

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

CAMBRIDGE UNIVERSITY PRESS,
et al.,

Plaintiffs,

-v-

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

Defendants.

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

**DEFENDANTS' MOTION IN LIMINE TO EXCLUDE EVIDENCE OF
ALLEGED INFRINGEMENT OF IMPROPERLY-ASSERTED
COPYRIGHTS AND MEMORANDUM OF LAW IN SUPPORT THEREOF**

Pursuant to Federal Rules of Evidence 401 and 402, Defendants move this Court to exclude all evidence regarding any acts of Defendants, Defendants' employees, independent contractors working for Defendants, and Defendants' predecessors that relate to copyrights for which Plaintiffs have not shown compliance with the mandatory preconditions for suit. In particular, Defendants move this Court to exclude:

(a) evidence related to alleged copyright infringement for which Plaintiffs have not provided admissible evidence of a valid copyright registration certificate, or otherwise satisfied the mandatory preconditions for a copyright infringement suit; and

(b) evidence related to alleged copyright infringement of works for which Plaintiffs have not provided any admissible evidence regarding their alleged ownership of the copyright in the works.

BACKGROUND

Three publishing houses have brought this action for copyright infringement against officials of the University System of Georgia and Georgia State University (“GSU”). Plaintiffs allege that Defendants are responsible for infringement of certain copyrighted works. In particular, Plaintiffs complain about certain GSU instructors’ practice of using electronic systems to reproduce and distribute excerpts from copyrighted works for educational use by GSU students.

The Court, in its November 5, 2010 Order, required the parties to provide a list of the alleged infringements and objections thereto. (11/5/2010 Order, Dkt. 240, at 3.) That list was the exhaustive set of potential works that Plaintiffs could use to try to prove “ongoing and continuous misuse of the fair use defense.”

(9/30/2010 Order, Dkt. 235 at 5, 30.) Pursuant to these Orders, the parties jointly filed a list of 99 alleged infringements that are at issue in this case. (Dkt. 266.)

As to many of the works listed in the joint filing, however, Plaintiffs have not satisfied the statutory preconditions to obtaining relief for copyright infringement. Specifically, for a number of these works, Plaintiffs have provided no evidence of a valid copyright registration—a mandatory precondition to maintain a copyright infringement action. In addition, Plaintiffs have made no showing that they have the right to assert certain of the copyrights at issue. Without a showing of ownership or an exclusive license, Plaintiffs do not have standing to assert the copyright.

Because Plaintiffs cannot demonstrate satisfaction of the mandatory preconditions of suit or ownership of the copyright for certain asserted works, evidence relating to the alleged infringement of those copyrights is irrelevant, and Defendants respectfully request that the Court exclude any such evidence.

ARGUMENT AND CITATION OF AUTHORITIES

Only relevant evidence is admissible, and evidence is only relevant if it has the tendency to make the existence of a fact more or less probable than it would be without the evidence. *See* Fed. R. Evid. 401, 402. A key issue in this case is whether Defendants infringe Plaintiffs' copyrighted works. For Plaintiffs to claim

that a copyright in a particular work has been infringed, Plaintiffs must demonstrate both proper registration (or that an exception to the registration requirement applies), and ownership of the copyright. For those alleged infringements where Plaintiffs cannot prove both proper copyright registration and ownership of the copyright, facts relating to the alleged infringement are irrelevant, and should be excluded from evidence.

I. Plaintiffs Should Not Be Allowed To Present Evidence Of The Alleged Infringement Of Copyrights For Which Statutory Formalities Have Not Been Satisfied.

The Copyright Act expressly states 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.” 17 U.S.C. § 411(a). The Eleventh Circuit used to consider copyright registration to be a jurisdictional requirement, the absence of which divested a court of the power to hear the case. *See M.G.B. Homes, Inc. v. Ameron Homes, Inc.*, 903 F.2d 1486, 1488 (11th Cir. 1990) (noting that copyright registration was a jurisdictional prerequisite for a copyright suit). In *Reed Elsevier v. Muchnick*, 130 S. Ct. 1237 (2010), however, the Supreme Court held that the registration requirement was not jurisdictional, but could be a “mandatory precondition” to an action for copyright infringement. *See id.* at 1249.

The handful of courts that have addressed the issue since the Supreme Court decided *Reed Elsevier* have determined that, indeed, registration is a mandatory precondition to a copyright claim. *See Dream Custom Homes, Inc. v. Modern Day Constr., Inc.*, No. 8:08-CV-1189-T-17AEP, 2011 U.S. Dist. LEXIS 18268, at *25 (M.D. Fla. Feb. 22, 2011) (“The Copyright Act’s registration requirement is a precondition to filing a copyright infringement claim that does not restrict a federal court’s jurisdiction with respect to infringement suits involving unregistered works.”); *Marketing Tech. Solutions, Inc. v. Medizine LLC*, No. 09 Civ. 8122 (LMM), 2010 U.S. Dist. LEXIS 50027, at *15-16 (S.D.N.Y. Apr. 23, 2010) (dismissing copyright case under Fed. R. Civ. P. 56 for failure to comply with the registration requirement of section 411(a)).

