

12-3200-cv

IN THE
United States Court of Appeals
FOR THE SECOND CIRCUIT

THE AUTHORS GUILD, INC., Associational Plaintiff,
BETTY MILES, JOSEPH GOULDEN, and JIM BOUTON, individually
and on behalf of all others similarly situated,

Plaintiffs-Appellees,

v.

GOOGLE, INC.,

Defendant-Appellant.

*On Appeal from the United States District Court
for the Southern District of New York (New York City)*

**BRIEF FOR AMICI CURIAE
THE AMERICAN LIBRARY ASSOCIATION,
THE ASSOCIATION OF COLLEGE AND
RESEARCH LIBRARIES, AND THE ASSOCIATION
OF RESEARCH LIBRARIES IN SUPPORT OF
DEFENDANT-APPELLANT AND REVERSAL**

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CORPORATE DISCLOSURE STATEMENT

Amici curiae the American Library Association, the Association of College and Research Libraries, and the Association of Research Libraries state that none of these entities has a parent corporation and that no publicly held corporation owns 10% or more of their respective stock.

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The American Library Association, the Association of College and Research Libraries, and the Association of Research Libraries submit this *amicus* brief in support of Google and request reversal of the District Court’s order certifying a class of plaintiffs. All parties have consented to the submission of this brief.¹

INTEREST OF *AMICI CURIAE*

The American Library Association (“ALA”), established in 1876, is a nonprofit professional organization of more than 60,000 librarians, library trustees, and other friends of libraries dedicated to providing and improving library services and promoting the public interest in a free and open information society.

The Association of College and Research Libraries, the largest division of the ALA, is a professional association of academic and research librarians and other interested individuals. It is dedicated to enhancing the ability of academic library and information professionals to serve the information needs of the higher education community and to improve learning, teaching, and research.

The Association of Research Libraries (“ARL”) is a nonprofit organization of 125 research libraries in North America. ARL’s members include university, public, governmental, and national libraries. ARL programs and services promote

¹ In accordance with Local Rule 29.1, no party’s counsel authored this brief in whole or in part, no party and no party’s counsel contributed money that was intended to fund preparing or submitting the brief, and no person other than *amici curiae* and their counsel contributed money that was intended to fund preparing or submitting the brief.

equitable access to and effective use of recorded knowledge in support of teaching and research.

Collectively, *amici* represent more than 100,000 libraries and 350,000 librarians and other personnel in the United States that serve the needs of the public in the digital age. The associations share a strong interest in the balanced application of copyright law to new technologies and online services like Google Book Search (“GBS”) that disseminate information, knowledge, and learning. In particular, the library association *amici* have an interest in preserving the public benefits that GBS offers and in ensuring the correct application and continuing vitality of the fair use doctrine, including in the context of class action litigation.

INTRODUCTION AND SUMMARY OF ARGUMENT

The decision below should be reversed.

1. Google Book Search has become an essential research tool that benefits scholars, students, and libraries, as well as authors themselves. Class certification, however, would jeopardize the public’s continued access to GBS. Appellees seek an award of the statutory minimum of \$750 for each work used, and with millions of copyrighted works in dispute, the damages could be immense. Such an award would have no connection to the alleged injury suffered or the many benefits that GBS provides to the public. Class certification has the potential to subject GBS to

potentially crippling damages and thus to eliminate or impair the public's access to and use of the service.

Class certification would also cause wider harm. It would set a precedent that *any* mass digitization initiative is subject to class action claims and the enormous damages exposure that accompanies them. The mere threat of having to defend against such claims creates a disincentive for libraries, universities, and others to engage in socially beneficial digitization efforts, even where there is a strong fair use justification. Class certification thus could unintentionally stifle further progress in digitizing and disseminating information and knowledge for the benefit of the public.

2. To protect litigants and preserve the public interest, the Federal Rules impose several requirements for class certification, including that there be issues of law or fact common to the class. *See* Fed. R. Civ. P. 23(a)(2). An issue is common only if it is capable of classwide resolution – in other words, where it has the capacity to generate common answers apt to drive the resolution of the litigation. *Wal-Mart Stores, Inc. v. Dukes*, 131 S. Ct. 2541, 2551 (2011).

