

**APPEAL NO. 20-13627-C
UNITED STATES COURT OF APPEALS
FOR THE ELEVENTH CIRCUIT**

Yellow Pages Photos, Inc.,

Plaintiff-Appellant,

vs.

YP, LLC, d/b/a “The Real Yellow Pages” and Print Media, LLC,
d/b/a Print Media Solutions, LLC

Defendants-Appellees.

BRIEF OF APPELLANT, YELLOW PAGES PHOTOS, INC.

APPEAL FROM THE UNITED STATES LOWER COURT FOR THE
MIDDLE LOWER OF FLORIDA, LOWER COURT CASE
NO. 8:17-CV-764-CEH-JSS

Richard E. Fee
Kathleen M. Wade
Cristina A. Castellvi
FEE & JEFFRIES, P.A.
1227 N. Franklin Street
Tampa, Florida 33602
(813) 229-8008

*Counsel for Appellant,
Yellow Pages Photos, Inc*

**CERTIFICATE OF INTERESTED PERSONS AND
CORPORATE DISCLOSURE STATEMENT (CIP)**

Appellant, Yellow Pages Photos, Inc. pursuant to FRAP Rule 26.1 and 11th Cir. R. 26.1-1, certifies that the following persons and entities have an interest in the outcome of this case and/or appeal:

Castellvi, Cristina A.

Fee & Jeffries, P.A.

Fee, Richard E.

Hanes, Ronald P.

Honeywell, Judge Charlene

Huang, Kuangyan

Latham & Watkins, LLP

Leon, Eric F.

Luka, Philip Matthew

Mayfield Settlement Funding, LLC

Moore, William Trent

Print Media, LLC

Sneed, Magistrate Judge Julie

Taylor, Nathan E.

Trombley, Gary R.

Trombley & Hanes, P.A.

Wade, Kathleen M.

Yellow Pages Photos, Inc.

YP, LLC

In accordance with FRAP Rule 26.1, Appellant, Yellow Pages Photos, Inc. (“YPPI”) states there is no parent corporation or publicly held corporation that owns 10% or more of its stock.

STATEMENT REGARDING ORAL ARGUMENT

Appellant requests oral argument and believes such argument will assist the Court in ruling on the issues presented in this appeal.

TABLE OF CONTENTS

CERTIFICATE OF INTERESTED PERSONS	i
STATEMENT REGARDING ORAL ARGUMENT	ii
TABLE OF CONTENTS	iii
TABLE OF CITATIONS	vi
STATEMENT OF SUBJECT MATTER AND APPELLATE JURISDICTION	1
STATEMENT OF THE ISSUES	2
STATEMENT OF THE CASE	3
I. Course of Proceedings and Disposition in the Lower Court	3
II. Statement of Facts	6
A. Parties	6
1. Appellant YPPI	6
2. Appellees YP and Print Media	7
B. The Appellees' Asserted Licenses	8
1. The Berry License	8
2. The AT&T Services License	10
III. Standard of Review	15
SUMMARY OF THE ARGUMENT	16
ARGUMENT AND CITATIONS OF AUTHORITY	18

I. THE LOWER COURT ERRED IN GRANTING SUMMARY JUDGMENT IN FAVOR OF YP REGARDING THE BERRY LICENSE AND IN FAVOR OF BOTH APPELLEES REGARDING THE AT&T SERVICES LICENSE BY CONCLUDING THAT THE APPELLEES’ BREACHES OF CONDITIONS OF THOSE LICENSES DID NOT MAKE THEIR USE OF THE YPPI IMAGES COPYRIGHT INFRINGEMENT.....18

A. The Lower Court failed to consider federal copyright law which clearly holds Appellees’ use of the YPPI images constituted copyright infringement because such use exceeded the scope of the Asserted Licenses..18

B. Under federal copyright law, the Licenses’ provisions at issue are clearly “conditions” not “covenants”.22

C. Under Texas state contract law, the cited provisions of the AT&T Services License are “conditions” and not covenants.....25

II. THE LOWER COURT ERRED IN GRANTING APPELLEES’ MOTION FOR SUMMARY JUDGMENT IN THE FACE OF GENUINE ISSUES OF MATERIAL FACT.26

A. The Lower Court erred in granting summary judgment for YP based on its determination that YP’s use of the YPPI images was covered by the Berry License because genuine issues of material fact exist.....26

B. The Lower Court erred in granting summary judgment based on its finding that Appellees were licensed under the AT&T Services License despite the existence of genuine issues of material fact.30

1. The Lower Court erred in finding that the undisputed evidence shows that the AT&T Advertising, L.P. was the party to the AT&T Services License.....30

III. THE LOWER COURT ERRED IN GRANTING PRINT MEDIA’S SUPPLEMENTAL SJ MOTION BECAUSE GENUINE ISSUE OF MATERIAL FACT EXIST35

A. YPPI’s BBQ-A0120 Image.....37

B. YPPI’s CRA-A0110 Image.....38

C. YPPI’s CRA-A0117 Image.....39

D. YPPI’s GUT-A0116, SID-A0102, and SID-A0112 Images..40

E. YPPI’s HOM-C0146 Image42

F. YPPI’s SCE-A0141 Image.....44

CONCLUSION.....46

CERTIFICATE OF COMPLIANCE47

CERTIFICATE OF SERVICE47

TABLE OF CITATIONS

Cases

<i>Columbia Data Prods., Inc. v. Symantec Corp.</i> , 2008 U.S. Dist. LEXIS 13304, at *15-16 (M.D. Fla. Feb. 22, 2008)	22
<i>Criswell v. European Crossroads Shopping Ctr., Ltd.</i> , 792 S.W. 2d 945, 948 (Tex. 1990).....	25
<i>Eberhard Architects, LLC v. Bogart Architecture, Inc.</i> , 314 F.R.D. 567, 572 (N.D. Ohio April 22, 2016)	21
<i>Energy Intelligence Group Ltd. v. Bank of America, N.A.</i> , 2018 U.S. Dist. LEXIS 112068 (S.D. Tex. July 5, 2018)	21
<i>Energy Intelligence Group, Inc. v. Tudor, Pickering, Holt & Co., Sec., Inc.</i> , 2013 U.S. Dist. LEXIS 10660, at *7-8 (S.D. Tex. Jan. 28, 2013)	22
<i>Furcron v. Mail Ctrs. Plus, LLC</i> , 843 F.3d 1295, 1303, 1304 (11th Cir. 2016)	15, 30, 46
<i>Genesys Software Sys. v. Comerica Bank</i> , 2013 U.S. Dist. LEXIS 200010, at *6 (N.D. Tex. April 9, 2013)	21
<i>Hegel v. First Liberty Ins. Corp.</i> , 778 F.3d 1214, 1219 (11th Cir. 2015)	16
<i>Jacobsen v. Katzer</i> , 535 F.3d 1373, 1380-81, 1382 (Fed. Cir. 2008)	20, 22, 24
<i>McCoy v. Mitsuboshi Cutlery, Inc.</i> , 67 F. 3d 917, 920 (Fed. Cir. 1995)	16
<i>MDY Indus., LLC v. Blizzard Entm't, Inc.</i> , 629 F.3d 928, 1008 (9th Cir. 2010)	21, 22
<i>Pohl v. MH Sub I LLC</i> , 770 Fed. Appx. 482, 486 (11th Cir. 2019)	15, 29-30, 46
<i>S.O.S., Inc. v. Payday, Inc.</i> , 886 F.2d 1081, 1088 (9th Cir. 1989)	20

<i>Stross v. Redfin Corp.</i> , 730 Fed. Appx. 198, 203 (5th Cir. 2018)	20
<i>Tingley Sys. Inc. v. Healthlink, Inc.</i> , 509 F. Supp. 2d 1209, 1217 (M.D. Fla. May 8, 2007)	20
<i>Virtual Studios, Inc. v. Royalty Carpet Mills, Inc.</i> , 2014 WL 12495340, at *8 (N.D. Ga. Feb. 10, 2014)	21
<i>Womack+Hampton Architects, L.L.C. v. Metric Holdings Ltd. P’shp</i> , 102 Fed. Appx. 374, 381 (5th Cir. 2004)	25

Statutes

17 U.S.C. § 101	1
28 U.S.C. §1291	1
28 U.S.C. § 1331	1
28 U.S.C. § 1338.....	1

Other Authorities

11th Cir. R. 26.1-1	i, 47
<i>Nimmer on Copyright</i> , § 1015[A] (1999)	21, 24

STATEMENT OF SUBJECT MATTER
AND APPELLATE JURISDICTION

The Lower Court possessed subject-matter jurisdiction over this action pursuant to 28 U.S.C. §§ 1331 and 1338(a) because YPPI's claims against Appellees arise solely under the Copyright Act, 17 U.S.C. § 101 *et seq.*

This Court possesses jurisdiction over this action pursuant to 28 U.S.C. § 1291, because this appeal arises from a final decision from the Lower Court that disposed of all the parties' claims. Specifically, Final Judgment was entered in favor of Appellees on August 31, 2020 (Doc 236), pursuant to the Lower Court's November 27, 2019, order granting in part Appellees' Motion For Summary Judgment (Doc 196), and the Lower Court's June 19, 2020, order granting Appellee, Print Media, LLC's Supplemental Motion for Summary Judgment (Doc 235).

YPPI timely filed its Notice of Appeal on September 24, 2020 (Doc 241).

STATEMENT OF THE ISSUES

I. Whether the Lower Court erred in granting the Appellees' Motion for Summary Judgment by concluding that Appellees' use of Appellant's copyrighted images was not copyright infringement despite the Appellees' breach of conditions of the very licenses they asserted as defenses.

