

Schedule F
Triable Issues

F-1. Wiley's Statement of Triable Issues

By The Jury

1. Did Kirtsaeng infringe the Wiley Copyrights by selling in the United States, without permission, copies of Wiley's Foreign Editions.
2. Did Kirtsaeng willfully infringe each of the Wiley Copyrights?
3. What amount of statutory damages should Wiley be awarded for Kirtsaeng's acts of copyright infringement for each of Wiley's Copyrights?

By The Court

4. Should the Court enjoin Kirtsaeng from further infringing Wiley's copyrights?
5. Should the Court award Wiley its costs, including reasonable attorneys' fees?
6. Does 17 U.S.C. § 109 apply to books printed outside of the United States with the authority of the United States copyright owner, but imported into the United States without the permission of the United States copyright owner?

F-2 Kirtsaeng's Triable Issues

1. Has the Plaintiff waived its entitlements under Section 602(a) of the Copyright Act (regarding the unauthorized importation of copyrighted works) where it had assigned them to another entity and imposed no restrictions upon that entity's distribution of the underlying books?
2. In view of its assignment does the Plaintiff have standing to sue the Defendant for infringement of the assigned copyrights?

3. Had the Plaintiff exhausted its exclusive statutory right to control the distribution of its books prior to the Defendant's U.S. sales by reason of a prior *first sale*?

4. Should the Defendant be found to have willfully infringed the Plaintiff's copyrights where he conducted research on the importation issue and his research specifically indicated that his sales would not comprise infringement?

5. Should the Plaintiff be awarded statutory damages where the underlying books did not bear copyright notices in its name?

F-3 Kirtsaeng's Statement On the Applicability of the First Sale Defense

The Defendant relies upon the following facts in advancing his *First Sale* defense.

1. The Defendant obtained foreign editions of books that were manufactured abroad in accordance with copyrights assigned by the Plaintiff to a foreign corporation.
2. The assignment provided that the books had to be equal in form and content to the Plaintiff's U.S. manufactured goods.
3. The books included copyright notices in the name of the foreign entity.
4. Before the Defendant even took possession of the books, the Plaintiff made profits from its assignment of the rights to the foreign entity.

The Defendant submits that the foregoing facts give rise to an array of issues ultimately bearing upon whether the *First Sale* defense is applicable in the instant case and necessitating the conclusion that it is.

Argument

Title 17 U.S.C. § 106(3) provides that the owner of a copyright has "the exclusive rights . . . to distribute copies or phonorecords of the copyrighted work to the public by

sale or other transfer of ownership, or by rental, lease, or lending." Yet, even prior to the codification of the so-called *First Sale* doctrine (17 U.S.C. § 109), the Supreme Court held that "once a copyright owner places a copyrighted item in the stream of commerce by selling it, he has exhausted his exclusive statutory right to control its distribution." Quality King Distributors, Inc. v. L'Anza Research Int'l, Inc., 523 U.S. 135, 152 (1998).² See also, e.g., Universal City Studios, Inc. v. Reimerdes, 111 F. Supp. 2d 294, 317 n. 137 (S.D.N.Y. 2000) ("the copyright holder, notwithstanding the exclusive distribution right conferred by Section 106(3) of the Copyright Act, is deemed by its 'first sale' of a copy of the copyrighted work to have consented to [the] subsequent sale of the copy.").³

Section 602(a) of the Copyright Act also comes into play here; it restricts the "[i]mportation into the United States, without the authority of the owner of copyright under this title, of copies or phonorecords of a work that have been acquired outside the United States." Again, Quality King qualifies the restriction, observing that the section "does not categorically prohibit the unauthorized importation of copyrighted materials." Id. (emphasis added). The Court found, "[I]ike the exclusive right to "vend" that was construed in *Bobbs-Merrill*, the exclusive right to distribute is a limited right." Id. In fact, Quality King supports the proposition that "[e]ven if the copyright holder places restrictions on the purchaser in a first sale (such as specifying the permissible uses of the article), the buyer's disregard of the restrictions on resale does not make the buyer or the

² The "first sale doctrine" was first recognized by the Supreme Court in Bobbs-Merrill Co. v. Straus, 210 U.S. 339 (1908) where, significantly, the Court "emphasized the critical distinction between statutory rights and contract rights." Novell, Inc. v. CPU Distrib., 2000 U.S. Dist. LEXIS 9975 (S.D. Tex. May 4, 2000).