There are no common issues that are capable of classwide resolution under the standard the Supreme Court established in *Wal-Mart*. The two issues the District Court found to be common – fair use and infringement – do not satisfy Rule 23(a)(2). Fair use certainly is at the core of this dispute. But three of the four

statutorily-mandated fair use factors involve facts unique to each copyrighted work and its usage. And none of the four factors may be examined in isolation; rather, the inquiry must explore and weigh all of the factors together. *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 578 (1994). The analysis is not necessarily the same for all members of the class.

The only other issue identified by the District Court – infringement – is not a common question; it is the ultimate question. An issue at such a high level of generality does not satisfy Rule 23(a)(2), as *Wal-Mart* noted. If it did, commonality would exist in every circumstance. There are no other common issues.

3. The Court cannot overcome the lack of commonality, or predominance for that matter, by employing subclasses to conduct its fair use analysis. The District Court never explained how it would use subclasses. A closer look reveals that using subclasses, even if appropriate as a legal matter, would require hundreds and more likely thousands of fair use mini-trials. Subclasses cannot repair the inherent flaws of litigating this dispute as a class action.

4. Class certification would make it virtually impossible for the District Court to craft an injunctive remedy if liability is found. Because ownership of a valid copyright is an element of a copyright infringement claim, the District Court could not issue an injunction barring GBS from using works owned by non-class

members. It would have to decide who owns each work at issue, but definitive copyright ownership information is not publicly available. Discovery of all class members would be necessary, and the court or a jury would be burdened with assessing the ownership status of millions of works – a nearly impossible task.

ARGUMENT

I. CLASS CERTIFICATION IN THIS CASE THREATENS TO UNDERMINE THE PUBLIC INTEREST

A. Google Book Search Benefits Researchers, Scholars, Librarians, Authors, and the Public at Large

From the perspective of the *amici* library associations, Google Book Search advances the public interest in a number of important ways.

GBS has become an essential research tool for scholars, students, and libraries. By letting users search for and identify relevant works, GBS allows researchers to get started on a path to access these materials through the physical holdings of a library or through other means like interlibrary loan. To librarians, GBS is indispensable for identifying valuable research sources. GBS in particular benefits students and faculty at small and remote educational institutions – many of which have limited resources and face significant challenges in identifying and accessing materials. Where a library does not hold a particular book in its collection, GBS helps librarians to decide whether to request a book by interlibrary loan, conserving strapped library budgets and speeding research. At geographically isolated institutions, getting books through interlibrary loan can

take weeks, with significant postage costs. By using GBS to identify the specific materials needed, a library can narrow its request and obtain the material in a day or two. And GBS has become a crucial tool for finding and checking citations, saving libraries and scholars significant time and allowing them to focus their efforts more productively elsewhere.

GBS is valuable not just for research, but also for developing and making the most of existing library collections. In *amici*'s experience, GBS has led librarians to identify resources that they purchase for their libraries, and it has assisted faculty members to order books for their own private collections. GBS also helps to identify material that is housed by a library itself but that otherwise would be difficult if not impossible to find.

For all these reasons, GBS has become an integral part of this nation's education system. GBS enhances scholarship and opens a universe of knowledge and learning that otherwise would be off limits for many.

GBS also benefits authors, despite Appellees' claims to the contrary. Most authors appear to approve of GBS. See A244; Br. of *Amici Curiae Academic Authors* in Supp. of Def.-Appellants and Reversal. The service helps readers find authors, which grows their audience and, not incidentally, improves sales. GBS is also valuable to authors as a research tool. GBS allows authors to tell whether a

book will assist their scholarship and writings, and it helps authors decide whether to borrow or buy books that are not in their own collections.