II. Whether the Lower Court erred in granting Appellees' Motion for Summary Judgment as to the asserted AT&T Services License where the record demonstrates the existence of genuine issues of material fact regarding the Appellees' ability to claim rights under that license.

III. Whether the Lower Court erred in granting Appellee Print Media LLC's Supplemental Motion for Summary Judgment where the record evidence shows that genuine issues of material fact exist as to whether Print Media's allegedly infringing advertisements are each a "renewal, reprint, or republication" of a prior advertisement published by Appellee YP.

STATEMENT OF THE CASE

I. Course of Proceedings and Disposition in the Lower Court

On March 31, 2017, YPPI filed its Complaint for direct copyright infringement against Appellee YP, LLC, d/b/a “The Real Yellow Pages” (“YP”). (Doc. 1). On October 5, 2017, YPPI filed its Amended Complaint, which included its direct copyright infringement claim against YP and a new claim for direct copyright infringement against added party, Appellee Print Media, LLC, d/b/a Print Media Solutions, LLC (“Print Media”). (Doc. 45). YPPI’s infringement claims arose from Appellees’ alleged prolific and continuing uses of YPPI’s copyrighted photographic images without authorization. (Doc. 45).

Appellees answered the Amended Complaint on October 19, 2017, and asserted affirmative defenses, including the defense of license, and a counterclaim. (Doc. 51). Count I of Appellees’ Counterclaim sought a declaratory judgment that they were permitted to use YPPI’s photographic images under a “Software License and Maintenance – Snap-Out Agreement . . . Between [YPPI] And *AT&T Services, Inc.*” (the “AT&T Services License”) (Doc. 51, Counterclaim at ¶¶1-23; Doc. 51-1, Ex. A) (Emphasis added). Appellees’ Counterclaim alleged that an entity named “AT&T Advertising, L.P.” (“AT&T Advertising”), not AT&T Services, actually entered into the AT&T Services License with YPPI and that, as a result of multiple corporate mergers and name changes, Appellees both became “affiliates” of a

company that succeeded to AT&T Advertising's rights under the License (Doc. 51, Counterclaim at ¶¶6, 11-17). Count II of Appellees' Counterclaim sought an award of reasonable attorneys' fees and costs. (Doc. 51, Counterclaim at ¶¶24-27).

YPPI's Answer to Appellees' Counterclaim denied that: (1) AT&T Advertising entered into the AT&T Services License; (2) YP Advertising & Publishing LLC had any rights under the AT&T Services License; (3) Appellees had any rights under the License, or any license, to use YPPI's images; and (4) Appellees had any right to an award of fees and costs. (Doc. 62 at ¶¶13, 15, 17, and 27).

On April 22, 2019, Appellees filed their Motion for Summary Judgment, arguing they were authorized to use all of YPPI's images under the AT&T Services License and also under a license between YPPI and L.M. Berry and Company (the "Berry License"). (Doc. 119). YPPI filed its Response in Opposition to Defendants' Motion for Summary Judgment on May 15, 2019. (Doc. 135). The parties filed a Stipulation of Agreed Material Facts on May 29, 2019. (Doc. 143). Appellees filed an unredacted version of their Motion for Summary Judgment on July 15, 2019. (Doc. 157)

On November 27, 2019, the Lower Court issued its Order, without oral argument, granting in part and denying in part Appellees' Motion for Summary Judgment (the "Summary Judgment Order"). (Doc. 196). The Lower Court's Summary Judgment Order directed the parties to inform the Lower Court whether:

(1) all of YPPI's images used by YP were covered by the AT&T Services License and the Berry License; and (2) all of YPPI's images used by Print Media were covered by the AT&T Services License. (Doc. 196).

On January 10, 2020, YPPI filed its Amended Notice in Response to the Court's Questions Set Forth in its Order Dated November 27, 2019. (Doc. 211). YPPI's Amended Notice informed the Lower Court that all of YPPI's images allegedly infringed by YP were licensed under the AT&T Services License, the Berry License, or both licenses and that ten (10) of YPPI's images allegedly infringed by Print Media were not licensed under the AT&T Service License.

During a January 22, 2020, status conference, the Lower Court granted Print Media's *ore tenus* motion for leave to file a supplemental motion for summary judgment regarding the ten (10) remaining YPPI images at issue. (Doc. 215). Print Media filed its Supplemental Motion for Summary Judgment on February 3, 2020 (the "Supplemental SJ Motion"). (Doc. 220). YPPI filed its Response in Opposition to Print Media's Supplemental SJ Motion on February 28, 2020. (Doc. 228).

On June 19, 2020, the Lower Court, again without oral argument, granted Print Media's Supplemental SJ Motion. (Doc. 235).

The Lower Court entered Final Judgment in favor of both Appellees on August 31, 2020. (Doc. 236).

YPPI timely filed its Notice of Appeal on September 24, 2020. (Doc. 241).

II. STATEMENT OF FACTS

All the facts set forth below are supported by Record citations and were present before the Lower Court.

A. The Parties

1. Appellant YPPI

YPPI's copyrights at issue derive from AdMedia Systems, Inc. ("AdMedia"), a Florida corporation under common ownership with YPPI. (Doc. 45 at ¶15). Both AdMedia and YPPI are owned by W. Trent Moore, the sole stockholder, officer, and director of both companies. (Doc. 45 at ¶15). Mr. Moore formed AdMedia to produce, own, and license copyrighted stock photographic images for use in creating, producing, and publishing advertisements, specifically including those used in telephone directories (the "YPPI Images"). (Doc. 45 at ¶16). Over the years, YPPI created and copyrighted over 5,000 photographic images, which are grouped into collections according to subject matter, such as "roofing", "homes", and "auto accidents". (Doc. 168 at p. 3).

On November 3, 2006: (a) AdMedia changed its name from "Yellow Pages Photos, Inc." to "AdMedia Systems, Inc."; (b) a new company, YPPI, was incorporated as "Yellow Pages Photos, Inc." to continue the then existing business of AdMedia, including business relating to the YPPI Images; and (c) AdMedia assigned to YPPI all of its right, title, and interest in and to the YPPI Images, and all

actions and causes of action for infringement of the copyrights in the YPPI Images (the “Assignment”). (Doc. 45 at ¶17). After the Assignment, YPPI assumed and continued the former business of AdMedia relating to the YPPI Images. (Doc. 45 at ¶18).

In early 2007, YPPI began registering the copyrights in the YPPI Images and received from the Register of Copyrights, registrations for the copyrights relating to the YPPI Images. (Doc. 45 at ¶19). Since November 3, 2006, YPPI has been, and continues to be, the owner of all right, title, and interest in and to all the YPPI Images, the copyrights in the YPPI Images, and, since their issuance, the registrations of the copyrights in the YPPI Images. (Doc. 45 at ¶20).

2. Appellees YP and Print Media

Appellees sell advertisements published in print and web-based yellow pages and white pages telephone directories and also create websites and internet “landing pages” for their customers. (Doc. 168 at p. 3). YPPI identified over 330 different YPPI Images used by Appellees, without authorization from YPPI, used in approximately 20,000 print and digital advertisements since April 1, 2014. (Doc. 135-1 at ¶¶4, 7). Appellees also used YPPI’s Images in websites and internet “landing pages” they created for their customers. (Doc. 168 at p. 3). Appellees alleged that all their uses of the YPPI Images were within the scope of the AT&T Services License and/or the Berry License. (Doc. 157 at p. 2).

B. The Appellees' Asserted Licenses

Long ago, YPPI and Ad Media licensed the YPPI Images to publishers of yellow pages directories. (Doc. 143 at ¶3). The only two licenses that Appellees argue give them the right to use YPPI Images are discussed below.

1. The Berry License

In June 2006, AdMedia entered into the Berry License, which licensed all 5,000 YPPI Images. (Doc. 143 at ¶4; Doc. 157 at p. 1; Doc. 157-2 at ¶6). Under the terms of the Berry License:

Licensee may create a digital library, network configuration, or similar arrangement across any number of Licensee's multiple locations and servers to allow the Digital Media to be used in Licensee's Business, but ***no more than 48 employees of Licensee*** may be involved in the process of creating modified images or templates.

(Doc. 157-2 at p. 2 of 9, ¶1.3) (Emphasis added). The "Licensee" of the Berry License is defined as "L.M. Berry and Company, and all affiliates owned or owning same." (Doc. 157-2, at p. 2 of 9, first sentence).

Under the Berry License, the Licensee may "have the Digital Media [the YPPI Images] ***reproduced*** by subcontractors of Licensee, ***provided that such subcontractors agree to abide by the restrictions of this Agreement.***" (Doc. 157-2 at p. 2 of 9, ¶1.2.2) (Emphasis added). The Berry License did not grant subcontractors or outsourcers the right to "use" the YPPI Images. (Doc. 157-2). Moreover, the Berry License expressly states that "Licensee may not sublicense,

assign, convey, or transfer any of its rights under this Agreement.” (Doc. 157-2 at p. 3 of 9, ¶1.4.1).

The Berry License provided for certain rights after its termination:

4. Termination and Revocation.

4.1 Nothing in this Agreement shall be construed to affect that Digital Media used in end-client’s applications (such as directory advertisements) prior to the termination of this Agreement; by way of example, the Digital Media used in the original advertisement may continue to be used in *renewals, republications or reprints* of the advertisement.

(Doc. 157-2, at p. 4 of 9, ¶4.1) (Emphasis added, plain bold in original).