³"[T]he owner of a particular copy . . . lawfully made under this title . . . is entitled, without the authority of the copyright owner, to sell or otherwise dispose of the possession of that copy." 17 U.S.C. § 109(a).

person who buys in the secondary market liable for infringement.” Am. Ass'n for the Advancement of Sci. v. Periodicals Publicacoes Tecnicas, 2008 U.S. Dist. LEXIS 108104 (S.D. Fla. Sept. 8, 2008).

In the wake of Quality King and the enactment of 17 U.S.C. § 109, cases involving the importation of copyrighted goods into the U.S. (where domestic sales of the imported goods threatens to impede the copyright owner's own U.S. sales) have mediated the competing economic interests of publishers and consumers. The focus is on whether the publisher has been deprived the financial benefits on the sales of the imported goods. See, e.g., Sebastian International, Inc. v. Consumer Contacts (PTY) Ltd., 847 F.2d 1093 (3rd Cir. 1988) (“[a]lthough the domestic copyright holder undoubtedly would prefer to block such importation, the statutory language does not expressly authorize such control.”); McDonald's Corp. v. Shop at Home, Inc., 82 F. Supp. 2d 801, 815 (M.D. Tenn. 2000) (addressing the notion of the copyright holder's “just rewards”).

Indeed, the Court of Appeals for the Third Circuit has found cases such as this to be more appropriately categorized as *grey goods* cases.

Although this case turns purely on copyright law, we recognize that the underlying “gray market,” or “parallel importing,” issues really are dominant. Various economic factors -- including the manipulation of global currency standards -- encourage transactions in which goods are produced in this country, shipped and sold to foreign concerns, and then returned to the United States for resale at less than the domestic prices.

This practice has led to complaints by manufacturers seeking a fair return on their costs of promotion and servicing of warranties in this country. Equally vocal are consumer advocates asserting the desirability of access to identical goods at lower costs. Because contractual remedies have proved inadequate, see Johnson & Johnson Products v. DAL Int'l Trading Co., 798 F.2d 100 (3^d Cir. 1986), domestic manufacturers now invoke the copyright

law to advance their economic interests. This twist has created the anomalous situation in which the dispute at hand superficially targets a product's label, but in reality rages over the product itself. We think that the controversy over "gray market" goods, or "parallel importing," should be resolved directly on its merits by Congress, not by judicial extension of the Copyright Act's limited monopoly....

Sebastian International, Inc. v. Consumer Contacts (PTY) Ltd., 847 F.2d. at 1093 (3rd Cir. 1988); see also Neutrogena Corp. v. US, Civil Action No. 2:88-0566-1, 1988 U.S. Dist. LEXIS 14090; 7 U.S.P.Q.2D (BNA) 1900; Copy. L. Rep. (CCH) P26, 300 (E.D. S.C. April 4, 1988) (“[m]ore specifically, the issue before this court is whether FAST can be enjoined for allegedly violating *Title 17, United States Code Section 602*, by importing gray-market or parallel-market goods into the United States.”).

To be sure, the First Sale doctrine, "applies only to copies that are 'lawfully made under this title.'" Here, the Plaintiff insists that the defense does not defeat a Section 602 claim where the allegedly infringing copies were manufactured and sold abroad. Some cases, the Plaintiff argues, provide that "lawfully made under this title," refers to goods actually manufactured by the copyright owner in the United States.⁴

Yet, just as the Supreme Court noted that the first sale defense does not *necessarily* defeat a Section 602(a) claim where the allegedly infringing copies were manufactured and sold abroad, see Quality King, 523 U.S. at 152, the Court did not hold that the doctrine would be *necessarily* inapplicable under such circumstances. In other words, there is no bright line rule that the sale of legitimate goods manufactured abroad is

⁴ The Plaintiff has itself earlier insisted that "the fact that Wiley authorized the printing of the textbooks in a foreign country is irrelevant" to whether they were *lawfully made*, Pl. Attachment Memo. at 14.

not a *first sale*; each case warrants an assessment of the specific underlying facts and the economic reality of the underlying transactions.

According to their notices, the copyrights in the Wiley foreign editions are owned by Wiley Asia. Wiley assigned its copyrights in the Foreign Editions to Wiley Asia in exchange for fair consideration, *i.e.*, continuing payments derived from overseas sales. The Defendant submits that upon making the assignment Wiley exhausted its exclusive distribution right.

In Sebastian International, Inc. v. Consumer Contacts (PTY) Ltd., 847 F.2d. at 1093 (3rd Cir. 1988), the court “conclude[d] that, having sold its goods with copyrighted labels to foreign distributors, the manufacturer is barred by the first sale doctrine from establishing infringement through an unauthorized importation.” See also, generally, Quality King Distributors, Inc. v. L'Anza Research Int'l, Inc., 523 U.S. 135, 152 (1998).

