

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

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

Plaintiffs,

- v -

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

Defendants.

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

**PLAINTIFFS' OPPOSITION TO DEFENDANTS' MOTION *IN LIMINE* TO
EXCLUDE EVIDENCE OF ALLEGED INFRINGEMENT OF
IMPROPERLY-ASSERTED COPYRIGHTS**

Plaintiffs Cambridge University Press, Oxford University Press, Inc., and SAGE Publications, Inc. (collectively, "Plaintiffs") hereby respond to Defendants' Motion in Limine to Exclude Evidence of Alleged Infringement of Improperly-Asserted Copyrights, filed April 29, 2011 (hereinafter "Def. Mot."). Defendants' arguments that Plaintiffs have not met the registration requirement or proven ownership for every work on the parties' March 15, 2011 joint filing of

alleged infringements are either factually misleading, legally wide of the mark, or, at best, premature. They are also essentially irrelevant. Copyright plaintiffs routinely obtain injunctions that protect against unlawful takings of *all* of their works by proving that a small sample of those works – often not more than five or ten – was infringed as part of a larger, ongoing pattern and practice of infringement. *See, e.g., Pac. & S. Co. v. Duncan*, 744 F.2d 1490 (11th Cir. 1984) (issuing injunction covering all Plaintiff works based on evidence of infringement of one newscast); *Princeton Univ. Press v. Mich. Document Servs., Inc.*, 99 F.3d 1381, 1387 (6th Cir. 1996) (issuing injunction based on six enumerated copyright infringement claims from three publishers); *Basic Books, Inc. v. Kinko's Graphics Corp.*, 758 F. Supp. 1522 (S.D.N.Y. 1991) (issuing injunction based on twelve examples of infringement from six publishers). Even to the extent a handful of the nearly 100 infringements identified on the Joint Filing were found to suffer a technical deficiency, the evidence concerning the remainder of the Joint Filing works more than suffices to demonstrate Plaintiffs' entitlement to an injunction requiring reformation of the challenged copying practices at GSU.

BACKGROUND

The Court's August 11 and 12, 2010 Orders directed Plaintiffs to produce a list of claimed infringements of their works during the Maymester 2009, Summer

2009, and Fall 2009 terms along with specified information relating to each claimed infringement (the “August Submission”). Following a November 5, 2010 scheduling conference, the Court ordered additional discovery related to the August Submission and directed the parties to prepare an updated version of that list informed by the additional discovery. Docket No. 240 at 3. The updated list was jointly filed on March 15, 2011 (the “Joint Filing”). Docket No. 266.

While all works identified on Plaintiffs’ original Complaint and Amended Complaint were registered with the U.S. Copyright Office, a small number of works on the August Submission were not yet registered at the time of that Submission. Plaintiffs subsequently registered them on an expedited basis, and in February 2011, produced the copyright registration certificates to Defendants – as well as copies of the books deposited with the Copyright Office during the registration process. The copyright registration information for these works was included on the March 15 Joint Filing. When the discovery ordered by the Court revealed that other Plaintiff works beyond those identified in the August Submission had been distributed to GSU students in 2009, Plaintiffs registered those that had not previously been registered as well and produced copies of the books deposited with the Copyright Office.

Because this latter set of infringements was not revealed to Plaintiffs until the additional discovery ordered by the Court,¹ the registration certificates were not yet available as of the date of the Joint Filing, so Plaintiffs stated: “Registration request filed with Copyright Office; certificate expected by 4/8/11.”² When the registration certificates were delivered to Plaintiffs in late March, Plaintiffs produced copies to Defendants immediately. Defendants’ claim on April 29 that Plaintiffs had not produced certain registration certificates “as of the Parties’ March 15, 2011 joint filing,” Def. Mot. 5 n.1, fails to mention that most of those certificates were produced very shortly thereafter to Defendants, who have had them for more than a month. Presently, only four works on the Joint Filing (other than foreign works where registration is not required) remain unregistered.³

¹ Specifically, the works were distributed by Professor Kim during the 2009 semester via uLearn, and therefore did not appear on the ERes reports that had previously been produced by Defendants. They are identified as No. 4-10 on Exhibit A to Defendants’ motion.

² In order to expedite the registration process, which can take as long as 12-18 months under normal procedures, Plaintiffs utilized the Copyright Office’s “special handling” procedures, which are designed in part to provide for rapid registration of works involved in litigation. Even with special handling, however, the certificates were not received until late March.

³ See Plaintiffs’ Motion in Limine to Overrule Objections to Evidence of Alleged Infringements, April 28, 2011, Docket No. 273 (regarding protection of non-registered foreign works under Berne Convention). The only remaining unregistered works include *The Cambridge Companion to Schubert*, *The*

Although there is no legal requirement to do so, Plaintiffs have provided Defendants with copies of almost every work from the Joint Filing (unless the book or particular edition was out of stock), including those that were recently registered.

