3</sup> This is despite the fact that the United States Court of Appeals for the Eleventh Circuit ultimately ruled in favor of the magazine publisher in the lawsuit that the photographer filed against it.<sup>4</sup>

This comment explores the impact of *Greenberg v. National Geographic Society* (“*Greenberg III*”) on publishers’ rights to reproduce collective works in digital formats. It addresses how magazine publishers can use the decision as a guide to produce digital reproductions of their issues, and how copyright law reforms could clarify publishers’ section 201(c) rights. Part I discusses the evolution of United States copyright law in regard to collective works such as *National Geographic* magazine and the *CNG*; the section then explains *Greenberg III*’s effect on

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<sup>1</sup> THE COMPLETE NATIONAL GEOGRAPHIC: 112 YEARS OF NATIONAL GEOGRAPHIC MAGAZINE (National Geographic Society CD-ROM, rel. 2, Oct. 2001) [hereinafter *CNG*].

<sup>2</sup> 121 NAT’L GEOGRAPHIC 1 (1962).

<sup>3</sup> *Greenberg v. Nat’l Geographic Soc’y*, 533 F.3d 1244 (11th Cir. 2008); see also *Faulkner v. Nat’l Geographic Enters. Inc.*, 409 F.3d 26 (2d Cir. 2005) (lawsuit concerning the *CNG*); *Auscape Int’l v. Nat’l Geographic Soc’y*, No. 02-CV-6441-LAK, 2002 U.S. Dist. LEXIS 26318 (S.D.N.Y. Oct. 8, 2002) (companion case to *Faulkner*); *Ward v. Nat’l Geographic Soc’y*, 208 F. Supp. 2d 429 (S.D.N.Y. 2002) (same); Alex Beam, *It’s a Case of Who Owns the Words*, BOSTON GLOBE, Oct. 4, 2005, at F1 (explaining the impact on the National Geographic Society of the lawsuits against following the release of the *CNG*); Press Release, National Geographic, *The Complete National Geographic* (July 29, 2009) (on file with author) (showing that National Geographic, which pulled the *CNG* from the market in 2001, has plans to reintroduce the product by selling a 120th anniversary edition of the CD-ROM in the fall of 2009).

<sup>4</sup> *Greenberg III*, 533 F.3d at 1258.

publishers' section 201(c) rights. Part II analyzes how *Greenberg III* could help to influence the ways magazine publishers exploit new technologies to create new collective works revisions. This section also looks at procedural efficiencies that could be implemented in the magazine publishing industry to make republications of collective works more efficient and economical. Part III proposes that Congress should clarify the scope of publishers' section 201(c) rights and establish a compulsory license for magazine, newspaper, and other journal publishers to help facilitate the reproduction of collective works in new digital technologies.

## I. BACKGROUND

### A. *Establishing Copyright in Collective Works*

The United States Constitution authorizes Congress “[t]o 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.”<sup>5</sup> Pursuant to this power, Congress enacted the Copyright Act of 1790.<sup>6</sup> Congress made a major revision to the Act in 1909.<sup>7</sup> Years later, Congress enacted the Copyright Act of 1976, the most recent overhaul to United States copyright law,<sup>8</sup> and in 1998 passed the Digital Millennium Copyright Act.<sup>9</sup>

The 1909 Copyright Act included the concept of “indivisibility” by using the singular form of the term “proprietor.”<sup>10</sup> “Proprietor” was construed to mean that a copyrighted work was a single piece of property that could have only one owner,<sup>11</sup> and that the bundle of rights held by a copyright owner was indivisible.<sup>12</sup> This concept

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<sup>5</sup> U.S. CONST. art. I, § 8, cl. 8.

<sup>6</sup> Copyright Act of 1790, 1 Cong. ch. 15, 1 Stat. 124 (1790).

<sup>7</sup> Copyright Act of 1909, H.R. 28192, 60th Cong. ch. 320, 35 Stat. 1075 (1909).

<sup>8</sup> Copyright Act of 1976, Pub. L. No. 94-553, 90 Stat. 2541 (codified as amended at 17 U.S.C. §§ 101–810 (2006)).

<sup>9</sup> Digital Millennium Copyright Act of 1998, Pub. L. No. 105-304, 112 Stat. 2860 (1998).

<sup>10</sup> H.R. 28192, at 1076 § 3 (“The copyright upon composite works or periodicals shall give to the proprietor thereof all the rights in respect thereto which he would have if each part were individually copyrighted under this Act.”); see also 3 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 10:02[A] (2009) (“[I]ndivisibility is abolished as regards exclusive licensees, who are regarded as the copyright owners of the rights that they have been licensed. But divisibility is provided for only with respect to ‘[a]ny of the exclusive rights comprised in copyright, including any subdivision of rights specified in section 106.’”).

<sup>11</sup> See Harry G. Henn, “*Magazine Rights*”—*A Division of Indivisible Copyright*, 40 CORNELL L. Q. 411, 417–18 (1955).

With respect to a particular work embodied in concrete form, or separable part of such work, there is, at any one time, in any particular jurisdiction, only a single incorporeal legal title or property known as the copyright, which encompasses all of the authorial rights recognized by the law of the particular jurisdiction with respect thereto.

*Id.*

<sup>12</sup> See *N.Y. Times Co. v. Tasini*, 533 U.S. 483, 494 (2001) (“[A]uthors risked losing their rights when they placed an article in a collective work. . . . The author did not have the option to assign only the right of publication in the periodical; such a partial assignment was blocked by the doctrine of copyright ‘indivisibility.’”); see also *Gardner v. Nike, Inc.*, 279 F.3d 774, 778 (9th Cir. 2002)

held particular significance to magazines and newspapers. These products are a collection of articles and photographs from various writers and photographers, which are then assembled and published by a publisher.<sup>13</sup> A contributor could contractually retain certain rights to his or her story or photos by “first assign[ing] all rights [to the publisher].”<sup>14</sup> Then, the publisher could “grant back those substantive rights that the [contributor] wished to retain.”<sup>15</sup>

The 1976 Copyright Act altered the copyright landscape by abolishing the doctrine of indivisibility, stating that, “Any of the exclusive rights comprised in a copyright, including any subdivision of any of the rights specified in section 106, may be transferred . . . and owned separately.”<sup>16</sup> The 1976 Act specified the bundle of rights that a copyright holder possesses.<sup>17</sup> The Act specified that a “collective work” is a, “[W]ork, 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.”<sup>18</sup> In regard to the rights vested in a “collective work,” the 1976 Act reads:

Copyright in each separate contribution to a collective work is distinct from copyright in the collective work as a whole, and vests initially in the author of the contribution. In the absence of an

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(“Under the doctrine of indivisibility, a copyright owner possessed an indivisible ‘bundle of rights,’ which were ‘incapable of assignment in parts.’ . . . Thus, an assignment included ‘the totality of rights commanded by copyright.’”); MARK S. LEE, ENTERTAINMENT AND INTELLECTUAL PROPERTY LAW § 6:52 (2008).

The 1909 Act spoke of a single “copyright,” and this and similar language in earlier copyright statutes caused courts to conclude that all of the rights available to a copyright owner were subsumed within a single “copyright” that was incapable of piecemeal assignment . . . . Transferees of specific rights in a copyrighted work (such as, initial publication rights, dramatic rights, serial rights, movie rights, etc.), were deemed “licensees” of those specific rights in the work, with the “indivisible” copyright continuing to be owned by the transferor author.

*Id.*

<sup>13</sup> See NIMMER & NIMMER, *supra* note 10, § 10:01[C][2].

[I]f . . . the magazine carried a notice only in the name of the magazine publisher without a separate notice in the name of the contributing author, applying the doctrine of indivisibility the result was that the author’s work was published without a valid notice in the name of the work’s “proprietor” and it was consequently injected into the public domain.

*Id.* But see *Goodis v. United Artists Television, Inc.*, 425 F.2d 397, 399 (2d Cir. 1970) (“[When] a magazine has purchased the right of first publication under circumstances which show that the author has no intention to donate his work to the public, copyright notice in the magazine’s name is sufficient to obtain a valid copyright on behalf of . . . the author or proprietor.”).

<sup>14</sup> See NIMMER & NIMMER, *supra* note 10, § 10:01[B].

<sup>15</sup> *Id.*

<sup>16</sup> 17 U.S.C. § 201(d)(2) (2006); see also 147 CONG. REC. E 182-02 (2001) (letter from Marybeth Peters, Register of Copyrights, to Congressman James P. McGovern) (“[The Copyright Act of 1976] represented ‘a break with a two-hundred-year old tradition that has identified copyright more closely with the publisher than with the author . . . .’”).

<sup>17</sup> 17 U.S.C. § 106.

