

PROVING COPYRIGHT INFRINGEMENT

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The essential elements of a copyright-infringement case are: ownership and copying.¹ Courts in 2009 addressed a number of issues that affect both of those elements as well as defenses such as both express and implied license, fair use and fee awards. Reviewing these cases does not necessarily reveal courts making new law. The cases do, however, cover in depth fundamental principles related to copyright-infringement litigation.

Regarding proof of ownership, “no civil action for infringement ... shall be instituted until ... registration of the copyright claim has been made in accordance with this title.”² Is the registration complete upon a party’s sending the application, fee and deposit copies to the Copyright Office, or must the Copyright Office pass (one way or another) on the application? The United States District Court for the Middle District of Tennessee decided in May that, until the Copyright Office passes on the application, the court lacks subject-matter jurisdiction to hear a case grounded in copyright infringement.³ The United States Supreme Court decided earlier this year that the “registration requirement is nonjurisdictional,”⁴ but that case did not answer the other question answered by the United States District Court for the Middle District of Tennessee last year: at what point in time does registration actually occur?

The court adopted the “registration approach” and reasoned that, from a statutory-interpretation perspective, “to read the statute to mean that registration occurs when the applicant files his materials would be to misread and render superfluous numerous provisions of the Copyright Act.”⁵ The court relied specifically upon Sections 410(a) and 411(a). The former requires the Register of Copyrights to issue a certificate of registration upon a determination that the deposited material

constitutes copyrightable material and satisfaction of the formal requirements of the title, and the latter specifies the procedure for pursuing a copyright-infringement suit upon refusal by the Register of Copyrights to issue a certificate of registration.

The court noted further that the district courts and circuit courts are split on whether to follow the “registration approach” or the “application approach.” The rationale for following the “application approach” is that, upon submission of the fee, deposit and application, the claimant “has done all that it can do, and will ultimately be allowed to proceed regardless of how the Copyright Office treats the application.”⁶

Upon establishing ownership, a plaintiff alleging copyright infringement then must establish copying. Absent direct evidence of copying, a plaintiff may establish an inference of copying by showing both access and substantial similarity. Courts this year addressed both of those elements.

In *Jones v. Blige*, the United States Court of Appeals for the Sixth Circuit affirmed summary judgment dismissing a copyright-infringement case, finding that an attenuated corporate connection between the defendant who authored the allegedly infringing work and an executive employed by that defendant’s record label was insufficient to establish a reasonable opportunity for the defendant/author to have heard the plaintiff’s work.⁷

The “corporate receipt doctrine” provides that “possession of a work by one employee of a corporation implies possession by another corporate employee who allegedly infringed the work.”⁸ In *Blige*, the plaintiff alleged that he had delivered the allegedly infringed work to an executive with Universal Music Enterprises, a division of

Universal Music Group Recordings, Inc. The allegedly infringing work, “Family Affair,” was recorded by Mary J. Blige and released by defendant Universal Music Group, Inc.

In rejecting “bare corporate receipt” as sufficient proof of access, the court noted that the plaintiff failed to present any evidence that Blige or anyone involved with the creation of “Family Affair” had any direct or indirect connection with the executive to whom the plaintiff had delivered his work.⁹ Recognizing that “chain of possession within a corporation is difficult to prove,” the court found “no evidence tending to show a reasonable possibility” that plaintiffs’ work made its way to the creators of “Family Affair.”¹⁰

Several courts addressed “substantial similarity.” Although substantial similarity is typically a fact-intensive inquiry, courts were increasingly willing to determine that no rational fact finder could determine the result any differently than the court, and courts consequently resolved substantial-similarity challenges on motions to dismiss and summary judgment.

In *Crane v. Poetic Products Limited*, the United States District Court for the Southern District of New York held that plaintiff’s play, *The Last Confession*, did not infringe the copyright of the defendant’s book, *In God’s Name: An Investigation into the Murder of Pope John Paul I*.¹¹ The court noted that neither historical facts nor interpretations of historical facts are protectable by the Copyright Act. The expression of those facts, however, may be protectable.

