

I. Background¹

A. Scholastic's Alleged Infringing Conduct as to the Photographs

The Court assumes the parties' familiarity with the facts of this case, which are set out in *Sohm*, 2018 WL 1605214, at *1-2, and *Sohm*, 959 F.3d at 42, and only briefly summarizes the facts as relevant to Plaintiffs' motion.

Sohm and VOA contracted with stock photography agencies, authorizing those agencies to grant third-party licenses for the use of Sohms' copyrighted photographs. *See Sohms*, 959 F.3d at 42. One of those agencies was Continuum Productions Corporation, a predecessor in interest to Corbis Corporation ("Corbis"). Pls. 56.1 Stmt. ¶ 4. In April 1994, Sohms, acting through a predecessor to VOA, entered into a representation agreement with Corbis, which was later renewed in 2001, 2006, and 2011. *Id.* That agreement authorized Corbis to issue limited licenses to third parties for the use of Sohms' photographs, in exchange for Corbis receiving a percentage of the license fee. *Id.* Pursuant to this representation agreement, between 2006 and 2009, Corbis issued limited licenses for the use of Sohms' photographs to Scholastic, the world's largest publisher and distributor of children's books, Dkt. 31 ¶ 3, including limited licenses for the Photographs. Pls. 56.1 Stmt. ¶¶ 5-6.

¹ The following facts are drawn from Judge Oetken's summary judgment opinion, *see Sohms*, 2018 WL 1605214, at *1-2, the Second Circuit's decision on appeal, *see Sohms*, 959 F.3d at 42, and the parties' statements of material facts pursuant to Local Civil Rule 56.1 in connection with Plaintiffs' instant motion for partial summary judgment, *see* Dkt. 128 ("Pls. 56.1 Stmt."); Dkt. 130 ("Def. Counter 56.1 Stmt."). Unless otherwise noted, the Court cites to only one party's Rule 56.1 or Counter Rule 56.1 Statement where the parties do not dispute the fact, the adverse party has offered no admissible evidence to refute that fact, or the adverse party simply seeks to add its own "spin" on the fact or otherwise dispute the inferences from the stated fact. Scholastic does not dispute various statements in Plaintiff's Rule 56.1 Statement in light of the prior decisions in this case, "but preserves its defenses summarized in Scholastic's accompanying opposition to Plaintiffs' renewed motion for summary judgment solely for the purpose of any further appeals in this action." Def. Counter 56.1 Stmt. ¶¶ 2, 7, 14.

These licenses limited the number of copies of the Photographs that Scholastic was authorized to make. *Id.* ¶ 7.² Scholastic, however, printed publications containing the Photographs in quantities that exceeded the quantity restrictions in the licenses. *Id.* ¶¶ 13-14, Exh. A. Specifically, for the five Photographs, Scholastic printed books that exceeded the license limitations in the following manner:

- For the photographs with Registration Number VA 1-074-964 and Registration Number VA 1-113-639, Corbis issued Scholastic a license (License Number 7063891) in the quantity of 25,000 copies of each photograph. Scholastic's book, *The American Flag*, contained both photographs, yet had a print quantity of 30,408, resulting in an infringing print quantity of 5,408 for each photograph. *Id.*, Exh. A.
- For the photograph with Registration Number VA 1-074-964, Corbis issued Scholastic a license (License Number 7063915) in the quantity of 25,000 copies of the photograph. Scholastic's book, *The Presidency*, contained this photograph, yet had a print quantity of 62,093, resulting in an infringing print quantity of 37,093. *Id.*, Exh. A.
- For the photograph with Registration Number VA 863-783, Corbis issued Scholastic a license (License Number 8078698) in the quantity of 25,000 copies of the photograph. Scholastic's book, *Population 1.3 Billion*, contained this photograph, yet had a print quantity of 34,794, resulting in an infringing print quantity of 9,794. *Id.*, Exh. A.
- For the photograph with Registration Number VA 863-785, Corbis issued Scholastic a license (License Number 1000029727) in the quantity of 50,000 copies of the photograph.

