

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

- - - - -x

JOHN WILEY & SONS, INC., :

Plaintiff, :

-against- : 08 Civ. 7834 (DCP)

SUPAP KIRTSASENG D/B/A : ECF Case

BLUECHRISTINE99 AND JOHN :

DOE NOS. 1-5, :

Defendants. :


- - - - -x

PLAINTIFF'S REQUESTS TO CHARGE

Plaintiff John Wiley & Sons, Inc. respectfully requests that the Court (i) in addition to its usual charges, charge the jury as follows, and (ii) use the following special verdict form.

Dated: New York, New York
October 7, 2009

DUNNEGAN LLC

By 
William Dunnegan (WD9316)
wd@dunnegan.com
Laura Scileppi (LS0114)
ls@dunnegan.com
Attorneys for Plaintiff
John Wiley & Sons, Inc.
350 Fifth Avenue
New York, New York 10118
(212) 332-8300

TO: Sam P. Israel, Esq.
SAM P. ISRAEL, P. C.
1 Liberty Plaza - 23rd Floor
New York, New York 10006

John Wiley and Sons, Inc. v. Supap Kirtsraeng d/b/a
Bluechristine99, John Doe Nos. 1-5

08 Civ. 7834 (DCP)

No. 1

Elements of Liability for Copyright Infringement;
Burden of Proof

"In this case, the plaintiff claims that the defendant has infringed the plaintiff's copyrights in [8 textbooks]. To find liability for copyright infringement, you, the jury, must find from a preponderance of the evidence that:

- (1) the plaintiff is the owner of a valid copyright;" and
- (2) the defendant imported or sold in the United States copies of plaintiff's copyrighted books which were printed abroad with plaintiff's permission but which were not authorized for importation or sale in the United States ("Foreign Editions").

Modern Federal Jury Instructions, Pub. 854, Inst. 86B-10, citing, Feist Publications v. Rural Tel. Serv. Co., 499 U.S. 340, 111 S. Ct. 1282 (1991); Pearson Education, Inc. v. Liao, 2008 U.S. Dist. LEXIS 39222 at *11-12 (S.D.N.Y. May 13, 2008) (Defendants "violated plaintiffs' exclusive right to "distribute copies . . . of the copyrighted work[s] to the public" in violation of 17 U.S.C. §§ 106(3) and 602(a) by purchasing copies of plaintiffs' textbooks that were manufactured abroad and subsequently selling them within the United States without the permission of the copyright holders."); 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) ("In summary, our 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. Under this rule, the first sale doctrine is unavailable as a defense to the claims under §§ 106(3) and 602(a) because there is no genuine dispute that Omega manufactured the watches bearing the Omega Globe Design in Switzerland.") (citations omitted).

John Wiley and Sons, Inc. v. Supap Kirtsaeng d/b/a
Bluechristine99, John Doe Nos. 1-5

08 Civ. 7834 (DCP)

No. 2

Effect of Registration of Copyright

"...The plaintiff's certificate of registration of the copyright constitutes evidence of the plaintiff's ownership of the copyright, and of the plaintiff's right to exclude others from copying the work. However, registration of a copyright is not conclusive as to the validity of the copyright. You may also consider any evidence offered by the opposing party that the registered copyright is invalid. From such evidence, you are free to find that a registered copyright is not valid, in accordance with the instruction on the defenses asserted by the defendant, if you find that the defendant has proved by a preponderance of the evidence that the copyright is invalid. Preponderance of the evidence means that you must be persuaded by the evidence that it is more probably true than not true that the registered copyright is invalid."

Modern Federal Jury Instructions, Pub. 854, Inst. 86B-15, citing, 17 U.S.C. §§ 209, 410(c).

John Wiley and Sons, Inc. v. Supap Kirtsaeng d/b/a
Bluechristine99, John Doe Nos. 1-5

08 Civ. 7834 (DCP)

No. 3

Election of Damages

Under the Copyright Act, the plaintiff is entitled to recover the greater of

(i) defendant's profits from the infringement,

or

(ii) statutory damages.

Here, Wiley has elected statutory damages, which I will now discuss with you.

17 U.S.C. § 504(c); Hamil America, Inc. v. GFI, 193 F.3d 92, 103 (2d Cir. 1999); Rogers v. Koons, 960 F.2d 301, 312-13 (2d Cir. 1992).

John Wiley and Sons, Inc. v. Supap Kirtsraeng d/b/a
Bluechristine99, John Doe Nos. 1-5

08 Civ. 7834 (DCP)

No. 4

Copyright Damages – Statutory Damages

The purpose of statutory damages is to penalize the defendant and deter future violations of the copyright laws, both by the defendant and by others.

You must award as statutory damages an amount that you find is just under the circumstances, provided that amount is not less than \$750, nor more than \$30,000, per copyright infringed, except if the plaintiff proves by a preponderance of the evidence that defendant willfully infringed its copyrights, you may, but are not required to, increase the statutory damages for infringement of each copyright that was willfully infringed to a sum as high as \$150,000 per copyright infringed.