B. The Potentially Immense Damages Available in a Class Action Threaten the Public Interest in Google Book Search

Class certification threatens to deprive the public's access to GBS and the many benefits it provides, by potentially giving rise to statutory damages that will disable or destroy the service. The Copyright Act allows, under certain circumstances, a plaintiff in a copyright infringement action to recover statutory damages, ordinarily in the range of \$750 to \$30,000 per work infringed. 17 U.S.C. § 504(c). Every member of Appellees' proposed class is eligible to elect statutory damages. *See* 17 U.S.C. § 412; SPA1 (“‘Books’ means each full-length book published in the United States in the English language and registered with the United States Copyright Office within three months after its first publication.”). Appellees seek an award of the \$750 statutory minimum for each work owned by a class member. Mem. of Law in Supp. of Pl.’s Mot. for Partial Summ. J. 47, ECF No. 1050.

Class certification is especially problematic in this case because of the millions of works in suit. If GBS is found to infringe, the total statutory damages award will not take into account the immense benefits that GBS provides to the public. In a case where fair use is at the core of the dispute and a careful examination and weighing of numerous factors is essential for a determination of

liability, the District Court will have no discretion to fashion a monetary remedy below the statutory minimum that reflects the circumstances of the use and the impact on the public. Nor does the Copyright Act require Appellees to prove that \$750 per work fairly compensates class members for their purported injuries. Indeed, it is unlikely that Appellees ever will try to make such a showing, other than to offer anecdotal evidence and conclusory arguments.²

Rather, class certification would create a toxic combination of fixed damages and large numbers of works that potentially exposes GBS to an award in the billions of dollars.³ The *amici* library associations are confident that Google ultimately will prevail on its fair use defense in this case, just as HathiTrust did on summary judgment with The Authors Guild and other individual plaintiffs concerning the Google-assisted mass digitization project. *See Authors Guild, Inc. v. HathiTrust*, No. 11 CV 6351, 2012 WL 4808939 (S.D.N.Y. Oct. 10, 2012). But there is a real concern that infringement liability, however remote a possibility, will give rise to a massive damage award that will harm the public interest. Such an award could force the shutdown of parts or all of GBS, significantly limit the

² Appellees' motion for summary judgment submitted to the District Court made no attempt to quantify the market harm suffered under the fourth fair use factor, or to explain how or why \$750 per book appropriately compensates their supposed losses. *See* Mem. of Law in Supp. of Pl.'s Mot. for Partial Summ. J. 41-47, ECF No. 1050.

³ Exposure still reaches into the billions of dollars if Google is found to be an innocent infringer and the court reduces statutory damages for works in suit to \$200. *See* 17 U.S.C. § 504(c)(2).

works available in the database and thereby reduce its usefulness, or restrict access to members of the public including researchers, scholars, students, and libraries who depend on GBS. None of these outcomes would benefit the public. In a case where a majority of authors appear to approve of GBS, it is manifestly unfair to give the few representative plaintiffs here such leverage.

C. Class Certification Would Have a Chilling Effect on Future Mass Digitization Efforts

Class certification has implications beyond this case. It would create a precedent for certifying classes of plaintiffs in other similar situations. That particularly affects libraries and universities that may be contemplating large-scale digitization projects. These institutions lack the resources to litigate complex class action lawsuits and defend against massive damages claims, and they will be disinclined to engage in socially beneficial digitization efforts even where they have strong fair use justifications. Class certification would, in essence put the brakes on future mass digitization initiatives and technological innovations, no matter how much the public may benefit from them.

II. THIS CASE PRESENTS NO COMMON ISSUE OF LAW OR FACT

Precisely because class actions have potentially far-reaching consequences for litigants and the public interest, the Federal Rules of Civil Procedure limit the ability of parties to obtain class status. One of these limitations is that there must

be issues of law or fact common to the class. Fed. R. Civ. P. 23(a)(2). No common issues are presented here.

A. Common Issues Must Be Capable of Generating Answers that Drive the Resolution of the Litigation

Class actions are an exception to the usual rule that litigation is conducted by and on behalf of the individual named parties only. *Califano v. Yamasaki*, 442 U.S. 682, 700-01 (1979). To justify a departure from that rule, the Federal Rules of Civil Procedure require a plaintiff to establish four requirements before a class can be certified. Fed. R. Civ. P. 23(a). Our brief focuses on one of these requirements – commonality. *See id.* 23(a)(2) (allowing a member of a class to sue as a representative party on behalf of all members only if there are “questions of law or fact common to the class”).

