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

REPLY IN SUPPORT OF DEFENDANTS' MOTION IN LIMINE TO EXCLUDE EVIDENCE OF ALLEGED INFRINGEMENT OF IMPROPERLY-ASSERTED COPYRIGHTS

Pursuant to Local Rule 7.1(C) and the Court's May 5, 2011 Order (Dkt. No. 282) directing the parties to file replies, if any, by May 11, 2011, Defendants Mark P. Becker, et al., hereby file this reply in support of their Motion *In Limine* To Exclude Evidence Of Alleged Infringement Of Improperly-Asserted Copyrights (Dkt. No. 277) ("Motion"). In the Motion, Defendants asked the Court to exclude evidence of alleged infringement relating to copyrights for which Plaintiffs have not shown compliance with the mandatory preconditions for suit.

Plaintiffs' Opposition To Defendants' Motion *In Limine* To Exclude Evidence Of Alleged Infringement Of Improperly-Asserted Copyrights (Dkt. No. 288) ("Opposition") tacitly admits the core of Defendants' motion. Plaintiffs do not contend that evidence relating to copyrights that are not assigned to them is relevant or admissible. Plaintiffs also do not provide any authority suggesting that evidence of unregistered works is relevant or admissible.

Instead Plaintiffs argue—without citing any authority—that this Court should overlook the absolute requirement that Plaintiffs have a signed writing evidencing an assignment or exclusive license from the author before they can bring suit. Plaintiffs also suggest that this Court should admit evidence of alleged infringement of works that Plaintiffs admit are not registered, and therefore cannot be asserted in a copyright infringement action. Plaintiffs' arguments miss the mark, and consequently, Defendants respectfully request that the Court grant the Motion.

ARGUMENT AND CITATION OF AUTHORITIES

I. Evidence Relating To The Alleged Infringement Of Works For Which Plaintiffs Cannot Prove Ownership Should Be Excluded.

It is black-letter law that a party does not have standing to maintain suit for the infringement of a copyright that it does not own or have an exclusive license for. *See Imperial Residential Design, Inc. v. Palms Dev. Group, Inc.*, 70 F.3d 96,

99 (11th Cir. 1995). The Copyright Act requires that an assignment be evidenced by a signed writing. 17 U.S.C. § 204(a) ("A transfer of copyright ownership, other than by operation of law, is not valid unless an instrument of conveyance, or a note or memorandum of the transfer, is in writing and signed by the owner of the rights conveyed or such owner's duly authorized agent."). This requirement of a signed writing applies to ***both*** assignments and exclusive licenses. *Imperial Residential Design v. Palms Dev. Group*, 29 F.3d 581, 583 (11th Cir. 1994). Plaintiffs do not dispute this black letter principle.

Instead, Plaintiffs accuse Defendants of making assertions that are "demonstrably inaccurate," while simultaneously admitting the truth of Defendants' contentions—that Plaintiffs do not have assignments for all of the asserted contributions of the collective works Defendants' have identified.[1] (Opp. at 12.) In addition to contradicting their own *ad hominem* attack on Defendants, Plaintiffs' Opposition is replete with several admissions of assignments they cannot prove.

[1] As Defendants noted on opening, the works identified therein were merely examples of works for which Plaintiffs had not provided evidence of ownership. (Mot. at 8 n.3, 9 n.4.) Defendants contend that until Plaintiffs have made a threshold showing of a proper assignment for any given work, evidence relating to the alleged infringement of such work is irrelevant and inadmissible. (Mot. at 9-10.)

Specifically, Plaintiffs admit that they do not have agreements for several additional works. (Opp. at 12 n.9.) Plaintiffs further admit that they have not produced or identified several other assignments for works at issue. (Opp. at 12 n.10; Pfund Decl. ¶¶ 5, 7, 8, 9.) Finally, Oxford admits that some of the works at issue are assigned not to Oxford, but to Oxford's affiliate in the United Kingdom.[2] (Pfund Decl. ¶¶ 10, 11, 12, 13, 14, 15.) Mr. Pfund's declaration asserts that "OUP has the exclusive right to distribute OUP UK works in the United States." (Pfund Decl. ¶ 11.) Of course, Mr. Pfund's bare assertion of the "exclusive right" Oxford has purportedly obtained is irrelevant in view of the fact that the plaintiff ***here*** (Oxford) has not provided admissible evidence of a written instrument transferring those exclusive rights to it. *Imperial Residential Design*, 29 F.3d at 583.

