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Cambridge Univ. Press v. Patton

769 F.3d 1232 (11th Cir. 2014)

VICTOR NG*

BACKGROUND

Plaintiffs Cambridge University Press, Oxford University Press, Inc., and Sage Publications, Inc. are publishers of advanced scholarly works and journals on highly specialized topics. Their publications are often used in upper division undergraduate and graduate curricula. The defendants are members of the Board of Regents of the University System of Georgia and officials at Georgia State University (“GSU”). The University System of Georgia governs GSU.¹

GSU has two digital distribution platforms known as “ERes” and “uLearn.”² Both platforms allow professors to distribute copies of reading material to students. Through the two platforms, students can access and save reading material throughout the duration of a scheduled course.

The Copyright Clearance Center (“CCC”) is a not-for-profit corporation that licenses excerpts of copyrighted works. The licenses are called permissions. Consumers, such as GSU, purchase permissions from CCC in order to photocopy or digitally reproduce excerpts of published works.

The plaintiffs claimed that the defendants infringed their copyrighted works by distributing unlicensed portions to students. In response to the plaintiffs’ lawsuit, the defendants enforced a new copyright policy (the “2009 Policy”).³ The 2009 Policy required GSU professors to complete a “Fair Use Checklist” for each excerpt used and distributed via ERes or uLearn.⁴

PROCEDURAL HISTORY

The plaintiffs brought suit against GSU officials for copyright infringement on April 15, 2008 in the United States District Court for the Northern District of Georgia. They filed the first amended complaint on December 15, 2008 to include members of the Board of Regents of the University System of Georgia. On February 26, 2010, after the initial

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1 Cambridge Univ. Press v. Patton, 769 F.3d 1232, 1237 (11th Cir. 2014).

2 *Id.* at 1239.

3 *Id.* at 1242.

4 *Id.*

discovery process was complete, both parties moved for summary judgment. Additionally, the plaintiff sought injunctive relief.

On August 11th and 12th, 2010, the district court ordered the plaintiffs to provide a list of alleged infringements by the defendants after the enforcement of the 2009 Policy. On August 20, 2010, plaintiffs provided a list of 126 instances of alleged copyright infringement. The court however, denied the defendants' motion for summary judgment on the claims of contributory infringement, but granted summary judgment for the claims of direct and vicarious infringement. The plaintiffs then filed for a motion for partial reconsideration. The defendants filed for dismissal of the plaintiffs' first amended complaint due to lack of subject matter jurisdiction.

On November 5, 2010, the district court ordered discovery on GSU's use of the plaintiffs' copyrighted works during the 2009 Maymester (a three-week term), summer, and fall terms. Following discovery, the bench trial was on May 17, 2011. The district court granted the defendants' motion for summary judgment, but left the claim that the 2009 Policy directly caused copyright infringement for further determination.

On June 1, 2011, the plaintiffs voluntarily revised the list, claiming there were only seventy-five instances of copyright infringement. The court only considered seventy-four instances of alleged copyright infringements since one work was listed for two consecutive semesters, but only used exclusively during one semester. On May 11, 2012, the district court found that there were only five instances of copyright infringement and the remaining sixty-nine instances fell under the fair use exception. The district court awarded attorney fees to the defendants, and awarded declaratory and injunctive relief to the plaintiffs. Both parties appealed.

ISSUE

The U.S. Court of Appeals for the Eleventh Circuit addressed two issues: (1) whether it was appropriate for the district court to perform a work-by-work analysis focusing on whether the use of each individual work constituted fair use, opposed to reviewing the broader context of GSU's ongoing practices; and (2) whether the district court erred in giving each of the four fair use factors equal weight.

DECISION

The court of appeals determined it was appropriate for the district court to perform a work-by-work analysis for fair use, opposed the evaluating the broader context of GSU's ongoing practices. However, the court of appeals found that the district court erred in giving each of the four fair use factors equal weight. Furthermore, the court of appeals held that district court abused its discretion by considering two additional fair use factors. The court of appeals vacated the judgment and remanded the case to the lower court for further proceedings.

REASONING

The court of appeals began its analysis by reviewing the district court's overarching fair use methodology. The court of appeals stated that fair use must be reviewed with a work-by-work analysis. The court reasoned that without such analysis, there would not be a principled method to guide the determination of fair use and whether injunctive relief was proper.

The court of appeals examined whether the lower court appropriately applied the four-pronged test for fair use. The four factors include: (1) the purpose and character of the use, including whether it is for commercial or educational use; (2) the nature of the copyrighted work; (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and (4) the effect of the use upon the potential market for or value of the copyrighted work.⁵

To evaluate the first factor, courts look at: (1) the extent to which the use transforms the original work and (2) whether the use is for a nonprofit educational purpose. The court of appeals found that it was undisputed that GSU's use of the copyrighted work was not transformative, since the original works published by the plaintiffs were merely digitized and shared through digital platforms. Further, the court found the use of the copyrighted material was for a nonprofit, educational purpose. While GSU derived some profit by not paying licensing fees, it was not a substantial commercial gain. As such, the court of appeals agreed with the lower court in affirming that the defendant's use of the work satisfied this prong.

The second fair use factor focuses on the communicative nature of the copyrighted work. Specifically, the court of appeals was concerned with whether the copied work was of factual or fictional nature. The court of appeals found that the plaintiffs' works were of "evaluative, analytical, or subjectively descriptive material"⁶ surpassing the bare facts required to communicate information. As such, the court of appeals held that the lower court erred in its determination that the defendants met this prong. However, the court of appeals stated that the second factor was not important in this case.

The third factor concerns how much use of the copyrighted material is unpaid in relation to the work as a whole. The factors considered are quality, quantity, importance, and type of use.⁷ The court of appeals found that the lower court erred in its blanket 10 percent or one chapter benchmark⁸ used to determine fair use. The court reasoned that the standard did not take into account the quality and importance of the work. Furthermore, the court held a work-by-work review is required to ensure all relevant factors are considered to meet this prong.

5 17 U.S.C § 107 (2012).

6 *Id.* at 1270.

7 *Id.* at 1271.

8 *Id.*

When evaluating the final and fourth factor, the court of appeals assessed the harm to the overall market caused by the alleged infringement, and whether the publisher's potential market was substantially, adversely impacted. Specifically, the fourth factor focuses on evaluating the potential damage if "everybody did it."⁹ The court of appeals agreed with the lower court's finding that the defendants' unpaid use of small excerpts of copyrighted work did not create such harm. The court of appeals found that the district court appropriately took license availability into account in determining whether the fourth factor should be weighed for or against fair use. However, the court of appeals found that the lower court erred by not affording the fourth factor more weight in the overall fair use calculation because the defendants' copying was non-transformative, as considered in the first factor, and the threat of market substitution was more plausible. Additionally, the court of appeals upheld the lower court's ruling that the plaintiffs were required to produce documents related to licensing availability, despite the defendants' burden of proof since the plaintiffs were reasonably expected to have such evidence.

Last, while the lower court had the discretion to go beyond the considerations set forth in the four fair use factors, the court of appeals held that additional considerations should be evaluated within existing statutory framework and not as supplements. Specifically, the lower court needed to look at factors one and four together to determine whether unpaid copying of excerpts deterred academic authors from publishing new work, and whether the plaintiffs' ability to publish scholarly work and promote dissemination of knowledge was appreciably diminished by the fair use of copyrighted works.

The court of appeals held that the district court erred in treating all components of the four fair use factors with equal weight. The court of appeals vacated the judgment. The court of appeals held that on remand the lower court must perform a holistic analysis, giving varied weights to different factors.