Though the assignment from Wiley to Wiley Asia did not involve the physical transfer of books, this case resembles Sebastian International, Inc., in that Wiley sold the entitlements to Wiley books with copyrighted labels to a foreign distributor. See 847 F.2d. at 1093.⁵ In this regard, the instant case differs from the facts underlying the holdings of the Plaintiff's authorities –upon which it relies for its overly simplistic argument (*i.e., if manufactured abroad, you lose*)—in that they do not expressly address a transfer of rights in exchange for financial consideration preceding the importation. In other words, the facts of this case are not susceptible to the Plaintiff's *bright line*

⁵ “Yet it would seem exceedingly odd that copyright protection should turn on which party has furnished the physical stuff to which the copyrighted conception is affixed...” Platt & Munk Co. v. Republic Graphics, Inc., 315 F.2d 847, 854 (2d Cir. 1963)

assessment; here the Plaintiff received compensation prior to the later (arguably unauthorized) distribution in the US.).⁶

Thus, whereas the Plaintiff's cases address the commercial interests of a U.S. copyright holder (and purport to protect its entitlement to receive a profit on the sales of its own domestic manufactured goods), by reason of its assignment agreement with Wiley Asia, the Plaintiff profited on its assignment (among other ways *via* the sales of all of the foreign editions purchased by the Defendant for resale in the U.S.). The distinction is critical. See, e.g., McDonald's Corp. v. Shop at Home, Inc., 82 F. Supp. 2d 801, 815 (M.D. Tenn. 2000); Sebastian International, Inc. v. Consumer Contacts (PTY) Ltd., 847 F.2d 1093 (3rd Cir. 1988), ("clearly the copyright owner already has received its reward through the purchase price.")⁷

The Second Circuit's earlier decision in Platt & Munk v. Republic Graphics, 315 F.2d 847 (2nd Cir. 1963) is instructive. There, Judge Friendly observed:

The foregoing makes it clear that the 'first sale' which terminates the exclusive right to vend patented or copyrighted objects need not be a truly voluntary one, but can consist of some reasonable and recognized form of

⁶ At all times, the Defendant offered books with online notices that his were foreign volumes with certain (non-qualitative) distinctions from their US counterparts (such as soft versus hard covers and the absence of supplements). In this regard, US consumers are not necessarily purchasing foreign volumes *in place of* the U.S. volumes (thereby arguably displacing sales) but are purchasing foreign, independently copyrighted volumes that are available from any number of other distributors who offer foreign Wiley editions within the U.S.

⁷ "There is, however, an economic reason for the rule as well. As the district court said in *Burke & Van Heusen*, "the ultimate question under the 'first sale' doctrine is whether or not there has been such a disposition of the copyrighted article that it may fairly be said that the copyright proprietor has received his reward for its use." 233 F. Supp. at 884. *See Platt & Munk Co. v. Republic Graphics, Inc.*, 315 F.2d 847, 854 (2d Cir. 1963). *See also Cosmair, Inc. v. Dynamite Enters., Corp.*, No. 85-0651, slip op. (S.D. Fla. Apr. 9, 1985) (1985 WL 2209)." Id.

compulsory transfer, such as a judicial sale or court-compelled assignment. In such cases the ultimate question embodied in the 'first sale' doctrine -- 'whether or not there has been such a disposition of the article that it may fairly be said that the patentee (or copyright proprietor) has received his reward for the use of the article.' *United States v. Masonite Corp.*, 316 U.S. 265 at 278, 62 S.Ct. 1070, at 1077, 86 L.Ed. 1461 -- is answered in the affirmative, since the proprietor or patentee has received from his creditor some value for which the copyrighted or patented article is now demanded unless the debt is paid. If rationalization is needed, this can be in terms of involuntary 'sale,' of a presumed 'consent' by the proprietor or patentee to the rights and remedies that are normally applicable to material objects in the course of trade, or of his being 'estopped' to deny that he has authorized transfer of the goods, see *Henry Bill Pub. Co. v. Smythe*, *supra*, 27 F. at 918. Thus, just as we have rejected defendants' absolutist contention that anyone in lawful possession of copyrighted goods may sell them without infringement, we likewise reject plaintiff's extreme position that copyrighted goods are immune from the normal remedies of unpaid creditors until the proprietor has had one truly voluntary 'sale. '

Platt & Munk, 315 F.2d at 854 (emphasis added).

