

**UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF GEORGIA,
ATLANTA DIVISION**

CAMBRIDGE UNIVERSITY PRESS,
OXFORD UNIVERSITY PRESS, INC.,
and SAGE PUBLICATIONS, INC.,

Plaintiffs,

- vs. -

MARK P. BECKER, in his official
capacity as Georgia State University
President, et. al.

Defendants.

Civil Action No. 1:08-CV-1425-ODE

**PLAINTIFFS' MOTION *IN LIMINE* TO OVERRULE OBJECTIONS
TO EVIDENCE OF ALLEGED INFRINGEMENTS**

Plaintiffs Cambridge University Press, Oxford University Press, Inc., and SAGE Publications, Inc. (collectively, "Plaintiffs") submit this memorandum in support of their motion to overrule several legally defective objections Defendants have interposed to the evidence of alleged infringements on the parties' March 15, 2011 Joint Filing, Docket No. 266 (the "Joint Filing"). Specifically, Plaintiffs move to overrule: (1) the objection that an exclusive license to publish a work does not confer standing to bring a copyright infringement claim; (2) the objection that

copyright registration is a prerequisite to a suit for infringement of works first published outside the United States; and (3) the objection that Plaintiffs should have produced “deposit copies” of each allegedly infringed work. As explained below, each of these objections is wrong as a matter of law.

ARGUMENT

I. AN EXCLUSIVE LICENSEE HAS STANDING TO SUE FOR INFRINGEMENT

Defendants object to a number of claimed infringements on the Joint Filing on the ground that the publisher-plaintiff has an exclusive license to publish the work but is not the owner of the copyright. This objection is wrong as a matter of law.

Section 501(b) of the Copyright Act provides that the “legal or beneficial owner of an exclusive right under a copyright is entitled . . . to institute an action for any infringement of that particular right committed while he or she is the owner of it.” 17 U.S.C. § 501(b). The owner of a copyright right for purposes of section 501(b) includes an exclusive licensee of the right. *See* 17 U.S.C. § 101 (defining “transfer of copyright ownership” as including an “exclusive license”); *Saregama India Ltd. v. Mosley*, No. 10-10626, 2011 WL 1103337, at *5 n.22 (11th Cir. Mar. 25, 2011). As one authoritative treatise states, “A copyright owner may transfer copyright ownership by assignment or *exclusive license*, the two being

synonymous. An exclusive license *is* copyright ownership.” 2 WILLIAM F. PATRY, PATRY ON COPYRIGHT § 5:101 (2010) (emphasis in original) (cited in *Saregama*, 2011 WL 1103337, at *5 n.22).

Section 201(d) of the Act provides that the “owner of any particular exclusive right is entitled, to the extent of that right, to all of the protection and remedies accorded to the copyright owner.” 17 U.S.C. § 201(d). Therefore, a party has standing to sue with respect to a particular work if it has been granted an exclusive license to one or more of the copyright rights in the work that allegedly were infringed. *See, e.g., Saregama*, 2011 WL 1103337, at *6 (explaining that the owner of an exclusive right can bring a copyright infringement claim based on infringement of that right).

Thus, Defendants’ objection to the standing of an exclusive licensee should be overruled.

II. REGISTRATION IS NOT A PREREQUISITE TO SUIT FOR FOREIGN WORKS

Defendants’ objections to works first published by one of the Plaintiffs in the United Kingdom on the ground that Plaintiffs failed to produce copyright registrations for these works have no merit. There is no need to obtain a U.S. copyright registration for works first published in foreign countries, including in the United Kingdom, in order to commence an infringement action.

Federal courts have jurisdiction to hear suits related to foreign works – and to award relief based on infringement of those works in the United States – even without registration. Section 104(b)(2) of Title 17 grants “protection under this title” to works “first published in . . . a foreign nation that, on the date of first publication, is a treaty party.” 17 U.S.C. § 104(b)(2). The United Kingdom, as a signatory to the Berne Convention,¹ an international agreement concerning intellectual property, is a “treaty party.” *See* 17 U.S.C. § 101 (defining treaty party as “a country . . . other than the United States that is a party to an international agreement,” including the Berne Convention); United States Copyright Office, International Copyright Relations of the United States (Circular 38A), at 10 & n.3 (identifying the United Kingdom as signatory to Berne Convention); *see also* 2 NIMMER ON COPYRIGHT § 7.16[B][1][b][ii] (explaining that “the claimant of a

¹ The Berne Convention is “the Convention for the Protection of Literary and Artistic Works, signed at Berne, Switzerland, on September 9, 1886, and all acts, protocols, and revisions thereto.” 17 U.S.C. § 101. The United States acceded to the Berne Convention effective March 1, 1989. *See* Berne Convention Implementation Act of 1988 (BCIA), March 1, 1989, Pub. L. 100-568. When the United States joined the Berne Convention, Title 17 was revised to provide that works published in countries that do not require formalities such as copyright registration will not lose copyright protection in the United States for that reason. *See* 2 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 7.16[B][1][b][ii] (2010); 4 NIMMER ON COPYRIGHT at § 17.01[C][2][b].

copyright in any [non-United States] work may file suit in a United States district court without first trying to register the work in the Copyright Office”).