The court focused on whether, in the eyes of an ordinary lay observer, the protectable elements of the allegedly infringed work were substantially similar. The

court found “that no reasonable observer could find the two works substantially similar, and whatever similarities exist are trivial or concern non-copyrightable material.”¹²

In *Brainard v. Vassar*, plaintiffs alleged that Phil Vassar and Craig Wiseman’s song “Good Ole Days” infringed their copyright in their composition entitled “Good Ol’ Days to Come.”¹³ The court granted the defendants’ motion for summary judgment and found that “a reasonable juror could not conclude that the songs [at issue] are substantially similar.”¹⁴

The court wrote that, in the Sixth Circuit, a substantial-similarity analysis involves two parts. First, the court is required to filter out the unprotectible elements of the protected work so that the court is left with only the “expressive elements” of the protected work.¹⁵ The second step is then to determine whether the “core, expressive aspects of the work” are substantially similar.¹⁶ The court noted that the test is based on the net impression of the ordinary observer.¹⁷

Regarding filtering, the court identified three levels. First, ideas are filtered out. Next, *scenes a faire* — “incidents, characters or settings which are as a practical matter indispensable, or at least standard, in the treatment of a given topic” — are filtered out.¹⁸ “Finally, any other ‘common’ or ‘stock’ themes and usages are filtered out of the protected work and also not used for purposes of the comparison.”¹⁹

In *Randolph v. Dimension Films*, the United States District Court for the Southern District of Texas granted defendants’ motion to dismiss, finding that a “side-by-side comparison of the plaintiff’s book and defendants’ movie leads to the conclusion that there is no substantial similarity in the protectable elements of the works.”²⁰ The plaintiff’s work was her book entitled *Mystic Deja: Maze of Existence*. The allegedly

infringing work was the defendants' movie entitled *The Adventures of Shark Boy and Lava Girl in 3-D*.

Plaintiff argued that the themes—searching for one's father and identifying one's strengths—were substantially similar. The court rejected that argument and reasoned that themes are not protectable.²¹ The court also noted that “[d]ifferences in total concept and feel are important in determining the degree of similarity between the two works.”²² “The mood and appearance of the book is black and gothic. The movie is bright and busy, featuring ‘3-D special effects’ (the glasses come with the DVD).”²³

The United States District Court for the Eastern District of New York not only emphasized the importance of the total concept and feel, but also recognized that the test in the Second Circuit did not permit the court “to dissect the works at issue into separate components and compare only the copyrightable elements.”²⁴ Blakeman, the plaintiff, alleged that the defendants' movie, *Swing Vote*, infringed his copyrighted work, *Go November*. The court dismissed the copyright-infringement claim, finding “that any similarities between the works concern only non-copyrightable elements of plaintiff's works and, in any event, no rational trier of fact could possibly find that the works are substantially similar.”²⁵

Otherwise infringing conduct can be overcome with either an express or an implied license. In *EMI Entertainment World, Inc. v. Karen Records, Inc.*, the United States District Court for the Southern District of New York analyzed Section 115 of the Copyright Act's requirements to obtain a compulsory license as well as the method for terminating such a license.²⁶ The case arose “out of a long-running royalty dispute” between the parties.²⁷ With respect to three of the four works at issue, the court

concluded that Karen Records, Inc. (“Karen”), had substantially complied with the requirements of Section 115(b) even though the requests were not signed by “a duly authorized officer or agent of the corporation” and were not entitled “Notice of Intention to Obtain a Compulsory License for Making and Distributing Phonorecords” as required by enabling regulation 37 C.F.R. § 201.18.²⁸ “[S]uch errors are not fatal to a notice unless they ‘materially affect[ed] of the information required to serve the purposes of [17 U.S.C. § 115(b)].’”²⁹ Karen committed copyright infringement, however, for sales that occurred thirty days after The Harry Fox Agency, as licensing agent for the plaintiff, sent a termination letter in accord with Section 115 (c)(6).³⁰

With respect to the fourth work at issue, the court determined that Karen never acquired a license. The letter that Karen sent requested a license rather than expressing a clear intent to make use of the composition.³¹ Thus, Karen failed to comply with Section 115 and was therefore liable for copyright infringement.

