

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

In accordance with this Court's May 3, 2011 Order, Defendants in the above-captioned matter hereby file this brief in opposition to "Plaintiffs' Motion *In Limine* to Overrule Objections to Evidence of Alleged Infringements" (the "Motion," Dkt. 273.)

On March 15, 2011, the parties submitted to the Court a joint filing detailing the alleged copyright infringements occurring during the Maymester 2009,

Summer 2009, and Fall 2009 terms that remain at issue in this case. (*See* Dkt. 266.) In the joint filing, Defendants objected to Plaintiffs' infringement allegations on several grounds, including that Plaintiffs have failed to demonstrate copyright ownership for several of the accused works, or have failed to provide copyright registrations or deposit copies for several of the accused works.

I. UNTIL PLAINTIFFS HAVE ESTABLISHED OWNERSHIP IN THE COPYRIGHTS FOR WHICH THERE ARE ALLEGED INFRINGEMENTS, THEY SHOULD BE PRECLUDED FROM PRESENTING ANY EVIDENCE OF SUCH ALLEGED INFRINGEMENTS.

Plaintiffs' Motion misconstrues Defendants' objections to Plaintiffs' claims of ownership in the copyrights of the accused works. Defendants do not contend that an exclusive license cannot confer standing to sue for copyright infringement, as Plaintiffs seem to allege. (*See* Dkt. 273 at 2-3.) Rather (without admitting the plaintiffs' proofs as to any work), Defendants dispute that Plaintiffs can demonstrate ownership of the copyright for certain works based on the documents they have produced in this case. As a result, Defendants have moved to preclude Plaintiffs from presenting any evidence regarding the alleged infringement of copyrights they do not appear, from the evidence they have produced, to own. (*See* Defs.' Mot. In Limine to Exclude Evidence of Alleged Infringement of

Improperly-Asserted Copyrights and Mem. of Law in Support Thereof (Dkt. 277) at 8-10.)

It is well-settled that, to bring a claim for copyright infringement, a plaintiff must own a valid copyright. *See* 3 Melville B. Nimmer & David Nimmer, *Nimmer on Copyright* § 12.02[B] (Matthew Bender, Rev. Ed.) (“[O]nly parties with ownership rights in a copyright have standing to bring claims for its infringement.”). Plaintiffs have failed to produce evidence to establish that Plaintiffs (or any one Plaintiff) owns the right to enforce each of the copyrights that are the subject of the alleged infringements (whether by assignment or by the transfer of all substantial rights through an exclusive license).

For example, in response to Defendants’ document requests and interrogatories relating to Plaintiffs ownership and/or licensing of the subject works, Plaintiffs did not present a comprehensive assignment or license for the 2001 edition of *The Fragility of Goodness: Luck and Ethics in Greek Tragedy and Philosophy*, which instructor Vincent Lloyd is alleged to have infringed through use in a Fall 2009 course (*See* Allegation of Use, Resp. to Ct.’s Or. (Dkt. 228) Ex. C-6.) Although on November 5, 2010, this Court ordered Plaintiffs to supplement their responses to Defendants’ requests and interrogatories for the subject works (Dkt. 240 at 2), Plaintiffs produced only a license for the 1986 version of the work,

which appears to be copyrighted in the name of Plaintiff Cambridge (Exhibit A). The 2001 version at issue in this case is copyrighted in the name of the author. (Exhibit A at 2.)

Similarly, for *A History of Feminist Literary Criticism*, which is the subject of an alleged infringement by Dr. Janet Gabler-Hover in a course in Fall 2009, Plaintiffs produced an agreement between the publisher and the editors of the collective work (Pls.' Ex. 105, Pls.' Ex. List, Dkt. 278-6 at 6), but did not produce the individual article author's assignment or licensure (*id.* (providing agreement with another author)). Because of shortcomings such as these in the purported rights of Plaintiffs to the exclusive right to the copyright in accused works, the Court's ruling on defendants' objections is rightly reserved for trial, upon the parties' showings of evidence.

Because it appears from documents produced by Plaintiffs that no Plaintiff has sufficient rights in the copyright for certain of the works that are the subject of Plaintiffs' allegations of infringement to maintain a claim for copyright infringement, Defendants respectfully submit that Plaintiffs should not be permitted to present any evidence of alleged infringement of the copyrights for these works. (*See* Defs.' Mot. In Limine (Dkt. No. 277) at 8-10.) Until the parties have made their showings on the issue of ownership at trial, it is premature to rule

on Defendants' objections with regard to Plaintiffs' ownership. Accordingly, Plaintiffs' motion should be denied.

II. PLAINTIFFS HAVE NOT DEMONSTRATED THAT SUBJECT WORKS FIRST PUBLISHED IN THE UNITED KINGDOM QUALIFY AS FOREIGN WORKS.

Plaintiffs assert that no copyright registration is required for 24 of their infringement allegations because the relevant works are "foreign works" under 17 U.S.C. § 104(b)(2), and not "United States work(s)" as defined in 17 U.S.C. §§ 101, 411(a). (*See* Dkt. 273 at 3-6.) Accordingly, Plaintiffs request that the Court overrule Defendants' objection related to Plaintiffs' failure to provide a registration for these works. (*Id.* at 6.)

