

questions” that are included in the booklet “How America Elects Her Presidents” (the “Booklet”) thereby allegedly infringing Plaintiffs’ copyright and tortiously converting the copyrighted work for the Oprah Winfrey Show.

By this motion Defendants seek sanctions and dismissal of the Complaint for the frivolous, harassing and groundless claims asserted by Plaintiffs in violation of Federal Rule of Civil Procedure 11(b) (1), (2), and (3). Had Plaintiffs or their attorney conducted a reasonable investigation into the facts by first obtaining a copy of the publicly available Transcript² they would have discovered that Ms. Winfrey did not copy questions, verbatim or otherwise, from the Booklet as they strenuously contend in the Complaint.

Furthermore, had Plaintiffs and their attorney done reasonable investigation into copyright law prior to filing suit, they would know that the facts regarding American presidents which form the basis of their claims are not copyrightable and thus cannot be the subject of copyright infringement. In *Feist Publ’ns Inc. v. Rural Tel. Serv. Co. Inc.*, 499 U.S. 340, 359 (1991) --- a case apparently known to Plaintiffs’ attorney because he referred to it in the demand letter he sent to Defendants on July 9, 2010³ --- the Supreme Court exhaustively addressed the well established proposition that facts are not copyrightable and further that even where facts are compiled together, “[a]s § 103 makes clear, a copyright is not a tool by which a compilation author may keep others from using the facts or data he or she has collected.” *Feist*, 499 U.S. at 359. Consequently, even if Plaintiffs had obtained a copyright registration of the Booklet as a

² See Exhibit A-1, hereto, (a true and correct copy of the February 16, 2009 TOWS transcript (the “Transcript”)

³ See Exhibit 8 to the Complaint at p. 4. The harassing purpose of this litigation in violation of Rule 11(b)(1) is also apparent by the demand made in this letter that is incorporated into the Complaint. According to Plaintiffs’ counsel, “in terms of liability, we rate this case as being 100% favorable,” that “**any fair, objective evaluation of this claim would lead a reasonable person to conclude that it has a value of \$100,000,000**” and the “**demand is non-negotiable and is very reasonable.**” *Id.* at p. 8 and Doc. # 1-4 at p. 5 (emphasis original).

compilation, which they have not,⁴ their copyright registration does not keep others from using facts about American presidents.⁵ Furthermore, the Copyright Act expressly provides that copyright has no effect on preexisting facts or “quotations borrowed under the rubric of fair use from other copyrighted works . . .” *Harper & Row Publishers, Inc.*, 471 U.S. 539, 548 (1985); *see* 17 U.S.C. § 103(b) (2006).

Accordingly, Defendants seek sanctions, including attorneys’ fees, against Plaintiffs and their counsel for bringing this frivolous and harassing lawsuit in violation of Rule 11(b)(1), and for their failure to make a reasonable inquiry under the circumstances into the facts and the law in violation of Rule 11(2) and (3).

II. ARGUMENT AND AUTHORITIES

Federal Rule of Civil Procedure 11 “imposes a duty on counsel to make an inquiry into both the facts and the laws which is reasonable under the circumstances.” *Zuk v. Eastern Pa. Psychiatric Inst. of the Med. Coll. of Pa.*, 103 F.3d 294, 299 (3d Cir. 1996)(affirming Rule 11 sanctions where party “had not sufficiently investigated the facts of the case nor had he educated himself well enough as to copyright law.”) “This is a more stringent standard than the original good-faith formula” *Id.* “Each duty is independent; the violation of one triggers Rule 11 sanctions.” *CTC Imports and Exports v. Nigerian Petroleum Corp.*, 951 F.2d 573, 578 (3d Cir. 1991).

“[R]ule 11 was designed to prevent abuse caused not only by bad faith but by negligence and, to some extent, by professional incompetence.” *Project 74 Allentown, Inc. v. Frost*, 143 F.R.D. 77, 82 (E.D.Pa. 1992) *citing Gaiardo v. Ethyl Corp.*, 835 F.2d 479, 482 (3d Cir. 1987).

⁴ See Exhibit 1 to the Complaint.

⁵ For example, a Google search of “heaviest president” resulted in 4,860 hits in .37 seconds. See Exhibit B, hereto.

In determining whether there has been a Rule 11 violation, “it is the objective reasonableness of the signing which must be evaluated, not the subjective intent or belief of the signer.” *Project 74 Allentown, Inc.*, 143 F.R.D. at 82-83. In other words, Rule 11 requires litigants to “‘stop-and-think’ before initially making legal or factual contentions.” Advisory Committee Notes to the 1993 Amendments (Subdivisions (b) and (c)). Consequently, “‘a pure heart and an empty head’ is not a defense to a Rule 11 violation...if a court finds that Rule 11 has been violated, the imposition of sanctions is mandatory.” *Project 74 Allentown, Inc.*, 143 F.R.D. at 82, n. 6 (citations omitted).

