

UNITED STATES DISTRICT COURT
DISTRICT OF MINNESOTA

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AMERICAN INSTITUTE OF PHYSICS,	:	
AND JOHN WILEY & SONS, INC.,	:	
	:	
Plaintiffs,	:	
	:	
-against-	:	12 Civ. 528 (RHK-JJK)
	:	
SCHWEGMAN, LUNDBERG & WOESSNER,	:	
P.A. AND JOHN DOE NOS. 1-10,	:	
	:	
Defendants.	:	

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MEMORANDUM OF PLAINTIFFS
FOR LEAVE TO FILE AN AMENDED COMPLAINT

Plaintiffs American Institute of Physics (“AIP”) and John Wiley & Sons, Inc. (“Wiley”) respectfully submit this memorandum, in support of their motion pursuant to Rule 15(a) of the Federal Rules of Civil Procedure for leave to file an amended complaint. The proposed amended complaint withdraws from Plaintiffs’ copyright infringement claim any allegation that Plaintiffs are entitled to relief based upon defendants (i) making such copies of a copyrighted work for submission to the United States Patent and Trademark Office (“PTO”) as may be required by the rules and regulations of the PTO, (ii) transmitting such copies to the PTO, or (iii) making an archival copy of that work transmitted to the PTO for Defendants’ internal file to document what has been transmitted. The amended

complaint does not expand Plaintiffs' claim, except to add additional copyrights to Schedule A, and to add as an additional Plaintiff an affiliate of Wiley which owns one copyright.

Preliminary Statement

Plaintiffs filed their complaint on February 29, 2012, alleging that Defendants had engaged in acts of copyright infringement by making copies of Plaintiffs' copyrighted articles in connection with their law practice. Defendants moved to dismiss the complaint, and the Court denied that motion by order entered July 2, 2012.

The same day, the PTO filed a motion to intervene as a Defendant and Ccounterclaimant. The PTO, among other things, demanded:

“A. That the court declare, pursuant to 17 U.S.C § 107 and 28 U.S.C. § 2201, that the copying of copyrighted [Non-Patent Literature (“NPL”)] and distribution thereof, which copying and/or distribution is necessary and incidental to the filing and prosecution of a U.S. patent application and/or the conduct of other [PTO] proceedings concerning or relating to the scope or validity of any issued U.S. Patent, including copies of NPL actually submitted to the [PTO] and copies of NPL initially considered but ultimately rejected for inclusion in submission to the [PTO], by or at the direction of Patent applicants, patentees, patent challengers, and/or their representatives, such as defendant Schwegman, constitutes a fair use of such copyrighted works under 17 U.S.C. § 107, and therefore is not an infringement of copyright.”

The Court granted the PTO's motion to intervene on July 11, 2012.

Plaintiffs now seek to file an amended complaint that continues to allege that Defendants have engaged in unauthorized copying in connection with their internal

research, but does not allege that this unauthorized copying includes (i) making such copies of a copyrighted work for submission to the PTO as may be required by the rules and regulations of the PTO, (ii) transmitting such copies to the PTO, or (iii) making an archival copy of that work transmitted to the PTO for Defendants' internal file to document what has been transmitted. To be clear, however, such submissions to the PTO may be evidence of broader use and circulation, which would be relevant to these proceedings.

Argument

Rule 15(a)(2) of the Federal Rules of Civil Procedure provides "In all other cases, a party may amend its pleading only with the opposing party's written consent or the court's leave. The Court should freely give leave when justice so requires."

Here, justice should require granting Plaintiffs leave to file the proposed amended complaint. No party would suffer any prejudice as a result of allowing the filing of the proposed amended complaint. Plaintiffs and Defendants have each served a set of interrogatories and discovery requests. The PTO has not served or responded to any discovery, beyond a voluntary disclosure. The proposed amended complaint does not expand the complaint except to add additional copyrights to Schedule A, and to add as an additional Plaintiff an affiliate of Wiley which owns one copyright.

Plaintiffs' application is timely. The Joint Pretrial Plan specifically provided that Plaintiffs would have until September 15, 2012, to move to add additional copyrights in an amended complaint.

Conclusion

For the reasons set forth above, Plaintiffs respectfully request that the Court grant them leave to file an amended complaint.