ARGUMENT

I. PLAINTIFFS HAVE REGISTERED AND PRODUCED CERTIFICATES OF REGISTRATION FOR SEVEN OF THE WORKS DEFENDANTS IDENTIFY AS UNREGISTERED

Defendants’ motion is carefully phrased, claiming that Plaintiffs had not produced certain registration certificates “as of the Parties’ March 15, 2011 joint filing.” Def. Mot. 5 n.1. Plaintiffs did, however, produce seven of the requested certificates in the last week of March and first week of April, so the statement that Plaintiffs have failed, “on the eve of trial,” to provide evidence that a registration has issued for the works identified in their motion, Def. Mot. at 5-6 and Ex. A, is simply wrong as to seven of those works. In addition, Plaintiffs have confirmed that an eighth work identified in Defendants’ Exhibit, *The Operas of Charles Gounod*, is a foreign work first published in the United Kingdom, and thus exempt

Cambridge Companion to Berlioz, The Fragility of Goodness, and The Cambridge Companion to Bach.

from the registration requirement. *See* Declaration of Niko Pfund in Opposition to Defendants' Motion In Limine May 9, 2011 ¶ 16.

The timing of the production of these certificates does not prejudice Defendants in any way. As an initial matter, the registration of these works was delayed only because the works were not known to Plaintiffs until they conducted the recent round of discovery ordered by the Court, including a deposition of Professor Kim on February 4, 2011, in which she confirmed she had in fact used the works at issue in her course. Plaintiffs acted expeditiously to register the works in the wake of that deposition and alerted Defendants in the Joint Filing that Plaintiffs had sought registration for the works and that the certificates were expected by early April. Indeed, there is no reason to exclude evidence relating to GSU's infringements of these works, particularly since other sections of that filing, as well as Plaintiffs' document production, provided Defendants with all the pertinent information (author, title, ownership, etc.) subsequently included in the certificates, and Defendants did not have to make any filings or conduct any depositions without them.⁴

⁴ *M.G.B. Homes, Inc. v. Ameron Homes, Inc.*, 903 F.2d 1486 (11th Cir. 1990) does not dictate a different result. As Defendants themselves acknowledge in their motion, the holding of that case was overturned in relevant respects by the Supreme Court in *Reed Elsevier, Inc. v. Muchnick*, 130 S. Ct. 1237 (2010). To the extent *M.G.B. Homes* survives, it stands for the common-sense proposition that

Nor is there reason to exclude evidence as to the infringement of the four works that remain unregistered. In *Reed Elsevier, Inc. v. Muchnick*, 130 S. Ct. 1237 (2010), the Supreme Court held that failure to register a work does *not* strip a court of jurisdiction over a copyright claim, and upheld a settlement agreement approved by the district court comprised *entirely of unregistered works*. *Id.* at 1248-49. Furthermore, injunctive relief in copyright actions routinely extends to unregistered (and even yet-to-be-created) works. *See e.g., Pac. & S. Co. v. Duncan*, 744 F.2d at 1499 n.17. Because the requested injunctive relief sought here would extend to unregistered works, evidence of infringement as to the four unregistered works is clearly relevant and should not be excluded.

where a registration for a work is granted by the Copyright Office after commencement of a suit, the proper procedural response is not to dismiss the plaintiff's claims as to that work (and require Plaintiffs to immediately re-file essentially the same case), but merely to allow the plaintiff to amend the pleadings as necessary to reflect the new registration. *See* 903 F.2d at 1489 (stating that “[i]t is too late in the day and entirely contrary to the spirit of the Federal Rules of Civil Procedure for decisions on the merits to be avoided on the basis of such mere technicalities,” and noting that the defendant was not prejudiced by the amendment). The *M.G.B. Homes* court's flexible approach is particularly apt here, where the Court has directed the parties to focus on infringements that occurred more than a year after the original complaint was filed and thus required the post-complaint registration of certain works.

II. THE REGISTRATION REQUIREMENT OF SECTION 411(a) DOES NOT REQUIRE PLAINTIFFS IN AN INFRINGEMENT ACTION TO DEMONSTRATE COMPLIANCE WITH EVERY STEP OF THE REGISTRATION PROCESS

Defendants press the argument that for certain works, Plaintiffs “have not provided either a deposit copy . . . or other evidence proving that a proper deposit was made.”⁵ Def. Mot. at 7. Defendants’ argument – which fails even to identify which works it purports to exclude on this theory – is without merit. First, while Plaintiffs are obviously unable to provide the actual deposit copies, as those copies were deposited with the Copyright Office in accordance with requirements of federal copyright law, Plaintiffs did provide Defendants with copies of the recently registered works (identical to those deposited with the Copyright Office), as well as copies of most of the other works on the Joint Filing. Moreover, because depositing a copy is a prerequisite to registration, the registration certificates produced by Plaintiffs are themselves evidence that Plaintiffs deposited copies with the Copyright Office, which otherwise would not have granted the certificates. As to works first published in the United Kingdom, U.S.

