

R. Bruce Rich
Benjamin E. Marks
Jonathan Bloom
John R. Gerba
WEIL, GOTSHAL & MANGES LLP
767 Fifth Avenue
New York, New York 10153
(212) 310-8000

Attorneys for Defendant West Publishing Corporation

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

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EDWARD L. WHITE, P.C.,

Plaintiff,

v.

12 Civ. 1340 (JSR)
Filed Electronically

WEST PUBLISHING CORPORATION d/b/a West;
and REED ELSEVIER, INC. d/b/a LexisNexis,

Defendants.
-----X

**DEFENDANT WEST PUBLISHING CORPORATION'S
OPPOSITION TO PLAINTIFF'S LOCAL CIVIL RULE 56.1 STATEMENT**

Pursuant to Rule 56 of the Federal Rules of Civil Procedure and Rule 56.1 of the Local Civil Rules of the United States District Court for the Southern District of New York, Defendant West Publishing Corporation ("West") respectfully submits this Opposition to Plaintiff's Local Civil Rule 56.1 Statement.

1. Plaintiff is a professional corporation engaged in the practice of law. [White Deposition]

RESPONSE: Undisputed.

2. Plaintiff holds copyright registration certificates for the following works (together, the “Works”):
 - a. Plaintiff’s Combined Motion for Summary Judgment for Plaintiffs Beer and Ramsey and Brief in Support, dated May 20, 2009 [Copyright Registration Certificate Number TX 7-259-439, White Deposition Exhibit 5]; and
 - b. Plaintiffs’ Motion in Limine, dated March 15, 2012 [Copyright Registration Certificate Number TX 7-417-300, White Deposition Exhibit 6].

RESPONSE: West does not dispute that Plaintiff has produced the above copyright registration certificates. However, West disputes the validity of those registrations in light of material errors in and omissions from those registrations. See infra West Response to ¶ 3. Compare Blue Decl.¹ Exs. F, G (White Dep. Exs. 5, 6) (claiming date of first publication) with Pl. Mem.² at 14-16 (conceding that the works are unpublished).

3. The copyright registration certificates for each of the Works identifies Plaintiff as the Author of the Works. [*Id.*]

RESPONSE: West does not dispute that the copyright registration certificates Plaintiff has produced identify Plaintiff as the Author of each of the Works. However, West disputes that the certificates correctly identify Plaintiff as the Author of each of the Works. Martin S. High—co-counsel in the Beer v. XTO Energy, Inc. litigation—was the principal author of the Beer Motion in Limine, see High Dep.³ 28:20-31:22, and drafted significant portions of the Beer Summary Judgment Motion, see id. at 26:8-28:19, 65:22-79:22. High is not an employee of

¹ “Blue Decl.” refers to the October 5, 2012 Declaration of Gregory A. Blue, ECF No. 54.

² “Pl. Mem.” refers to Plaintiff’s Memorandum of Law in Support of Motion for Summary Judgment, dated October 5, 2012, ECF No. 55.

³ “High Dep.” refers to the transcript of the September 6, 2012 deposition of Martin S. High, excerpts of which are attached as Exhibit B to the October 23, 2012 Declaration of Jonathan Bloom (“Bloom Decl.”).

Plaintiff, see id. at 10:4-14; White Dep.⁴ 20:20-22, and he has no written agreement with Plaintiff concerning ownership of intellectual property rights in materials he drafts, in whole or in part, for cases on which he works with Plaintiff, see id. at 19:19-22; White Dep. 22:9-12.

4. The copyright registration certificates for each of the Works identifies Plaintiff as the Copyright Claimant of the Works. [*Id.*]

RESPONSE: Undisputed.

5. Defendant West did not seek or obtain express permission from the Plaintiff to reproduce the Works. [West's Response to Notice to Admit No. 4]

RESPONSE: Undisputed.

6. Defendant Lexis did not seek or obtain express permission from the Plaintiff to reproduce the Works. [Lexis's Response to Notice to Admit No. 4]

RESPONSE: West lacks knowledge or information sufficient to respond to this statement as it pertains solely to the conduct of Defendant Reed Elsevier, Inc. ("Lexis"). West respectfully refers the Court to Lexis's response to this paragraph.