On April 2, 2007, YPPI and L.M. Berry and Company amended the Berry License to increase the number of authorized users (also known as “seat licenses”) from 48 to 93. (Doc. 143 at ¶5). On April 23, 2008, The Berry Company, LLC, as “Assignor”, L.M. Berry and Company, as “Assignee”, and AdMedia Systems, Inc., as “Licensor”, entered into a Partial Assignment of Agreement and Consent (the “Partial Assignment Agreement”), under which The Berry Company LLC reassigned 45 seat licenses back to L.M. Berry and Company. (Doc. 143 at ¶6).

L.M Berry and Company was acquired by AT&T, Inc. in December of 2006. (Doc. 121 at ¶8). All of the rights YP and Print Media claim under the Berry License come only through AT&T, Inc. (Doc. 121 at ¶¶8-9).

2. The AT&T Services License

On December 12, 2007, YPPI entered into the AT&T Services License (Doc. 143 at ¶8), which is governed by Texas law. (Doc. 157-6 at p. 5 of 18).

In the case below, the parties disputed which AT&T entity was a party to the AT&T Services License. (Doc. 157 at pp. 2-3; Doc. 135 at pp. 8-9). “AT&T” is not defined in the AT&T Services License. (Doc. 157-6, at pp. 2-9 of 18). The License identifies the “AT&T: Affiliate Name” as “AT&T Services, Inc.” (Doc. 157-6, at p. 3 of 18). The License also identifies “AT&T Services, Inc.” as the entity to “Refer Questions To:” (Doc. 157-6, at p. 3 of 18). Yet, the License also states: “Send Invoices To:” an entity called “AT&T Advertising, L.P. d/b/a AT&T Advertising and Publishing.” (Doc. 157-6, at p. 3 of 18). The signature block at the end of the AT&T Services License states:

AT&T Affiliate Name: AT&T Services, Inc.
On behalf of AT&T Advertising, L.P. dba
AT&T Advertising & Publishing
Denise O. Davis

(Doc. 157-6 at p. 4 of 18).

Appellees do not claim that they are a “subsidiary” or “affiliate” of AT&T Services, Inc., or AT&T Inc. Rather, Appellees argued below, and the Lower Court found, that their rights derive through AT&T Advertising (Doc. 119 at pp. 2, 15–21; Doc. 196 at pp. 26–27).

The AT&T Services License granted a license to:

copy the [YPPI Images] on to AT&T's server for unlimited End Users; (ii) use the [YPPI Images] *in AT&T's business locations and for AT&T's business purposes only*...; (iii) make copies of the [YPPI Images] for archive or backup purposes.

(Doc. 157-6 at p. 3 of 18) (Emphasis added). 2,150 out of 5,000 YPPI Images were licensed in the AT&T Services License, which also “extended” an existing 500-user license for many of the same YPPI Images. (Doc. 157-6 at p. 3 of 18; Doc. 135-5 at p. 100, line 2 through p. 102, line 5).

Rights under the AT&T Services License were expressly conditioned on the Licensee including a special copyright notice and allowed the Licensee to:

incorporate any [YPPI Image] into its own original work and publish, display and distribute the work in any media *provided that a copyright notice is included in any electronic or digital work reflecting on the copyright ownership of both AT&T and Licensor as follows: “Copyright ©20__ [AT&T] and its licensors. All rights reserved.”*

(Doc. 157-6 at p. 3 of 18) (Emphasis added). AT&T's internal communications expressly noted this copyright notice requirement and its desire to eliminate the notice requirement in a later proposed amendment, which YPPI rejected. (Doc. 135-5 at p. 215, lines 20-25, p. 216, lines 1-18; Doc. 135-5 at pp. 17-18 of 18).

Appellees' advertisements and directories including the YPPI Images did not include the copyright notice required by the AT&T Services License. (Doc. 135-7 at pp. 2-26). Appellees did not argue in the case below that they used the required copyright notice.

The AT&T Services License contains the following conflicting provisions:

- “**Description:** The seat license applies to AT&T *and its subsidiaries.*”
- “Licensor License Grant - ..., Licensor grants to AT&T *and its affiliates* a non-exclusive, non-transferrable, royalty-free, *perpetual* license.”
- “**Expiration Date: 12/31/2010.**”
- “AT&T’s rights to the Digital Images are *worldwide.*”
- “Licensor grants to AT&T and its affiliates a ... license to: ... (ii) use the Digital Images *in AT&T’s business locations* and for AT&T’s business purposes only provided that such use is in accordance with the Specifications detailed in this Agreement.”

(Doc. 157-6 at p. 3 of 18) (Emphasis added, plain bold in original).

The AT&T Services License also contains an integration clause that expressly provides:

Entire Agreement – The terms contained in this Agreement, including any attachments, will constitute the entire integrated agreement between Supplier and AT&T with respect to the subject matter hereof. This Agreement will supersede all prior oral and written discussions, agreements, and understandings of the Parties with respect hereto.

(Doc. 157-6 at p. 5 of 18) (bold in original).

On October 31, 2008, YPPI and AT&T Services executed an amendment to the AT&T Services License (the “1st Amendment”). (Doc. 157-6 at p. 13 of 18). The 1st Amendment coversheet is titled “Amendment 20071211.071.A.001 Between Yellow Pages Photo, Inc. And *AT&T Services, Inc.*” (Doc. 157-6 at p. 10 of 18) (Emphasis added). The 1st Amendment provides in relevant part:

- “This Amendment ... amending Agreement No. 20071211.071.C, is by and between Yellow Pages Photo, Inc., a Florida corporation (“Supplier”) and *AT&T Services, Inc.*, a Delaware corporation (“AT&T”);
- “**WHEREAS**, Supplier and AT&T entered into Agreement No. 20071211.071.C on December 12, 2007 (the ‘Agreement’);
- “**WHEREAS**, Supplier and AT&T desire to amend the Agreement.”

(Doc. 157-6 at p. 11 of 18) (Emphasis added, plain bold in original). The 1st Amendment was executed for “*AT&T Services, Inc.*” by Denise O. Davis, “Sr. Contract Manager.” (Doc. 157-6 at p. 13 of 18) (Emphasis added). Neither “AT&T Advertising, L.P.” nor “AT&T Advertising & Publishing” are mentioned in the 1st Amendment. (Doc. 157-6 at pp. 10-13 of 18).

YPPI and AT&T Services amended the AT&T Services License a second time (the “2nd Amendment”). (Doc. 157 at p. 16 of 18). The coversheet for the 2nd Amendment is titled “Amendment 20071211.071.A.002 Between Yellow Pages Photo, Inc. And *AT&T Services, Inc.*” (Doc. 157-6 at p. 14 of 18) (Emphasis added).

The 2nd Amendment provides in relevant part:

- “This Amendment ... amending Agreement No. 20071211.071.C, is by and between Yellow Pages Photo, Inc., a Florida corporation (“Supplier”), and *AT&T Services, Inc.*, a Delaware corporation (“AT&T”);
- “**WHEREAS**, Supplier and AT&T entered into Agreement No. 20071211.071.C, (the “Agreement”) on December 12, 2007”;

- “**WHERAS**, Supplier and AT&T executed Amendment No. 1 to the Agreement dated October 31, 2008”;
- “**WHEREAS**, Supplier and AT&T desire to amend the Agreement as hereinafter set forth.”
- “The section entitled “Specifications” is modified to include the following:
 - a. Supplier [YPPI] shall supply 137 images identified in Exhibit 1 to AT&T ... for AT&T’s use in accordance with and subject to the terms of the agreement, it being acknowledged and agreed that such images are on the CD collection know[n] by the parties as the ‘LMBerry/Nashville Collection.’”

(Doc. 157-6 at p. 15 of 18) (Emphasis added, plain bold in original). Neither “AT&T Advertising, L.P.” or “AT&T Advertising & Publishing” are mentioned in the 2nd Amendment. (Doc. 157-6, at pp. 14-18 of 18).

In 2011, AT&T Services requested that YPPI amend the AT&T Services License a third time to permit outsourcers to use the YPPI Images and to eliminate the copyright notice requirement. (Doc. 135-5 at p. 52, lines 6-25 and p. 53, lines 1-13; Doc. 135-6 at p. 186, lines 6-17). YPPI rejected AT&T Services’ third proposed amendment. (Doc. 135-5 at p. 52, lines 6-25 and p. 53, lines 1-13; Doc. 135-6 at p. 186, lines 6-17). After YPPI rejected the third proposed amendment, AT&T Services informed YPPI it would no longer use the YPPI Images and undertook a time-consuming and expensive effort to remove the YPPI Images from use and quarantine them into a “ZZZ folder.” (Doc. 135-5 at p. 54, lines 4-18 and 20-25, p. 55, lines 1-5, p. 63, lines 3-11; Doc. 135-6, at p. 186, lines 13-17).

Appellees used Asia-based outsourcers for their ad creation services and have done so since before April 1, 2014. (Doc. 135-5 at p. 73, lines 22-24). Appellees' outsourcers did not use the YPPI Images "in AT&T's business locations", but created advertisements containing the YPPI Images from their offices in Asia. (Doc. 135-5 at p. 75, lines 14-22).