The Third Circuit has established a five pronged test under which a district court can evaluate the reasonableness of the pre-filing conduct by the signer of the document. *CTC Imports and Exports v. Nigerian Petroleum Corp.*, 951 F.2d 573, 578 (3d Cir. 1991); *Mary Ann Pensiero, Inc. v. Lingle*, 847 F.2d 90, 95 (3d Cir. 1988); *Project 74 Allentown, Inc.*, 143 F.R.D. at 87. What constitutes a reasonable inquiry may depend on such factors as (1) the amount of time available for pre-filing investigation, (2) the need to rely on a client for factual information, (3) the plausibility of the legal position advocated in the pleading, (4) whether the case was referred by another member of the bar, and (5) the complexity of the legal and factual issues raised by the pleading. *Id.*

None of the aforementioned factors mitigate in Plaintiffs’ favor in this case. The alleged infringement took place on February 16, 2009, more than eighteen (18) months ago; hence, there was no urgency to file. Plaintiffs’ attorney did not have to rely solely on his clients for the factual information about the Show because the Transcript is readily available to the public

online for \$29.95.⁶ Had he done so, Plaintiffs’ baseless factual contentions against Defendants would have been apparent, as we discuss in more detail below.

1. Rule 11(b)(2) Failure to Make Reasonable Inquiry Into the Law. Rule 11(b)(2) requires that all “claims, defenses, and other legal contentions [b]e warranted by existing law or by nonfrivolous argument for the extension, modification, or reversal of existing law or the establishment of new law.” *Zuk v. Eastern Pa. Psychiatric Inst. of the Med. Coll. of Pa.*, 103 F.3d 294, 299 (3d Cir. 1996). “To establish copyright infringement, two elements must be proven: (1) ownership of a valid copyright, and (2) copying of constituent elements of the work that are *original*.” *Feist*, 499 U.S. at 361 (emphasis added).

Plaintiffs’ legal position, that the Defendants infringed Plaintiffs’ copyright in questions such as (1) “A person must live in the U.S. how long before they become President?”; (2) “Who was the heaviest President?”; and (3) “The only President who never went to school?”⁷ is utterly untenable in light of well-settled Supreme Court precedent and statutory exceptions to the copyright owner’s rights. See *Id.*; 17 U.S.C. §§ 107-118 (2006). “[H]istorical fact . . . [are] not *per se* copyrightable” nor is information in the public domain. See *Harper & Row*, 471 U.S. at 545, 556. Even assuming *arguendo*, without admitting, that Defendants copied some of Plaintiffs’ material verbatim, a copyright owner’s rights are subject to the traditional privilege of others to make “fair use” of an earlier writer’s work. See *Harper & Row*, 471 U.S. at 548. Indeed, fair use has traditionally been defined as “a privilege in others than the owner of the copyright to use the copyrighted material in a reasonable manner without his consent.” *Id.* at

⁶ The February 16, 2009 TOWS transcript is readily available to the public online through the website for \$29.95. See Exhibit A-1, hereto, (a true and correct copy of the February 16, 2009 TOWS transcript (the “Transcript”)) and Exhibit A-2.

⁷ See Doc.# 1-3 at p. 8.

549. At most, only one of Ms. Winfrey's questions ("which one of our presidents weighed the most?") even begins to approximate the questions Plaintiffs complain are infringed.⁸

As the Supreme Court stated in *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co., Inc.*, 499 U.S. 340, 345. "[t]hat there can be no valid copyright in facts is universally understood. The most fundamental axiom of copyright law is that 'no author may copyright his idea or the facts he narrates.'" In *Feist*, a telephone utility company brought a copyright infringement action against a publisher of an area-wide telephone directory for the publisher's use of the utility's white pages. At issue was whether the plaintiff utility company could prove whether the defendant copied constituent elements of the work that were original. The Court, in examining that element, reiterated the well known proposition that "facts are not copyrightable" and "[t]hat there can be no valid copyright in facts is universally understood. The most fundamental axiom of copyright law is that 'no author may copyright his ideas or the facts he narrates.'" *Feist*, 499 U.S. at 344-45.

In addressing the "originality" element of copyright infringement, the Court stated:

The question was whether Rural has proved the second element. In other words, did Feist, by taking 1,309 names, towns, and telephone numbers from Rural's white pages, copy anything that was 'original' to Rural? Certainly, the raw data does not satisfy the originality requirement. Rural may have been the first to discover and report the names, towns, and telephone numbers of its subscribers, but this data does not 'owe its origin' to Rural. Rather these bits of information are uncopyrightable facts; they existed before Rural reported them and would have continued to exist if Rural had never published a telephone directory. The originality requirement 'rules out protecting names, addresses, and telephone numbers of which the plaintiff by no stretch of the imagination could be called the author.