7. Defendant West did not seek or obtain express permission from the Plaintiff to create derivative works. [West's Response to Notice to Admit No. 5]

RESPONSE: West disputes that it created derivative works but does not dispute that it did not seek or obtain express permission from Plaintiff to create derivative works. See Blue Decl. Ex. D ("West Responses to Admission Requests") No. 5.

⁴ "White Dep." refers to the transcript of the August 30, 2012 deposition of Edward L. White, excerpts of which are attached as Exhibit A to the Bloom Decl.

8. Defendant Lexis did not seek or obtain express permission from the Plaintiff to create derivative works. [Lexis's Response to Notice to Admit No. 5]

RESPONSE: West lacks knowledge or information sufficient to respond to this statement as it pertains solely to the conduct of Lexis. West respectfully refers the Court to Lexis's response to this paragraph.

9. Defendant West did not seek or obtain express permission from the Plaintiff to distribute Copies of the Works. [West's Response to Notice to Admit No. 6]

RESPONSE: West disputes that it distributed Copies of the Works but does not dispute that it did not seek or obtain express permission from the Plaintiff to distribute Copies of the Works. See West Responses to Admission Requests No. 6.

10. Defendant Lexis did not seek or obtain express permission from the Plaintiff to distribute Copies of the Works. [Lexis's Response to Notice to Admit No. 6]

RESPONSE: West lacks knowledge or information sufficient to respond to this statement as it pertains solely to the conduct of Lexis. West respectfully refers the Court to Lexis's response to this paragraph.

11. Defendant West did not seek or obtain an express license from the Plaintiff to use the Works in any fashion whatsoever. [West's Response to Notice to Admit No. 7]

RESPONSE: Undisputed.

12. Defendant Lexis did not seek or obtain express permission from the Plaintiff to use the Works in any fashion whatsoever. [Lexis's Response to Notice to Admit No. 7]

RESPONSE: West lacks knowledge or information sufficient to respond to this statement as it pertains solely to the conduct of Lexis. West respectfully refers the Court to Lexis's response to this paragraph.

13. Prior to the institution of this lawsuit, West had no communications with the Plaintiff, or anyone acting on the Plaintiff's behalf, concerning the grant of a license, whether express or implied, to authorize West to use the Works. [West's Response to Notice to Admit No. 8]

RESPONSE: Undisputed.

14. Prior to the institution of this lawsuit, Lexis had no communications with the Plaintiff, or anyone acting on the Plaintiff's behalf, concerning the grant of a license, whether express or implied, to authorize Lexis to use the Works. [Lexis's Response to Notice to Admit No. 8]

RESPONSE: West lacks knowledge or information sufficient to respond to this statement as it pertains solely to the conduct of Lexis. West respectfully refers the Court to Lexis's response to this paragraph.

15. West obtained the Works from the PACER system. [West's Response to Notice to Admit No. 10]

RESPONSE: West does not dispute that it obtained the Works (excluding exhibits) from the PACER system. See West Responses to Admission Requests No. 10.

16. Lexis obtained the Works from the PACER system. [Lexis's Response to Notice to Admit No. 10]

RESPONSE: West lacks knowledge or information sufficient to respond to this statement as it pertains solely to the conduct of Lexis. West respectfully refers the Court to Lexis's response to this paragraph.

17. Lexis made at least one Copy of each of the Works, in PDF or similar form. [Lexis's Response to Notice to Admit No. 20]

RESPONSE: West lacks knowledge or information sufficient to respond to this statement as it pertains solely to the conduct of Lexis. West respectfully refers the Court to Lexis's response to this paragraph.

18. West made Copies of the Works by converting the Works into the electronic file format used by West's electronic legal research databases. [West's Response to Notice to Admit No. 11]

RESPONSE: Undisputed.

19. Prior to the filing of the Complaint, West included electronic, text-searchable versions of the Works in West's electronic legal research databases that were available to subscribers. [West's Response to Notice to Admit No. 12]

RESPONSE: West does not dispute that, prior to the filing of the Complaint, it included, for a limited period of time, electronic, text-searchable versions of the Works (excluding exhibits) in certain of its electronic legal research databases that were available to certain subscribers. See West Responses to Admission Requests No. 12.