Until recently, the commonality requirement was easily satisfied. That changed a little more than a year ago with *Wal-Mart Stores v. Dukes*. In *Wal-Mart*, the Supreme Court reversed the certification of a nationwide class of 1.5 million female employees against whom Wal-Mart allegedly discriminated in violation of Title VII of the Civil Rights Act of 1964. The Court held that there was no question of law or fact common to the class, and in so ruling, articulated a more stringent commonality standard. The commonality requirement, the Court noted, is easy to misread, as any competently crafted class complaint literally raises common questions. *Wal-Mart Stores*, 131 S. Ct. at 2551. The lawsuit must

depend on a common contention that is capable of classwide resolution, meaning that determination of its truth or falsity will resolve an issue that is “central to the validity of each one of the claims in one stroke.” *Id.* The Court concluded that what matters is not the ability of the plaintiff to raise common questions, even in droves, but rather “the capacity of a classwide proceeding to generate common answers apt to drive the resolution of the litigation.” *Id.* (quoting Richard Nagareda, *Class Certification in the Age of Aggregate Proof*, 84 N.Y.U. L. Rev. 97, 131-32 (2009)). That is the standard that governs here.

B. There Are No Common Issues under *Wal-Mart*

The District Court found that this case presents two common questions: whether Google’s actions constitute an infringement of the class members’ copyright interests, and whether Google’s use of snippets of these works constitutes fair use. *Authors Guild v. Google, Inc.*, 282 F.R.D. 384, 394 (S.D.N.Y. 2012). Neither is common to the class.

1. Fair Use Is Not a Common Issue under Rule 23(a)(2)

Fair use, the District Court noted, is Google’s principal defense in this litigation. *Id.* at 387. Fair use is one of the First Amendment safeguards built into the Copyright Act, *Eldred v. Ashcroft*, 537 U.S. 186, 219-20 (2002), and there is a strong policy interest in maintaining the doctrine’s vitality across a variety of

factual situations. Congress accordingly wrote Section 107 of the Copyright Act to require a particularized inquiry into the facts of each work and its usage.

A court determines whether the use made “of a work in any particular case” is fair. 17 U.S.C. § 107. It does so by considering four (and other, if appropriate) factors. Three of these factors involve facts unique to the work and the usage. The second fair use factor examines the nature of each copyrighted work in suit, such as whether the work is creative or informational, or in-print or out-of-print. The third factor considers the relative amount and substantiality of the copyrighted work used. The fourth factor considers the economic effect on the market for or value of the copyrighted work, for example whether the use negatively impacts or benefits the economic prospects for the work – again, an inquiry into facts particular to the work. Google’s opening brief details the ways in which the second, third, and fourth factors present predominant individual issues, and those arguments need not be repeated here. *See* Br. for Appellant 29-35. Suffice it to say, none of the three factors present common issues among class members.

Google has acknowledged that the first fair use factor – the purpose and character of the use – could be resolved on a classwide basis. Def.’s Opp’n to Mot. for Class Certification 18, ECF No. 1000. The first factor does not satisfy the *Wal-Mart* commonality standard, however. The Copyright Act requires *all* four factors to be considered together in determining whether the use made of a work in any

particular case is fair. No single fair use factor may be considered in a vacuum. A factor must be considered and weighed together with the other factors in the same analysis. *Campbell*, 501 U.S. at 578 (“Nor may the four statutory factors be treated in isolation, one from another. All are to be explored, and the results weighed together, in light of the purposes of copyright.”). A single fair use factor viewed in isolation, even if it could be decided on a classwide basis, has no independent significance and will not generate common *answers* to the question of fair use.