It is also significant that in making its assignment to Wiley Asia, the Plaintiff appears not even to have imposed a geographical restriction on the distribution of the books.⁹ Having already given unbridled distribution rights to its assignee, Wiley cannot be said to have retained its claim to exclusivity under section 602.

Wiley invokes dicta in Quality King where the Court hypothesized that “[i]f the author of the work gave the exclusive U.S. distribution rights -- enforceable under the Act

⁹ After being ordered by the Court to produce any and all license agreements for the foreign editions, the Plaintiff produced only one document, an agreement dated March, 2007 and represented that it has “found” no other agreements. See Email dated May 18, 2009 from William Donnegan to Sam Israel.

-- to the publisher of the U.S. edition and the exclusive British distribution rights to the publisher of the British edition... presumably only those made by the publisher of the U.S. edition would be ‘lawfully made under this title.’” Quality King Distribs. v. L'anza Research Int'l, 523 U.S. at 148. This case, however, falls outside the hypothetical. This case does not involve two distinct arrangements undertaken by a copyright owner—one of which has no nexus with U.S. commerce. This case much more closely approximates Sebastian International where the ultimate source of the books was one and the same. Here the author did not give rights to two different publishers; the author gave rights to Wiley which controlled and profited from all sales of the books.

The fallacy of the Plaintiff’s bright line rule becomes apparent upon consideration of an alternative hypothetical. If Wiley determined that it would be more economically sound to manufacture its “American” volumes overseas, then ship them into the US for domestic sales, would the First Sale defense be unavailable to U.S. purchasers of the books? The books technically would be manufactured abroad; hence—according to the Plaintiff—they would not have been *legally made in the U.S.* and a purchaser would not be shielded from liability by the First Sale defense. Obviously, this cannot be the result Congress intended, but it is a necessary consequence were the Plaintiff’s argument embraced by this Court.

The Plaintiff will try to rebut this point by arguing that the distinction is whether the sale of the foreign made item was “legal” or “authorized.” Putting aside the infringement issue itself, the sales the Defendant made were certainly *legal*. If the sales somehow occasioned a violation of the Plaintiff’s contract with Wiley Asia (regarding distribution-- a contractual grievance between the Plaintiff and a non-party) this did not

render the Defendant's sales *unlawful*. Nor is it of consequence that the importations were or were not *authorized*. In Sebastian International, Inc. v. Consumer Contacts (PTY) Ltd., 847 F.2d. at 1093 (3rd Cir. 1988), the court "conclude[d] that, having sold its goods with copyrighted labels to foreign distributors, the manufacturer is barred by the first sale doctrine from establishing infringement through an unauthorized importation." Again, Judge Friendly spoke for the Circuit in ruling in Platt & Munk v. Republic Graphics, 315 F.2d 847 (2nd Cir. 1963 "that the 'first sale' which terminates the exclusive right to vend patented or copyrighted objects need not be a truly voluntary one." In other words, neither the fact that the goods were manufactured overseas, nor the ostensible unauthorized nature of the importation renders the sales infringements or the First Sale doctrine inapplicable. Surely the rule cannot be that an infringement arises by the occurrence of both: 1) an unauthorized sale; 2) of something manufactured overseas.

Where is this "rule" found in the legislative history of any of the applicable sections of the Act and what policy is being served by such a construct other than the restraint of trade? There is no sound reason to accept this strained and self-serving interpretation of the case law.

Finally, whereas some of the import cases raise ersatz *dilution* policy in the context of their copyright analyses (*i.e.*, allowing low caliber foreign manufactured goods to be sold in the U.S. in competition with their U.S. counterparts might tarnish attendant good will) the foreign goods here are of the same quality as the U.S. versions—as per the assignment agreement. See generally Neutrogena Corp. v. US, Civil Action No. 2:88-0566-1, 1988 U.S. Dist. LEXIS 14090; 7 U.S.P.Q.2D (BNA) 1900; Copy. L. Rep. (CCH) P26, 300 (E.D. S.C. April 4, 1988) ("Accordingly, at this juncture it cannot be

concluded that plaintiff will likely prevail on its claim that defendant has violated § 602 of the Copyright Act of 1976. Furthermore, it is unlikely that the plaintiff will be irreparably harmed by the sale of plaintiff's authentic products. By no means can it be said that the sale of plaintiff's authentic goods will affect or damage plaintiff's good will or reputation.").

The Defendant submits that, upon consideration of the foregoing authorities and the specific facts of this case, the Court should find the First Sale doctrine applicable to the case at bar and available to the Defendant as a defense to the Plaintiff's infringement claims.