A. Plaintiffs Should Not Be Allowed To Present Infringement Evidence For Works Lacking A Registration Certificate.

Despite ample opportunity to do so, Plaintiffs have not provided a registration certificate (or contention that the work is exempt from the registration requirement of 17 U.S.C. § 411(a)) for a number of works at issue.¹ Each of these works requires registration before a cause of action can go forward, yet, on the eve

¹ Exhibit A to this Motion includes a list of works for which Plaintiffs had not provided a registration certificate (or assertion that the work was not subject to the registration requirement) as of the Parties’ March 15, 2011 joint filing. This list is not necessarily exhaustive, and Defendants reserve the right to challenge the sufficiency of the registration of all asserted copyrights at trial.

of trial, Plaintiffs have not provided evidence that a registration has issued. Accordingly, Plaintiffs have failed to satisfy a mandatory precondition of a cause of action for copyright infringement for at least these works. *See Dream Custom Homes*, 2011 U.S. Dist. LEXIS 18268, at *25. Accordingly, facts relating to the alleged infringement of the copyright in these works are irrelevant, and therefore inadmissible. *See* Fed. R. Evid. 402. For these reasons, Defendants respectfully request that the Court preclude Plaintiffs from introducing any evidence relating to the alleged infringement of works for which Plaintiffs have not provided a valid registration certificate.

B. Plaintiffs Should Not Be Allowed To Present Infringement Evidence For Certain Works Lacking A Deposit Copy.

A key component of the registration requirement is the deposit requirement—the requirement that a copyright holder deposit a copy of the copyrighted work with the Library of Congress. *See* 17 U.S.C. § 408(b). A copyright owner cannot assert a copyright without proving that it has made a proper deposit. *See St. Luke’s Cataract and Laser Inst. v. Sanderson*, 573 F.3d 1186, 1201 (11th Cir. 2009) (“[A]n owner cannot bring a cause of action for copyright infringement until the owner has complied with the copyright registration procedures . . . which include payment of fees and deposit of copies of the work.”).

Plaintiffs have failed to provide deposit copies for many, if any, of the works at issue. To the extent that Plaintiffs have not provided other evidence of compliance with the copyright registration requirements, they have failed to satisfy the mandatory preconditions for a copyright infringement suit.² See 17 U.S.C. §§ 410(c), 411(a); *Dream Custom Homes*, 2011 U.S. Dist. LEXIS 18268, at *25. Accordingly, facts relating to the alleged infringement of these works are irrelevant, and therefore inadmissible. See Fed. R. Evid. 402. For these reasons, Defendants respectfully request that the Court preclude Plaintiffs from introducing any evidence relating to the alleged infringement of those copyrights for which Plaintiffs have not provided either a deposit copy of the work or other evidence proving that a proper deposit was made.

² By way of example, Plaintiffs' March 15, 2011 list of asserted works includes five works for which the copyright registration was still pending. Those works—Fundamental Considerations In Language Testing, Assessing Listening, Language Testing in Practice, Learning Vocabulary in Another Language, and Assessing Vocabulary—were all first published at least ten (and in some cases as many as twenty) years ago. Accordingly, the registration certificates for these works, if Plaintiffs provide one, would not be *prima facie* proof of a proper deposit copy. See 17 U.S.C. § 410(c) (“In any judicial proceedings the ***certificate of a registration made before or within five years after first publication of the work*** shall constitute prima facie evidence of the validity of the copyright and of the facts stated in the certificate.” (emphasis added)).

II. Plaintiffs Should Not Be Allowed To Present Evidence Of The Alleged Infringement Of Copyrights They Do Not Own.

A plaintiff does not have standing to assert infringement of a copyright it does not own. *See Imperial Residential Design, Inc. v. Palms Dev. Group, Inc.*, 70 F.3d 96, 99 (11th Cir. 1995). Plaintiffs, however, appear to be attempting exactly that, as they have failed to provide assignments for several allegedly infringed copyrights.³

Moreover, many of the works Plaintiffs assert are collective works, of which the accused portion is a discrete essay or article included in the collective work. To assert copyright infringement of a portion of a collective work, Plaintiffs must prove that they have been assigned the rights to *both* the collective work as a whole *and* the individual accused work. *See New York Times Co. v. Tasini*, 533 U.S. 483, 496 (2001) (“[T]he owner of copyright in the collective work is presumed to have acquired *only* the privilege of reproducing the contribution as part of that particular collective work.” (emphasis in original)).