III. STANDARD OF REVIEW

The Lower Court's grant of summary judgment is reviewed de novo. *Pohl v. MH Sub I LLC*, 770 Fed. Appx. 482, 486 (11th Cir. 2019). This Court's "review is guided by [its] previous admonition that '[s]ummary judgment is such a lethal weapon, depriving a litigant of trial on the issue, caution must be used to ensure only those cases devoid of any need for factual determinations are disposed of by summary judgment.'" *Furcron v. Mail Ctrs. Plus, LLC*, 843 F.3d 1295, 1303 (11th Cir. 2016)(citations omitted). The party moving for summary judgment "can prevail only if it shows that there is no genuine dispute as to any material fact." *Pohl*, 770 Fed. Appx. at 486. The Lower Court must construe the evidence in the light most favorable to YPPI, the party opposing the motion, and "draw every justifiable inference in [its] favor." *Id.* "[T]he Court may not weigh conflicting evidence or make credibility determinations of its own." *Furcron*, 843 F.3d at 1304 (citations omitted).

A license is a contract and its interpretation by the Lower Court is also reviewed de novo. *McCoy v. Mitsuboshi Cutlery, Inc.*, 67 F. 3d 917, 920 (Fed. Cir. 1995); see *Hegel v. First Liberty Ins. Corp.*, 778 F.3d 1214, 1219 (11th Cir. 2015).

SUMMARY OF THE ARGUMENT

The Lower Court erred in granting Appellees' Motion for Summary Judgment in two critical ways.

First, the Lower Court committed clear legal error in concluding that Appellees possessed rights under the asserted Berry License and AT&T Services License. The Lower Court did so despite record evidence that Appellees and their claimed predecessors in interest breached conditions of those licenses. In so doing, the Lower Court erred by: (a) failing to apply federal copyright law in its analysis; (b) finding that the breached provisions were mere covenants and not conditions of the licenses; and therefore, (c) Appellees did not infringe YPPI's copyrights. Under well-settled law, the breached license provisions were conditions and breaches of those conditions making Appellees' use of the YPPI Images copyright infringement.

The Lower Court also erred in granting Appellees' Motion for Summary Judgment because the record demonstrates that genuine issues of material fact should have precluded entry of summary judgment. Record evidence controverted the Lower Court's finding that YP was permitted to use the YPPI Images under the

Berry License. Record evidence also disputed the Lower Court's finding that Appellees were permitted to use the YPPI Images under the AT&T Services License.

The Lower Court also critically erred in granting Appellee Print Media's Supplemental SJ Motion because record evidence raised genuine issues of material fact that should have precluded entry of summary judgment on that motion. The record evidence controverted the Lower Court's finding that each of the advertisements published by Print Media was a "renewal, reprint, or republication" of a YP-published advertisement.

YPPI respectfully requests that this Court reverse the Lower Court's grant of Appellees' Motion for Summary Judgment and Appellee Print Media's Supplemental SJ Motion and remand the case back to the Lower Court for a trial on the merits.

ARGUMENT AND CITATIONS OF AUTHORITY**I. THE LOWER COURT ERRED IN GRANTING SUMMARY JUDGMENT IN FAVOR OF YP REGARDING THE BERRY LICENSE AND IN FAVOR OF BOTH APPELLEES REGARDING THE AT&T SERVICES LICENSE BY CONCLUDING THAT THE APPELLEES' BREACHES OF CONDITIONS OF THOSE LICENSES DID NOT MAKE THEIR USE OF THE YPPI IMAGES COPYRIGHT INFRINGEMENT.**

This portion of the appeal addresses the Lower Court's erroneous conclusion that Appellees' uses of the YPPI Images were licensed under the Berry License and AT&T Services License (collectively, the "Asserted Licenses"). YPPI respectfully seeks reversal of the Lower Court's rulings in its Order that Appellees' breaches of certain provisions in the Asserted Licenses did not result in copyright infringement, but were mere breaches of contract. The Lower Court's conclusion is not supported by the law or facts. Rather, the Lower Court's error was premised on its mistaken conclusion that the breached provisions of the Asserted Licenses were mere "covenants" and not "conditions".

A. The Lower Court failed to consider federal copyright law which clearly holds Appellees' use of the YPPI images constituted copyright infringement because such use exceeded the scope of the Asserted Licenses.

The Lower Court clearly erred in finding that Appellees' prolific and continuing use of the YPPI Images was covered by the Asserted Licenses. Appellees' prolific use of the YPPI Images is not in dispute. Rather, this case turns

on whether Appellees' use of the YPPI Images was licensed despite their breaches of conditions of those licenses.

In response to Appellees' defenses that their use of the YPPI Images was covered by the Asserted Licenses, YPPI argued and presented record evidence that Appellees and their predecessors in interest breached conditions of those licenses. Specifically, YPPI presented record evidence that YP's use of outsourcers to create advertisements using the YPPI Images exceeded the scope of the Berry License, thereby rendering all such uses of YPPI Images infringing. (Doc. 135 at pp. 12-13). YPPI additionally presented record evidence that YP and Print Media breached the AT&T Services License by: (1) using outsourcers to create advertisements using the YPPI Images; and (2) failing to use the copyright notice upon which the license was expressly conditioned. (Doc. 135 at pp. 17-18).

The Lower Court erred in analyzing whether the Appellees' documented breaches of the Asserted Licenses precluded entry of summary judgment for Appellees. Specifically, the Lower Court erred by focusing on state law principles of contract construction and failing to consider whether its construction contravened federal copyright law. The Lower Court erroneously concluded that the breached license provisions were all mere "covenants" under state law, rather than "conditions" of those licenses.

The Asserted Licenses, however, “must be construed in accordance with the purposes underlying federal copyright law.” *S.O.S., Inc. v. Payday, Inc.*, 886 F.2d 1081, 1088 (9th Cir. 1989). Courts should “rely on state law to provide the canons of contractual construction, but only to the extent such rules do not interfere with federal copyright law or policy.” *Id.* In *S.O.S.*, the Ninth Circuit determined that the lower court erred in applying the California state rule that a contract should be interpreted against the drafter. The lower court in *S.O.S.* erred because its construction was contrary to federal copyright policy that licenses are assumed to prohibit any use not expressly authorized. *Id.*

Likewise, the Lower Court erred here by failing to consider that under federal copyright law, if a licensee “acts outside the permitted scope of its license,” as YPPI expressly alleged,¹ the licensee “may be held liable for copyright infringement.” *Stross v. Redfin Corp.*, 730 Fed. Appx. 198, 203 (5th Cir. 2018); *see also Tingley Sys. Inc. v. Healthlink, Inc.*, 509 F. Supp. 2d 1209, 1217 (M.D. Fla. May 8, 2007) (“a copyright owner may bring a claim for infringement against a licensee whose actions exceed the scope of the license”); *Jacobsen v. Katzer*, 535 F.3d 1373, 1380 (Fed. Cir. 2008) (“If, however, a license is limited in scope and the licensee acts outside the scope, the licensor can bring an action for copyright infringement”); *S.O.S.*, 886 F.2d at 1087 (“A licensee infringes the owner’s copyright if its use exceeds the scope

¹ (Doc. 135 at pp. 12, 17-18).

of its license”); *Energy Intelligence Group Ltd. v. Bank of America, N.A.*, 2018 U.S. Dist. LEXIS 112068, *17 (S.D. Tex. July 5, 2018) (use of copyrighted material in a way that exceeds scope of license may infringe copyright); *Genesys Software Sys. v. Comerica Bank*, 2013 U.S. Dist. LEXIS 200010, at *6 (N.D. Tex. April 9, 2013) (use of software “in a way that exceeded the scope of permission given [in a license agreement] ... is a typical copyright infringement claim”); *Nimmer On Copyright*, § 1015[A] (1999).

The federal courts in three of the five decisions cited by the Lower Court in its Order, agree with this clear principle. *See MDY Indus., LLC v. Blizzard Entm’t, Inc.*, 629 F.3d 928, 1008 (9th Cir. 2010) (“a player [who creates derivative works without licensor’s consent] would exceed the scope of her license and violate one of [licensor]’s exclusive rights under Copyright Act”); *Eberhard Architects, LLC. v. Bogart Architecture, Inc.*, 314 F.R.D. 567, 572 (N.D. Ohio April 22, 2016) (“A copyright owner who grants a nonexclusive license to use copyrighted material cannot later sue for copyright infringement, **provided the use falls within the scope and duration of the license**”) (emphasis added); *Virtual Studios, Inc. v. Royalty Carpet Mills, Inc.*, 2014 WL 12495340, at *8 (N.D. Ga. Feb. 10, 2014) (where “the licensee acts outside the scope [of the license], the licensor can bring an action for copyright infringement.”). Yet, the Lower Court failed to follow federal copyright law in entering summary judgment.

B. Under federal copyright law, the Licenses’ provisions at issue are clearly “conditions” not “covenants”.

The scope of each of the Asserted Licenses is limited by provisions that Appellees are documented to have breached. Therefore, under well-settled federal law, those breached provisions are “conditions” of the Asserted Licenses.

Restrictions implicating a copyright owner’s statutory rights, such as limitations of scope, are “conditions” of the license grant. *MDY Indus.*, 629 F.3d at 1008; *Jacobsen*, 535 F.3d at 1380-81 (limitations to scope of license are conditions); *Energy Intelligence Group, Inc. v. Tudor, Pickering, Holt & Co., Sec., Inc.*, 2013 U.S. Dist. LEXIS 10660, *7-8 (S.D. Tex. Jan. 28, 2013) (agreement language “clearly appears to limit the scope of the license itself and is not a separate contractual covenant” and alleged use beyond scope stated a claim for copyright infringement); *see also Columbia Data Prods., Inc. v. Symantec Corp.*, 2008 U.S. Dist. LEXIS 13304, *15-16 (M.D. Fla. Feb. 22, 2008) (holding that conduct in contravention of the license grant was a failure to satisfy a condition of the license and constituted copyright infringement and not breach of contract claim).