F-4. Wiley's Statement About the First Sale Doctrine

A. Kirtsaeng's Reliance Upon The "First Sale Doctrine" Is Misplaced Because The "First Sale Doctrine" Does Not Apply To Goods Manufactured Abroad.

Courts have consistently held that the "first sale doctrine," codified at 17 U.S.C. § 109, does not apply to copies of works manufactured abroad. Pearson Education, Inc. v. Liao, 2008 U.S. Dist. LEXIS 39222, *11 (S.D.N.Y. May 13, 2008)("Indeed, because a first sale defense only applies to the sale of copies that are 'lawfully made under this title,' 17 U.S.C. § 109(a), the resale in the United States of copies manufactured outside the United States is not protected under the terms of the statute."); Pearson Education, Inc. et al. v. Allen Air Conditioning Co. et al., 08-cv-6152 (RJH) (S.D.N.Y. Sept. 25, 2009)("Because the foreign editions were manufactured abroad, defendants did not acquire ownership of copies 'lawfully made under this title.'")(citation omitted); Omega S.A. v. Costco Wholesale Corp., 541 F.3d 982, 990 (9th Cir. 2008)("[O]ur general rule that § 109(a) refers 'only to copies legally made . . . in

the United States,' is not clearly irreconcilable with Quality King, and, therefore, remains binding precedent.”)(internal citation omitted); Microsoft Corp. v. Big Boy Distrib. LLC, 2008 U.S. Dist. LEXIS 97965 at *15 (S.D. Fla. December 1, 2008)(“[S]ection 109(a) provides a defense to copyright claims only where the claims involve domestically made copies of U.S. copyrighted works. Put another way, the ‘first sale’ doctrine is no bar to a copyright claim where the copyrighted software is manufactured and first sold abroad.”)(internal citation omitted); See Quality King Distribs. v. L'anza Research Int'l, 523 U.S. 135, 148, 118 S. Ct. 1125, 1132 (1998)(“If the author of the work gave the exclusive U.S. distribution rights -- enforceable under the Act -- to the publisher of the U.S. edition and the exclusive British distribution rights to the publisher of the British edition, however, presumably only those made by the publisher of the U.S. edition would be ‘lawfully made under this title’ within the meaning of § 109(a). The first sale doctrine would not provide the publisher of the British edition who decided to sell in the American market with a defense to an action under § 602(a) (or, for that matter, to an action under § 106(3), if there was a distribution of the copies”).

Indeed, Kirtsaeng cannot cite a single case holding that the “first sale doctrine” applies to copies manufactured abroad. Sebastian International, Inc. v. Consumer Contacts (PTY) Ltd., 847 F.2d 1093 (3d Cir. 1988), is distinguishable because the copyright owner manufactured the goods in the United States. (“The facts, seen here in the context of the first sale doctrine, are not complex. We do not confront a license agreement or copies produced in a foreign country under that agreement by someone other than the owner; instead, this case centers on actual copies of labels printed in this country by the copyright owner.”); McDonald’s Corp. v. Shop at Home, Inc., 82 F. Supp. 2d 801 (M.D. Tenn. 2000), is distinguishable because it is a

trademark case, which requires a different infringement analysis. (“McDonald’s provided the court with a one-page analysis containing five cases that mention the *Platt & Munk* just reward analysis. None of these cases is binding precedent, all of them deal with copyrights, not trademarks, and none of them is persuasive for the position that McDonald’s advances.”); Universal City Studios Inc. v. Reimerdes, 111 F. Supp. 2d 294 (S.D.N.Y. 2000), is distinguishable because it addresses a completely different type of copyright infringement, software encryption circumvention, and not the importation and sale of goods manufactured abroad; Am. Assn. For The Advancement of Science v. Periodicals Publicacoes Tecnicas, 2008 U.S. Dist. LEXIS 108104 (S.D. Fla. Sept. 8, 2008), is distinguishable because it discusses the first sale doctrine in the context of journal subscription fraud, not the importation and sale of goods manufactured abroad. (“ . . . Plaintiffs argue the first sale doctrine is inapplicable to their claim, because the Valerios obtained the journals by conversion resulting from their allegedly fraudulent representations with respect to the identity of the customers.”); Neutrogena Corp. v. U.S., 1988 U.S. Dist. LEXIS 14090 (April 4, 1988) is distinguishable because the goods at issue were manufactured in the United States. (“Under the facts of this case, especially the fact that the goods were manufactured in the United States and sold to the defendant by a third party, this court is of the opinion that the first sale defense may be applicable here . . .”).