20. Prior to the filing of the Complaint, Lexis included electronic, text-searchable versions of the Works in Lexis's electronic legal research databases that were available to subscribers. [Lexis's Response to Notice to Admit No. 12]

RESPONSE: West lacks knowledge or information sufficient to respond to this statement as it pertains solely to the conduct of Lexis. West respectfully refers the Court to Lexis's response to this paragraph.

21. West made at least one copy of each of the Works for the purpose of including at least one copy of each of the Works in West's databases that are available to subscribers of your electronic legal research services. [West's Response to Notice to Admit No. 18]

RESPONSE: West does not dispute that it made at least one copy of each of the Works (excluding exhibits) for the purpose of including at least one copy of each of the Works (excluding exhibits) in certain of its databases that are available to certain subscribers to its electronic legal research service. See West Responses to Admission Requests No. 18.

22. Lexis made at least one copy of each of the Works for the purpose of including at least one copy of each of the Works in Lexis's databases that are available to subscribers of your electronic legal research services. [Lexis's Response to Notice to Admit No. 18]

RESPONSE: West lacks knowledge or information sufficient to respond to this statement as it pertains solely to the conduct of Lexis. West respectfully refers the Court to Lexis's response to this paragraph.

23. An image of each of the Works (excluding exhibits), in PDF form, as filed on PACER, was linked to the electronic, text-searchable version of the Work that was included in West's databases that are available to certain subscribers to its electronic legal research service. [West's Response to Notice to Admit No. 21]

RESPONSE: West does not dispute that an image of each of the Works (excluding exhibits), in PDF form as filed on PACER, was linked to the electronic, text-searchable version

of that Work that, for a limited time, was included in at least one of its databases that were available to certain subscribers of its legal research service. See West Responses to Admission Requests No. 21.

24. Lexis copied an image of each of the Works, in PDF or similar form, for the purpose of offering those images to subscribers of Lexis's electronic legal research services. [Lexis's Response to Notice to Admit No. 20]

RESPONSE: West lacks knowledge or information sufficient to respond to this statement as it pertains solely to the conduct of Lexis. West respectfully refers the Court to Lexis's response to this paragraph.

25. Prior to the filing of the Complaint, certain of the Defendants' subscribers and other fee-paying users accessed copies of the Works from the Defendants' databases. [Bogan Declaration; Document No. LN 8276; West's Response To Plaintiff's Request for Documents Regarding Pricing, dated September 5, 2012]

RESPONSE: Undisputed as to West. West lacks knowledge or information sufficient to respond to this statement as it pertains to Lexis and respectfully refers the Court to Lexis's response to this paragraph.

26. Plaintiff's registration with the CM/ECF system for the Western District of Oklahoma did not expressly require Plaintiff to relinquish his intellectual property rights in any document filed with the court, nor did the registration expressly inform the Plaintiff that the filing of such documents would entitle others to copy, sell, or distribute those documents for a commercial purpose. [White Deposition Exhibit No. 13]

RESPONSE: West disputes this statement. The CM/ECF system expressly advises CM/ECF users to download a copy of electronically filed legal documents to avoid later charges. See Bloom Decl. Exs. E, F. Moreover, Plaintiff has admitted that the Works are available to be copied through PACER and at the Court Clerk's office of the Western District of Oklahoma.

See Gerba Decl.⁵ Ex. E (Def. West Publ'g Corp.'s First Set of Requests for Admission to Pl. Edward L. White, P.C.), Nos. 5, 6 (admitted pursuant to Fed. R. Civ. P. 36(a)(3)), ECF No. 62.

27. Both Works were created within three years prior to the filing of the Complaint. [Copyright Registration Certificates, White Deposition Exhibits 5 and 6]

RESPONSE: Undisputed.

Dated: October 23, 2012

Respectfully submitted,

WEIL, GOTSHAL & MANGES LLP

By: /s/ R. Bruce Rich

R. Bruce Rich
Benjamin E. Marks
Jonathan Bloom
John R. Gerba
767 Fifth Avenue
New York, New York 10153
(212) 310-8000
benjamin.marks@weil.com

Attorneys for Defendant West Publishing Corp.

⁵ “Gerba Decl.” refers to the October 5, 2012 Declaration of John R. Gerba, ECF No. 62, submitted in support of West’s motion for summary judgment.