Dated: September 14, 2012

Respectfully submitted,

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UNITED STATES DISTRICT COURT
DISTRICT OF MINNESOTA

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AMERICAN INSTITUTE OF PHYSICS, :
WILEY PERIODICALS, INC. AND :
JOHN WILEY & SONS, INC., :

Plaintiffs, :

-against- : 12 Civ. 528 (RHK-JJK)

SCHWEGMAN, LUNDBERG & WOESSNER, :
P.A. AND JOHN DOE NOS. 1-10, :

Defendants. :

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PLAINTIFFS' [PROPOSED] AMENDED COMPLAINT

Plaintiffs American Institute of Physics (“AIP”), Wiley Periodicals, Inc. and John Wiley & Sons, Inc., (collectively “Wiley”), for their amended complaint against Defendants Schwegman, Lundberg & Woessner, P.A. (“Schwegman”) and John Doe Nos. 1-10 (collectively “Defendants”), aver:

Nature of the Action

1. This is an action for copyright infringement. It arises from the unauthorized copying and/or distribution of Plaintiffs’ copyrighted works by a law firm, and its professionals, in connection with their scientific, technical and medical research on behalf of themselves and their clients, so that both may reap a profit (“Unauthorized Copying”). This amended complaint does not aver that the

Unauthorized Copying includes (i) making such copies of a copyrighted work for submission to the PTO as may be required by the rules and regulations of the PTO, (ii) transmitting such copies to the PTO, or (iii) making one archival copy of that work transmitted to the PTO for Defendants' internal file to document what has been transmitted.

Jurisdiction and Venue

2. This Court has subject matter jurisdiction over the claim in this action pursuant to 28 U.S.C. §§ 1331 and 1338 because it arises under the Copyright Act, 17 U.S.C. § 101 et seq.

3. Venue is proper in this Court under 28 U.S.C. §§ 1391 and 1400.

Parties

4. AIP is a New York not-for-profit corporation with a place of business in Melville, New York.

5. Plaintiff John Wiley & Sons, Inc. is a New York corporation with its principal place of business in Hoboken, New Jersey. It is the indirect parent corporation of Plaintiff Wiley Periodicals, Inc., a Delaware corporation with its principal place of business in Hoboken, New Jersey.

6. Schwegman is a law firm with its principal place of business in Minneapolis, Minnesota .

7. Defendants John Doe Nos. 1-10 are partners, associates or other employees of Schwegman, whose identities are not currently known to Plaintiffs.

The Business of Plaintiffs

8. Plaintiffs publish many of the world's leading scientific, technology, and medical journals.

9. Plaintiffs' journals consist primarily of peer-reviewed articles, written by one or more scholars, often based upon original research.

10. Plaintiffs invest heavily in publishing their journals. Plaintiffs incur substantial costs for copyediting, proofreading, typesetting, printing, binding, distributing, and marketing their journals, as well as administering the peer-review process that is integral to the publication of those works and the progress of science.

11. Each Plaintiff ordinarily requires its authors to assign or exclusively license to it the copyright in each article accepted for publication in one of its journals. This practice enables each Plaintiff to maximize the dissemination of each work. Plaintiffs routinely register their copyrights in their journals published in the United States.

12. Plaintiffs earn a substantial portion of their revenue from the publication of their copyrighted journals both through (a) the sale of subscriptions to, and individual issues of, those journals, and (b) the licensing of the rights that

the copyright law provides with respect to the content of those journals. Consistent with the purpose of Article 1, Section 8, Clause 8, of the Constitution of the United States, this revenue provides an incentive for creative expression. Plaintiffs would suffer serious financial injury if the copyrights in those journals were not enforced. A substantial decline in their income could cause Plaintiffs to cease publishing one or more deserving journals. This would adversely impact the creation of new works, scholarly endeavor and, ultimately, scientific progress.

The Unlawful Acts of Defendants

13. Schwegman is engaged in the practice of law. According to its website, Schwegman “specializes in strategic patent portfolio planning and management, infringement, validity and clearance investigations, opinions and all phases of intellectual property prosecution practice.” Among other things, Schwegman files and prosecutes United States patent applications on behalf of its clients. In addition to practicing patent law, Schwegman holds itself out as practicing copyright law.

14. Upon information and belief, Defendants have engaged in Unauthorized Copying with respect to the copyrighted articles from Plaintiffs’ journals, including but not limited to the articles identified on Schedule A.