A party can also avoid liability for copyright infringement if the relevant conduct establishes an implied license to exploit the subject work. In *Wilchombe v. Teevee Toons, Inc.*, the United States Court of Appeals for the Eleventh Circuit affirmed the district court’s order awarding summary judgment to defendants on plaintiff’s claim for copyright infringement.³² Plaintiff claimed copyright in the song “Weedman” that he authored after a discussion during a recording session that someone contact a supplier of marijuana. The song was included on defendant Lil Jon’s album entitled *Kings of Crunk*. The district court found that plaintiff created the song at Lil Jon’s request, that he understood that the song would be used on the album and that, at the time that he

delivered the song, he did not discuss with any of the defendants that using the song would constitute copyright infringement.³³

Even without a license, otherwise infringing conduct may be immune from liability under the doctrine of fair use. The United States District Court for the Southern District of New York decided two fair-use cases this year involving alleged parodies. In one case, the court found that the allegedly infringing work was a parody of the song *When You Wish Upon a Star*.³⁴ In the other case, the court found that the book *60 Years Later: Coming Through the Rye* was neither a parody nor protected by the doctrine of fair use.³⁵

In *Bourne*, the plaintiff alleged that a song that appeared in the television series *Family Guy* infringed its copyright in *When You Wish Upon a Star*; defendants claimed that the song was a parody and that they were protected from plaintiff's claim by the doctrine of fair use.

The court first determined whether the song was a parody, satire or neither. The court wrote that “[t]he distinction between parody and satire turns on the nature of the ‘comment’ made by the allegedly infringing work.”³⁶ Relying upon the United States Supreme Court’s decision in *Campbell v. Acuff-Rose Music, Inc.*, the district court noted that parody uses the prior author’s material to comment on that very material. “Parody needs to mimic an original to make its point ... whereas satire can stand on its own two feet and so requires justification for the very act of borrowing.”³⁷

The court determined that the song was a parody, but that was not the end of the analysis. The court analyzed the allegedly infringing song using the four factors enumerated in Section 107 of the 1976 Copyright Act: the purpose and character of the

use, the nature of the protected work, the amount and substantiality of the portion used in relation to the copyrighted work as a whole and the effect of the use upon the potential market for or value of the copyrighted work.³⁸

The test in analyzing the first factor is whether the new work “adds something new to the original song and qualifies as ‘transformative.’”³⁹ The court found that the new song was “strikingly different in tone and message” and that “the tune of the song, though very similar to the original, is somewhat different.”⁴⁰

The second factor was satisfied because the plaintiff’s work, a musical composition, clearly falls within the “core of copyright’s protective purposes.”⁴¹ Regarding the third factor, the amount taken in proportion to the copyrighted work, the court noted that a parody may require taking substantially all of the work “to allow the parodic character of the work to come through.”⁴²

The court articulated the test for the fourth factor as “whether the secondary use usurps the market of the original work.”⁴³ The court found in favor of the defendant on this point; “[a]s the Supreme Court predicted, the parody and the original here serve different market functions.”⁴⁴ The court found that the defendants’ use of the plaintiff’s work was fair. The court therefore granted defendants’ motion for summary judgment.⁴⁵

In *Salinger*, the court again began its analysis by determining whether the defendants’ work was a parody, satire or neither. The court distinguished satire from parody. “Unlike satire, which critiques and comments on aspects of society more broadly, parody sharpens its knives for the very work from which it borrows.”⁴⁶

The court found that the defendants' work "contains no reasonably discernable rejoinder or specific criticism of any character or theme" of the plaintiff's work.⁴⁷ The court also found that the defendants' work "contains no reasonably perceived parodic character as to *Catcher* and Holden Caulfield."⁴⁸

Defendants argued that the novel was, in part, a critique of the reclusive nature of Salinger himself. That, however, did not meet the definition of parody because the criticism was not directed at either *Catcher* or Caulfield.⁴⁹

After deciding that the novel was not a parody, the court then analyzed the four fair-use factors enumerated in the 1976 Copyright Act. Although the use of Salinger as a character did add some transformative value and *Catcher* was a work that fell within "the core of the copyright's protective purposes," the court did not find that the allegedly infringing work was protected by the fair-use doctrine.⁵⁰

Under the Copyright Act, a prevailing party may be entitled to recover its attorneys' fees and costs. If a plaintiff sues for two alleged infringements but only prevails on one of the two claims, who is the prevailing party?

According to the United States District Court for the Southern District of California, "the prevailing party is the one who succeeds on a significant issue in the litigation that achieves some of the benefits the party sought in bringing suit."⁵¹ The district court granted summary judgment in favor of the defendant with respect to one of the claims for copyright infringement, but a jury returned a verdict of willful copyright infringement, trade dress infringement and false designation of origin with respect to a different work.⁵² The court awarded fees to the plaintiff and denied the defendant's request for fees.⁵³

Why not allocate fees based on the success that each party achieved? The court concluded that allocation was not required because the parties’ “copyright claims arose from a common core of facts, the evidence of infringement overlapped, and the claims were based on the same governing law.”⁵⁴

Although articulating the fundamentals of proving copyright infringement is no more difficult than listing ownership and copying, a copyright infringement case can raise a number of issues that require a much more thorough analysis. Whether the corporate receipt doctrine is itself sufficient to allow a case to go to the jury becomes an analysis of the principles of circumstantial evidence, and whether an implied license exists may require applying state-law rules of contract interpretation. Whether a party is a “prevailing party” in a copyright-infringement case can lead to a rule that may be applied in other contexts. Cases decided in 2009 explored each of those issues, and in so doing reaffirmed the potential complexity of analyzing and proving copyright infringement.