⁵ Defendants appear to argue that both registration *and* proof of compliance with the steps necessary to *obtain* registration must be demonstrated, *i.e.*, that Plaintiffs were required to provide evidence of having deposited copies with the Copyright Office even in those instances where Plaintiffs produced the actual registration certificate that the Copyright Office issued after reviewing Plaintiffs’ application for registration.

copyright registration is not required⁶ and thus no “deposit” was required either; any requirement to comply with U.S. registration formalities would undermine the protections granted to those works in the U.S. under the Berne Convention.

In any event, substantive copyright law simply does not require a plaintiff who alleges copyright infringement to prove its compliance with the formalities of the registration process, including the submission of deposit copies, before it can proceed. To establish copyright infringement, the plaintiff must show that (i) it owns a valid copyright in the allegedly infringed work(s) and (ii) the defendant copied protected elements of the work(s). *Peter Letterese & Assocs., Inc. v. World Inst. of Scientology Enters., Int’l*, 533 F.3d 1287, 1300 (11th Cir. 2008). “[O]nce [a plaintiff] produces a copyright certificate he establishes a prima facie case of validity of his copyright and the burden of production shifts to the defendant to introduce evidence of invalidity.” *Original Appalachian Artworks, Inc. v. Toy Loft, Inc.*, 684 F.2d 821, 826 (11th Cir. 1982).

Nor can such a requirement be inferred from the registration requirement of 17 U.S.C. § 411(a). That provision merely establishes that U.S. works need to *be registered*, not that Plaintiffs have an affirmative burden to prove that they

⁶ See Plaintiffs’ Motion *in Limine* to Overrule Defendants’ Objections to Evidence of Alleged Infringements, Docket No. 273, at Part II and Part III (addressing the foreign works and deposit copy issues).

satisfied each of the prerequisites necessary to obtain the registration in the first place. *St. Luke's Cataract & Laser Inst. v. Sanderson*, 573 F.3d 1186, 1201 (11th Cir. 2009), reiterates only the basic requirement that a copyright owner must have “complied” with registration procedures to assert an infringement claim; it does not conclude, as Defendants suggest, that a “copyright owner cannot assert a copyright without *proving* that it has made a proper deposit.” Def. Mot. 6 (emphasis added).⁷ Defendants have presented no case where copyright plaintiffs had to provide proof of having made a deposit as part of their infringement action.

The copyright law provides that if a work is registered within five years of its publication, the certificate is *prima facie* evidence of the validity of the copyright and the facts stated in the certificate. 17 U.S.C. § 410(c). Defendants suggest that because Plaintiffs registered certain works *outside* the five-year

⁷ Defendants’ confusion on this point appears to stem from *Dream Custom Homes, Inc. v. Modern Day Construction, Inc.*, No. 8:08-CV-1189, 2011 WL 976420 (M.D. Fla. Feb. 22, 2011), a district court case suggesting that compliance with registration procedures, including the filing fee and the deposit copy, must be “shown.” *Id.* at *9. But the district court’s source for that proposition, *Donald Frederick Evans & Assocs. v. Continental Homes, Inc.*, 785 F.2d 897, 903 (11th Cir. 1986), simply restates the Section 411(a) registration requirements and provides some explanation as to what obtaining a registration entails. *Id.* (quoting section 411(a)). Neither case required plaintiffs to prove that they deposited copies; rather, the court relied on the plaintiff’s registration certificates alone to establish the validity of its copyrights. *Dream Custom Homes*, 2011 WL 976420, at *10.

window, the registration cannot be taken as “prima facie proof of a proper deposit copy,” and that Plaintiffs must therefore provide independent evidence of having made the required deposit. Def. Mot. at 7 n.2. It is unclear what additional evidence Defendants seek – presumably, they are not suggesting that Plaintiffs must produce photographs of the copies being deposited with the Copyright Office. In any event, the Copyright Office will not issue the certificate without receiving deposit copies, so the mere fact that it issued the registration certificates – whether within five years of publication or later – proves that Plaintiffs complied with the requisite formalities.⁸

III. EVIDENCE SHOULD NOT BE EXCLUDED BASED SOLELY ON DEFENDANTS’ UNSUPPORTED ASSERTIONS REGARDING PLAINTIFF OWNERSHIP OF WORKS