<sup>18</sup> *Id.* § 101.

express transfer of the copyright or of any rights under it, the owner of copyright in the collective work is presumed to have acquired only the privilege of reproducing and distributing the contribution as part of that particular collective work, any revision of that collective work, and any later collective work in the same series.<sup>19</sup>

In this section, Congress attempted to strike a balance between contributors' and publishers' rights in collective works.<sup>20</sup> This legislation clarified and attempted to improve confusing and often inequitable legal relationships between publishers and contributors.<sup>21</sup> Disagreements arose concerning the applicability of section 201(c) to digital media, which the Supreme Court ultimately addressed.<sup>22</sup>

*B. The Tasini Effect on Publishers' Section 201(c) Reproduction Privileges*

The Supreme Court's first and only ruling on the extent of publishers' rights under section 201(c) came in *New York Times Co. v. Tasini*.<sup>23</sup> *Tasini* held that republication of freelance authors' stories in electronic databases, such as LEXIS-NEXIS, without the writers' consent, was not a publisher's privileged reproduction under section 201(c).<sup>24</sup> Writing for the Court, Justice Ginsburg analyzed whether the articles in the databases appeared as part of the periodicals, or as individual articles separated from the original publications.<sup>25</sup> The Court ruled that they appeared as the latter, that the stories appearing individually in the database did not constitute a reproduction of the original collective work.<sup>26</sup>

The publishers presented an analogy between the electronic databases and microfilm and microfiche.<sup>27</sup> The Court did not agree with this analogy.<sup>28</sup> In response to this argument, however, the Court did offer a framework in which a reproduction would be allowed.<sup>29</sup> The Court stated, "[U]nlike the conversion of newsprint to microfilm, the transfer of articles to the Databases does not represent a mere conversion of intact periodicals (or revisions of periodicals) from one medium to another."<sup>30</sup> The Court agreed with the publishers that the Copyright Act's concept of media neutrality provided that "the 'transfer of a work between media' does not 'alter

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<sup>19</sup> *Id.* § 201(c).

<sup>20</sup> See H.R. REP. NO. 94-1476, at 122 (1976), *reprinted in* 17 GEORGE S. GROSSMAN, OMNIBUS COPYRIGHT REVISION LEGISLATIVE HISTORY 1, 122 (2001). ("[O]ne of the most significant aims of the bill is to clarify and improve the present confused and frequently unfair legal situation with respect to rights in contributions.").

<sup>21</sup> *See id.*

<sup>22</sup> *See* N.Y. Times Co. v. Tasini, 533 U.S. 483 (2001).

<sup>23</sup> *Id.*

<sup>24</sup> *Id.* at 506.

<sup>25</sup> *Id.* at 500–01 ("The Databases' reproduction and distribution of individual Articles—simply as *individual Articles*—would invade the core of the Authors' exclusive rights.").

<sup>26</sup> *Id.* at 503–04.

<sup>27</sup> *Id.* at 501.

<sup>28</sup> *Id.* at 501–02.

<sup>29</sup> *Id.* at 502.

<sup>30</sup> *Id.*

the character of” that work for copyright purposes.”<sup>31</sup> Media neutrality was tested in the litigation surrounding the National Geographic CD-ROM.

### C. Greenberg Cases Help to Clarify Section 201(c) Privileges

Jerry Greenberg’s underwater photography was prominently featured in *National Geographic* for three decades. Specifically, his photographs appeared in the January 1962,<sup>32</sup> February 1968,<sup>33</sup> May 1971,<sup>34</sup> and July 1990<sup>35</sup> issues of the magazine. Hired as a freelancer, Greenberg initially assigned the copyright in the photographs to National Geographic Society, and subsequently regained copyrights in the photos.<sup>36</sup>

Greenberg challenged the extent of National Geographic’s rights under section 201(c) to reproduce its magazines in digital format.<sup>37</sup> He sued the National Geographic Society for copyright infringement following the 1997 release of the *CNG*.<sup>38</sup> The thirty-disc CD-ROM reproduced every issue of *National Geographic*—approximately 1,200 issues dated from 1888 to 1996.<sup>39</sup> The digital magazines appeared in almost the exact design layout and with the same content—with only trivial additions or deletions of stories, photographs, or advertisements—as they originally appeared in print.<sup>40</sup> The United States District Court for the Southern District of Florida initially granted National Geographic Society summary judgment, finding that the *CNG* was a privileged revision of a collective work under section 201(c).<sup>41</sup>

Greenberg appealed to the United States Court of Appeals for the Eleventh Circuit, and in what would ultimately be its first of three decisions (“*Greenberg I*”), the court reversed and remanded the case.<sup>42</sup> *Greenberg I* broke the *CNG* down into three elements: (1) the magazine replicas, (2) the computer program that stored and

<sup>31</sup> *Id.* But see *Random House, Inc. v. Rosetta Books LLC*, 150 F. Supp. 2d 613, 622 (S.D.N.Y. 2001), *aff’d*, 283 F.3d 490 (2d Cir. 2002) (explaining that in book publishing industry standards, at the time of this litigation, an “ebook” is not a privileged revision of a printed book).

<sup>32</sup> Jerry Greenberg, *Florida’s Coral City Beneath the Sea*, 121 NAT’L GEOGRAPHIC 1, 70 (1962).. Jerry Greenberg’s photo appears on the cover of this issue of *National Geographic*. *Id.* at cover.

<sup>33</sup> Nathaniel T. Kenney, *Sharks: Wolves of the Sea*, 133 NAT’L GEOGRAPHIC 151, 222 (1968). Jerry Greenberg’s photo appears on the cover of this issue of *National Geographic*. *Id.* at cover.

<sup>34</sup> Jerry Greenberg & Idaz Greenberg, *Buck Island—Underwater Jewel*, 139 NAT’L GEOGRAPHIC 591, 675 (1971).

<sup>35</sup> Fred Ward, *Florida’s Coral Reefs Are Imperiled*, 178 NAT’L GEOGRAPHIC 1, 115 (1990).

<sup>36</sup> *Greenberg v. Nat’l Geographic Soc’y*, 533 F.3d 1244, 1247 n.3 (11th Cir. 2008).

<sup>37</sup> See *Greenberg v. Nat’l Geographic Soc’y*, No. 97-3924-CV-JAL, 1998 U.S. Dist. LEXIS 18060, at \*3 (S.D. Fla. May 14, 1998), *rev’d*, 244 F.3d 1267 (11th Cir. 2001), *rev’d*, 488 F.3d 1331 (11th Cir. 2007), *vacated*, 497 F.3d 1213 (11th Cir. 2007), *rev’d en banc*, 533 F.3d 1244 (11th Cir. 2008).

<sup>38</sup> *Id.*

<sup>39</sup> See *id.* at \*2; see also *Faulkner v. Nat’l Geographic Enters. Inc.*, 409 F.3d 26, 30 (2d Cir. 2005). National Geographic created an updated version of the *CNG* in 1998, 1999, 2000, and 2001 to include the most current year’s issues. *Id.* at n.2. It also produced decade sets of the *CNG*, a thirty-year set containing thirty years of issues, a version of the *CNG* for teachers, and individual CD-ROM discs to supplement the *CNG*. *Id.*

<sup>40</sup> *Greenberg*, 1998 U.S. Dist. LEXIS, at \*8–9.

<sup>41</sup> *Id.* at \*10.

<sup>42</sup> *Greenberg v. Nat’l Geographic Soc’y*, 244 F.3d 1267, 1276 (11th Cir. 2001).

retrieved the replicas, and (3) the rotating sequence of *National Geographic* magazine covers that appears when the CD-ROM launches on a computer.<sup>43</sup> The court wrote that, “[C]ommon-sense copyright analysis compels the conclusion that the Society . . . has created a new product . . . in a new medium, for a new market that far transcends any privilege of revision or other mere reproduction envisioned in § 201(c).”<sup>44</sup>

*Greenberg I* held that the introductory sequence and underlying computer program operating the digital archive altered the magazine in such a way that it made the *CNG* “in no sense a ‘revision.’”<sup>45</sup> On remand, a jury found National Geographic liable for \$400,000 in statutory damages.<sup>46</sup>

About three months after *Greenberg I*, the Supreme Court decided *New York Times Co. v. Tasini*.<sup>47</sup> *Tasini* clarified the legal framework for reproductions of collective works.<sup>48</sup> A split also emerged between the United States Court of Appeals for the Eleventh Circuit and the United States Court of Appeals for the Second Circuit.<sup>49</sup> In *Faulkner v. National Geographic Enterprises Inc.*,<sup>50</sup> the Second Circuit relied upon *Tasini* to allow National Geographic to reproduce its archives in the *CNG*.<sup>51</sup> *Faulkner* involved a group of photographers and authors whose work appeared in the *CNG*.<sup>52</sup> The court held that “the *CNG* is a revision for Section 201(c) purposes.”<sup>53</sup> In addition, the court rejected the claim by most of the photographers and writers that their contracts with National Geographic overrode section 201(c) by “limit[ing] publication rights in paper format only.”<sup>54</sup>

With this backdrop, National Geographic appealed the holding in *Greenberg I* (“*Greenberg IP*”).<sup>55</sup> Relying upon *Tasini* and *Faulkner*, the United States Court of

<sup>43</sup> *Id.* at 1269.

<sup>44</sup> *Id.* at 1273.

<sup>45</sup> *Id.* at 1272. The Supreme Court denied National Geographic’s petition for writ of certiorari. *Greenberg v. Nat’l Geographic Soc’y*, 534 U.S. 951 (2001).

<sup>46</sup> See *Greenberg v. Nat’l Geographic Soc’y*, 488 F.3d 1331, 1334 (11th Cir. 2007) (detailing how the district court jury found a verdict for willfulness and awarded Jerry Greenberg \$400,000—\$100,000 for each issue of National Geographic on the *CNG* to which he contributed photos—at the time the maximum statutory damages at the time for willful copyright infringement); see also 17 U.S.C. § 504(c)(2) (2006) (providing that the maximum statutory damages for willful copyright infringement is \$150,000 for each work that is infringed).

<sup>47</sup> 533 U.S. 483 (2001).

<sup>48</sup> *Id.* at 504.

<sup>49</sup> Compare *Faulkner v. Nat’l Geographic Enters. Inc.*, 409 F.3d 26, 40 (2d Cir. 2005) (holding that the *CNG* is a privileged revision), with *Greenberg*, 244 F.3d at 1275 (holding that the *CNG* infringes on contributors’ copyrights).