B. Kirtsaeng’s Interpretation Of
§ 109(a) Is Incorrect Because
It Would Render § 602(a) Meaningless.

Extending the “first sale doctrine” to goods manufactured abroad would render the importation right, codified in 17 U.S.C. § 602(a), meaningless. Section 602(a) does not distinguish between authorized copies and pirated copies, but authorizes the copyright owner to prevent importation of copies of the copyrighted work. It states:

“Importation into the United States, without the authority of the owner of copyright under this title, of copies or phonorecords of a work that have been acquired outside the United States is an infringement of the exclusive right to distribute copies or phonorecords under section 106, actionable under section 501.”

Furthermore, the legislative history of § 602 demonstrates that it applies to both pirated and non-pirated goods. House Report No. 94-1476 (“Section 602, which has nothing to do with the manufacturing requirements of section 601, deals with two separate situations: importation of ‘piratical’ article (that is, copies or phonorecords made without any authorization of the copyright owner), and unauthorized importation of copies or phonorecords that were lawfully made. The general approach of section 602 is to make unauthorized importation an act of infringement in both cases. . .”).

Accordingly, if the “first sale doctrine” applies to non-pirated works manufactured abroad, § 602 becomes meaningless. Omega S.A., 541 F.3d at 986 (“[T]he application of § 109(a) after foreign sales would ‘render § 602 virtually meaningless’ as a tool against the unauthorized importation of nonpiratical copies because importation is almost always preceded by at least one lawful foreign sale that will have exhausted the distribution right on which § 602(a) is premised.” quoting BMG Music v. Perez, 952 F.2d 318, 319-20 (9th Cir. 1991); quoting CBS v. Scorpio Music Distributors, 569 F. Supp. 47, 49 (E.D. Pa. 1983), aff’d without opinion, 738 F.2d 424 (3d Cir. 1984).

C. Kirtsaeng’s Imagined Application of Wiley’s Position To Authorized Importation is Contrary to the Law

A United States copyright owner can lawfully import its own works into the United States. Section 602 applies only to importations “without the authority of the copyright owner.”

While Kirtsaeng argues that the interpretation that Wiley advances would allow Wiley to manufacture copies abroad, authorize their importation into the United States, and perpetually control their sale in the United States, this is not true. Once an authorized sale occurs in the United States of a work printed in a foreign country, the copyright owner loses the right to control subsequent sales. The Ninth Circuit has held in Omega, supra:

“Perhaps most compelling is the objection that BMG Music would provide substantially greater copyright protection to foreign-made copies of U.S.-copyrighted works. A U.S. copyright owner, for example, would be unable to exercise distribution rights after one lawful, domestic sale of a watch lawfully made in South Dakota, but, without the limits imposed by § 109(a), the same owner could seemingly exercise distribution rights after even the tenth sale in the United States of a watch lawfully made in Switzerland. The difference would likely encourage U.S. copyright owners to outsource the manufacturing of copies of their work overseas. Drug Emporium and Denbicare, however, resolved this problem by clarifying that parties can raise § 109(a) as a defense in cases involving foreign-made copies so long as a lawful domestic sale has occurred. See Drug Emporium, 38 F.3d at 481; Denbicare, 84 F.3d at 1150.” (Emphasis added.) Omega, supra, 541 F.3d at 989-90, 2008 U.S. App. LEXIS 1800 at *20.

D. Kirtsaeng’s Arguments Concerning Consent To The Importation Do Not Raise Legal Issues.

Kirtsaeng’s remaining arguments, concerning the licensing arrangements with Wiley’s Asian subsidiary, do not raise a legal issue. Whether Wiley consented to the importation and sale of the books (despite their warnings) is a factual inquiry on which Kirtsaeng may attempt to create an issue of fact for the Jury.

Schedule G
List of Witnesses

1. Wiley's Witnesses

Patrick Murphy
John Wiley & Sons, Inc.
111 River Street
Hoboken, New Jersey 07030-5774

Wiley expects to call Patrick Murphy to testify

about the business of Wiley, Wiley's copyrights, Wiley's printings of books for different parts of the world, Wiley's copyright enforcement program and Wiley's investigation of Kirtsaeng.

Supap Kirtsaeng
3637 Mentone Avenue, Apartment 3
Los Angeles, California 90034

Wiley expects to call Kirtsaeng to testify as to

all matters constituting, referring, or relating to this action, including his education, his infringing sales of Wiley's copyrighted textbooks, his business of selling books, and his state of mind concerning the legality of his sales of Wiley's books printed outside of the United States and imported without Wiley's consent.