Defendants’ argument that the Court should exclude evidence related to certain Plaintiff works because Plaintiffs allegedly have failed to produce evidence of ownership of chapters authored by contributors to those works, Def. Mot. at 8-9, is in certain instances factually incorrect and, in any event, premature. It is improper to preclude evidence as to certain works based merely on the assertions

⁸ Even where the work is registered more than five years after publication, the 410(c) presumption is not necessarily lost; rather, it is left to the district court’s discretion to decide whether to maintain it. 17 U.S.C. § 410(c); *see also* 3 Nimmer on Copyright at § 12.11[A][1] (2010) (“Upon receipt of some evidence for plaintiff’s ownership, courts typically extend the presumption.”).

of Defendants' counsel that certain contracts have not been produced, particularly where some of these assertions are demonstrably inaccurate. For example, Defendants are simply wrong to suggest that Plaintiffs failed to provide contributor assignments for the SAGE *Handbook of Qualitative Research* and *Handbook of Feminist Research*. Def. Mot. at 9 n.4. Those assignments can be found at Pl. Tr. Ex. 268-272 and 274-281 (assignments for 13 of the 14 chapters of the *Handbook of Qualitative Research* identified on Joint Filing) and 245-246 (assignments for 2 of the 3 chapters of the *Handbook of Feminist Research* identified on Joint Filing).⁹

Furthermore, as the accompanying declaration of Oxford's Niko Pfund makes clear, providing an agreement from a contributor is not the only way to show an assignment of rights; such ownership is evidenced through editor contracts and copyright registration certificates, and through Mr. Pfund's knowledge of the standard practices of Oxford University Press and of the circumstances surrounding particular works at issue.¹⁰ Witnesses from SAGE and

⁹ Carol Richman of SAGE will testify that the two unlocated agreements would have been identical to the fifteen work-for-hire agreements that were produced.

¹⁰ Mr. Pfund also explains that in response to Defendants' motion, Oxford was able to locate four additional agreements concerning works identified in the motion. Simultaneous with this filing, Plaintiffs are producing those documents to Defendants and filing a separate motion with the Court requesting permission to add those works to its exhibit list.

Cambridge University will likewise testify at trial as to their ownership of contributions flagged by Defendants' motion.

There are a small number of Oxford works identified on the Joint filing for which Mr. Pfund is unable definitively to confirm OUP's ownership of the excerpts.¹¹ In the interest of efficient trial presentation, Plaintiffs will not present evidence related to those works or their infringement at GSU. As earlier stated, this should be immaterial to Plaintiffs' entitlement to an injunction based on the evidence to be adduced as to the substantial number of infringements.

CONCLUSION

For the foregoing reasons, the Court should deny Defendants' Motion in all respects.

This 9th day of May, 2011.

/s/ John H. Rains IV
Edward B. Krugman
krugman@bmelaw.com
Georgia Bar No. 429927
John H. Rains IV
rains@bmelaw.com
Georgia Bar No. 556052

¹¹ The works are *Film Theory and Criticism*; *Social Theory: Roots & Branches*; *The Gendered Society Reader*; and *Television: The Critical View*.

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

R. Bruce Rich (*pro hac vice*)
Randi Singer (*pro hac vice*)
Jonathan Bloom (*pro hac vice*)
Todd D. Larson (*pro hac vice*)

WEIL, GOTSHAL & MANGES LLP
767 Fifth Avenue
New York, New York 10153

Attorneys for the Plaintiffs

CERTIFICATE OF SERVICE

I hereby certify that I have this day filed the foregoing **PLAINTIFFS’
OPPOSITION TO DEFENDANTS’ MOTION *IN LIMINE* TO EXCLUDE
EVIDENCE OF ALLEGED INFRINGEMENT OF IMPROPERLY-
ASSERTED COPYRIGHTS** with the Clerk of Court using the CM/ECF filing
system which will send e-mail notification of such filing to opposing counsel as
follows:

Stephen M. Schaezel, Esq.
Kristen A. Swift, Esq.
C. Suzanne Johnson, Esq.
Mary Katherine Bates, Esq.
KING & SPALDING
1180 Peachtree Street
Atlanta, Georgia 30309

Kristina M. Quicker, Esq.
BALLARD SPAHR, LLP
999 Peachtree Street, Suite 1000
Atlanta, Georgia 30309

Anthony B. Askew, Esq.
LAW OFFICE OF ANTHONY B. ASKEW
211 Townsend Place
Atlanta, Georgia 30327

Mary Jo Volkert, Esq.
Assistant S. Attorney General
40 Capitol Square
Atlanta, Georgia 30334

This 9th day of May, 2011.

/s/ John H. Rains IV
John H. Rains IV