<sup>50</sup> 409 F.3d 26.

<sup>51</sup> *Id.* at 30, 38.

<sup>52</sup> *Id.* at 32.

<sup>53</sup> *Id.* at 30.

<sup>54</sup> *Id.* at 40 (explaining that publishers who do not contractually specify the scope of reproduction rights that extend or override section 201(c), only acquire the rights as specified in section 201(c)); see also RAYMOND T. NIMMER & JEFF DODD, WHAT LAW, WHAT FORUM APPLIES TO A LICENSE?, MODERN LICENSING LAW § 2:31 (2008) (explaining *Faulkner*) (“The court viewed the Section 201 privilege as a form of default rule and held that this rule could be changed and the privilege withheld, but not by merely failing to grant the right involved by contract. Instead, precluding revisions required express contractual language to that effect.”).

<sup>55</sup> *Greenberg v. Nat’l Geographic Soc’y*, 488 F.3d 1331 (11th Cir. 2007). National Geographic presented three grounds upon which it appealed *Greenberg I*. Brief of Appellants at 17, *Greenberg*,

Appeals for the Eleventh Circuit used the *Tasini* framework to analyze section 201(c) privileges.<sup>56</sup> The court examined whether the *CNG*'s introductory sequence and the underlying computer program destroyed the "original context" of the collective work.<sup>57</sup> It reversed *Greenberg I*, holding that the *CNG* was a privileged revision under Section 201(c) because these elements did not transform the original magazines into a different collective work.<sup>58</sup>

*Greenberg II*, however, was vacated,<sup>59</sup> and the United States Court of Appeals for the Eleventh Circuit reheard the case en banc ("*Greenberg III*").<sup>60</sup> Greenberg argued that the premise behind section 201(c) is "[t]o preserve the motivational effort of authors."<sup>61</sup> He further argued that Congress drafted section 201(c) to grant publishers the right to reproduce contributions to collective works in limited circumstances.<sup>62</sup> He argued that the *CNG* constituted a "revision" of the original collective works, and that the court should not stretch section 201(c) to encompass such a work.<sup>63</sup> The *Greenberg III* court was not persuaded by his argument, and essentially reiterated the rationale behind *Greenberg II* in determining that the *CNG* was a privileged revision.<sup>64</sup> In a seven-to-five vote, the court decided the case in favor of National Geographic and mended a circuit split.<sup>65</sup> The court also peeked into the

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488 F.3d 1331 (No. 05-16964-JJ). First, National Geographic asserted that *Greenberg I* incorrectly held that it was not entitled to the privilege of section 201(c) with the *CNG*. *Id.* at 17. Second, National Geographic claimed that the district court erred by striking its answer on remand, which precluded it from defending itself against liability for copyright infringement. *Id.* at 35. Third, National Geographic argued that the magistrate judge on remand from *Greenberg I* was incorrect in allowing the jury to award Jerry Greenberg damages for willful copyright infringement. *Id.* at 45.

<sup>56</sup> *Greenberg*, 488 F.3d at 1335, 1338.

Under the *Tasini* framework, the relevant question is whether the original context of the collective work has been preserved in the revision. Clearly, the Replica portion of the *CNG* preserves the original context of the magazines, because it comprises the exact images of each page of the original magazines. Similarly, the Program is transparent to the viewer and does not alter the original context of the magazine contents.

*Id.* at 1338.

<sup>57</sup> *Id.* at 1339.

<sup>58</sup> *Id.* at 1341.

<sup>59</sup> *Greenberg v. Nat'l Geographic Soc'y*, 497 F.3d 1213, 1214 (11th Cir. 2007).

<sup>60</sup> *Greenberg v. Nat'l Geographic Soc'y*, 533 F.3d 1244, 1248 (11th Cir. 2008).

<sup>61</sup> Brief of Appellee Jerry Greenberg at 25, *Greenberg*, 488 F.3d 1331 (No. 05-16964-JJ).

<sup>62</sup> *Id.*

<sup>63</sup> *Id.* at 16.

<sup>64</sup> *Greenberg*, 533 F.3d at 1255 ("The addition of new material to a collective work will not, by itself, take the revised collective work outside the privilege, and the pertinent question for a court is whether the new material so alters the collective work as to destroy its original context.").

<sup>65</sup> *Id.* at 1258. *But see id.* n.21 (indicating that National Geographic could still be held liable for its use of the January 1962 cover in the opening sequence on the *CNG*). In a vigorous dissent, Justice Birch argued that "the authors, artists, and creators should share in the publisher's profits and that the arguments, both legal and policy, by the publishers are bereft of logic, legal merit, and are totally disingenuous." *Id.* at 1259–60 (Birch, J., dissenting). He then enunciated three reasons why the *CNG* should not be classified as a privileged reproduction: (1) that it is an entirely new collective work; (2) the National Geographic could not enter into agreements with third parties such as the technology company Mindscape to work on the collective work; (3) and National Geographic has displayed Jerry Greenberg's works publicly on a computer screen, which is a "non privileged exercise by a § 201(c) grantee" of a section 106 exclusive right of a copyright holder. *Id.* at 1260.

digital future of the publishing industry, stressing the importance to abide by media neutrality as discussed in *Tasini*, with technological advances leading to the proliferation of new media.<sup>66</sup>

## II. ANALYSIS

### A. Magazine Industry Receives Some Section 201(c) Clarity to Exploit Digital Reproductions

Magazine publishers across the United States waited with bated breath for the court's decision in *Greenberg III*.<sup>67</sup> When the court held that National Geographic did not infringe upon Greenberg's copyright when his photos appeared in the *CNG*,<sup>68</sup> publishers in general most likely welcomed the decision.<sup>69</sup> A ruling in favor of Greenberg could have created cost-prohibitive legal hurdles for publishers to reproduce their archives in digital formats.<sup>70</sup> Such a ruling also could have created potential copyright infringement liability for magazine publishers that have developed digital versions of their archives similar to the *CNG*.<sup>71</sup>

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<sup>66</sup> *Id.* at 1257 (“With publications continuously being reproduced in new mediums, courts should not disapprove of the reproduction or distribution of collective works in those mediums without evaluating whether the publisher has violated the contextual fidelity of the original collective work or revised the individual contribution itself.”); see also William Patry: I’m Barking for Judge Barkett, <http://williampatry.blogspot.com/2008/07/im-barking-for-judge-barkett.html> (July 1, 2008 21:00 PST). (“Judge Barkett rightly focused on [National Geographic’s] contextual nature: the CNG used the identical selection, coordination, and arrangement of the freelancer’s contributions as found in the hard copy magazines, and was an image-based reproduction just like microfilm . . .”).

<sup>67</sup> See Brief of Amicus Curiae Magazine Publishers of America, Inc. Supporting Defendants-Appellants at 11, *Greenberg v. Nat’l Geographic Soc’y*, 488 F.3d 1331 (11th Cir. 2007) (No. 05-16964-JJ) (“[T]his court will . . . finally provide the 1400 magazines represented by the MPA and other periodical publishers a clear, unified standard to follow when they seek to offer the public their archives.”).

<sup>68</sup> *Greenberg*, 533 F.3d at 1258.

<sup>69</sup> See Joseph Siprut, *Greenberg v. National Geographic Society: The Eleventh Circuit Clarifies the Privileged Revision Doctrine of the Copyright Act*, 30 HASTINGS COMM. & ENT. L.J. 521, 521 (2008) (“[T]he Eleventh Circuit’s opinion is a victory for both National Geographic, specifically, and publishers, generally.”).

<sup>70</sup> See Mark A. Lemley, *Cultural Environmentalism @ 10: Should A Licensing Market Require Licensing?*, 70 LAW & CONTEMP. PROBS. 185, 192 (2007) (discussing the problem of copyright owners overvaluing their content, which can result in steep hurdles to distribute the work in subsequent formats).

<sup>71</sup> See THE COMPLETE NEW YORKER (Random House DVD-ROM, rel. 25, Sept. 2005) (featuring a digital version of every issue of *The New Yorker* published from February 1925 to April 2008, available as a eight-DVD set or loaded onto a portable hard drive); PLAYBOY COVER TO COVER: THE 50S (Bondi Digital Publishing DVD-ROM, rel. 9, Oct. 2007) (featuring a digital version of every issue of *Playboy* published in the 1950s on DVD); ROLLING STONE COVER TO COVER: THE FIRST 40 YEARS (Rolling Stone DVD-ROM, rel. 9, Oct. 2007) (featuring a digital version of every issue of *Rolling Stone* published from 1967 to May 2007 on a four-DVD set); see also Dylan Stableford, *National Geographic Renews Legal War Over Digital Archive*, FOLIO, March 3, 2008, <http://www.foliomag.com/2008/national-geographic-renews-legal-war-over-digital-archive> (quoting Edward Klaris, Condé Nast vice president of editorial assets, publisher of *The New Yorker*, regarding the company’s risk in producing its DVD prior to *Greenberg III*).