A recent district court decision is instructive on how a multifactor analysis that contains factors capable of classwide resolution nevertheless fails to satisfy the commonality requirement of Rule 23(a)(2). In *FPX v. Google*, a trademark infringement lawsuit against Google, the court found no common issues and denied plaintiffs’ motion for class certification. *FPX, LLC v. Google, Inc.*, 276 F.R.D. 543, 549-50 (E.D. Tex. 2011). There, the plaintiffs alleged that Google infringed their trademarks by selling keywords containing their marks to third parties, so that when an internet user searches for the trademark owner’s mark using Google’s search engine, a competitor’s advertisement appears next to the search results. The plaintiffs’ burden was to prove that Google’s use is likely to cause initial interest confusion, based on a weighing of seven nonexclusive factors.

Two of those factors conceivably could be decided on a classwide basis.⁴ The district court concluded that, even if Google's policy resulted in initial interest confusion with regard to FPX's trademark, that did not necessarily mean Google's policy would result in confusion with regard to the other class members' marks. *Id.* at 550. For that reason, plaintiffs' common contention that Google's policy of selling trademarks as keywords leads to initial interest confusion was not capable of classwide resolution and did not satisfy the commonality requirement. *Id.* The same reasoning should apply here. Even though the purpose and character of use factor can be resolved classwide, the fair use analysis is not necessarily the same for all class members.⁵

2. Whether Google Is Liable Fails to Satisfy the Commonality Requirement

The one other common issue identified by the District Court – whether Google's actions infringe the class members' copyrights – merely states the

⁴ The likelihood of confusion analysis considers (1) the type of trademark allegedly infringed, (2) the similarity between the two marks, (3) the similarity of the products or services, (4) the identity of the retail outlets and purchasers, (5) the identity of the advertising media used, (6) the defendant's intent, and (7) any evidence of actual confusion. *Id.* at 549. Factors 5 and 6 are potentially capable of classwide resolution.

⁵ Of course, if the District Court were to find that the entire GBS project is legitimate based on the transformative purpose and character of the use, then it could find fair use without having to consider each individual work. *See, e.g., HathiTrust*, 2012 WL 4808939, at *8-14. But if, as Google notes in its opening brief, the District Court were to reject the contention that the entire GBS project is fair use, Google is entitled to present, and the Court must consider, a fair use defense as to uses of individual works. Br. for Appellant 2.

ultimate question of whether the defendant is liable as a matter of law. Under the Copyright Act, a defendant is liable if it infringed the plaintiff's copyrights. 17 U.S.C. § 501(a). Defining the issue at this highest level of generality renders the common issue requirement meaningless. Commonality would always be satisfied because in every case the issue is whether the defendant is liable. The Supreme Court recognized that such formulations are not sufficient when it ruled that commonality does not mean merely that the class members all suffered a violation of the same provision of law. *Wal-Mart Stores*, 131 S. Ct. at 2551.

3. There Are No Other Common Questions of Law or Fact

In their opening brief with the District Court requesting class certification, Appellees listed what they saw as the common issues in the case. In addition to fair use and whether Google's actions constitute copyright infringement, Appellees suggested as common issues: (1) "[w]hether Google digitized Books, distributed copies of Books to libraries, and publicly displayed content from Books on its commercial website without authorization from the copyright owners as part of its Library Project"; (2) "[w]hether Google's actions are ongoing, such that injunctive relief is appropriate"; and (3) "[w]hether members of the Class are entitled to

statutory damages.”⁶ Mem. of Law in Supp. of Pl.’s Mot. for Class Certification 10, ECF No. 990. None satisfies Rule 23(a)(2).

The first of these questions – what actions Google took – is not in dispute. Google digitized copyrighted works, gave copies to libraries, and publicly displayed snippets online. Undisputed facts like these do not generate common answers that are apt to drive the resolution of the litigation. *See Wal-Mart Stores*, 131 S. Ct. at 2551.