Contrary to Plaintiffs' assertion, Defendants' objection is proper for at least two reasons. First, Plaintiffs have not yet demonstrated that the subject works are "foreign works" under the statute. Plaintiffs acknowledge that, if a work is a "United States work" rather than a "foreign work," preregistration or registration of the copyright must be made in accordance with the Copyright Act. (*See id.* at 4-5.) A work is a "United States work" if it was first published in the United States or if it was first published in a Berne Convention signatory country and within 30 days thereafter was then published in the United States. *See* 17 U.S.C. § 101.

Plaintiffs have not yet demonstrated that United States publication occurred more than 30 days after publication in the United Kingdom. Thus, Plaintiffs have not yet established, as is their burden, that the works at issue are “foreign works” exempt from the registration requirement, yet enforceable under the law. *See* 2 Melville B. Nimmer & David Nimmer, Nimmer on Copyright § 7.16[B][1][b] n.83.1 (stating that a plaintiff bears the burden to prove his work is of foreign, Berne-signatory-nation origin).

Second, in the absence of copyright registration, Plaintiffs must demonstrate the copyrightability of the works at issue, which they have not done. For foreign works, plaintiffs do not enjoy the presumptions that exist in the case of a valid U.S. registration, including the *prima facie* presumption of copyright validity.

2 Melville B. Nimmer & David Nimmer, Nimmer on Copyright § 7.16[B][1][c]; *see Latin Am. Music Co. v. Archdiocese of San Juan of the Roman Catholic & Apostolic Church*, 194 F. Supp. 2d 30, 39 (D.P.R. 2001) (noting “[t]he benefits of avoiding United States Registration are slight compared to the costs associated with not registering--notably giving up attorney’s fees, statutory damages and the *prima facie* presumption of copyright validity”). A plaintiff seeking to enforce the copyrights of a foreign work thus must provide proof that the work is copyrightable. *See Ward v. Nat’l Geographic Soc.*, 208 F. Supp. 2d 429, 445

(S.D.N.Y. 2002); *see also Clarus Transphase Scientific, Inc. v. Q-Ray, Inc.* No. 06 C 4634, 2006 WL 4013750, at *20 (N.D. Ill. Oct. 6, 2006) (explaining that without a certificate of copyright registration “there is no presumption in [plaintiff’s] favor, the district court makes an independent determination regarding [plaintiff’s] ownership of a valid copyright; a *de novo* determination as to whether plaintiff’s work is copyrightable That means [plaintiff] must provide proof on this issue”); *Morelli v. Tiffany and Co.*, No. Civ. A. 00-1961, 2001 WL 179898, at *1 (E.D. Pa. Jan. 10, 2001) (“The fact that plaintiff does not have a copyright registration . . . dictates that the burden of proof is on him in this infringement action to establish the copyrightability of his [work].”). Plaintiffs here have not yet made such a showing.

Because of the factual showing Plaintiffs must make before the Court can rule on these objections, Defendants respectfully submit that Plaintiffs’ request that these objections be overruled is premature, and that the Court should reserve ruling on these objections until trial.

III. BY FAILING TO PROVIDE DEPOSIT COPIES FOR CERTAIN WORKS, PLAINTIFFS HAVE FAILED TO ESTABLISH COMPLIANCE WITH THE COPYRIGHT REGISTRATION REQUIREMENTS, A PREREQUISITE TO ASSERTING A CAUSE OF ACTION FOR COPYRIGHT INFRINGEMENT.

To bring a copyright infringement suit, a plaintiff must have complied with the copyright registration requirements. *See* 17 U.S.C. §§ 410(c), 411(a). Where, for example, Plaintiffs are not entitled to a presumption that a proper deposit copy was submitted to the Copyright Office, they must produce such a copy for consideration by this Court. As explained in “Defendants’ Motion *In Limine* to Exclude Evidence of Alleged Infringement of Improperly-Asserted Copyrights and Memorandum of Law in Support Thereof” (Dkt. 277), there are at least five works among Plaintiffs’ infringement assertions for which the copyright registration was still pending as of the parties’ March 15, 2011 joint filing. (*See* Dkt. 277 at 7 & n.2.) In cases such as these, where Plaintiffs do not enjoy the presumption of validity, Plaintiffs will need to demonstrate compliance with the copyright registration requirements, including provision of a proper deposit copy for the work at issue.¹

¹ Defendants do not intend to assert their objections regarding Plaintiffs’ failure to provide deposit copies to Defendants during discovery at trial. Defendants note, however, that it may be necessary for Plaintiffs to introduce the deposit copies to establish their *prima facie* cases for infringement.

Because any ruling on this objection first requires the presentation of evidence to this Court, Defendants respectfully submit that ruling on Defendants' objections is best reserved for trial.

Respectfully submitted, this 9th day of May, 2011.

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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' BRIEF IN OPPOSITION TO PLAINTIFFS' MOTION *IN LIMINE* TO OVERRULE OBJECTIONS TO EVIDENCE OF ALLEGED INFRINGEMENTS** was prepared in a font and point selection approved by this Court and authorized in Local Rule 5.1C.

/s/ Mary Katherine Bates

Mary Katherine Bates

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that on this 9th day of May, 2011, I have electronically filed the foregoing **DEFENDANTS' BRIEF IN OPPOSITION TO PLAINTIFFS' MOTION *IN LIMINE* TO OVERRULE OBJECTIONS TO EVIDENCE OF ALLEGED INFRINGEMENTS** 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:

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