Here, YPPI presented record evidence that Appellees breached the “Seat License” provision in the Berry License. The “Seat License” provision expressly limits the license to “48 employees”. Thus, an express condition of using the YPPI Images under the Berry License is that one be an “employee” of the Licensee. (Doc. 119-2 at ¶1.3). YPPI presented record evidence that Asian-based outsourcers, who

were not employees of any asserted licensee under the Berry License, used YPPI Images to create Appellees' advertisements. (Doc. 135-5 at p. 75, lines 14-22).

YPPI also presented record evidence that Appellees breached the "Licensor License Grant" provision of the AT&T Services License by having Asian-based outsourcers use YPPI Images to create advertisements.² The "Licensor License Grant" provision states:

Licensor grants to AT&T and its affiliates a non-exclusive, non-transferrable, royalty-free, perpetual license to: ... (ii) use the Digital Images *in AT&T's business locations* and for AT&T's business purposes only provided that such use is in accordance with the Specifications detailed in this Agreement.

(Doc. 119-6 at p. 3 of 18) (Emphasis added). Under the AT&T Services License, use of the YPPI Images was expressly conditioned on their use "in AT&T's business locations."

Appellees' use of YPPI Images by Asian-based outsourcers, who did not use the YPPI Images "in AT&T's business locations", to create ads for Appellees, exceeded the scope of the AT&T Services License. (Doc. 135 at pp. 8-9, 12, 17). Thus, under established federal law, Appellees' publication of such advertisements infringed YPPI's copyrights.

YPPI also presented the Lower Court with record evidence that Appellees violated the AT&T Services License's provision that conditioned the license grant

² (Doc. 135-5 at p. 75, lines 14-22).

on the licensee's use of a particular form of copyright notice. Specifically, the AT&T Services License required use of a copyright notice "reflecting on the copyright ownership of both AT&T and Licensor [YPPI] as follows: 'Copyright ©20__[AT&T] and its licensors. All rights reserved.'" (Doc. 119-6 at p. 3 of 18). The record evidence presented to the Lower Court shows that AT&T wanted to eliminate the notice requirement in the proposed third amendment that YPPI rejected. (Doc. 135-5, at p. 215, lines 20-25, p. 216, at lines 1-18, and Ex. 25 thereto).

A requirement that distributed copies contain a particular copyright notice is a "condition" of a license. "An express or possibly implied condition that a licensee must affix a proper copyright notice to all copies of the work that he causes to be published will render a publication devoid of such notice without authority from the licensor and therefore, an infringing act." *Jacobsen*, 535 F.3d at 1382 (quoting *Nimmer On Copyright* § 10.15).

The record shows Appellees did not use the required form of copyright notice. (Doc. 135 at pp. 10, 17-18; 135-7). Appellees never contended otherwise. Thus, Appellees exceeded the scope of the AT&T Services License, and thereby infringed YPPI's copyrights, in this way as well.

C. Under Texas state contract law, the cited provisions of the AT&T Services License are “conditions” and not covenants.

The Lower Court erred in finding that the provisions of the AT&T Services License breached by Appellees were covenants and not conditions even if Texas law governed the interpretation of that license. Under Texas law a court will interpret a provision as a condition precedent:

In order to make performance specifically conditional, a term such as “if”, “**provided that**”, “on condition that”, or some similar phrase of conditional language must normally be included. (Emphasis added).

Womack+Hampton Architects, L.L.C. v. Metric Holdings Ltd. P’shp, 102 Fed. Appx. 374, 381 (5th Cir. 2004) (citing *Criswell v. European Crossroads Shopping Ctr., Ltd.*, 792 S.W. 2d 945, 948 (Tex. 1990)).

The breached provisions of the AT&T Services License unquestionably contain the requisite conditional language:

Licensor grants to AT&T and its affiliates a ... license to: ... (ii) use the Digital Images in AT&T’s business locations and for AT&T’s business purposes only **provided that** such use is in accordance with the Specifications detailed in this Agreement.³

AT&T may incorporate any Digital Image(s) into its own original work and publish, display and distribute the work in any media **provided that** a copyright notice is included in any electronic or digital work reflecting on the copyright ownership of both AT&T and Licensor as follows: “Copyright ©20__[AT&T] and its licensors. All rights reserved.”

³ The requirement that AT&T use the YPPI Images “*in AT&T’s business locations*” is found in the Specifications portion of the AT&T Services License.

(Doc. 119-6 at p. 3 of 18)(Emphasis added).

In light of the well-settled federal law, the record evidence, and Texas law, the Lower Court's grant of summary judgment in favor of Appellees on the AT&T Services License and in favor of YP on the Berry License was erroneous and should be reversed and the case remanded for a jury trial.

II. THE LOWER COURT ERRED IN GRANTING APPELLEES' MOTION FOR SUMMARY JUDGMENT IN THE FACE OF GENUINE ISSUES OF MATERIAL FACT.

Not only did the Lower Court err in concluding that Appellees' breaches of the Asserted Licenses did not preclude summary judgment, it also erred in entering summary judgment despite the presence of genuine issues of material fact regarding both of the Asserted Licenses.

A. The Lower Court erred in granting summary judgment for YP based on its determination that YP's use of the YPPI Images was covered by the Berry License because genuine issues of material fact exist.

The Lower Court erroneously concluded that YP owned L.M. Berry and Company before any alleged infringement of the YPPI Images and was, therefore, an "affiliate owning L.M. Berry and Company and included within the scope of the Berry License." (Doc. 196 at p. 18). The Lower Court's Order adopted YP's assertions regarding a series of corporate mergers and name changes through which YP claimed to be an affiliate of the original licensee under the Berry License.

Granting summary judgment on this basis was error because genuine issues of material fact dispute exist as to whether YP had any rights under the Berry License.

Critically, YP had claimed before Lower Court that YP's rights under the Berry License derived through AT&T. (Doc. 121 at ¶¶ 8, 9). YPPI disputed that any AT&T entity enjoyed the benefits of the Berry License based upon record facts that Appellees omitted in their Motion for Summary Judgment. (Doc. 135 at p. 7).

First, the 2nd Amendment to the AT&T Services License contradicts Appellees' argument that AT&T enjoyed the benefits of the Berry License. The contradiction is double licensing. AT&T, Inc. acquired L.M. Berry and Company in 2006. (Doc. 121 at ¶ 8). Under YP's argument, AT&T should have enjoyed rights under the Berry License upon that acquisition. However, the record shows that the 2009 2nd Amendment licensed to AT&T a collection of YPPI Images that were already included in the Berry License. (Doc. 119-6, at p. 15 of 18). YPPI argued that the 2nd Amendment would not have been needed if AT&T possessed rights under the Berry License. The Lower Court rejected YPPI's argument and adopted YP's explanation that "such facts simply show that the second license was unnecessary." (Doc. 196 at p. 19). At a minimum, the Lower Court's express acknowledgement that the 2nd Amendment was "unnecessary" raises a genuine issue of material fact as to whether AT&T did, in fact, enjoy rights under the Berry License.

Second, YPPI argued that AT&T could not have used the Berry License because AT&T needed a license for far more users than the 45 “seat licenses” authorized in the Berry License. YPPI presented record evidence that the AT&T Services License was executed a year after AT&T, Inc. acquired L.M. Berry and Company, and was for “Unlimited Users” and had “extended” a 500-user license for many of the same YPPI Images. (Doc. 121 at ¶ 8; Doc. 135-5 at p. 100, line 2 – p. 102, line 5). The Lower Court dismissed YPPI’s argument and evidence as simply “answer[ing] the issue raised by YPPI’s first argument – Yellow Pages could use the Berry License, but would need additional resources.” (Doc. 196 at p. 19). The Lower Court simply ignored that this evidence viewed separately, or in conjunction with the 2nd Amendment, raised a genuine issue of material fact as to whether AT&T enjoyed rights under the Berry License.

Finally, YPPI argued in the Lower Court that the AT&T Services License superseded the Berry License. Specifically, YPPI argued that, even if AT&T was an authorized user under the Berry License when AT&T acquired L.M. Berry and Company in 2006, the December 12, 2007, execution of the AT&T Services License superseded the Berry License. The AT&T Services License expressly states:

Entire Agreement - The terms contained in this Agreement, including any attachments, will constitute the entire integrated agreement between Supplier and AT&T with respect to the subject matter hereof. This Agreement will supersede all prior oral and written discussions, agreements, and understandings of the Parties with respect hereto.

(Doc. 119-6 at p. 5 of 18).

As YPPI argued below, the “subject matter” of the AT&T Services License and the Berry License are the same -- licensing YPPI Images. The Lower Court erroneously determined, however, that the “‘subject matter’ of the AT[&]T [Services] License, ... is different subject matter from the Berry License.” (Doc. 196 at p. 19). The Lower Court made its determination despite the clear content of the Asserted Licenses to the contrary and without any factual support or analysis. The sole basis for the Lower Court’s finding was that L.M. Berry and Company “was not a party to the” AT&T Services License.⁴ Based on its unfounded interpretations of the Asserted Licenses, the Court concluded that the AT&T Services License did not supersede the Berry License.

Any of the three foregoing issues of fact raised by YPPI should have, as a matter of law, prevented entry of summary judgment on the issue of whether YP was authorized to use the YPPI Images under the Berry License. Collectively, they make the Lower Court’s entry of summary judgment clear error. This Court has repeatedly admonished, in ruling on a summary judgment motion, that a lower court “must construe the evidence in the light most favorable” to the non-movant and “must draw every justifiable inference in [its] favor.” *Pohl v. MH Sub I LLC*, 770 Fed. Appx.