The second and third questions go to the remedies available if liability is found, not the merits of the underlying claims. Again, these do not generate common answers that drive resolution of the case. *See id.*

All three questions are of the same type that the Supreme Court rejected as not satisfying commonality in *Wal-Mart*: “Do all of us plaintiffs indeed work for Wal-Mart? Do our managers have discretion over pay? Is that an unlawful employment practice? What remedies should we get?” *Id.* While certainly these are questions, none of them are questions of law or fact that are relevant to the

⁶ Appellees slightly recast these issues in their reply brief to the District Court: (1) “[d]oes Google scan in-copyright books in their entirety in its Library Project, distribute entire digital copies of such books to libraries, and/or display verbatim expression from such books on its search website, all without copyright owner permission?”; (2) “[s]hould statutory damages of \$750 per book be assessed?; and (3) “[w]hat injunctive and equitable relief is appropriate to address Google’s conduct?” Reply Mem. of Law in Supp. of Pl.’s Mot. for Class Certification 13, ECF No. 1008.

commonality inquiry, and merely reciting them is not sufficient to obtain class certification. *See id.*

III. USING SUBCLASSES TO DETERMINE FAIR USE IS AN UNWORKABLE SOLUTION TO THE PROBLEMS INHERENT IN LITIGATING THIS DISPUTE AS A CLASS ACTION

In the portion of its opinion addressing the predominance requirement of Rule 23(b)(3), the District Court noted that the question of fair use could be determined on a “sub-class-wide basis.” In particular, “[t]he court would determine whether the defense applies to a particular type of book, obviating the need to evaluate each book individually.” *Google*, 282 F.R.D. at 395. The District Court’s suggestion is telling: it indicates there are issues that are not capable of classwide resolution and that require individualized attention. Regardless, creating subclasses to decide fair use is not feasible, and it would not resolve the lack of commonality under Rule 23(a)(2) or predominance under Rule 23(b)(3).

The District Court did not explain how it would employ subclasses in its fair use analysis. Even if using subclasses were appropriate, the Court would have to construct a multiplicity of groupings to account for the different types of works, the relative amounts used, and the economic effects of the usages. Take, for example, the second fair use factor. The District Court found that it could create subclasses of owners of fiction, nonfiction, poetry, cookbooks, photographs, and illustrations. *Google*, 282 F.R.D. at 390. More groupings would be necessary,

because the second factor involves additional considerations like whether works are in print or out of print. *See Maxtone-Graham v. Burtchaell*, 631 F. Supp. 1432, 1438 (S.D.N.Y. 1986); S. Rep. No. 94-473, at 64 (1975) (“whether or not the work is available to the potential user” is a “key, though not necessarily determinative, factor in fair use.”). Thus, the District Court would have to create at least **twelve** subclasses (*i.e.*, one for in-print works of fiction, one for out-of-print works of fiction, one for in-print works of nonfiction, etc.).

That number is conservative. Distinctions can be drawn between books published inside and outside the U.S. – the latter being more amenable to fair use because of their unavailability in this country. And there are many more genres of works than just the six the District Court identified – perhaps dozens – each requiring its own distinct analysis under the second factor. All works of nonfiction cannot be lumped together into one group as the District Court suggested, given the enormous variation in content, audience, and pricing. Nonfiction trade books, such as popular biographies and histories, differ markedly in nature from professional works like legal, medical, and engineering writings, which in turn are distinct from academic works like textbooks and monographs. Likewise, works of fiction cannot be fairly considered in one subclass given their enormous literary range – romance, mystery, humor, historical fiction, science fiction, children’s and young adult literature, to name a few.

The third and fourth factors would require subclasses as well – a point that the District Court neglected to address. The third fair use factor considers the relative amount of the portion used (a *quantitative* measure) and the substantiality of the portion used (a *qualitative* measure). The Court would have to construct at least **nine** subgroups to analyze whether the display of book snippets is fair use: one subgroup for works where a small quantitative amount and a small qualitative amount was displayed, another for works with a small quantitative and intermediate qualitative taking, another for works with a small quantitative and large qualitative taking, and so on. These nine subgroups are not the end of the story. Given the tens of millions of volumes scanned into Google’s database, it is conceivable that many works were never, or rarely, accessed by or displayed to the public. In such circumstances, the mere reproduction of copies into the database is *de minimis* and not subject to copyright liability, or at the very least weighs the third factor strongly in favor of fair use. *See Cambridge Univ. Press v. Becker*, 863 F. Supp. 2d 1190, 1245-46, 1248, 1251, 1252, 1253, 1265, 1298-99, 1314, 1337 (N.D. Ga. 2012) (finding infringement of copyrighted works *de minimis* and not giving rise to liability when digital copies uploaded to a university electronic reserves system were accessed only a few times, likely by a staff librarian, professors, or counsel for the parties). Thus, additional subgroups are required for

works whose snippets GBS users viewed frequently, moderately, infrequently, or not at all.