If you find that defendant infringed all of the plaintiff's copyrights, you may not award plaintiff less than \$6,000 in statutory damages, which represents minimum statutory damages of \$750 for each of the 8 copyrights. If you find the defendant willfully infringed all of the plaintiff's copyrights, you may award up to \$1,200,000 in statutory damages, which represents \$150,000 for each of the 8 copyrights.

17 U.S.C. § 504(c); Manual of Model Jury Instructions of the Ninth Circuit §20.25; Frank Music Corp. v. MGM, Inc., 886 F.2d 1545, 1554 (9th Cir. 1989), cert. denied, 494 U.S. 1017, 110 S. Ct. 1321 (1990); Twin Peaks Prods. v. Publ'ns Int'l, Ltd., 996 F.2d 1366, 1381 (2d Cir. 1993); Fitzgerald Pub. Co. v. Baylor Pub. Co., 807 F.2d 1110, 1117 (2d Cir. 1986); Island Software & Computer Serv. v. Microsoft Corp., 413 F.3d 257, 263 (2d Cir. 2005); Frank Music Corp. v. MGM, Inc., 886 F.2d 1545, 1554 (9th Cir. 1989), cert. denied, 494 U.S. 1017, 110 S. Ct. 1321 (1990).

John Wiley and Sons, Inc. v. Supap Kirtsaeng d/b/a
Bluechristine99, John Doe Nos. 1-5

08 Civ. 7834 (DCP)

No. 5

Statutory Damages – Willfulness

“To prove willfulness under the Copyright Act,
The plaintiff must show that:

- i. the defendant was actually aware of the infringing activity,

or

- ii. the defendant's actions were the result of reckless disregard for, or willful blindness to, the copyright holders' rights.”

Island Software & Computer Serv. v. Microsoft Corp., 413 F.3d 257, 263 (2d Cir. 2005); Lipton v. Nature Co., 71 F.3d 464, 472 (2d Cir. 1995) (“We have previously held that a defendant's copyright infringement will be found willful pursuant to § 504(c)(2) where the defendant had knowledge that its conduct constituted infringement or showed reckless disregard for the copyright holder's rights.”)

John Wiley and Sons, Inc. v. Supap Kirtsang d/b/a
Bluechristine99, John Doe Nos. 1-5

08 Civ. 7834 (DCP)

No. 6

Affirmative Defense – Waiver

Defendant has raised the affirmative defense of waiver to plaintiff's claim of copyright infringement. The burden is on the defendant to prove waiver occurred.

"[A] claim of waiver requires proof of an intentional relinquishment of a known right with both:

- (i) knowledge of [the] existence [of the right]
- and
- (ii) an intention to relinquish it."

Oboler v. Goldin, 714 F.2d 211, 212 (2d Cir. 1983) ("Once Oboler established the fact of copyright ownership and infringement, the burden of proof shifted to Goldin to show invalidity or waiver of the copyright. . ."); Covington Indus. v. Nichols, 2004 U.S. Dist. LEXIS 6210 at *13 (S.D.N.Y. April 5, 2004) (numerals added) ("[A] claim of waiver requires proof of an intentional relinquishment of a known right with both knowledge of its existence and an intention to relinquish it."), citing Capitol Records, Inc. v. Naxos of Am., Inc., 262 F. Supp. 2d 204, 211 (S.D.N.Y. 2003), citing Airco Alloys Div. v. Niagra Mohawk Power Corp., 76 A.D.2d 68, 430 N.Y.S. 2d 179, 187 (4th Dep't 1980).

UNITED STATES DISTRICT COURT
 SOUTHERN DISTRICT OF NEW YORK

-----x

JOHN WILEY & SONS, INC., :
 Plaintiff, :

-against- : 08 Civ. 7834 (DCP)

SUPAP KIRTSANG D/B/A : ECF Case
 BLUECHRISTINE99 AND JOHN :
 DOE NOS. 1-5, :

Defendants. :

-----x

SPECIAL VERDICT SHEET

For each of the 8 copyrights, please determine (i) whether there was an infringement, (ii) whether or not defendant's infringement was willful, and (iii) the amount of statutory damages that you award with respect to each infringement.

<u>Copyright</u>	<u>Infringement (Yes or No)</u>	<u>Willful (Yes or No)</u>	<u>Statutory Damages</u>
1. <u>Accounting Principles</u>	_____	_____	\$ _____
2. <u>Fundamentals of Heat and Mass Transfer</u>	_____	_____	\$ _____
3. <u>Fundamentals of Physics</u>	_____	_____	\$ _____
4. <u>Information Technology for Management</u>	_____	_____	\$ _____
5. <u>Introduction to Heat Transfer</u>	_____	_____	\$ _____
6. <u>Management</u>	_____	_____	\$ _____

7. Materials Science
and Engineering:
An Introduction

\$ _____

8. Organic Chemistry

\$ _____

Foreperson