⁴ The AT&T Services License states that it is with “AT&T and its affiliates” and “AT&T and its subsidiaries.” (Doc. 119-6). There is no record evidence whether L.M. Berry and Company was or was not an affiliate or subsidiary of “AT&T”.

482, 486 (11th Cir. 2019); *Furcron v. Mail Ctrs. Plus, LLC*, 843 F.3d 1295, 1303 (11th Cir. 2016).

Here, the Lower Court failed to construe the evidence in the record in the light most favorable to YPPI and also failed to draw every justifiable inference in YPPI's favor, when it rejected YPPI's three arguments above. For these reasons as well, this Court should reverse the Lower Court's grant of summary judgment in favor of YP regarding the Berry License and remand the case for trial.

B. The Lower Court erred in granting summary judgment based on its finding that Appellees were licensed under the AT&T Services License despite the existence of genuine issues of material fact.

The Lower Court erred in granting Appellees' Motion for Summary Judgment as to their AT&T Services License defense. Record evidence shows that genuine issues of material fact exist as to whether the Appellees are licensees under the AT&T Services License.

1. The Lower Court erred in finding that the undisputed evidence shows that AT&T Advertising L.P. was the party to the AT&T Services License.

The parties disputed below which AT&T entity was a party to the AT&T Services License. YPPI contended that AT&T Services was the party to the License, but Appellees argued that AT&T Advertising was the party. Despite these conflicting positions and conflicting record evidence, the Lower Court found that

the evidence was “undisputed” that AT&T Advertising was the party to the AT&T Services License. The Lower Court’s finding is erroneous.

In its Order, the Lower Court first analyzed whether the AT&T Services License was ambiguous. It noted that, under Texas law, “[i]f the contract is subject to two or more reasonable interpretations after applying the pertinent rules of construction, the contract is ambiguous, *which creates a fact issue* on the parties’ intent.” (Doc. 196 at p. 23) (citation omitted, emphasis added). The Lower Court then correctly noted that, if an ambiguity exists, “summary judgment is not proper” because “interpretation of ambiguous contracts is a question for the jury.” (*Id.*). The Lower Court also stated:

the court may construe as a matter of law an ambiguous contract by considering *undisputed* evidence of the parties’ intent. If there is a conflict in the parol evidence, however, the question of the parties’ intent becomes one of fact, appropriate for consideration by the jury.

(*Id.*) (citation omitted, emphasis added).

The Lower Court failed to properly follow the Texas law it correctly cited. The Lower Court first erred by finding that the AT&T Services License “is ambiguous as to whether ATT Services or ATT Advertising was the intended party.” (Doc. 196 at p. 25). This finding was error. The AT&T Services License and the amendments thereto clearly and repeatedly identify AT&T Services as the party to the License:

- The cover page of the AT&T Services License explicitly states that it is “between Yellow Pages Photo, Inc. and ***AT&T Services, Inc.***” (Doc. 119-6 at p. 2 of 18);
- The first page of the AT&T Services License, it identifies the “AT&T: Affiliate Name” as “***AT&T Services, Inc.***” and directs that questions should be referred to “Denise O. Davis” at “***AT&T Services, Inc.***” (Doc. 119-6, at p. 3 of 18);
- The cover page for the 1st Amendment states, “Amendment 20071211.071.A.001 Between Yellow Pages Photo, Inc. And ***AT&T Services, Inc.*** (Doc. 119-6 at p. 10 of 18);
- The 1st Amendment expressly states that it is “between Yellow Pages Photos, Inc. ... and ***AT&T Services, Inc.***, ... (‘AT&T’).” (Doc. 119-6, at p. 11 of 18);
- The 1st Amendment further states that “Supplier [YPPI] and AT&T [defined in the 1st Amendment as ***AT&T Services, Inc.***] entered into Agreement No. 20071211.071.C,” which again is the AT&T Services License. (Doc. 119-6 at p. 11 of 18);
- The 1st Amendment was executed by Denise O. Davis as “Sr. Contract Manager” for “***AT&T Services, Inc.***” (Doc. 119-6 at p. 11 of 18);
- The cover page of the 2nd Amendment explicitly states it is “Amendment 20091211.071.A.002 Between Yellow Pages Photo, Inc. And ***AT&T Services, Inc.***” (Doc. 119-6 at p. 14 of 18) (the “2nd Amendment”);
- The 2nd Amendment expressly states it is “between Yellow Pages Photo, Inc. and ***AT&T Services, Inc.*** (‘AT&T’).” (Doc. 119-6 at p. 15 of 18);
- The Second Amendment further states that “Supplier [YPPI] and AT&T [defined in the Amendment as ***AT&T Services, Inc.***] entered into Agreement No. 20071211.071.C.” (Doc. 119-6 at p. 15 of 18);
- The Second Amendment additionally states that “Supplier [YPPI] and AT&T executed amendment No. 1 to the Agreement.” (Doc. 119-6 at p. 15 of 18) (Emphasis added).

Neither the 1st Amendment nor the 2nd Amendment even mention “AT&T Advertising” or “AT&T Advertising & Publishing.” (Doc. 119-6 at pp. 10-18). Thus, the express terms in the AT&T Services License and the two subsequent amendments to it all clearly indicate that AT&T Services, not “AT&T Advertising” or “AT&T Advertising & Publishing” is a party to it.

The Lower Court compounded its error by resolving that “ambiguity” despite conflicting evidence. The Lower Court’s error in this regard contains two sub-parts, each of which is a separate error. First, the Lower Court erred in finding that there was “undisputed evidence” of the parties’ intent. Second, based on the supposed “undisputed evidence,” the Lower Court erroneously found that AT&T Advertising, and not AT&T Services, was the party to the AT&T Services License.

The Lower Court’s finding that there was “undisputed” evidence as to the parties’ intent was error. This finding was erroneous because record evidence shows that YPPI understood that AT&T Services was the intended party to the AT&T Services License, not AT&T Advertising. YPPI’s corporate representative who negotiated the AT&T Services License testified that:

- It was his understanding that AT&T Services was responsible for publishing the AT&T yellow pages directories (Doc. 157-5 at 72:5-11);
- AT&T Services was “the one calling [him], they were the one wanting the images, they were the one wanting the license.” (Doc. 157-5 at 73:7-10);

- It was his understanding that AT&T Services would execute the license (Doc. 157-5 at 89:1-3); and
- AT&T drafted the License and referred to AT&T Services in the AT&T Services License (Doc. 157-5 at 89:4-9).

Although the Lower Court described YPPI's corporate representative's testimony as "*not entirely consistent*," the Court nevertheless found:

[b]ased on the *undisputed* evidence, the most favorable interpretation for YPPI that can reasonably be made is that YPPI was *indifferent* to which AT&T entity was the party to the license, but intended for AT&T Advertising to use the license.

(Doc. 196 at p. 26) (emphasis added). The Lower Court's acknowledgement that evidence before it was inconsistent and that YPPI was "indifferent" as to which entity was the party to the AT&T Services License, contradicts its finding that the evidence was "undisputed".

Yet, there is more. The record evidence cited above also shows YPPI thought AT&T Services was the intended party under the AT&T Service License. Thus, the Lower Court erred in determining the evidence was "undisputed" that YPPI intended for AT&T Advertising "to use the license." Under Texas law, the Lower Court should have found that the conflicting evidence as to the parties' intent required denial of summary judgment and reserved this determination for the jury. For this reason too, this Court should reverse the Lower Court's ruling on summary judgment as to the AT&T Services License defense and remand the matter for trial.

III. THE LOWER COURT ERRED IN GRANTING PRINT MEDIA'S SUPPLEMENTAL SJ MOTION BECAUSE GENUINE ISSUES OF MATERIAL FACT EXIST.

After the Lower Court's Order denied Appellees' Motion for Summary Judgment as to Print Media's argument that it had rights to use the YPPI Images under the Berry License, Print Media filed its Supplemental SJ Motion regarding the ten (10) remaining YPPI Images allegedly infringed by Print Media.

The Lower Court erred in granting Print Media's Supplemental SJ Motion. Specifically, the Lower Court erred in finding that each use by Print Media of the ten different YPPI Images "qualif[ies] for use by Print Media as a renewal, reprint, or republication based on the clear language of the Berry License." (Doc. 235 at p. 15). The Lower Court's finding is error because record evidence shows that the advertisements published by Print Media were not "renewals, reprints, or republications" of earlier YP advertisements covered by the Berry License. The differences between the Print Media advertisements and the claimed prior YP advertisements created, at a minimum, genuine issues of material fact as to whether each of the Print Media advertisements constituted a "renewal, reprint, or republication" of the YP advertisements.

In granting the Supplemental SJ Motion, the Lower Court erroneously found that "[n]o genuine dispute exists as to the fact that this type of minor change to an original advertisement by the same client is permitted by the Berry License." (Doc.

235 at p. 15). This finding was erroneous because YPPI emphatically argued that the changes to the original YP advertisements were not permitted under the Berry License.

The Lower Court erred in finding that the differences between the ads were a “type of minor change to an original advertisement by the same client [that] is permitted by the Berry License.” The Berry License, even as construed by the Lower Court, did not allow such changes. The Lower Court claimed to construe the terms “renewal” and “republication” in accordance with their definitions in Black’s Law Dictionary. (Doc. 235 at p. 14)⁵. The Lower Court noted, that “renewal is defined as ‘the act of restoring or reestablishing’” and that “[r]epublication is ‘the act or an instance of publishing again or anew.’” (*Id.*). The Lower Court purported to apply these definitions and concluded that “the only reasonable reading of the Berry License allows minor formatting and size changes ... as long as the reprint, renewal, or republication is the same advertisement for the same client.” (*Id.*). The definitions of “renewal” and “republication” cited by the Lower Court do not, however, allow for any changes, let alone the changes as identified by YPPI and as shown in the record.