The fourth fair use factor would require multiple subclasses as well. Whether a work suffered economic harm or enjoyed economic benefits by inclusion in GBS turns on a host of unique factual considerations, including the availability of the work, its prior licensing (if any) in the marketplace, the economic interests of the author, and the channels of trade in which it typically is sold. For example, trade, professional, and educational and academic books are sold in different channels, each with its own economic characteristics relevant to a market harm analysis. It is not clear that any arrangement of subclasses could account for all of the necessary considerations. But even assuming subclasses could accommodate analysis of the fourth factor, at a minimum **three** subclasses would be required: one for works that suffer economic harm from the use, one for works that benefit economically from the use, and one for works where the harms and benefits are neutral. These broad categories, of course, ignore facts crucial to the analysis.

After devising subclasses, the District Court would then have to combine them, factor by factor, in order to assess fair use. Using just the limited number of

subclasses given above⁷ yields 324 separate combinations. In effect, the court or a jury tasked with determining fair use would have to conduct at least 324 distinct fair use mini-trials. That number will be much higher, likely in the thousands, when the additional necessary subgroups discussed above are taken into account.

The large number of subclasses and subclass combinations call into doubt the District Court's conclusion that there is no need to evaluate each individual work. To conduct the analysis by subclass, each of the millions of copyrighted works in dispute would have to be identified and examined – first, to determine if they are owned by class members and subject to the lawsuit, and for those that are, then to slot each work, one-by-one into the subgroup that best describes it. The District Court failed to recognize this when it concluded, without analysis, that it could determine whether the defense applies to a particular type of book without the need to evaluate each book individually. *Google*, 282 F.R.D. at 395. Each book *would* have to be evaluated, by the court or a jury, in a painstaking, time-consuming, and likely error-prone and dispute-ridden process.

The hundreds, if not thousands, of separate fair use analyses required in a class action of this magnitude, and the necessity of examining each work in suit, confirm that fair use is not a common issue capable of classwide resolution and

⁷ That is, twelve subclasses for factor two, nine subclasses for factor three, and three subclasses for factor four.

that Appellees cannot satisfy the predominance requirement.⁸ Indeed, use of subclasses may be wholly inappropriate because it runs contrary to the well-established method of considering fair use on a case-by-case basis. *See Campbell*, 501 U.S. at 578. The better approach is to revert to the traditional rule applicable to civil litigation in this country and embodied in Rule 23(a) – requiring an individual named party that believes it was injured to assert claims and prove them in court.

IV. CLASS CERTIFICATION WOULD MAKE IT VIRTUALLY IMPOSSIBLE TO CRAFT AN INJUNCTIVE REMEDY

In addition to damages, Appellees seek injunctive relief. If the class is certified and GBS found infringing, implementing an injunction would be incredibly burdensome if not impossible for the District Court.

⁸ This is not to say the fair use analysis can never be conducted when multiple plaintiffs or works are at issue. Courts outside of the class action setting have appropriately decided fair use in such circumstances. *See, e.g., HathiTrust*, 2012 WL 4808939, at *8-14; *Cambridge Univ. Press*, 863 F. Supp. 2d 1190. The *HathiTrust* and *Cambridge University Press* courts considered far fewer copyrighted works than at issue here, and each assessed fair use with respect to the works in its own case rather than the works at issue in millions of cases that a class action effectively would combine. Class actions are not designed, as a matter of law or practicality, to assess fair use on the vast scale as Appellees propose. Moreover, *HathiTrust* and *Cambridge University Press* concluded that the digitization projects at issue in those cases were entirely justified. In such circumstances, a court need not consider each work allegedly infringed. But if the District Court were to reject the contention that the entire GBS project is fair use, the Court is required to consider a fair use defense for each work in dispute. *See Br. for Appellant 2*. A class action is not suited for that undertaking.