In an effort to sidestep their lack of evidence, Plaintiffs advance the curious argument that industry practice and oral testimony obviates the requirement of a written assignment. (Opp. at 12-13.) Plaintiffs provide no legal support for this

[2] Although Defendants' contend that several works from each Plaintiff are lacking proper assignment, Plaintiffs' opposition only includes a declaration for Oxford. Plaintiffs provide nothing more than bare assertions about the testimony anticipated to be offered on behalf of the other plaintiffs, SAGE and Cambridge. Notably, however, even Plaintiffs' bare arguments do not include a contention that the testimony from SAGE and Cambridge will involve the introduction of signed, written assignments or exclusive licenses (which would be objectionable, as they have not been produced).

position.[3] Indeed, the law is clear: a signed assignment (or exclusive license) ***in writing*** is required for Plaintiffs to have standing to assert copyrights. 17 U.S.C. § 204(a); *Imperial Residential Design v. Palms Dev. Group*, 29 F.3d 581, 583 (11th Cir. 1994). For this reason, Plaintiffs' arguments and Mr. Pfund's declaration are largely irrelevant to the issue—that Plaintiffs are alleging infringement of copyrights they cannot prove that they own. Consequently, Defendants respectfully request that the Court grant the motion with respect to such works.

II. This Court Should Exclude Evidence Of The Alleged Infringement Of Copyrights For Which Statutory Formalities Have Not Been Satisfied.

The Copyright Act is clear—registration is required to maintain a suit for copyright infringement. 17 U.S.C. § 411(a). The case law on point is similarly clear—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); *Marketing Tech. Solutions, Inc. v. Medizine LLC*, No. 09 Civ. 8122 (LMM), 2010 U.S. Dist. LEXIS

[3] In fact, the best evidence rule requires that Plaintiffs produce the agreement (or a duplicate) to prove its contents. Fed. R. Evid. 1002, 1003. Plaintiffs do not contend that these missing agreements are "lost," and even assuming Plaintiffs make such a contention, their loss would be their own fault, and the exception of Fed. R. Evid. 1004(1) would not apply. *See Summerlin v. Georgia-Pacific Corp. Life, Health and Accident Plan*, 366 F. Supp. 2d 1203, 1211-1212 (M.D. Ga. 2005) (refusing to allow a party to introduce secondary evidence of the terms of a missing agreement, despite evidence that the party's administrative procedures would have necessitated the existence of such an agreement).

50027, at *15-16 (S.D.N.Y. Apr. 23, 2010). *See also Reed Elsevier v. Muchnick*, 130 S. Ct. 1237 at 1249 (2010). Plaintiffs do not dispute this point.

Plaintiffs admit that several works at issue remain unregistered.[4] (Opp. At 5.) As such, Plaintiffs necessarily admit that the statutory preconditions for these works remain unsatisfied. The only post-*Reed Elsevier* authority on point suggests that dismissal is the proper procedural step for unregistered copyrights. *Marketing Tech. Solutions*, 2010 U.S. Dist. LEXIS 50027, at *15-16. In view of the fact that this dispute, to the extent it concerns unregistered copyrights, should not proceed, evidence relating to the alleged infringement thereof is irrelevant and inadmissible. Fed. R. Evid. 402. Accordingly, Defendants respectfully request that the Court exclude such evidence.[5]

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[4] As Defendants stated on opening, the list of unregistered works is merely exemplary, and not intended to be exhaustive. (Mot. at 5 n.1.)

[5] Defendants stand on the authority set forth in their Motion in response to any other points Plaintiffs raise, especially regarding Plaintiffs' burden to prove compliance with the registration requirements a registration certificate that is *prima facie* evidence of compliance or some other means. *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."); *Dream Custom Homes*, 2011 U.S. Dist. LEXIS 18268, at *25 ("An owner's cause of action for copyright infringement is unenforceable until compliance with the formalities of registration, including the payment of fees and deposit of copies of the work, is shown.").

CONCLUSION

For the foregoing reasons, and for the reasons set forth in Defendants' opening motion, Defendants respectfully request that the Court grant their Motion.

Respectfully submitted, this 11th 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 **REPLY IN SUPPORT OF DEFENDANTS' MOTION IN LIMINE TO EXCLUDE EVIDENCE OF ALLEGED INFRINGEMENT OF IMPROPERLY-ASSERTED COPYRIGHTS** was prepared in a font and point selection approved by this Court and authorized in Local Rule 5.1C.

/s/ Stephen M. Schaetzel
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CERTIFICATE OF SERVICE

The undersigned hereby certifies that on this 11th day of May, 2011, I have electronically filed the foregoing **REPLY IN SUPPORT OF DEFENDANTS' MOTION IN LIMINE TO EXCLUDE EVIDENCE OF ALLEGED INFRINGEMENT OF IMPROPERLY-ASSERTED COPYRIGHTS** 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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