YPPI provided the Lower Court with record evidence of all of the differences between the original YP advertisements and the allegedly infringing advertisements

⁵ The Lower Court did not construe the term “reprint.” (Doc. 235).

published by Print Media for eight (8) of the ten (10) YPPI Images at issue. The advertisements using each of those eight (8) YPPI Images is discussed below.

A. YPPI's BBQ-A0120 Image

Print Media submitted a single ad to show that the Print Media ads identified by YPPI as containing its BBQ-A0120 copyrighted image were originally published by YP. (Doc. 220-7, pp. 2-4 and Doc. 228-1 at p. 4 of 4). At least two of the Print Media ads identified by YPPI as containing its BBQ-A0120 copyrighted image are different from the ad Print Media claims was originally published by YP. Specifically, two identical allegedly infringing ads published by Print Media in a directory “Issued February 2017” for Huntsville, Alabama for Gibson’s Bar-B-Q (Doc. 220-4 at pp. 2, 13-15 and Doc. 228-2) are different from the previously published YP ad because the Print Media ads are: (a) significantly larger in size (larger than $\frac{1}{4}$ page) than the ad purportedly published by YP (about $\frac{1}{8}$ page); (b) a different shape (square vs. rectangle); (c) formatted differently; and (d) one of the Print Media ads contains a “see our restaurant menu” logo not present in the prior YP ad. A side by side comparison of the ads is shown below, with the directory page showing the YP ad on the left and the Print Media ad on the right:

The collage consists of several distinct advertisements. On the left, there are ads for carpet and rug services, including 'Carpet & Rug Dealers (Cont'd)' and 'Carpet-Caterers'. In the center, there are ads for 'Huntsville Decorating Center', 'Evans Awning Co.', and 'Bubba's Catering'. On the right, there is a large 'Restaurants (Cont'd)' section listing numerous dining establishments with their phone numbers and addresses. At the bottom, there are ads for 'Removable Moments' and 'Steak-Out'.

(Doc. 228 at p. 8). This comparison shows that the allegedly infringing Print Media ads were not originally published by YP and are not, therefore, covered by the Berry License.

B. YPPI's CRA-A0110 Image

Print Media submitted two (2) identical ads contained in one (1) directory to show that the Print Media ads identified by YPPI as containing its CRA-A0110 copyrighted image were originally published by YP. (Doc. 220- 7, pp. 5-10 and Doc. 228-3 at pp. 4-7). It is clear that all of the Print Media ads identified by YPPI as containing its CRA-A0110 copyrighted image are different from the two identical prior YP ads. Specifically, the ads published by Print Media in directories dated “June 2015-2016” and “Issued June 2017” for “Kings & Tulare Counties” (Doc. 220-4 at pp. 16-25 and Doc. 228-4, at pp. 4-5, 7-8, and 10-11) are different from the

ads that Print Media claims were previously published by YP because the Print Media ads contain the phrases “CELEBRATING 20 YEARS!” and “CELEBRATING 24 YEARS!”, while the prior YP ads state “CELEBRATING 19 YEARS!”. Thus, the Print Media ads were not originally published by YP and are not, therefore, covered by the Berry License.

C. YPPI’s CRA-A0117 Image

Print Media submitted a single ad in a single directory as purported evidence that the Print Media ads identified by YPPI as containing its CRA-A0117 copyrighted image were originally published by YP. (Doc. 220-7 at pp. 11-14 and Doc. 228-5 at pp. 4-5). At least two of the Print Media ads identified by YPPI as containing its CRA-A0117 copyrighted image are different from the ad Print Media claims was originally published by YP. Specifically, the ads published by Print Media in directories dated “June 2015-2016” and “Issued June 2016” for “Greater Macon -Forsyth” (Doc. 220-4 at pp. 30-35 and Doc. 228-6 at pp. 4-5, and 7-8) are different from the ads that Print Media claims were previously published by YP. The allegedly infringing Print Media ads use a different photo and a different phone number than the purported YP ad. The comparison below (with the claimed prior YP ad on the top and the allegedly infringing Print Media ads below) shows that the ads are different, that the Print Media ads were not originally published by YP and are not, therefore, covered by the Berry License:

20 Attorneys

To advertise call 1-800-438-7322 or visit advertising.yppi.com

PERSONAL INJURY

REZA SEDGHI

ATTORNEY AT LAW

Experienced, Skilled & Aggressive

Recent Recoveries:

- \$1.9 Million Wrongful Death
- \$650,000 Disc Injury
- \$350,000 Disc Injury
- \$500,000 Back Injury
- \$560,000 Fracture
- \$200,000 Fracture
- \$200,000 Pedestrian
- \$525,000 Traumatic Neck Injury
- \$180,000 Rotator Cuff

INJURED?

- Whiplash Injuries
- Back Injuries
- Herniated Disk
- Head Injuries
- Amputations
- Burns
- Work Related Injuries
- Slip & Fall
- Medical/Hospital Malpractice
- Nursing Home Injuries
- Wrongful Death
- Hit & Run Cases
- Trucking Accidents
- Motorcycle Accidents

Held 2007
Best Attorney / Law Firm
By Macon Telegraph Readers

Former Judge - Macon Municipal Court

741-3770 LET ME FIGHT FOR YOU.

AVAILABLE 24 HOURS FOR CONSULTATION

YP DOWNLOAD THE APP Or visit YP.com Attorneys 21

CRIMINAL DEFENSE

This Can Happen To An Innocent Person.

AGGRESSIVE DEFENSE FOR

- Drug Charges
- Homicide / Manslaughter
- DUI
- Aggravated Assault
- Probation Violation Matters
- Juvenile Crimes
- Forgery / Fraud
- Traffic Violations
- Theft / Shoplifting
- Bond Reduction

Admitted To:

State, Superior & Federal Courts 11th Circuit Court of Appeals
U.S. District Court For Middle District U.S. District Court For Northern District
U.S. District Court For Southern District

www.rezasedghi.com

SAME DAY FREE CONSULTATION

741-3770

2870 Vineville Avenue • Macon, GA AVAILABLE 24 HOURS FOR CONSULTATION

20 Attorneys

To advertise call 1-800-438-7322 or visit advertising.yppi.com

PERSONAL INJURY

REZA SEDGHI

ATTORNEY AT LAW

Experienced, Aggressive

Recent Recoveries:

- \$1.9 Million Wrongful Death
- \$650,000 Disc Injury
- \$350,000 Disc Injury
- \$500,000 Back Injury
- \$560,000 Fracture
- \$200,000 Fracture
- \$200,000 Pedestrian
- \$525,000 Traumatic Neck Injury
- \$180,000 Rotator Cuff

INJURED?

- Whiplash Injuries
- Back Injuries
- Herniated Disk
- Head Injuries
- Amputations
- Burns
- Work Related Injuries
- Slip & Fall
- Medical/Hospital Malpractice
- Nursing Home Injuries
- Wrongful Death
- Hit & Run Cases
- Trucking Accidents
- Motorcycle Accidents

Held 2007
Best Attorney / Law Firm
By Macon Telegraph Readers

Former Judge - Macon Municipal Court

239-6658 LET ME FIGHT FOR YOU.

AVAILABLE 24 HOURS FOR CONSULTATION

YP DOWNLOAD THE APP Or visit YP.com Attorneys 21

CRIMINAL DEFENSE

This Can Happen To An Innocent Person.

AGGRESSIVE DEFENSE FOR

- Drug Charges
- Homicide / Manslaughter
- DUI
- Aggravated Assault
- Probation Violation Matters
- Juvenile Crimes
- Forgery / Fraud
- Traffic Violations
- Theft / Shoplifting
- Bond Reduction

Admitted To:

State, Superior & Federal Courts 11th Circuit Court of Appeals
U.S. District Court For Middle District U.S. District Court For Northern District
U.S. District Court For Southern District

www.rezasedghi.com

SAME DAY FREE CONSULTATION

239-6658

2870 Vineville Avenue • Macon, GA AVAILABLE 24 HOURS FOR CONSULTATION

(Doc. 228 at pp. 10-11).

D. YPPI's GUT-A0116, SID-A0102, and SID-A0112 Images

Print Media submitted a single ad in one directory to show that the Print Media ads identified by YPPI as containing its GUT-A0116, SID-A0102, and SID-A0112 copyrighted images were originally published by YP. (Doc. 220-7 at pp. 15-17 and Doc. 228-7 at p.4.). At least two of the allegedly infringing Print Media ads identified by YPPI as containing its GUT-A0116, SID-A0102, and SID-A0112

copyrighted images are different from the ad Print Media claims was originally published by YP. Specifically, the ads published by Print Media in directories dated “February 2016-2017” and “Issued February 2017” for “Greater Ohio Valley Area” for Benthall Bros., Inc. are different from the ads that Print Media claims were previously published by YP. (Doc. 220-4 at pp. 2, 13-15 and Doc. 228-8 at pp. 4 and 6). The allegedly infringing Print Media ads (270 228-0640 v. 270 926-2103) each use a different phone number than the prior YP ad. Additionally, the Print Media ad from the “Issued February 2017” directory is larger (over a ¼ page) than the purported YP ad (less than ¼ page). The comparison below (with the claimed YP ad on the top and the Print Media ads at the bottom) shows that the ads are different and that the Print Media ads were not originally published by YP and are not, therefore, covered by the Berry License.

