

**UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK**

-----X
JOHN WILEY & SONS, INC.,

08 CV 7834

Plaintiff

-against-

**SUPAP KIRTSANG D/B/A BLUECHRISTINE99
and JOHN DOE NOS. 1-5,**

Defendants

-----X

DEFENDANT'S SUBMISSION OF PROPOSED JURY INSTRUCTIONS

Defendant Supap Kirtsaeng (“**Kirtsaeng**” or “**Defendant**”), by his counsel, Sam P. Israel, P.C., respectfully submits the following proposed instructions to the Jury:

**1. Copyright Infringement—Elements—
Ownership and Copying
(17 U.S.C. § 501(a)–(b))**

On a copyright infringement claim, the Plaintiff has the burden of proving both of the following by a preponderance of the evidence:

1. The Plaintiff is the owner of a valid copyright; and
2. The Defendant copied original elements from the copyrighted work.

If you find that the Plaintiff has proved both of these elements and the Defendant has failed to prove a valid defense, your verdict should be for the Plaintiff. If, on the other hand, the Plaintiff has failed to prove either of these elements and/or the Defendant has established a valid defense, your verdict should be for the Defendant.

Support Feist Publications v. Rural Tel. Serv. Co., 499 U.S. 340, 361 (1991) (two elements that must be proved by the Plaintiff to establish infringement are: “(1) ownership of a valid copyright, and (2) copying of constituent elements of the work that are original.”).

2. Copyright Interests— Owner Has Exclusive Right To Sue For Infringement (17 U.S.C. § 510(b))

The Copyright Act provides that only the owner of the copyright has a right to institute an action for any infringement; the right is exclusive.

See 17 U.S.C. § 510(b).

3. Standing: Assignment of Ownership Conveys Exclusive Right To Sue (17 U.S.C. § 201(d)(1))

A copyright owner may transfer, sell or convey to another person all or part of the owner's property interest in the copyright; that is, the right to exclude others from copying the work. The person to whom the copyright is transferred, sold or conveyed becomes the owner of the copyright in the work.

See 17 U.S.C. § 201(d)(1).

To be valid, the transfer must be in writing. The person to whom this right is transferred is called an assignee.

See 17 U.S.C. § 204(a).

In this case, the Plaintiff does not claim to be the author of the copyrights at issue. Instead, the Plaintiff claims that it received the copyrights by virtue of assignment from the work's author so that the Plaintiff is now the assignee of the copyright.

The Defendant, on the other hand, claims that the Plaintiff, in turn, assigned its ownership to the copyrights that are the subject of this lawsuit to another party and is, therefore, no longer the owner of the copyrights claimed to have been infringed.

If you find that the Plaintiff has assigned the copyrights to the books sold by the Defendant to another entity, then you will find that only that entity—and not the Plaintiff can sue for the infringement of that copyright. If, on the other hand, you find that the Plaintiff has not assigned the copyrights to the foreign entity then you will find that the Plaintiff has retained the right to sue for the infringement of those copyrights.

See 17 U.S.C. § 201(d)(2).

Support: Nimmer § 12.02

4. Copyright-First Sale Defense
17 U.S.C. § 109

Once a copyright owner sells an item lawfully made under the copyright law it has exhausted its exclusive statutory right to control its distribution and may not claim infringement by reason of further sales.

See 17 U.S.C. § 109.

Support: Quality King Distributors, Inc. v. L'Anza Research Int'l, Inc., 523 U.S. 135, 152 (1998); Universal City Studios, Inc. v. Reimerdes, 111 F. Supp. 2d 294, 317 n. 137 (S.D.N.Y. 2000).

The question under the first sale doctrine is whether or not the copyright owner has received its reward in connection with the disposition of the books.

Support: Platt & Munk Co. v. Republic Graphics, Inc., 315 F.2d 847, 854 (2d Cir. 1963); Sebastian International, Inc. v. Consumer Contacts (PTY) Ltd., 847 F.2d. at 1093 (3rd Cir. 1988)

If you find that the books sold by the Defendant were lawfully made under the copyright law and that the owner of the copyrights for the books had already made a prior sale, you will find that the Defendant has not infringed the copyrights.

5. Exclusive Importation Right and Waiver
17 U.S.C. § 602(a)

The Copyright Act restricts the importation into the United States, without the authority of the owner of copyright, works that have been acquired outside the United States.

See 17 U.S.C. § 602(a).

Yet, it is a well-accepted legal principal that rights may be waived.

The Plaintiff has assigned U.S. copyrights to a foreign entity. The Defendant maintains that, in so doing, the Plaintiff imposed no geographical restrictions on the foreign entity's distribution of the copyrighted books. The Plaintiff contends that it did impose such restrictions and that books were not authorized for distribution in the United States.

If you find that the Plaintiff did not restrict the foreign entity from distributing the books in the United States then you will find that it waived any claim that it waived the right to restrict the distribution of the books in the United States.

**6. Copyright—Statutory Damages
(17 U.S.C. § 504(c))**

If you find for the Plaintiff on the Plaintiff's copyright infringement claim, you must determine the Plaintiff's damages. In this case the Plaintiff has elected to pursue statutory damages against the Defendant. A statutory damage award was established by Congress for the purpose of penalizing an infringer and to deter future violations of the copyright laws.

As a punitive damage, it may not be awarded to compensate a plaintiff; its purpose is exclusively to deter and punish conduct which is malicious, wanton, or oppressive.

Support: Smith v. Wade, 416 U.S. 30, 49(1983).

The amount you may award as statutory damages is not less than \$750.00, nor more than \$30,000.00 for each work you conclude was infringed.

See 17 U.S.C. § 504(c)(1).

However, if you find the infringement was innocent, you may award as little as \$200.00 for each work innocently infringed.

At the same time, if you find the infringement was willful, you may award as much as \$150,000.00 for each work willfully infringed.

Accordingly, if you find for the Plaintiff, depending upon your assessment of innocence or willfulness, you may award statutory damages in the range of \$200.00 in total to as much as \$30,000.00 for each work you conclude was infringed.

Support: Feltner v. Columbia Pictures Television, Inc., 523 U.S. 340, 355 (1998) (The Seventh Amendment provides for the right to a jury trial on statutory damage issues, including the amount of such award.).

**7. Copyright—Innocent Infringement
(17 U.S.C. § 504(c)(2))**

An infringement is considered innocent when the Defendant has proved both of the following elements by a preponderance of the evidence:

1. The Defendant was not aware that his acts constituted infringement of the copyright;
- and

2. The Defendant had no reason to believe that his acts constituted an infringement of the copyright.

The statutory damage minimum for innocent infringement is \$200.00.

See 17 U.S.C. § 504(c)(2).

**8. Copyright—Damages—Willful Infringement
(17 U.S.C. § 504(c)(2))**

An infringement is considered willful when the Plaintiff has proved both of the following elements by a preponderance of the evidence:

1. The Defendant engaged in acts that infringed the copyright; and
2. The Defendant knew that those acts infringed the copyright.

Thus, “willful” means acting with knowledge that one’s conduct constitutes copyright infringement.

Support: Feltner v. Columbia Pictures Television, Inc., 523 U.S.340 (1998).

The statutory damage maximum for willful infringement is \$150,000.

See 17 U.S.C. § 504(c)(2).

Dated: New York, New York
October 6, 2009

Respectfully submitted:
Sam P. Israel, P.C.

**By: S/ _____
Sam P. Israel (SPI0270)
Attorney for Defendant Supap
Kirtsaeng
Twenty Third Floor
New York, NY 10006
Tel: 212-201-5345
Fax: 212-201-5343**