Feist, 499 U.S. at 361 (citations omitted).

⁸ See Exhibit A-1, hereto, at p. 10.

Here, as in *Feist*, the “raw data” which Plaintiffs’ claim Defendants have infringed do not satisfy the originality requirement. The historical facts about American’s presidents obviously pre-existed Mr. Harris’s Booklet. Those facts do not “owe” their origin to Mr. Harris. To paraphrase the Court in *Feist*, these bits of information about American presidents are uncopyrightable facts; they existed before Mr. Harris wrote the Booklet, and would have continued to exist if Mr. Harris had not written the Booklet.

Even if Plaintiffs here were to claim that their selection, coordination and arrangement of the facts about America’s presidents contained in the Booklet were original to Mr. Harris, the Booklet would receive only limited protection. Section 103 of the Copyright Act explains that the “subject matter of the copyright . . . includes compilations,” but that copyright protects only the author’s original contributions not the facts or information conveyed:

The copyright in a compilation . . . extends only to the material contributed by the author of such work, as distinguished from the preexisting material employed in the work, and does not imply any exclusive right in the preexisting material.

Feist, 499 U.S. at 359, 17 U.S.C. § 103(b).

But Plaintiffs’ copyright registration is not for a compilation.⁹ Even if it were, though, “[a]s § 103 makes clear, copyright is not a tool by which a compilation author may keep others from using the facts or data he or she has collected.” *Feist*, 499 U.S. at 359, 17 U.S.C. § 103(b). The Court in *Feist* continued, “copyright . . . has no effect one way or the other on the copyright or public domain status of the pre-existing material.” *Feist*, 499 U.S. at 359. “Rather, the facts contained in existing works may be freely copied because copyright protects only the elements that owe their origin to the compiler—the selection, coordination, and arrangement of facts. *Id.*

⁹ See Exhibit 1 to Complaint.

The originality requirement “remains the touchstone of copyright protections today”; it is “the very premise of copyright law” and “*constitutionally mandated* for all works.” *Feist*, 499 U.S. at 347 (emphasis in original). As a result, it should have been apparent to Plaintiffs and their attorney that their claims that Defendants infringed their copyright by asking questions regarding American presidents does not meet the originality requirement required under the Copyright Act. *See e.g. Feist*, 499 U.S. at 361. Plaintiffs’ Complaint, therefore, is not warranted under the law and is sanctionable under Rule 11(b)(2).

2. Rule 11(b)(3) Failure to Make A Reasonable Inquiry into the Facts. Rule 11(b)(3) requires that “the factual contentions have evidentiary support.” In *Zuk*, the Third Circuit citing to the Advisory Committee Notes to the 1993 amendments to Rule 11 explained that even when factual contentions are made on information and belief, the litigant is not relieved from “the obligation to conduct an appropriate investigation into the facts that is reasonable under the circumstances; it is not a license to...make claims...without any factual basis or justification.” *Zuk v. Eastern Pa. Psychiatric Inst. of the Med. Coll. of Pa.*, 103 F.3d 294, 299 (3d Cir. 1996). “[T]he plaintiff must have some basis in fact for the action.” *Id.* In *Zuk*, the Third Circuit affirmed imposition of Rule 11 sanctions in a copyright case where the plaintiff Dr. Zuk’s factual assertions were based on his beliefs but he had nothing but conjecture to support such beliefs and their argument was contrary to copyright law. *Id.*

Here, unlike *Zuk*, the allegations in the Complaint about Defendants alleged conduct are not couched on information or belief. Instead, they are absolute unqualified assertions of fact that are unsupportable and flatly contradicted by the Transcript. For example, the Complaint alleges that on February 16, 2009, Mr. Harris saw “Ms. Winfrey reading out to the studio and viewing audiences several of *the exact same questions* that are included in the booklet” *See*

Complaint at ¶ 19. “The *language and the structure of the questions* were exactly the same to the material copyrighted in Mr. Harris’s booklet.” *Id.* at ¶ 20. “The questions in the booklet “How America Elects Her Presidents” were developed and designed for Unique, not for the Ms. Winfrey show.” *Id.* at ¶ 21. “Defendants copied questions verbatim from Mr. Harris’ ‘Copyrighted Work,’ without his permission or license.” *Id.* Notably, the Complaint does not refer to the Transcript or provide *any* of the allegedly infringing questions asked by Ms. Winfrey.