148 Siding Speech

Vinyl Siding & Soffit

Bentall Bros., Inc.

ALL OUR PRODUCTS ARE BUILT TO LAST

- Aluminum & Steel Siding & Soffit
- Vinyl Replacement Windows
- Aluminum & Doors • Entry Door Systems
- Garage Doors & Openers
- Fickett Blind Doors
- Petst-Resistant & Safe Floors
- Reverse Aluminum Clad
- 2 x 4 & 2 x 6 Columns & Pilasters

200 926-2103

1520 BULE WAVE BLVD INDEPENDENCE

DESIGN & BUILD BY DINA

SIGNS

www.signsbysina.com

200 486-2142

200 486-2142

200 486-2142

200 486-2142

200 486-2142

200 486-2142

200 486-2142

200 486-2142

200 486-2142

200 486-2142

200 486-2142

200 486-2142

200 486-2142

200 486-2142

200 486-2142

200 486-2142

200 486-2142

200 486-2142

200 486-2142

200 486-2142

200 486-2142

200 486-2142

200 486-2142

200 486-2142

200 486-2142

200 486-2142

200 486-2142

200 486-2142

200 486-2142

200 486-2142

200 486-2142

200 486-2142

200 486-2142

200 486-2142

200 486-2142

200 486-2142

200 486-2142

200 486-2142

200 486-2142

200 486-2142

REACTIVE 220 670-7534

REACTIVE 220 670-7534

REACTIVE 220 670-7534

REACTIVE 220 670-7534

REACTIVE 220 670-7534

REACTIVE 220 670-7534

REACTIVE 220 670-7534

REACTIVE 220 670-7534

REACTIVE 220 670-7534

REACTIVE 220 670-7534

REACTIVE 220 670-7534

REACTIVE 220 670-7534

REACTIVE 220 670-7534

REACTIVE 220 670-7534

REACTIVE 220 670-7534

REACTIVE 220 670-7534

REACTIVE 220 670-7534

REACTIVE 220 670-7534

REACTIVE 220 670-7534

REACTIVE 220 670-7534

REACTIVE 220 670-7534

REACTIVE 220 670-7534

REACTIVE 220 670-7534

REACTIVE 220 670-7534

REACTIVE 220 670-7534

REACTIVE 220 670-7534

REACTIVE 220 670-7534



(Doc. 228 at pp. 12-13).

E. YPPI's HOM-C0146 Image

Print Media submitted eight (8) ads from eight (8) different directories in its effort to show that the Print Media ads identified by YPPI as containing its HOM-C0146 copyrighted image were originally published by YP. (Doc. 220-7 at pp. 18-26; Doc. 220-8 at pp. 3-17; and Doc. 228-9 at pp. 4-5, 7, 9-10, 12-13, 15-16, 18-19, 21-22, and 24-25). It is clear that at least fifteen (15) of the allegedly infringing Print Media ads identified by YPPI as containing its HOM-C0146 copyrighted image (Doc. 220-5 and Doc. 228-10) are different from any ad Print Media claims was originally published by YP. The ads that Print Media claims were published by YP are in two general varieties, as an ad with two facing pages (a format referred to as

a “double truck”) and grey-scale photos and as a full-color ad about ¾ page in size.

The two general types of ads previously published by YP, are shown below:



(Doc. 228 at p. 14).

The allegedly infringing Print Media published ads fall into two general types, a double truck ad with full-color photos⁶ and different inset photo and a less than full-size color ad that has a larger and yellow “Broken Springs Our Specialty” badge.⁷ Those two general types of different Print Media ads are below:



⁶ (Doc. 220-5 at pp. 9-11, 18-20, 27-28, 32-37, 41-46, 52-60, 64-64, 69-73).

⁷ (Doc. 220-5 at pp. 23-26).

(Doc. 228 at p. 15).

For ease of reference, enlargements of the different “Broken Springs Our Specialty” badges is below, with the badge from the prior YP ad on the left and the badge from the Print Media ad on the right:



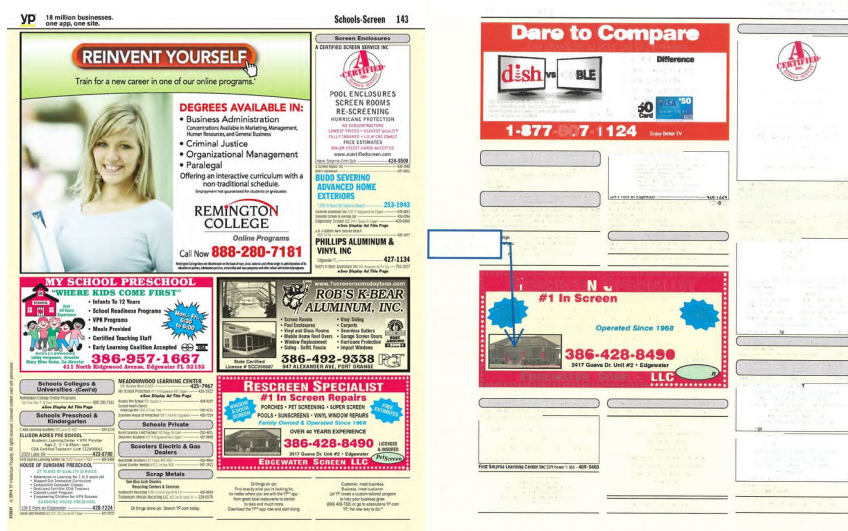
These comparisons show that at least fifteen (15) of the YPPI identified Print Media ads were not originally published by YP and are not, therefore, covered by the Berry License.

F. YPPI's SCE-A0141 Image

Print Media submitted two ads, one in each of two (2) directories, as purported evidence that the Print Media ads identified by YPPI as containing its SCE-A0141 copyrighted image were originally published by YP. (Doc. 22-9 at pp. 12, 14 and Doc. 228-12 at pp. 4, and 6). At least two of the allegedly infringing Print Media ads identified by YPPI as containing its SCE-A0141 copyrighted image are different from the two (2) ads that Print Media claims were originally published by YP. Specifically, the ads published by Print Media in directories “Issued March 2017” for “Daytona Beach Area” and “Issued May 2017” for “New Smyrna Beach Area” for Edgewater Screen LLC published by Print Media (Doc. 220-6 at pp. 36, 42 and

Doc. 228-13 at pp. 4, 6) are different from the ads that Print Media claims were previously published by YP.

The allegedly infringing Print Media ads are larger, two thirds (2/3) of a page wide, than the ads that Print Media claims were published by YP, which ads are one-half (1/2) page wide. The comparison below (an example of the claimed YP ad on the left and a sample of the different allegedly infringing Print Media ad on the right) shows that the ads are different and that the Print Media ads were not originally published by YP and are not, therefore, covered by the Berry License.



(Doc. 228 at p. 17).

The differences between the claimed YP-published ads and the Print Media-published ads shown above were all presented with record evidence to the Lower Court. That record evidence establishes that Print Media did not publish advertisements that were a “reprint, renewal, or republication” of the original YP

advertisement because the Print Media advertisements were not the same as the YP advertisements.

The Lower Court erred in finding that each of the allegedly infringing Print Media ads was a “renewal, reprint, or republication” of a YP ad covered by the Berry License. In making its erroneous finding, the Lower Court failed to heed this Court’s clear directives that the evidence must be construed in the light most favorable to YPPI and that every justifiable inference is to be drawn in YPPI’s favor. *Pohl v. MH Sub I LLC*, 770 Fed. Appx. 482, 486 (11th Cir. 2019); *Furcron v. Mail Ctrs. Plus, LLC*, 843 F.3d 1295, 1303 (11th Cir. 2016). As such, the Lower Court’s grant of supplemental summary judgment in favor of Print Media as to eight of the ten remaining YPPI Images must be reversed and the case remanded for a trial on the merits.

CONCLUSION

For all the reasons discussed above, YPPI respectfully requests that this Court reverse the Lower Court’s grant of Appellees’ Motion for Summary Judgment and Print Media’s Supplemental SJ Motion and remand the case back to the Lower Court for trial by jury on the merits of this case.

CERTIFICATE OF COMPLIANCE

I certify that this brief complies with the type-volume limitation set forth in FRAP 28.1(e)(2)(A)(i) and contains 9,876 words excluding the materials referenced in 11th Cir. R. 32-4.

Respectfully submitted,

/s/ Richard E. Fee

Richard E. Fee
Florida Bar No. 813680
Kathleen M. Wade
Florida Bar No. 127965
Cristina A. Castellvi
Florida Bar No. 55519
FEE & JEFFRIES, P.A.
1227 N. Franklin Street
Tampa, Florida 33602
(813) 229-8008
(813) 229-0046 (Facsimile)
rfee@feejeffries.com
kwade@feejeffries.com
ccastellvi@feejeffries.com
bszabo@feejeffries.com

*Counsel for Appellant,
Yellow Pages Photos, Inc*

CERTIFICATE OF SERVICE

The undersigned further certifies that a true and correct copy of the forgoing was electronically filed and served via United States Mail on the 4th day of December, 2020, to Eric F. Leon, Esq., Kuangyan Huang, Esq., and Nathan E. Taylor, Esq., LATHAM & WATKINS LLP, 885 Third Ave., New York, NY 10022

(eric.leon@lw.com, kuan.huang@lw.com, and nathan.taylor@lw.com), *Counsel for Appellees-Defendants.*

/s/ Richard E. Fee
Richard E. Fee
Florida Bar No. 813680