The *Greenberg III* holding, however, did not give publishers blanket rights to reproduce their archives in any format, nor did the court explicitly extend its holding to any other form of new media.<sup>72</sup> The court clarified the *Tasini* holding by creating a test for privileged revisions.<sup>73</sup> A revision that “faithfully preserves the original context” of the collective work could be classified as a privileged section 201(c) reproduction.<sup>74</sup>

Courts could construe *Greenberg III* as expanding the protection of collective works revisions beyond reproductions of magazines on a CD-ROM.<sup>75</sup> For instance, a magazine publisher could argue that *Greenberg III* applies to digital magazines.<sup>76</sup> A digital magazine, which can be read online or downloaded to a computer, allows a reader to flip virtually through an all-digital replica of the magazine.<sup>77</sup> While the market penetration of digital magazines has not advanced to the point of threatening to replace their paper counterparts, they are making steady inroads into the market.<sup>78</sup> Companies such as Zinio LLC, Texterity, Inc., and Olive Software, Inc., provide the technology and services to bring these new publications to the market.<sup>79</sup> The major bookseller Barnes & Noble even features a digital newsstand on its web site that sells digital subscriptions and single issues of magazines.<sup>80</sup>

Digital magazines can be enhanced versions of their print counterparts, with publishers adding stories, photos, audio, and video to the digital publication.<sup>81</sup> This could potentially destroy the collective work’s original context and eliminate a

<sup>72</sup> *Greenberg*, 533 F.3d at 1258 n.21.

<sup>73</sup> *Id.* at 1258.

<sup>74</sup> *Id.*

<sup>75</sup> *Id.* at 1256–57 (“The conversion of magazine issues from print to digital form—as opposed to their conversion from print to print, or print to microform—does not create a different balance of copyright protection under § 201(c) between individual authors and publishers because copyright protection is media neutral.”).

<sup>76</sup> See Jon Swartz, *Zinio Puts Hundreds of Magazines a Click Away*, USA TODAY, May 28, 2008, at Money 9A (describing the functionality of digital magazines); see also Julie Bosman, *Magazines Going to the Web to Get Students to Read*, N.Y. TIMES, Sept. 7, 2006, at C5 (reporting that publishers are giving away digital magazine subscriptions to college students, believing they will appeal to a younger demographic).

<sup>77</sup> See Swartz, *supra* note 76.

<sup>78</sup> See Matt Kinsman, *Gilbane Study: Digital Magazines Post Rapid Reader Growth Yet Market Penetration Slips*, FOLIO, June 1, 2008, at 13 (“[T]here are more than 3,200 digital magazines today—b-to-b and consumer combined—with more than 13 million subscriptions, up more than 260 percent from 2005.”).

<sup>79</sup> See Backgrounder - 1, <http://info.texterity.com/info/CorpBack/#pg1> (last visited Aug. 17, 2009) (detailing Texterity’s technological capabilities and market reach); Company Overview - Company - Olive Software, <http://www.olivesoftware.com/company/> (last visited Aug. 17, 2009) (offering an overview of the company’s history and technologies); Press Release, Zinio, Zinio Launches “INSIDE”: Original Magazine Content Unlocked For Search (Nov. 20, 2008) (on file with author) (describing a new digital publishing platform from “the world’s leader in digital publishing solutions and services”).

<sup>80</sup> Barnes & Noble.com - Magazines: Formats: Digital Magazines, <http://gifts.barnesandnoble.com/search/results.asp?TYP=Z&PST=Z1&FMT=33> (last visited Aug. 17, 2009) (featuring digital magazine titles for download); see also Press Release, Zinio, Barnes & Noble.com Announces New Digital Products (May 6, 2008) (on file with author) (unveiling a partnership between Barnes & Noble.com and Zinio to provide more than “1,000 magazine titles available in both digital and print formats”).

<sup>81</sup> Michael V. Copeland, *The End Of Paper*, FORTUNE, March 16, 2009, at 66.

publisher's section 201(c) privilege.<sup>82</sup> In addition, new technologies such as the Kindle or other similar digital reading devices ("e-readers") can change the way that readers interact with magazines.<sup>83</sup> For example, magazine publishers currently create versions of their magazines to be compatible with the Kindle e-reader sold by Amazon.<sup>84</sup> Once Amazon releases a color-screen version of the Kindle, or other companies release e-readers that feature a color screen, publishers will have a platform to place graphic-intensive, interactive digital publications into readers' hands.<sup>85</sup> These can include single issues or complete archives of their magazines.<sup>86</sup> As publishers move forward, *Greenberg III* will serve as a touchstone decision to help them determine the extent to which they can alter and augment the original magazine and still have it classified as a privileged section 201(c) revision.<sup>87</sup> But as publishing technology continues to evolve, conflicts between publishers and their contributors may raise new section 201(c) issues.<sup>88</sup>

*B. Greenberg III Does Not Eliminate Potential Section 201(c) Issues Between Publishers and Freelance Contributors*

When Greenberg began contributing to *National Geographic* in the early 1960s, neither he nor the magazine envisioned that one day the magazine could appear in formats that allowed for the publication to be viewed on a computer.<sup>89</sup> Digital

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<sup>82</sup> See 107 U.S.C. § 201(c) (2006).

<sup>83</sup> See Copeland, *supra* note 81.

<sup>84</sup> See Amazon.com: Kindle Magazines: The Kindle Store, [http://www.amazon.com/Kindle-Magazines/b/ref=amb\\_link\\_84305771\\_79?ie=UTF8&node=1263069011&pf\\_rd\\_m=ATVPDKIKX0DER&pf\\_rd\\_s=browse&pf\\_rd\\_r=0NGCANMTFZ3SV7C5GNJ3&pf\\_rd\\_t=101&pf\\_rd\\_p=481800131&pf\\_rd\\_i=133141011](http://www.amazon.com/Kindle-Magazines/b/ref=amb_link_84305771_79?ie=UTF8&node=1263069011&pf_rd_m=ATVPDKIKX0DER&pf_rd_s=browse&pf_rd_r=0NGCANMTFZ3SV7C5GNJ3&pf_rd_t=101&pf_rd_p=481800131&pf_rd_i=133141011) (last visited Aug. 17, 2009) (Amazon's Kindle magazine stand).

<sup>85</sup> See Copeland, *supra* note 81.

[A]t least a half-dozen companies, including giants like Hewlett-Packard and Fujitsu and startups such as Polymer Vision, FirstPaper, and Plastic Logic, are developing a new crop of readers, some of which will start hitting the market later this year. Designed with the requirements of newspapers and magazines in mind, they will feature larger screens (to make it easier to navigate through stories), wireless updating (something the Kindle has made a requirement), better image resolution, and eventually color and video.

*Id.*

<sup>86</sup> See Jeffrey M. O'Brien & Jessica Shambora, *Amazon's Next Revolution*, FORTUNE, June 8, 2009, at 68 ("Advertisers and publishers, especially magazine producers like Fortune's parent, Time Inc., are salivating over the prospect of a color-screen Kindle.")

<sup>87</sup> *Greenberg v. Nat'l Geographic Soc'y*, 533 F.3d 1244, 1258 (11th Cir. 2008) (laying forth the test that courts will probably use in these battles).

<sup>88</sup> *Id.* at n.21.

<sup>89</sup> Brief of Appellee Jerry Greenberg, *supra* note 61, at 26.

When I began a relationship with the Society as a contributor to the Magazine around 1960, and for many years thereafter, the Magazine was distributed only to Society members and the Society was purely a nonprofit institution. No other "market" for the photographs provided by me for the four articles published in the monthly Magazine was ever contemplated. Had I had any intimation that the Society would

publishing technologies will only continue to expand. While new technologies present challenges to the copyright law system currently in place,<sup>90</sup> they also present business opportunities for magazine publishers. Therefore, even in a time of declining advertising revenues<sup>91</sup> and circulation<sup>92</sup> for magazines, new media can provide new revenue streams. This allows publishers to actually pay their contributors and retain their staff.<sup>93</sup> For example, Amazon proactively works with publishers to license their content to Amazon, in an effort to provide Kindle e-reader users with a broad range of content options.<sup>94</sup>

While *Greenberg III* offered a broad range of protection for collective works reproductions, it did not contemplate every prospective use that a magazine publisher may find with the contributions to a collective work.<sup>95</sup> For example, *Greenberg III* did not discuss whether a publisher can post select articles—not in facsimile form and taken out of the context of the collective work—from an issue of a magazine on its web site. A party that believes it has been injured by another can seek recourse in the courts.<sup>96</sup> Therefore, as magazine publishers navigate the new digital waters and create new collective work revisions, they will never be immune from potential litigation from freelance contributors. As a result, courts may have to determine when a revision constitutes an entirely new collective work, such as the databases in *Tasini*.<sup>97</sup> The prevailing issue, however, is to develop a copyright system for contributions to collective works that balances the interests of publishers and freelance contributors.<sup>98</sup> This system should not burden publishers to the point

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in later years expand its horizons for the Magazine into for-profit enterprises and digital products, I would have approached the jobs they offered me with a different set of expectations.

*Id.*

<sup>90</sup> See Doris Estelle Long, *Dissonant Harmonization: Limitations on "Cash n' Carry" Creativity*, 70 ALB. L. REV. 1163, 1186–87 (2007) (“Copyright regimes have also managed to stumble when faced with technological advances that alter business models and force long standing culture industries to reconstitute themselves.”).

<sup>91</sup> See Jason Fell, *Magazine Ad Pages Fall 12.9 Percent in Q3*, FOLIO, Oct. 14, 2008, <http://www.foliomag.com/2008/magazine-ad-pages-fall-12-9-percent-during-third-quarter> (describing a drop in United States consumer magazine advertising pages and revenue in the third quarter of 2008).

<sup>92</sup> See Dylan Stableford, *Magazines Take a Huge Hit at the Newsstand*, FOLIO, Feb. 11, 2008, <http://www.foliomag.com/2008/magazines-take-hit-newsstand> (“[A] number of high profile consumer magazines took a big hit in overall circulation while others saw a precipitous drop at the newsstand.”).