¹ *Ellis v. Diffie*, 177 F. 3d 503 (6th Cir. 1999).

² 17 U.S.C. § 411(a).

³ *Specific Software Solutions, LLC v. Institute of Workcomp Advisors, LLC*, 615 F. Supp. 2d 708, 715 (M. D. Tenn. 2009).

⁴ *Reed Elsevier, Inc. v. Muchnick*, 130 S.Ct. 1237 (U.S. 2010).

⁵ *Specific Software Solutions, LLC*, 615 F. Supp. 2d at 716.

⁶ *Id.* at 715 (quoting *Nimmer on Copyright* § 7.16 (B)(1)(a)(i)).

⁷ *Jones v. Blige*, 558 F. 3d 485 (6th Cir. 2009).

⁸ *Id.* at 492.

⁹ *Id.* at 493.

¹⁰ *Id.*

¹¹ *Crane v. Poetic Products Limited*, 593 F. Supp. 2d 585 (S.D.N.Y. 2009).

¹² *Id.* at 595.

¹³ *Brainard v. Vassar*, 625 F. Supp. 2d 608 (M.D. Tenn. 2009).

¹⁴ *Id.* at 621.

¹⁵ *Id.* at 617 (internal citation omitted).

¹⁶ *Id.*

¹⁷ *Id.*

¹⁸ *Id.*
¹⁹ *Id.*
²⁰ *Randolph v. Dimension Films*, 630 F. Supp. 2d 741, 746 (S.D. Tex. 2009).
²¹ *Id.* at 749.
²² *Id.* at 748-49.
²³ *Id.* at 748.
²⁴ *Blakeman v. The Walt Disney Company*, 613 F. Supp. 2d 288, 314 (E.D.N.Y. 2009)(internal citations omitted).
²⁵ *Id.* at 306.
²⁶ *EMI Entertainment World, Inc. v. Karen Records, Inc.*, 603 F. Supp. 2d 759 (S.D.N.Y. 2009).
²⁷ *Id.* at 761.
²⁸ *Id.* at 766.
²⁹ *Id.*
³⁰ *Id.* at 768.
³¹ *Id.*
³² *Wilchombe v. Teevee Toons, Inc.*, 555 F.3d 949 (11th Cir. 2009).
³³ *Id.* at 956.
³⁴ *Bourne Co. v. Twentieth Century Fox Film Corporation*, 602 F. Supp. 2d 499 (S.D.N.Y. 2009).
³⁵ *Salinger v. Colting*, 641 F. Supp. 2d 250 (S.D.N.Y. 2009).
³⁶ *Bourne*, 602 F. Supp. 2d at 504.
³⁷ *Id.* at 505 (quoting *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 576-77 (1994)).
³⁸ *Id.* at 504.
³⁹ *Id.* at 508-509 (internal citation omitted).
⁴⁰ *Id.* at 509.
⁴¹ *Id.*
⁴² *Id.* at 510.
⁴³ *Id.*
⁴⁴ *Id.*
⁴⁵ *Id.* at 511.
⁴⁶ *Salinger*, 641 F. Supp.2d at 256.
⁴⁷ *Id.* at 258.
⁴⁸ *Id.* at 260.
⁴⁹ *Id.* at 261.
⁵⁰ *Id.* at 263, 268.
⁵¹ *Brighton Collectibles, Inc. v. Coldwater Creek, Inc.*, 2009 U. S. Dist. LEXIS 4005 at *6-7 (S. D. Ca., January 20, 2009)(quoting *Thoroughbred Software Int'l, Inc. v. Dice Corp.*, 488 F. 3d 352, 362 (6th Cir. 2007)).
⁵² *Brighton Collectibles, Inc.*, 2009 U. S. Dist. LEXIS 4005 at *2-3.
⁵³ *Id.* at *9.
⁵⁴ *Id.* at *9-10.