² As previewed in the preceding footnote, Scholastic acknowledges the Second Circuit decision on this issue, but preserves its objection. In particular, while Scholastic concedes that the invoices issued in connection with the Corbis licenses for the Photographs included the number of copies that Scholastic anticipated making, Scholastic contends that those numbers did not reflect a limitation of Scholastic's use of the Photographs. Def. Counter 56.1 Stmt. ¶ 7; *see also id.* ¶ 14.

Scholastic's book, *The American Flag*, contained this photograph, yet had a print quantity of 195,713, resulting in an infringing print quantity of 145,713. *Id.*, Exh. A.

B. Procedural History

In an Amended Complaint filed on October 25, 2016, Plaintiffs pleaded a count of copyright infringement against Scholastic, in violation of 17 U.S.C. §§ 501 *et seq.*, alleging 117 infringing uses of 89 photographs. Am. Compl. ¶¶ 17-19, Exh. 1. In June and July 2017, after the close of discovery, the parties each moved for partial summary judgment. *See* Dkts. 66-69, 73-80.

1. Judge Oetken's Summary Judgment Opinion

Judge Oetken granted each side partial summary judgment with respect to certain disputed photographs. First, Judge Oetken addressed Scholastic's challenge to the validity of some of Plaintiffs' copyright registrations. *Sohm*, 2018 WL 1605214, at *3-6. Judge Oetken found that, under the plain language of 17 U.S.C. § 409(2), Corbis validly used group registrations. *Id.* at *4. Judge Oetken also rejected Scholastic's challenge to four registrations for inaccurately representing that certain published photographs were "unpublished," explaining that Scholastic failed to show an absence of a genuine factual dispute as to Sohm's knowledge of those inaccuracies. *Id.* at *6-7; *see* 17 U.S.C. § 411(b)(1)(A). Judge Oetken then denied summary judgment on Scholastic's argument that the registration of eight photographs was flawed because the photographs were created after the registration's first publication date, finding a genuine factual dispute as to these photographs' creation dates. *Sohm*, 2018 WL 1605214, at *7-9.

Judge Oetken next addressed Scholastic's argument for summary judgment on the grounds that no "unauthorized copying" occurred. *Id.* at *8-9. Judge Oetken granted summary judgment in favor of Scholastic for twelve uses involving ten photographs where the undisputed facts confirm that Scholastic did not exceed its print limitation under the relevant licenses. *Id.* at *8.

Judge Oetken also dismissed claims as to seven uses where Plaintiffs “ha[d] not come forth with any evidence that a use occurred at all,” and as to another thirty-six uses where Plaintiffs did not present sufficient evidence of infringement. *Id.* at *9.

Judge Oetken then turned to Plaintiffs’ motion for partial summary judgment as to thirteen uses where Scholastic “exceeded the print runs in the relevant invoices and licenses.” *Id.* at *10. After rejecting certain arguments raised by Scholastic, including that some claims were barred by the statute of limitations and that damages should be limited to the three years prior to commencement of this action, Judge Oetken addressed whether Scholastic’s overuse of the Photographs it licensed from Corbis could generate copyright claims. *See Sohm*, 2018 WL 1605214, at *12-14. Breaches of publication limits in licenses only give rise to copyright claims if the limits are conditions precedent. *Id.* at *12. If the limits are instead covenants, a plaintiff has a potential contract claim, but not a copyright claim. *See id.* Applying New York law, Judge Oetken concluded that the print run limitations in Corbis’s vendor agreements with Scholastic “are best characterized as covenants, rather than conditions,” because “Scholastic’s license was conditional on full payment *as invoiced*” and Plaintiffs did not allege that Scholastic failed to pay as invoiced. *Id.* at *13. Judge Oetken thus concluded that any claims must sound in contract (which was not pleaded), rather than copyright, and granted summary judgment against Plaintiffs’ copyright claims. *Id.* at *14. Judge Oetken, however, found that the problem did not afflict Plaintiffs’ claims based on Scholastic’s licenses with two other agencies and granted Plaintiffs summary judgment on those claims. *Id.*

Thus, Judge Oetken granted Plaintiff summary judgment as to the claims corresponding to Rows 8, 9, and 13-16 of Docket Number 69-1, and granted Scholastic summary judgment as to claims corresponding to Rows 1-67, 72-84, 97, 105, and 109-114 of Docket Number 74-1.

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