<sup>93</sup> See Tim Arango, *Time Inc. Has Plans to Lay Off 600 Workers*, N.Y. TIMES, Oct. 29, 2008, at B8 (reporting plans by the world’s largest magazine publishing company Time Inc., to cut approximately six percent of its staff).

<sup>94</sup> See Malcolm Gladwell, *Priced to Sell: Is Free the Future?*, THE NEW YORKER, July 6, 2009, at 78.

<sup>95</sup> *Greenberg v. Nat’l Geographic Soc’y*, 533 F.3d 1244, 1257–58 (11th Cir. 2008) (discussing the test that a court must use to determine if a reproduction in a new medium qualifies as a privileged reproduction under section 201(c)).

<sup>96</sup> See, e.g., *Marbury v. Madison*, 5 U.S. 137, 163 (1803) (“The very essence of civil liberty certainly consists in the right of every individual to claim the protection of the laws, whenever he receives an injury.”).

<sup>97</sup> See *N.Y. Times v. Tasini*, 533 U.S. 483, 506 (2001).

<sup>98</sup> See JAY DRATLER, JR., LICENSING INTELL. PROP. § 3:03[3] (2009) (discussing the general framework of the relationship between publishers and freelance contributors to collective works).

where they lose economic incentives to publish revisions to collective works, or be subject to injunctions or excessive liability if they publish a contribution without the author's consent.<sup>99</sup> Yet, it should offer contributors the necessary rewards to provide their intellectual property to collective works.<sup>100</sup>

Publishers and their contributors can negotiate their contracts to account for copyright issues that have emerged with new publishing technology and future media.<sup>101</sup> The free market system has sparked new contractual frameworks for some publications.<sup>102</sup> Publishers have changed their freelance publishing contracts to expressly grant them expansive reproduction rights in digital media, or media that may hereafter come into existence, for contributions to collective works.<sup>103</sup> The process of retroactively negotiating usage, however, can prove cost and time prohibitive, creating potentially debilitating barriers for a publisher to reproduce a collective work.<sup>104</sup>

Such a system of individual retroactive negotiations may create a confusing patchwork of contracts.<sup>105</sup> This could provide contributors with "holdout" power to refuse to sign a contract, thereby preventing particular contributions from being used in collective works.<sup>106</sup> Ironically, the lack of foresight by potential holdout copyright owners could actually hinder their own economic interests by blocking new revenue streams from emerging technologies.<sup>107</sup> This occurred in cable television, where many content providers initially blocked cable operators from airing their

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<sup>99</sup> See Lemley, *supra* note 70, at 192 (discussing a situation in which the copyright holder does not grant the rights to disseminate their work, and the negative consequences that this can have).

<sup>100</sup> See Daniel R. Cahoy, *Changing the Rules in the Middle of the Game: How the Prospective Application of Judicial Decisions Related to Intellectual Property Can Promote Economic Efficiency*, 41 AM. BUS. L.J. 1, 13 (2003) ("Due to the low cost of copying and using information assets such as copyrighted material, protection . . . is necessary if one is to invest time and resources in developing them.").

<sup>101</sup> See *Faulkner v. Nat'l Geographic Enters. Inc.*, 409 F.3d 26, 40 (2d Cir. 2005) (explaining that publishers who do not specify the scope of reproduction rights that extend or override section 201(c), acquire only the privilege of reproducing and distributing the contribution as part of that particular collective work, any revision of that collective work, and any later collective work in the same series).

<sup>102</sup> See generally Carolina Saez, *Enforcing Copyrights in the Age of Multimedia*, 21 RUTGERS COMPUTER & TECH. L.J. 351 (1995) (discussing changes in contracts involving digital media).

<sup>103</sup> *Id.* at 358–59.

<sup>104</sup> See Alina Ng, *Authors and Readers: Conceptualizing Authorship in Copyright Law*, 30 HASTINGS COMM. & ENT. L.J. 377, 409–10 (2008) (arguing for a balance between authors' property rights in copyrighted works and the need to have a system that disseminates useful information to the public).

<sup>105</sup> See *id.* at 411 (discussing the procedural efficiencies in a standardized licensing system for parties to use other parties' works).

<sup>106</sup> See Hannibal Travis, *Building Universal Digital Libraries: An Agenda for Copyright Reform*, 33 PEPP. L. REV. 761, 786 (2006).

History provides us with some helpful guidance to the process by which property owners try, but often fail, to leverage their "holdout power" to block progress. . . . Holdout behavior seems to be common when new technologies with a potential to benefit the public enormously, such as digital libraries, intrude upon the properties or monopolies of vested interests.

*Id.*

<sup>107</sup> See *id.*

programming.<sup>108</sup> Once the cable operators received statutory permission to operate their networks, ratings went up and the content providers reaped the economic rewards from the system they initially wanted to block.<sup>109</sup> Carefully constructed contractual agreements to reproduce contributions to collective works may provide the most efficient method to reach an accord between publishers and contributors.<sup>110</sup> However, Congressional intervention may become necessary if the copyrights conflicts present a significant enough issue.<sup>111</sup>

*C. Finding Common Ground with Compulsory Licenses to Reproduce Contributions to Collective Works*

When publishers' and content owners' reproduction rights come into conflict, Congress has, at times, established compulsory licensing as a mechanism for intervention.<sup>112</sup> The 1909 Copyright Act established the compulsory mechanical licensing system for phonorecords as a way to encourage the proliferation of music and to prevent monopoly control of music by the copyright owners of the musical works.<sup>113</sup> This compulsory licensing system remains in existence today.<sup>114</sup> Detailed rules exist for a maker of a phonorecord to obtain a compulsory mechanical license, if a party wishes to obtain this license directly through the United States Copyright Office.<sup>115</sup> The Harry Fox Agency has emerged as a mechanical licensing clearinghouse for many U.S. music publishers to provide an efficient method to obtain this license.<sup>116</sup> Rather than obtain a compulsory licenses, a licensee can also negotiate directly with a copyright owner licensor for a mechanical license.<sup>117</sup> This compulsory licensing system has, for the most part, proven to be an effective method to balance the rights of copyright owners of musical works and those who desire to reproduce these works in new recordings.<sup>118</sup>

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<sup>108</sup> *Id.* at 788.

<sup>109</sup> *Id.*

<sup>110</sup> See Ng, *supra* note 104, at 413–14 (detailing the ability of authors to control the dissemination of their works through the property rights vested in the works, as well as the ability for authors to negotiate uses of these works with other parties).

<sup>111</sup> See 17 U.S.C. §§ 111(c)(1), 115, 118(b)–(c), 119(a)–(c) (2006) (mandating compulsory licensing for mechanical licenses for phonorecords, secondary transmissions, and works in connection with noncommercial broadcasting); See also Ng, *supra* note 104, at 414–15 (discussing compulsory licensing as a solution when copyright law does not offer an adequate balance between content producers and publishers).

<sup>112</sup> 17 U.S.C. §§ 111(c)(1), 115, 118(b)–(c), 119(a)–(c), 122(a).

<sup>113</sup> Copyright Act of 1909, H.R. 28192, 60th Cong. ch. 320, 35 Stat. 1075, 1075–76 (1909).

<sup>114</sup> 17 U.S.C. § 115.

<sup>115</sup> 37 C.F.R. § 201.18 (2009).

<sup>116</sup> Lydia Pallas Loren, *Untangling the Web of Music Copyrights*, 53 CASE W. RES. L. REV. 673, 682 (2003) (explaining the role of the Harry Fox Agency).

<sup>117</sup> 17 U.S.C. § 115(c)(3)(B); *EMI Entm't World, Inc. v. Karen Records, Inc.*, 603 F. Supp. 2d 759, 763 (S.D.N.Y. 2009).

<sup>118</sup> *Contra* Loren, *supra* note 116, at 709–11 (proposing to eliminate the compulsory mechanical license). The U.S. Copyright Office has proposed reforms to the phonorecord compulsory mechanical licensing system to rectify inefficiencies and confusion in the code due to digital music streaming and downloading. See *generally* Compulsory License for Making and Distributing Phonorecords, Including Digital Phonorecord Deliveries, 73 Fed. Reg. 137, 40802 (proposed July 16, 2008) (to be

Congress also adopted compulsory licenses for content distribution such as secondary transmission by cable systems,<sup>119</sup> for the use of certain works in noncommercial broadcasting,<sup>120</sup> and secondary transmissions of superstations and network stations for private home viewing.<sup>121</sup> Other areas of copyright law, however, have not embraced compulsory licenses.<sup>122</sup>

Compulsory licensing could prevent costly copyright infringement litigation.<sup>123</sup> In addition, even when a court finds a publisher liable for copyright infringement for exceeding its section 201(c) privileges in a collective work, determining the plaintiff's damages can become a prolonged and contentious process.<sup>124</sup> The *Tasini* plaintiffs, for example, have yet to receive satisfaction on their judgment, more than eight years after the Supreme Court's decision.<sup>125</sup>

The Copyright Act's statutory damages provision<sup>126</sup> can also lead to remedies for a plaintiff in excess of potential licensing revenue.<sup>127</sup> On remand from *Greenberg I*, a jury awarded Greenberg \$400,000 in damages for the use of photos from four issues of *National Geographic* on the *CNG*.<sup>128</sup> If a court awarded this amount to multiple plaintiffs, given the number of photos that appear in *National Geographic*, the liability assessed to the publisher would have proven almost incalculable. Such a judgment would almost certainly have created a financial abyss for the National

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codified at 37 C.F.R. pts. 201, 255) (addressing how streaming audio falls within the section 115 license).