15. Plaintiffs cannot know the full extent of Defendants’ Unauthorized Copying without discovery.

16. This Unauthorized Copying is for the commercial benefit of Defendants and their clients.

CLAIM FOR RELIEF
(Copyright Infringement – 17 U.S.C. § 501)

17. Plaintiffs repeat the averments contained in paragraphs 1 through 16 as if set forth in full.

18. Plaintiffs either own the copyrights in the articles contained in the journals they publish or, alternatively, exclusively license those copyrights (“Plaintiffs’ Copyrights”).

19. Defendants have infringed certain of the Plaintiffs’ Copyrights, including, but not limited to, the copyrights in the articles listed on Schedule A by engaging in Unauthorized Copying.

20. This Unauthorized Copying for the for-profit business purposes of Defendants is not privileged under the law.

21. Defendants are conducting research for the profit of themselves and their clients and are engaging in Unauthorized Copying of Plaintiffs’ Copyrights as part of that profit-making activity without due compensation to Plaintiffs. Upon information and belief, Schwegman has charged its clients for that Unauthorized Copying and thereby made a direct profit as a result of its infringement.

22. The Unauthorized Copying has involved the copying of the copyrighted articles in their entirety.

23. Plaintiffs publish, sell and distribute journals and license the copyrighted content contained in them for precisely these types of use. Plaintiffs are ready, willing, and able to provide Defendants with licenses for their use either directly, or through their licensing agents. Nevertheless, Defendants have not acquired any of the licenses necessary to make their Unauthorized Copying lawful.

24. The Unauthorized Copying complained of herein has irreparably damaged and, unless enjoined, will continue to irreparably damage the Plaintiffs. Plaintiffs have no adequate remedy at law for the injury resulting from this Unauthorized Copying. Plaintiffs are, therefore, entitled to a preliminary and permanent injunction restraining and enjoining Defendants and their agents, servants, employees, attorneys, and all persons acting in concert with them, from engaging in Unauthorized Copying.

25. Defendants have willfully infringed the Plaintiffs' Copyrights.

26. Plaintiffs are entitled to recover damages sustained as a result of Defendants' Unauthorized Copying, including (1) Defendants' profits, or (2) Plaintiffs' damages, or alternatively, at Plaintiffs' election, (3) statutory damages.

WHEREFORE, Plaintiffs respectfully request that this Court enter judgment:

A. Preliminarily and permanently enjoining Defendants, their agents, servants, employees, attorneys, and all those acting in concert with them, from engaging in Unauthorized Copying;

B. Awarding Plaintiffs their damages or Defendants' profits, or alternatively, at Plaintiffs' election, statutory damages, as a result of Defendants' Unauthorized Copying;

C. Awarding Plaintiffs their costs and reasonable attorneys' fees in this action; and

D. Awarding Plaintiffs such further and further relief as the Court deems just and proper.

Dated: October __, 2012

Respectfully submitted,

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Schedule A

AIP

Dabbousi, B. O., et al., "Electroluminescence from CdSe quantum-dot/polymer composites," Applied Physics Letters, vol. 66, Issue 11, pp. 1316-1318 (1995), that is a subject of U.S. Certificate of Copyright Registration No. TX 4-805-681, registered on March 13, 1995.

Drndic, M., et al., "Transport properties of annealed CdSe colloidal nanocrystal solids," Journal of Applied Physics, vol. 92, Issue 12, pp. 7498-7503 (2002), that is a subject of U.S. Certificate of Copyright Registration No. TX 5-646-209, registered on January 10, 2003.

Fischbein, M. D., et al., "CdSe nanocrystal quantum-dot memory," Applied Physics Letters, vol. 86, Issue 19, pp. 193106-1 - 193106-3 (2005), that is a subject of U.S. Certificate of Copyright Registration No. TX 6-176-889, registered on June 3, 2005.

Gadisa, A., et al., "Correlation between oxidation potential and open-circuit voltage of composite solar cells based on blends of polythiophenes/fullerene derivative," Applied Physics Letters, vol. 84, Issue 9, pp. 1609-1611 (2004), that is a subject of U.S. Certificate of Copyright Registration No. TX 5-968-769, registered on March 1, 2004.

Ginger, D. S., et al., "Charge injection and transport in films of CdSe

nanocrystals,” *Journal of Applied Physics*, vol. 87, Issue 3, pp. 1361-1368 (2000), that is a subject of U.S. Certificate of Copyright Registration No. TX 5-051-290, registered on February 2, 2000.

Goncalves, B. M. S., et al., “Plasma potential profile determination by a new diagnostic based on neutral particle beam injection and laser induced fluorescence,” *Review of Scientific Instruments*, vol. 70, Issue 1, pp. 908-911 (1999), that is a subject of U.S. Certificate of Copyright Registration No. TX 4-828-254, registered on January 25, 1999.