Gervaise Mourlet
350 Fifth Avenue
New York, New York 10118

Wiley may call Gervaise Mourlet to testify on the topic of her book purchases.

2. Kirtsaeng's Objections to Wiley's Witnesses

Defendant reserves his right to object to the appearance of Gervaise Mourlet as a witness at trial.

3. Kirtsaeng's Witnesses

Defendant expects to call the following witnesses:

Patrick Murphy

Defendant expects to call Patrick Murphy to testify about the assignment of Wiley's copyrights to other companies abroad, Wiley's profits on sales of foreign editions and other aspects of Wiley's international business affairs.

Supap Kirtsaeng

Defendant expects to call Mr. Kirtsaeng, among other things, to testify concerning the efforts he had undertaken to ensure that his sales of foreign books in the United States would be lawful.

William Dunnegan

Defendant expects to call the witness regarding the limited subject of his Email dated May 18, 2009 to Sam Israel, including authentication of the email.

4. Wiley's Objections to Kirtsaeng's Witnesses

Wiley believes that each witness should take the stand only once and that objections as to the scope of cross-examination should be waived.

Defendant presses his right to call witnesses independently.

Schedule H
Exhibits

H-1. Wiley's Exhibits

<u>TX</u>	<u>DX</u>	<u>Bates</u>	<u>Date</u>	<u>Description</u>
1		1-2	7/13/87	Copyright Certificate for Accounting Principles
2		21-22	7/28/06	Copyright Certificate for Fundamentals of Heat and Mass Transfer
3		27-29	9/17/07	Copyright Certificate for Fundamentals of Physics – Part 1
4		33-34	8/20/04	Copyright Certificate for Information Technology for Management
5		39-40	8/14/06	Copyright Certificate for Introduction to Heat Transfer
6		45-46	5/17/04	Copyright Certificate for Management
7		47-48	6/19/06	Copyright Certificate for Materials Science and Engineering: An Introduction
8		55-56	4/19/89	Copyright Certificate for Organic Chemistry
9			undated	United States Edition of Accounting Principles
10			undated	Foreign Edition of Accounting Principles
11			undated	United States Edition of Fundamentals of Heat and Mass Transfer
12			undated	Foreign Edition of Fundamentals of Heat and Mass Transfer
13			undated	United States Edition of Fundamentals of Physics
14			undated	Foreign Edition of Fundamentals of Physics
15			undated	United States Edition of Information Technology for Management
16			undated	Foreign Edition of Information Technology for Management

17		undated	United States Edition of Introduction to Heat Transfer
18		undated	Foreign Edition of Introduction to Heat Transfer
19		undated	United States Edition of Management
20		undated	Foreign Edition of Management
21		undated	United States Edition of Materials Science and Engineering: An Introduction
22		undated	Foreign Edition of Materials Science and Engineering: An Introduction
23		undated	United States Edition of Organic Chemistry
24		undated	Foreign Edition of Organic Chemistry
25-32 unused			
33	B	3/13/09	Kirtsaeng's response to Wiley's Document Requests
34	G	9/8/08	eBay auction listing
35	H	9/8/08	eBay auction listing
36	I	9/8/08	eBay auction listing
37	J	9/8/08	eBay feedback
38	K	4/22/09	eBay items for sale
39	L	4/22/09	eBay auction listing
40	M	4/22/09	eBay auction listing
41	N	4/22/09	eBay feedback
42	O	4/22/09	eBay feedback
43	P	4/22/09	eBay feedback
44	Q	4/22/09	eBay feedback
45	R	4/22/09	eBay feedback

46	S		8/28/08	PayPal receipt of Mourlet
47	T		8/28/08	Gmail receipt of Mourlet
48	U		9/2/08	PayPal receipt of Mourlet
49	V		9/2/08	Package label sent from Kirtsaeng to Mourlet
50	W		undated	Foreign Edition of Management
50A	W		undated	Foreign Edition of Management 3-Page Photocopy
51	X		undated	Foreign Edition of Materials Science and Engineering 2-Page Photocopy
52	Y		undated	Foreign Edition of Introduction to Heat Transfer 2-Page Photocopy
53	Z		undated	Foreign Edition of Accounting Principles 1-Page Photocopy
54	AA		undated	Foreign Edition of Physics 1-page Photocopy
55	AB		undated	Foreign Edition of Fundamentals of Heat and Mass Transfer 1-Page Photocopy
56	AC		undated	Foreign Edition of Information Technology for Management 1-Page Photocopy
57	AH		undated	Kirtsaeng's disclosed sales
58	AI		undated	PayPal transaction log
59	AJ	PP1	4/20/09	Declaration of Melody Fry
60	AJ	PP2	4/17/09	Declaration of Melody Fry
60A		PP4	7/14/09	Declaration of Stephanie Vigil
61	AJ	PP3	4/28/09	Letter from Melody Fry
62				PayPal CD-Rom
63	AK		4/17/09	PayPal FIT Pages
64	AL		undated	Reduced PayPal Transaction Log