<sup>119</sup> 17 U.S.C. § 111(c)(1).

<sup>120</sup> *Id.* § 118(b)–(c).

<sup>121</sup> *Id.* § 119(a)–(c).

<sup>122</sup> See Thomas F. Cotter, *Fair Use and Copyright Overenforcement*, 93 IOWA L. REV. 1271, 1279 (2008).

For the most part, intellectual property law in general and copyright in particular shun the use of compulsory licenses out of concerns that courts or other governmental actors lack the information necessary to determine the proper amount of the fee, and these actors may undervalue [the owner's] entitlement and undermine the incentive scheme. Additionally, compulsory licensing itself may discourage the private sector from developing superior transaction-cost-reducing institutions.

*Id.*

<sup>123</sup> See, e.g., Beam, *supra* note 3.

<sup>124</sup> See *In re Literary Works in Elec. Databases Copyright Litig.*, 509 F.3d 116, 128 (2d Cir. 2007), *cert. granted sub nom.* Reed Elsevier, Inc. v. Irvin Muchnick, 129 S.Ct. 1523 (U.S. Mar. 2, 2009) (No. 08-103) (finding that the district court in the damages stage of the *Tasini* case did not have subject matter jurisdiction to certify the class and approve the settlement agreement). The Court limited the petition to the question, "Does 17 U.S.C. § 411(a) restrict the subject matter jurisdiction of the federal courts over copyright infringement actions?" *Reed Elsevier*, 129 S.Ct. at 1523.

<sup>125</sup> See *N.Y. Times v. Tasini*, 533 U.S. 483, 506 (2001) (holding that publishers infringed upon authors' copyrights); *In re Literary Works*, 509 F.3d at 128.

<sup>126</sup> 107 U.S.C. § 504(c).

<sup>127</sup> See *Greenberg v. Nat'l Geographic Soc'y*, 488 F.3d 1331, 1334 (11th Cir. 2007) (detailing the statutory damages from *National Geographic* that a district court awarded to Jerry Greenberg); see Lemley, *supra* note 70, at 197.

<sup>128</sup> *Greenberg*, 488 F.3d at 1334.

Geographic Society.<sup>129</sup> The potential for such “supracompensatory” damages<sup>130</sup> could scare publishers away from attempting to compile products such as the *CNG*, eliminating important products from the marketplace.<sup>131</sup> Also, such a high dollar figure may not reflect the value of the actual contribution by the freelancer if it was not connected with the publication.<sup>132</sup> The reproduction value of a story or photograph is directly influenced by the prestige, circulation, and influence of the publication in which it first appears.<sup>133</sup> For example, the same photo would have a greater value if it originally appeared in *National Geographic* as compared to if it originally appeared in a newsletter for a small scuba diving club.<sup>134</sup> Beyond payment for rights to first publication, freelance contributors have an economic incentive to have their work associated with high-profile, respected publications.<sup>135</sup> These larger publications have the ability to expand the reach of freelance contributors’ reputations, and generally have more resources to reproduce collective works in new media.<sup>136</sup> They also have the deep pockets that make them targets for copyright infringement lawsuits.<sup>137</sup>

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<sup>129</sup> See Beam, *supra* note 3 (quoting National Geographic Society Executive Vice President Terry Adamson) (“[The National Geographic Society has spent] millions of dollars . . . We’ve lost the opportunity of having this product in homes all over the world. I think that’s a huge loss.”).

<sup>130</sup> See Lemley, *supra* note 70, at 199.

<sup>131</sup> See *id.* at 192 (“[S]ociety will be best served by a rule that allows compensation for the copyright owner but denies them control over the defendant’s work.”). This article discusses the pending Orphan Works Act as a potential means to limit publishers’ liability when the author of a work cannot be located. *Id.* at 202. The Orphan Works Act of 2008 would limit a publisher’s copyright infringement liability if it uses someone’s work after it could not find the creator of the work following a diligent search. Orphan Works Act of 2008, H.R. 5889, 110th Cong. § 2 (2d Sess. 2008). The Copyright Office has been pushing this bill as an important measure to give peace of mind to publishers and producers. See letter from Marybeth Peters, Register of Copyrights, The Importance of Orphan Works Legislation (Sept. 25, 2008) (on file with author), available at <http://www.copyright.gov/orphan>.

The legislation . . . would ease the orphan problem by reducing, but not eliminating, the exposure of good faith users. But there are clear conditions designed to protect copyright owners. A user must take all reasonable steps, employ all reasonable technology, and execute the applicable search practices to be submitted to the Copyright Office by authors, associations, and other experts. The user must meet other hurdles, including attaching an orphan symbol to the use, to increase transparency and the possibility that an owner may emerge. If an owner does emerge, the user must pay “reasonable compensation” or face full liability.

*Id.*

<sup>132</sup> See Naomi Jane Gray, *Analyzing the Publisher’s Section 201(c) Privilege in the Wake of New York Times v. Tasini*, 53 CASE W. RES. L. REV. 647, 652 (2003) (discussing how the value of a work increases depending upon the publication in which it appears).

<sup>133</sup> See *id.*

<sup>134</sup> See *id.*

<sup>135</sup> *Id.* at 651.

<sup>136</sup> See *id.*

<sup>137</sup> See Lemley, *supra* note 70, at 197–98 (discussing the potential \$300 billion statutory liability for Google surrounding the lawsuits involving Google Book Search prior to the proposed settlement agreement that Google reached with authors).

The following section discusses potential revisions to section 201(c), as well as a possible compulsory license for reproducing contributions to collective works.<sup>138</sup> These proposals have the intended goal of reducing copyright litigation by providing a balance between magazine publishers and freelance contributors.<sup>139</sup>

### III. PROPOSAL

The final bell has not rung in the fight over magazine publishers' section 201(c) rights in the digital age. The close seven-to-five en banc vote in *Greenberg III* shows that little judicial consensus exists, at least in the United States Court of Appeals for the Eleventh Circuit, in regard to publishers' section 201(c) rights.<sup>140</sup> Publishers of such magazines as *National Geographic*, *Rolling Stone*, *The New Yorker*, and others who create commercially available digital archive products, as well as publishers of digital magazines and other digital media, do have clearer standards upon which they can produce revisions of their collective works.<sup>141</sup> However, litigation over section 201(c) rights will most likely continue.<sup>142</sup> In a free market system, to curb this litigation publishers and their attorneys should have the foresight to draft contributors' contracts that take into account reproduction rights in emerging and undeveloped technologies.<sup>143</sup> Well-negotiated contracts that include licensing provisions for digital archive reproductions can alleviate many of the legal barriers to digital reproductions of collective works.<sup>144</sup> During contract negotiations, however, the publisher or the contributors cannot have unequal bargaining power.<sup>145</sup> Negotiations to license contributions to collective works for digital reproductions can result in a contract with licensing rates less than the proposed compulsory licensing rates discussed below.<sup>146</sup> Negotiations can also result in a contract with licensing rates that match or supersede this comment's proposed compulsory licensing rates,

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<sup>138</sup> See *infra* Section III.

<sup>139</sup> *Id.*

<sup>140</sup> *Greenberg v. Nat'l Geographic Soc'y*, 533 F.3d 1244, 1258 (11th Cir. 2008). In addition, the en banc panel's decision includes two lengthy dissents, one by Justice Birch, *id.* at 1258, and one by Justice Anderson, *id.* at 1281.

<sup>141</sup> See *Greenberg*, 533 F.3d at 1257–58; Siprut, *supra* note 69, at 532.

<sup>142</sup> See *Greenberg*, 533 F.3d at 1258 n.21; see also DRATLER, *supra* note 98, at [3] (discussing section 201(c) issues that the Supreme Court did not address in *Tasini*, and that subsequent courts have not addressed).

<sup>143</sup> See J. Michael Huget & Sarah K. Fisher, *Put It In Writing: The Extent of Rights Acquired on a Copyrightable Work should be Agreed upon Ahead of Time*, MICH. BAR J., Nov. 2001, at 50, 51 (“[I]t is imperative for any person or company hiring an independent contractor to create a copyrightable work to agree in writing, before the work is begun, on the extent of the rights to be acquired from the independent contractor.”).

<sup>144</sup> See ROBERT P. MERGES, COMPULSORY LICENSING V. THE THREE “GOLDEN OLDIES”: PROPERTY RIGHTS, CONTRACTS, AND MARKETS, POLICY ANALYSIS NO. 508 1 (CATO Institute 2004), available at <http://www.cato.org/pubs/pas/pa508.pdf> (arguing that the right to contract should supersede attempts to create compulsory licensing mechanisms in the digital era).

<sup>145</sup> See DRATLER, *supra* note 98, at [3] (discussing the power of freelancers to negotiate as a collective body).

<sup>146</sup> See MERGES, *supra* note 144, at 7 (discussing contractual negotiations for intellectual property rights).

depending upon the relationship between the publisher and contributor.<sup>147</sup> But if parties are unable to reach a contractual agreement, a Congressionally mandated compulsory license, if properly drafted, can provide an efficient and fair mechanism to prevent copyright conflicts between publishers and contributors for reproductions of collective works.<sup>148</sup> Before enacting a compulsory license for reproducing collective works, however, Congress should update section 201(c) to reflect the digital era.