Greczynski, G., et al., “Energy level alignment in organic-based three-layer structures studied by photoelectron spectroscopy,” *Journal of Applied Physics*, vol. 88, Issue 12, pp. 7187-7191 (2000), that is a subject of U.S. Certificate of Copyright Registration No. TX 5-220-064, registered on December 8, 2000.

Mattoussi, H., et al., “Electroluminescence from heterostructures of poly(phenylene vinylene) and inorganic CdSe nanocrystals,” *Journal of Applied Physics*, vol. 83, Issue 12, pp. 7965-7974 (1998), that is a subject of U.S. Certificate of Copyright Registration No. TX 4-725-348, registered on June 26, 1998.

McDonald, S., et al., “Photoconductivity from PbS- nanocrystal/semiconducting polymer composites for solution-processible, quantum-size tunable infrared photodetectors,” *Applied Physics Letters*, vol. 85, Issue 11, pp.

2089-2091 (2004), that is a subject of U.S. Certificate of Copyright Registration No. TX 6-053-544, registered on September 30, 2004.

Nguyen, T-Q., et al., "Improving the performance of conjugated polymer-based devices by control of interchain interactions and polymer film morphology," *Applied Physics Letters*, vol. 76, Issue 17, pp. 2454-2456 (2000), that is a subject of U.S. Certificate of Copyright Registration No. TX 5-087-556, registered on April 20, 2000.

Peumans, et al., "Small molecular weight organic thin-film photodetectors and solar cells," *Journal of Applied Physics*, vol. 93, Issue 7, pp. 3693-3723 (2003), that is a subject of U.S. Certificate of Copyright Registration No. TX 5-710-180, registered on April 17, 2003.

Rabeau, J. R., et al., "Diamond chemical-vapor deposition on optical fibers for fluorescence waveguiding," *Applied Physics Letters*, vol. 86, Issue 13, pp. 134104-1-134104-3 (2005), that is a subject of U.S. Certificate of Copyright Registration No. TX 6-157-537, registered on April 19, 2005.

Reneker, D. H., et al., "Bending instability of electrically charged liquid jets of polymer solutions in electrospinning," *Journal of Applied Physics*, vol. 87, Issue 9, pp. 4531-4547 (2000), that is a subject of U.S. Certificate of Copyright Registration No. TX 5-142-478, registered on July 12, 2000.

Solensten, L., et al., "Heavy ion beam probe energy analyzer for measurements of plasma potential fluctuations," *Review of Scientific Instruments*, vol. 58, Issue 4, pp. 516-519 (1987), that is a subject of U.S. Certificate of Copyright Registration No. TX 2-051-409, registered on May 1, 1987.

Solomeshch, O., et al., "Optoelectronic properties of polymer-nanocrystal composites active at near-infrared wavelengths," *Journal of Applied Physics*, vol. 98, Issue 7, pp. 074310-1-074310-6 (2005), that is a subject of U.S. Certificate of Copyright Registration No. TX 6-292-911, registered on December 2, 2005.

Ye, Z., et al., "InAs quantum dot infrared photodetectors with $\text{In}_{0.15}\text{Ga}_{0.85}\text{As}$ strain-relief cap layers," *Journal of Applied Physics*, vol. 92, Issue 12, pp. 7462-7468 (Dec. 15, 2002), that is a subject of U.S. Certificate of Copyright Registration No. TX 5-646-209, registered on January 10, 2003.

Wiley

Greenwald, Y., et al., "Polymer-polymer Rectifying Heterojunction Based on Poly(3,4-dicyanothiophene) and MEH-PPV," *Journal of Polymer Science: Part A: Polymer Chemistry*, vol. 36, Issue 17, pp. 3115-3120, (1998) that is a subject of U.S. Certificate of Copyright Registration No. TX 4-822-483, registered on January 8, 1999.

Wiley Periodicals, Inc.

Lee, Y. M., et al., "Synthesis and Swelling Characteristics of pH and Thermoresponsive Interpenetrating Polymer Network Hydrogel Composed of Poly(vinyl alcohol) and Poly(acrylic acid)," Journal of Applied Polymer Science, vol. 62, Issue 2, pp. 301-311 (1996), that is a subject of U.S. Certificate of Copyright Registration No. TX 4-390-638, registered on December 10, 1996.