Ownership of a valid copyright is an element of a copyright infringement claim. 17 U.S.C. § 501(b). If liability were established, it would be unreasonable and inequitable to bar GBS from using works that are owned by non-class members, especially given the significant adverse impact on the public of such a broad injunction. Any injunction would have to be limited to works that are owned by class members. *See Chicago Bd. of Educ. v. Substance, Inc.*, 354 F.3d 624, 632 (7th Cir. 2003) (vacating as overbroad an injunction that was not limited to the secure tests owned by the plaintiff). But sorting out the works subject to an injunction from those that are not would present immense challenges. Just as with the fair use analysis, it would require examining each individual work – a difficult if not impossible task given the millions of works at issue.

Contrary to the District Court’s suggestion, *see Google*, 282 F.R.D. at 390, comprehensive copyright ownership information is not publicly available. While timely-filed copyright registrations provide *prima facie* evidence of copyright ownership, 17 U.S.C. § 410(c), they are not conclusive. The Copyright Office does not independently verify the information submitted in a registration application. *See* H.R. Rep. No. 94-1476, at 157 (1976) (“It is true that, unlike a patent claim, a claim to copyright is not examined for basic validity before a certificate is issued.”). Nor is there a requirement that transfers or licenses of copyright be recorded with the Copyright Office, making a registration certificate,

at best, a snapshot of who owned the copyright at the moment the application was filed. There is a significant risk that a registration certificate contains ownership information that is inaccurate, out-of-date, or false, and for that reason the Copyright Act entitles a defendant to rebut the presumption that attaches to a timely-filed registration. Once a defendant effectively challenges the validity of the copyright, the burden shifts back to the plaintiff to prove it. *Id.*

Google is entitled to defend itself, and it would be entitled to discovery of *each* class member to determine if he or she owns a valid interest. Establishing ownership will prove difficult in a class of this size. Copyright ownership may have been transferred from a class member to a non-class member, or the copyright may be owned by a non-class member as a work made for hire. Where evidence of ownership is missing – as it invariably will be with such a large number of works – it cannot be presumed. *See Cambridge Univ. Press*, 863 F. Supp. 2d at 1221-23 (district court refused to find that works were joint works co-owned by plaintiff where there was no evidence of collaboration and no evidence of mutual intent to create a joint work, and refused to presume that missing contracts existed or that missing contracts would contain particular provisions assigning rights to the plaintiff).

A class action would open the door to burdensome litigation into ownership issues specific to each class member and would require the District Court to

adjudicate ownership disputes, as Google aptly puts it, in a series of book-by-book mini-trials. Br. for Appellant 3. Just as with analyzing fair use, a class action of this scale is not suited for crafting injunctive remedies.

CONCLUSION

Google Book Search is a valuable resource for researchers, scholars, libraries, and authors, and it makes vast amounts of information and learning far more accessible to the public than ever before possible. The public has a strong interest in having continued access to GBS – an interest that class certification endangers. Class certification is not appropriate as legal, practical, or policy matter, and the decision of the District Court should be reversed.

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Respectfully submitted,

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I hereby certify that on this 16th day of November, 2012:

1. This brief complies with the type-volume limitation of Federal Rule of Appellate Procedure 32(a)(7)(B) because the brief contains 6,093 words, excluding the parts of the brief exempted by Federal Rule of Appellate Procedure 32(a)(7)(B)(iii); and

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/s/ Stefan M. Mentzer

STEFAN M. MENTZER

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I hereby certify that on this 16th day of November, 2012, I caused a PDF version of the foregoing brief to be filed electronically using the CM/ECF system. Prior to transmittal, the PDF was scanned for viruses and no viruses were detected.

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I hereby certify that on this 16th day of November, 2012, I caused the foregoing brief to be filed electronically using the CM/ECF system, which will send notification of such filing to counsel of record.

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