*A. Congress Should Clarify the Statutory Definition of Publishers' Section 201(c) Rights*

The Copyright Act of 1976 defines a “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.”<sup>149</sup> Today’s collective works, however, embody myriad new forms in digital media.<sup>150</sup> The Copyright Act makes no mention of microfilm, microfiche, DVDs, CD-ROMs, digital web-based reproductions, digital magazines, e-readers, or other new digital media. In addition, section 101 does not give a definition of “revision,”<sup>151</sup> and section 201(c) does not give any detail about what constitutes a revision of a collective work.<sup>152</sup> Congress should provide some clarity and amend section 101 of the Copyright Act to include a definition of revision.<sup>153</sup> In addition, Congress should amend section 201(c) to expand the scope of privileged revisions of a collective work. This should include express language indicating that collective works produced on microfilm, microfiche, DVD, CD-ROM, digital magazines, e-readers such as Kindle, and future comparable media do not create new collective works.<sup>154</sup> Section 201(c) should make a digital version of a collective work privileged as long as the revision preserves the original context of the collective work.<sup>155</sup> The digital version can alter the original collective work to take advantage of the features that the new digital media offers, such as embedded video, expanded photo libraries, audio interviews, interactive pages, and extended interviews.

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<sup>147</sup> *See id.*

<sup>148</sup> *See* 17 U.S.C. §§ 111(c)(1), 115, 118(b)–(c), 119(a)–(c), 122(a) (2006); *see also* DRATLER, *supra* note 98, at [3] (discussing the circumstances under which Congress draft compulsory licenses).

<sup>149</sup> 17 U.S.C. § 101.

<sup>150</sup> *See, e.g.*, Copeland, *supra* note 81 (describing how e-readers such as the Kindle offer new publishing platforms).

<sup>151</sup> 17 U.S.C. § 101.

<sup>152</sup> *Id.* § 201(c).

<sup>153</sup> *See* N.Y. Times v. Tasini, 533 U.S. 483, 500 (2001). Congress could use the language that the Court used—quoting *Webster's Third New International Dictionary*—to define a revision as a template for its new definition: “‘Revision’ denotes a new ‘version,’ and a version is, in this setting, a ‘distinct form of something regarded by its creator or others as one work.’” *Id.*

<sup>154</sup> *See id.* at 501 (indicating that microfilm and microfiche are privileged revisions of collective works).

<sup>155</sup> *See* Greenberg v. Nat’l Geographic Soc’y, 533 F.3d 1244, 1258 (11th Cir. 2008); *see also* Lateef Mtima, Tasini and its Progeny: *The New Exclusive Right or Fair Use on the Electronic Publishing Frontier?*, 14 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 369, 424 (2004) (discussing that exact replicas of archives works should constitute a privileged revision). *Contra* Greenberg, 533 F.3d. at 1266 (Birch, J., dissenting) (arguing that a product such as the CNG does not represent a privileged revision of a collective work).

Additional functionality in a digital revision of a collective work became a major point of contention on the *Greenberg III* panel.<sup>156</sup> The panel argued whether the underlying computer program that operated and provided the *CNG* functionality such as zoom and print made the *CNG* a new collective work.<sup>157</sup> Congress should use the *Greenberg III* holding as a guide to revise section 201(c) so that an underlying computer program that provides the platform for a digital collective work does not eliminate the privilege to reproduce that work.<sup>158</sup> As discussed above, the computer program should not, however, alter the original context of the collective work.<sup>159</sup> The standard should be that a reasonable reader would believe they are reading the original collective work when viewing the new version on a computer or other digital device.<sup>160</sup>

Finally, in amending section 201(c), Congress should define “revision” to reflect advances in technology.<sup>161</sup> It should amend the statute to allow publishers to insert audio, video, additional text, and other multimedia content into a digital collective work revision without destroying section 201(c) revision rights. The additional materials must complement already existing stories, photos, or advertisements in the original collective work.<sup>162</sup> This can have a particularly large impact on the digital magazine industry, which lures readers from print magazines with the promise of a more interactive, feature-rich reading experience.<sup>163</sup> In order to fall within the proposed section 201(c) privilege, the additional multimedia content would have to be embedded within a collective work so that it preserves the context of the original collective work.<sup>164</sup> Using this analysis, a story or photo from a collective work cannot be detached from the original collective work so that it exists only as a supplement to multimedia content on a DVD or CD-ROM.<sup>165</sup>

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<sup>156</sup> *Greenberg*, 533 F.3d at 1256.

<sup>157</sup> *Id.* (“[T]he computer program’s elements, such as the search function or zoom capacity, do not take the *CNG* outside the § 201(c) privilege.”). *Contra id.* at 1284 (Anderson, Circuit Judge, dissenting) (“[T]he *CNG*’s advanced search function, compression/decompression program, and its digital format are relevant to deciding whether the *CNG* constitutes an unprivileged new collective work.”).

<sup>158</sup> See Patry, *supra* note 66.

What is most thrilling about the opinion is its giving meaning to *Tasini*’s media neutral interpretation of Section 201(c), by authorizing the use of an underl[y]ing computer program to search and index articles, as well as zoom and print functions, all of which had analogs in microfiche. Particularly noteworthy . . . is the majority’s rejection of ways users might hack into the [*CNG*s] contextual presentation to extract [an] individual article.

*Id.*

<sup>159</sup> *Greenberg*, 533 F.3d at 1258 (discussing the “faithfully preserve” test).

<sup>160</sup> See, e.g., THE COMPLETE NATIONAL GEOGRAPHIC: 112 YEARS OF NATIONAL GEOGRAPHIC MAGAZINE (National Geographic Society CD-ROM, rel. 2, Oct. 2001).

<sup>161</sup> See *N.Y. Times v. Tasini*, 533 U.S. 483, 500 (2001).

<sup>162</sup> See *Greenberg*, 533 F.3d at 1258.

<sup>163</sup> See, e.g., Thomas S. Mulligan, *Serving Up Spin Online*, L.A. TIMES, Feb. 7, 2008, at C1 (describing the interactive features, such as active-link advertisements and embedded video, of the digital version of *Spin* magazine).

<sup>164</sup> See *Greenberg*, 533 F.3d at 1258.

<sup>165</sup> See *id.*

Using the January 1962 issue of *National Geographic* as an example, if Jerry Greenberg's story and photos on Florida's coral reef appeared as supplementary material on a National Geographic DVD about diving, this would not constitute a privileged reproduction.<sup>166</sup> If, however, the complete original collective work is reproduced on the *CNG* or in another digital version of *National Geographic*, the original story can feature an embedded video, an audio commentary, or additional text and retain its section 201(c) privilege.<sup>167</sup>

Some could argue that Congress should not interfere in a realm where publishers and their freelance contributors could negotiate their contracts to reflect new media.<sup>168</sup> Freelance contributors can either individually or collectively negotiate uses of their works in new media.<sup>169</sup> The right to contract is sacrosanct in United States business,<sup>170</sup> with Congressional intervention a last-resort option.<sup>171</sup>

The time has come, however, for this option. By updating section 201(c) to reflect technological advances in digital media, Congress could reduce the potential for copyright infringement litigation between publishers and contributors, and open the door to new waves of digital publications.<sup>172</sup> Additionally, amending section 201(c) in concert with enacting a compulsory license for reproducing contributions to collective works could further promote publishers exploiting their archives.<sup>173</sup> As a result, this could give consumers a broader range of digital publications.<sup>174</sup>

#### *B. Congress Should Enact a Compulsory License for Reproducing Contributions to a Collective Work*

Compulsory licensing is another reform that could rectify inefficiencies and confusion in the publishing industry regarding publishers' collective work reproduction rights.<sup>175</sup> Publishers complying with the *Greenberg III* test to "faithfully preserve the original context" to create an archive product or digital version of its collective works are forced to create products that do not fully exploit available technologies.<sup>176</sup> In addition, if a court finds that a collective work is not a

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<sup>166</sup> *See id.*

<sup>167</sup> *See id.*

<sup>168</sup> *See* MERGES, *supra* note 144, at 6–10.

<sup>169</sup> *See* DRATLER, *supra* note 98, at [3].

<sup>170</sup> *See* MERGES, *supra* note 144, at 1.

<sup>171</sup> DRATLER, *supra* note 98.

<sup>172</sup> *See Greenberg*, 533 F.3d at 1244.

<sup>173</sup> *See* discussion *infra* Part III.B.

<sup>174</sup> *See, e.g.*, Press Release, National Geographic, The Complete National Geographic (July 29, 2009) (on file with author) (showing that National Geographic, which pulled the *CNG* from the market in 2001, has plans to reintroduce the product by selling a 120th anniversary edition of the CD-ROM in the fall of 2009).

<sup>175</sup> DRATLER, *supra* note 98.