65	AO	E3-E9	4/20/09	Declaration of Janet M. Wagner
66	AP		undated	eBay Registration Form
67				eBay CD-Rom
68			4/27/09	e-mail from Scileppi to Israel and Fry
69		B1-B39	5/09	Bank of America Statements
70			undated	Copyright Registration and PayPal Sales Chart (Rule 1006)
71		TBD	TBD	Bank of America Statements [Not yet received]

H-2. Kirtsang's Exhibits

1. Google search results and blog on the issue of the legality of selling books published overseas in the United States.
2. Covers of Foreign Editions and copyright notice pages of Foreign Editions.
3. English Language Reprint Agreement between Wiley and Wiley India dated May 1, 2006 and bearing bates nos. 000573-585.
4. Plaintiff's pleadings, legal memoranda and discovery responses.
5. Records reflecting sales expenses, fedex, packaging and other shipment costs and electronic merchant fees.
6. Records reflecting amounts Defendant paid for the books he resold.
7. Airway Bills for shipments from Thailand to Los Angeles.
8. Email dated May 18, 2009 from William Donnegan to Sam Israel.

Schedule I
Objections to Exhibits

I-1 Kirtsaeng's Objections to Wiley's Exhibits

- Exhibit 34. Defendant's Objection to Use at trial: Hearsay and authentication.
- Exhibit 35. Defendant's Objection to Use at trial: Hearsay and authentication.
- Exhibit 36. Defendant's Objection to Use at trial: Hearsay and authentication.
- Exhibit 37. Defendant's Objection to Use at trial: Hearsay and authentication.
- Exhibit 39. Defendant's Objection to Use at trial: Hearsay and authentication.
- Exhibit 40. Defendant's Objection to Use at trial: Hearsay and authentication.
- Exhibit 41. Defendant's Objection to Use at trial: Hearsay and authentication.
- Exhibit 42. Defendant's Objection to Use at trial: Hearsay and authentication.
- Exhibit 43. Defendant's Objection to Use at trial: Hearsay and authentication.
- Exhibit 44. Defendant's Objection to Use at trial: Hearsay and authentication.
- Exhibit 45. Defendant's Objection to Use at trial: Hearsay and authentication.
- Exhibit 46. Defendant's Objection to Use at trial: Hearsay and authentication.
- Exhibit 47. Defendant's Objection to Use at trial: Hearsay and authentication.
- Exhibit 48. Defendant's Objection to Use at trial: Hearsay and authentication.
- Exhibit 58. Defendant's Objection to Use at trial: Hearsay and authentication.
- Exhibit 59. Defendant's Objection to Use at trial: Hearsay.
- Exhibit 60. Defendant's Objection to Use at trial: Hearsay.
- Exhibit 60A. Defendant's Objection to Use at trial: Hearsay.
- Exhibit 61. Defendant's Objection to Use at trial: Hearsay and authentication.
- Exhibit 62. Defendant's Objection to Use at trial: Hearsay and authentication.

Exhibit 63. Defendant's Objection to Use at trial: Hearsay and authentication.

Exhibit 64. Defendant's Objection to Use at trial: Hearsay and authentication.

Exhibit 65. Defendant's Objection to Use at trial: Hearsay.

Exhibit 67. Defendant's Objection to Use at trial: Hearsay and authentication.

I-2 Wiley's Objections to Kirtsaeng's Exhibits

Exhibit 1. Wiley objects to Kirtsaeng's Exhibit 1 under FRCP 37(c) and FRE 901.

Exhibit 5. Wiley objects to Kirtsaeng's Exhibit 5 under FRE 403.

Exhibit 6. Wiley objects to Kirtsaeng's Exhibit 6 under FRCP 37(c), on the grounds of insufficient identification.

Exhibit 7. Wiley objects to Kirtsaeng's Exhibit 7 under FRCP 37(c), on the grounds of insufficient identification.

Exhibit 8. Wiley objects to Kirtsaeng's Exhibit 8 under FRE 403.