Had Plaintiffs reviewed the publically available Transcript, they would have discovered that Ms. Winfrey’s questions were not copied “verbatim as in the booklet,” her questions were not “the exact same questions” nor was “the language and structure of the question . . . exactly the same” as the copyrighted material, as they allege nor were they substantially similar to *any* copyrightable material. Indeed, had they conducted even a modicum of investigation, they would have discovered that the program titled “*Oprah’s Search for the World’s Smartest and Most Talented Kids*” on February 16, 2009 (hereafter the “Show”) does not copy their copyrighted work, verbatim or otherwise, but merely asks a six year old guest some questions regarding American presidents.¹⁰

The entirety of the exchange between Ms. Winfrey and her six year old guest Graham is as follows:

WINFREY: . . . Okay, we also came across a first-grade whiz kid who knows more about American presidents than many adults, certainly more than I do. Meet six year old Graham.

...

WINFREY: . . . So what do you think of our new president?

GRAHAM: He’s, um, is a good order like J.F.K.

¹⁰ See Exhibit A-1, hereto, at pp. 9-10.

...

WINFREY: . . . I hear you have some interesting trivia about our first president, George Washington.

GRAHAM: He, um, had false teeth. Most people say that they were made of wooden teeth, some people say he had ivory, gold, and silver.

WINFREY: Yeah, some people say that. Okay, *which one of our presidents weighed the most?*

GRAHAM: William Howard Taft.

WINFREY: Okay. What did he weigh?

GRAHAM: He weighed 327 pounds.

WINFREY: Okay. He had to take baths in the pool. I just found that out today, so—who is the president on the screen?

GRAHAM: That's Grover Cleveland.

WINFREY: Grover Cleveland.

GRAHAM: Right.

WINFREY: Okay And he was the 22nd and

GRAHAM: 24th.

WINFREY: Thank you—president. I just learned that today, too. Well, it's a pleasure to meet you. Thanks you very much. Thank you sir.

(Exhibit A-1, hereto, at pages 9-10).

Thus, even a cursory comparison of the allegedly infringed excerpts from the Booklet (attached as Exhibits 8, 9, and 10 to Exhibit 8 of the Complaint) to the Transcript would have revealed that only the subject matter---historical facts about American presidents---is common to

both Ms. Winfrey's colloquy with her young guest Graham and the Booklet. There are no questions whatsoever common to both the Transcript and the Booklet---in no small part because the Booklet does not contain questions at all.¹¹

Consequently, the factual allegations in the Complaint that Ms. Winfrey was "reading out to the studio and viewing audiences *several of the exact same questions* that are included in his booklet...Ms. Winfrey was reading out the *questions verbatim as in the booklet*,"¹² and "The language and structure of the question *were exactly the same to material copyrighted* in Mr. Harris's booklet"¹³ are demonstrably and patently false. Because the factual contentions against Defendants lack evidentiary support, the Complaint violates Rule 11(b)(3) and mandatory sanctions must be imposed.

3. The State Law Claims Are Preempted. Plaintiffs' state law claims for tortious conversion, unjust enrichment and quantum meruit are pre-empted by the Copyright Act. *See* 17 U.S.C. § 301; *TEGG Corp. v. Beckstrom Elec. Co.*, 650 F.Supp.2d 413, 434 (W.D.Pa. 2008) (holding plaintiff's claim for conversion was functionally equivalent to its exclusive right to copy, distribute, and create derivative works from the copyrighted TEGG software and databases, and therefore, pre-empted by the Copyright Act); *Live Face on Web, L.L.C. v. Howard Stern Prods., Inc.*, No. Civ. A. 09-2579, 2009 WL 723481, at *5-6 (E.D.Pa. Mar. 17 2009) (unjust enrichment claim preempted by copyright law). The allegations in the Complaint for these torts mirror and are the functional equivalent of the copyright infringement claim and, therefore, are preempted by the Copyright Act.

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¹² See Complaint at ¶ 19.

¹³ See Complaint at ¶ 20.

Conclusion

Accordingly, because the legal and factual contentions advanced by Plaintiffs and their attorney in the Complaint are not supportable or warranted by existing law or by a non-frivolous argument for extending, modifying or for establishing new law, sanctions should be imposed pursuant to Rule 11.

WHEREFORE, Defendants respectfully pray that this Court grant this motion for sanctions pursuant to Federal Rule of Civil Procedure 11 against Plaintiffs and their attorneys, that the Complaint be stricken, that Defendants be awarded their attorneys fees and expenses and for such other and further relief, at law or in equity to which they may justly be entitled.

Respectfully submitted,

**OPRAH WINFREY, as an individual and The
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CERTIFICATE OF SERVICE

I, William T. Hangley, hereby certify that a true and correct copy of Defendants' Motion for Rule 11 Sanctions was initially served on James E. Lee, counsel for Plaintiffs, at the address below, on November 15, 2010, pursuant to Federal Rule of Civil Procedure 11(c)(2), by certified mail and e-mail, and that a true and correct copy of Defendants' Motion for Rule 11 Sanctions was served on December 20, 2010 on all counsel of record via electronic filing through the Court's Electronic Filing System and by United States Mail, first class postage prepaid, to:

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