<sup>176</sup> *See* Jessica Mintz, *New Yorker on DVD is Readers' Delight, Surfer's Frustration*, WALL ST. J., Nov. 10, 2005, at B1 (bemoaning that the DVD has a cumbersome feel because of the limited search capabilities embedded into it in an effort to comply with the restrictions that section 201(c) puts on a publisher's collective work revision privilege).

privileged reproduction, the potential copyright liability could prove substantial,<sup>177</sup> and have a potentially catastrophic effect on the publisher's business.<sup>178</sup>

Before *Tasini*, a scholar discussed the economic considerations that a court should consider to protect parties in situations when a revision of a collective work contains content that infringes upon the freelance contributors' copyrights.<sup>179</sup> The article proposed "a court-administered scheme of monetary recovery for existing infringements—a kind of retrospective compulsory license."<sup>180</sup>

In turn, a prospective compulsory licensing system, similar to what exists in the Copyright Act for phonorecords<sup>181</sup> and network television station transmissions,<sup>182</sup> could allow previously published content to be used in the marketplace<sup>183</sup> while providing freelance contributors an efficient, reliable, and fair method to be compensated for the republication of their work.<sup>184</sup> Similar to the section 119 statutory license for secondary television transmissions, the system, which would augment section 201(c), could be administered by the Register of Copyrights.<sup>185</sup> In addition, a publishers' rights clearinghouse such as the Harry Fox Agency could emerge for contributors to collective works to receive their compulsory license royalties.<sup>186</sup> The Copyright Royalty Judges would establish a reasonable royalty rate<sup>187</sup> for contributions to collective works based upon the space in the original collective work that the contribution comprised.<sup>188</sup>

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<sup>177</sup> See Colby B. Springer, *Ownership of Electronic Publishing Rights in Collective Works: New York Times Co. v. Tasini*, 18 SANTA CLARA COMPUTER & HIGH TECH. L.J. 341, 341 (2002) ("[*Tasini*] represents a potentially colossal financial windfall for freelance authors, while throwing a time consuming and costly wrench into the gears of the multi-million dollar business that is on-line periodical storage and retrieval.").

<sup>178</sup> See Beam, *supra* note 3.

<sup>179</sup> Wendy J. Gordon, *Fine-Tuning Tasini: Privileges of Electronic Distribution and Reproduction*, 66 BROOK. L. REV. 473, 493–94 (2000).

<sup>180</sup> *Id.* at 498.

<sup>181</sup> 107 U.S.C. § 115 (2006).

<sup>182</sup> *Id.* § 119(a)–(c).

<sup>183</sup> See LAWRENCE LESSIG, *THE FUTURE OF IDEAS* 259 (Random House 2001).

Once a work is published, if a holder of a copyright does not continue to make it available commercially, then others should have the right to exploit the work. Technically, we could accomplish this balance by giving anyone a right, after a brief period of exclusive control, to license the work under compulsory terms. The terms of such licenses can't be set here. Which would work best depends upon lots of things we can't know in the abstract. But the basic idea is that once a limited monopoly right has been granted, there is no further reason to allow a rights holder to hold up the content. This, like the need to renew, would assure that work was quickly pushed into the public domain.

*Id.*

<sup>184</sup> *Contra* MERGES, *supra* note 144, at 11 ("A competitive market, combined with the existence of property rights such as those prevailing today, will foster a wide spectrum of market strategies regarding how much to protect intellectual creations.").

<sup>185</sup> See 17 U.S.C. § 119(a)–(c).

<sup>186</sup> See Loren, *supra* note 116, at 682.

<sup>187</sup> See 17 U.S.C. § 803 (delineating the role of the Copyright Royalty Judges); see also *Recording Indus. Ass'n of Am. v. Copyright Royalty Tribunal*, 662 F.2d 1, 8 (D.C. Cir. 1981)

For example, the Copyright Royalty Judges would set a compulsory license royalty rate for photos that comprise one-quarter of a page, half-page, three-quarter page, and full page of the original collective work.<sup>189</sup> Images that appear on the cover of a magazine would receive an enhanced royalty rate. Likewise, the royalty rate for articles would be based upon the length of the articles in the original collective work.<sup>190</sup> The royalty would be a fee for each “print run” of the new media.<sup>191</sup> This is in contrast to the perpetual phonorecord compulsory mechanical license, which is based upon the number of phonorecords distributed.<sup>192</sup> Rather, to streamline the compulsory license, the royalty fee would be based on the scheduled print run or circulation of the new media in which the contribution to the original collective work will appear. For example, a royalty would be greater if a DVD has a print run of 25,000 units as compared to a DVD with a print run of 10,000 units.

Using this system, a contributor could not ask the publisher for a circulation audit, in contrast to the option available for compulsory mechanical licenses of musical works.<sup>193</sup> Instead, the Copyright Royalty Judges would have jurisdiction to intervene with a publisher’s royalty payments in the event of clear proof of a publisher’s abuse of this system.<sup>194</sup> This system would serve as a compromise between publishers and contributors.<sup>195</sup> It allows a publisher to get new products into the marketplace without being overburdened and hindered by gathering the numerous rights from its contributors for which it may not have originally contracted, or having to fear “supracompensatory” infringement liability.<sup>196</sup> It also provides freelance contributors a standardized royalty rate for their work.<sup>197</sup>

Admittedly, compulsory licenses, while reducing copyright licensing transaction costs, have been criticized as running contrary to the free-market system upon which the United States economy runs.<sup>198</sup> This standardized pricing, especially if the pricing is too low, can reduce the incentive to create, which is a cornerstone of copyright law.<sup>199</sup> In addition, establishing a pricing regimen in a compulsory licensing system can appear to be a random act of valuation, given the difficulty in

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(explaining that the Copyright Royalty Tribunal, which then set the section 115 compulsory license royalty rates, must not yield an unfairly large return for the copyright holders).

<sup>188</sup> See 17 U.S.C. § 115(c)(2) (setting the compulsory mechanical license royalty rates for musical works in phonorecords).

<sup>189</sup> *Id.*

<sup>190</sup> *Id.*

<sup>191</sup> *Contra id.* (royalty for the work in each phonorecord).

<sup>192</sup> *Id.*

<sup>193</sup> *Id.* § 115(c)(6).

<sup>194</sup> See *id.* § 803(b)(2).

<sup>195</sup> See LESSIG, *supra* note 183, at 259.

<sup>196</sup> See Lemley, *supra* note 70, at 198 (“We need a legal rule for these cases that actually provides copyright owners with compensation for their losses and nothing more . . . since massively overcompensatory damages remedies can have the same practical effect as an injunction.”).

<sup>197</sup> See LESSIG, *supra* note 183, at 109–10. (“These ‘compromises’ give the copyright holder a guarantee of compensation without giving the copyright holder perfect control over the use of its copyrighted material.”).

<sup>198</sup> See Robert P. Merges, *Contracting into Liability Rules: Intellectual Property Rights and Collective Rights Organizations*, 84 CAL. L. REV. 1293, 1299 (1996) (arguing that compulsory licenses create false pricing in the market).

<sup>199</sup> See *id.* at 1306.

placing value in intellectual property.<sup>200</sup> Compulsory licensing critics do admit, however, that the system does reduce intellectual property licensing transaction costs.<sup>201</sup> This efficiency is precisely the reason why I propose a compulsory licensing system for reproductions of collective works.<sup>202</sup>

The proposals in this section suggest that Congressional intervention may help alleviate copyright ownership tensions between publishers and contributors in regard to reproductions of collective works. These ideas do not circumvent the right to contract. Rather, first I propose that Congress amend section 201(c) to expressly encompass new technologies.<sup>203</sup> Second, I propose that Congress establish a compulsory licensing system to republish contributions to a collective work.<sup>204</sup> Collectively, these potential solutions are intended to establish fair and efficient means for publishers and freelance contributors to work together to create innovative new digital products.<sup>205</sup>

#### CONCLUSION

As demonstrated by his contributions to *National Geographic* magazine, Jerry Greenberg is a phenomenal underwater photographer.<sup>206</sup> His persistent pursuit of the rights to his photographs in his litigation against National Geographic Society shows that he has strong convictions about the limitations of National Geographic Society's section 201(c) rights to reproduce his images.<sup>207</sup> National Geographic Society's section 201(c) rights to reproduce revisions of its collective works in a new medium outweighed Greenberg's right to control such uses of his photographs.<sup>208</sup> *Greenberg III* may have provided some clarity to publishers' section 201(c) rights.<sup>209</sup> However, it did not provide a broad enough scope of rights for publishers to exploit their archives and new products most effectively in the digital era.<sup>210</sup> Congressional intervention is necessary to amend the Copyright Act to redefine section 201(c) to expressly include new digital media revisions as privileged.<sup>211</sup> In addition, Congress should create a compulsory licensing system that gives publishers a statutory rate at which it can republish contributions to a collective work.<sup>212</sup> These proposals would offer consumers greater access to information through the digital products they expect.<sup>213</sup> These suggestions would also provide new revenue streams to the

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<sup>200</sup> *See id.*

<sup>201</sup> *See, e.g., id.* at 1298–99.

<sup>202</sup> *See id.*

<sup>203</sup> *See* discussion *supra* Part III.A.

<sup>204</sup> *See* discussion *supra* Part III.B.

<sup>205</sup> *See* LESSIG, *supra* note 183, at 259.

<sup>206</sup> *See, e.g.,* Greenberg, *supra* note 32.

<sup>207</sup> *See* Greenberg v. Nat'l Geographic Soc'y, 533 F.3d 1244 (11th Cir. 2008).

<sup>208</sup> *See id.* at 1258.

<sup>209</sup> *See id.*; *see also* Patry, *supra* note 66 (discussing how the court specified publishers' section 201(c) rights).

<sup>210</sup> *See* Greenberg, 533 F.3d at 1258 n.21.

<sup>211</sup> *See* discussion *supra* Part III.A.

<sup>212</sup> *See* discussion *supra* Part III.B.

<sup>213</sup> *See* Mintz, *supra* note 176.

publishing industry.<sup>214</sup> In the tough economic times that this industry currently faces, these recommendations would prove advantageous to publishers, contributors, and consumers.<sup>215</sup>

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<sup>214</sup> See LESSIG, *supra* note 183, at 126 (discussing that new products create new markets, which therefore establish new sources of income).

<sup>215</sup> See *id.*