Here, Plaintiffs assert copyright infringement of portions of collective works without providing any evidence that they have an assignment to the copyright in

³ Exhibit A to this Motion contains a list of works for evidence of assignment to the Publisher is lacking. This list is not necessarily exhaustive, and Defendants reserve the right to challenge the sufficiency of the registration of all asserted copyrights at trial.

the accused portion. For example, Plaintiffs contend that a GSU professor placed an essay from the collective work “Dionysus Since ’69” on GSU’s electronic reserve system. Dionysus Since ’69 is a collective work made up of multiple essays written by different authors. The accused portion of the work is an essay written by one particular author. While Plaintiffs have provided a purported assignment to the copyright by the editors of the collective work “Dionysus Since ’69” (PE 380), they have failed to provide any evidence of ownership of the copyright in the accused essay.⁴

Where, as here, Plaintiffs have not shown ownership of (or an exclusive license to) the copyright of a work or an accused portion of a compilation, Plaintiffs do not have standing to allege that the copyright in the work or accused portion has been infringed. Accordingly, facts pertaining to the alleged infringement of such copyrights are irrelevant and inadmissible. *See Fed. R. Evid.* 402. For these reasons, Defendants respectfully request that the Court preclude Plaintiffs from introducing any evidence relating to the alleged infringement of copyrights for portions of collective works for which Plaintiffs have not provided

⁴ Dionysus Since ’69 is not the only instance where Plaintiffs have not provided evidence of assignment of the accused portion of a collective work. For example, Plaintiffs have failed to provide assignments for accused portions of the Sage Handbook of Qualitative Research (both second and third editions) and The Handbook of Feminist Research, each of which is a collective work. A comprehensive listing will be provided in Defendants’ proposed findings.

an assignment for the accused portion thereof, or for works where Plaintiffs have provided no evidence of assignment of the copyright thereto.

CONCLUSION

Plaintiffs' list of claimed copyright infringements includes a number of works for which Plaintiffs have not satisfied the mandatory preconditions to an infringement suit. Plaintiffs' list also includes a number of works for which they have not provided evidence that they have the necessary rights to assert infringement. Because Plaintiffs must make both showings to assert copyright infringement, evidence relating to infringement of those copyrights is irrelevant to this action, and is inadmissible. Accordingly, Defendants respectfully request that the Court grant this motion *in limine* expressly prohibiting the admission of such evidence.

Respectfully submitted, this 29th day of April, 2011.

SAMUEL S. OLENS
Georgia Bar No. 551540
Attorney General

R. O. LERER
Georgia Bar No. 446962
Deputy Attorney General

DENISE E. WHITING-PACK
Georgia Bar No. 558559
Senior Assistant Attorney General

MARY JO VOLKERT
Georgia Bar No. 728755
Assistant Attorney General

s/ Katrina M. Quicker

Katrina M. Quicker
Georgia Bar No. 590859
BALLARD SPAHR LLP
999 Peachtree Street, Suite 1000
Atlanta, GA 30309-3915
Telephone: (678) 420-9300
Facsimile: (678) 420-9301

Stephen M. Schaetzel
Georgia Bar No. 628653
KING & SPALDING LLP
1180 Peachtree Street, N.E.
Atlanta, GA 30309
Telephone: (404) 572-4600
Facsimile: (404) 572-5100

Anthony B. Askew
Special Assistant Attorney General
Georgia Bar No. 025300
211 Townsend Place
Atlanta, GA 30327
Telephone: (404) 262-7981

Attorneys for Defendants

CERTIFICATE OF COMPLIANCE

Pursuant to Rule 7.1D of the Local Rules of the Northern District of Georgia, counsel for Defendants certifies that the foregoing **DEFENDANTS' MOTION IN LIMINE TO EXCLUDE EVIDENCE OF ALLEGED INFRINGEMENT OF IMPROPERLY-ASSERTED COPYRIGHTS AND MEMORANDUM OF LAW IN SUPPORT THEREOF** was prepared in a font and point selection approved by this Court and authorized in Local Rule 5.1C.

/s/ Katrina M. Quicker
Katrina M. Quicker

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that on this 29th day of April, 2011, I have electronically filed the foregoing **DEFENDANTS' MOTION IN LIMINE TO EXCLUDE EVIDENCE OF ALLEGED INFRINGEMENT OF IMPROPERLY-ASSERTED COPYRIGHTS AND MEMORANDUM OF LAW IN SUPPORT THEREOF** with the Clerk of the Court using the CM/ECF system, which will automatically send e-mail notification of such filing to the following attorneys of record:

Edward B. Krugman
krugman@bmelaw.com
Georgia Bar No. 429927
Corey F. Hirokawa
hirokawa@bmelaw.com
Georgia Bar No. 357087
John H. Rains IV
rains@bmelaw.com
Georgia Bar No. 556052

BONDURANT, MIXSON &
ELMORE, LLP
1201 West Peachtree Street N.W.
Suite 3900
Atlanta, GA 30309
Telephone: (404) 881-4100
Facsimile: (404) 881-4111

R. Bruce Rich
Jonathan Bloom
Randi Singer
Todd D. Larson

WEIL, GOTSHAL & MANGES LLP
767 Fifth Avenue
New York, NY 10153
Telephone: (212) 310-8000
Facsimile: (212) 310-8007

s/ Katrina M. Quicker

Katrina M. Quicker
Georgia Bar No. 590859
BALLARD SPAHR LLP
999 Peachtree Street, Suite 1000
Atlanta, GA 30309-3915
Telephone: (678) 420-9300
Facsimile: (678) 420-9301