Protection of foreign works under U.S. law as described above is, in some situations, limited by section 411(a) of the Copyright Act, which provides, in relevant part, that “no civil action for infringement of the copyright *in any United States work* shall be instituted until preregistration or registration of the copyright claim has been made in accordance with this title.” 17 U.S.C. § 411(a) (emphasis added). A “United States work” is defined in section 101 as a work first published “in the United States” or first published “simultaneously in the United States and another treaty party, whose law grants a term of copyright protection that is the same as or longer than the term provided in the United States.” 17 U.S.C. § 101. Simultaneous publication is defined in article 3 of the Berne Convention to include publication within two or more countries within thirty days of first publication.²

Therefore, although United Kingdom is a “treaty party,” and although its term of copyright protection is the same as that of the United States,³ the

² See BCIA, art. 3(4), available at http://www.wipo.int/export/sites/www/treaties/en/ip/berne/pdf/trtdocs_wo001.pdf (last visited Apr. 27, 2011).

³ Compare Copyright, Designs and Patent Act of 1988, Nov. 15, 1988, c. 48, ch. 1 (12) (copyright term in United Kingdom for literary works subsists to 70 years after death of creator), available at <http://www.legislation.gov.uk/ukpga/1988/48/contents> (last visited Apr. 27, 2011), with 17 U.S.C. § 102 (same).

registration requirement of section 411(a) does not apply where a work is first published in the United Kingdom and is not published within thirty days in the United States. That is precisely the case with the works at issue here, which were first published by one of the Plaintiffs in the United Kingdom *more* than thirty days prior to publication in the United States. To the extent Plaintiffs make that showing, no proof of registration is required for such works, and Defendants' objection to the contrary should be overruled.

III. PLAINTIFFS ARE NOT REQUIRED TO PROVIDE DEFENDANTS WITH DEPOSIT COPIES OF THE ALLEGEDLY INFRINGED WORKS

Defendants object to works listed on the Joint Filing on the ground that Plaintiffs did not provide them with a "deposit copy" of the work. However, because there is no such legal requirement, and, further, because the deposit copy is, by definition, deposited with the Copyright Office in connection with the copyright registration application and not retained by Plaintiffs, the objection has no merit.

Section 408 of the Copyright Act provides that the copyright owner may obtain a copyright registration by depositing two copies of the best edition of a

work, along with the application and fee specified by section 409 and 708.⁴ 17 U.S.C. § 408. The deposit copy is, by definition, a copy that has been deposited with the Copyright Office (and thus is not available to be provided to the defendant or, for that matter, to the Court).

There is no requirement, in the statute or anywhere else, that a deposit copy be provided to the defendant in an infringement action.⁵ To make out a *prima facie* case of copyright infringement, a plaintiff must show only that it “(1) owns a valid copyright in the work and (2) defendants copied protected elements from the work.” *Saregama*, 2011 WL 1103337, at *13. Plaintiffs have produced author contracts and registration materials, among other things, that establish these elements and provide full information as to the title, author, edition, publication date, etc. of the works at issue. This evidence is all that is necessary to identify the works at issue and to satisfy the first element of Plaintiffs’ claims; deposit copies would not provide any additional (much less legally required) information.⁶

⁴ The statute provides that the deposit requirement is not a condition of copyright protection. 17 U.S.C. § 407(a).

⁵ As demonstrated above, works that are not “United States works” do not need to be registered to be protected in U.S. courts; for such works there are by definition no deposit copies.

⁶ Despite having no obligation to do so, Plaintiffs provided Defendants with a copy of each work at issue in the suit that was available to them. For certain works,

In any event, the Library of Congress provides public access to deposit copies, which are therefore as available to Defendants as they are to Plaintiffs.⁷ A requirement that Plaintiffs produce deposit copies of the works would be particularly unwarranted here, moreover, given that GSU's copyright policy – on which Defendants' otherwise rely to defend their conduct – specifically requires that “[t]he instructor, library or other unit of the institution must possess a lawfully obtained copy of any material submitted for electronic reserves.” Defendants' Proposed Trial Exhibit 13 at 9, a copy of which is attached hereto as Exhibit A. In other words, a copy of the work already should be in Defendants' possession or control.

CONCLUSION

For the foregoing reasons, the Court should overrule the following objections Defendants have interposed to the evidence of alleged infringements on the Joint Filing: (1) that copyright ownership is required to confer standing to bring

however (for example, where the print edition of the book had sold out), Plaintiffs no longer had print copies in their possession and informed Defendants of this fact. These are the works to which Defendants have lodged their “deposit copy” objection.

⁷ See United States Copyright Office, Obtaining Access to and Copies of Copyright Office Records and Deposits (Circular 6), *available at* <http://www.copyright.gov/circs/circ06.pdf> (last visited Apr. 27, 2011).

a copyright infringement claim; (2) that copyright registration is required for works first published outside the United States; and (3) that Plaintiffs were required to provide Defendants with a deposit copy of each allegedly infringed work.

Respectfully submitted, this 28th day of April, 2011.

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CERTIFICATE OF SERVICE

I hereby certify that I have this day filed the foregoing **PLAINTIFFS'**
MOTION *IN LIMINE* TO OVERRULE OBJECTIONS TO EVIDENCE OF
ALLEGED INFRINGEMENTS with the Clerk of Court using the CM/ECF
filing system which will automatically send e-mail notification of such filing to the
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This 28th day of April, 2011.

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